

A Note on Paris Priority Claims for Hague Design Applications

By Rick Neifeld, Neifeld IP Law, PC

The kinks are still being worked out of the Hague international design application system. One such kink is how to accrue the benefit of a Paris priority claim to an earlier design application. For at least the United States, the Republic of Korea (that is South Korea), and Japan, obtaining that benefit is problematic due to their requirements to timely file a certified copy of the priority document.

To minimize the risk of loss of priority in those countries, you should order certified copies of the priority document as soon as you know that you intend to file Hague and claim Paris priority. From <http://www.wipo.int/hague/en/guide/ia.html#r13>:

Notwithstanding the general principle above, **Japan and the Republic of Korea have indicated that their national laws require that a priority document be furnished to their Offices, in all cases, in order to support priority claims, within three months from the date of publication of the international registration in the International Designs Bulletin, and such a priority document be certified by the Office in which the earlier application was filed (“certified priority document”).**

For both Japan and the Republic of Korea, the period for submitting a certified priority document is **three months from the date of publication of the international registration** in the International Designs Bulletin, failing which the right of priority will be lost and, as a consequence, their Offices may refuse the international registration.

For the United States of America, a **certified priority document must be submitted during the pendency of the application for patent before the United States Patent and Trademark Office (USPTO) (i.e. prior to issuance of the patent or abandonment) and, furthermore, should be submitted on or before the date of the payment of the issue fee (second part of the individual designation fee for the United States of America).**

Generally, speaking the certified copy must be filed by a patent practitioner registered with the national office. However, Annex V to a Hague application filing provides for inclusion of a certified copy of the priority document. A certified copy of the priority document Annex V meet the national requirement for South Korea. Furthermore, and the USPTO allows a natural person who is a Hague applicant to file in the USPTO a certified copy of their priority application.