

Rule by Rule review of "Changes To Implement the Hague Agreement Concerning International Registration of Industrial Designs; Proposed Rule" 78 FR 71870, published 11/29/2013.

I. INTRODUCTION

Hague is nearing implementation in the USPTO. For a review of Hague, see ["Summary of the Hague Agreement Concerning the International Registration of Industrial Designs" Rick Neifeld, November 5, 2012](#). For a review of the US statutory implementation of Hague, see ["The Patent Law Treaties Implementation Act of 2012," now Public Law 112-211](#).

The proposed rules published 11/29/2013 sent only a 1 month comment period, indicating the urgency with which the USPTO considers promulgation of rules implementing Hague and entry into Hague. What follows is a brute force, rule by rule review, of all of the proposed rules. the format followed below is generally a summary of a proposed rule, followed by the citation to the rule.

II. REVIEW OF THE PROPOSED CHANGES TO PRE EXISTING RULES IN 37 CFR PARTS 1 (RULES OF PRACTICE); 3(ASSIGNMENT AND RECORDING); 5 (SECRECY AND LICENSE TO EXPORT)

Cert of mailing does not apply to a international design application filing. 1.8(a)(2)(K)
The definition "national application" includes an international design application. 1.9(a)(1)
The definition "nonprovisional application" includes an international design application. 1.9(a)(3).

Hague Agreement Regulations as used in this chapter means the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement; and Hague Agreement Rule as used in this chapter means one of the Hague Agreement Regulations. 1.9(m).

An international design application as used in this chapter means an application for international registration of a design filed under the Hague Agreement 1.9(n).

Unless otherwise clear from the wording, reference to “design application” or “application for a design patent” in this chapter includes an international design application that designates the United States. 1.9(n).

International design applications will be publicly available to the same extent as noted in paragraphs (a)-(I) of rule 1.14. 1.14(j). Generally, this means that the USPTO will make public an international design application that has been published or for which a priority claim exists in a publicly available application. 1.14.

There is a fee for petitioning the USPTO to review the filing date of an international design application. 1.17(f).

There is a fee for petitioning the USPTO to excuse belated cation in an international design application. 1.17(u).

There is a fee for petitioning the USPTO to convert an international design application to a design application under 35 U.S.C. chapter 16. 1.17(v).

The issue fee may optionally be paid through the IB in which case the IB fee schedule

applies. The IB fee schedule shows international design application fees include 4 fees. The basic fee, the standard designation fee for each designated country; an individual design fee for each designated country; and a publication fee. The standard designation fee for an examination country like the U.S. is a level three designation. The IB specifies fees in Swiss Francs.

Note: These fees are:

Basic: 397 for one design +19 per each additional design.

Publication: 17 per reproduction (+ additional fees if submitted in paper)

Publication: 2 per word, for words in excess of 100.

Designation of the US: 90 + 40 per each additional design.

Base fee for a Hague application designating only the US: 504 = \$554 at current exchange rates. By comparison, the base fee for a US design patent application filing is \$880 (large entity) and grant is \$760 (large entity).

The cost for international design applications fees in the USPTO may be paid via a USPTO deposit account. 1.25(b).

International design applicants can qualify for micro entity status; for such applications filed at the IB, the micro entity status certification needs to be filed at the IB when filing the application. 1.29(e).

The creators specified in the international publication of the international registration are defined to be the inventorship, for purposes of US law. 1.41(f).

The new rule AIA rule 1.46 provisions entitling the applicant to be the assignee, obligated assignee, or SPI party applies to international design applications before the United States as a designate office. However, assignee, obligated assignee, or SPI party must have been identified as the applicant for the United States in the holder in the publication of the international registration under Hague Agreement Article 10(3). 1.46(b).

Hague article 16 provides for recording of changes before the IB. This includes any change in ownership; name; address; representative; renunciation; limitation; invalidation in the territory of a designated office by that office; and any other relevant fact. Hague article 16 makes such changes legally effective in every designated office. However, under the proposed U.S. rules, a Hague article 16 filing is effective to "correct" the name of the original applicant whereas a request to "replace the original applicant" with an assignee, obligated assignee, or SPI party will only be effective if accompanied by an updated ADS. 1.46(c).

A rule 1.53(d) CPA application cannot be filed for an international design application. 1.53(d)(1)(ii).

The benefit of an international design application may be claimed in a subsequently filed U.S. application. 1.55(b).

The claim for priority to a foreign application in an international design application may be made by complying with the Hague Agreement and Hague Agreement regulations, or by an ADS filed in the USPTO after the publication of the international registration under Hague Agreement Article 10(3). The priority claim and certified copy of the priority document must be filed pursuant the requirements of pre-existing 1.55(g). 1.55(m). (1.55(g) requires the claim and certified copy be filed during pendency of the application.)

Inadvertently omitted portions of the specification and drawings which are contained in an application to which priority (1.55) or benefit (1.78) is claimed may be inserted into the

application by operation of incorporation by reference. 1.57(a).

An amendment to an international design application that designates the United States is effective and does not change the international filing date. 1.57(a)(3).

An application data sheet can identify the "intellectual property authority" in which a foreign application was filed, in lieu of a country, in order to be entitled to the filing date of the foreign application. 1.76(b)(6).

An international design application can claim the filing date of an earlier US application, and a US application can claim the filing date of an earlier international design application. 1.78(c). However, the international design application must be entitled to a filing date as determined by the IB in accordance with the Hague Agreement as implemented in US law as 35 USC 384 and 381(a)(5). 1.78(c)(1)(iii).

The requirements for a specific reference to each prior filed application, the relationship of the prior filed applications, and that the specific reference be made via an ADS, are imposed on applications filed in the USPTO viz international design applications. For benefit to an international design application, the ADS must identify the prior filed "international registration number and international registration date." 1.78(c)(2).

Note: Proposed rule language in proposed 1.78(c)(2) "If the later-filed application is a nonprovisional application" is surplusage.

The USPTO reserves the right to require a certified copy and translation into English of any international design application that designates the United States but "did not originate in the United States." 1.78(c)(7).

The USPTO may accept a belated priority claim viz an international design application, if the delay was unintentional. 1.78(d).

The USPTO is implementing a new type of drawing standard for international design applications, by incorporating the "requirements of Rule 9 and Part Four of the Administrative Instructions" of Hague in new rule 1.1026. 1.84(y).

Note: WIPO posts the Hague rules here:

http://www.wipo.int/export/sites/www/hague/en/legal_texts/pdf/hague_common_regulations.pdf

Hague rule 9(1) provides for use of "photographs or other graphic representations of the industrial design itself or of the product or products which constitute the industrial design".

Hague rule 9(2) provides for disclaimers of shown material.

Hague rule 9(3)(a) requires countries (contracting parties to Hague) to declare to WIPO any required views and circumstances in which they are required. Currently, no country has made such a declaration, as indicated by: <http://www.wipo.int/hague/en/declarations/declarations.html>

Hague rule 9(3)(b) limits the number of required views to not more than one for a two-dimensional design, and not more than six views for a three-dimensional product.

Hague rule 9(4) prevents a country (contracting parties to Hague) from refusing "the effects of the international registration" because of lack of a view required by that country's national law, unless that additional view was declared pursuant to rule 9(3).

A drawing in an international design application complying with US rule 1.1026 (which means complying with Hague rule 9) may be admitted for examination, and a drawing in an international design application that does not comply with Hague rule 9 at the time an application is allowed in the USPTO, the USPTO will so notify the application and allow 3 months for the

applicant to file a corrected drawing complying with Hague rule 9. 1.85(a) and (c).

An IDS will be considered by the USPTO if filed within 3 months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application. 1.97(b)(3).

An RCE cannot be filed for an international design application. 1.114(e)(5).

Examination of an international design application that designates the United States may be expedited, if the application has been published by the IB. 1.55(a)(1).

International design applications will not be published by the USPTO. 1.211(b).

The date the issue fee is paid in an international design application, for purposes of determining if an amendment is before or after payment of the issue fee, is the date the issue fee payment is recorded by the USPTO (in cases where the issue fee is paid to the IB). 1.312.

Recondition of assignments, in the USPTO, of international design applications must identify the international design application by either the international registration number or by the U.S. application number assigned to the international design application. 3.21.

International design applications may be subject to secrecy orders, require a license for export if the design was made in the U.S., 5.1; 5.3; and 5.11.

One can petition for a foreign filing license for design. 5.13.

Former Office employees are barred from representing before the USPTO in an international design application in which the former employee "participated personally and substantially as an employee of the Office"; and are barred for two year from such representation in an application that was under the former employee's official responsibility. 11.10(b)(3)(iii).

III. PROPOSED NEW 37 CFR PART 1, SUBPART DIRECTED TO INTERNATIONAL DESIGN APPLICATIONS, AND ITS PROPOSED RULES

There is a new 37 CFR subpart I titled "International Design Application" having rules numbered 1.1001 through 1.1070.

Rules 1.1001 to 1.1004 are in a subsection titled "General Information".

Rule 1.1011 is in a subsection titled "Who May File An International Design Application".

Rules 1.1021 to 1027 are in a subsection titled "The International Design Application"

Rule 1.1031 is in a subsection titled "Fees".

Rule 1.1035 is in a subsection titled "Priority".

Rule 1.1041 is in a subsection titled "Representation".

Rule 1.1045 is in a subsection titled "Transmittal of the International Design Application to the International Bureau".

Rules 1.1051 to 1.1052 are in a subsection titled "Relief From Prescribed Time Limits; Conversion to a design Application Under 35 U.S.C. Chapter 16".

Rules 1.1061 to 1.1070 are in a subsection titled "National Processing of International Design Applications".

References in USPTO rules 1.1001 et seq refer to the Hague Treaty, rules, and administrative instructions. 1.1001.

The USPTO is an "office of indirect filing" which will receive international design applications and fees (where the applicant's contracting party is the United States), and transmit the international design application to the IB unless the USPTO issues a secrecy order. 1.1002.

The USPTO is the designated office for the United States. In this capacity, the USPTO will accept international design applications and examine them pursuant to 35 USC Chapter 16, and communicate the results of the examination to the IB. 1.1003.

Note: 35 USC Chapter 16 contains the statute sections of substantive law for US design patent. These sections are 35 USC 171 (titled "Patents for designs"); 172 (titled "Right of priority"); and 173 (titled "Term of design patent").

The IB will receive international design applications directly from applicants and indirectly on behalf of applicants from any office of indirect filing, collect fees and credit accounts of member countries (contracting parties); review international design applications for formal compliance; translate the international design applications into required languages; record the international design applications in the "International Register"; publish the international design applications in the "International Designs Bulletin"; transmit copies for the publication of the international registration to each designated office. 1.1004.

The filing of international design applications in the USPTO is limited to those having domicile, residence, or an industrial or commercial establishment in the United States. If the applicant for the international design registration is not a person qualified under 35 U.S.C. chapter 11 to be an applicant, the USPTO as a designated office will refuse the application. 1.1011.

An international design application must be in one of three languages. English, French, or Spanish.

An international design application must contain a request for registration under Hague. It must include data concerning the applicant; copies of the reproductions or, for a two-dimensional design, specimens and a request for deferment of publication; indication of product corresponding to the design; list of designated countries (contracting parties); the basic, designations, and publication fees; identification of the countries (contracting parties) in which the applicant is qualified to "be the holder of an international registration" within the meaning of Hague rule 7(3)(iii), and a country (contracting party) in which the applicant has standing under Hague; the number of designs in the international design application; fee payment method information and authorization. 1.1021(a).

Hague article 5(2) and rule 8(2) allow contracting parties to require additional information, including identify of the creator, a brief description, and a claim, and to require the application be filed in the name of the creator. 1.1021(b).

Note: WIPO's list of declarations by contracting parties indicate that Romania and Syria require some of this additional information. See:

<http://www.wipo.int/hague/en/declarations/declarations.html>

An international design application may contain two or more industrial designs, so long as all designs are for products that belong to the same Locarno International Classification. 1.1021(c)(1).

Note: WIPO posts the list of classes of the Locarno (International) classification at: <http://www.wipo.int/classifications/nivilo/locarno/index.htm?lang=EN#>

An international design application may contain a request to defer publication.
1.1021(c)(2).

An international design application may contain any of the additional mandatory information specified in article 5(2) and rule 8(4), even when not required by designations.
1.1021(c)(3).

An international application may contain name and address of representatives; a claim for priority; Paris article 11 declarations of prior disclosures; a statement of material information; and proposed translations. 1.1021(c)(4)-(9).

An international design application that designates the United States must contain a claim; identity of the creator; a rules 1.63 or 1.64 inventor oath or declaration; inventor and substitute statement signor's addresses.

No particular form is required to file an international design application. 1.1022.

The date of the international registration determined by the IB is the United States filing date, subject to correction via petition. 1.1023.

An international design application designating the U.S. must include a 35 USC 112 compliant specification, which preferably includes brief descriptions of the reproductions.
1.1024.

Note: Hague Rule 11 prohibits the specification from concerning technical features of the operation of the industrial design or its possible utilization."

The claim of an international design application designating the U.S. must be in "formal terms to the ornamental design for the article (specifying name of article) as shown, or as shown and described." Only one claim is permitted. 1.1025.

The reproductions in an international application shall comply with Rule 9 and part four of the Administrative instructions of Hague. Rule. 1.1026.

Note: The Hague Administrative instructions are available at:
http://www.wipo.int/export/sites/www/hague/en/legal_texts/pdf/admin_instructions.pdf. The Hague administrative instructions in part for include sections 401 to 407.

Section 401 provides the following. It authorizes both photographs and other graphics, black and white, and color. It limits the number of copies of each representation to one. It specifies that the publication will be of the representations in the orientation in which they are provided, and that each representation must fall within a right-angled quadrilateral.

Section 402 provides the following. Photographs must exclude objects other than the product having the industrial design. Dimensions of each representation must be no larger than 16 centimeters on a side and no smaller than 3 centimeters. Technical drawings containing axes; dimensions; explanatory text, shall not be accepted.

Section 403 provides the following. Disclaimers may be made in the description; and by dotted or broken lines.

Section 404 appears to relate only to paper representations. It provides that photographs must have edges cut at right angles, that any background must be neutral and plain, and that retouched photos shall not be allowed.

Section 405 provides the following. Representations must be numbered in a margin. Plural representations of the same design must be in the following number format: 1.1; 1.2; 1.3...

Plural representations of a subsequent design in the same application must be in the form 2.1; 2.2; 2.3 ... Representations must also be in the application in ascending order.

Section 406 provides the following relating to physical specimens. Specimens may not be larger than 26.2 centimeters by 17 centimeters, 50 grams in weight, or 3 millimeters in thickness, and must be pasted onto A4 sized paper sheets, and physical packages transmitting specimens are limited to 4 kilograms.

Section 407 provides the following. The application must identify the relationship of the principle design in the international design application to any principal application or registration in any designated country (contracting party). The identification may be to an industrial design number in the international design application; or to the number of some other national or international registration; or to the number of a pending national application or applicant reference number therefore; or the reference give by the IB to another international application; and the number of industrial designed in the international design application having such relationships.

A request for deferment of publication and specimens are not permitted in an international design application that designates any other country that does not permit deferment. The U.S. permit neither deferment nor specimens.

The USPTO will charge a transmittal fee for international design applications filed with it. 1.1031(a).

The remaining fees for an international design application filed in the USPTO may be paid either to the USPTO (in dollars) or to the IB (in Swiss Francs). 1.1031(b) and (c).

International design applications are entitled to Paris convention priority. 1.1035.

An applicant may appoint a representative before the IB pursuant to Hague rule 3 or before the USPTO. The USPTO will only recognize registered patent attorneys and agents. 1.1041.

Note: Hague rule 3 provides the following. The IB will only recognize one representative per application or registration, but a partnership or firm will be recognized as one representative. Only the applicant can appointment a representative.

The USPTO notifies both the IB and the applicant of the date it receives the application. 1.1045(a).

That USPTO will not transmit the application to the IB if the USPTO imposes a secrecy order. 1.1045(b).

After the USPTO has transmitted the application to the IB, the USPTO will not forward correspondence regarding the application to the IB. 1.1045(c).

The USPTO will accepted belated action by the applicant under the "unintentional" standard; via petition; fee; reply; "copy of any invitation sent from the International Bureau setting a prescribed time limit"; and "certified copy of the originally filed international design application" unless the certified copy is already present in the USPTO. 1.1051(a).

The USPTO will accept as a reply a continuing application if the international design application has not been registered; or merely a grantable petition where the USPTO was the office of indirect filing. 1.1051(c).

An international design application filed in the USPTO as the office of indirect filing may

be converted to a U.S. design application, if the international registration of the international design application has not yet been published. This conversion required a petition, petition fee, and basic U.S. design application filing fees, and inventor declaration. 1.1052(a).

Similar rules apply if the petition is filed and granted before the international design application is transmitted to the IB. 1.1053(b).

Rules of practice applicable to U.S. design application are generally applicable to international design applications designating the U.S. 1.1061.

International design applications designating the U.S. are examined in the USPTO, but grounds for refusal are limited by Hague. 1.1062(a). The USPTO generally has 12 months to notify the IB that an application is refused. The exception is when there was a timely decision transmission of which to the IB was unintentionally delayed (per Hague rule 18(1)(c)(ii)). 1.1062(b).

Note: Hague Rule 26(3) replaces the Bulletin with website publication. Hague rule 18(1)(a) provides for notification of the IB within 6 months, but Hague rule 18(1)(b) extends the time for examination Offices to 12 months if that country (contracting party) submits a declaration noting the 12 month period.

If the USPTO refuses an application, it will specify the grounds for refusal, set a time period for reply, and any reply must be filed with the USPTO, not with the IB. 1.1063.

The USPTO will require election of one independent and distinct design when examining an international design application containing more than one such design. Such a requirement is reviewable pursuant to 1.143 and 1.144. 1.1064.

The USPTO will correspond with the address identified in the international design application unless that address is changed by the party specified in 1.33(b)(1) (practitioner of record) or 1.33(b)(3) (the applicant), and changed as specified in rule 1.33(a)(in an ADS or other clearly identifiable manner).

The title of an international design application must designate the particular article; must include the inventor declaration. 1.1067.

The USPTO will notify the IB if the applicant files a division application, providing the IB with the international registration; the number of designs contained in the division; and the division application numbers. 1.1069.

The design patentee must inform the USPTO if the design patent is invalidated in the United States, and the USPTO will then notify the IB. 1.1070.

Note: The IB will record the invalidation in the International Register. Hague rule 20(2).

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