

# Review of the United States Statutory Implementation of the Hague Agreement Concerning International Registration of Industrial Designs

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## I. INTRODUCTION

On December 18, 2012, the President signed into the "Patent Law Treaties Implementation Act of 2012", now Public Law 112–211. Title I of Public Law 112–211 is the United States statutory implementation of the Hague Agreement Concerning International Registration of Industrial Designs (herein after "Hague"). This article reviews the provisions of Title I of Public Law 112–211.

Title I consists of Sections 101, 102, and 103. Section 101 provides a new chapter 38 of 35 USC, which contains the substantive sections of United States Code implementing Hague. Section 102 contains confirming amendments in other sections of United States Code (herein after "USC"). Section 103 is an effective date provision.

## II. SECTION 101 OF Public Law 112–211

Section 101 provides Chapter 38, which is titled "International Design Applications." Chapter 38 contains USC sections 381 to 390. Each of these USC sections is produced below. Comments about a section, were applicable, appear below the section.

### § 381. Definitions

(a) IN GENERAL. When used in this part, unless the context otherwise indicates (1) the term 'treaty' means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva on July 2, 1999; (2) the term 'regulations' (A) when capitalized, means the Common Regulations under the treaty; and (B) when not capitalized, means the regulations established by the Director under this title; (3) the terms 'designation', 'designating', and 'designate' refer to a request that an international registration have effect in a Contracting Party to the treaty; (4) the term 'International Bureau' means the international intergovernmental organization that is recognized as the coordinating body under the treaty and the Regulations; (5) the term 'effective registration date' means the date of international registration determined by the International Bureau under the treaty; (6) the term 'international design application' means an application for international registration; and (7) the term 'international registration' means the international registration of an industrial design filed under the treaty.

(b) RULE OF CONSTRUCTION. Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.

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I have no comments on section 381.

§ 382. Filing international design applications

(a) **IN GENERAL.** Any person who is a national of the United States, or has a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the United States, may file an international design application by submitting to the Patent and Trademark Office an application in such form, together with such fees, as may be prescribed by the Director.

(b) **REQUIRED ACTION.** The Patent and Trademark Office shall perform all acts connected with the discharge of its duties under the treaty, including the collection of international fees and transmittal thereof to the International Bureau. Subject to chapter 17, international design applications shall be forwarded by the Patent and Trademark Office to the International Bureau, upon payment of a transmittal fee.

(c) **APPLICABILITY OF CHAPTER 16.** Except as otherwise provided in this chapter, the provisions of chapter 16 shall apply.

(d) **APPLICATION FILED IN ANOTHER COUNTRY.** An international design application on an industrial design made in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17 if the international design application is filed (1) in a country other than the United States; (2) at the International Bureau; or (3) with an intergovernmental organization.

35 USC 382(a) allows an entity that would not qualify as an applicant for a United States patent to file an international design application in the Patent and Trademark Office (herein after "USPTO"). Keep in mind that obtaining a United States patent for such an application would require that the applicant be one entitled under United States law to a patent. That is, the inventor, assignee, obligated assignee, or Sufficient Proprietary Interest (SPI) party. See 35 USC 118; and "Review of "Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act" 77 FR 48776 (8/14/2012) Presented by Rick Neifeld, September 5, 2012, available on <http://www.neifeld.com/advidx.html>.

Chapter 17 of 35 USC deals with secrecy and licenses for foreign filing. The reference in 35 USC 382(b) to Chapter 17 therefore means that an international design application may be subject to a secrecy order in which case it will not be transmitted by the Patent and Trademark Office (herein after "USPTO") to the International Bureau (herein after the "IB").

Chapter 16 of 35 USC contains the substantive law provisions for United States design patents, sections 35 USC 171 (titled "Patents for designs"); 172 (titled "Right of priority"); and 173 (titled "Term of design patent"). The reference in 382(c) to Chapter 16 therefore means that patents resulting an international design applications will have the rights and limitations of a United States design patent.

35 USC 382(d) defines the filing of an international design application with the IB or any other intergovernmental organization a filing of an application in a foreign country. Unauthorized filings of an application in a foreign country are a violation of 35 USC 184. 35

USC 185 punishes such an unauthorized filing by invalidating the corresponding United States patent.

§ 383. International design application

In addition to any requirements pursuant to chapter 16, the international design application shall contain (1) a request for international registration under the treaty; (2) an indication of the designated Contracting Parties; (3) data concerning the applicant as prescribed in the treaty and the Regulations; (4) copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international design application, presented in the number and manner prescribed in the treaty and the Regulations; (5) an indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed in the treaty and the Regulations; (6) the fees prescribed in the treaty and the Regulations; and (7) any other particulars prescribed in the Regulations.

35 USC 383 cedes the specification of the substantive requirements of an international design application that are in addition to the requirements for U.S. design patent applications, to Hague.

§ 384. Filing date

(a) IN GENERAL. Subject to subsection (b), the filing date of an international design application in the United States shall be the effective registration date. Notwithstanding the provisions of this part, any international design application designating the United States that otherwise meets the requirements of chapter 16 may be treated as a design application under chapter 16.

(b) REVIEW. An applicant may request review by the Director of the filing date of the international design application in the United States. The Director may determine that the filing date of the international design application in the United States is a date other than the effective registration date. The Director may establish procedures, including the payment of a surcharge, to review the filing date under this section. Such review may result in a determination that the application has a filing date in the United States other than the effective registration date.

The effective registration date triggers the Hague deadline(s) for national rejections of the registration.

§ 385. Effect of international design application

An international design application designating the United States shall have the effect, for all purposes, from its filing date determined in accordance with section 384, of an application for patent filed in the Patent and Trademark

Office pursuant to chapter 16.

The "for all purposes" includes the effect as prior art under United States prior art law; the effect as a priority for purposes of determining what is prior art against the application; and the effect, if any (for example due to non statutory double patenting) on patent term.

§ 386. Right of priority

(a) NATIONAL APPLICATION. In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172, a national application shall be entitled to the right of priority based on a prior international design application that designated at least 1 country other than the United States.

(b) PRIOR FOREIGN APPLICATION. In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172 and the treaty and the Regulations, an international design application designating the United States shall be entitled to the right of priority based on a prior foreign application, a prior international application as defined in section 351(c) designating at least 1 country other than the United States, or a prior international design application designating at least 1 country other than the United States.

(c) PRIOR NATIONAL APPLICATION. In accordance with the conditions and requirements of section 120, an international design application designating the United States shall be entitled to the benefit of the filing date of a prior national application, a prior international application as defined in section 351(c) designating the United States, or a prior international design application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international design application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application as defined in section 351(c) which designated but did not originate in the United States or a prior international design application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.

35 USC 386 accords U.S. and foreign priority rights to international design applications to the same extent as it accords U.S. and foreign priority rights to all other applications.

§ 387. Relief from prescribed time limits

An applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international design application may be excused as to the United States upon a showing satisfactory to the Director of unintentional delay and under such conditions, including a requirement for payment of the fee specified in section 41(a)(7), as may be prescribed by the Director.

35 USC 387 provides for belated action based upon the "unintentional" standard. The United States struck the "unavoidable" standard (corresponding to the international "all due care"

standard) leaving only the "unintentional" standard for excusing belated action in the USPTO. See "Review of United States Statutory Implementation of the Patent Law Treaty" Rick Neifeld, November 18, 2013, available on <http://www.neifeld.com/advidx.html>.

§ 388. Withdrawn or abandoned international design application

Subject to sections 384 and 387, if an international design application designating the United States is withdrawn, renounced or canceled or considered withdrawn or abandoned, either generally or as to the United States, under the conditions of the treaty and the Regulations, the designation of the United States shall have no effect after the date of withdrawal, renunciation, cancellation, or abandonment and shall be considered as not having been made, unless a claim for benefit of a prior filing date under section 386(c) was made in a national application, or an international design application designating the United States, or a claim for benefit under section 365(c) was made in an international application designating the United States, filed before the date of such withdrawal, renunciation, cancellation, or abandonment. However, such withdrawn, renounced, canceled, or abandoned international design application may serve as the basis for a claim of priority under subsections (a) and (b) of section 386, or under subsection (a) or (b) of section 365, if it designated a country other than the United States.

An effect of 388 is that international design application that is a withdrawn or canceled as to the United States loses its status under United States law as prior art from its filing date, unless the priority to that application is claimed in a United States patent application.

§ 389. Examination of international design application

(a) IN GENERAL. The Director shall cause an examination to be made pursuant to this title of an international design application designating the United States.

(b) APPLICABILITY OF CHAPTER 16. All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter

16.

(c) FEES. The Director may prescribe fees for filing international design applications, for designating the United States, and for any other processing, services, or materials relating to international design applications, and may provide for later payment of such fees, including surcharges for later submission of fees.

(d) ISSUANCE OF PATENT. The Director may issue a patent based on an international design application designating the United States, in accordance with the provisions of this title. Such patent shall have the force and effect of a patent issued on an application filed under chapter 16.

35 USC 389(a) and (d) fails to require the USPTO to issue a patent when the international design application has not been timely examined by the USPTO within the meaning of Hague.

The only exception under Hague to timely examination is when the failure is unintentional. Systematic failures, such as those due to excessive backlogs, are not allowed under Hague. 35 USC 389(c) fails to proscribe the fees for filing specified in Hague, which means the USPTO must file a suitable declaration when acceding to Hague.

§ 390. Publication of international design application

The publication under the treaty of an international design application designating the United States shall be deemed a publication under section 122(b).

A publication under 122(b) is legally a United States patent application publication. This means that the publication under the treaty of an international design application designating the United States obtains the same legal effects as a United States patent application publication. The two important rights associated therewith are (1) the effect of the publication as prior art and of any priority claimed application therein as prior art, under 35 USC 102 and 103 and (2) the provisional rights to a reasonable royalty under 154(d).

### **III. SECTION 102 OF PUBLIC LAW 112–211 - CONFORMING AMENDMENTS**

Section 102 is titled "Conforming Amendments". It contains miscellaneous amendments to conform existing sections of 35 USC to Hague. The non substantive amendments include adding references to new USC section 386, in USC sections 100(i)(1)(B); 102(d)(2); 111(b)(7); 115(g)(1); and 120; 365(c); in USC section 154 adding a reference to international design applications in 154(d)(1).

35 USC 173 is substantively amended by changing the term of a design patent from 14 years to 15 years. As amended, 35 USC 173 now reads:

35 U.S.C. 173 Term of design patent.

Patents for designs shall be granted for the term of fifteen years from the date of grant.

### **IV. SECTION 103 OF PUBLIC LAW 112–211 - EFFECTIVE DATE**

Section 103 contains both effective date and applicability date provisions. It reads:

**SEC. 103. EFFECTIVE DATE.**

(a) **IN GENERAL.** The amendments made by this title shall take effect on the later of (1) the date that is 1 year after the date of the enactment of this Act; or (2) the date of entry into force of the treaty with respect to the United States.

(b) **APPLICABILITY OF AMENDMENTS.** (1) **IN GENERAL.** Subject to paragraph (2), the amendments made by this title shall apply only to international design applications, international applications, and national applications filed on and after the effective date set forth in subsection (a), and patents issuing thereon. (2) **EXCEPTION.** Sections 100(i) and 102(d) of title 35, United States Code, as

amended by this title, shall not apply to an application, or any patent issuing thereon, unless it is described in section 3(n)(1) of the Leahy-Smith America Invents Act (35 U.S.C. 100 note).

(c) DEFINITIONS. For purposes of this section (1) the terms “treaty” and “international design application” have the meanings given those terms in section 381 of title 35, United States Code, as added by this title; (2) the term “international application” has the meaning given that term in section 351(c) of title 35, United States Code; and (3) the term “national application” means “national application” within the meaning of chapter 38 of title 35, United States Code, as added by this title.

Sec. 103(a)(2) provides for effect when the United States accedes to Hague. That will presumably occur shortly after the USPTO finalizes its proposed regulations for implementing Hague. See "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," Rick Neifeld, available on <http://www.neifeld.com/advidx.html>.

Sec. 103(b)(1) makes the new Chapter 38 of USC effective for application filed on and after the United States accedes to Hague. Sec. 103(b)(1) prevents applicability of 35 USC 100(i) and 102(d) for applications not described in section 3(n)(1) of the Leahy-Smith America Invents Act (herein after "AIA"). Section 3(n)(1) of the AIA describes applications subject to the first inventor to file provisions of the AIA. These are all applications filed after March 15, 2013 with no priority claim, and these are all application filed after March 15, 2013 with a priority claim, if the substantive claim to exclusive rights in the application does not have written description support in a pre March 16, 2013 filed application.