
December 11, 2013

USPTO Issues Proposed Rules on Design Patents

On November 29, 2013, the Federal Register published a notice of proposed rulemaking from the United States Patent and Trademark Office (“USPTO”) to Implement the Hague Agreement Concerning International Registration of Industrial Designs (“Hague Agreement”). Currently, a U.S. design applicant seeking global protection generally has to file separate design applications in each country or intergovernmental organization for which protection is sought, complying with the formal requirements imposed by each country or intergovernmental organization. The main purpose of the Hague Agreement is to facilitate protection for industrial designs by allowing applicants to apply for protection in those countries and intergovernmental organizations that are Contracting Parties to the Hague Agreement by filing a single standardized application in a single language.

A. Background

The 1999 Geneva Act is the latest revision to the 1925 Hague Agreement (“1925 Agreement”). The United States is not a party to the 1925 Agreement, and did not join any of the subsequent Acts revising the 1925 Agreement because those agreements either did not provide, or did not adequately provide, for substantive examination of international design applications by national offices. The Hague Agreement, adopted on July 2, 1999, is the first Act that adequately provides for a system of individual review by the national offices of Contracting Parties. The Hague Agreement will take effect for the United States three months after the date its ratification is filed (deposited) with the Director General of the International Bureau of the World Intellectual Property Organization (“WIPO”) or at any later date indicated in the ratification instrument. According to the USPTO, the United States would not file its instrument of ratification until the necessary implementing legal structure was established domestically.

Title I of the PLTIA, enacted on December 18, 2012, amends portions of Title 35 of the United States Code to implement the terms of the Hague Agreement. Through these proposed rules the USPTO seeks to amend the relevant rules of practice in the Code of Federal Regulations to implement title I of the PLTIA. Thus, when the Hague Agreement ultimately takes effect in the United States after its ratification is properly filed, U.S. applicants will be able to file a single application for protection of an industrial design which will have effect in more than 40 territories.

B. Summary of Major Changes to Practice

The major changes to U.S. practice in title I of the PLTIA pertain to:

1. Standardizing formal requirements for international design applications;
2. Establishing the USPTO as an office through which international design applications may be filed;
3. Providing a right of priority with respect to international design applications;
4. Treating an international design application that designates the United States as having the same effect from its filing date as that of a national design application;
5. Providing provisional rights for published international design applications that designate the United States;
6. Setting the patent term for design patents issuing from both national design applications and international design applications designating the United States to 15 years from the date of patent grant;
7. Providing for examination by the USPTO of international design applications that designate the United States; and
8. Permitting an applicant's failure to act within prescribed time limits in an international design application to be excused as to the United States under certain conditions.

The USPTO is specifically proposing to revise the rules of practice to provide for the filing of international design applications by U.S. applicants in the USPTO as an office of indirect filing. The USPTO would transmit the international design application and any collected international fees to the International Bureau of WIPO, subject to national security review and payment of a transmittal fee. The International Bureau would review the application for compliance with the applicable formal requirements under the Hague Agreement.

Written comments must be received on or before January 28, 2014.

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A copy of the notice of proposed rulemaking is available in the Federal Register at <http://www.gpo.gov/fdsys/pkg/FR-2013-11-29/pdf/2013-28262.pdf>

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