Design Patents and the Hague Agreement

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Design patents protect the visual characteristics or aspects (e.g., appearance, ornamentation) of any article of manufacture. A design patent can be used to prevent competitors from producing similar items (e.g., knock-offs) intended to look like the original. In this way, the owner of the design patent may be able to exclude others from copying the new and non-obvious appearance associated with the patented product design.

Design patents can be just as effective in deterring competitors from copying as utility patents. For example, U.S. patent law allows both design and utility patent owners to claim compensatory damages, injunctive relief, attorneys’ fees, and enhanced damages. Any prevailing patentee is also entitled to reasonable royalties and can recover lost profits. With design patents, patent laws further allow design patent owners to claim damages in the amount of an infringer’s total profits.

As the United States officially joined the Geneva Act of Hague Agreement Concerning the International Registration of Industrial Designs (hereafter referred to as the Hague Agreement) on May 13, 2015, the usefulness of design patents has been improved in at least two different ways. Under the Hague Agreement, the lifespan of design patents is increased by an additional year, from fourteen years to fifteen years).

The other change that the Hague Agreement brings to design patents is facilitating the foreign filing process. Prior to May 13, 2015, applicants seeking foreign rights associated with a particular design application were required to file separate applications to each patent office where protection was desired. These foreign filings also needed to be completed within six months of the U.S. filing date. The Hague Agreement, however, provides a uniform minimum requirement for foreign filings for design patents across all countries that have agreed to the Hague Agreement. Some basic mandatory requirements include: the applicant name, figures, indication of product within a single Locarno Classification, and up to 100 different designs and embodiments.

The applicant should be cautioned, however, that the uniform minimum requirement for foreign filings laid out by the Hague Agreement should be considered only that. Each member of the Hague Agreement may introduce additional requirements that applicants would also need to fulfill. For example, the United States additionally requires a claim, identification of inventor(s), and an oath or declaration. Fulfillment of the additional requirements may be necessary before review of the application in that particular country may be commenced or a filing date assigned.

Foreign filings under the Hague Agreement may be submitted by each applicant in their home country via their national patent office (e.g., in the United States, the national patent office is the USPTO). Alternatively, an applicant may desire to pursue foreign filings through the World Intellectual Property Organization (WIPO). In the case of WIPO, the initial formalities (e.g., drawings) are reviewed. It should be noted that WIPO does not evaluate the substantive aspect of the foreign filing. Rather, WIPO evaluates to see if the minimum requirements for the foreign filing have all been satisfied. If the formalities are approved by WIPO, the submitted application should not be rejected based on the reviewed formalities in the separate designated countries.

After all the basic requirements for the foreign filings have been met, WIPO will generally publish the application at six months from filing or from the filing of any earlier priority application. It should be noted that it may be...
possible that publication of design applications can be deferred up to 30 months. There are some countries, including the United States, however, that do not allow deferment of publication of the design application.

Aside from publishing the application, WIPO will also transmit the design application to each of the applicant’s designated countries for substantive examination. At each designated country, the foreign-filed design application will be evaluated based on each particular country’s design patent laws.

To date, an Applicant can file design applications under the Hague Agreement in over 75 different countries. With the increased ease of foreign filings for U.S. applicants, there may be an increased incentive to pursue patent protection for designs in a wider array of countries than previously sought.

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