

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Seminar on the Hague System for the International Registration of Industrial Designs

## USPTO FEEDBACK

**David R. Gerk**

Attorney-Advisor

Office of Policy and International Affairs (OPIA)

[david.gerk@uspto.gov](mailto:david.gerk@uspto.gov)

571-272-9300

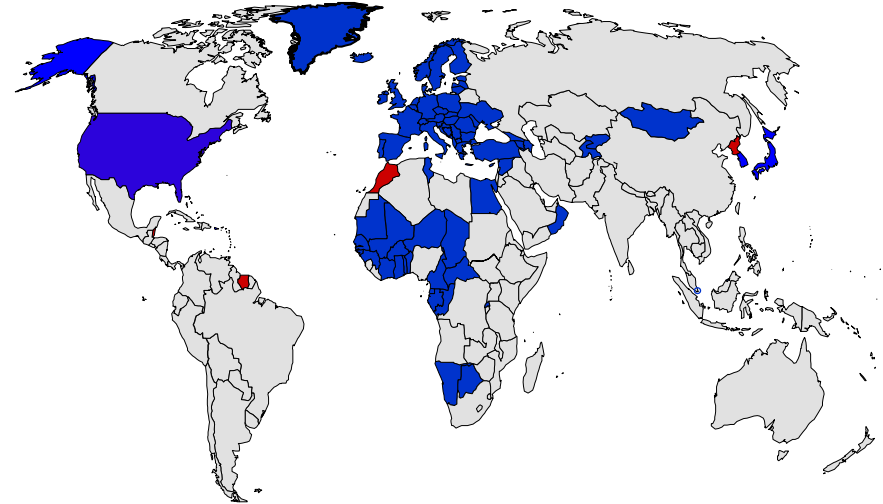
**June 23, 2016**

UNITED STATES  
PATENT AND TRADEMARK OFFICE



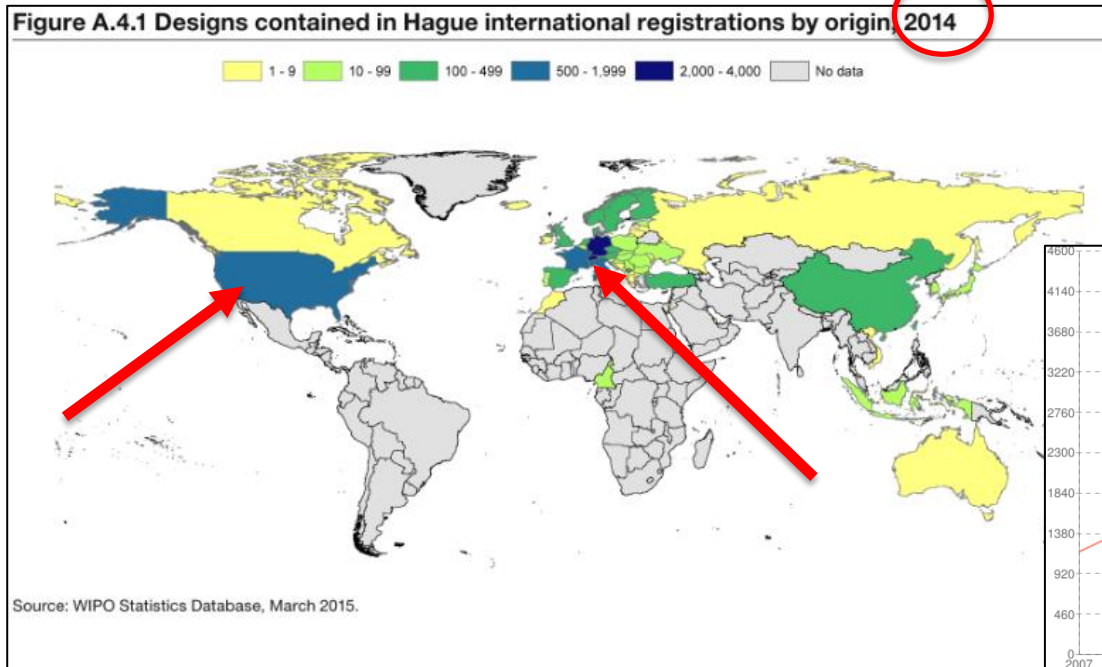
# The Hague Agreement

- **May 13, 2015:**  
**Hague Agreement  
in Effect in U.S.**
  - Title I of PLTIA
  - USPTO Rules
- **June 20-22, 2016:**  
**WIPO Hague  
Working Group**
  - Sixth Session

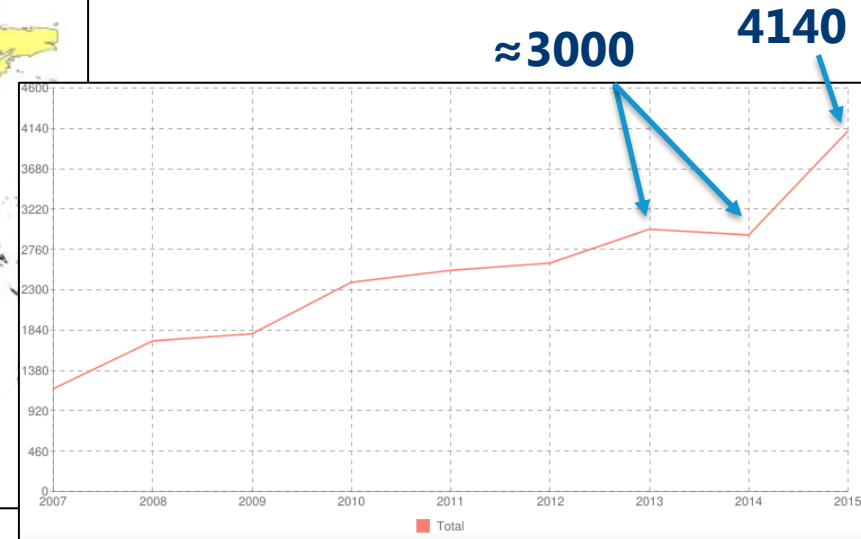


# The Hague Agreement

- Filing Statistics...



## Int'l Design Apps: 2007-2015



# The Hague Agreement

- **Helpful Information for Applicants & Representatives**

- *USPTO Hague Implementation Page*

- <http://www.uspto.gov/patent/initiatives/hague-agreement-concerning-international-registration-industrial-designs#tips>

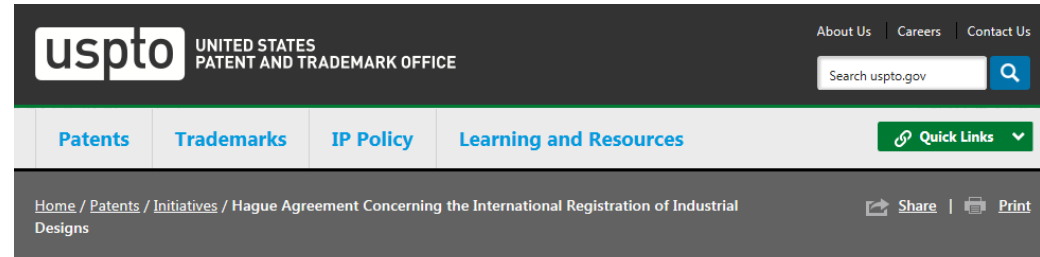
- *WIPO Hague System Page*

- <http://www.wipo.int/hague/en/>

# The Hague Agreement

- **USPTO Page**

- Forms
- Fees
- Resources
- FAQ
- Tips for Filing
- Contacts



Helpful 16

Not Helpful 3

## Hague Agreement Concerning the International Registration of Industrial Designs

Information concerning the Hague system, including geographic coverage and a guide for users, is available at WIPO's Web site <http://www.wipo.int/hague/en/>.

- [International Design Application Forms](#)
- [Fees](#)
- [Resources](#)
- [Frequently Asked Questions](#)
- [Tips for Filing New International Design Applications](#)
- [Contact Us](#)

Patents for Humanity

Information concerning the Hague system, including geographic coverage and a guide for users, is available at WIPO's Web site <http://www.wipo.int/hague/en/>.

# The Hague Agreement

- **USPTO Page**

- Forms
- Fees
- **Resources**
- FAQ
- Tips for Filing
- Contacts

The screenshot shows the top of the USPTO website. It includes the 'uspto' logo, the text 'UNITED STATES PATENT AND TRADEMARK OFFICE', a search bar with 'Search uspto.gov', and a navigation menu with links for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. There is also a 'Quick Links' dropdown menu. Below the navigation is a breadcrumb trail: 'Home / Patents / Initiatives / Hague Agreement Concerning the International Registration of Industrial Designs'. There are also links for 'Share' and 'Print'.

Helpful 16

Not Helpful 3

More Patents

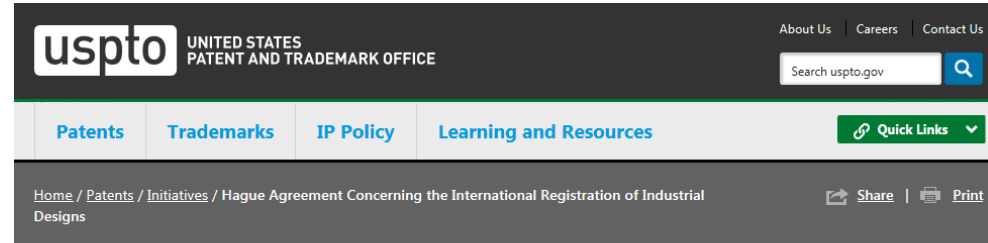
## Hague Agreement Concerning the International Registration of Industrial Designs

### Resources

- [EFS-Web Quick Start Guide for Filing International Design Applications Through the USPTO as an Office of Indirect Filing \(May 2015\)](#)
- [Hague Agreement Public Forum \(April 29, 2015\) \(videos/slides\)](#)
- [Changes To Implement the Hague Agreement Concerning International Registration of Industrial Designs; Final Rule \(April 2015\)](#)
- [Patent Law Treaties Implementation Act of 2012, Pub. L. 112-211 \(enacted on December 18, 2012\)](#)
- [Text of the 1999 Geneva Act, Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement, and Administrative Instructions](#)
- [The President's Letter of Transmittal \(November 13, 2006\)](#)
- [Report on the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, Senate Foreign Relations Committee \(November 27, 2007\)](#)
- [MPEP Chapter 2900 \(International Design Applications\)](#)

# The Hague Agreement

- USPTO Page
  - Forms
  - Fees
  - Resources
  - **FAQ**
  - Tips for Filing
  - Contacts



Helpful 16  
Not Helpful 3

## Hague Agreement Concerning the International Registration of Industrial Designs

### FILING AN INTERNATIONAL DESIGN APPLICATION

**Question HA1000:** Where can I file an international design application?

An international design application may be filed either directly with the International Bureau of the World Intellectual Property Organization (WIPO) or indirectly through the office of the applicant's Contracting Party. The USPTO serves as an office of indirect filing for applicants having a sufficient connection to the United States. See Question **HA1020** for further information regarding filing an international design application through the USPTO. Please note that **a foreign filing license may be required** to properly file an international design application **directly with the International Bureau**. See 35 U.S.C. 184. WIPO provides an electronic filing system for filing international design applications. Likewise, international design applications can be filed electronically through the USPTO via EFS-Web. International design applications can also be filed in paper with either WIPO or the USPTO, though additional WIPO publication fees may apply for paper submissions. See Question **HA4000** for further information concerning fees.



# The Hague Agreement

- USPTO Page

- Forms
- Fees
- Resources
- FAQ
- Tips for Filing
- Contacts



The screenshot shows the USPTO website header with the logo and navigation links. The main content area is titled "Tips for Filing New International Design Applications" and is categorized under "IN GENERAL".

### 1. Deciding where to file

U.S. applicants should consider whether to file the international design application through the USPTO or directly with the International Bureau (IB) based on their specific circumstances. Filing the application directly with the IB avoids having to pay a transmittal fee to the USPTO and enables the IB to perform a formalities review earlier, which may be important for applicants wanting immediate publication or a certified copy of the international design application quickly. In addition, for applications filed through the IB's electronic filing (E-filing) interface on or after March 30, 2016, applicants will have the ability to send corrections of irregularities or defects (including corrected reproductions and documents) electronically to the IB via the E-Filing Portfolio Manager. See [http://www.wipo.int/edocs/hagdocs/en/2016/hague\\_2016\\_5.pdf](http://www.wipo.int/edocs/hagdocs/en/2016/hague_2016_5.pdf). The IB's E-filing interface also provides for electronic entry of application data, thus eliminating the need for a separate DM/1 form, and the entered data is validated in real time to minimize errors in the application submission. Furthermore, filing through the USPTO is not possible if each applicant does not have at least one of a U.S. nationality, or a domicile, habitual residence, or real and effective industrial or commercial establishment in the United States.

It is important to note, however, that a **foreign filing license may be needed to file an international design application directly with the IB**. In addition, unlike filing an international design application through EFS-Web, reproductions in PDF format are not accepted by the IB's E-filing system.

### 2. Ensure that applications filed through the USPTO meet the conditions for transmittal to the International Bureau (IB)

Even if the application contains, upon filing with the USPTO, all elements required under the Hague Agreement for a filing date, entitlement to the USPTO receipt date as the filing date is contingent upon the IB receiving the application from the USPTO within six months of the USPTO receipt date. See Hague Agreement Rule 13. The USPTO will not transmit the application to the IB if the transmittal fee has not been paid or the DM/1 application form fails to indicate, for **each** applicant, at least one of a U.S. nationality, or a domicile, habitual residence, or real and effective industrial or commercial establishment in the United States. (Box 2 of the DM/1 form). In addition, for **each** applicant, the United States must be indicated as the "applicant's contracting party" (Box 3 of the DM/1 form).

Additional page content visible on the right side of the screenshot includes a search bar, "Quick Links", "Share | Print", and a partial article titled "ing the of Industrial".

# The Hague Agreement

- **USPTO Page**

- Forms
- Fees
- Resources
- FAQ
- Tips for Filing
- **Contacts**

The screenshot shows the top of the USPTO website. It includes the USPTO logo, the text 'UNITED STATES PATENT AND TRADEMARK OFFICE', a search bar with the text 'Search uspto.gov', and a navigation menu with links for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. There is also a 'Quick Links' dropdown menu. Below the navigation menu, there is a breadcrumb trail: 'Home / Patents / Initiatives / Hague Agreement Concerning the International Registration of Industrial Designs'. To the right of the breadcrumb trail are links for 'Share' and 'Print'.

Helpful 16

## Hague Agreement Concerning the International Registration of Industrial Designs

### Contact us

**Boris Milef**  
Sr. Legal Examiner  
International Patent Legal Administration  
571-272-3288

**David Gerk**  
Patent Attorney  
Office of Policy and International Affairs  
571-272-9300

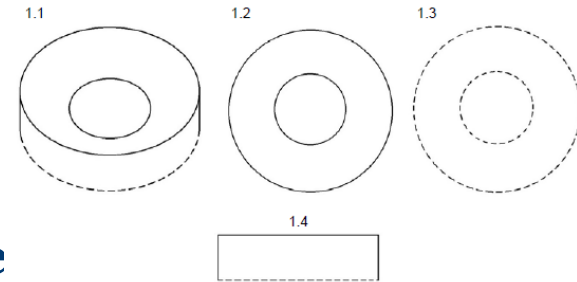
# Considerations for Applicants

- Reproductions
- Description
- Creator
- Single Design
- Priority Claims
- Duty of Disclosure
- 1<sup>st</sup> Communication from USPTO



# Considerations: Reproductions

- Fully disclose the claimed design
  - Full disclosure for each separate design
  - No fixed requirement for # of views
  - Orthogonal & perspective combos useful
  - Avoid ambiguity in reproductions
    - Consistent views
    - Clearly represent claimed subject matter
      - not left to conjecture
      - (e.g., convex vs concave)



# Considerations: Description

- **Figure Descriptions are helpful:**
  - **DM1 Form Box 9 & 10**

**10** DESCRIPTION OF THE REPRODUCTIONS (LEGENDS)<sup>6</sup>  
Associate the number in the margin of your reproduction with the corresponding code (eg. 1.1, 1.2, etc.):  
1 Perspective; 2 Front; 3 Back; 4 Top; 5 Bottom; 6 Left; 7 Right;  
9 Unfolded; 10 Exploded; 11 Cross-sectional; 12 Enlarged; 00 Other (limited to 40 characters)

No.	Code	Legend (max 40 characters, where code 00 has been indicated)	No.	Code	Legend (max 40 characters, where code 00 has been indicated)	No.	Code	Legend (max 40 characters, where code 00 has been indicated)

<sup>6</sup> Recommend

**DESCRIPTION**

FIG. 1 is a perspective view of a portion of a shoe upper showing our new design;  
FIG. 2 is a side elevational view of one side of the portion of a shoe upper shown in FIG. 1;  
FIG. 3 is a front elevational view of the portion of a shoe upper shown in FIG. 1;  
FIG. 4 is a rear elevational view of the portion of a shoe upper shown in FIG. 1; and,  
FIG. 5 is a top plan view of the portion of a shoe upper shown in FIG. 1.

The broken line showing of the remainder of the shoe is for illustration purposes only and forms no part of the claimed design.



# Considerations: **Creator**

- **Creator is a person(s).**
- **Creator is the designer(s) (inventor(s)).**



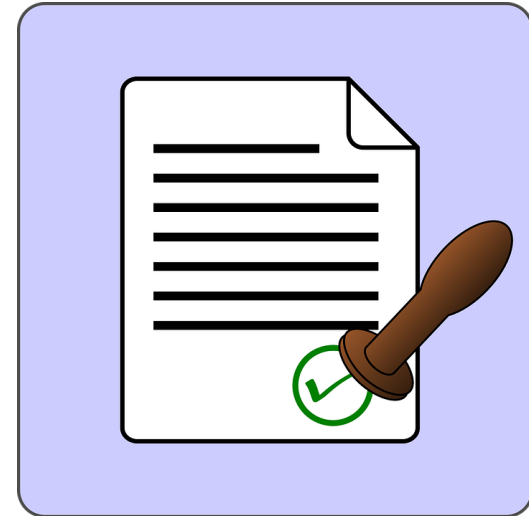
# Considerations: **Single Design**

- Only can claim single design in design patent.
- Refusal
  - if more than one patentably distinct designs in international registration.
- Non-patentably distinct designs
  - can be kept together as “embodiments” of the one design



# Considerations: **Priority**

- **Copy of Certified Priority Document**
  - Must be filed with USPTO to perfect priority claim.
- **When?**
  - Before payment of second part designation fee (issue fee).
- **Who?**
  - Pro se creator (inventor) or representative registered to practice before USPTO.





# Considerations: **Duty of Disclosure**

- **Creators, applicants, representatives, etc., have an affirmative duty to provide certain information to USPTO.**
- **“Material to Patentability”**
  - **37 CFR 1.56**
- **Information Disclosure Statement (IDS)**



# Considerations: **1<sup>st</sup> Communication**

- USPTO Filing Receipt:
  - Frequently first communication from the USPTO.
  - Indication that USPTO has received the international registration pursuant to its designation and role as a CP.
  - Provides info regarding U.S. identification of international registration.
  - Typically, no response needed.



# Seminar on the Hague System for the International Registration of Industrial Designs

## USPTO FEEDBACK

**David R. Gerk**

Attorney-Advisor

Office of Policy and International Affairs (OPIA)

[david.gerk@uspto.gov](mailto:david.gerk@uspto.gov)

571-272-9300

**June 23, 2016**

UNITED STATES  
PATENT AND TRADEMARK OFFICE



