

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# USPTO & The Hague System Two Years And Counting...

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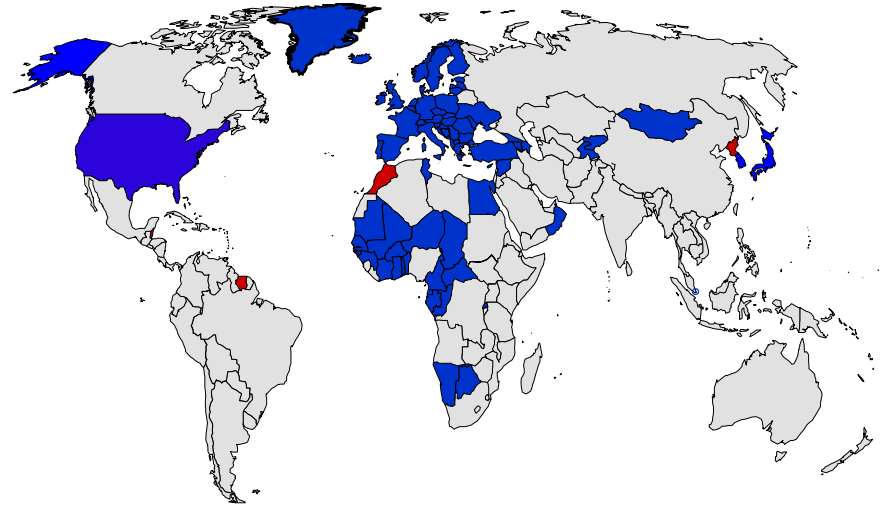
March 30, 2017

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



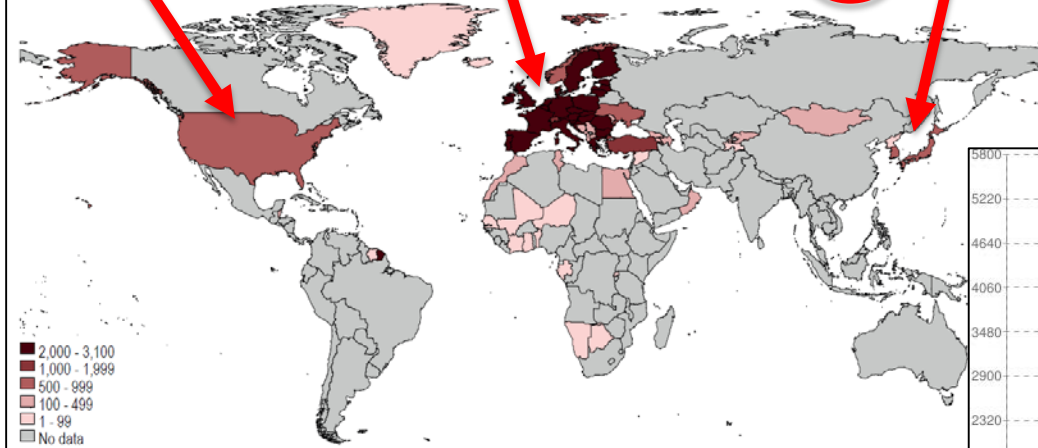
# The Hague Agreement

## • Filing Statistics...

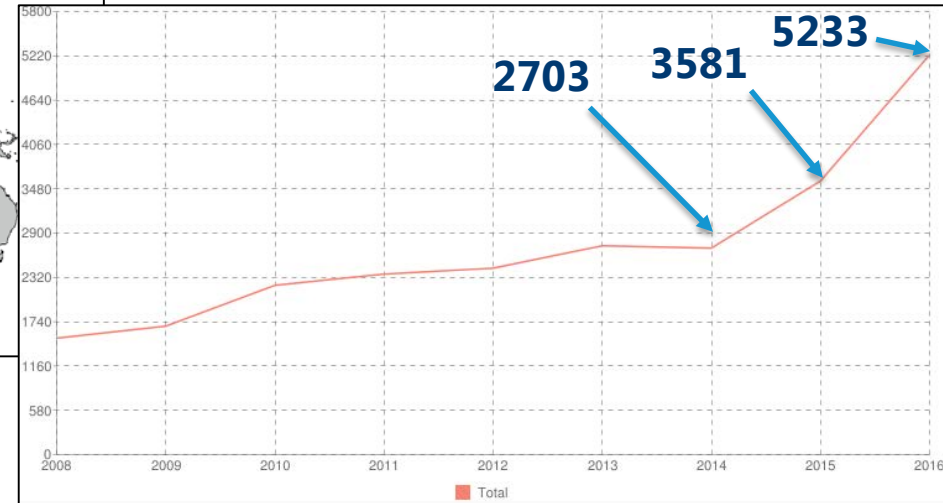
Int'l Design Apps:  
**2008-2016**

- *increase in Hague applications:*
  - **+ 40.6%** **2014-2015**
  - **+ 46.1%** **2015-2016**

Figure A.3.2 Hague international applications by designated Hague members 2015



Source: WIPO Statistics Database, May 2016.



# 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>

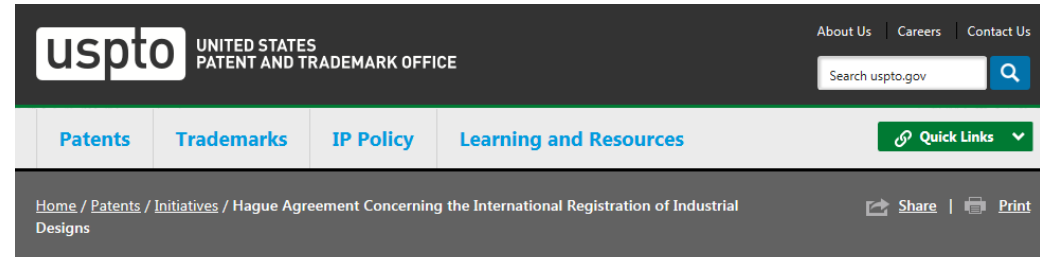
- *WIPO Hague System Page*

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

# The Hague Agreement

- **USPTO Page**

- IDA 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](#)

# The Hague Agreement



- **USPTO Page**

- Forms

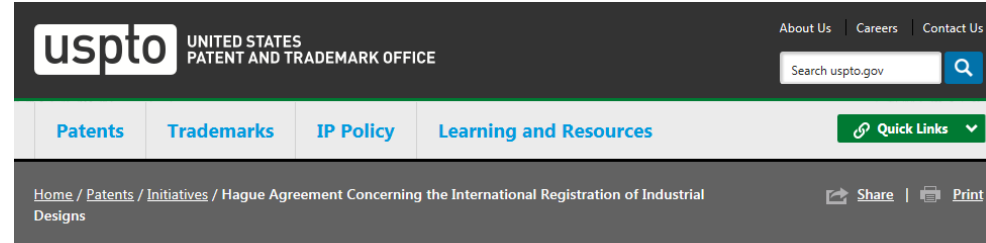
- Fees

- **Resources**

- FAQ

- Tips for Filing

- Contacts



Helpful 16

Not Helpful 3

More Patents

## Hague Agreement Concerning the International Registration of Industrial Designs

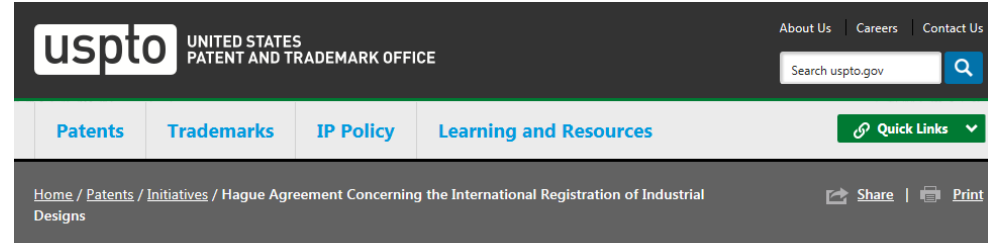
### Resources

- EFS-Web Quick Start Guide for Filing International Design Applications Through the USPTO as an Off 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**

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- 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).

# The Hague Agreement

- **USPTO Page**

- Forms
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- 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 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 'Share' and 'Print' icons.

Helpful 16

## Hague Agreement Concerning the International Registration of Industrial Designs

### Contact us

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

# **Design Patentability Requirements in the United States**

# Patentability Requirements

- Patentable designs (§171)
- Novelty (§102)
- Non-Obviousness (§103)
- Written Desc., Enablement, Best Mode (§112(a))
- Distinctly Claim Subject Matter (§112 (b))

Requirements for Patentability

# ***U.S. Design Patents***

The Statute:

35 U.S.C. 171 Patents for designs.

Whoever invents any **new**, **original**, and **ornamental** design for an **article of manufacture** may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U.S.C. § 171

New  
Original  
Ornamental  
Article  
Non Obvious  
Enabled  
Described  
Definite

# ***U.S. Design Patents***

New  
Original  
Ornamental  
Article  
Non Obvious  
Enabled  
Described  
Definite

## Designs must be:

- new,
- original,
- ornamental, and
- for an article of manufacture

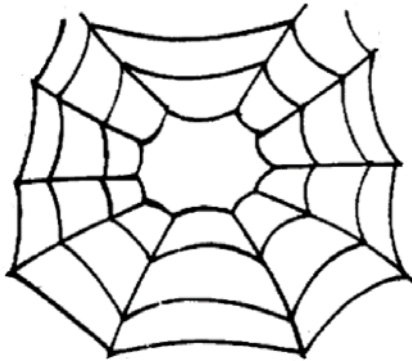
35 U.S.C. § 171

Requirements for Patentability  
**U.S. Design Patents**

The design "for an article"

- New
- Original
- Ornamental
- Article
- Non Obvious
- Enabled
- Described
- Definite

Disembodied  
Design



Not Acceptable

35 U.S.C. § 171

Embodied Design

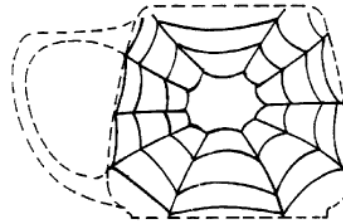


FIG. 1

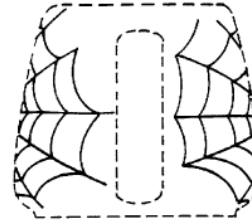


FIG. 2

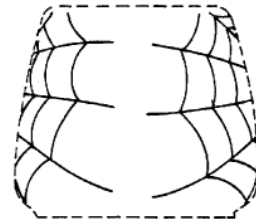


FIG. 3

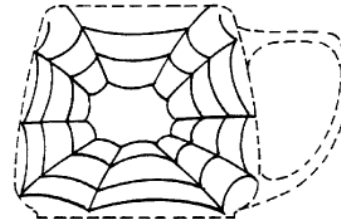
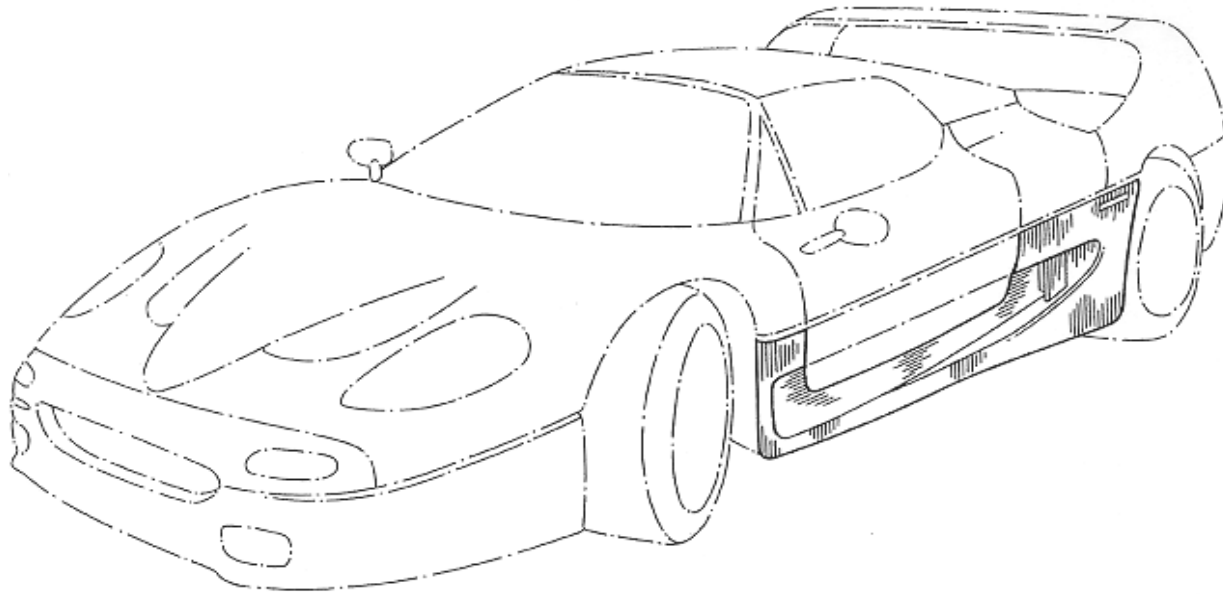


FIG. 4

## Requirements for Patentability

### *U.S. Design Patents*

**A Design May be Directed to  
Less than an Entire Article**



New  
Original  
Ornamental  
**Article**  
Non Obvious  
Enabled  
Described  
Definite



# Patentability Requirements

- ✓ Patentable designs (§171)
- Novelty (§102)
- Non-Obviousness (§103)
- Written Desc., Enablement, Best Mode (§112(a))
- Distinctly Claim Subject Matter (§112 (b))

Requirements for Patentability  
**U.S. Design Patents**

**Anticipation**

**Not New:**

New

Original

Ornamental

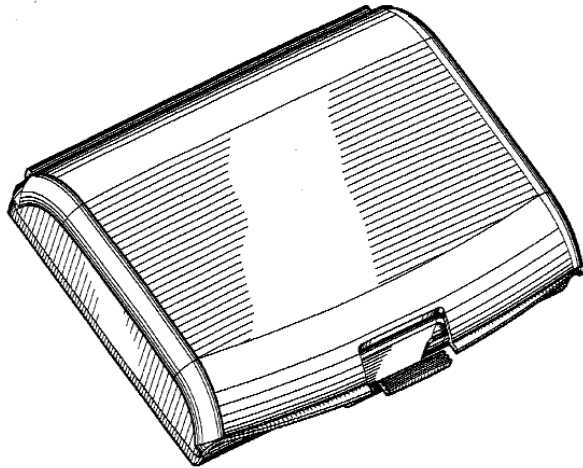
Article

Non Obvious

Enabled

Described

Definite

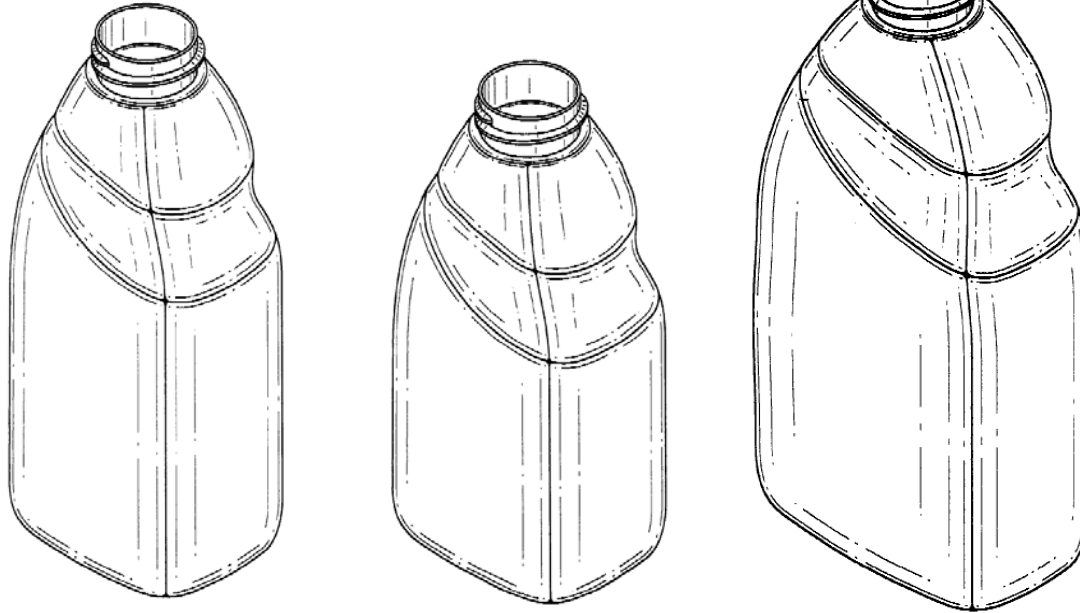


35 U.S.C. § 102

Requirements for Patentability  
***U.S. Design Patents***

**Obvious:**

- New
- Original
- Ornamental
- Article
- Non Obvious
- Enabled
- Described
- Definite



35 U.S.C. § 103

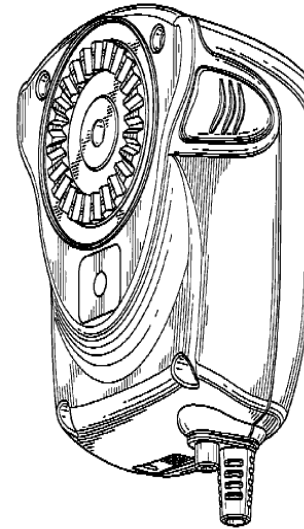
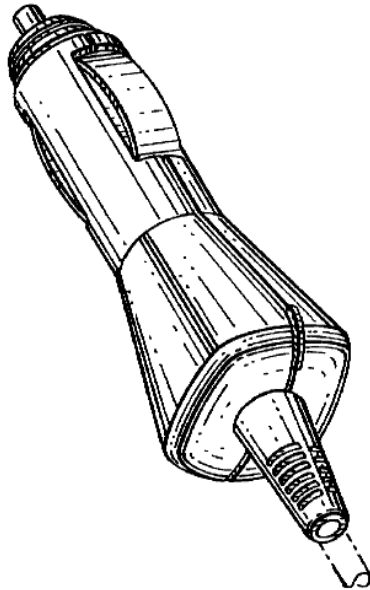
Requirements for Patentability  
***U.S. Design Patents***

**Obvious:**

New  
Original  
Ornamental  
Article  
**Non Obvious**  
Enabled  
Described  
Definite

Prior Art References

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35 U.S.C. § 103



# Patentability Requirements

- ✓ Patentable designs (§171)
- ✓ Novelty (§102)
- ✓ Non-Obviousness (§103)
- Written Desc., Enablement, Best Mode (§112(a))
- Distinctly Claim Subject Matter (§112 (b))

Requirements for Patentability  
***U.S. Design Patents***

New  
Original  
Ornamental  
Article  
Non Obvious  
Enabled  
Described  
Definite

Designs must be:

- Enabled,
- Definite and
- Described

35 U.S.C. § 112

## Requirements for Patentability

# ***U.S. Design Patents***

The Statute:

35 U.S.C. 112(a) Specification.

The specification shall contain a **written description** of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to **enable** any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same,  
... .

35 U.S.C. § 112(a)

New  
Original  
Ornamental  
Article  
Non Obvious  
**Enabled**  
Described  
Definite

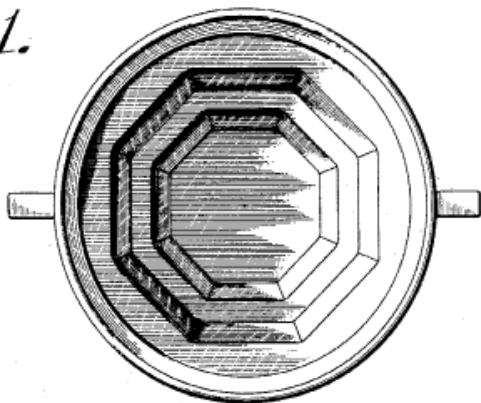


Requirements for Patentability  
**U.S. Design Patents**

**Enablement**  
**Not enabled:**

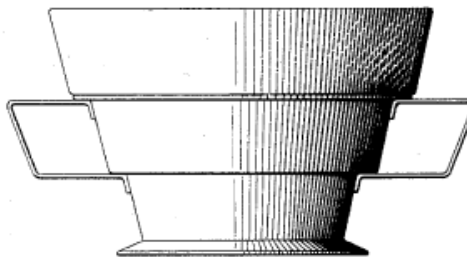
New  
Original  
Ornamental  
Article  
Non Obvious  
**Enabled**  
Described  
Definite

*Fig. 1.*



Top plan view

*Fig. 2.*



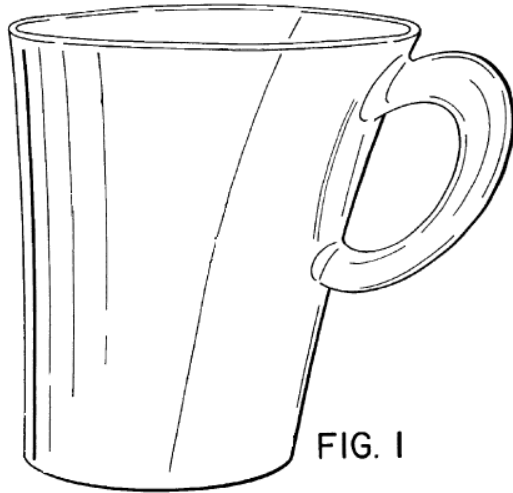
Front elevation view



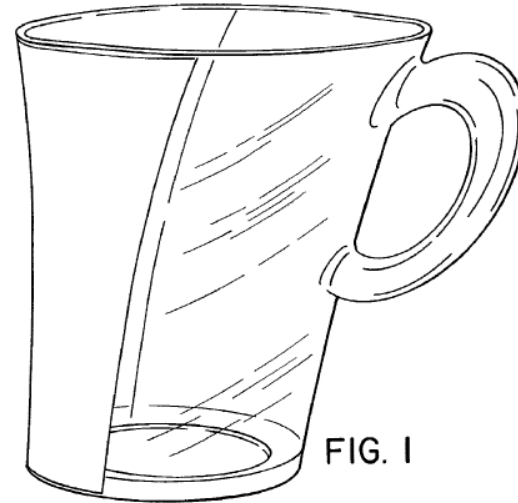
Requirements for Patentability  
**U.S. Design Patents**

**Described**

**Has not met the description requirement:**



**Originally Filed**



**Amendment  
(now claimed)**

- New
- Original
- Ornamental
- Article
- Non Obvious
- Enabled
- Described**
- Definite

# Patentability Requirements

- ✓ Patentable designs (§171)
- ✓ Novelty (§102)
- ✓ Non-Obviousness (§103)
- ✓ Written Desc., Enablement, Best Mode (§112(a))
- Distinctly Claim Subject Matter (§112 (b))

## Requirements for Patentability

# ***U.S. Design Patents***

The Statute:

35 U.S.C. 112(b) Specification.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

New  
Original  
Ornamental  
Article  
Non Obvious  
Enabled  
Described  
Definite

Requirements for Patentability

# ***U.S. Design Patents***

## **Definite**

Design patents have **only one claim** and the form is dictated by regulation:

I Claim:

“The ornamental design for a  
(insert title of article)  
as shown and described.”

37 CFR § 1.153

New  
Original  
Ornamental  
Article  
Non Obvious  
Enabled  
Described  
**Definite**

Requirements for Patentability  
***U.S. Design Patents***

**Definite**

New  
Original  
Ornamental  
Article  
Non Obvious  
Enabled  
Described  
Definite

I Claim:

“The ornamental design for  
**(insert title of article)**  
as shown and described.”

**Drawings**



**Specification**

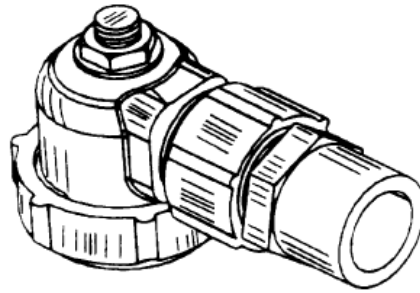


Requirements for Patentability  
**U.S. Design Patents**

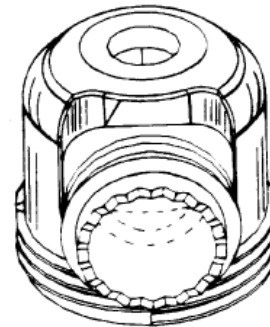
**Definite**  
**Not Definite:**

New  
Original  
Ornamental  
Article  
Non Obvious  
Enabled  
Described  
**Definite**

Condensate flow shut-off switch



**FIG. 1**



**FIG. 2**



**FIG. 3**

# **Hague Registry: Illustrative Examples**

# Illustrative Examples



1.3



1.2



DM/095232  
"Toilet"



# Illustrative Examples

1



2



3



4



DM/095217  
"Beds"

# Illustrative Examples

1



2



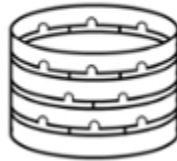
3



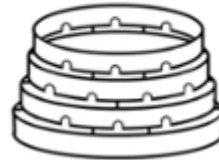
4



5



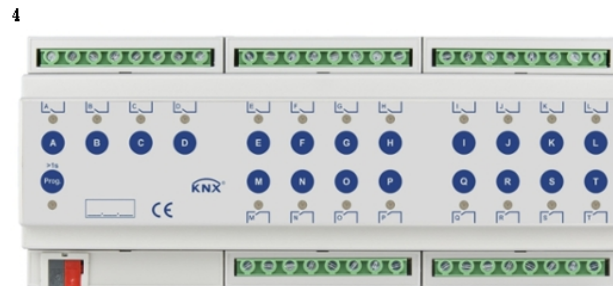
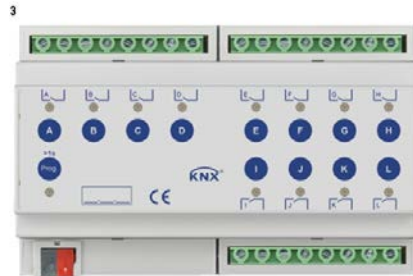
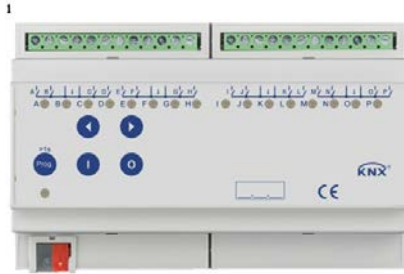
6



DM/095162  
"Composting  
bins"

# Illustrative Examples

DM/095230  
“Equipment  
for control of  
electric  
power”



# Illustrative Examples



DM/095229  
“Boxes  
[packaging]”

# Illustrative Examples

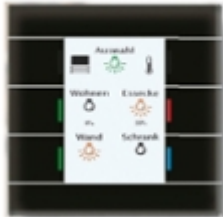
1



3



2



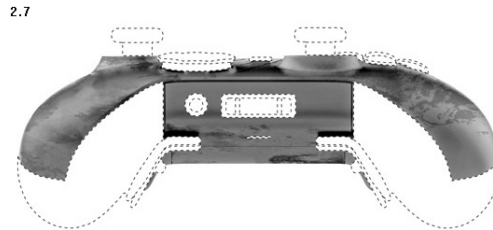
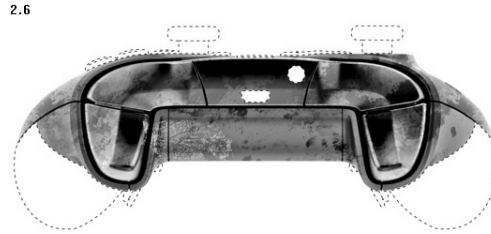
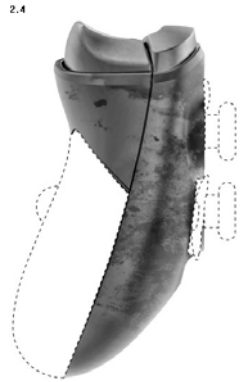
4



DM/095233

"1-4. Switches  
[electricity]"

# Illustrative Examples



DM/094640  
"Wireless  
controls for  
electronic  
devices"

