

## The Hague System: Going Global

Designating the European Union, Japan, the Republic of Korea, the Russian Federation and the United States of America

- Tips to Maximize your Chances to be Granted Protection

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The Hague Registry

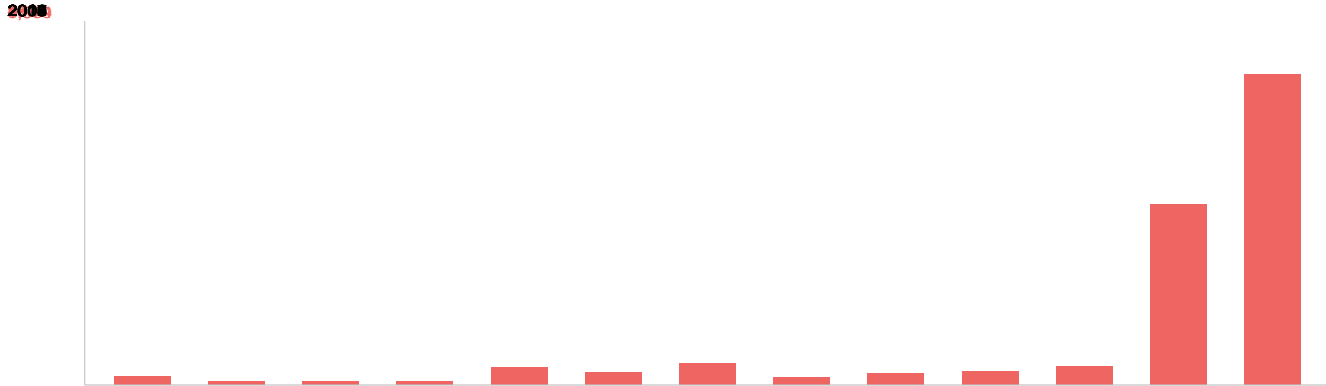
Geneva  
July 19, 2018

# Designating Japan, the Republic of Korea, the Russian Federation and the United States of America

- «Examining jurisdictions» under the Hague System:
  - Some declarations may only be made by a CP with an Examining Office (Art.1(xvii) of the 1999 Act);
  - Specific elements required by USPTO, JPO, KIPO and ROSPATENT

# Refusals issued by Examining Offices

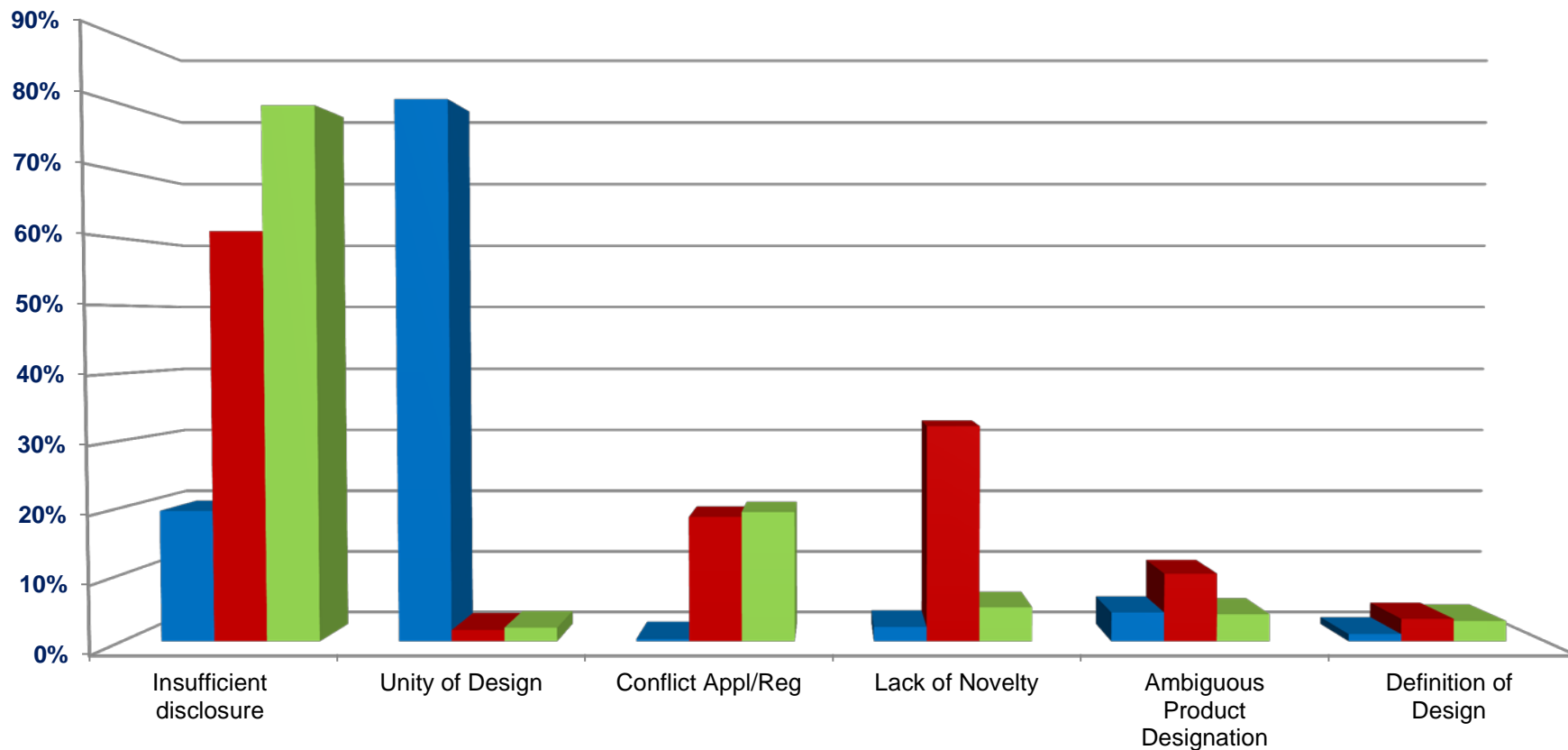
■ In 2017, the number of refusals received is 3,389.



Note: Counts are based on refusal notifications recorded by the IB

# USPTO, JPO & KIPO - Refusal Grounds

As included in all refusals recorded against UK-origin designs, up to June 10, 2018



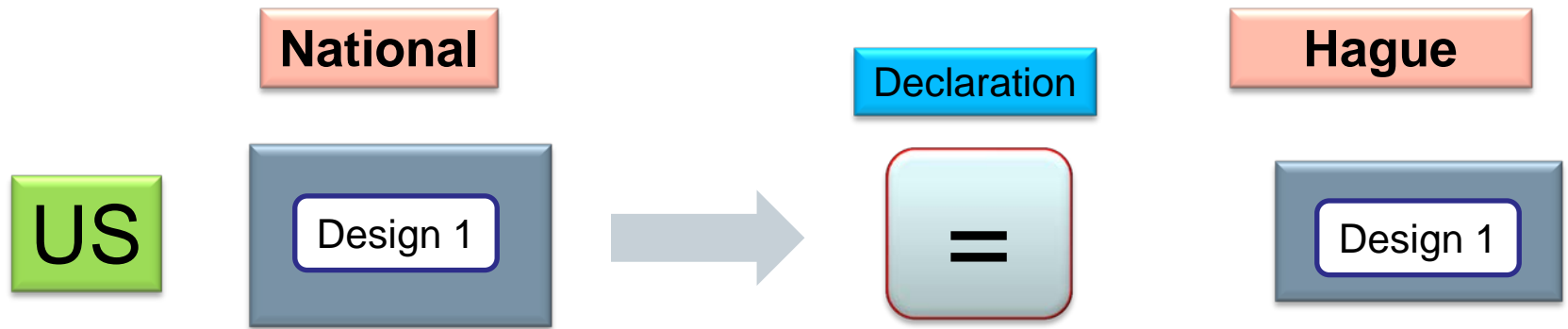
	Insufficient disclosure	Unity of Design	Conflict Appl/Reg	Lack of Novelty	Ambiguous Product Designation	Definition of Design
■ USPTO	19.56%	80.43%	0.36%	2.17%	4.34%	1.08%
■ JPO	61.01%	1.69%	18.64%	32.20%	10.16%	3.38%
■ KIPO	79.53%	2.04%	19.38%	5.10%	4.08%	3.06%

Source: Internal WIPO statistics



# Unity of Design

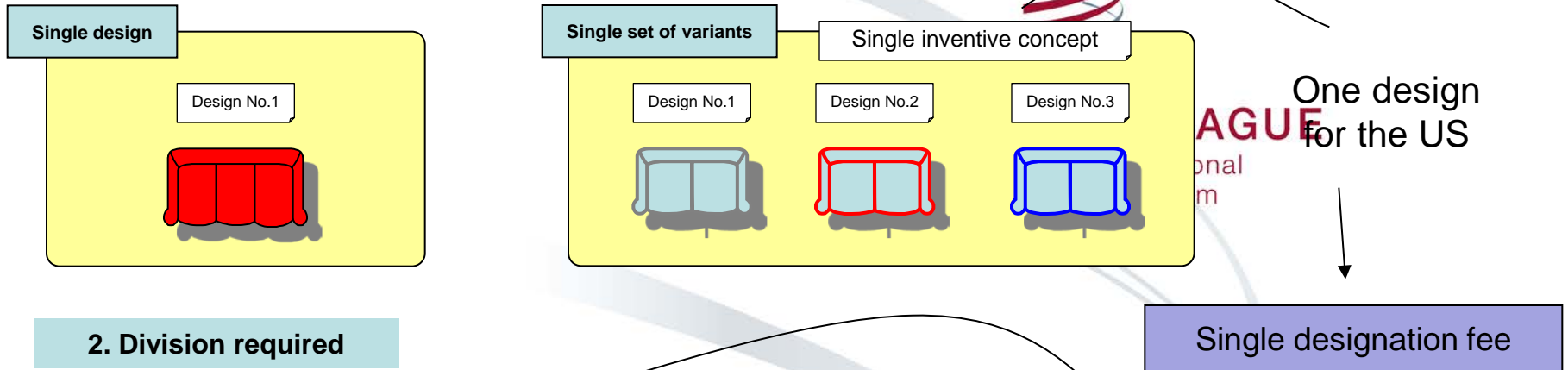
# USA: A single design system



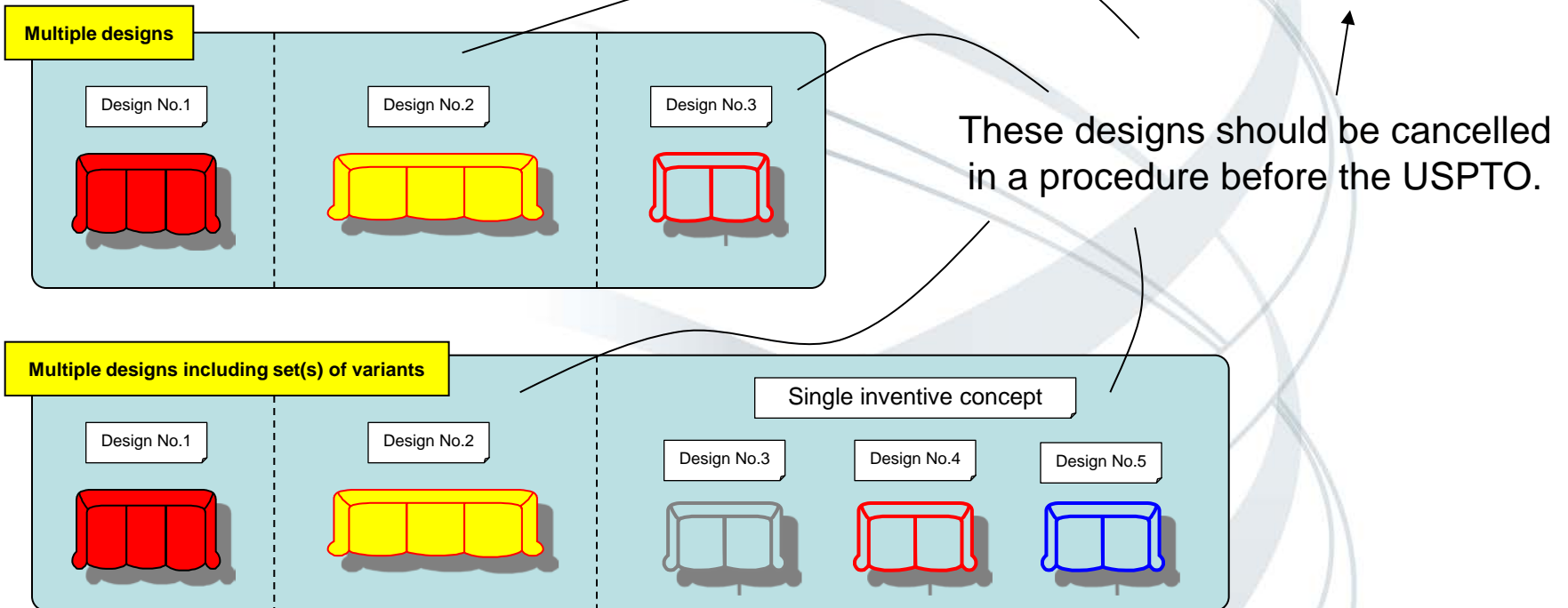
- ❑ **Declaration under Article 13(1): Only one independent and distinct design may be accepted.**
  - no examination by IB
  - possibility of refusal by USPTO based on this condition
  - any patentably distinct design should be eliminated.
- ❑ **Claim: A single claim**
- ❑ **Fee (Individual designation fee):**
  - A single fee, although different amounts apply according to the economic status of the applicant

# Multiple designs and designation of US in an international registration

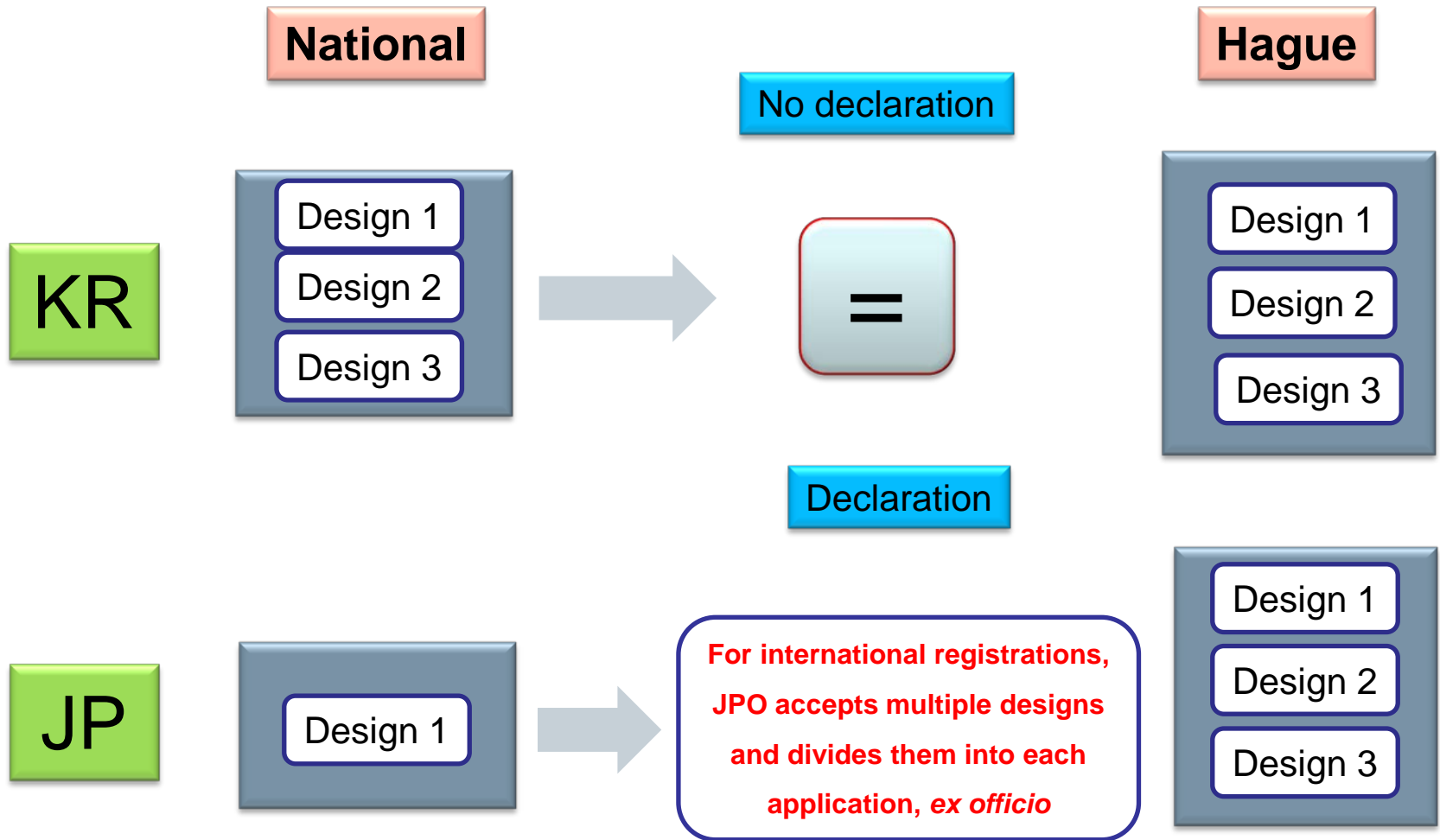
## 1. No division required



## 2. Division required

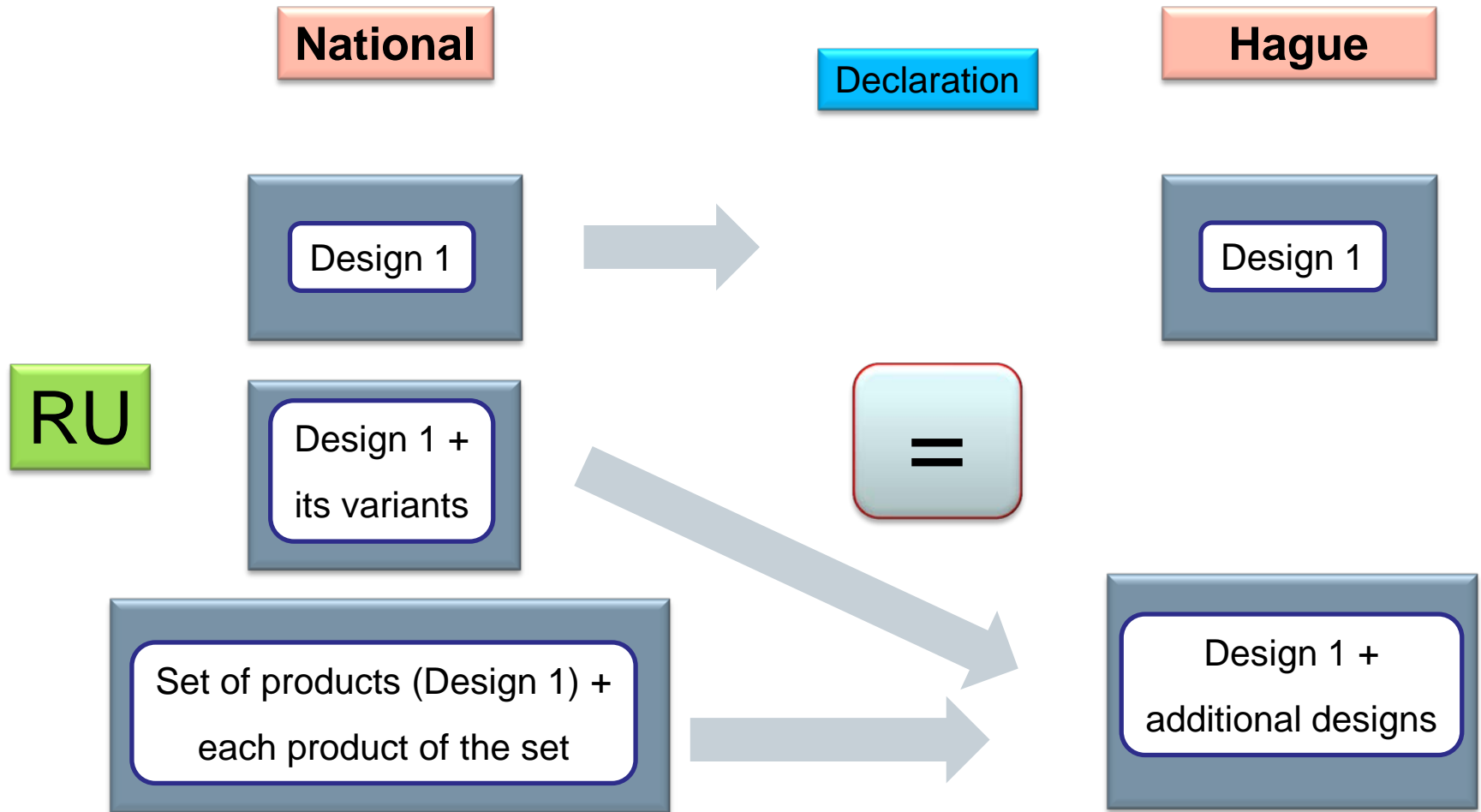


# Declaration under Article 13(1): KR and JP





# Declaration under Article 13(1): RU



The variants of the design claimed shall visually differ from it and from each other by minor distinctions and/or by combination of colors.

# RU: Unity of design requirement

№ 1

Independent and  
distinct design



№ 2

Set of designs,  
each product of the set  
may be included into the same IR



№ 3

Independent and distinct design  
and its variants



# USA: additional requirements

## Mandatory and attached to IA

- **A claim** must be provided in a specific wording, that is:

*The ornamental design for «product indication» as shown and described.*

- **Oath/Declaration of Inventorship** («Substitute Statement» may be used where it is not possible to obtain the signature of the inventor)

*Required from each of the creators*

- **Annex IV: Reduction of United States individual designation fee**

*along with the claim of micro entity status in item 18 of DM/1*

## Optional

- **Information on eligibility for protection**

*May be submitted to IB (at the time of application only, by a hard copy (with Annex III) or PDF (E-Filing)),*

*or*

*be submitted to USPTO (later)*



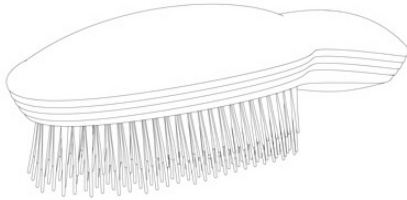
# Insufficient disclosure

# What causes the disclosure of the design to be insufficient or unclear?

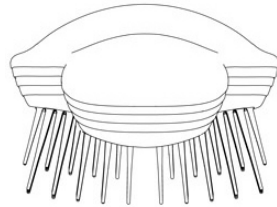
- Lack of /or inadequate surface shading
- Lack of a description to clarify the scope of protection
- Insufficient number of views
- Lack of consistency among the views
  - *Don't mix drawings and photograph of the design!*

# Provide Enough Views

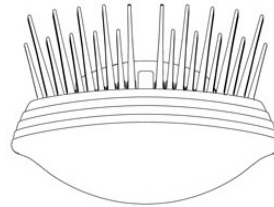
1.1



1.2



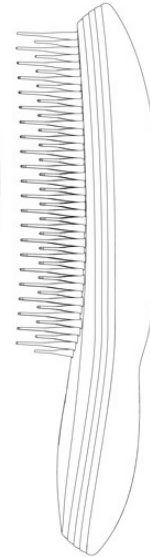
1.3



1.4



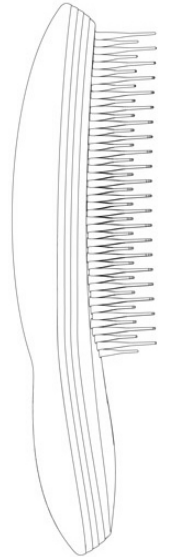
1.5



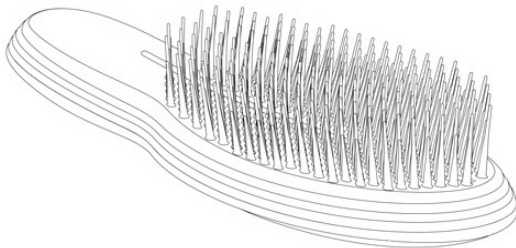
1.6



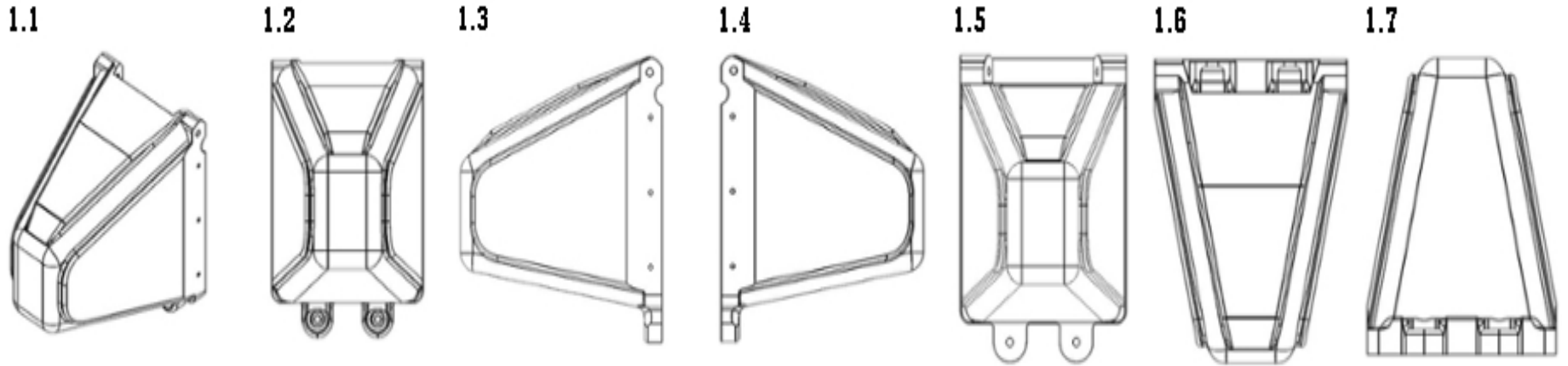
1.7



1.8



# It's Always safer with a Legend



1.1) Perspective; 1.2) Front; 1.3) Left; 1.4) Right; 1.5) Back; 1.6) Top; 1.7) Bottom

[DM/092 108](#) for a “Security bulwark”

# Legends

Always remember to provide a legend (using the legend features of E-filing) when designating any of four Examining offices

**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)

If the space provided is not sufficient, check this box and use a continuation sheet.

<sup>6</sup> Recommended for a designation of Japan and the United States of America.

- ✓ Legends may NOT be shown in a reproduction;
- ✓ Legends may be provided in association with the numbering of reproduction in a specific item



# Use the «description» to justify absent views

- DM/088980: “front view is omitted because it is identical with the back view; right side view is omitted because it is identical with the left side view”

1.1



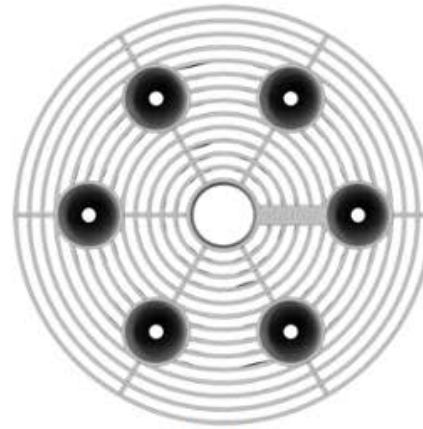
1.1) Perspective

1.2



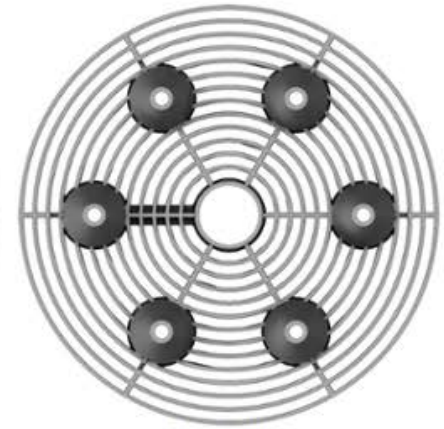
1.2) Perspective

1.3



1.3) Top

1.4



1.4) Bottom

1.5



1.5) Left

1.6



1.6) Back

# Use the «description» to justify absent views

9

## DESCRIPTION<sup>5, 6, 7</sup>

Only the characteristic features of the industrial design(s) that appear in (a) reproduction(s) should be described. In addition, matter which is shown in a reproduction but for which protection is not sought may be indicated in the description (and/or by means of dotted or broken lines or coloring in the reproduction). The description can further disclose the operation or possible use of the industrial design as long as it is not technical. Furthermore, the omission of a specific view may be indicated. If the description exceeds 100 words, an additional fee of 2 Swiss francs per word exceeding 100, shall be payable.

.....

.....

.....

.....

.....

If the space provided is not sufficient, check this box and use a continuation sheet.

<sup>5</sup> If the **Syrian Arab Republic** is designated, a brief description of the reproduction or of the characteristic features of the industrial design is required.

<sup>6</sup> If **Romania** is designated, a brief description of the characteristic features of the design is required.

<sup>7</sup> If the **Russian Federation** is designated, ROSPATENT recommends that a brief description of the characteristic features of the industrial design be provided.

- ✓ Item 9 of DM/1 form or
- ✓ Dedicated tab in e-filing



**Lack of novelty**

# Surprise: it's almost never prior art

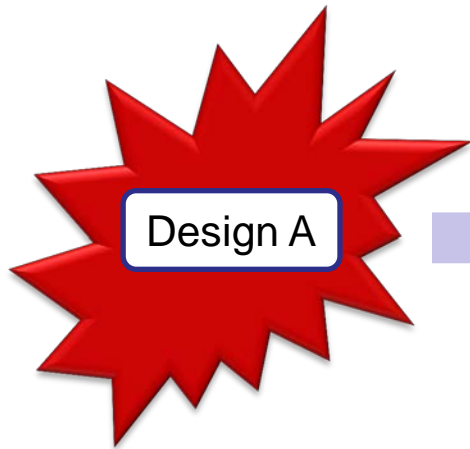
- What destroys your novelty in KR and JP is almost always your own design...
  - when designs are similar they destroy each other's novelty
- That's easy to avoid!
  - Identify one as the «principal design»
  - Identify the others as «related designs»

# Prior Divulgation

- KR: Attach documentation in support of a declaration concerning exception to lack of novelty under dedicated E-filing tab;
- JP: File original documentation in support of a declaration concerning exception to lack of novelty directly with JPO
- With respect to the designation of Japan, the Japan Patent Office (JPO) requires that the supporting documentation be submitted to it directly within 30 days from the date of publication of the international registration in the *International Designs Bulletin*.

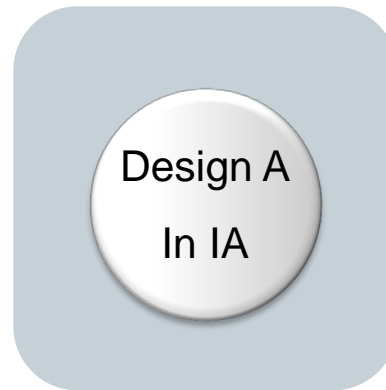
# Exception to lack of novelty: KR, JP

## Disclosure of Design A



In an exhibition, published materials such as a magazine, catalog, or through the internet media, etc.

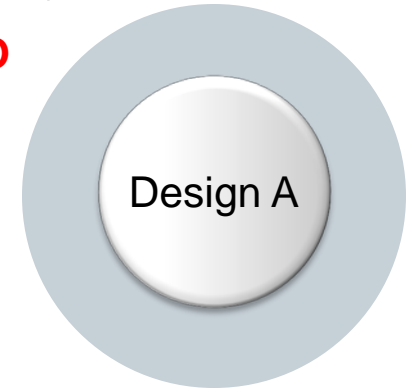
## Filing of an IA



- Filing within 12 months from the date of disclosure
- With declaration concerning exception to lack of novelty

## Examination by

JPO/KIPO



Disclosure of Design A does not become a reason for lack of novelty

# Exception to lack of novelty: KR, JP

## Declaration in the application form

**15** EXCEPTION TO LACK OF NOVELTY (optional element applicable to the designation of **Japan** and/or **Republic of Korea** only)  
For more guidance, refer to the Guide to the International Registration of Industrial Designs, International Application – Item 15, at [www.wipo.int/hague/en/guide/ia.html#r15](http://www.wipo.int/hague/en/guide/ia.html#r15).

Contracting Party concerned:  Japan and/or  Republic of Korea

The applicant claims to benefit from exceptional treatment provided for in the design law of the Contracting Party(ies) concerned, for disclosure of all the industrial designs, or the industrial designs indicated below, included in the present application.

.....

.....

Supporting documentation may be submitted using Annex II (only for the designation of the **Republic of Korea**).  
Annex II provided

# Exception to lack of novelty: KR

## ANNEX II:

### SUPPORTING DOCUMENT(S) CONCERNING A DECLARATION TO THE EXCEPTION TO LACK OF NOVELTY

under Section 408(c)(ii) of the Administrative Instructions

#### **IMPORTANT**

1. This cover sheet is to submit documentation in support of a declaration concerning exception to lack of novelty to the Korean Intellectual Property Office (KIPO) (refer to DM/1, item 15)
2. Please note that a declaration concerning exception to lack of novelty might affect the applicant's rights in other jurisdictions. It is the responsibility of the applicant to ensure that his rights are preserved.
3. This Annex must be submitted with the DM/1 form at the time of filing. It cannot be submitted alone.
4. Please number your pages.

#### For use by the applicant

This Annex concerns the international application referenced by the applicant as below:

Reference: .....

#### For use by the International Bureau

Document type: DDD

**II**

SUPPORTING DOCUMENT(S) CONCERNING A DECLARATION TO THE EXCEPTION TO LACK OF NOVELTY

Contracting Party concerned	Design(s) number(s) (leave empty if the documents concern all designs)	Number of pages (including this cover page)
KR		





## Definition of the product

# JP and KR: Definition of the product

**8**

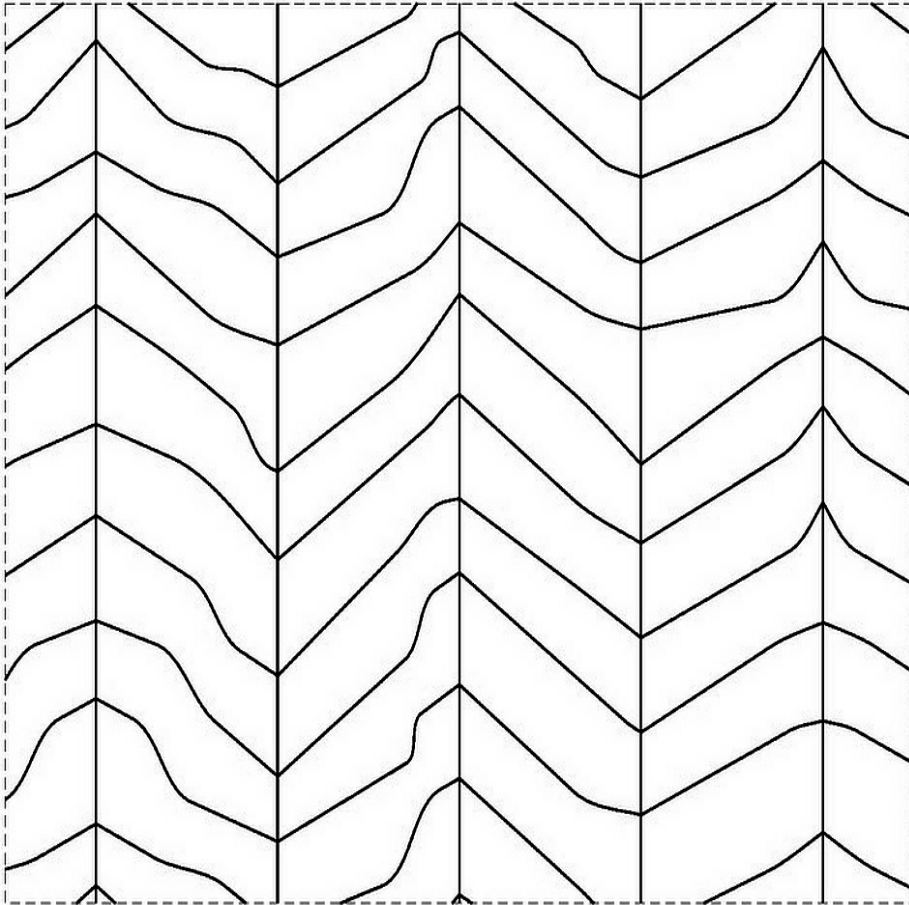
PRODUCTS WHICH CONSTITUTE THE INDUSTRIAL DESIGN OR IN RELATION TO WHICH IT IS TO BE USED  
(mandatory)  
(see note 1 on cover page)

Class to which the industrial design(s) belong(s) (optional): .....

No. of the design (in numerical order)	Total number of reproductions	Product(s)	Subclass (optional)

If the space provided is not sufficient, check this box and use a continuation sheet.

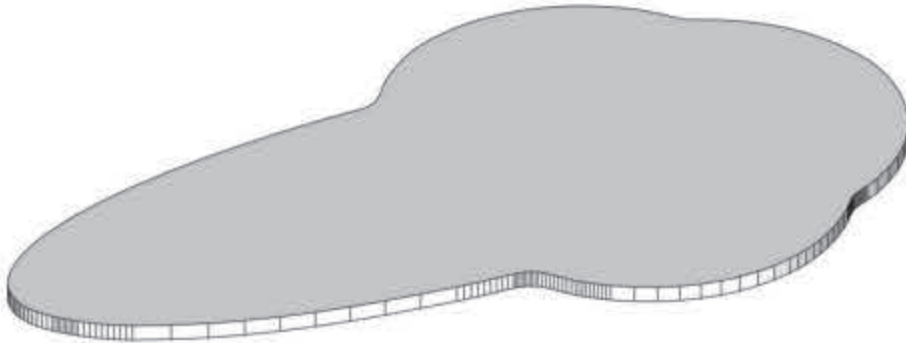
# JP: Definition of the product



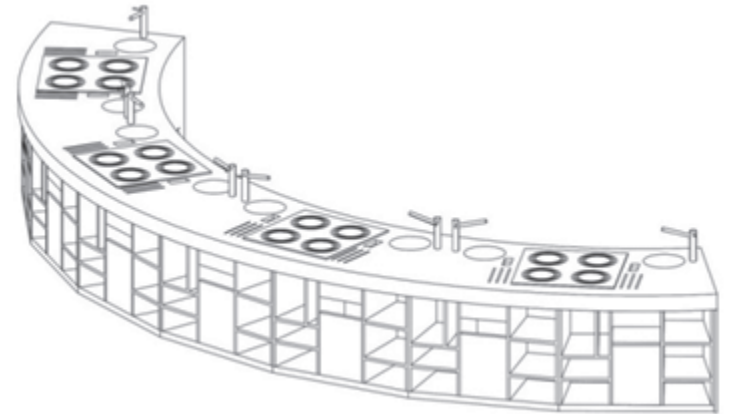
JPO issued a notification on the grounds of the omitted views and broken lines.

DM/087054 "Parquet"

# JP and KR: Definition of the product



DM/089390 “Collagen membrane”



DM/087657 Design Number:  
2 “Get-ups (kitchen arrangement)”

# Bear in Mind : Japan and Republic of Korea

- Be Specific in the product indication
- Do not file for logos under class 32

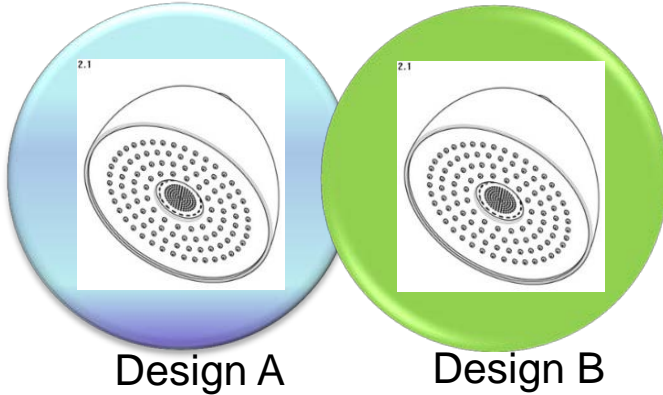


## **Conflict application/registration**

# Multiple Embodiments? Related designs? Then, identify your 'principal' design

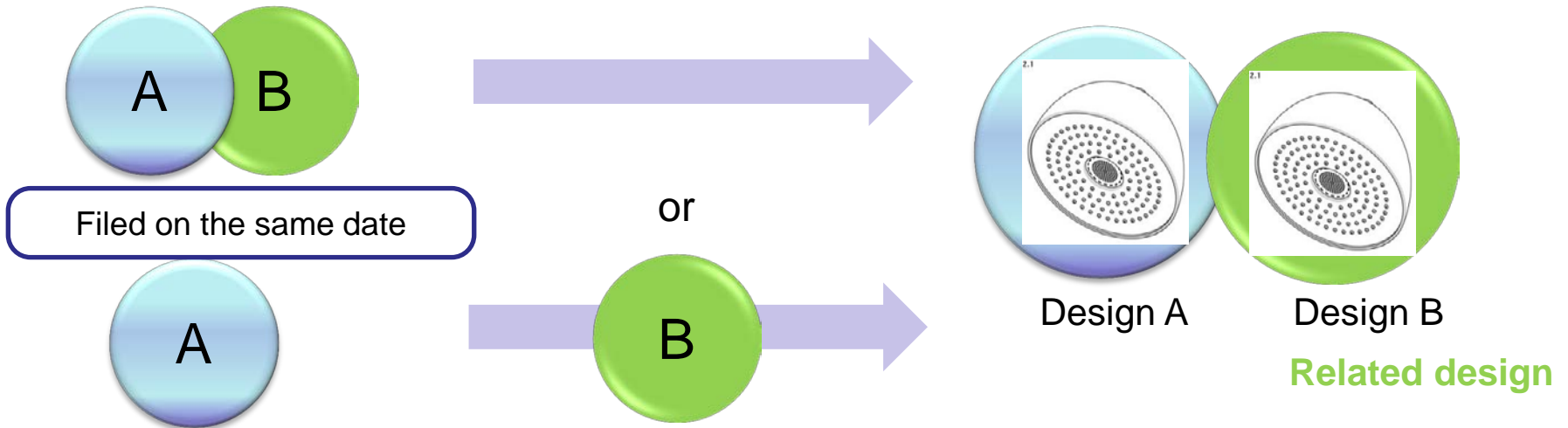
- Under the related design systems of Japan and the Republic of Korea, a design may be registered as a design related to another design to which it is similar and identified as a principal design, under the condition that both designs belong to the same applicant/holder.
- Failure to do so may lead to a refusal by the Office concerned on the ground of conflict with a prior similar design.

# What is related design?



- Similar
- Filed by the same applicant
- Filed in appropriate duration

**Principal design**



KR: filed within 1 year from the filing date of Design A

JP: after the filing date and before the date of publication for design registration of Design A in JP



# What is related design?

## ■ Indication of the principle design in the application form

16

RELATION WITH A PRINCIPAL DESIGN (optional element applicable to the designation of **Japan** and/or **Republic of Korea** only)

Under the national laws of Japan and the Republic of Korea one/some design(s) may be requested to be registered as (a) related design(s) in relation with the principal design (for more guidance, refer to the Guide to the International Registration of Industrial Designs, International Application – Item 16, at [www.wipo.int/hague/en/guide/ia.html#r16](http://www.wipo.int/hague/en/guide/ia.html#r16)).

(a) Check the appropriate box:

Contracting Party concerned:  Japan and/or  Republic of Korea

The applicant requests **all** the industrial designs which are contained in the present international application to be registered as a related design, or

The applicant requests **the following** industrial designs which are contained in the present international application to be registered as a related design(s):

Indicate the number(s) of the industrial design(s) concerned.

.....  
.....

(b) Information concerning the **principal design** to which the design(s) indicated under item (a) are related

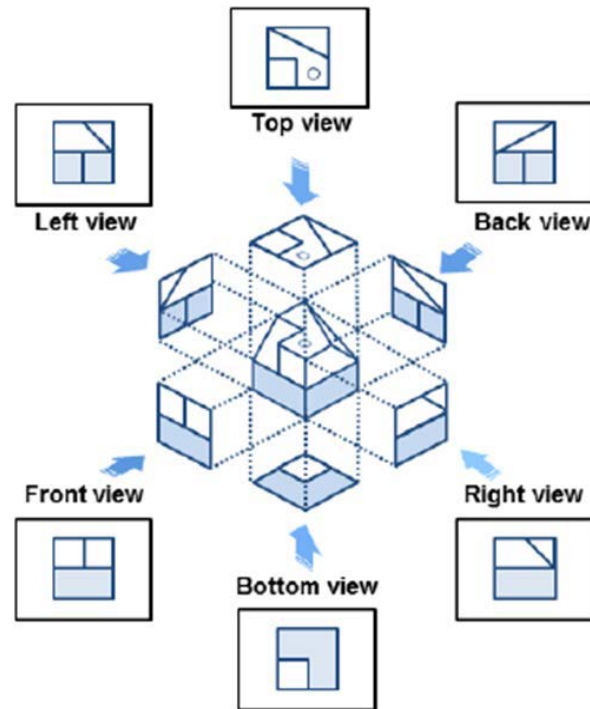
# Submission of Priority documents to KIPO and JPO

- KR: Attach your priority document under dedicated tab
- JP: File your original priority document with JPO
- PAY ATTENTION TO DEADLINES for submission of priority documents! 3 months from the international publication date. No extension possible!
  - *Why don't you make the international application the priority application?*

# **REPRODUCTIONS AND OTHER COMMON ISSUES**

# Views

## Six views



Six views created by the orthographic projection method

**JP:** Front, back, top, bottom, left right view by the orthographic projection method are mandatory;

**KR, US, RU:** Six views are recommended, not mandatory

# Magna!

- Always explain in the description the presence of shading or dotted lines:

- **JP**: required

- **KR**: recommended

- **US**: may not be necessary

- **RU**: may not be necessary

# Reproductions: shading/coloring

2.1



2.2



2.3



“The blue marked parts of designs 2 to 4 are not coming into the scope of the industrial design (disclaimer)”

DM/080861 “Vehicle bodywork”

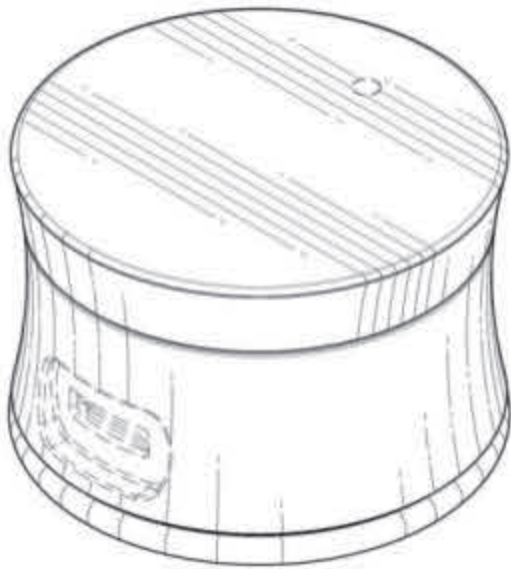
# Reproductions: dotted lines



DM/082544; “Shoe”

“No protection is sought for the matters shown in dotted lines (disclaimer)”

# JP: Reproductions – dotted, broken lines, shading



DM/088498 “Electronic stethoscope”

**JPO issued a notification concerning the shading (narrow lines on the surface of the article).**

Amendments to overcome the refusal  
The applicant has overcome the reasons for refusal by amending to add the statement, “the thin lines indicate a relief of surfaces”.

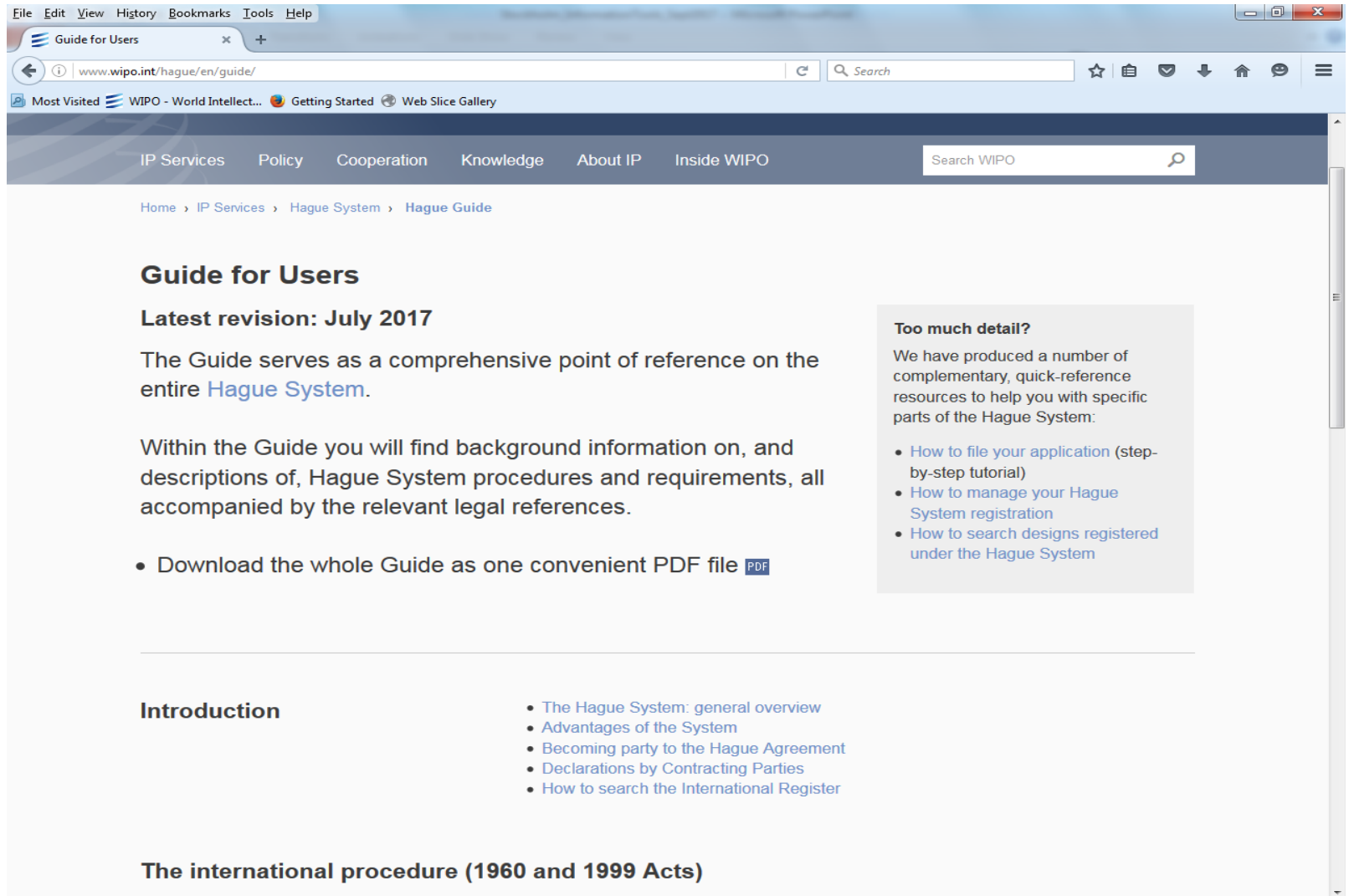


# WIPO's Reaction to Help Users

- Intelligent **E-filing** system to keep it simple
- Prevention of omission or systemic mistakes
- Prepopulated declarations and claim
- Links to national websites for guidance
  - on prior art issues
  - the applicable level of fees (USPTO)
  - on related design practice (JPO and KIPO)

# Guide for Users

## Comprehensive Point of Reference



The image is a screenshot of a web browser displaying the WIPO Guide for Users. The browser's address bar shows the URL [www.wipo.int/hague/en/guide/](http://www.wipo.int/hague/en/guide/). The page features a dark blue navigation bar with links for IP Services, Policy, Cooperation, Knowledge, About IP, and Inside WIPO, along with a search bar labeled "Search WIPO". Below the navigation bar, a breadcrumb trail reads "Home > IP Services > Hague System > Hague Guide". The main content area is titled "Guide for Users" and includes a sub-heading "Latest revision: July 2017". The text states that the Guide serves as a comprehensive point of reference on the entire Hague System. It also mentions that the Guide provides background information, descriptions of Hague System procedures and requirements, and relevant legal references. A bullet point offers to download the whole Guide as a PDF file. To the right, a grey box titled "Too much detail?" provides links to complementary resources: "How to file your application (step-by-step tutorial)", "How to manage your Hague System registration", and "How to search designs registered under the Hague System". At the bottom, a section titled "Introduction" lists links to "The Hague System: general overview", "Advantages of the System", "Becoming party to the Hague Agreement", "Declarations by Contracting Parties", and "How to search the International Register". The final section is titled "The international procedure (1960 and 1999 Acts)".

File Edit View History Bookmarks Tools Help

Guide for Users

www.wipo.int/hague/en/guide/ Search

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Home > IP Services > Hague System > Hague Guide

### Guide for Users

**Latest revision: July 2017**

The Guide serves as a comprehensive point of reference on the entire [Hague System](#).

Within the Guide you will find background information on, and descriptions of, Hague System procedures and requirements, all accompanied by the relevant legal references.

- Download the whole Guide as one convenient PDF file [PDF](#)

#### Too much detail?

We have produced a number of complementary, quick-reference resources to help you with specific parts of the Hague System:

- [How to file your application \(step-by-step tutorial\)](#)
- [How to manage your Hague System registration](#)
- [How to search designs registered under the Hague System](#)

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### Introduction

- [The Hague System: general overview](#)
- [Advantages of the System](#)
- [Becoming party to the Hague Agreement](#)
- [Declarations by Contracting Parties](#)
- [How to search the International Register](#)

### The international procedure (1960 and 1999 Acts)

Home › IP Services › Hague System

## WIPO | HAGUE

### Hague – The International Design System

The Hague System for the International Registration of Industrial Designs provides a practical business solution for registering up to 100 designs in over **68 contracting parties** through filing one single international application.

#### Find out more

- [What is an industrial design?](#)
- [Main features and advantages](#)
- [Legal framework](#)
- [Frequently asked questions](#)
- [Guidance on reproductions](#) **PDF**



#### FEATURED



Case study: "Reinventing the Frame, Challenging the Status Quo". (Photo: Jeff Harris/Artmix; RoundTAIL)

**Guidance on Preparing and Providing Reproductions in Order to Forestall Possible Refusals on the Ground of Insufficient Disclosure of an Industrial Design by Examining Offices**

# A Few Tips From the «Guidance»

- Provide enough views
- Provide a legend to your views
- Provide a description to explain presence of shading/dotted lines
- Avoid mixing depiction styles

# Rule 9(4) of the Common Regulations

- No refusal on formal grounds.
- Refusal possible on the ground «*that the reproductions contained in the international registration are not sufficient to disclose fully the industrial design*»
- Criteria for sufficient disclosure of an industrial design may be different from one jurisdiction to another.

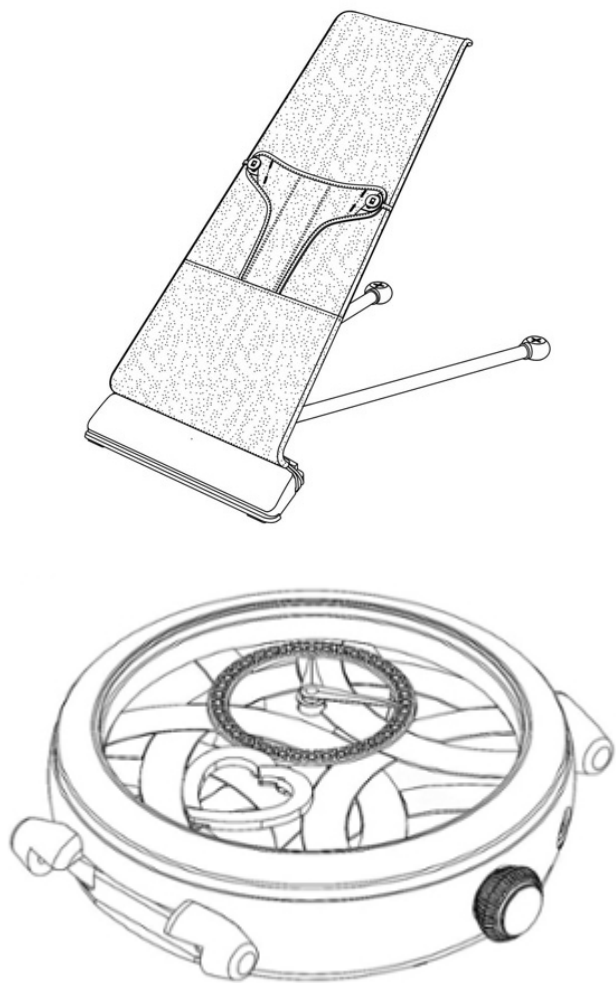
# Remember: Refusals on Substantive Grounds only

- In particular, Offices cannot formally:
  - Oppose to color
  - Oppose to photographs
  - Oppose to surface shading or dotted line
  - Require surface shading
  - Require a description
  - Require a legend
  
- It's your liberty under the Hague System to use these or not

# Refusals: How to avoid Them

- Think of Unity of Invention in US and the RU
- Indicate your Principal & Related Designs in JP and KR
- Be specific in your product indication for JP and KR
- Disclosure, Disclosure, Disclosure

# Success Stories: these cases accepted by all Offices !

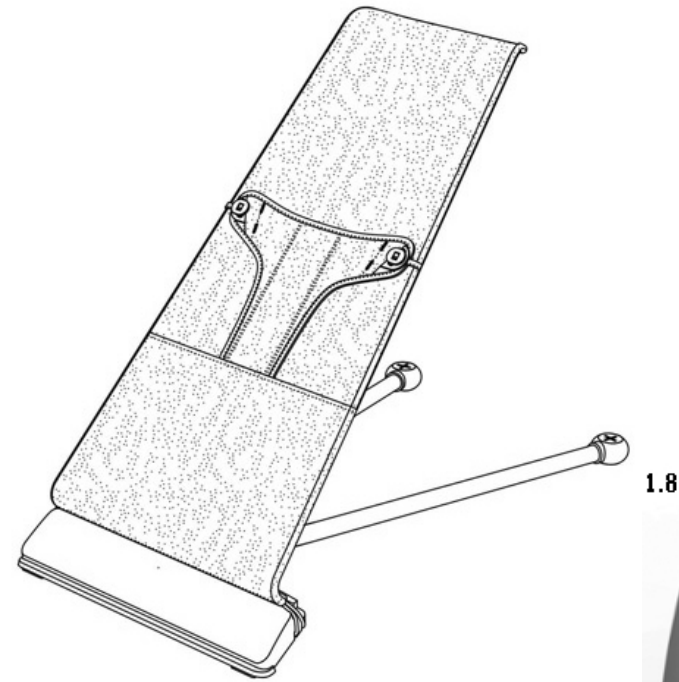


DM/89713 DM/92976 DM/90971  
DM/89865 DM/89858 DM/89019



# Success Stories: these cases accepted by all Offices !

1.1



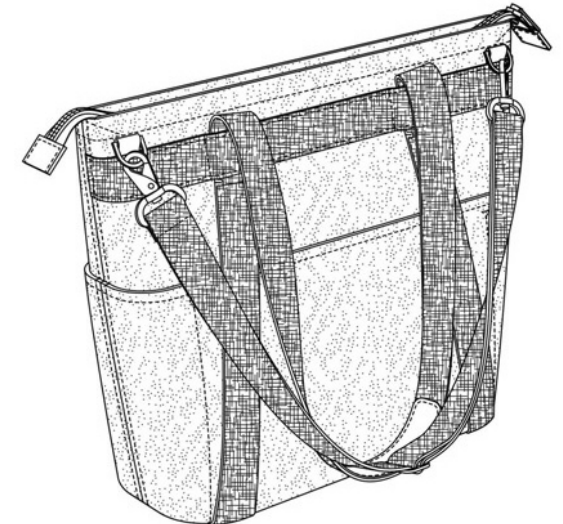
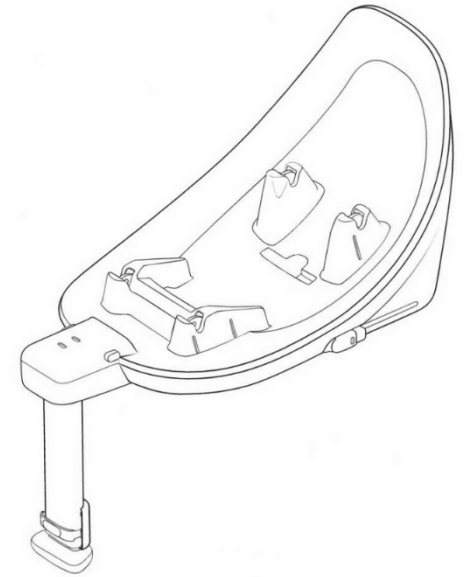
1.8

DM/89713  
DM/88913  
DM/86974  
DM/87158  
DM/87367

1.1



1.2



Thank you!

