

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Hague System – Practical Aspects for U.S. Applicants

Charles Pearson

Director

International Patent Legal Administration

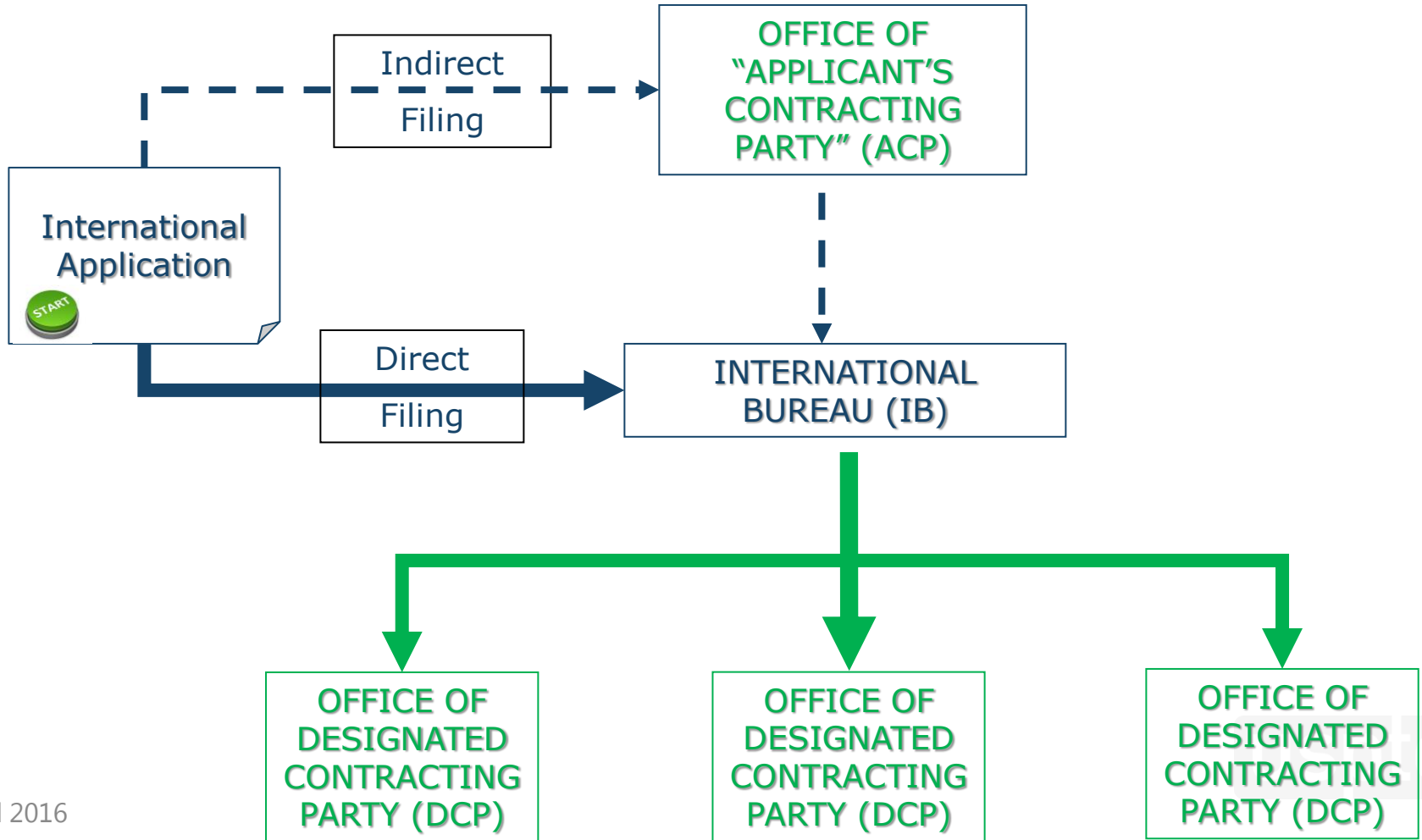
Some Statistics (as of 4/5/16)

- Since May 13, 2015:
 - Approximately **184** applications filed through the USPTO as an office of indirect filing
 - **795** registrations received from the IB for examination

U.S. Statutes & Regulations Implementing the Geneva Act of the Hague Agreement

- 35 U.S.C. chapter 38
 - 35 U.S.C. 381-390
- 37 CFR part 1, subpart I
 - §§ 1.1001-1.1071
- Took effect with respect to the United States on 13 May 2015

Hague System Procedure



Roles in the Hague Process

Three Main Actors:

1. Office of Indirect Filing
2. International Bureau (WIPO)
3. Office of a Designated Contracting Party

Roles in the Process

- **Office of Indirect Filing**
 - Limited review... essentially a pass-through office
 - Accords a “receipt” date
 - May require payment of a transmittal fee
 - Many CPs do not provide for filing through their office

Roles in the Process

- **International Bureau (WIPO)**
 - Examines formalities
 - Records in the International Register
 - Issues a Registration Certificate to holder
 - Publishes in WIPO Bulletin in 3 official languages
 - Transmits copies of certain notifications received from CPs to holders
 - Maintains the International Register

Roles in the Process

- **Office of a Designated Contracting Party**
 - Conducts *substantive* examination to the extent required under the CP's law
 - Some CPs republish
 - USPTO will issue a design patent if appropriate (republish)

International Design Applications:

Who Can File

Where to File

Who can file an International Design Application?

That depends on **where** the international design application is filed....

1. **Directly** with the International Bureau
2. **Indirectly** through an office of indirect filing

To File Directly With the International Bureau

- The applicant must have at least one of the following **connections** with a **Contracting Party** to the Hague Agreement:
 - Nationality
 - Domicile
 - Habitual residence
 - Real and effective industrial or commercial establishment
- If there is more than one applicant, **each** applicant must have a connection to a Contracting Party

To File Through the USPTO as an Office of Indirect Filing

- The applicant must have at least one of the following **connections** to the **United States**:
 - **U.S.** Nationality
 - Domicile in the **U.S.**
 - Habitual residence in the **U.S.**
 - Real and effective industrial or commercial establishment in the **U.S.**
- If more than one applicant, **each** applicant must have a connection to the **United States**

Filing Through the USPTO: What do we review?

- USPTO reviews:
 1. Entitlement to file through the USPTO
 - i. Each applicant has a **U.S. connection**
 - Box 2 of DM/1 form
 - ii. U.S. is *Applicant's Contracting Party*
 - Box 3 of DM/1 form
 2. Payment of the transmittal fee
 3. National security

Filing Through the USPTO: What do we review?

- If these conditions **are met**, the USPTO will transmit the application to the IB and notify applicant (Form PTO-2320)
 - The IB will also send applicant an acknowledgement letter upon receipt of the application from the USPTO
- If these conditions **are not met**, the USPTO will **not** transmit the application, and the applicant will be notified of the reason(s) for not transmitting (via Form PTO-2320)
- **Tip: Consider docketing for receipt of the USPTO and IB notices**

Filing Through the USPTO: Applicant's CP

- To file through the USPTO, the U.S. must be “**applicant's Contracting Party**” (**ACP**)
 - **ACP** is the CP through which applicant derives entitlement to file an IDA, or if there are two or more such CPs, the one indicated as such in the IDA
- Identify **ACP** in Box 3 of the DM/1 for each applicant
 - DM/1, revised March 2016, now provides that if Box 3 is blank and the IDA is filed through the office of a CP identified in Box 2, that CP is deemed to be the **ACP**

(Article 1 (xiv), Article 4, §1.1012)



Filing Through the USPTO: How to File

- IDAs may be submitted to the USPTO electronically via **EFS-Web** or in **paper** via mail or hand delivery
 - Facsimile transmission of IDAs to the USPTO is prohibited
- IDAs filed in **paper** are subject to an **additional** per page WIPO publication fee
 - Currently, **150** Swiss francs for each page containing a reproduction after the first page

Filing Through the USPTO: How to File

- IDAs filed through EFS-Web **may also be subject to the additional per page publication** fee if the reproductions are not submitted in the prescribed manner
- To avoid incurring the additional per page publication fee, upload reproductions via the special “**Attach Reproductions**” section in EFS-Web
 - Each image file uploaded must be a single page PDF or JPEG file having only ONE reproduction (i.e., one view)
 - Do not include figure numbers in the images, as EFS-Web will prompt the user to assign a figure number (design/view number) as each file is uploaded

Filing Through the USPTO: How to File

EFS Unregistered

Unregistered eFilers | Please Read Announcements | Application Data | Attach Documents | Review Documents | Calculate Fees | Confirm & Submit | Pay Fees | Receipt

Attach Documents

A submission has not been filed officially at the USPTO until the e-filer executes the Submit function and the documents are received at the USPTO Eastern Time. The Acknowledgement Receipt is evidence of this submission.
This is the application data associated with your filing. If any information is incorrect, please edit the [Application Data](#)

Title of Invention	Car Window
Applicant Name	John Q. Filer
Customer Number or Correspondence Address	1234
Filed By	John Q. Filer
Attorney Docket Number	
Application Type	International Design Application (Hague) for filing through the USPTO as an office of indirect filing

Attach Documents other than Reproductions

Files to be Submitted	Category	Document Description	
1 Choose File No file chosen Does your PDF file contain multiple documents? <input type="radio"/> Yes <input checked="" type="radio"/> No	View All Categories		Delete

Add File

Attach Reproductions

Instructions: Click the "Browse" button to attach each reproduction. To avoid additional per page publication fees, each reproduction must be submitted as a single page PDF or JPEG file that contains only one reproduction per file. In addition, the numbering of the reproduction should not appear in the image content but rather associated with the PDF or JPEG file via the attaching section below. See <http://www.wipo.int/hague/en/fees/sched.htm>. To add additional views or designs, click the "Add View" or "Add Design" Button. To reorder the sequence of views or designs click the "Move Up" or "Move Down" buttons.

Design 1 Delete Move Down Move Up

Files to be submitted	Document Description	
View 1.1 Choose File jpg1.jpg	Drawings-only black and white line drawings	Delete Move Down Move Up
View 1.2 Choose File jpg2.jpeg	Drawings-other than black and white line drawings	Delete Move Down Move Up

Filing Through the USPTO: How to File

For further information, see *EFS-Web Quick Start Guide: International Design Application (Hague) for filing through the USPTO as an office of indirect filing* available:

<http://www.uspto.gov/patents-application-process/applying-online/efs-web-guidance-and-resources>

Filing Through the USPTO: Additional Tips

Additional filing tips, including information concerning figure numbering under the Hague system, design size limits, and reproduction orientation, are available on the USPTO web site (link to follow) under “*Tips for Filing New International Design Applications*”

Direct vs. Indirect Filing

Why file directly with the IB?

- Applicant does not have a U.S. connection but does have a connection with another CP
- IB's E-filing interface automatically checks for certain errors in the application submission
 - In addition, for IDAs filed through the interface on or after March 30, 2016, corrections may also be sent through the interface
- Avoids having to pay a transmittal fee
- Quicker processing

However-- a foreign filing license may be needed to file directly with the IB (35 U.S.C. 184)

Direct vs. Indirect Filing Considerations

Why file indirectly through the USPTO?

- A foreign filing license is not required
 - USPTO will review IDA and grant license if appropriate
- Difference in time zones may benefit last minute filers
- May file reproductions in PDF

However-- Each applicant must have a U.S. connection

International Design Applications: **Parts & Contents**

Components of an International Design Application

Main components:

1. “Official form” & Annexes
2. Reproductions
3. Fees

Official form

- The IDA **must** be presented on the “**official form**” signed by the applicant
 - The IB established form **DM/1** “*Application for International Registration*” as an official form
- **Tip:** If applicant’s representative signs the DM/1, submit WIPO form **DM/7** (“*Appointment of Representative*”) to avoid an IB irregularity letter concerning the signature
 - Do NOT use USPTO Power of Attorney forms to appoint a representative before the IB

(Rule 7(1), Rule 1(vi), § 1.1022)

Annexes

- For submitting required & optional content items for certain designated CPs
- Annexes currently available:
 1. **Annex I:** Oath or declaration of the creator (US)
 2. **Annex II:** Document(s) supporting a declaration to the exception to lack of novelty
 3. **Annex III:** Information disclosure statement (US)
 4. **Annex IV:** Micro-entity certification (US)
 5. **Annex V:** Priority document (KR)

Contents of an IDA

Three types of content:

1. Mandatory contents
2. Additional mandatory contents
3. Optional contents

(Art. 5, Rule 7, § 1.1021)

Mandatory Content

All IDAs shall include or indicate:

- Applicant data, as prescribed
- Basis for applicant's entitlement to file
- Indication of the product(s) that constitute the industrial design or in relation to which the design is to be used
- Number of designs in the IDA (not to exceed 100)
- Designation of at least one CP

(See Rule 7(3) for a complete list)

TIP: Decide carefully in advance which CPs to designate, as further CPs cannot be added after filing

Additional Mandatory Content

- Additional content is required **when designating a CP that has made an Article 5(2) and/or Rule 8 declaration**
- Article 5(2) elements:
 - i. Identity of the creator (*RO*)
 - ii. A brief description of the reproduction or of the characteristic features of the industrial design (*RO, SY*)
 - iii. A claim (*US*)
- Rule 8: special requirements concerning the *applicant or creator* (*US, FI, IS, HU, GH*)

(Rule 7(4))

Optional Contents

Optional contents for IDAs include, e.g.:

- A description (unless required under Art. 5(2))
- A request for **deferred/immediate** publication
- The name/address of applicant's representative
- A claim of priority under the Paris Convention
 - ❖ No provision for adding a priority claim after filing
 - ❖ No provision for submitting priority documents except for purposes of KR via Annex V

(See Rule 7(5) for a complete list)

Optional Contents

Timing of WIPO publication:

- **Default: 6 months** after the date of international registration
- **Immediate publication:** immediately after registration
- **Deferred publication:** Up to **30 months** from the priority date (or filing date, if no priority), provided:
 - All designated CP's permit deferred publication
 - Some CPs may limit deferment to < 30 months

(Rule 17)

Contents – Description

- DM/1 Form includes Boxes 9 and 10 for providing a description
- Depending on the CPs designated, a description may be an **additional mandatory content** item or **optional**
 - Even where optional, be mindful of substantive law requirements applicable to designated CPs
 - U.S. law requires a disclosure in the manner prescribed by 35 U.S.C. 112

Contents – Description

- **Box 9** “*Description*”
 - For providing a brief description of the reproduction or of the characteristic features of the industrial design
 - Subject to additional word fee if > 100 words
 - Mandatory if designating a CP that requires a description under Article 5(2)
- **Box 10** “*Brief Description of the Reproductions (Legends)*”
 - For providing figure descriptions
 - Identify view by code (1=Perspective, 2=Front, etc.)
 - Not subject to the additional word fee
 - Recommended if U.S. or Japan is designated
 - May be required in U.S. examination phase if missing

Contents – Description

9 DESCRIPTION^{4, 5}

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.

⁴ If the Syrian Arab Republic is designated, a brief description of the reproduction or of the characteristic features of the industrial design is required.

⁵ If Romania is designated, a brief description of the characteristic features of the design is required.

10 DESCRIPTION OF THE REPRODUCTIONS (LEGENDS)⁶

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.

⁶ Recommended for a designation of Japan and the United States of America.

Contents – U.S. Designated

IDAs **designating the U.S.** must include:

1. A claim
2. Indications concerning the identity of the creator(s)
 - The creator must be an inventor
3. The inventor's oath or declaration
 - WIPO Annex I contains forms for the inventor's declaration and substitute statement specifically tailored for use in IDAs

(§ 1.1021(d))

Contents – U.S. Designated Claim

- Claim:
 - More than one claim is not permitted
 - *the specific wording shall be in formal terms to the ornamental design for the article (specifying name of article) as shown, or as shown and described*

(§1.1025)

Contents – U.S. Designated Claim

12

CLAIM (Applicable to the designation of the **United States of America** only)⁸

Indicate an article in the blank space provided. Only one article shall be indicated, irrespective of the number of industrial designs contained in the present international application.

CLAIM: The ornamental design for as shown and described.



⁸ If the **United States of America** is designated in item 7, this information is required.

International Design Applications: Fees

Transmittal Fee

- Payment of a transmittal fee is required if the IDA is filed through the USPTO
 - Amount: **\$120** (no entity-based discount)
 - The IDA will **not** be transmitted to the IB if the transmittal fee is not paid

(§1.1031(a))

WIPO Application Fees

Application fees required by WIPO:

1. Basic fee

- 397 CHF for 1 design; 19 CHF/additional design

2. Publication fee

- 17 CHF/reproduction
- 150 CHF/page of reproduction after 1st page (paper submissions)

3. Designation(s) fee

- Standard (levels 1-3) (42/60/90 CHF)
- Individual (67 chf-733 CHF)
- May also depend on the # of designs

4. Additional word fee if description > 100 words

- 2 CHF/word

(Rules 12(1), 11(2) and 28(1))

WIPO Application Fees

- Amounts are set forth in:
 - *Schedule of Fees*
<http://www.wipo.int/hague/en/fees/sched.htm>
 - *Individual Fees under the Hague Agreement*
<http://www.wipo.int/hague/en/fees/individ-fee.html>
- “Hague System Fee Calculator” is a WIPO tool for calculating application fees
<http://www.wipo.int/hague/en/fees/calculator.jsp>

WIPO Application Fees

Hague System Fee Calculator

Enter the details below to quickly estimate the application or renewal fees in Swiss francs (CHF)

Type:

Date:

Applicant's State of origin (Hague "1960" Act):

Applicant's Contracting Party (Geneva "1999" Act):

Add the number of industrial designs:

Add the number of reproduction(s) of the industrial design(s):

If using the paper application form, add the number of pages of reproductions: (free if you use the e-filing interface)

Add the number of words of description:

Locarno Classification:(For KR designations only)

Economic Status : (For US designations only)

Select All

Clear All

Continue

Re

Sch

Ind

FA

E-f

Paying WIPO Application Fees

Paying WIPO through the USPTO:

- Applicants filing indirectly **may** pay WIPO application fees through the USPTO **on or before** the date of payment of the transmittal fee
 - Payment will only be accepted in **U.S. dollars**

Note: fluctuations in currency exchange rates may result in the IB receiving less than the required Swiss currency amount, and the IB may invite the applicant to pay the deficiency

(§ 1.1031(d))

Paying WIPO Application Fees

Applicants are **not** required to pay WIPO application fees through the USPTO

- IB will invite applicant to pay any deficiency
- Later payment of WIPO fees does **not** impact the filing date or international registration date

Paying WIPO Application Fees

Paying WIPO directly:

- Modes of payment: credit card, WIPO current account, bank and postal transfer
- Can pay online via WIPO's
 - E-filing system (if filing directly with WIPO)
 - E-Payment system (after WIPO sends an irregularity letter)
- Can include authorization to charge a WIPO current account on the DM/1 form

For further information, see:

<http://www.wipo.int/about-wipo/en/finance/hague.html#payments>

U.S. Designation Fee

- U.S. individual designation fee consists of two parts:
 1. A **first part** due on filing
 2. A **second part** (issue fee) due within the time period set in a notice of allowance

First Part U.S. Designation Fee

- **First part= 733 CHF**
 - Approx. equivalent to the *combined* U.S. dollar amounts for the filing/search/examination fees for a regular U.S. design application
 - Discounted 50% for small and 75% for micro entities
 - Indicate status in **Box 18** of the DM/1 form
 - Micro entities must submit the micro entity certification form (Annex IV)

Second Part U.S. Designation Fee (Issue Fee)

- If the USPTO determines that the applicant is entitled to a patent, a **Notice of Allowance** (PTOL-85 (Hague)) will be sent specifying the amount of the **second part** of the U.S. designation fee (issue fee)
- Fee can be paid:
 - **Directly to USPTO** - in U.S. dollars in the amount stated in the Notice of Allowance
 - **To WIPO**– in Swiss Francs in the amount specified on web site of WIPO

Second Part U.S. Designation Fee (Issue Fee)

- Small/micro entities must verify entitlement to such entity status prior to paying the issue fee
- If no longer entitled to small/micro entity status, a notification of loss of entitlement **must be filed directly with the USPTO** prior to or at the time of paying the issue fee
 - Further information is set forth in the Notice of Allowance

The International Registration has published... **now what?**

Consider Whether Certain Documents Need to be Filed with Designed CPs

- NO submission/fee is required to trigger examination
- May still be a need to file certain documents with designated CPs, e.g.:
 - **Priority document**
 - JP & KR, for example, require such to be filed within 3 months from WIPO publication
 - Declaration and/or supporting documents **for an exception to lack of novelty**
 - JP, for example, requires such to be filed within 30 days from WIPO publication
- Many CPs require local counsel to file documents with their office

Consider Whether Certain Documents Need to be Filed with Designated CPs

If **U.S.** is designated, consider need to file:

- Certified copy of foreign priority document
- ADS to claim domestic benefit
- IDS
 - no fee or § 1.97(e) statement needed if filed within 3 months from publication
- Change of correspondence address
 - Customer Number with e-Office action delivery will result in earlier notification of any refusal

TIP: The U.S. application number will be on the filing receipt sent by the Office and is searchable via Public PAIR after WIPO publication using the “DM/” number.

What to expect?

- Some CPs do **not** examine and may not communicate any notification regarding a grant of protection
- Some non-examining CPs:
 - **OAPI**: grant of protection begins from the date of international registration
 - **Bosnia and Herzegovina**: grant of protection begins from the date of WIPO publication

What to expect?

- CPs that examine will send a **Refusal** if the requirements under their national/regional law are not met
 - Degree of examination varies
 - Many CPs do not examine for novelty

What to expect?

- Generally no requirement for a CP to send notice that protection is granted
 - Some exceptions:
 - The design was amended before the CP
 - Rules 18(1)(c)(i) or (ii) “extensions” apply to the CP
- Some offices (e.g., OHIM) still send notice of a grant of protection

Refusals

- Refusals are communicated **directly to the IB**, which must transmit a copy to the holder “*without delay*”
- Time period for communicating the Refusal to the IB:
 - **6 months** from WIPO publication, or
 - **12 months** (if the CP makes a **Rule 18(1)(b)** declaration)
 - Such declaration may include statements under **Rule 18(1)(c)(ii)** (excusing unintentional delay by the CP) and **Rule 18(1)(c)(i)** (setting a later time at which protection is granted in the CP)

Refusals

In the **United States:**

- The time period for sending a Refusal is **12 months**
 - Exception where the delay was unintentional
- The Refusal will typically be the examiner's first action that includes a rejection, restriction requirement, objection, or other requirement.
- Substantive examination occurs as in the case of U.S. regular design applications
 - The Office will generally not refuse based on matters of form reviewed by the IB

Following a Refusal

- Any reply to a Refusal must be filed directly with the office sending the Refusal and not through the IB
 - Remedies/procedures are governed by the CP's law
 - Some CPs require local representation to file a reply
 - In the U.S., replies must be signed in accordance with §1.33(b)
- Subsequent communications by the CP are generally not communicated through the IB
 - Exceptions: Any withdrawal of the refusal/Statement of Grant of Protection

Resources

- WIPO Web-site

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

- USPTO Web-site

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

Questions?

Charles Pearson

Director, International Patent Legal Administration

Charles.Pearson@uspto.gov

UNITED STATES
PATENT AND TRADEMARK OFFICE



