

# The United States as a Member of the Geneva Act of the Hague Agreement



David R. Gerk  
Patent Attorney  
Office of Policy and International Affairs  
U.S. Patent and Trademark Office



# Agenda

- **Background on US Membership**
- **U.S. as an Office of Indirect Filing**
- **U.S. as a Designated Contracting Party**
- **International Registrations With Multiple Designs and Other Areas of Complexity**
- **Questions ???**



# Road to U.S. Membership

- **July 2, 1999** –By consensus, WIPO Member States adopted the Geneva Act of the Hague Agreement
- **July 6, 1999** - United States signs on to Agreement
- **November 13, 2006** – President Bush transmitted Hague Agreement to Senate Foreign Relations Committee (SFRC) (Treaty Doc. 109-21)
- **July 17, 2007** – SFRC held hearings (S.Hrg. 110-305)
- **November 27, 2007** – SFRC reported resolution of advice and consent to ratification (Exec. Rept. 110-7)



# Road to U.S. Membership

- **December 7, 2007** – The Senate considered; Advice and consent to ratification agreed to in Senate
- **\*\*September 16, 2011** – President Obama signed Leahy-Smith America Invents Act (AIA) into law.\*\*
- **December 18, 2012** – President Obama signed into law the Patent Law Treaties Implementation Act of 2012, implementing legislation for the Hague Agreement (and the Patent Law Treaty (PLT))
- **February 13, 2015** - United States deposits instrument of ratification with WIPO (now member)
- **May 13, 2015** – Geneva Act of the Hague Agreement takes effect in the United States



# Governing Provisions

- **Geneva Act of the Hague Agreement**
  - Takes effect with respect to the United States on **May 13, 2015**.
- **Update to United States Law (Title 35 USC) \***
  - Public Law 112-211 enacted Dec. 18, 2012  
*“The Patent Law Treaties Implementation Act of 2012” (Title I)*
  - Takes effect **May 13, 2015**.

\* <http://www.gpo.gov/fdsys/pkg/PLAW-112publ211/pdf/PLAW-112publ211.pdf>



# Governing Provisions

- **Update to USPTO's Final Rules \*\***
  - Published April 2, 2015 (Fed. Reg. Notice)
  - Takes effect **May 13, 2015**

\*\*<http://www.uspto.gov/sites/default/files/documents/80-fr-17918.pdf>

- **MAY 13, 2015 → ALL THE MAGIC HAPPENS!**
  - (1) Geneva Act Takes Effect,
  - (2) US Law Changes Take Effect, **AND**
  - (3) USPTO Rules Take Effect



# Governing Provisions

- **Most changes simply implement the Geneva Act of the Hague Agreement.**
- **Two Highlighted Changes:**
  - (1) **Term** for design patents
    - will change from **14 years** from patent grant to **15 years** from patent grant.
  - (2) **Provisional rights**
    - Available from date of publication of the International Registration (IR). (IR designating the U.S. is a 35 USC §122(b) publication.) *35 USC §390*



# U.S. as a Contracting Party

- **USPTO Roles as Office of a Contracting Party:**
  - **(1) Office of Indirect Filing**
  - **(2) Designated Office**





# USPTO as an Office of Indirect Filing





# Who May File?

- Article 4 sets forth procedure for filing
  - Can file with IB or Applicant's contracting party
- May be filed through the USPTO only if:
  - (1) Applicant (all the applicants) is/are:
    - A national of the United States **OR**
    - Have a domicile, habitual residence, or a real and effective industrial or commercial establishment in the United States
  - (2) Applicant's (all the applicants') contracting Party is the United States

*35 USC 382(a) and 37 CFR 1.1011(a); 37 CFR 1.1012 and Art. 4*



# How Do You File?

- IDAs may be filed through the USPTO as an office of indirect filing
  - (1) USPTO's EFS-Web (electronic)
  - (2) Mail
  - (3) Hand Delivery
- If mailed or hand delivered:

**U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building,  
401 Dulany Street  
Alexandria, VA 22314**



# USPTO as a Designated Office



*Consideration of International Registrations by the USPTO when the United States is a Designated Contracting Party*



# Examination & Search

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

---



# Highlighted Considerations

- New, original, ornamental and for an article of manufacture
  - 35 USC § 171, 102, 103
- Fully and clearly described
  - 35 USC §112 (a)
- Only one independent and distinct design claimed
  - 35 USC §112 (b)





# *U.S. Design Patents*

### Examination

### Search

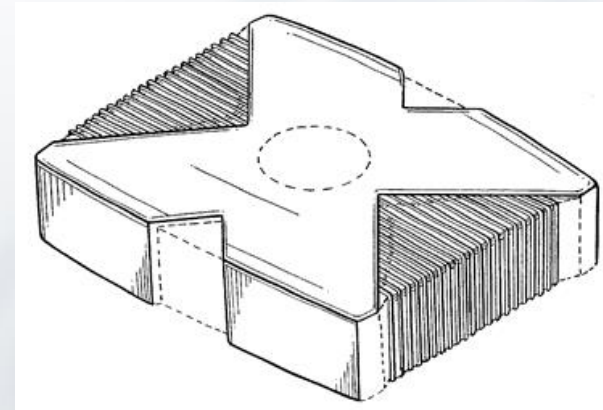
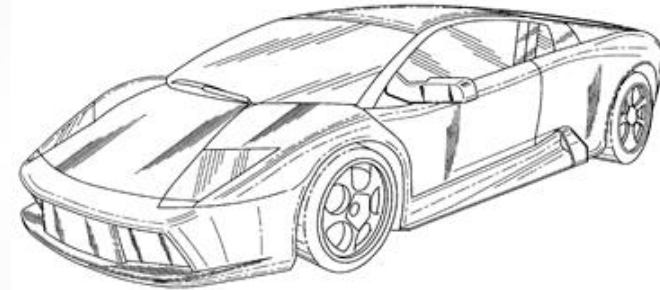
## Examination Process:

- Review the application for a claim and a signed oath/declaration.
- Review the drawings and specification to determine what is claimed.
- Plan and conduct a search which includes US patents, and may include foreign patents, along with non-patent literature.
- Analyze the claim to determine if it is the design for an article, enabled, definite, ornamental, new, original and non-obvious.
- Communicate the results of the analysis to the applicant.



# U.S. Design Patents from IR

- Protects ornamental appearance.
- Covers shape, configuration, or surface decoration.
- *Infringement*: whether in the eye of an “ordinary observer,” two designs are substantially the same in overall visual appearance.
- *Duration*: 15 yrs from issuance\*



\* Term for all US design patents filed on or after May 13, 2015





# Requirements for Patentability

## *U.S. Design Patents*

---



## Requirements for Patentability

# *U.S. Design Patents*

**New**  
**Original**  
**Ornamental**  
**Article**

Non Obvious  
Enabled  
Described  
Definite

### 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



## Requirements for Patentability

# *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



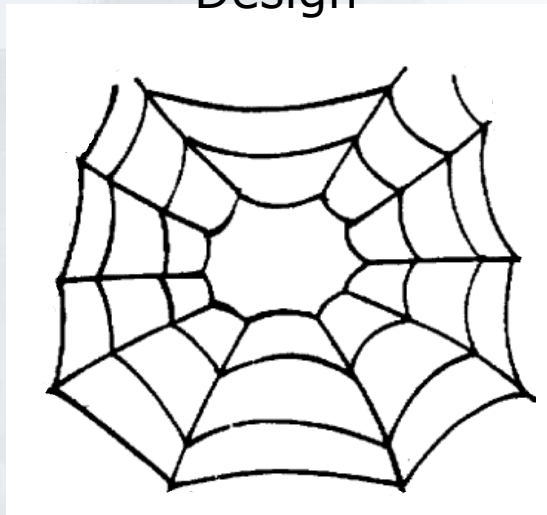
# Requirements for Patentability

## U.S. Design Patents

### The design "for an article"

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

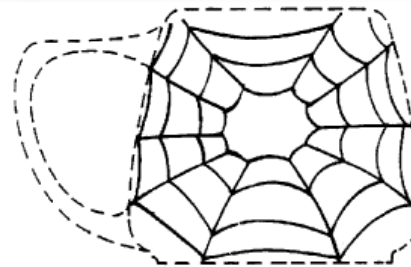
#### Disembodied Design



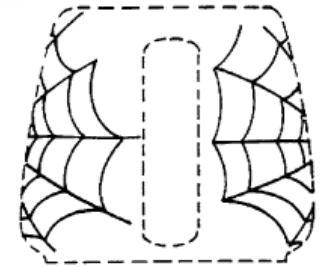
**Not Acceptable**

35 U.S.C. § 171

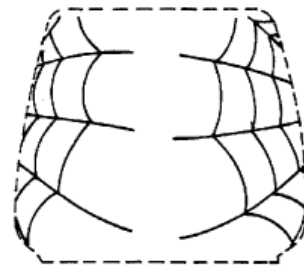
#### Embodied Design



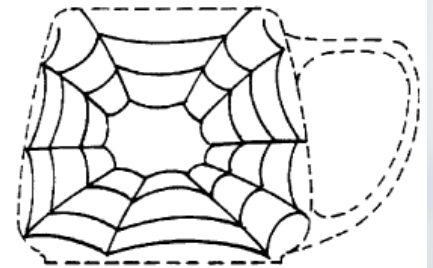
*Fig. 1*



*Fig. 2*



*Fig. 3*



*Fig. 4*

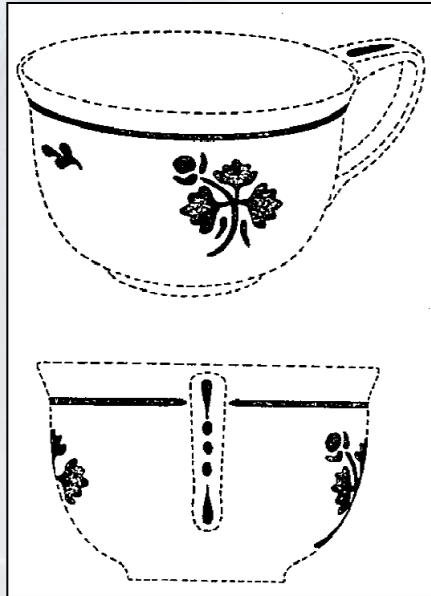


# Requirements for Patentability

## *U.S. Design Patents*

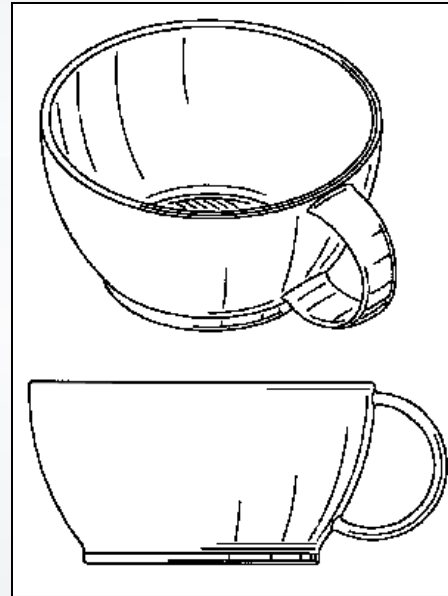
### Types of Designs for Articles:

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



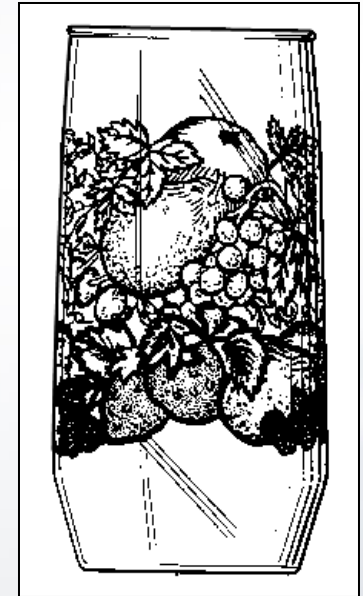
(1)

Surface  
ornamentation  
applied to an article



(2)

Configuration  
embodied  
in an article



(3)

Configuration  
and Surface  
ornamentation for an  
article

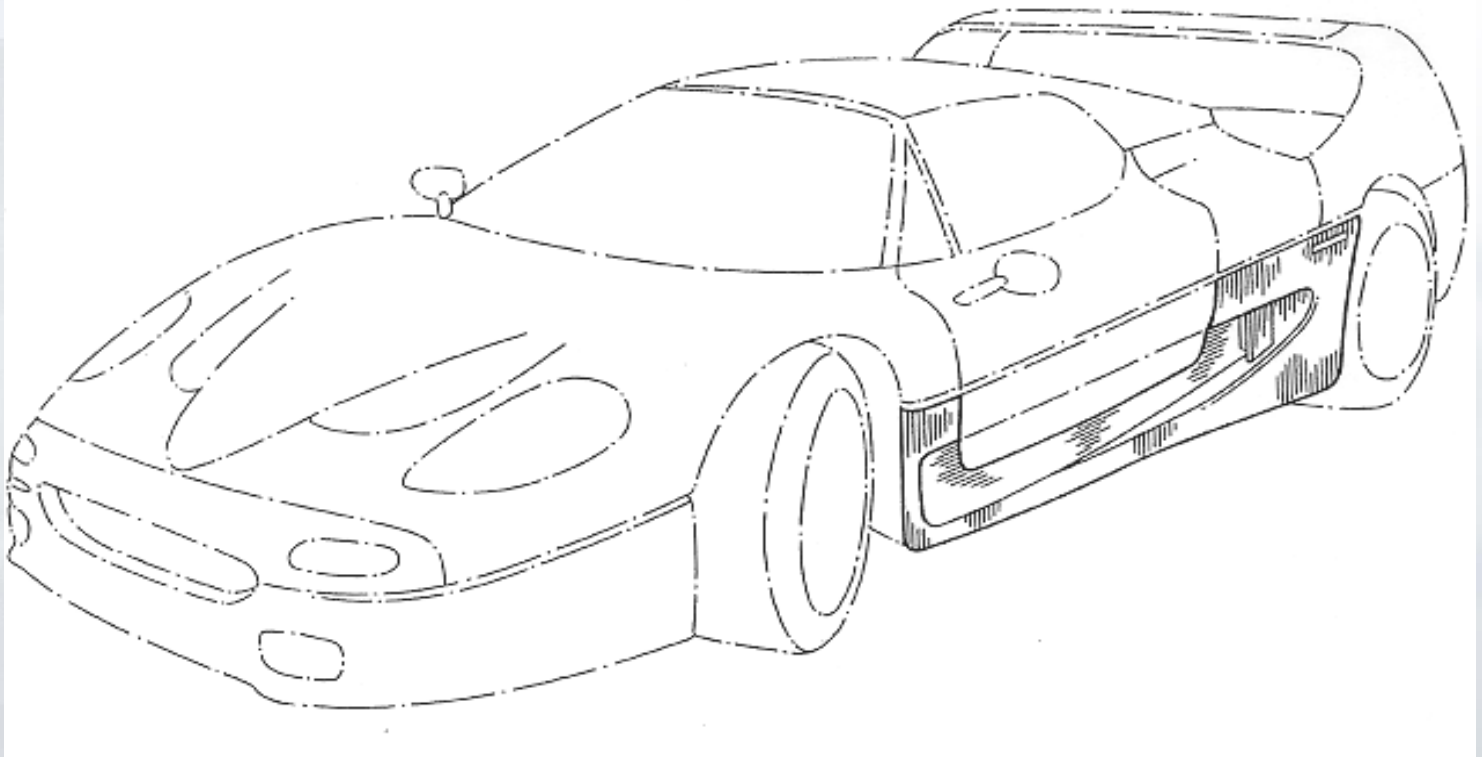
35 U.S.C. § 171



# 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

35 U.S.C. § 171



# Requirements for Patentability

## *U.S. Design Patents*

New

**Original**

Ornamental

Article

Non Obvious

Enabled

Described

Definite

### **Not Original:**

A claim directed to a design for an article which **simulates a well known or naturally** occurring object or person should be rejected under 35 U.S.C. 171 as nonstatutory subject matter in that the claimed design **lacks originality**.

MPEP 1504.01(d)

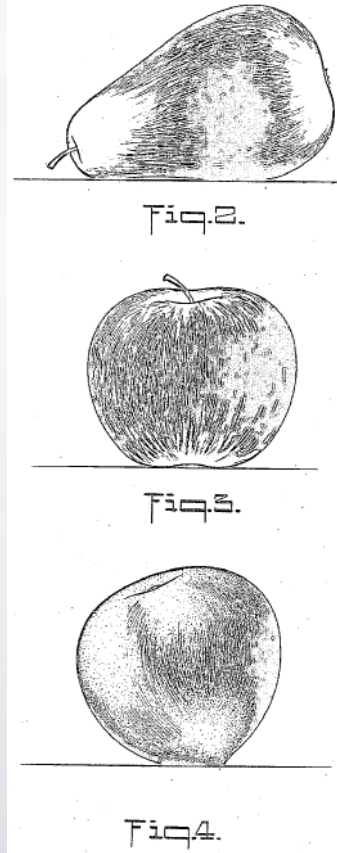
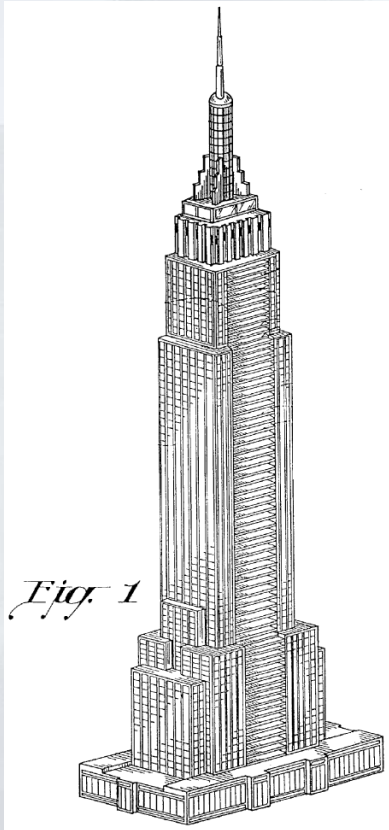


# Requirements for Patentability

## *U.S. Design Patents*

### Not Original:

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



35 U.S.C. § 171





## Requirements for Patentability

# *U.S. Design Patents*

New

Original

**Ornamental**

Article

Non Obvious

Enabled

Described

Definite

## Ornamental Designs:

- Aesthetic appearances.
- Must not be primarily functional.
- Appearance must be a matter of concern.

35 U.S.C. § 171



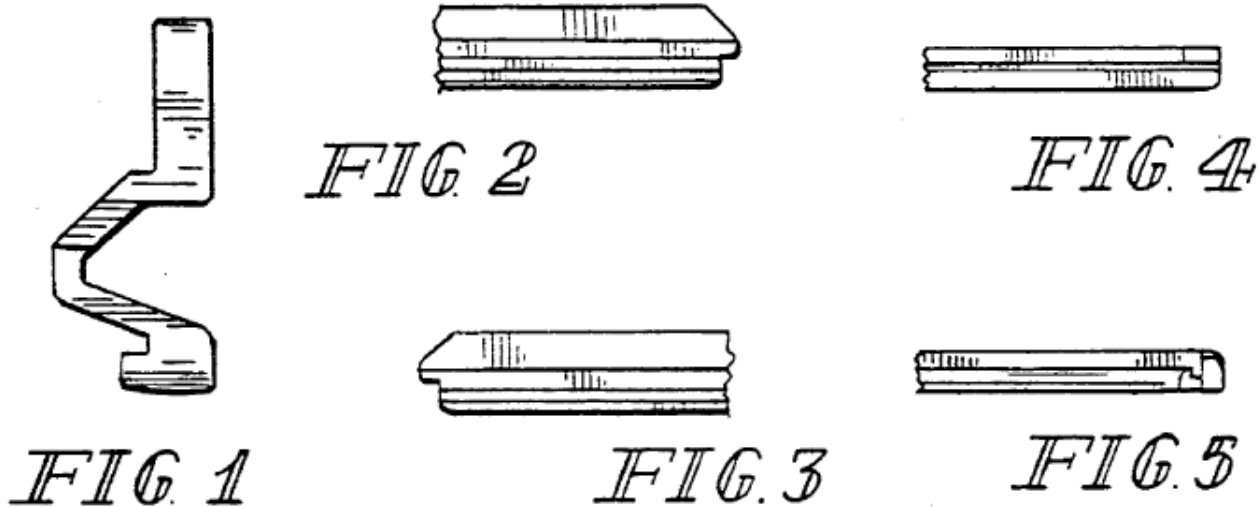
# Requirements for Patentability

## *U.S. Design Patents*

### **Not Ornamental:**

“... the D327,636 patent is invalid under 35 U.S.C. Section 171 for failure to satisfy the statute's ornamentality requirement.”

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



*Best Lock Corp. v. Ilco Unican Corp.* (CAFC) 40 USPQ2d 1048 (1996)

35 U.S.C. § 171



# Patentability Requirements

- Patentable subject matter (§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

#### New

Original  
Ornamental  
Article  
Non Obvious  
Enabled  
Described  
Definite

As with a utility patent, design patent anticipation requires a showing that a single prior art reference is “**identical in all material respects**” to the claimed invention. *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1461, 43 USPQ2d 1887, 1890(Fed. Cir. 1997).

“**All material respects**” are all respects that matter to an ordinary observer.



# Requirements for Patentability

## *U.S. Design Patents*

### Anticipation

**Not New:**

**New**

Original

Ornamental

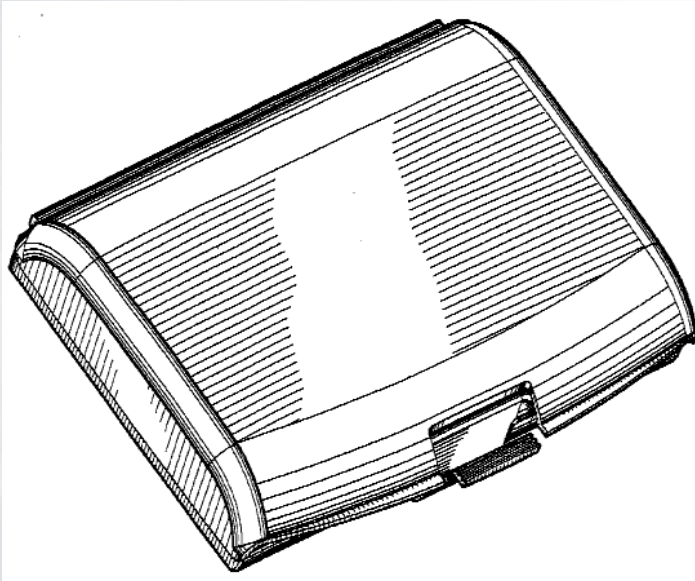
Article

Non Obvious

Enabled

Described

Definite



35 U.S.C. § 102



## Requirements for Patentability

# *U.S. Design Patents*

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

### The Statute:

## 35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

(a) A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the **claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art** to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. § 103

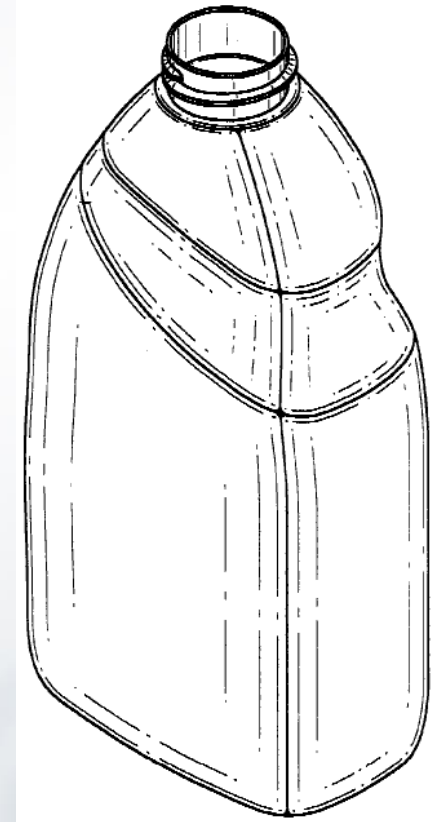
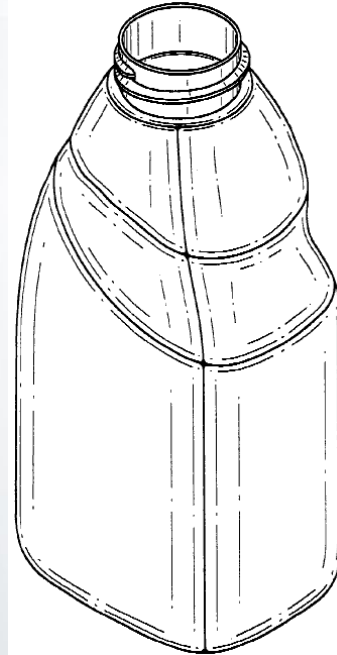
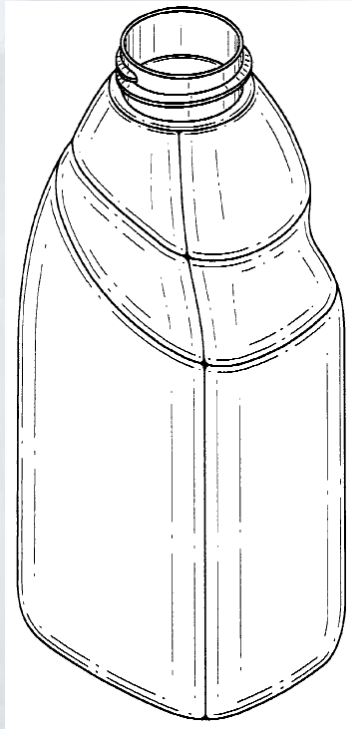


# Requirements for Patentability

## *U.S. Design Patents*

### Obvious:

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



35 U.S.C. § 103



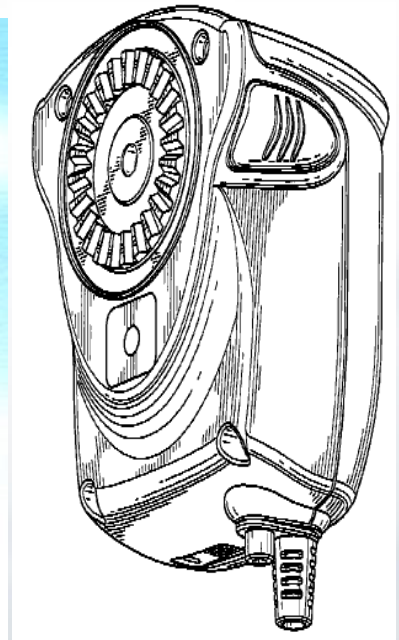
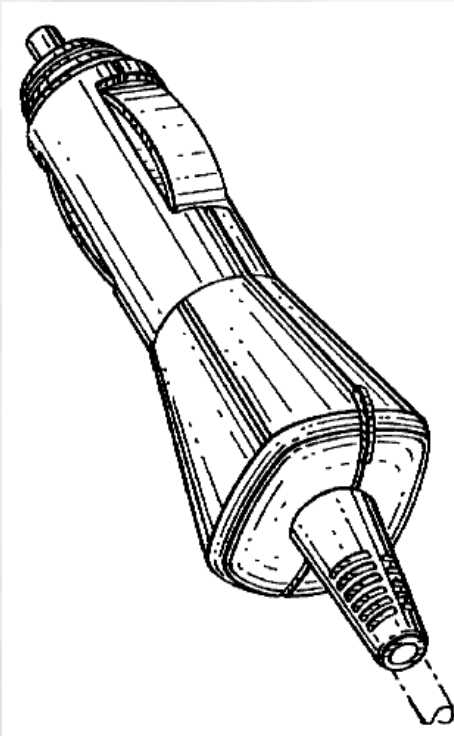
# Requirements for Patentability

## *U.S. Design Patents*

**Obvious:**

Prior Art References

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



35 U.S.C. § 103





## 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. In General

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

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)



# Requirements for Patentability

## *U.S. Design Patents*

### Enablement

What may be claimed is limited to what is shown in the application drawings.

*In re Mann*, USPQ2d 2030 (Fed. Cir. 1988)

The scope of a design claim may be anything that is enabled in the disclosure.

One may not rely on anything beyond that which is disclosed in the specification for enablement of a design.

35 U.S.C. § 112(a)

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



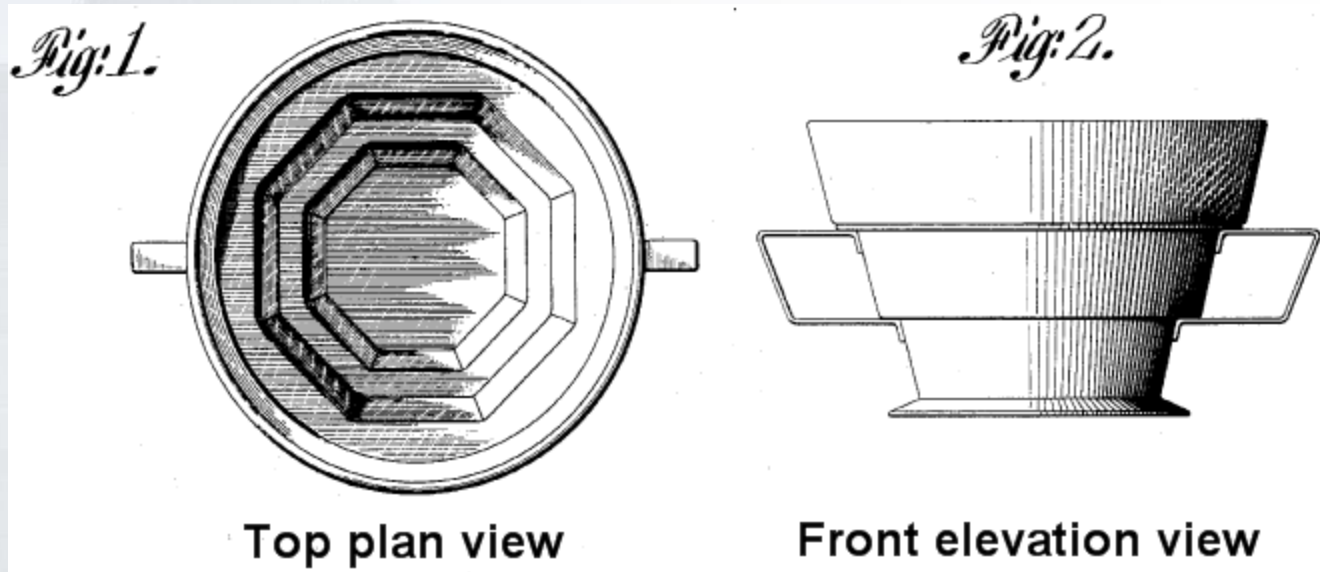
# Requirements for Patentability

## *U.S. Design Patents*

### Enablement

**Not enabled:**

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



35 U.S.C. § 112 (a)



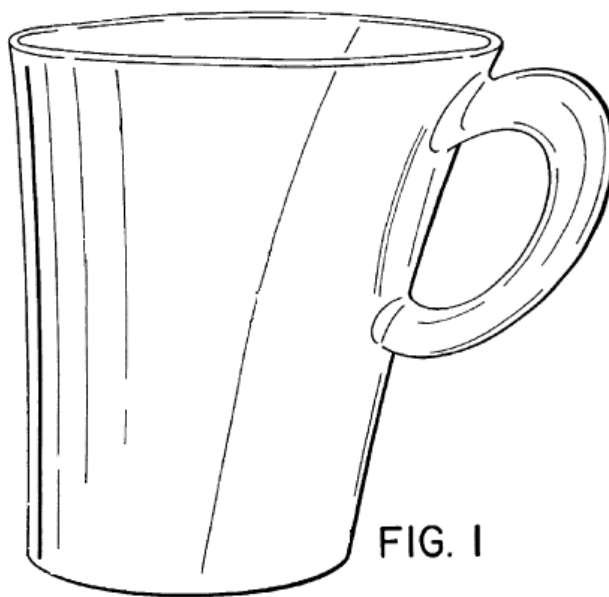
# Requirements for Patentability

## *U.S. Design Patents*

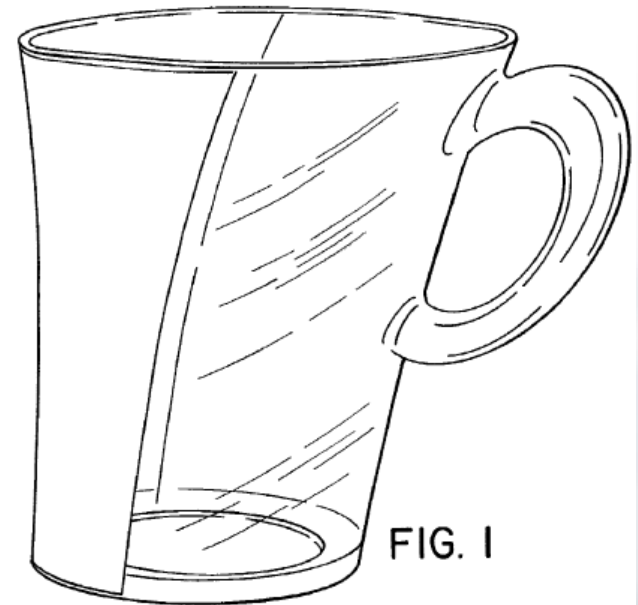
### Described

**Has not met the description requirement:**

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



**Originally Filed**



**Amendment  
(now claimed)**

35 U.S.C. § 112(a)



## Requirements for Patentability

# *U.S. Design Patents*

### **The Statute:**

## **35 U.S.C. 112(b) Specification. Conclusion**

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

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

35 U.S.C. § 112(b)



# Requirements for Patentability

## *U.S. Design Patents*

### Definite

New  
Original  
Ornamental  
Article  
Non Obvious  
Enabled  
Described  
**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

35 U.S.C. § 112(b)



# 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**

35 U.S.C. § 112(b)





# Requirements for Patentability

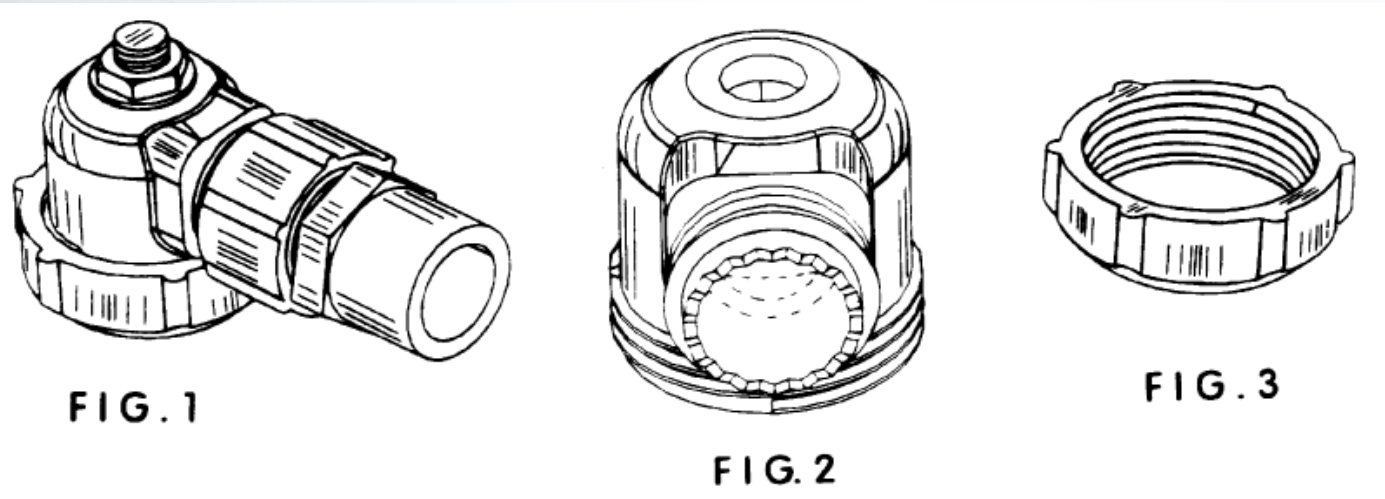
## *U.S. Design Patents*

**Definite**

**Not Definite:**

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

Condensate flow shut-off switch



35 U.S.C. § 112(b)

# International Registrations with Multiple Designs



*What to Expect with Respect to  
Designation of the United States*



# Apps with Multiple Designs

- Restriction Requirements by the Examiner
  - When will the examiner issue a restriction?
  - When will the examiner allow two or more designs to remain in the same application/U.S. design patent?
  - What are your options in response?
- Pursuing designs in the IR that were cancelled from the “parent” application
  - Filing continuation/divisional applications
  - Effect of not pursuing designs that were cancelled in a continuation/divisional application



# Why Apps with Multiple Designs Are Restricted?

## 35 USC § 121:

“If two or more independent and distinct inventions are claimed in one application, the [USPTO] Director may require the application to be restricted to one of the inventions.”

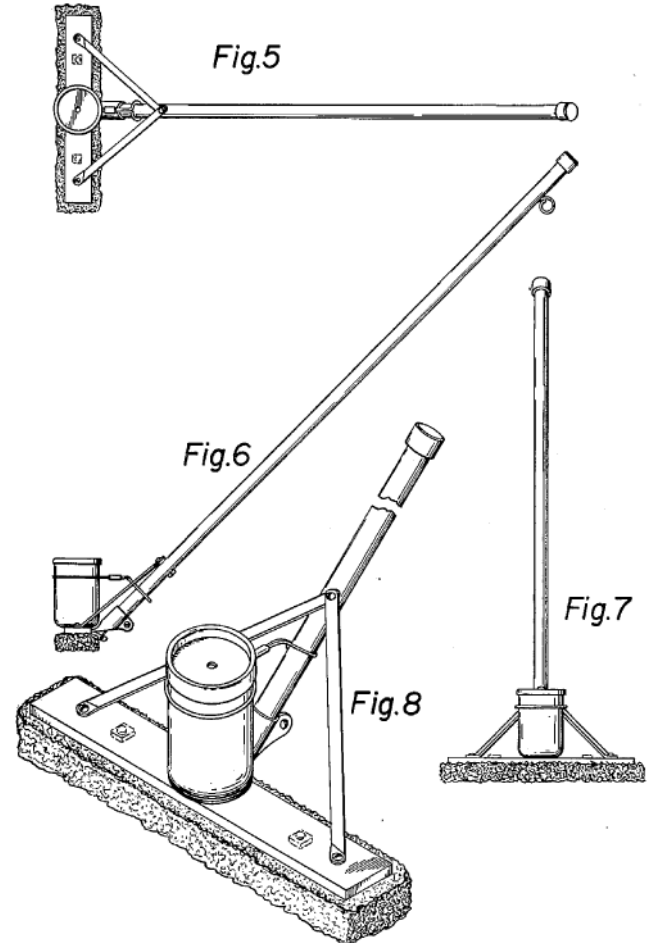
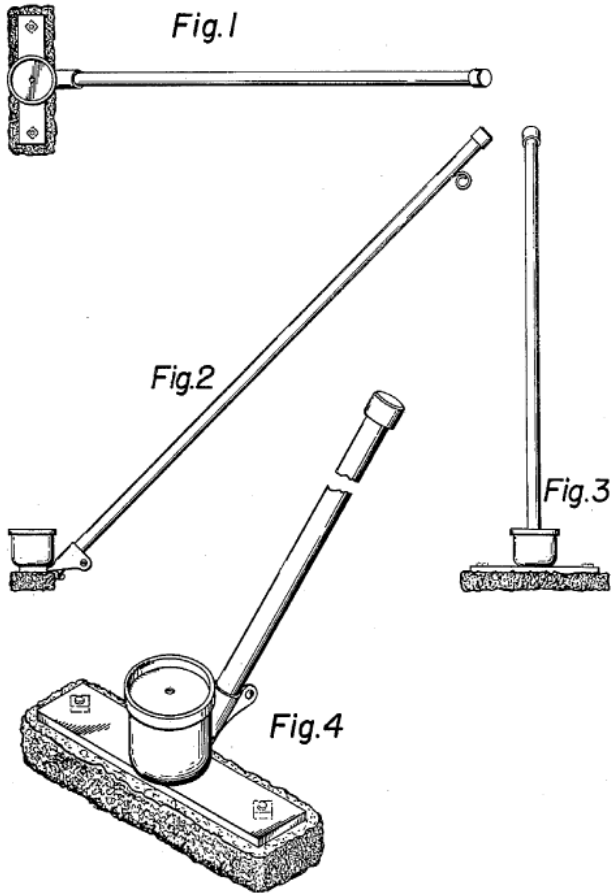


# Why Apps with Multiple Designs Are Restricted?

- In utility applications, the decision to restrict an application to one invention is at the discretion of the examiner.
- Not so in designs.
- The single claim requirement of design patents make restriction of independent and distinct inventions mandatory not discretionary in the area of designs.
  - See *In re Rubinfeld*, 123 USPQ 210 (CCPA 1959)



# *In re Rubinfeld (CCPA 1959)*





# *In re Rubinfeld (CCPA 1959)*

- Addressed the issue of multiple claims in a design patent.
- Concluded that the single-claim requirement of 37 CFR § 1.153 should be preserved.
- Held that a single claim may include more than one embodiment of a design as long as the embodiments are **not patentably different (distinct)** from one another or, in other words, as long as they involve a single inventive concept.



# Restriction Determination

- **Obviousness-type double patenting** standard is used to determine whether or not to require restriction. So....
  - A design claim may include *only one inventive concept*.
  - An inventive concept in a design application may only include variations of a design that are patentably the same or obvious variations of one another. (*patentably indistinct variations*)
  - When patentably distinct variations or groups of variations are present, applicant *must elect one and cancel the rest*.





# Restriction Determination?

- Three step process:
  - **Step #1:** Do the two designs have design characteristics that are basically the same?
    - i.e., Are the visual features that drive the overall appearances of the design basically the same?
  - If **NO** → Restriction
  - If **YES** → Go to #2



# Restriction Determination?

- Three step process:
  - **Step #2:** Are the differences between the two designs minor (de minimis) relative to the overall appearance?
    - If **YES** → No restriction
    - If **NO** → Go to #3



# Restriction Determination?

- Three step process:
  - **Step #3:** Are the differences found in the prior art?
    - If **NO** → Restriction
    - If **YES** → No restriction.



# Restriction Requirement

- This decision on whether or not to require a restriction should be determined by the Examiner prior to or coincident with the first action on the merits.
- An applicant can respond to “traverse” (overcome) a restriction requirement by responding to the restriction requirement and arguing why a restriction is improper.
- Note: Any arguments will be part of the prosecution history.



# Hypotheticals - Restriction?



**Design 1**



**Design 2**



**Design 3**



# Hypotheticals - Restriction?



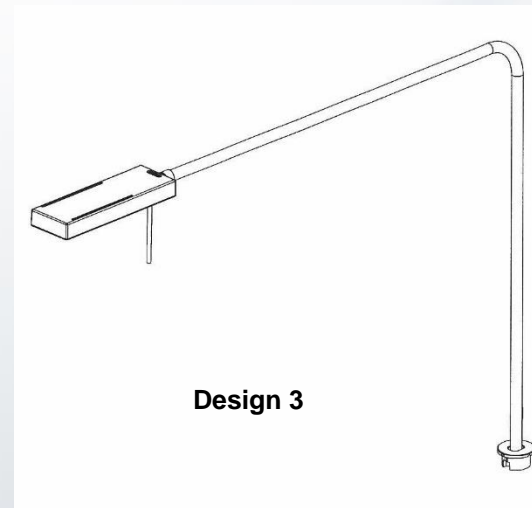
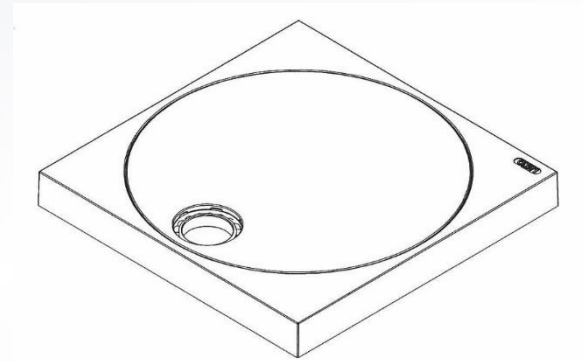
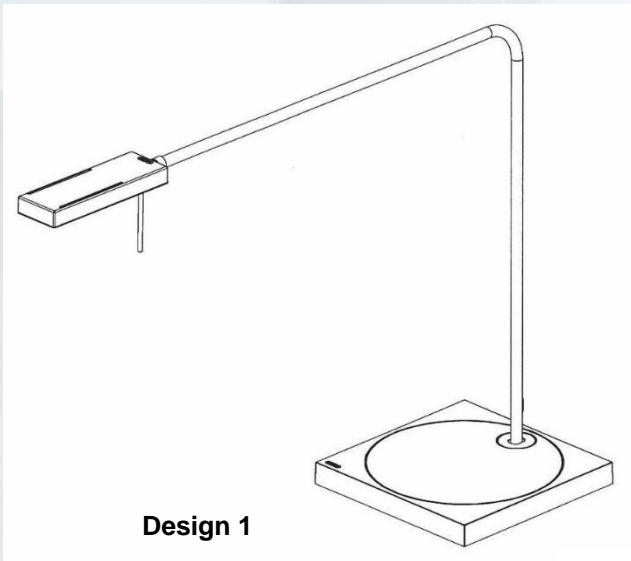
**Design 1**



**Design 3**



# Hypotheticals - Restriction?

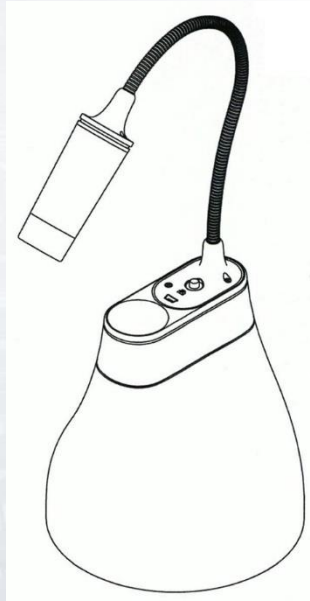




# Hypotheticals - Restriction?



Design 1



Design 2



Design 3





# Hypotheticals - Restriction?



**Design no. 1**



**Design no. 2**



# Cancelled Subject Matter?

- If the applicant cancels subject matter (e.g., designs or figures) from the application (e.g., to overcome a restriction) they can pursue the cancelled subject matter in a “divisional” or “continuation” application.
- A further application can be filed **either** directly with the USPTO (a domestic application) **or** as another **Hague application** that designates the United States and claim benefit of the earlier filing date. (*domestic priority*)



# Potential Pitfalls

## **WARNING! WARNING! WARNING!**

- In order to receive the benefit of the earlier filed case's filing date, the applications must maintain a chain of *copendency* among other things.
- Three General Continuities Needed.....
  - Continuity of ***Prosecution***
  - Continuity of ***Disclosure***
  - Continuity of ***Inventorship***



# Potential Pitfalls

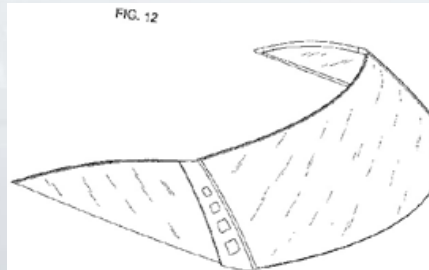
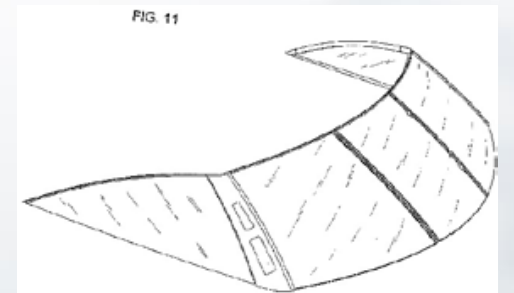
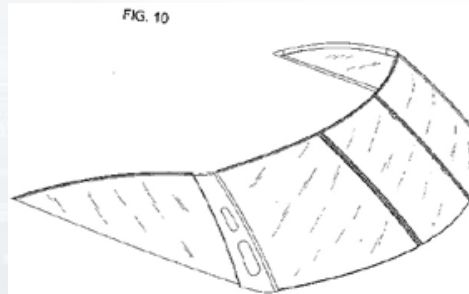
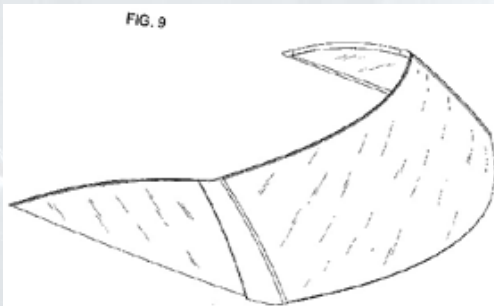
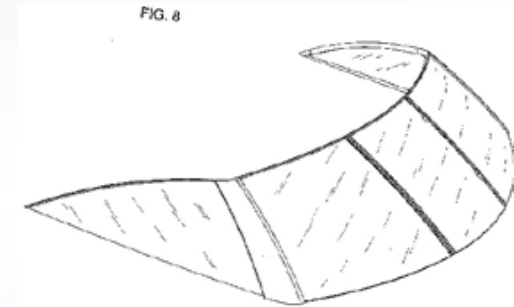
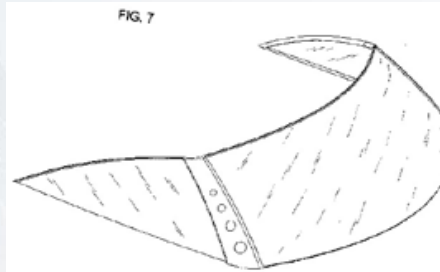
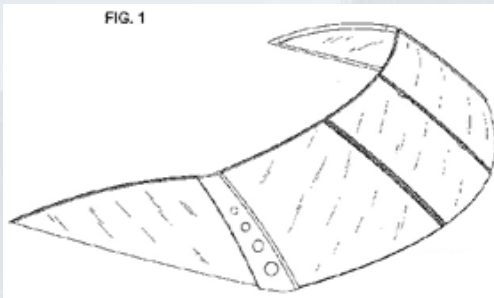
## **WARNING! WARNING! WARNING!**

- If you cancel subject matter in a design application (even if in response to a restriction) and you do not pursue that subject matter to a later patent, you may have “**dedicated it to the public.**”
- *Pacific Coast Marine Windshields v. Malibu Boats, LLC.*



# Pacific Coast Marine's Lesson

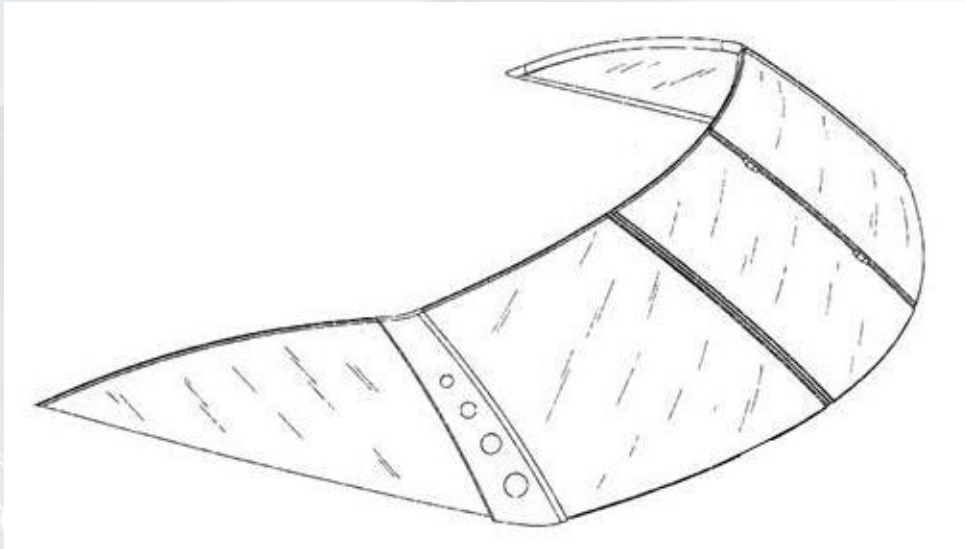
## US Des Pat. 555,070 – Embodiments Originally Filed





# *Pacific Coast Marine's Lesson*

**US Des Pat. 555,070**



**Accused Design**



**Don't let your design protection sink!**



# Potential Pitfalls - Drawings

## **Areas Where More Attention to Figures May Be Warranted ....**

- Complex Designs
- Depressions, Protrusions
- Protecting Sets of Items
- Graphical User Interfaces and Icons
- Designs Claiming Color
- Multiple Design Applications
- Transparent/Translucent

# Questions?????



David R. Gerk  
Patent Attorney  
Office of Policy and International Affairs  
U.S. Patent and Trademark Office