

The Hague System: Going Global

Designating Japan, the Republic of Korea and the
United States of America

- Tips to Maximize your Chances to be Granted
Protection

Designating Japan, the Republic of Korea and the United States of America

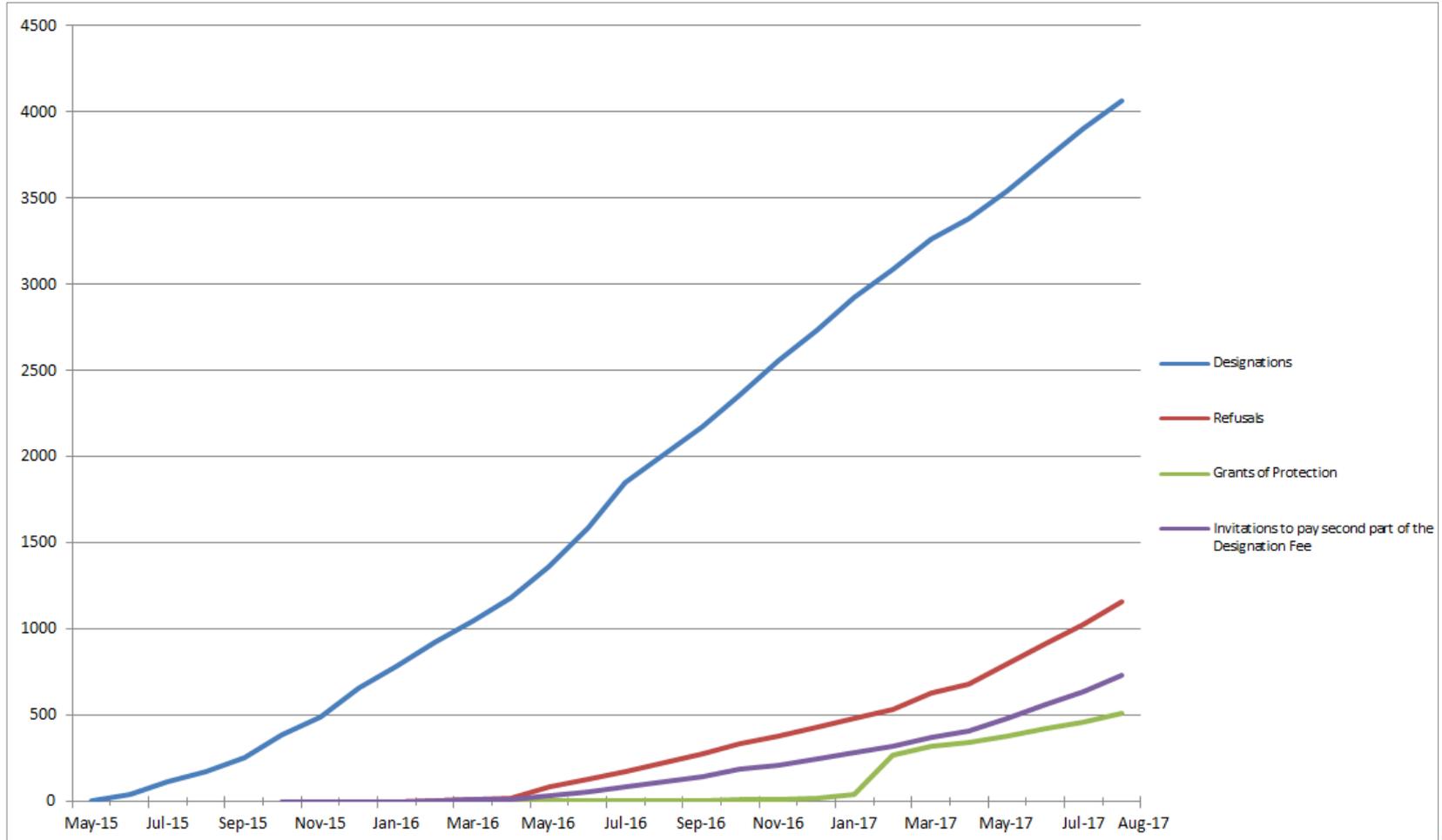
- «Examining jurisdictions» under the Hague System:
 - Some declarations may only be made by a CP with an Examining Office (Art.1(xvii) of the 1999 Act);
 - Specific elements required by USPTO, JPO and KIPO

Contents:

- *Designations and Decisions by JPO, KIPO and USPTO;*
- *Multiple International Registrations vs. Requirement of Unity of Design;*
- *Designating the United States of America: it is easy but must be done with care!*
- *Issues Common to Japan and the Republic of Korea;*
- *WIPO's reaction to help users;*
- *Strategic considerations & Success Stories*

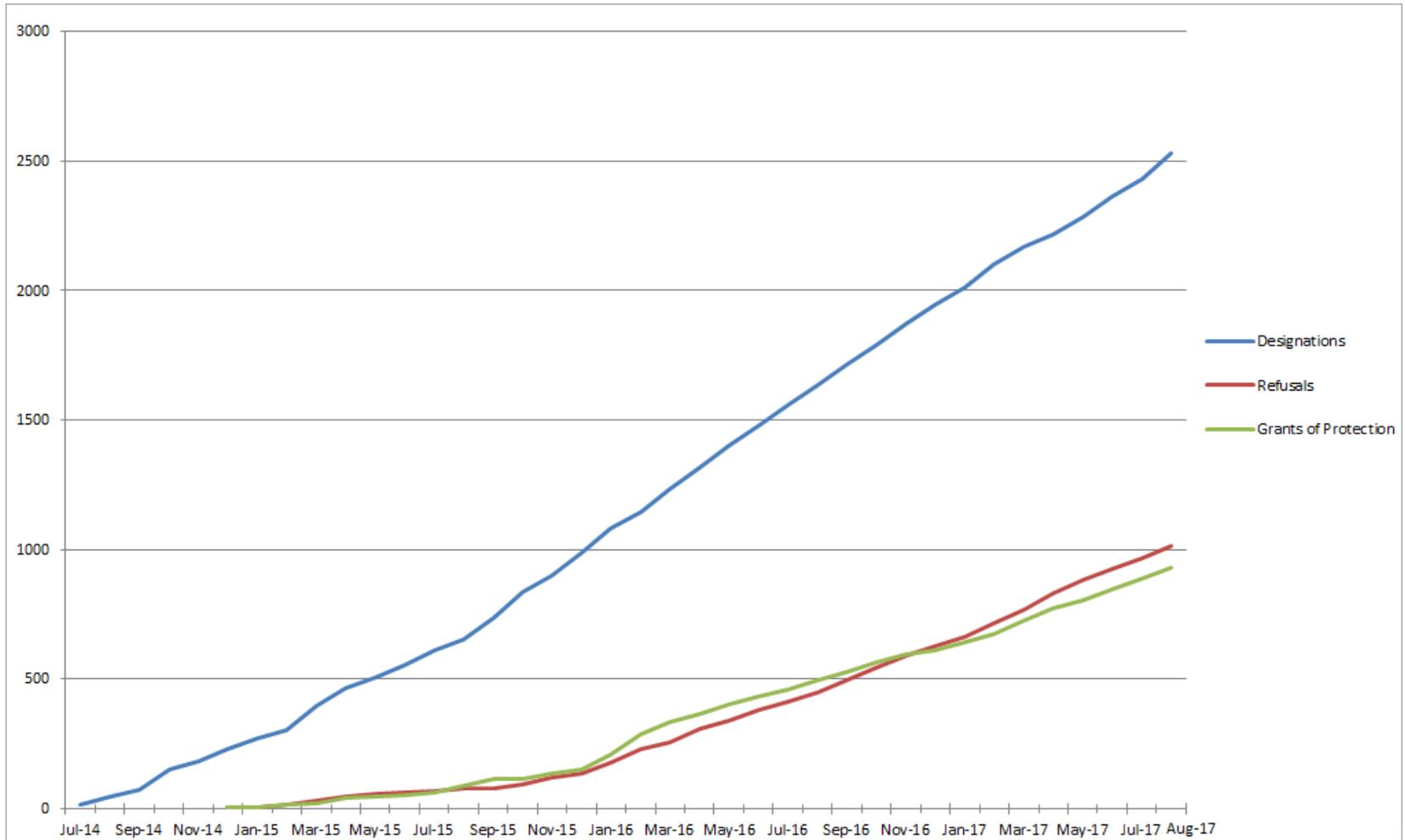
United States of America : Designations and Decisions

(Figures from Day 1 to August 31, 2017 – Source: Internal (unofficial) statistics)



RoK : Designations and Decisions

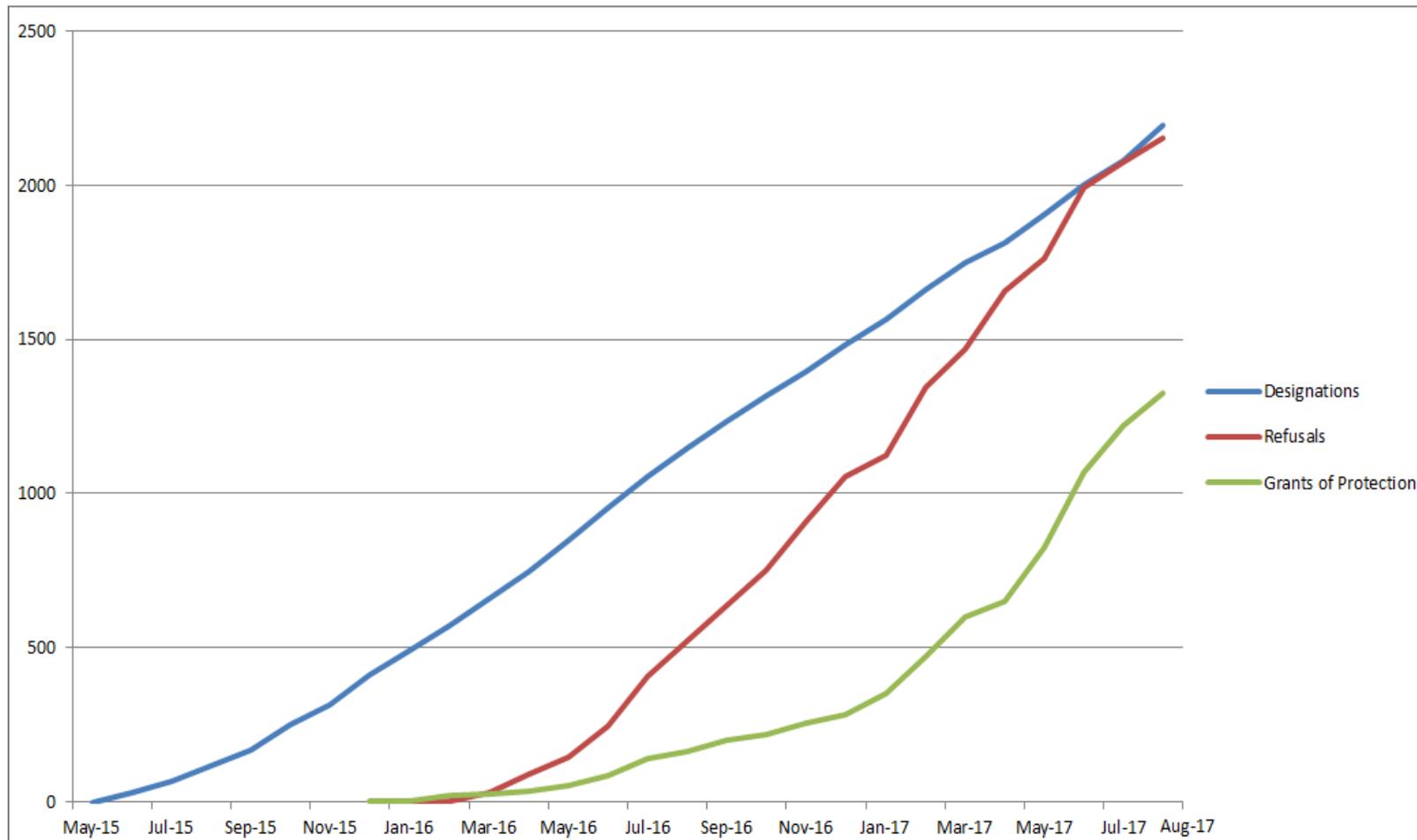
(Figures from Day 1 to August 31, 2017 – Source: Internal (unofficial) statistics)



Japan :

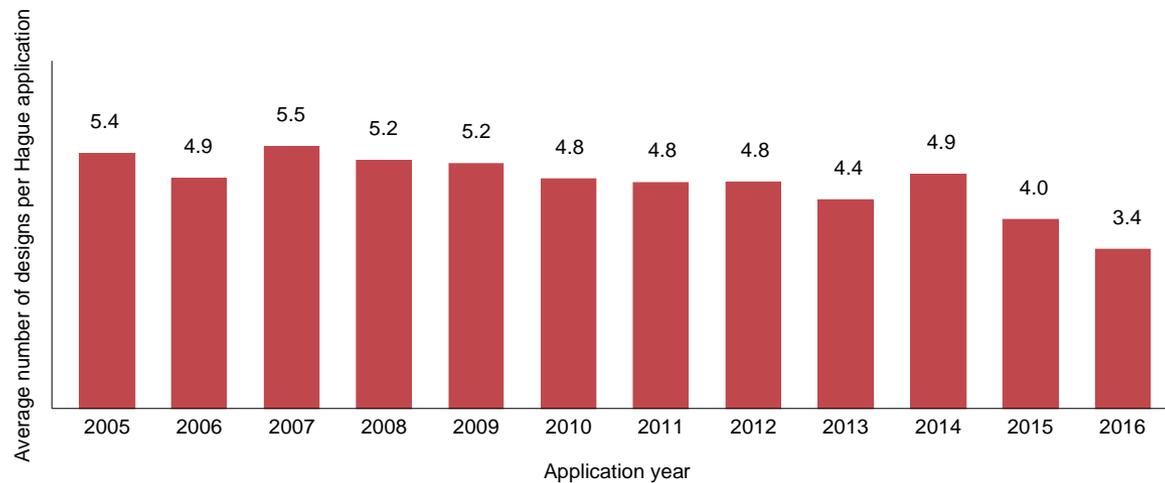
Designations and Decisions

(Figures from Day 1 to August 31, 2017 – Source: Internal (unofficial) statistics)



NOTE: JPO issues a separate NoR or SGP for each design contained in an IR (multiple designs).

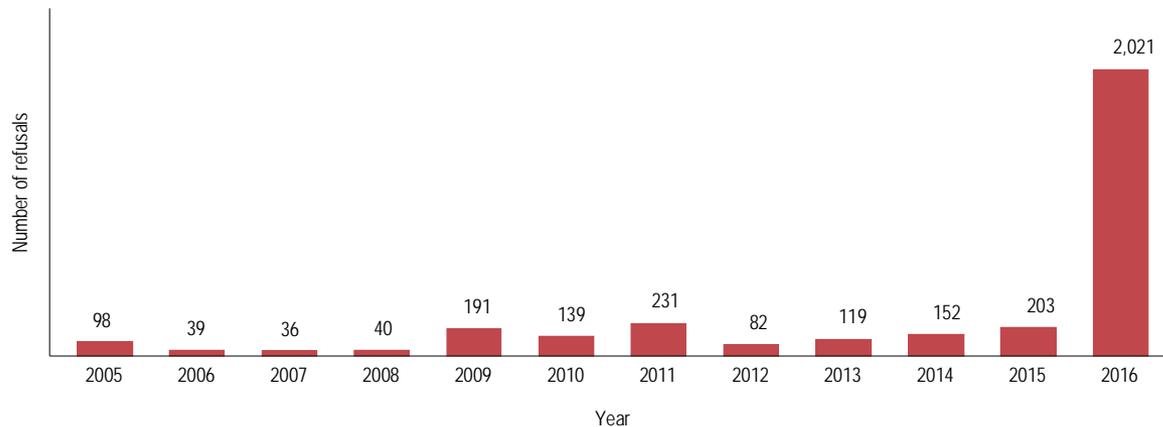
The average number of designs per Hague international application continues to decline



■ Source: WIPO Statistics Database, May 2017

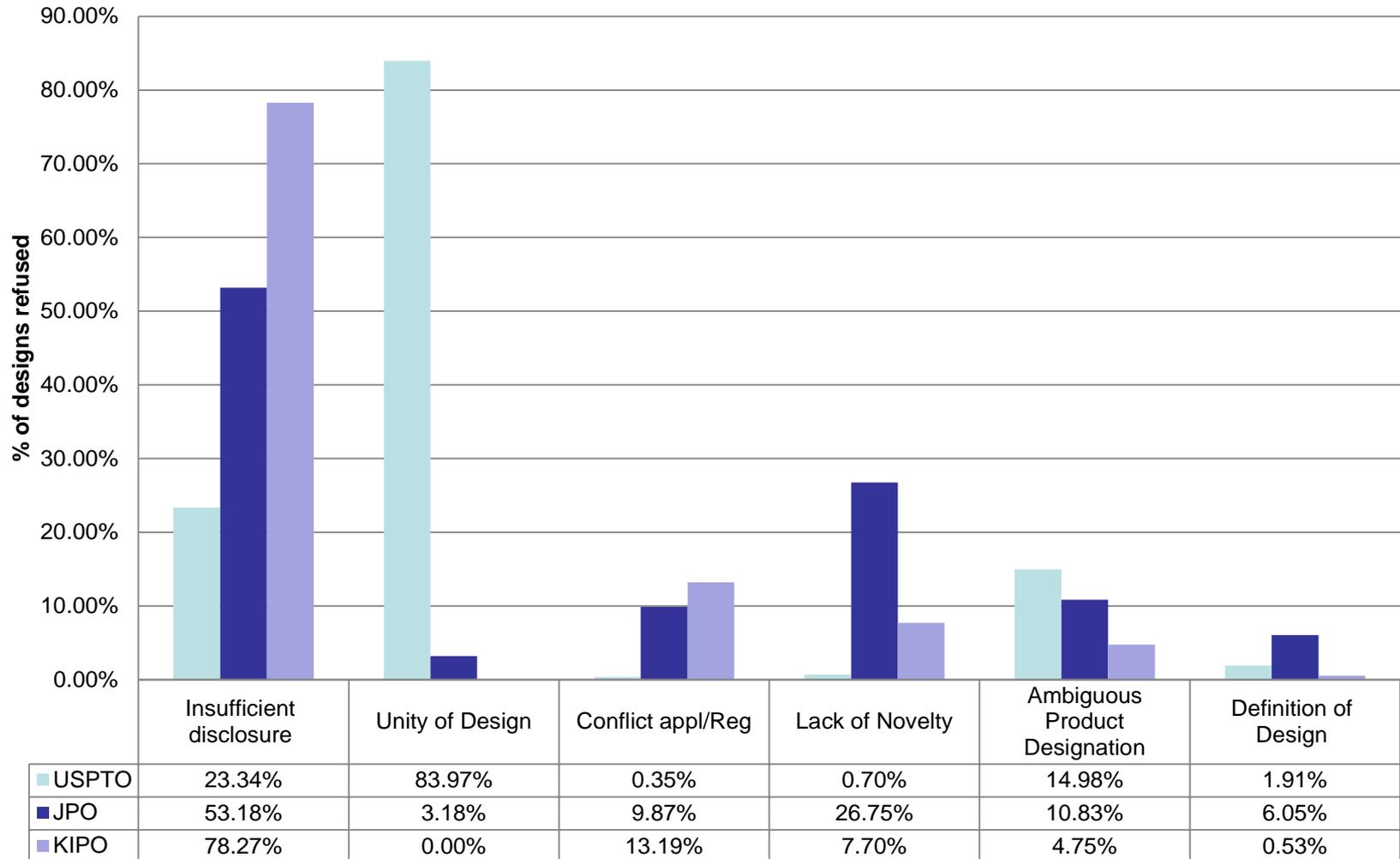
Refusals issued by Examining Offices

- The number of refusals increased substantially in 2016 due to a large number of refusals by three recent Hague members: Japan, the Republic of Korea and the US.
- In 2017, by the end of September, the number of refusals received is 2,520



USPTO, JPO & KIPO Refusal Grounds as Percentage of Designs Refused

Representative sample of all refusals received



Note: USPTO: Refusals recorded from 16.02.2016 to 29.08.2017

JPO: Refusals recorded from 18.04.2016 to 28.08.2017

KIPO: Refusals recorded from 18.02.2015 to 28.08.2017

Grounds of Refusals by USPTO against all Filings

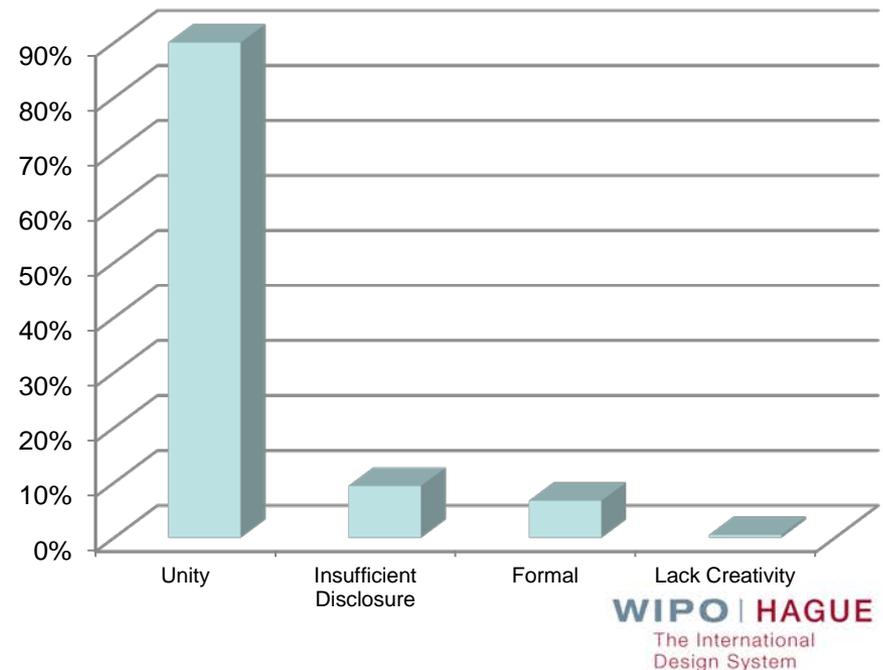
■ Total number of designs in IR's from US designating US: 9072

- Designs in IR designating US up to 06 September 2017
- The Refusal Grounds analyzed represent a representative sample of all the refusals received from USPTO

■ The sample contains 3228 (%) Designs with 4338 Refusal Grounds

■ Primary Refusal Grounds

1. Unity of Design
 - 2512 Designs (77.82%)
2. Insufficient Disclosure
 - 771 Designs (23.88%)
3. Formal (Objections to specification, legend, format, title, description)
 - 735 Designs (22.77%)
4. Lack of Creativity
 - 105 Design (3.25%)



Source: Internal (unofficial) statistics

Grounds of Refusals by JPO against all Filings

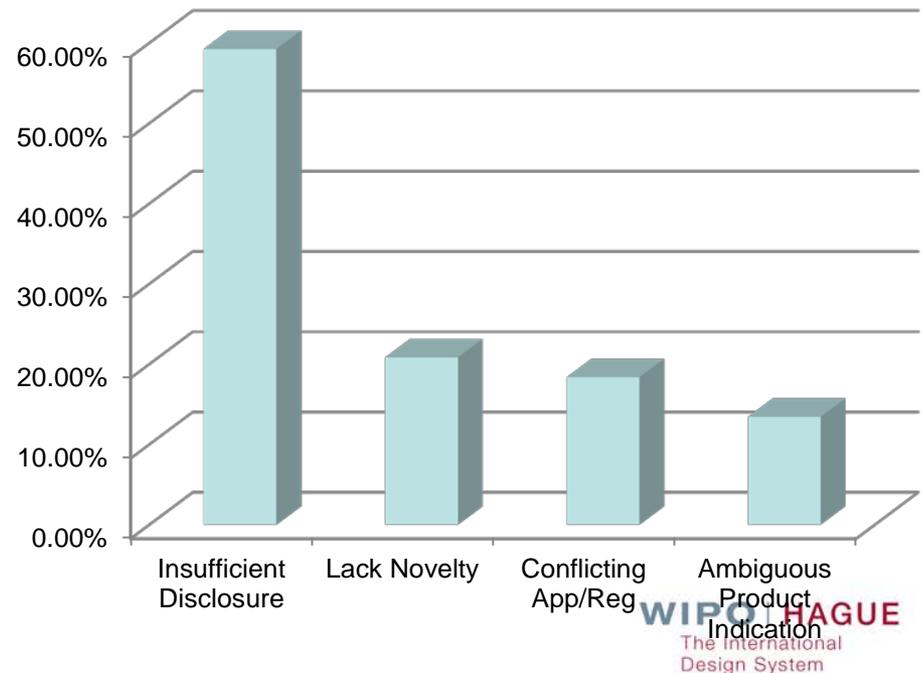
■ Total number of designs in IR's designating JP: 4668

- Designs in IR designating JP up to 06 September 2017
- The Refusal Grounds analyzed represent a representative sample of all the refusals received from JPO

■ The sample contains 2106 (%) Designs with 2697 Refusal Grounds

■ Primary Refusal Grounds

1. Insufficient Disclosure
 - 1248 Designs (59.26%)
2. Lack of Novelty
 - 439 Designs (20.85%)
3. Conflict App/Reg
 - 387 Designs (18.38%)
4. Ambiguous Product Indication
 - 283 Designs (13.44%)



Source: Internal (unofficial) statistics

Grounds of Refusals by KIPO against all Filings

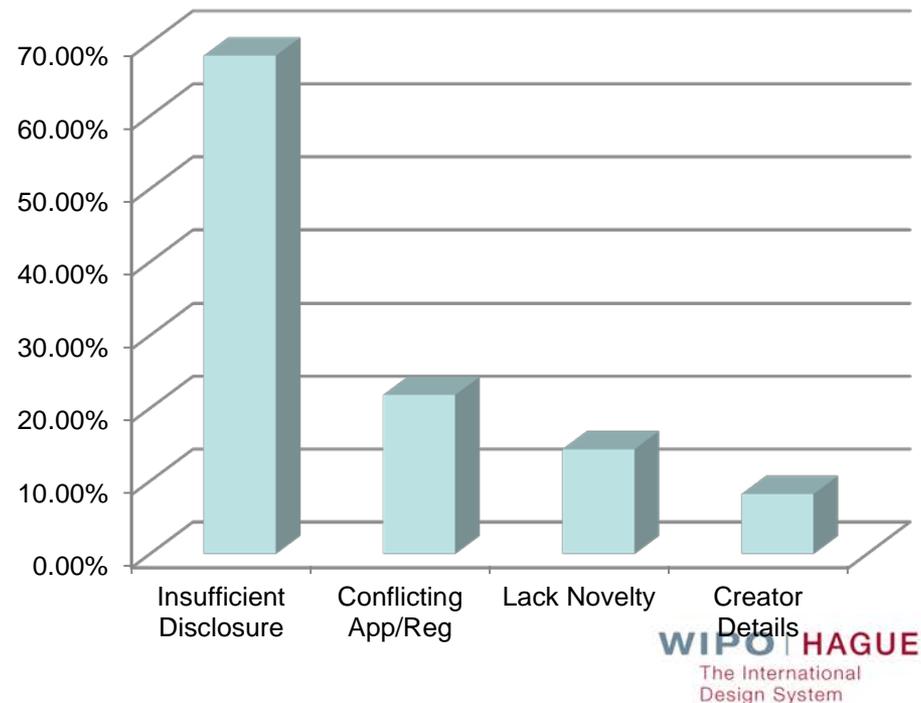
■ Total number of designs in IR's designating KR: 7199

- Designs in IR designating KR up to 05 September 2017
- The Refusal Grounds analyzed represent a representative sample of all the refusals received from KIPO

■ The sample contains 2861 (%) Designs with 3811 Refusal Grounds

■ Primary Refusal Grounds

1. Insufficient Disclosure
 - 1952 Designs (68.23%)
2. Conflict App/Reg (Related Designs)
 - 624 Designs (21.81%)
3. Lack of Novelty
 - 411 Designs (14.37%)
4. Creator Details
 - 235 Designs (8.21%)



Source: Internal (unofficial) statistics

Multiple International Registrations vs. Requirement of Unity of Design

- Unity of design under the Hague System:
 - Up to 100 industrial designs per international application.
 - If more than one design is included in the international application, all the designs must belong to the same class of the Locarno Classification.

- Korean Intellectual Property Office (KIPO)
 - No declaration under Article 13(1) of the 1999 Act (unity of design)

Multiple International Registrations vs. Requirement of Unity of Design

- United States Patent and Trademark Office (USPTO): Declaration under Article 13(1) of the 1999 Act (unity of design)
 - Only one independent and distinct design may be claimed in a single application (= one inventive step).
 - Where multiple designs are contained in an international registration:
 - USPTO will issue a refusal on the ground of requirement of unity of design under its national law (together with substantive grounds, if any), and
 - request the restriction of the international registration to one group of patentably indistinct designs; for the other designs the holder may file divisional applications

USPTO: NoR on the ground of lack of Unity of Design

- Indistinct designs or obvious variations:

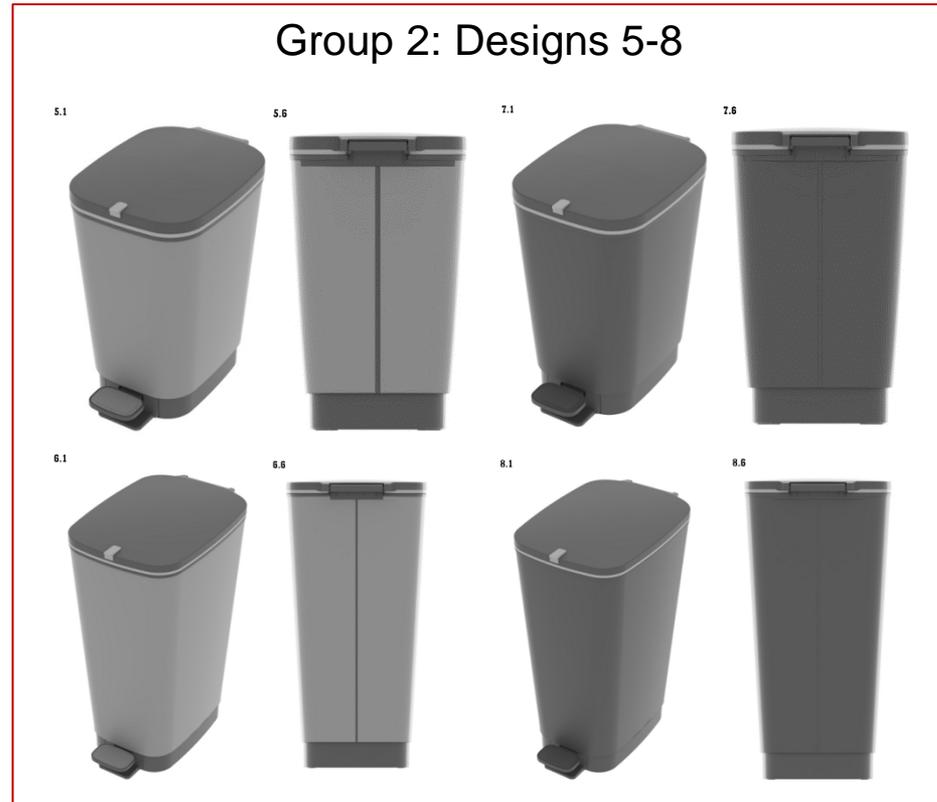
DM/087960: ABM ITALIA S.P.A;

Designs 1-8 “Storage Boxes”



USPTO: Unity of Design requirement

- Indistinct designs or obvious variations:



Designs grouped together have the same basic design characteristics:

- similar in overall appearance
- similar in visual impression
- similar in shape/ configuration

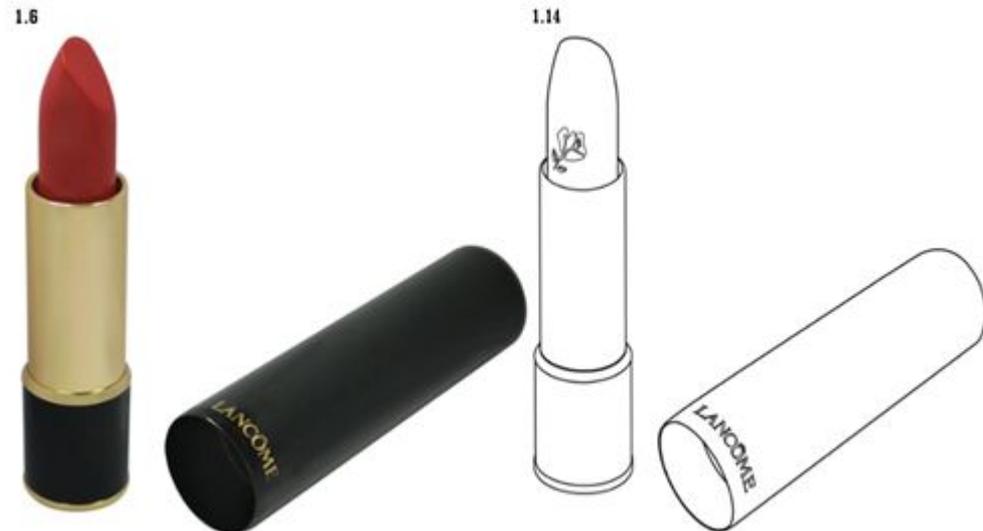
Multiple International Registrations vs. Requirement of Unity of Design

- Japan Patent Office (JPO): Declaration under Article 13(1) of the 1999 Act (unity of design)
 - Article 7 of the Design Act of Japan, which requires that only one independent and distinct design may be included in a single application is applied only to national applications;
 - JPO divides the IR internally, and issues separate SGPs or NoRs for each design (on substantive grounds, if any).

DM/088200: Notification of refusal on the ground of lack of unity of design by JPO

- Design No. 1 includes two or more designs judged by the national examination standard, JPO issued a NoR on the ground of lack of unity of design.
- In such a case, if the holder deletes either of them, protection can be granted to the amended design. At the same time, the holder may file divisional national application(s) for the deleted design(s), keeping the filing date.
- SGP following refusal issue by the JPO (for the amended design)

LANCÔME PARFUMS ET BEAUTE & CIE
PARIS (FR)



Designating the United States of America: it is easy but must be done with care!

■ Article 5(2)(a) of the 1999 Act

- CLAIM: The ornamental design for as shown and described.
- “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.”

- Examples:

The ornamental design for a motor car as shown and described.

OR

The ornamental design for a rear door panel for vehicles as shown and described.

NOTE: products in the same class (here: in class 12) may be included in an international registration but only ONE claim for only ONE product.

Designating the United States of America: it is easy but must be done with care!

- Article 7(2) of the 1999 Act and Rule 12(3) of the Common Regulations
 - Individual designation fee to be paid in two parts: the first part to be paid at the time of filing of the international application and the second part to be paid upon its allowance.
 - Upon receipt of the notice of allowance through the International Bureau the second part of the individual designation fee may be paid either directly to the USPTO (in US dollars) or through the IB (in Swiss francs).
 - NOTE: Where the second part of the fee is paid through the International Bureau, the payment must be received by the IB by the due date (for example, if paid through a bank transfer, the correct amount must be on the WIPO's bank account by the due date).
 - Following receipt of the payment of the second part of the fee, **USPTO** will issue grant of the patent.

Designating the United States of America: it is easy but must be done with care!

- Amount of the individual designation fee:
 - Reductions for small entity applicants and micro-entity applicants
 - If the applicant claims **micro entity status**, the certification form is mandatory.
 - Certification form ([PTO/SB/15A](#) or [PTO/SB/15B](#)), along with the instructions for its completion and signature, is available on the United States Patent and Trademark Office web site:
http://www.uspto.gov/forms/aia_forms.jsp.

- NOTE: Individual designation fee for the US is for one design (or a group of patentably indistinct designs)
 - In the case of a multiple international registration, following restriction of the designation of the US in the IR to one design (or a group of patentably indistinct designs), fees to be paid to the USPTO when filing divisional applications for the remaining designs.

Designating the United States of America; it is easy but must be done with care!

- Declaration under Rule 8(1) of the Common Regulations: Identity of the creator and an oath/declaration by the creator is mandatory.
- Standard text for an Oath or Declaration is contained in Annex I to Form DM/1 and the E-Filing interface.
- If there are several creators, each of them shall sign the Oath or Declaration.
- The Oath or Declaration for each creator may be attached as a .pdf file, or be filled in directly on the website during the E-filing process.
- The standard USPTO form of an Oath/Declaration of Inventorship can also be found in different languages at the following addresses:
http://www.uspto.gov/sites/default/files/forms/aia_oathdecl_guide.pdf and
<http://www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012>.

Designating the United States of America; it is easy but must be done with care!

- Article 11(1)(b) of the 1999 Act
 - No deferment of the publication of the international registration.

- Rule 18(1)(b) of the Common Regulations
 - Refusal period of 12 months from the date of publication of the IR in the International Designs Bulletin on the WIPO website.

- Duty of Candor
 - The *Information Disclosure Statement* forms (SB08a/SB08b/SB08a-EFS-web) are available on the USPTO web site: http://www.uspto.gov/forms/aia_forms.jsp.

Issues Common to Japan and the Republic of Korea

- Related design system;
- Product indication;
- Class 32;
- Prior divulgation;
- Submission of priority documents/other documents

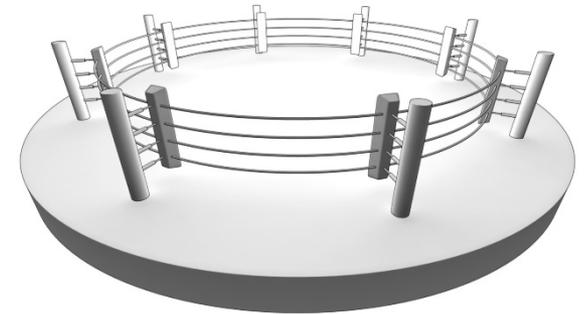
Multiple Embodiments? Related designs? Then, identify your 'principal' design

- 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.

Bear in Mind : Japan and Republic of Korea

- Be Specific in the product indication

- Sports installation (D089511)
 - Mixed martial arts ring



- Do not file for logos under class 32

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*.

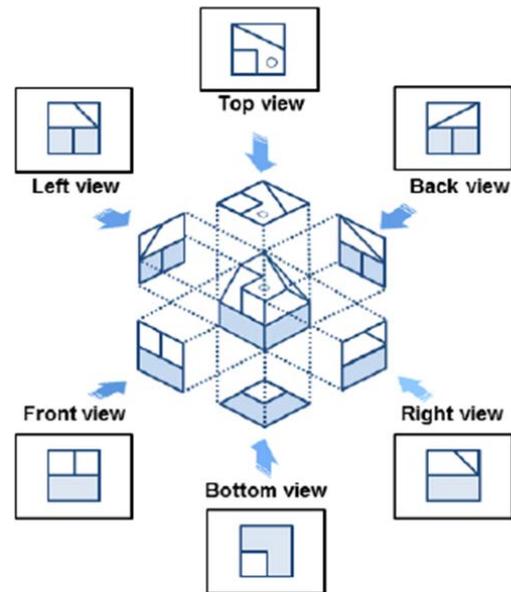
Submission of Priority documents to KIPO and JPO

- 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?*

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 (Declaration under Rule 9 (3))

KR, US: Six views are recommended, not mandatory

Tips!!!

- Always explain in the description the presence of shading or dotted lines when designating JP and KR;
- Always remember to provide a legend (using the legend feature of E-filing) when designating any of the three Examining offices.

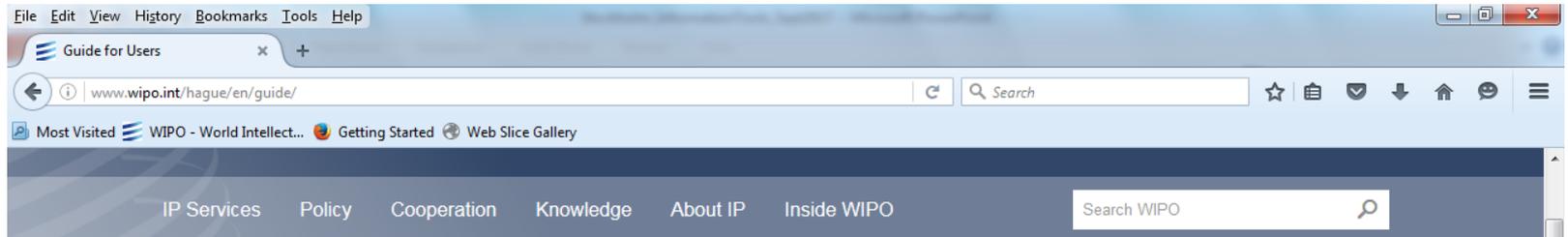
...as these tricks improve the clarity of the disclosure...

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



[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](#)

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)

How to file your application: Prepare reproductions

- Overview
- Entitlement
- Fees and payment
- Preparing reproductions**
- File
- After filing

The following instructions explain how to prepare your design (s) for electronic filing.

Terminology: A "design" refers to the subject matter for which protection is sought, and a "reproduction" refers to photographs or other graphic representations representing the design. A design may be represented by several reproductions showing different views of the design.

Legal requirements

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

These instructions help to ensure that your image files comply with the technical requirements under the Hague System. Moreover, they help to preserve the quality of the publication of your reproductions.

- ▶ [Summary of technical requirements for image files](#)
- ▶ [Providing quality image files](#)
- ▶ [What is the resolution \(or dpi\) of my image?](#)
- ▶ [How to keep proportions of your design consistent](#)
- ▶ [Borders between 1 and 20 pixels](#)

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.

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!*

Guidance on Preparing and Providing Reproductions

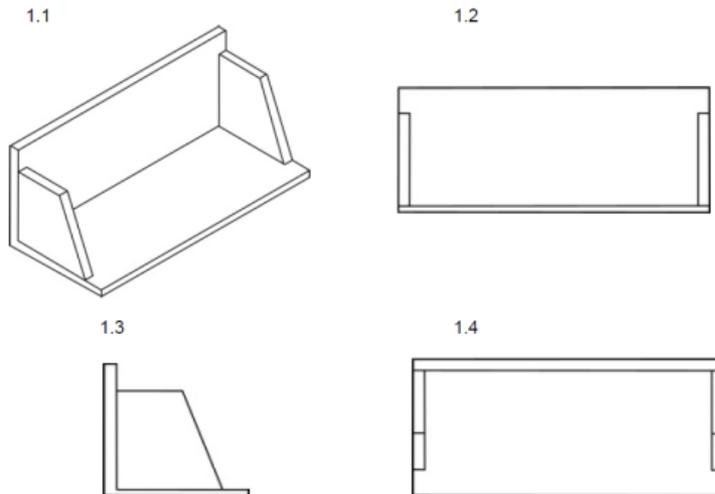
I. NOT ENOUGH VIEWS

Examining Offices may consider that the design has not been sufficiently disclosed if the whole configuration of the product in which the claimed design is embodied is not fully shown.

EXAMPLE OF POSSIBLE PROBLEMATIC PRACTICE

The following example involves a bookstand. Only a certain part of the product is shown in the reproductions without any explanation regarding the lack of some views.

Indication of the product: "Bookstand"



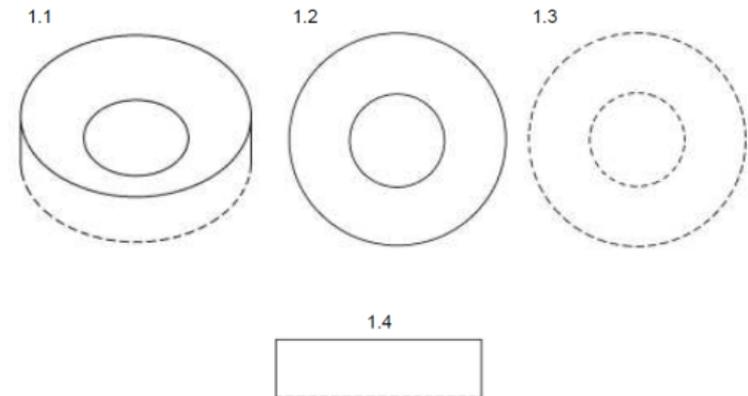
III. UNCLEAR RELIEF OR CONTOURS OF SURFACES OF A THREE-DIMENSIONAL PRODUCT

It may be considered by Examining Offices that the design has not been sufficiently disclosed if the scope of the claimed design has not been clearly defined with the submitted views in combination with any additional written description.

EXAMPLE OF POSSIBLE PROBLEMATIC PRACTICE

The contours of a three-dimensional product with curved surfaces have not been clearly shown in the representation since shading is not provided in the drawings.

Indication of the product: "Pharmaceutical tablet"



Legends

1.1) Perspective (front, top and right); 1.2) Top; 1.3) Bottom; 1.4) Front.

Description

The parts shown by means of broken lines in the reproductions are not part of the claimed design. The left side view, the right side view and the back view are omitted because they are identical with the front view, respectively.

Strategic Considerations Relating to Designation of

- the Republic of Korea,
- Japan,
- the United States of America and
- the European Union

in the SAME International Application

Remember: Refusals on Substantive Grounds only

- In particular, Offices cannot formally:
 - Oppose to color
 - Oppose to photographs or CADs
 - 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

Benefits for Design Owners

■ Simple

- a single electronic procedure
- a single filing Office

■ Savings

- low registration fees
- no need to pay foreign agents for filings

■ Effective

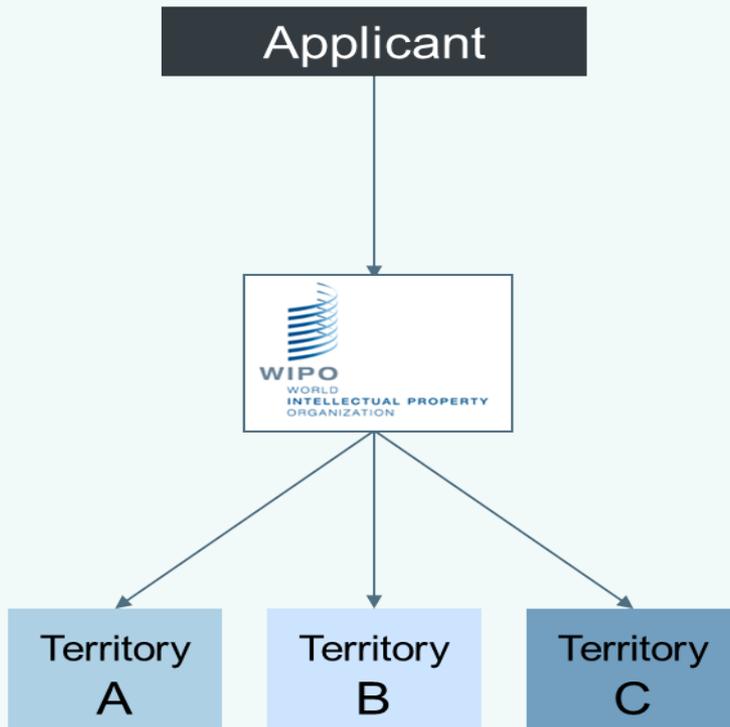
- a single application produces simultaneously the same legal effect in many countries
- a fixed deadline for confirmation or refusal
- a single, flexible title to manage

Using the Hague System to Get a Registered Community Design (RCD) :

- No differences in the legal effects
- Some practical advantages
 - all views and description published in the International Designs Bulletin
 - cheaper to maintain
- **More importantly:** one-stop shop
 - Neighboring States of the European Union no luxury
 - Major markets (Japan, Republic of Korea, United States of America, Russian Federation (coming), China (coming))
- **KR, EU, JP and US in the same application!!!**

The Benefits Remain Largely Intact

- Single application
- Clear deadlines
- Single registration to manage



A Change of Paradigm for Users...

- It is possible to be successful before all Offices
 - *Success stories start to abound*
- Hague Bonuses!
 - JP, KR, US: Provisional rights for Hague-filed designs!
 - JP: Multiple designs filed together are not refused

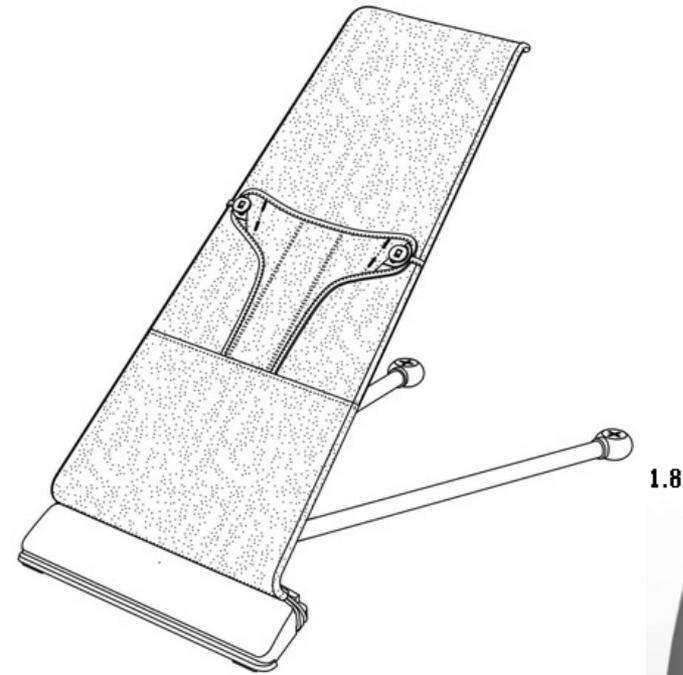
Success Stories: these cases accepted by all Offices !



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

Success Stories: these cases accepted by all Offices !

1.1



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

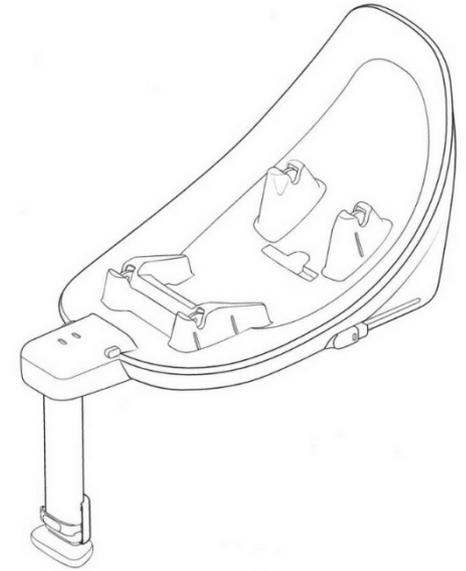
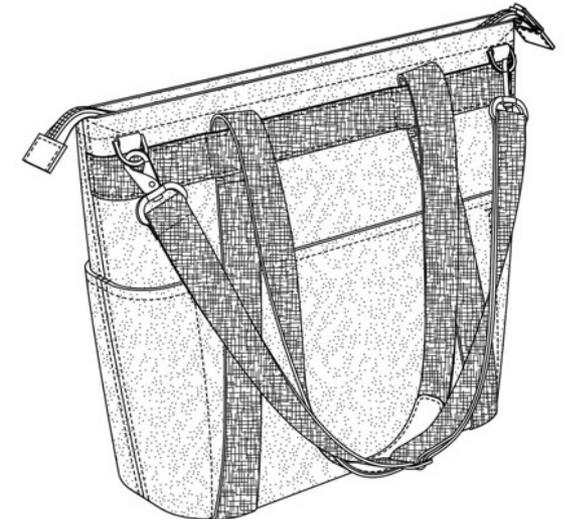
1.1



1.8



1.2



Thank you!

