

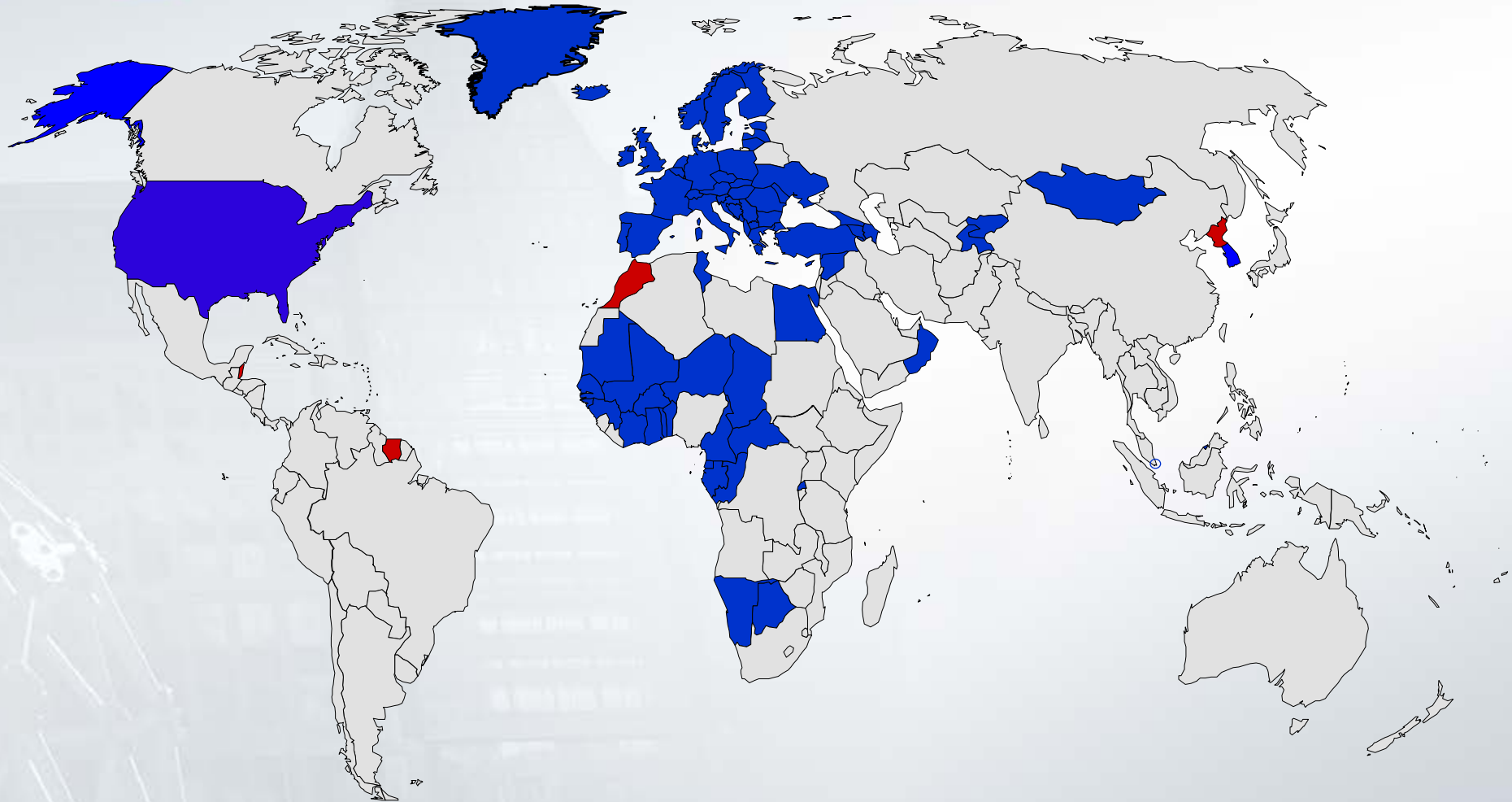
Expansion of the Hague System: Update on the United States and Related Considerations



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Office of Policy and International Affairs
United States Patent and Trademark Office
November 13, 2014



Hague Union – Near Future?



Hague System: The Road to U.S. Membership





Road to U.S. Membership

- **July 6, 1999** – United States signed Agreement
- **December 7, 2007** – The Senate considered; Advice and consent to ratification agreed to in Senate
- **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))
- **November 29, 2013** – Notice of Proposed Rulemaking Published in Federal Register



Notice of Proposed Rulemaking

- Notice of Proposed Rulemaking can be found in the Federal Register at:

<https://federalregister.gov/a/2013-28262>

- Comment Period Is Closed.



Current Work on the Road to U.S. Membership?

- US Government Inter-agency review of the final rules
- Complete information technology and processing preparation for membership
- Continued collaboration with WIPO to integrate systems, processing and operation



What's Left on the Road to U.S. Membership?

- Deposit of instrument of ratification with the IB
 - Note: Title I (Hague Provisions) of the Patent Law Treaties Implementation Act of 2012 (PLTIA) will take effect based off of the deposit of instrument of ratification.
- Publish final rules in the Federal Register
- Bring IT system modifications and updated application processing into operation.

Changes to U.S. Law: Patent Law Treaties Implementation Act of 2012 (PLTIA)





Changes to Title 35 of the U.S.C.

- Title 35 of the United States Code (U.S.C.) is amended to provide for “**international design applications**” (**IDAs**) and treatment / examination of these IDAs.
- Chapter 38 entitled, *International Design Applications*, is added to the Title 35 of the United States Code.
 - Adds new sections 381-390 to the U.S.C.
 - Effective date: “the date of entry into force of the treaty with respect to the United States.”



35 U.S.C. §§ 381-390 (PLTIA)

- **35 U.S.C. §§ 381- 390:**

§ 381: *Definitions*

§ 382: *Filing international design applications (IDAs)*

§ 383: *International design application*

§ 384: *Filing date*

§ 385: *Effect of international design application*

§ 386: *Right of priority*

§ 387: *Relief from prescribed time limits*

§ 388: *Withdrawn or abandoned international design applications*

§ 389: *Examination of international design applications*

§ 390: *Publication of international design applications*



Proposed Changes to Regulations (37 CFR)

- Notice of Proposed Rulemaking published
 - 78 Fed. Reg. 71870 (November 29, 2013)
- Implements Title I of the Patent Law Treaties Implementation Act of 2012 (PLTIA), Public Law 112-211, 126 Stat. 1527 (2012)
 - Enacted December 18, 2012



Proposed Changes to Regulations (37 CFR) – What to Expect?

- New subpart I specific to international design applications (IDA)
 - USPTO as an office of indirect filing
 - Form and content requirements
 - National processing provisions
- Changes to various existing rules to accommodate IDAs

Declarations?





Expected U.S. Declarations?

- *Report of the Senate Foreign Relations Committee (SFRC), Treaty Doc. 109-21, November 27, 2007:*
- *Nine declarations included in SFRC Report:*
 - (1) Additional Mandatory Contents
 - [Art. 5(2)(a) & Rule 11(3)]
 - (2) First and Second Part Designation Fee
 - [Art. 7(2) & Rule 12(3)]
 - (3) No deferment of publication
 - [Art. 11(1)(b)]
 - (4) Only 1 independent and distinct design
 - [Art. 13(1)]



Expected U.S. Declarations?

- *Report of the Senate Foreign Relations Committee, Treaty Doc. 109-21, November 27, 2007:*
- *Nine declarations (cont'd):*
 - (5) Recording has no effect until receipt
 - [Art. 16(2)]
 - (6) Maximum duration of protection is 15 years from grant
 - [Art. 17(3)(c)]
 - (7) Identity of creator & oath/declaration
 - [Rule 8]
 - (8) Security clearance: 1 mo. to transmit increased to 6 mos.
 - Rule 13(4)
 - (9) Extended refusal period
 - [Rule 18(1)(b)]

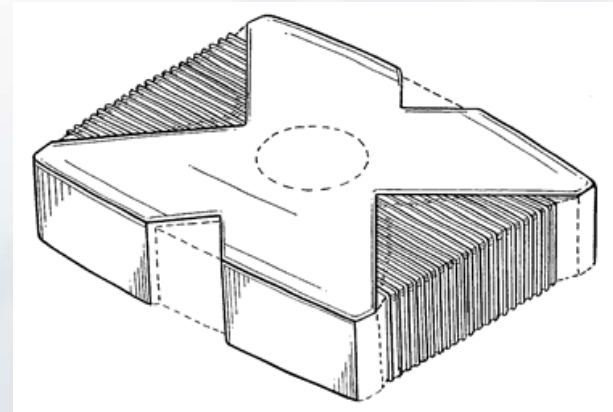
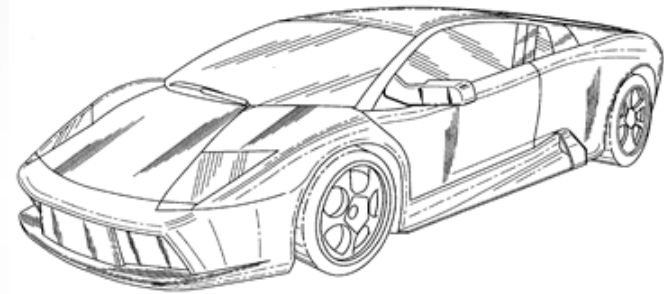
Hague System: Considerations Relating to United States design patents





Design Patents

- Protects ornamental appearance
- Does not protect purely functional designs
- 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*: 14 years from issuance (soon: 15 years from issuance)





Requirements for Patentability

U.S. Design Patents



Patentability Requirements

- Patentable subject matter (§171)
- Novelty (§102)
- Non-Obviousness (§103)
- Written Description, Enablement (§112 (a))
- Distinctly Claim Subject Matter (§112 (b))



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



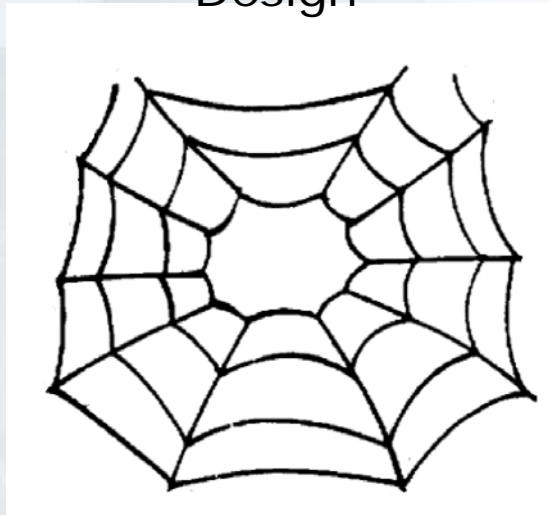
Requirements for Patentability

U.S. Design Patents

New
Original
Ornamental
Article
Non Obvious
Enabled
Described
Definite

The design "for an article"

Disembodied
Design



Not Acceptable

35 U.S.C. § 171

Embodied Design

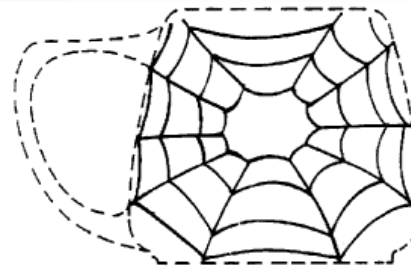


Fig. 1

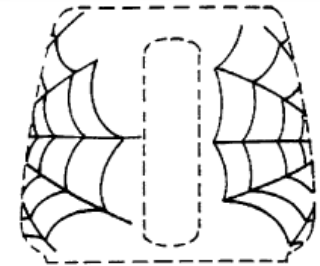


Fig. 2

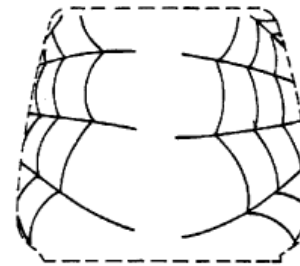


Fig. 3

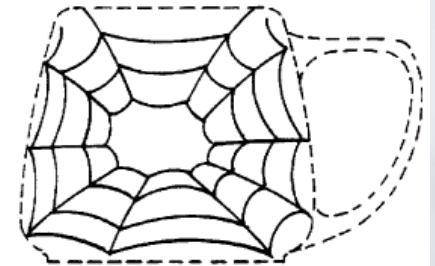


Fig. 4

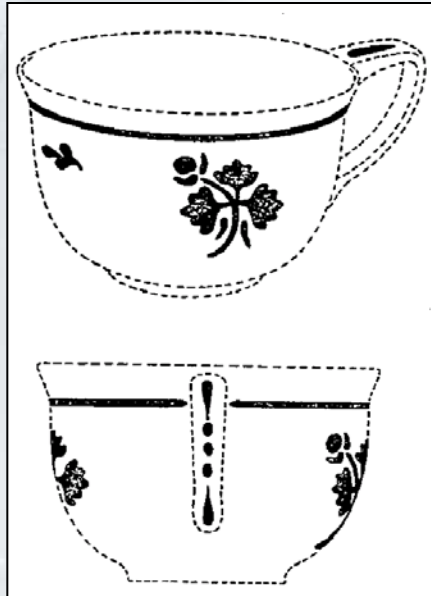


Requirements for Patentability

U.S. Design Patents

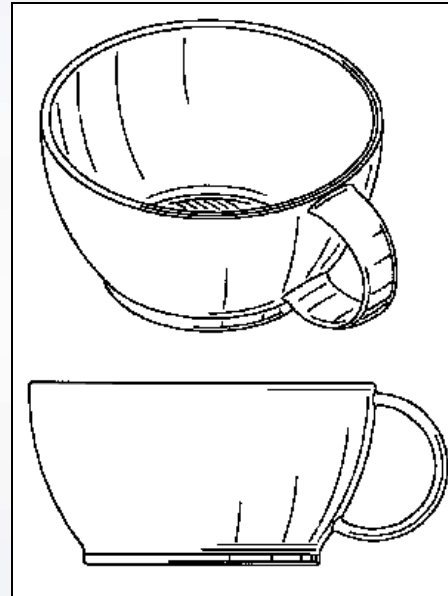
Types of Designs for Articles:

New
Original
Ornamental
Article
Non Obvious
Enabled
Described
Definite



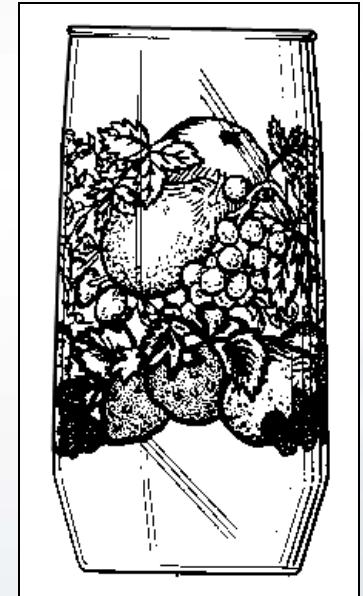
(1)

Surface
ornamentation
applied to an article



(2)

Configuration
embodied
in an article



(3)

Configuration
and Surface
ornamentation for an
article

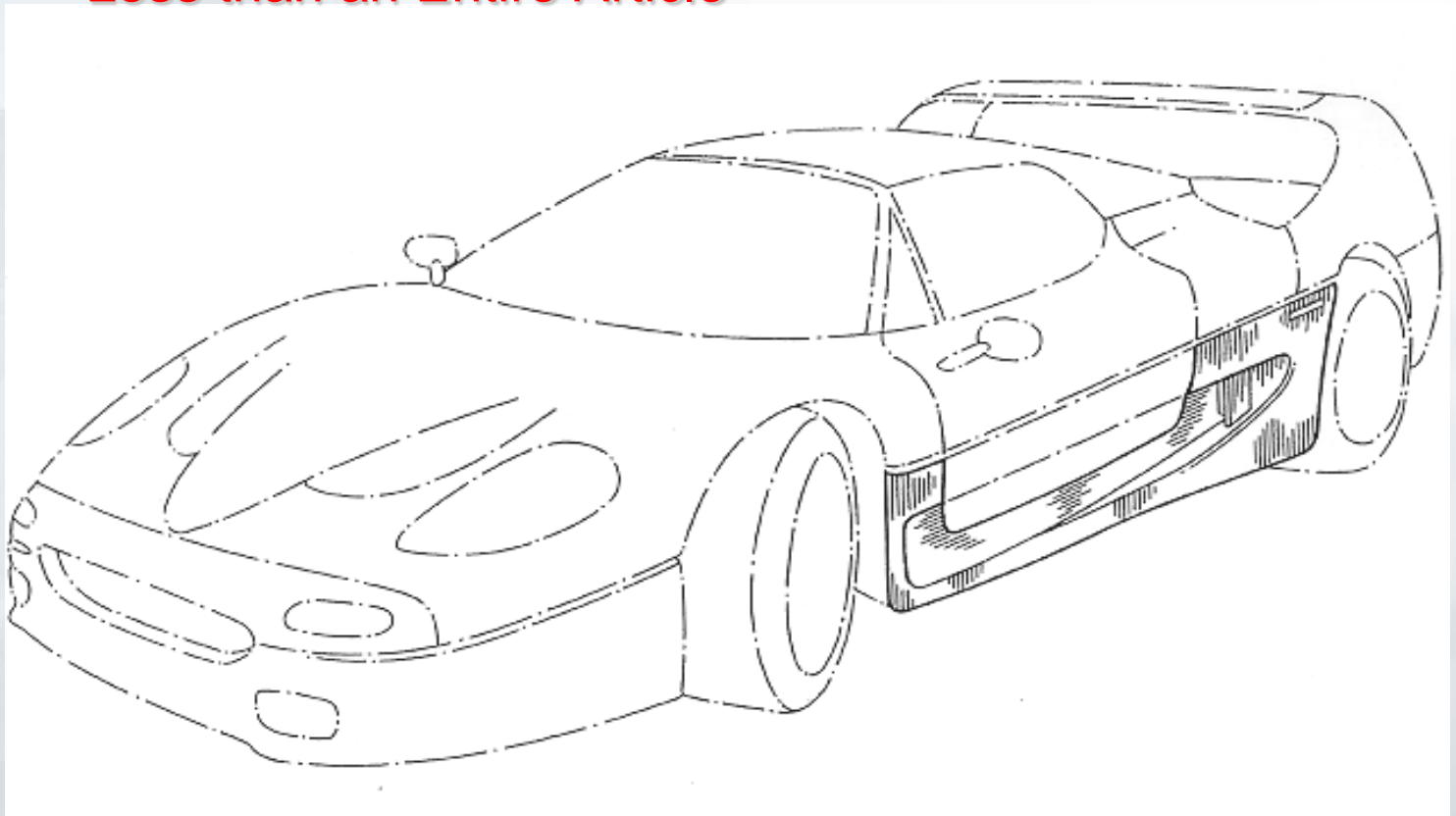
35 U.S.C. § 171



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

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)

New

Original

Ornamental

Article

Non Obvious

Enabled

Described

Definite

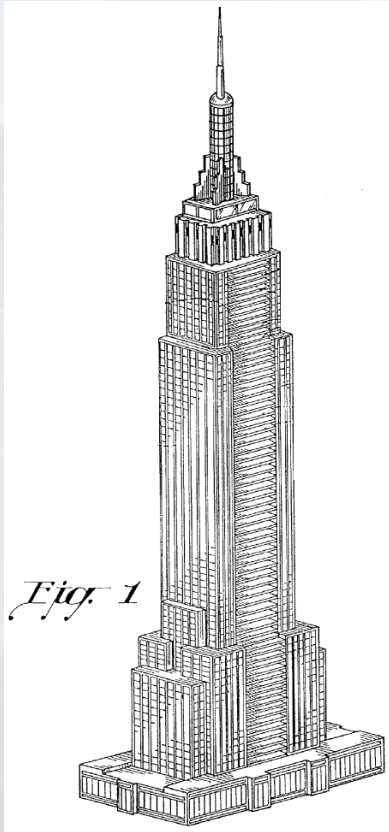


Requirements for Patentability

U.S. Design Patents

Not Original:

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



35 U.S.C. § 171

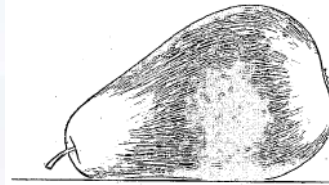


Fig. 2.

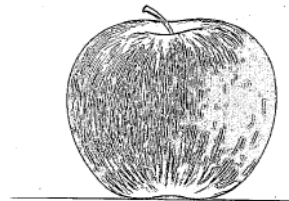


Fig. 3.

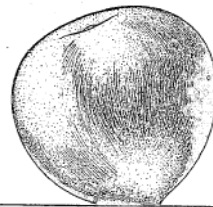


Fig. 4.





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



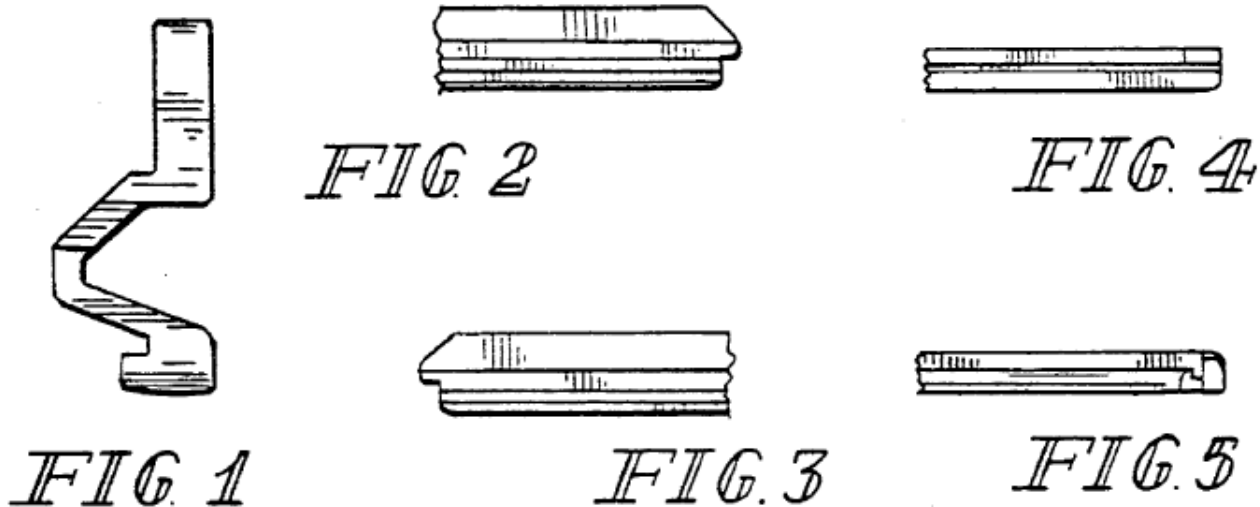
Requirements for Patentability

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



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

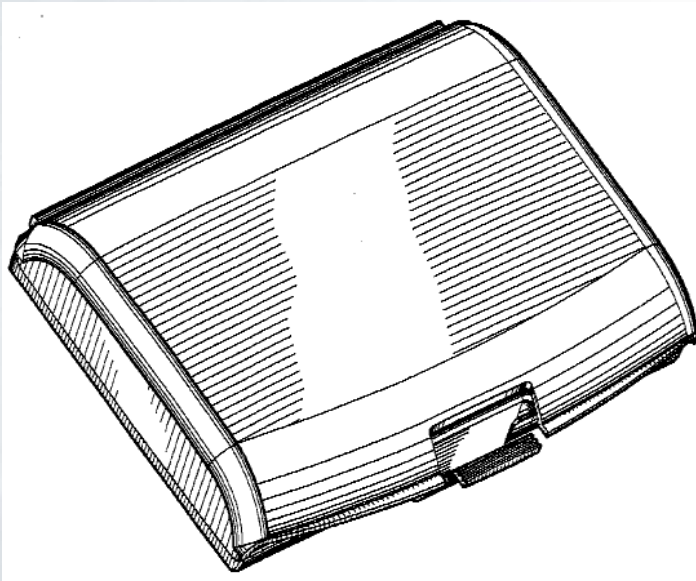
U.S. Design Patents

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 **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
(Emphasis added)

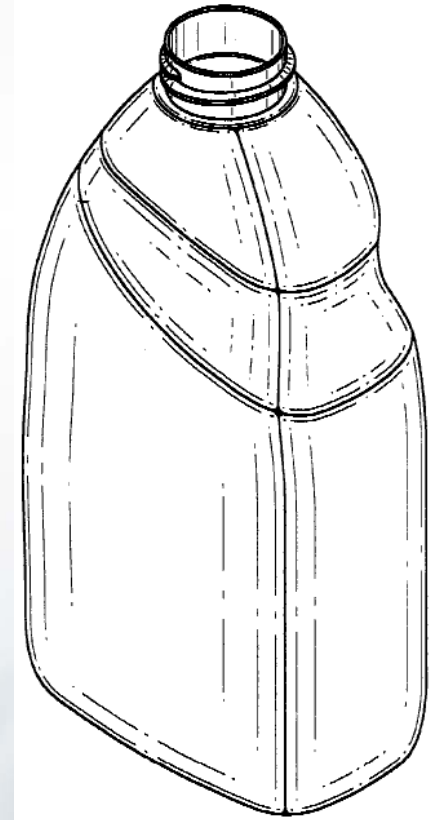
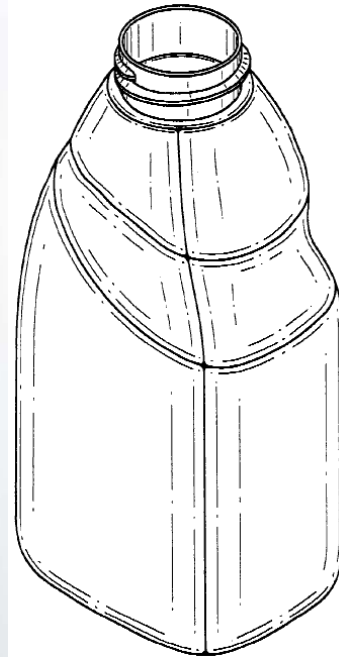
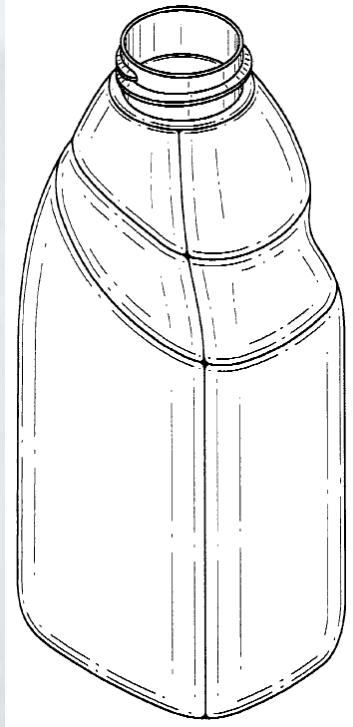


Requirements for Patentability

U.S. Design Patents

Obvious:

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



35 U.S.C. § 103



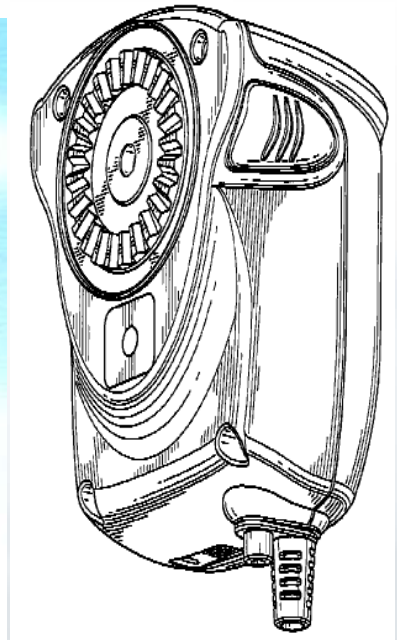
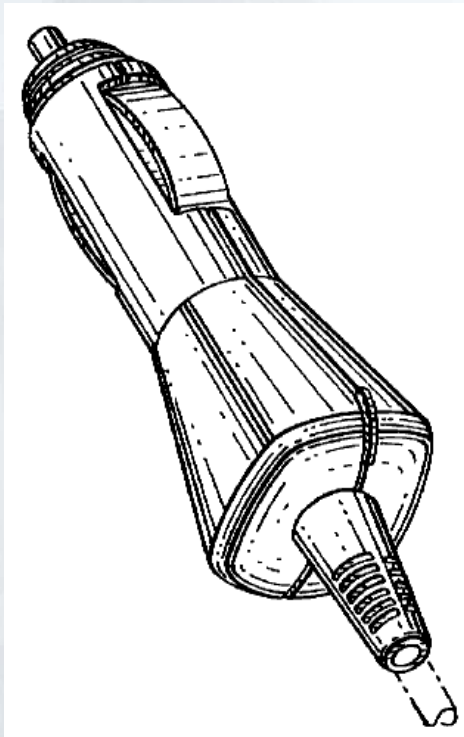
Requirements for Patentability

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.

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

35 U.S.C. § 112 (a)

New

Original

Ornamental

Article

Non Obvious

Enabled

Described

Definite



Requirements for Patentability

U.S. Design Patents

Enablement

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



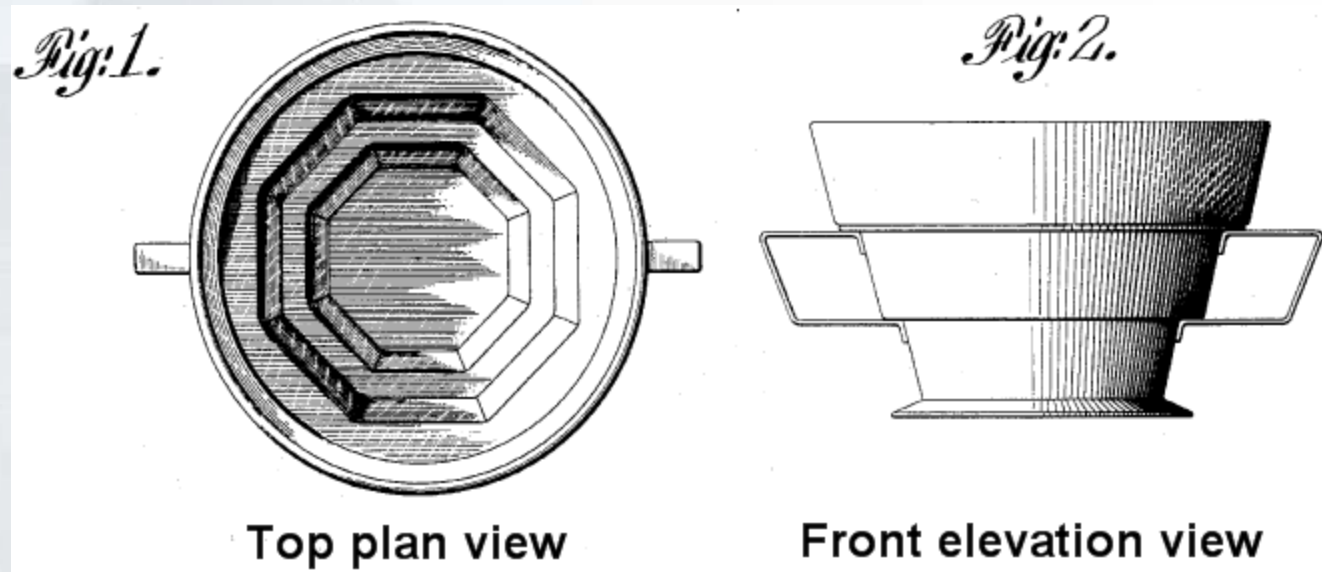
Requirements for Patentability

U.S. Design Patents

Enablement

Not enabled:

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



35 U.S.C. § 112, ¶ 1



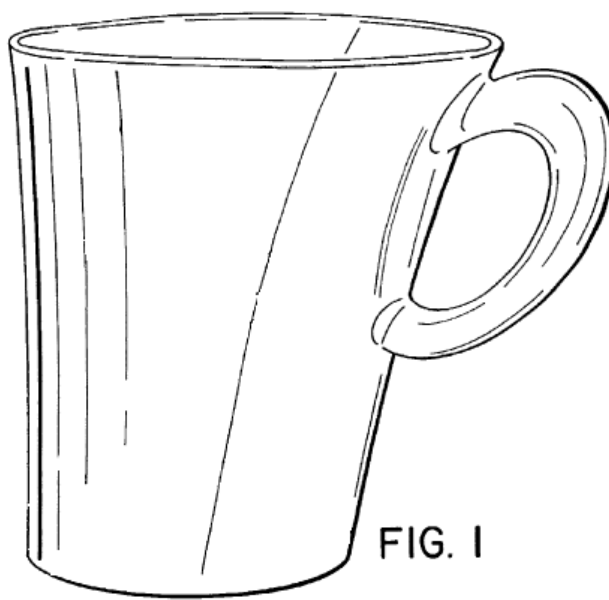
Requirements for Patentability

U.S. Design Patents

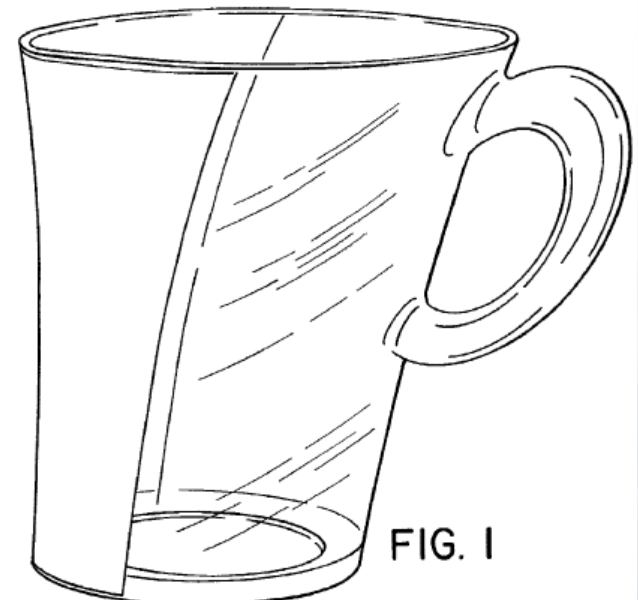
Described

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, ¶ 1



Requirements for Patentability

U.S. Design Patents

The Statute:

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

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

New
Original
Ornamental
Article
Non Obvious
Enabled
Described
Definite

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

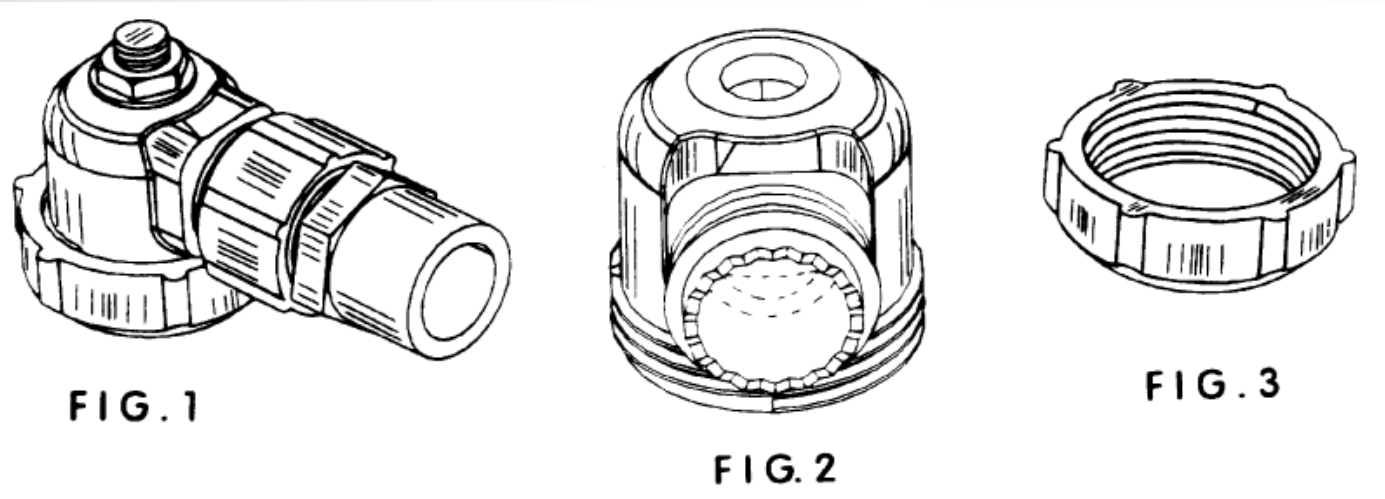
U.S. Design Patents

Definite

Not Definite:

New
Original
Ornamental
Article
Non Obvious
Enabled
Described
Definite

Condensate flow shut-off switch



35 U.S.C. § 112 (b)



Patentability Requirements

- Patentable subject matter (§171)
- Novelty (§102)
- Non-Obviousness (§103)
- Written Description, Enablement (§112 (a))
- Distinctly Claim Subject Matter (§112 (b))

Thank You!



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Office of Policy and International Affairs
United States Patent and Trademark Office
November 13, 2014