CLIENT ALERT

Calling All Design Patent Applicants: Hague is Coming to Town

Feb.26.2015

On February 13, 2015, the U.S. Patent and Trademark Office deposited with the World Intellectual Property Organization (WIPO) an instrument ratifying the 1999 Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (Hague Agreement). This ratification is the penultimate step in a lengthy process intended to allow U.S. design patent applicants enhanced access to a unified international design patent filing system. As a result of ratification, the U.S. will be a participating member of the Hague Agreement on May 13, 2015.

For design patent applicants, the forthcoming increase in accessibility of the Hague Agreement warrants both optimism and caution. On one hand, there will inevitably be challenges inherent in the simultaneous filing in registration and examination jurisdictions because no unified worldwide drawing standards currently exist. As such, drawings that may be perfectly adequate to receive the rubber stamp of a registration jurisdiction such as Europe may fail to meet requirements in an examination jurisdiction such as the U.S. For this reason, ready access to the Hague Agreement may offer a dangerous trap for the unwary, who are tempted to forgo adequate forethought regarding the varying requirements for drawings in the totality of jurisdictions where design protection ultimately will be pursued.

Further, on the downside, although the Hague Agreement is frequently touted as offering potential cost-savings, this possibility may be somewhat misleading. In the first instance, costs for filing an international application under the Hague Agreement are assessed both per design and per jurisdiction, so these costs can add up quite rapidly, particularly where multiple designs are pursued in multiple jurisdictions. Additionally, many jurisdictions, including the U.S., have a restriction practice that may result in the need to subdivide the international application into more than one application at the national stage, potentially resulting in further fees.

However, for those who prefer to view the glass as half full, there are also many advantages that are likely to inure to U.S. design patent applicants as a result of the Hague Agreement. For example, design patent applicants have the Hague Agreement to thank for an additional year of patent term; indeed, patent term will be 15 years from issue for all design patent applications filed on or after May 13, 2015.

Additionally, on the plus side, the filing of multiple designs and the designation of multiple jurisdictions through a single application filing undoubtedly offers significant convenience, the benefits of which will be fully reaped by those who, at the time of filing an international application, remain cognizant of varying drawings requirements and restriction practices.

The Hague Agreement may also be expected to result in early provisional design patent protection because provisional patent protection begins upon publication, and international design registrations typically publish very rapidly. As such, because damages in design patent infringement actions may be traced from the time of provisional protection, the Hague Agreement may result in the accrual of damages from an earlier time point than in the case of a direct national filing, with a potential for overall higher damage awards for design patentees.

As such, although final implementation will not be a panacea to conflicting worldwide drawings standards for design patents, and whether or not to file an international design patent application under the Hague Agreement should be evaluated on a case-by-case basis with all due caution, the Hague Agreement does promise a longer patent term, added convenience and valuable provisional patent rights for U.S. design patent applicants.

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