

REPORT

UNITED STATES IMPLEMENTS TREATIES FACILITATING DESIGN AND UTILITY PATENT FILINGS

January 2, 2013

On December 18, President Obama signed into law the Patent Law Treaties Implementation Act that implements two treaties in the United States: (1) the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, and (2) the Patent Law Treaty.

As to the Hague Agreement, the Act will allow U.S. applicants to apply for design protection in each of the 60 member countries participating in the Hague Agreement through the filing of just one standardized English-language international design application in the United States Patent and Trademark Office (USPTO). Conversely, the Act will also allow international design applicants in other participating countries to designate the United States in an international design application.

Currently, the European Union, Benelux, Denmark, Finland, France, Germany, Norway, Poland, Singapore, and Switzerland are among the 60 participating countries/regions. Japan and South Korea are expected to become participating countries in the near future. China has also expressed interest in joining.

The Patent Law Treaty is intended to allow applicants to salvage priority benefits for utility patents when a priority date is missed, streamline

filing requirements, and streamline and harmonize other formal matters.

The Patent Law Treaties Implementation Act will take effect as of December 18, 2013, but the USPTO still has to draft implementing regulations. Accordingly, the specific requirements (including fees, necessary documents, statements, etc.) for filing and prosecuting an international design application in the USPTO are not yet established. We will provide updates when the regulations are established.

I. International Design Application Process

Currently, an applicant may file an international design application in the World Intellectual Property Organization's (WIPO's) International Bureau in Geneva, Switzerland, designating participating countries and regions in which protection is sought. As of December 18, 2013, the USPTO will act as a receiving office that forwards filed international design applications to the International Bureau. Also as of December 18, 2013, the United States can be designated in an international design application filed in the International Bureau or any other authorized receiving office.

The International Bureau only examines an international design application for formalities. If

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acceptable, the international design application is registered within four to six weeks from filing. Within six months after registration, the International Bureau publishes the international design application.

Designated countries then have six to twelve months to refuse protection for the international registration. A refusal by a designated country can lead to proceedings in that country until the refusal is withdrawn or the applicant takes no further action. If a designated country fails to issue a refusal, or a refusal is withdrawn, the International Registration has the same effect as if the application had been filed directly in that designated country.

International design applications designating the United States will be examined in the USPTO as if they were U.S. design patent applications. If an international application is deemed patentable according to U.S. design patent law, a U.S. design patent will be issued.

Unlike directly-filed U.S. design patents, International Registrations are subject to renewal. The initial period of the International Registration is five years, with renewal periods every five years afterwards. Failure to renew the International Registration during the patent term of a given designated country results in loss of patent protection in that country.

II. Analysis of Implementation of the Hague Agreement

The Act adds new Chapter 38 to Title 35, "International Design Applications" and creates new Sections 381 through 390.

The Act changes the term of all U.S. design patents issued on design patent applications (international and national) filed on or after

December 18, 2013 from 14 years from the issue date to 15 years from the issue date.

Different from U.S. design patent applications, which are only published when the patent issues, international design applications are published as a matter of course around six months after registration. (Deferral of publication is possible in some participating countries). Publication occurs before refusals can be issued by participating countries. Thus, international design applications are published even if ultimately refused at the national level.

The publication by the International Bureau of an international design application designating the United States will be considered a "publication" under 35 U.S.C. §122(b). Thus, published international design applications that designate the United States will become prior art as of their effective filing date (defined in new §102(d)). Such publication also results in provisional rights under 35 U.S.C. §154(d) for the patent owner, from the time of such publication until issuance of the corresponding U.S. design patent. This will provide an advantage over directly-filed U.S. design patent applications, which according to 35 U.S.C. §122(b)(2)(A)(iv) are not permitted to be published.

International design applications can be useful to establish prior art dates, to allow for provisional rights, and to streamline filing and prosecution. When protection in a significant number of participating countries is sought, filing an international design application would significantly reduce filing costs, and could reduce prosecution costs. However, different participating countries have different requirements relating to, for example, shading, orthogonality, claiming partial designs, claiming colors, etc., which can result in refusals of protection on the national level, thereby reducing the cost savings.

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U.S. design patent applications are limited to one design per application. However, international design applications can have up to 100 different designs in a single application, as long as all of the designs are within the same Locarno classification. This standard is in line with European Union registered design practice, but is much broader than the USPTO's "not patentably distinct" standard. Thus, this discrepancy may result in national-level proceedings in the USPTO, including issuance of restriction requirements.

International design applications designating the United States will be examined in the USPTO according to U.S. design patent law. According to U.S. design patent law, a single application can include multiple embodiments only if the embodiments are not patentably distinct from one another. Thus, international applicants should expect applications that will be pursued in the United States to be limited to a single design, or expect to file a separate divisional application directed to each design that is patentably distinct.

III. Implementation of the Patent Law Treaty

The Act also implements provisions of the Patent Law Treaty, which are intended to streamline and harmonize formal matters regarding the filing of applications.

As a result of the Act, for non-provisional applications filed on or after December 18, 2013, it will no longer be necessary to include a claim in the application to obtain a filing date. When an application is filed without a claim, the filing date will be granted and the USPTO will issue a Notice to File Missing Parts requiring the submission of at least one claim and the payment of a late-filing surcharge.

Also, for non-provisional applications filed on or after December 18, 2013, the Act permits the USPTO to accept the identification of a prior filed application (by application number and country) as the filing of a U.S. application. A copy of the prior application plus a surcharge will be required after the filing date. Even though it will be possible to obtain a filing date by merely identifying the prior application, we recommend only doing so as a last resort in view of the extra steps and costs, and the issues that may arise from a need to rely on a direct translation of the prior application as the U.S. application text.

The Act also permits a two-month grace period for an unintentional failure to meet a priority deadline in a utility or design patent application (with a \$1,700 fee). The grace period will not allow an applicant to salvage priority based on an intentional failure to meet a priority deadline. The provisions regarding the grace period will take effect on or after December 18, 2013, and will apply to any application that is pending on or after December 18, 2013 and any patent issued before, on or after December 18, 2013, thus potentially allowing for retroactive revival of priority claims.

IV. Recommendations Regarding Design Applications

When considering whether to file, or designate the United States in, an international design application on or after December 18, 2013, we recommend the following:

(a) When preparing to file design patent applications in multiple countries claiming priority to a U.S. application, consider the potential cost savings of starting by filing an international design application in the USPTO designating the desired countries.

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(b) When preparing to file design patent applications in even one (or more) foreign country(ies) based on multiple U.S. applications directed to designs within a single Locarno classification, consider the potential cost savings of combining them into a single international design application to be filed in the USPTO.

(c) When preparing to file a U.S. design patent application claiming priority to a foreign application, consider instead designating the United States in an international design application. If you do so, be sure that drawings in the international application meet the very rigorous U.S. drawing standards, and do not include material that could unnecessarily limit the scope of the U.S. design patent.

(d) Ensure that the drawings submitted in an international design application meet the requirements of each designated country. Otherwise, any required changes to the drawings in a given designated country might be prohibited based on allegations of the impermissible addition of new matter. When designating countries that have conflicting drawing requirements, include multiple sets of drawings in the application (since an application can have up to 100 different designs). This will ensure that at least one set meets the requirements of each designated country.

(e) When preparing to file multiple U.S. design patent applications directed to different designs in the same Locarno classification, consider spreading out costs and expiration dates by including them in a single U.S. application or international application designating the United States, and filing simultaneous or serial divisional applications thereafter.

(f) Weigh the benefit of filing an international design patent application against the additional cost of two renewals of an International Registration that would not be incurred if the design patent application were filed directly in the United States.

V. Recommendations Regarding Patent Law Treaty Implementation

(a) We recommend against routine reliance on filing non-provisional applications without claims to postpone the expense of drafting claims. The interplay between specification and claims in the United States is so important that they should be prepared and reviewed together, before being filed in the USPTO. In addition, the late-filing surcharge is an avoidable expense.

(b) We recommend against routine use of identification of a prior application to establish a filing date for U.S. non-provisional applications. If a prior application is in English and identical to the U.S. non-provisional application, such reliance merely adds complexities and cost. If the prior application is not in English, it is likely that a direct translation will be required, and that translation issues will further complicate U.S. prosecution.

(c) We recommend reviewing any pending patent applications and unexpired patents in which a priority date was unintentionally missed, to determine whether priority benefits can be salvaged.

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We will provide further details as the USPTO proceeds with the rulemaking process.

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Please let us know if you desire any additional information regarding the Patent Law Treaties Implementation Act.

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