

WEEKLY NEWS - DECEMBER 13, 2007 Breaking news: US Senate approves Hague Agreement

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A spokesperson for the USPTO has confirmed to MIP Week that the US Senate voted on December 7 to ratify the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

The [Hague Agreement](#), which is administered by WIPO in Geneva, Switzerland, allows design owners to obtain multinational design protection through one international application process. They can also renew their international designs with one procedure at WIPO.

Forty-six countries, and the EU, are signatories to the agreement. The EU joined in September and the Agreement will be effective for Community designs from January next year.

US ratification of the Hague Agreement will allow applicants to extend their US designs to the other Hague member states, as well as allowing applicants in other countries to designate the US.

Now that the Senate has approved the Agreement, President Bush is expected to sign the instrument of ratification. However, it is not yet known how soon the Agreement will be effective in the US.

Robert Katz, a patent and design specialist at Banner & Witcoff, welcomed the news: "This clearly adds administrative efficiencies, and in that there are cost benefits. The downside is that we often like to maximize design protection based on the nuances of the countries in which we're filing. However, EU harmonization has solved many of those problems. We'll definitely use the Geneva Act for filing in EU countries. We'll consider it on a routine basis and use it in many circumstances, although I would not say that it will be an automatic tool."

But he said that there are also some potential drawbacks: "The US has some requirements that other countries don't, such as the duty of disclosure doctrine. People in other countries might file without disclosing prior art because they aren't familiar with the nuances of the duty of disclosure rule, and they could be potentially accused of committing fraud against the USPTO."

The Senate approval was subject to nine declarations. These cover issues such as the timescales to be used, where the Agreement provides flexibility.

The fees are set as \$430 to be paid on filing, plus \$800 when the application is allowed. There is a discounted small-entity fee.

Deferment will not be allowed, and the term of protection will be up to 15 years.

Katz warned: "US examiners may eventually end up relaxing their standards because they're getting lower-quality applications [since the US generally has more rigid requirements for approving design applications]. If that happens, it may lead to increased validity challenges, which will cost more for applicants in the long run."

However, ratification of the Hague Agreement is also likely to lead to more US businesses seeking Community designs in the EU as well as design rights in other Hague member states.

Since the Community design was established in 2003, US applicants have filed 8.8% of applications, more than applicants from France or the UK but much less than those from Germany, who have filed 24%, or Italy, who have filed 15%.

David Musker, a partner of RGC Jenkins in London, commented: "Compared to OHIM, the high designation fee and restrictive unity requirements will make Hague/US a less attractive route for European business than Hague/EU for American business."

Most of the existing members of the Hague Agreement are in Europe, central Asia and Africa. Notably, Japan, China, India, Australia and South Africa are not yet members and there are no members from Latin America.

MIP understands that the Senate also approved ratification of the Patent Law Treaty and Singapore Treaty on trade marks last week, though the USPTO was unable to confirm this.