IP Alert | Can a Tiger Change its Stripes? China is Joining the Hague System, but Many Quirks Remain

By Richard Stockton

The World Intellectual Property Organization, which administers the Hague System for the International Registration of Industrial Designs, announced that China will join the Hague System on May 5, 2022. The Hague System allows the filing of a single international design application that can lead to design protection in more than 90 jurisdictions. A single set of figures is provided for each design, official fee payments are centralized and counsel in each jurisdiction of interest is not needed to file.

China is the "missing piece" of the Hague System's jurisdictional footprint. The US, European Union, Japan, Korea, UK and most other major jurisdictions are already members. For multinational applicants, Chinese joinder magnifies the Hague System's apparent efficiency vis-à-vis separate national applications.

However, many key aspects of design law and practice remain unharmonized across major jurisdictions. Although China recently began allowing portion claims (i.e., design protection for desired parts of articles instead of the entire article), other aspects of Chinese design law remain idiosyncratic.

For example, China's absolute novelty requirement remains at odds with the one-year grace period of most major jurisdictions. Accordingly, if an applicant wants to use the Hague System to obtain enforceable design protection in China, the applicant needs to file before any disclosure despite grace period availability elsewhere.

Moreover, China will require "[s]pecific figures" of designs, which could include up to six orthographic figures. The US and most other major jurisdictions do not have minimum figure or

orthography requirements, and they could be unpalatable. The Hague System also allows jurisdictions to continue to object to “sufficiency of disclosure” type issues that could be interpreted in different ways by China’s office, CNIPA.

Furthermore, China will require a “[b]rief explanation of the characteristic features” of the design. While a short textual statement describing novel aspects of the design might seem benign, it could haunt corresponding US enforcement proceedings if the same Hague application leads to protection in the US and China.

Consequently, the Hague System’s multinational efficiency comes at a price, namely conforming a Hague System application to quirks in various jurisdictions’ design laws and practices at the expense of preferred laws and practices elsewhere. Currently, the trick to using the Hague System is to assess which quirks matter and which do not—and then formulate a filing strategy accordingly.

One strategy is to file a US application first and then pursue Hague System applications later, thus avoiding some US quirks (e.g., separate foreign filing licenses) and better preserving the status quo of US prosecution and enforcement precedent. Especially with China now in the mix, it might be worthwhile to file multiple Hague System applications to track groups of quirks, e.g., a first application directed to the EU and UK, which allow many more disparate designs inexpensively in a single application and a second application for China, Japan and Korea.

Chinese joinder makes the Hague System more attractive than ever as a vehicle for obtaining multinational design protection. But many quirks remain, and these quirks must be navigated until design law and practice worldwide is further harmonized worldwide.

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