IP Alert: U.S. President Barack Obama Signed the Patent Law Treaties Implementation Act of 2012 into Law

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The United States to Implement the Hague Agreement Concerning International Registration of Industrial Designs

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On December 18, 2012, U.S. President Barack Obama signed the Patent Law Treaties (PLT) Implementation Act of 2012 into law. The Hague Agreement Implementation section of the act adds a new Chapter 38 to the patent provisions of Title 35 of the U.S. Code. The Hague Agreement, administered by the World Intellectual Property Office (WIPO), provides only a simplified procedural avenue to obtain industrial design protection in selected member countries. The provisions directly pertaining to the U.S. Hague Implementation will become effective one year from enactment or when the U.S. deposits its implementing legislation to the WIPO.

Following the enactment of U.S. patent reform with the America Invents Act of 2011, the PLT Implementation Act creates a new international design application that entitles U.S. applicants to file a design application in the 45 member countries that are contracting parties of the Geneva Act of the Hague Agreement. Likewise, applicants whose countries or regional systems are members of the Geneva Act can file applications in their home country, designate the U.S. for examination and receive an examination on the merits from the U.S. Patent and Trademark Office (USPTO). During

substantive examination of the design application, the applicant will need to engage local U.S. counsel to respond to Office Actions issued by the USPTO.

Notably, the new PLT Implementation Act provides for the first time provisional rights resulting from publication of the international design application designating the U.S. Assuming a U.S. design patent eventually issues substantially similar to a published design in the international application, this provision in effect provides constructive notice for certain types of damages in design patent litigation court cases in the U. S. Other noteworthy changes in the law include the term of design patents increasing from 14 years from issuance to 15 years, and enabling domestic and foreign priority claims emanating from the international design application.

While the Hague system enables a simplified filing procedure to member countries, it is not a “one-size-fits-all” approach. Only one set of drawings of each design are included in one application for all of the designated countries. Under the Hague system, the local substantive examination process remains unchanged and the legal standard for obtaining a design patent is not affected. Hence, the applicant’s country selection and drawings should be based on dynamics, including strategies to maximize design rights, and whether the intellectual property rights (IPR) regime of the member country accepts partial designs, shaded or unshaded figures, the strength of IPR enforcement, where the product would be sold, potential copying, design prosecution and examination cost, and the like. Because there is no substantive examination by WIPO, the applicant’s quality of design drawings, including shading, contouring and further features of the drawings, will still need to be addressed and customized prior to filing a design application under the Hague Agreement.

The next few years may be “undiscovered country” for patent lawyers as the new law is implemented. Based on our years of experience of utilizing the Hague Agreement to acquire intellectual property protection for design-driven clients in other member countries, applicants should carefully navigate the legal issues to obtain desired design protection. We will monitor and advise on the new rules packages issued by the USPTO for implementation of the Hague Agreement in the U.S. throughout the next year.

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