House Passes the Legislation to Implement the Hague Agreement Concerning International Registration of Industrial Designs in the United States

December 5, 2012

On December 5, 2012, the House of Representatives of the 112th Congress passed the “Patent Law Treaties Implementation Act,” bill S.3486, which provides legislation to implement the Hague Agreement Concerning International Registration of Industrial Designs. The S.3486 bill previously passed in the Senate on September 22, 2012. Now that the bill has passed both the House and Senate, the legislation will be sent to President Barack Obama for enactment into law. The provisions of the new law will become effective one year from when the legislation is signed by the President. The act is to be called the “Patent Law Treaties Implementation Act of 2012.” The Hague Agreement Implementation section will be added to a new Chapter 38 to Title 35 of the United States Code.

The Hague Agreement, administered by the World Intellectual Property Office (“WIPO”), provides only a simplified procedural avenue to obtain a design registration in selected member countries. Before an applicant can obtain protection in a designated member country, formal and substantive examination on the merits of the filed design is conducted by the member countries using their national laws. Hence, the substantive examination process remains unchanged and the legal standard for obtaining a design patent is not affected. 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. Furthermore, the applicant’s country selection and drawings should be based on a number of dynamic factors, 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.

We will monitor new rules packages issued by the U.S. Patent and Trademark Office throughout the next year for implementation of the Hague Agreement in the United States. We have years of experience in using the Hague Agreement to obtain protection for design-driven clients in other member countries. While there are benefits of using the Hague system, applicants should carefully navigate the various potential drawbacks to obtain desired design protection.

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