

## **Intellectual Property and Technology Law Update**

**5/15/2015**

### **US Patent and Trademark Office Implements Significant Changes to Design Patent Application Filings**

Significant changes in design patent law became effective May 13. The biggest change is that the U.S. and Japan are now members of the Hague Union. The Hague Union is part of an international treaty that establishes a simple procedure for filing design patent applications that can be transmitted to many countries worldwide. Another change is that the term of a U.S. design patent is extended from 14 years to 15 years from the date of issuance. Lastly, U.S. design patent applicants are no longer required to petition and pay extra fees to include color drawings.

Joining the Hague Union has been a long time coming, but most practitioners agree that it can simplify multinational filings. Before joining the Hague Union, U.S. applicants wishing to pursue protection for industrial designs in multiple countries had to file individual applications in each of the respective jurisdictions where protection was desired. Now it is possible for U.S. applicants to file a single international design application either with the World Intellectual Property Organization in Geneva, Switzerland, or with the U.S. Patent and Trademark Office (USPTO) to obtain protection in multiple economies. A single international design patent application can extend protection for up to 100 designs in more than 62 territories. It is important to note that although applicants may file international applications through the Hague Union, filing a single application in the U.S. and then pursuing specific international registrations is still an option.

Although the Hague Agreement harmonizes basic filing requirements for design patents and industrial design registrations across member countries, it establishes only the minimum mandatory requirements. This helps avoid complexities related to, for example, foreign language translations, basic drawing requirements, fees and deadlines for renewal. One caveat is that individual countries may have additional requirements. For example, many foreign countries allow multiple claims in a single design application, but the U.S. will still only allow one claim per application. This means that an applicant with multiple claims may face restriction requirements in the U.S., should the USPTO determine that some embodiments or “claims” are patentably distinct designs. In such cases, the applicant will need to file divisional applications on the restricted claims it seeks to protect in the U.S., or run the risk of having restricted claims be subject to prosecution estoppel.

Applicants that use the streamlined design application process of the Hague Agreement are expected to see significant cost savings, more predictable patent prosecution and maintenance costs, and improved consistency in foreign design application filings. Additionally, the publication of the international design application can give rise to provisional rights that do not exist under current U.S. design application procedures, because the U.S. does not allow for publication of pending design applications. Thus, this process may be appealing to applicants that plan to manufacture or sell products outside of the U.S.

However, one should be aware that filing a design application pursuant to the Hague Agreement may increase the risk that an application will not meet the specific requirements of a particular jurisdiction; therefore, before filing a design application pursuant to the Hague Agreement, one should obtain advice from an attorney regarding the specific requirements of the jurisdiction(s) of interest. In addition, filing fees for applications filed under the Hague Agreement are based on the number of embodiments, the number of figures and the number of words, which can quickly increase the cost of the filing.

In sum, the Hague Agreement provides U.S. applicants with a useful alternative when filing international applications. A simplified application process for foreign protection is now available that may also reduce the cost of international filings.

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