

# The Limited Monopoly™

## International Design Registration Through the Hague System

by Robert Gunderman PE and John Hammond PE

### Industrial Designs - The Subject Matter of the Hague System

An industrial design right is an intellectual property right that protects the visual appearance of an object that is not purely utilitarian. An industrial design may be a shape, pattern, arrangement of color, or a combination of pattern and color that has ornamental or aesthetic value. An industrial design may be two dimensional or three dimensional in nature and used in a product, commodity, handicraft, or the like. In the United States, such articles are often the subject matter of design patents. There are also ways of protecting an industrial design in other countries, which is the subject of this article.

### History

The Hague Agreement Concerning the International Deposit of Industrial Designs was prepared at The Hague, Netherlands on November 6, 1925, and entered into force in 1928. The Hague System operates under several treaties. The beginnings of the Hague System go back to the London Act of 1934, followed by The Hague Act of 1960, and the Geneva Act of 1999. Some countries are party to only one of these Acts, some to two, and some to all three. Recently, Member States which were only party to the London Act of 1934 were asked to become party to the Geneva Act of 1999, or lose status as a Member State. The original Hague Agreement did not meet the needs of countries such as the United States that require substantive examination of designs for novelty and non-obviousness. Therefore, the United States never became a party to the original Hague Agreement. It is interesting to note that the protection of Designs began

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in the United Kingdom in 1787 with the Designing and Printing of Linen Act.

### The Hague System or The Hague Agreement

Under The Hague System for the International Registration of Industrial Designs, there is a way to register

produces the same effects in each of the designated countries as it would have, had the design been registered in each of the national offices of those designated countries. In some ways similar to the PCT, the Hague System simplifies international design registration, as well as changes and renewals, all of which can be done through the International



Bureau of WIPO. One advantage to filing via the Hague Agreement is that no in-country patent agent is required in order to obtain protection in that jurisdiction. Additionally, countries are required to accept applications whose formalities are in agreement with Hague Agreement practice, but not necessarily with practice in that country. Examples are the use of multiple design variations in one application or the use of dashed lines to disclaim a portion of the object.

a design in countries, as well as intergovernmental organizations that are a party to the Hague Agreement. The Hague System is administered by the World Intellectual Property Office (WIPO) located in Geneva, Switzerland. WIPO also administers the Patent Cooperation Treaty (PCT)<sup>1</sup>. The Hague System provides the owner of an industrial design with the ability to obtain protection in multiple countries by filing one application with WIPO, in one language, and with one currency for payment of fees. International registration through the Hague System

### Application Requirements

In order to take advantage of the Hague System, the applicant must be a national of a country or intergovernmental organization that is a member of the Hague Union<sup>2</sup>, domiciled in that country, or must have a commercial establishment in that country. The application may be filed in English, French, or Spanish. The application must depict the design, and may have up to 100 different designs, provided they are all in the same class in the International Classification of Industrial Designs. There are three sets of fees involved in the application:

a basic fee, a publication fee, and a designation fee for each designated country.

### Procedural Matters

Once filed, the application is then examined by the International Bureau of WIPO for formal requirements, with the applicant being given the opportunity to make corrections. When all formalities have been met, the application is recorded in the International Register and published electronically in the *International Designs Bulletin* of WIPO. Publication usually takes place six months after registration, but can be deferred by up to 30 months from the filing date for some Contracting Parties (countries or intergovernmental organizations that are members of the Hague Union). It is important to note that WIPO does not examine applications on substantive grounds. If any designated Contracting Party finds that a design does not meet its criteria for registration (for example, the design lacks novelty), it must notify the International Bureau within six months that it is refusing registration. Some national offices can request that the refusal period be twelve months instead of six to allow for substantive examination, oppositions, and other proceedings. On the other hand, if registration is not refused, then international registration has the same effect as if the design were registered under the national laws of that Contracting Party. A refusal from a national office is not prosecuted within WIPO, but is dealt with directly at that national office. Substantive examination of the application is done at the national level, rather than at the international level with WIPO.



### Duration

The duration of initial international registration is five years, and can be renewed in five year increments up to the maximum duration permitted by each Contracting Party. Renewal payments are processed the International Bureau of WIPO. The Applicant simply specifies the countries in which registration should be renewed, and pays the appropriate fees.

### Some Country Specifics

In the United States, a design patent has a term of 14 years from the date of grant. A design applicant in the U.S. must file separate applications for design protection in each country until such time as the U.S. passes legislation to implement the Hague agreement, since the U.S. was not a party to the original Hague Agreement. It is expected that the U.S. will adopt the Geneva Act, as well as make some changes to its design patent laws at that time. However, if a company has a “real and effective industrial or commercial establishment” in a contracting party

to the Agreement, design protection can be obtained by way of the Hague System. Some U.S. companies have taken advantage of this fact and have realized significant savings. The Industrial Design Act of Canada provides a ten year term for registered industrial designs. In Europe, Community Designs provide for rights within the European community that can extend for up to 25 years, subject to payment of renewal fees every five years. The United Kingdom also has its own set of design rights in addition to Community Designs. Japan also has its own set of laws to deal with Industrial Designs, and Japanese design law provides for 15 years of protection from the day of registration.

### U.S. Design Patent Applications

If a foreign design application is filed first, a U.S. design patent application can obtain the benefit of an earlier foreign filing date under 35 U.S.C. 119 (a)-(d), provided that the U.S. design patent application is filed within six months of the earliest date on which any foreign application for the same design was filed. The U.S. recognizes foreign filings under the Hague Agreement in determining priority claims. If a U.S. design patent application is filed first, foreign applications must be filed within six months of the filing date of the U.S. application. Until the Geneva Act is adopted by the U.S.,

this means that separate applications must be filed in each country in which design protection is sought. If your business has an industrial design aspect, it is important to be aware of the Hague Agreement and its relationship to U.S. design patent law, and to keep up to date with changes that will certainly result once the U.S. adopts the Geneva Act.

1. To read more about the PCT, see [www.patenteducation.com/patentarticles.html](http://www.patenteducation.com/patentarticles.html) under the topic “International Patent Applications.”
2. For a list of members of the Hague Union, see [www.wipo.int/hague/en/members/](http://www.wipo.int/hague/en/members/)

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