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A New Design Patent International Filing Treaty

A new system for international design patent registration will greatly benefit design innovators through cost and timing efficiencies. In December 2012, President Obama signed into law the Patent Law Treaties Implementation Act of 2012, which implemented the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (“the Hague Agreement”). The Hague Agreement is an international registration system that offers the possibility of obtaining protection for industrial designs in a number of countries and/or intergovernmental organizations (both referred to as “Contracting Parties”) by means of a single international application filed with the International Bureau of the World Intellectual Property Organization (WIPO). The Hague Agreement will likely not go into effect for one year and will apply only to design patent applications filed after the effective date.

The Hague Agreement simply is an agreement for the international filing of industrial designs. It is the equivalent of the Patent Cooperation Treaty (PCT) for utility patents. Any substantive aspect of the protection is entirely a matter for the domestic legislation of each designated Contracting Party.

The Hague Agreement arose from a need for simplicity and economy. In effect, it enables design owners originating from a Contracting Party to obtain protection for their designs with a minimum of formality and expense. For example, the Hague Agreement offers the owner of an industrial design a means of obtaining protection in several countries by simply filing one application with the International Bureau of WIPO, in one language, with one set of fees in one currency. An international registration produces the same effects in each of the designated countries, as if the design had been registered directly with each national office, unless protection is refused by the national office of that country.

In particular, design owners are relieved from the need to make a separate national application in each of the Contracting Parties in which they require protection. Thus, they avoid the complexities arising from procedures that may differ from country to country. Design owners do not have to file documentation in various languages, nor keep a watch on the deadlines for renewal of a whole series of national registrations, varying from one country to the other. In addition, design owners avoid the need to pay fees in various currencies. Under the Hague Agreement, the same result can be obtained by means of a single international application, in one language, accompanied by the payment of a single set of fees, in one currency and with one office (the International Bureau).

The Hague Agreement simplifies the management of an international industrial design registration portfolio, since it is possible to record subsequent changes or to renew the registration through a single procedural step with the International Bureau of WIPO. Moreover, by having a single international registration with effect in several Contracting Parties, the subsequent management of the protection obtained is also considerably facilitated. For instance, a change in ownership, or in the name or address of the holder, can be recorded in the International Register and have effect in all the designated Contracting Parties, by means of one simple procedural step.

In short, the Hague Agreement is a welcome addition to the array of tools facilitating the protection of intellectual property internationally.

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