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## SECTION 3-15 : MPEP Chapter 2900

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### Chapter 2900 – International Industrial Design Applications

The Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, July 2, 1999 (hereinafter “Hague Agreement”) is an international agreement that enables an applicant to file a single international design application which may have the effect of an application for protection for the design(s) in countries and/or intergovernmental organizations that are parties to the Hague Agreement (the “Contracting Parties”) designated in the application. The United States is a Contracting Party to the Hague Agreement, which took effect with respect to the United States on May 13, 2015. The Hague Agreement is administered by the International Bureau of the World Intellectual Property Organization (“the International Bureau”). MPEP 2901.

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#### BASIC FLOW UNDER THE HAGUE AGREEMENT

1. **Filing** - “indirectly” through the USPTO or “directly” with the International Bureau.
  - a. **Who can file?**
    - i. A national of a Contracting Party or of a State that is a member of an intergovernmental organization that is a Contracting Party; or
    - ii. One who has a domicile, habitual residence, or real and effective industrial or commercial establishment in the territory of a Contracting Party. MPEP 2904/Article 3.
  
1. **US Inspection:**
  - a. If the application is filed through the USPTO, the Office will confirm that the required transmittal fee has been paid, perform a security review, and check that the required indications demonstrating applicant’s entitlement to file the application through the USPTO are present in the application submission. Next, the application will be transmitted to the International Bureau and the applicant will be notified of the transmittal.
  
1. **Formal Examination by the International Bureau**
  - a. Regardless of whether the application is filed directly or indirectly, the International Bureau examines the application to determine whether the applicable “formal” requirements have been satisfied (i.e., completeness). These are different from the “substantive” requirements of the subject matter. If satisfied, the International Bureau will accord the application a ***filing date*** and register the industrial design in

the International Register. If the International Bureau finds that the international design application does not satisfy the applicable requirements, it will invite the applicant to make the required corrections within a prescribed time limit. The failure to timely respond to the invitation may result in abandonment or loss of designation.

- b. **Filing date:** the date when the USPTO (indirect) or International Bureau (direct) receives the international application. MPEP 2906/Hague Agreement Article 9.
- c. **International Registration Date:** the LATTER of: (a) the filing date of the international application (directly or indirectly), and (b) the date of receipt of any additional mandatory content required under Article 5(2). Publication deferment is irrelevant here. MPEP 2907/Article 10.
- d. **US Filing Date:** same as the international registration date (a.k.a. “the effective registration date”). See MPEP 2908; 35 U.S.C. 381(a)(5), 384(a) & (b).

### **APPLICATION REQUIREMENTS:**

#### **Mandatory Contents for the International Design Application**

The international design application must be in English, French, or Spanish, it must be presented on the official form (see MPEP 2902.01) and signed by the applicant, and it must include:

- a. A request for international registration under the Hague Agreement;
- b. Applicant identification (name, address, etc.);
- c. The prescribed number of copies of a reproduction(s) (or, if possible, the number of specimens, but NO SPECIMENS IN US);
- d. An indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed;
- e. Designate Contracting Parties;
- f. Fees;
- g. The Contracting Party or Parties in respect of which the applicant fulfills the conditions to be the holder of an international registration;
- h. The number of industrial designs (max 100) and the number of reproductions or specimens of the industrial designs in the application;
- i. The amount of the fees being paid and the method of payment; and
- j. An indication of applicant’s Contracting Party as required under Rule 7(4)(a).

#### **Additional [Possibly] Mandatory Content (Depending on Designated Parties)**

Additional mandatory content may be required by certain Contracting Parties and therefore are mandatory in any international design application that designates such Contracting Parties. Such additional mandatory contents may consist of:

- a. Indications concerning the identity of the creator,
- b. A brief description of the reproduction or of the characteristic features of the industrial design,
- c. A claim, and/or
- d. A statement, document, oath, or declaration.

### **Additional Requirements if the US is Designated**

In addition to the mandatory requirements otherwise required, an international design application designating the United States must also include:

- a. A claim;
- b. Indications concerning the identity of the creator (i.e., the inventor); and
- c. The inventor's oath or declaration.

Additionally, an international design application designating the United States must include a specification as prescribed by 35 U.S.C. 112; and preferably include a brief description of the reproductions.

### **Optional Contents:**

The following may be included in an international design application:

- a. Two or more industrial designs, subject to the prescribed conditions;
- b. A request for deferment of publication (NOT ALLOWED IN US-DESIGNATING APPLICATION) or a request for immediate publication;
- c. Any of the additional mandatory elements discussed above, even if such elements are not required by any Contracting Party designated in the international design application;
- d. Where the applicant has a representative, the name and address of applicant's representative, as prescribed;
- e. A claim of priority of one or more earlier filed applications;
- f. A declaration, for purposes of Article 11 of the Paris Convention, that the product or products that constitute the industrial design, or in which the industrial design is incorporated, have been shown at an official or officially recognized international exhibition, and details of the exhibition;
- g. Any declaration, statement, or other relevant indication as may be specified in the Administrative Instructions;
- h. A statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned; and
- i. A proposed translation of any text matter contained in the international application for purposes of recording and publication.

If the international application contains any matter other than that required or permitted, the International Bureau shall delete it ex officio.

### **Registration and Publication**

1. If the international design application satisfies all applicable requirements, the International Bureau will register the international design application in the International Register and accord a ***date of international registration***.
2. The international registration is published by the International Bureau. Absent a request for immediate publication or deferment, the registration will be published approximately six months after the date of international registration. The publication includes the data from the international registration and the reproductions of the industrial design. The applicant may request that publication occur immediately after

registration or that publication be deferred for up to 30 months from the filing date (or priority date, if applicable). Applications designating the US are not allowed to request deferment.

### **Examination by the Offices of the Designated Contracting Parties**

1. Following publication of the international registration by the International Bureau, the offices of the designated Contracting Parties proceed with examination if required under their respective laws. For example, if you wanted a US design patent, that examination would begin now based on the published international registration received from the International Bureau.
2. If your application included the proper US requirements and you paid the US examination fees with your original international application fee, US examination will automatically begin after the international application is published.
3. **2914 – Converting Int’l Design App. To a US Design App.**
4. Pursuant to 35 U.S.C. 384(a), “any international design application designating the United States that otherwise meets the requirements of chapter 16 may be treated as a design application under chapter 16.” 37 CFR 1.1052 sets forth a procedure for converting an international design application designating the U.S. to a U.S. design application by a petition. The petition must be accompanied by a fee and be filed prior to publication of the international registration under Article 10(3).
5. An international design application converted under 37 CFR 1.1052 is subject to the regulations applicable to a design application filed under 35 U.S.C. chapter 16. See 37 CFR 1.1052(d); MPEP Chapter 1500.
6. Where it appears that the applicant is not entitled to a patent, the USPTO will send a notification of refusal to the International Bureau, normally within 12 months from the publication of the international registration. This is similar to an office action, a non-final rejection. The applicant may reply to such notification directly to the USPTO, and then continue with the normal design patent examination process. Any further Office action, such as a subsequent non-final rejection, a final rejection, or an allowance will be sent directly to the applicant.

### **Grant of U.S. Design Patent (MPEP 2940 & 2950)**

1. A grant of protection for an industrial design that is the subject of an international registration shall only arise in the United States through the issuance of a patent. So basically, the international design registration doesn’t provide you any U.S. rights until it actually issues a U.S. design patent.
2. U.S. patents issued from international design applications shall be effective for a term of fifteen years from the date of grant. Issue fees are due three months after the Notice of Allowance, just like for normal US design patents. (NOTE: part of the US examination fee is paid when filing an international design application designating the US, and the rest is paid upon allowance in the US).
3. Upon issuance of a patent, the USPTO will send to the International Bureau a statement that protection is granted in the United States to the industrial design(s). This will provide notice to the public and third parties through publication of the statement by the International Bureau in the International Designs Bulletin that protection for an industrial design has been granted in the U.S.

**Miscellaneous:**

1. Hague Agreement generally does not affect MPEP 1500 design patents.
2. No provisional or PCT applications for designs.
3. Foreign priority for designs is six months, not 12.
4. Method of filing at the USPTO (indirectly) – by EFS, mail, or hand delivery; NO fax; NO Certificate of Mailing and/or Transmission. MPEP 2905.
5. Revivable unintentional abandonment – 37 CFR 1.1051 (similar to Rule 1.137).
6. Correcting inventorship – Rule 1.48 – Needs oath or substitute statement like usual.
7. Must notify the International Bureau and USPTO of changes in ownership - MPEP 2920.02.
8. If you fail at prosecution, you can file continuation (1.53(b)), or appeal, but NO 1.53(d).