UNITED STATES
PATENT AND TRADEMARK OFFICE



Strategies for Filing Internationally: Including the PCT and the Hague System for Industrial Designs

Layla Lauchman 14 March 2017



What is a Patent?

- Property Right
 - Right to exclude others from making, using, selling, offering for sale or importing the claimed invention
 - Limited term
 - Territorial protection only where patent granted
- Exchange
 - Inventor discloses the invention in exchange for the opportunity to receive the patent grant and its associated rights

Who Grants Patents?

- National patent offices
 - E.g., USPTO, JPO, KIPO
- Regional patent offices
 - Grants patents with effect in some or all member countries
 - European Patent Office (EPO)
 - Eurasian Patent Convention (EA)
 - African Regional Intellectual Property Organization (ARIPO)
 - African Intellectual Property Organization (OAPI)
 - Patent Office of the Gulf Cooperation Council (GCC)



Regional Patent Offices

AP (ARIPO)

BW	Botswana
GH	Ghana
GM	Gambia
ΚE	Kenya
LS	Lesotho
MW	Malawi
ΜZ	Mozambique
NA	Namibia
SD	Sudan
SL	Sierra Leone
SZ	Swaziland
ΤZ	United Republic of Tanzania
UG	Uganda
ΖM	Zambia
ZW	Zimbabwe

EA (EA)

AM	Armenia
ΑZ	Azerbaijan
BY	Belarus
KG	Kyrgyzstan
ΚZ	Kazakhstan
MD	Moldova
RU	Russian Fed.
TJ	Tajikistan
TM	Turkmenistan

EP (EPO)

AL AT BE CH CZ DK ES FI FR GR HU IE	Albania Austria Belgium Bulgaria Switzerland Cyprus Czech Republic Germany Denmark Estonia Spain Finland France United Kingdom Greece Croatia Hungary Ireland	IS IT LIT LUV MC MK MT NO PL RO RS SE SI SK	Iceland Italy Liechtenstein Lithuania Luxembourg Latvia Monaco Macedonia Malta Netherlands Norway Poland Portugal Romania Serbia Sweden Slovenia Slovakia
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EP (EPO) Extension Countries

ВА	Bosnia and Herzegovina
ME	Montenegro

OA (OAPI)

BF	Burkina Faso
BJ	Benin
CF	Central African Rep.
CG	Congo
CI	Côte d'Ivoire
CM	Cameroon
GΑ	Gabon
GN	Guinea
GQ	Equatorial Guinea
GW	Guinea-Bissau
ML	Mali
MR	Mauritania
NE	Niger
SN	Senegal
TD	Chad
TG	Togo

GC (GCC)

BL	Bahrain
KW	Kuwait
OM	Oman
QA	Qatar
SA	Saudi Arabia

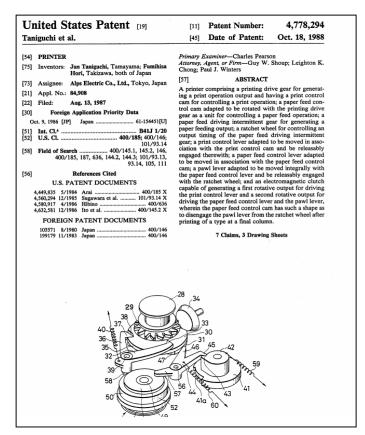
United Arab Emirates

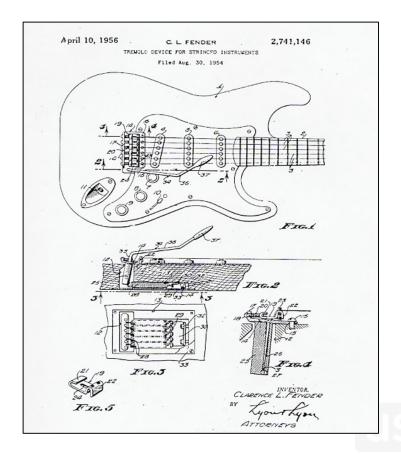
Types of U.S. Patents

- Utility
 - Inventions
 - 20 year term from filing date
- Design
 - Ornamental design described and shown
 - 15 year term from grant date (For applications filed on or after May 13, 2015)
- Plant
 - New variety of asexually reproduced plant
 - 20 year term from filing date



Utility Patent



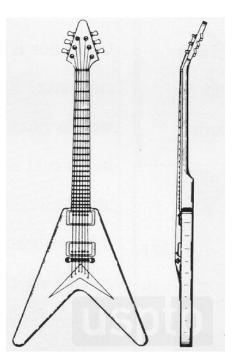


Design Patent

- In the USA, protects the way an article looks, including
 - its shape and configuration, as well as
 - surface ornamentation applied to the article



Couture



March, 2017

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Plant Patent



(12) United States Plant Patent van der Knaap

(10) Patent No.: US PP25,124 P2

(45) Date of Patent:

- (54) CURCUMA PLANT NAMED 'CURALIMEI'
- (50) Latin Name: Curcuma alismatifolia Varietal Denomination: Curalimei
- (71) Applicant: Leonardus Johannes Maria van der Knaap, Naaldwijk (NL)
- (72) Inventor: Leonardus Johannes Maria van der Knaap, Naaldwijk (NL)
- (73) Assignee: Nubilus B.V., Naaldwijk (NL)
- (*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.
- (21) Appl. No.: 13/987,345
- (22) Filed: Jul. 15, 2013
- (51) Int. Cl. A01H 5/00 (2006.01)

(52) U.S. Cl. USPC Plt./421

Nov. 25, 2014

Primary Examiner — Anne Grunberg
(74) Attorney, Agent, or Firm — C. A. Whealy

(57) ABSTRACT

A new and distinct cultivar of *Curcuma* plant named 'Curalimei', characterized by its upright and columnar plant habit with outwardly arching leaves; freely clumping growth habit; leaves with dark purple-colored midveins; freely flowering habit; flowers with dark pink-colored flower bracts and dark red purple-colored apices that are positioned just above the foliar plane on strong and erect peduncles.

2 Drawing Sheets



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Where to Patent?

- Patent rights are territorial
 - Protection against infringing activities only within the country or region in which patent was granted
- No world-wide patent
 - Must apply for and be granted a patent in each country or region of interest
- Patent protection can be an important part of overall global business strategy



Where to Patent: Business Considerations

- Market size and potential of country/region
- Manufacturing potential
- Industry size and growth
- Competition activity
- Patent procurement costs



Where to Patent: Patent Law Considerations

- Standards of patentability in country/region
 - Patentable subject matter differences
 - Prior art differences
 - Grace Period
 - Some countries have only a registration system
 - No substantive examination
- Types of protection differ
 - Patent, inventor's certificate, utility certificate, utility model, petty patent, patent of addition, certificate of addition, inventor's certificate of addition, utility certificate of addition, industrial design

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Grace Period

- Time prior to filing during which public disclosure by an inventor will not be considered prior art
- Differs in different jurisdictions
 - US 1 year (35 U.S.C. 102(b))
 - EPO None
 - JP 6 months under certain circumstances



Where to Patent: Enforcement Considerations

- Enforceability of patents
- Enforcement requires patent owner action
- Competitor products should be monitored
- Licensing may be beneficial



Options for Foreign Filing

- File a patent application directly in a national or regional patent office (Paris Convention)
 - A foreign filing license from the USPTO may be required
- File an international patent application under the Patent Cooperation Treaty (PCT)
 - A foreign filing license from the USPTO may be required, if filing in a foreign receiving Office

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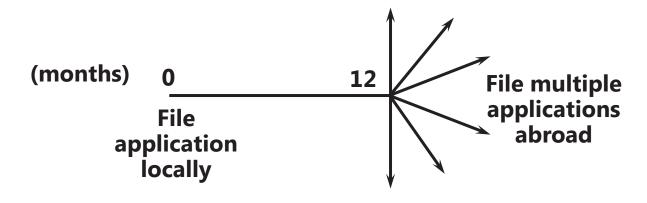
Direct Filing (Paris Convention)

- Provides a 12-month right of priority
 - Triggered by the first filing of a patent application
 - Within which to file a subsequent application in another Paris Convention member country for the same invention
 - Subsequent application must claim the priority of the 1st application
- Currently 176 Contracting States
 - Excludes countries not recognized by United Nations
 - E.g., Taiwan
 - http://www.wipo.int/treaties/en/ip/paris/

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Direct Filing Timeline



- Local patent application filed first
 - Multiple foreign applications filed at 12 months, claiming priority under the Paris Convention
 - Multiple formality requirements
 - Multiple prosecutions of applications
 - Translations and national/regional fees required at 12 months

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Why Direct File in Foreign National or Regional Patent Office

- May be cost effective
 - If filing in only a few countries
- When certain
 - As to which countries applications are to be filed
- Prepared to pay the filing costs early
 - E.g., filing fees, translation costs, attorney fees
- Necessary for countries not party to the PCT



The Patent Cooperation Treaty

- A United Nations Treaty
 - Signed June 1970
 - Became operational June 1978
 - Administered by the International Bureau (IB)
 - Of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland



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International Patent?

- An international application is filed under the PCT but...
 - There is no "international patent"
 - The PCT functions as a patent application filing system
 - The international application must still be prosecuted in each national or regional office where patent protection is desired

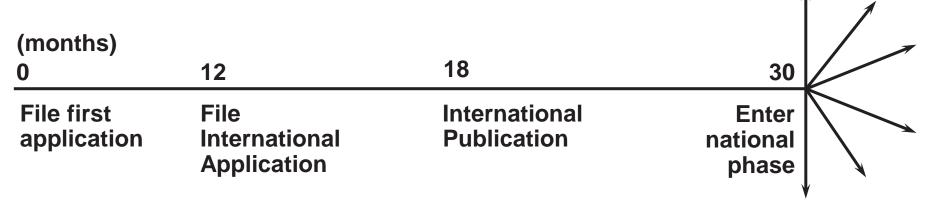


Purposes of the PCT

- To simplify the process of filing foreign patent applications
- To give every regional and national patent Office and the applicant the benefit of
 - A search and opinion on patentability by a major patent Office
 - An optional further examination by a major patent
 Office



PCT Filing Timeline



- Local patent application filed first
 - single international application filed at 12 months, claiming priority under the Paris Convention
 - one set of formalities requirements
 - one international phase prosecution
 - translations and national/regional fees and prosecution not required until 30 months

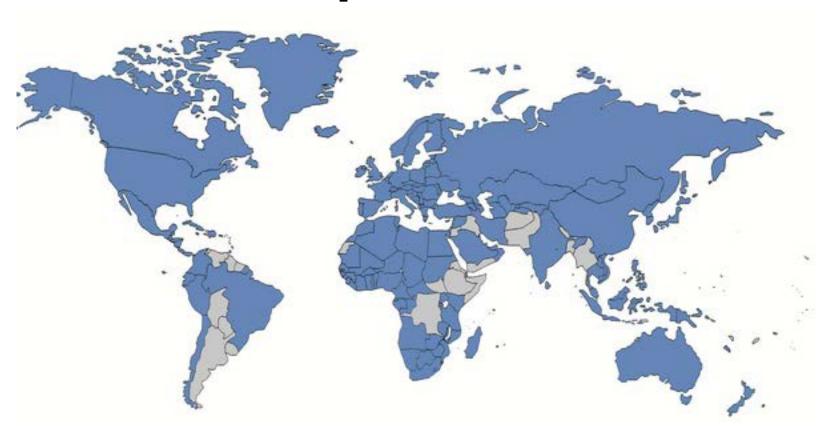


PCT Contracting State

- A country which is a signatory to the PCT
- Eighteen (18) Contracting States in 1978
- Currently 151 Contracting States
 - Excludes countries not recognized by the United Nations
 - *E.g.*, Taiwan
 - http://www.wipo.int/pct/en/



PCT World Map



PCT Benefits for Applicants

- Simplifies the process of filing foreign applications
 - One set of formality requirements
 - Establishes a filing date in all PCT Contracting States
- Postpones costs
 - Translation fees, filing fees, attorney fees
- Provides
 - An early indication of prior art and
 - A written opinion as to the novelty, inventive step and industrial applicability of the claimed invention
- Gives extra time for assessment of commercial viability in designated
 States

PCT Benefits for Offices

- Provides every regional and national patent Office, where protection is sought, the benefit of
 - An International Search Report (ISR) and
 - Written Opinion of the International Searching Authority (WOISA)
 - Optionally, a Supplementary International Search Report (SISR)
 - By a Supplementary International Searching Authority
 - Optionally, an International Preliminary Report on Patentability (Chapter II) – IPRP (Chapter II)
 - By an International Preliminary Examining Authority (IPEA)

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The International Application

- A single application
 - Filed in one language
 - Filed in one patent Office
 - The receiving Office (RO)
 - Usually the applicant's home patent office
 - Treated as a national application in each designated State as of the international filing date
- Formalities in compliance with the PCT
 - Must be accepted during national phase



Why Foreign File via the PCT

- May be cost-effective
 - If filing in more than a few countries
- When uncertain
 - As to which countries applications are to be filed
 - Preserves rights
- Provides additional time
 - To assess the commercial potential in the various foreign markets
- Defers national patent fees and other costs
 - E.g., translations, local associate fees, etc.
- Provides an assessment opportunity
 - Of international search and written opinion results, before incurring additional filing costs

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PCT Filing Strategies

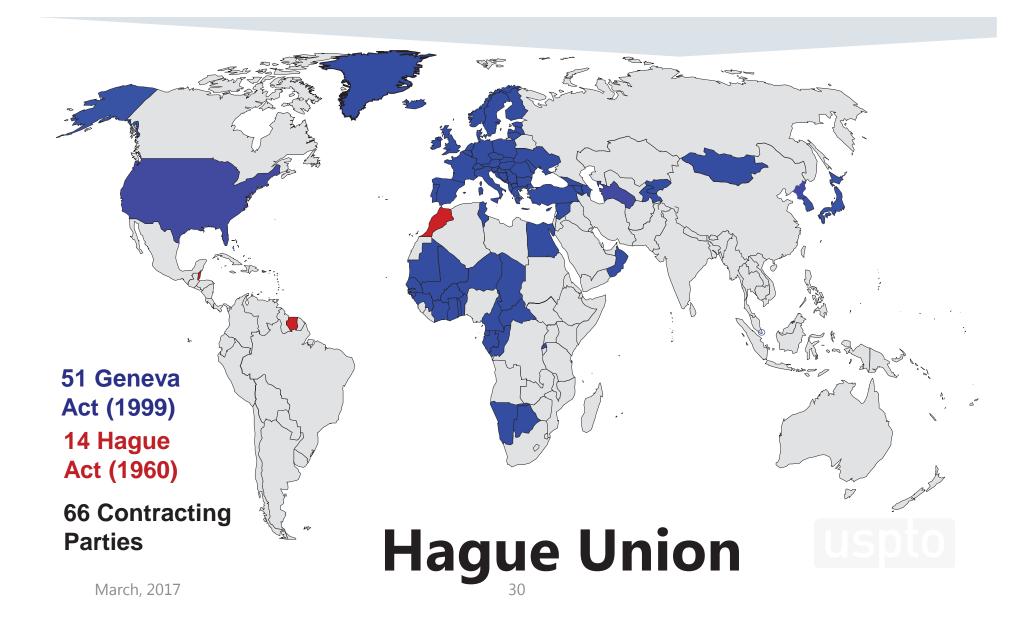
- Options for foreign filing using the PCT
 - Option 1: Non-Provisional followed by PCT
 - Option 2: Provisional followed by PCT
 - Option 3: Provisional followed by Non-Provisional and PCT
 - Option 4: PCT filed first



Other International Agreements and Treaties - Hague System

- Hague System for International Registration of Industrial Designs
 - U.S. became a member of the 1999 Geneva Act on May 13, 2015





What is the Hague System?

- A single international application for a single international registration (IR)
 - Designating one or more Contracting Parties (CP)
 - Capable of being registered in 66 Contracting Parties
 - Register up to 100 industrial design with a single application
 - All designs must belong to the same Locarno class
- If no refusal, the resulting international registration has the effect of a grant of protection in each designated Contracting Party



...And What the Hague System is Not

- Since the Hague System is primarily a procedural treaty, it does not determine:
 - The conditions for protection;
 - The rights which result from protection
- Such issues are governed by the law of each Contracting Party designated in an international registration



Who Can Use the Hague System?

- You need
 - An attachment to a Contracting Party
 - Nationality
 - Domicile
 - Real and effective industrial or commercial establishment
 - Habitual residence



Filing a Hague Application

- Language: English, French, or Spanish
- Directly with WIPO, electronically or on paper
- Indirectly through USPTO
- Up to 100 different designs if they belong to the same International Classification (Locarno)
- Single set of formal requirements apply
- Single set of international fees can be paid to WIPO (CHF)

Filing a Hague Application Through the USPTO

- The applicant must have a U.S. attachment
- Must pay a transmittal fee (\$120) to the USPTO
- International fees required by WIPO may be paid through USPTO or directly to WIPO
 - Payment through USPTO must be on/before date of payment of transmittal fee



Hague Application Processing: Role of International Bureau

- Examines IDAs for compliance with treaty requirements
- Translates into two other languages
- Records the IR in the International Register
- Credits designation fees to accounts of CPs
- Publishes registrations in the Int'l Designs Bulletin
 - Every Friday on WIPO's website
 - http://www.wipo.int/hague/en/bulletin/haguebulletin/index.jsp

Hague Application Processing: Role of the Designated Office

- Normal Substantive Examination by Office:
 - To the extent it applies to national filings
 - Formalities examination is skipped
 - Statement of Grant of Protection may be issued
- Any refusal must generally be communicated within 6 or 12 months from publication of the IR (U.S. 12 months)



Hague System - Additional Items (1)

• The *start* and *duration* of the effect of a grant of protection varies by CP:

United States

- Protection begins: On the date of issuance of a U.S. patent
 - Provisional rights may also be available from the date of WIPO publication
- <u>Duration</u>: **15 years** from issuance (fixed term no renewal)

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Hague System - Additional Items (2)

European Union

- Protection begins: On the international registration date (if no refusal or refusal is withdrawn)
- Max duration: 25 years (fixed renewal fees)

Republic of Korea

- Protection begins: On the date of the statement of grant of protection
- Max duration: 20 years (renewal fees progressively increase except for designs belonging to certain Locarno classes)

Resources

- WIPO Hague website:
 - http://www.wipo.int/hague/en/

- USPTO Hague website:
 - http://www.uspto.gov/patent/initiatives/hagueagreement-concerning-international-registrationindustrial-designs

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Other International Agreements and Treaties - Patent Law Treaty (PLT)

- Harmonizes and streamlines formal procedures pertaining to the filing and processing of patent applications
- Standardizes requirements for obtaining a filing date for an application for patent
- Only 39 Contracting Parties
 - U.S. became a Contracting Party on December 18, 2013
 - http://www.wipo.int/treaties/en/ip/plt/

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Other International Agreements and Treaties – Patent Prosecution Highway

- When at least 1 claim is indicated as patentable by an Office of First Filing (OFF) or Office of Earlier Examination (OEE)
- Applicant may request PPH processing by an Office of Second Filing (OSF) or Office of Later Examination (OLE)
 - Fast track the examination of corresponding claims in corresponding applications filed in the OSF or OLE
- USPTO has PPH agreements with various Intellectual Property Offices around the world
 - http://www.uspto.gov/patents/init_events/pph/index.jsp

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PCT-PPH

- Patent Prosecution Highway (PPH) is expanded to include PCT work
 - PPH treatment may be requested if a positive written opinion or an international preliminary report on patentability (Chapter II) from a participating Office is issued
- USPTO has PCT- PPH agreements with various Intellectual Property Offices around the world
 - http://www.uspto.gov/patents/init_events/pph/index.jsp



Local Counsel/Representation

- Consult with local industry contacts
- Check with U.S. Embassy in each country
- Inventor organizations
- Within the United States
 - https://oedci.uspto.gov/OEDCI/



Avoiding Common Mistakes

- Confidentiality
 - Avoid making the invention public prior to filing a patent application
- Be familiar with key dates and deadlines
 - Under U.S., foreign, and international laws
- Recommend securing the services of a registered patent attorney or agent
 - If unfamiliar with the complexities in obtaining foreign patent rights
 - To avoid potentially losing patent rights

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USPTO Resources

- PCT Help Desk
 - 571-272-4300
 - Monday Friday 8:30am 5:00pm ET
- International Patent Legal Administration Web site
 - https://www.uspto.gov/patents-getting-started/internationalpatent-cooperation
- Office of International Patent Cooperation Web site
 - https://www.uspto.gov/patents-getting-started/internationalpatent-cooperation

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USPTO Resources (cont)

- Inventors Assistance Center
 - 800-786-9199
- Inventors Resources on PTO Internet site
 - https://www.uspto.gov/learning-and-resources/inventorsentrepreneurs-resources
- USPTO Internet site
 - http://www.uspto.gov
- Searching U.S. patents and U.S. patent application publications
 - http://patft.uspto.gov/

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Other Resources

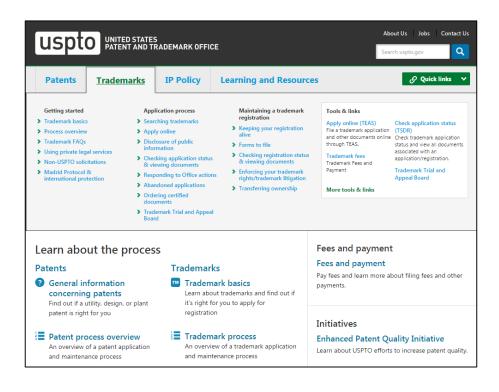
- Protecting Intellectual Property Rights
 - http://www.StopFakes.gov
- Office of U.S. Trade Representative
 - http://www.ustr.gov/trade-topics/intellectual-property
- World Intellectual Property Organization (WIPO)
 - http://www.wipo.int
- PATENTSCOPE
 - WIPO's searchable PCT publication database and image file wrapper
 - http://patentscope.wipo.int/search/en/structuredSearch.jsf
- European patent database
 - http://www.epo.org/searching-for-patents/technical/espacenet.html
- Japanese patent database
 - http://www.ipdl.inpit.go.jp/homepg_e.ipdl

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USPTO Website – www.uspto.gov

- Search Patents
- Image File Wrapper

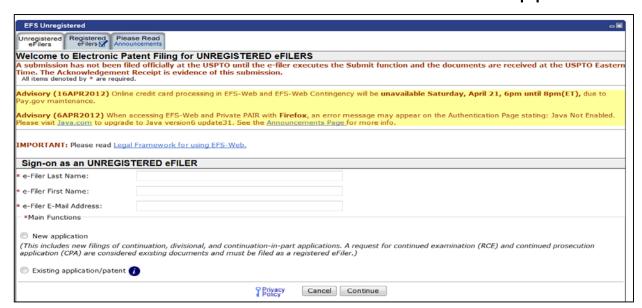
- Electronic Filing
- Fees





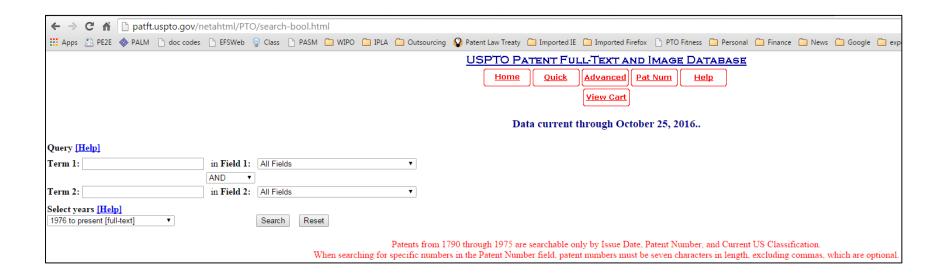
Electronic Filing – EFS-Web

- Currently over 96% of applications are filed electronically using EFS-Web
- Web-based tool
- Upload .pdf documents
- File PCT applications



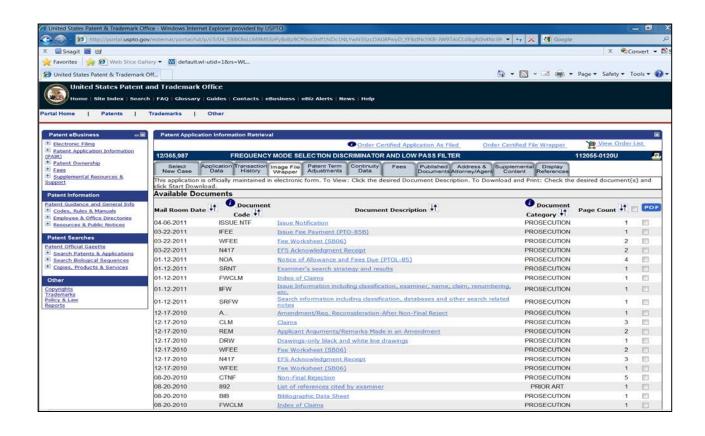


Public Search Page





Public PAIR





THANK YOU!

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