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

<table>
<thead>
<tr>
<th>AP (ARIPO)</th>
<th>EP (EPO)</th>
<th>OA (OAPI)</th>
</tr>
</thead>
<tbody>
<tr>
<td>BW Botswana</td>
<td>AL Albania</td>
<td>IS Iceland</td>
</tr>
<tr>
<td>GH Ghana</td>
<td>AT Austria</td>
<td>IT Italy</td>
</tr>
<tr>
<td>GM Gambia</td>
<td>BE Belgium</td>
<td>LI Liechtenstein</td>
</tr>
<tr>
<td>KE Kenya</td>
<td>BG Bulgaria</td>
<td>LT Lithuania</td>
</tr>
<tr>
<td>LS Lesotho</td>
<td>CH Switzerland</td>
<td>LU Luxembourg</td>
</tr>
<tr>
<td>MW Malawi</td>
<td>CY Cyprus</td>
<td>LV Latvia</td>
</tr>
<tr>
<td>MZ Mozambique</td>
<td>CZ Czech Republic</td>
<td>MC Monaco</td>
</tr>
<tr>
<td>NA Namibia</td>
<td>DE Germany</td>
<td>MK Macedonia</td>
</tr>
<tr>
<td>SD Sudan</td>
<td>DK Denmark</td>
<td>MT Malta</td>
</tr>
<tr>
<td>SL Sierra Leone</td>
<td>EE Estonia</td>
<td>NL Netherlands</td>
</tr>
<tr>
<td>SZ Swaziland</td>
<td>FI Finland</td>
<td>NO Norway</td>
</tr>
<tr>
<td>TZ United Republic of Tanzania</td>
<td>FR France</td>
<td>PL Poland</td>
</tr>
<tr>
<td>UG Uganda</td>
<td>GB United Kingdom</td>
<td>PT Portugal</td>
</tr>
<tr>
<td>ZM Zambia</td>
<td>GR Greece</td>
<td>RO Romania</td>
</tr>
<tr>
<td>ZW Zimbabwe</td>
<td>HR Croatia</td>
<td>RS Serbia</td>
</tr>
<tr>
<td>EA (EA)</td>
<td>HU Hungary</td>
<td>SE Sweden</td>
</tr>
<tr>
<td>AM Armenia</td>
<td>IE Ireland</td>
<td>SI Slovenia</td>
</tr>
<tr>
<td>AZ Azerbaijan</td>
<td>BA Bosnia and Herzegovina</td>
<td>SK Slovakia</td>
</tr>
<tr>
<td>BY Belarus</td>
<td>KZ Kazakhstan</td>
<td>SM San Marino</td>
</tr>
<tr>
<td>KG Kyrgyzstan</td>
<td>MD Moldova</td>
<td>TR Turkey</td>
</tr>
<tr>
<td>KO Korea</td>
<td>RU Russian Fed.</td>
<td>TR Turkey</td>
</tr>
<tr>
<td>TD Chad</td>
<td>TJ Tajikistan</td>
<td>TR Turkey</td>
</tr>
<tr>
<td>TG Togo</td>
<td>TM Turkmenistan</td>
<td>TR Turkey</td>
</tr>
</tbody>
</table>

**EP (EPO) Extension Countries**

| BA Bosnia and Herzegovina | ME Montenegro |

**GC (GCC)**

| BL Bahrain | KW Kuwait | OM Oman |
| QA Qatar   | SA Saudi Arabia | AE 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


Tajima et al.

primary Examiner—Charles Pearson

App. No. 84,908

Assignee: Kansai Electric Co., Ltd., Tokyo, Japan

Filed: Aug. 11, 1987

A printer comprising a printing drive gear for generating a print operation output and having a print control cam for controlling a print operation; a paper feed control cam adapted to be rotated with the printing drive gear as a unit for controlling a paper feed operation; a paper feed driving intermittent gear for generating a paper feed driving output; a ratchet wheel for controlling an output timing of the paper feed driving intermittent gear; a print control lever adapted to be moved in association with the print control cam and be reliability engaged therewith; a paper feed control lever adapted to be moved in association with the paper feed control cam; a pair of levers adapted to be moved integrally with the paper feed control lever and be reliability engaged with the ratchet wheel and an electromagnetic clutch capable of generating a first rotational output for driving the print control lever and a second rotational output for driving the paper feed control lever and the pair of levers, wherein the paper feed control cam has such a shape as to disengage the pair of levers from the ratchet wheel after printing of a type at a final column.

7 Claims, 3 Drawing Sheets
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
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
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
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
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
**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
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
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

<table>
<thead>
<tr>
<th>(months)</th>
<th>0</th>
<th>12</th>
<th>18</th>
<th>30</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>File first application</td>
<td>File International Application</td>
<td>International Publication</td>
<td>Enter national phase</td>
</tr>
</tbody>
</table>

- 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

March, 2017
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
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)
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
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
51 Geneva Act (1999)
14 Hague Act (1960)
66 Contracting Parties

Hague Union

March, 2017
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
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
  – **Duration**: 15 years from issuance (fixed term - no renewal)
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:

• USPTO Hague website:
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
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
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
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/international-patent-cooperation

• Office of International Patent Cooperation Web site
  – https://www.uspto.gov/patents-getting-started/international-patent-cooperation
USPTO Resources (cont)

• Inventors Assistance Center
  – 800-786-9199

• Inventors Resources on PTO Internet site
  – https://www.uspto.gov/learning-and-resources/inventors-entrepreneurs-resources

• USPTO Internet site
  – http://www.uspto.gov

• Searching U.S. patents and U.S. patent application publications
  – http://patft.uspto.gov/
Other Resources

• Protecting Intellectual Property Rights
• 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
• European patent database
• Japanese patent database
  – http://www.ipdl.inpit.go.jp/homepg_e.ipdl
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
THANK YOU!

Layla Lauchman
Special Programs Examiner
International Patent Legal Administration
layla.lauchman@uspto.gov
571.272.2418