

UNITED STATES  
PATENT AND TRADEMARK OFFICE



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

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14 March 2017

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# 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
KE	Kenya
LS	Lesotho
MW	Malawi
MZ	Mozambique
NA	Namibia
SD	Sudan
SL	Sierra Leone
SZ	Swaziland
TZ	United Republic of Tanzania
UG	Uganda
ZM	Zambia
ZW	Zimbabwe

## EA (EA)

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

## EP (EPO)

AL	Albania	IS	Iceland
AT	Austria	IT	Italy
BE	Belgium	LI	Liechtenstein
BG	Bulgaria	LT	Lithuania
CH	Switzerland	LU	Luxembourg
CY	Cyprus	LV	Latvia
CZ	Czech Republic	MC	Monaco
DE	Germany	MK	Macedonia
DK	Denmark	MT	Malta
EE	Estonia	NL	Netherlands
ES	Spain	NO	Norway
FI	Finland	PL	Poland
FR	France	PT	Portugal
GB	United Kingdom	RO	Romania
GR	Greece	RS	Serbia
HR	Croatia	SE	Sweden
HU	Hungary	SI	Slovenia
IE	Ireland	SK	Slovakia
		SM	San Marino
		TR	Turkey

## EP (EPO) Extension Countries

BA	Bosnia and Herzegovina
ME	Montenegro

## OA (OAPI)

BF	Burkina Faso
BJ	Benin
CF	Central African Rep.
CG	Congo
CI	Côte d'Ivoire
CM	Cameroon
GA	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
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

**United States Patent** [19]  
Taniguchi et al.

[11] Patent Number: 4,778,294  
[45] Date of Patent: Oct. 18, 1988

[54] **PRINTER**  
[75] Inventors: Jun Taniguchi, Tamayama; Fumihisa Hori, Takizawa, both of Japan  
[73] Assignee: Alps Electric Co., Ltd., Tokyo, Japan  
[21] Appl. No.: 84,908  
[22] Filed: Aug. 13, 1987

[30] Foreign Application Priority Data  
Oct. 9, 1986 [JP] Japan ..... 61-154451[U]  
[51] Int. Cl.<sup>4</sup> ..... B41J 1/20  
[52] U.S. Cl. .... 400/185; 400/146;  
101/93.14  
[58] Field of Search ..... 400/145.1, 145.2, 146,  
400/185, 187, 636, 144.2, 144.3; 101/93.13,  
93.14, 105, 111

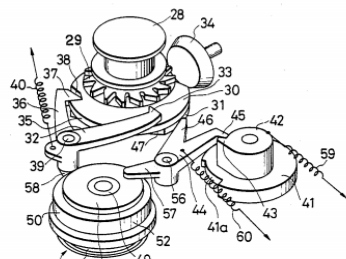
[56] References Cited  
U.S. PATENT DOCUMENTS  
4,449,835 5/1984 Arai ..... 400/185 X  
4,560,294 12/1985 Sugawara et al. .... 101/93.14 X  
4,580,917 4/1986 Hibino ..... 400/636  
4,632,581 12/1986 Ito et al. .... 400/145.2 X

FOREIGN PATENT DOCUMENTS  
105571 8/1980 Japan ..... 400/146  
199179 11/1983 Japan ..... 400/146

Primary Examiner—Charles Pearson  
Attorney, Agent, or Firm—Guy W. Shoup; Leighton K. Chong; Paul J. Winters

**ABSTRACT**  
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 feeding 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 releasably engaged therewith; a paper feed control lever adapted to be moved in association with the paper feed control cam; a pawl lever adapted to be moved integrally with the paper feed control lever and be releasably engaged with the ratchet wheel; and an electromagnetic clutch capable of generating a first rotative output for driving the print control lever and a second rotative output for driving the paper feed control lever and the pawl lever, wherein the paper feed control cam has such a shape as to disengage the pawl lever from the ratchet wheel after printing of a type at a final column.

7 Claims, 3 Drawing Sheets



April 10, 1956

C. L. FENDER

2,741,146

TREMULO DEVICE FOR STRINGED INSTRUMENTS

Filed Aug. 30, 1954

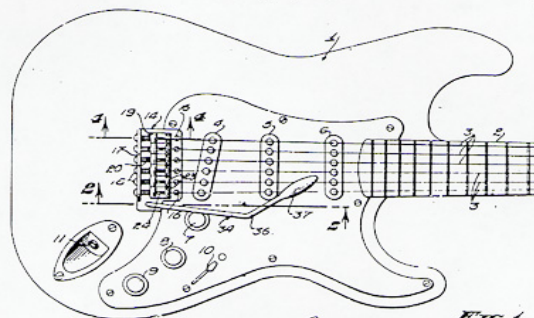


FIG. 1

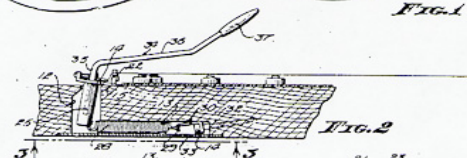


FIG. 2

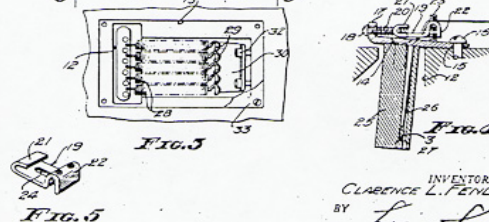


FIG. 3

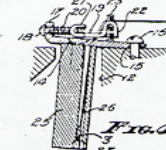


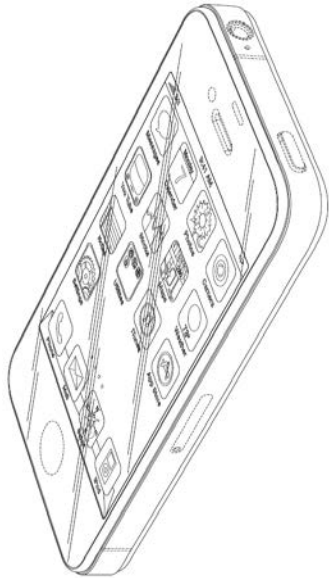
FIG. 4

FIG. 5

INVENTOR  
CLARENCE L. FENDER  
BY  
Lyons & Lyons  
ATTORNEYS

# Design Patent

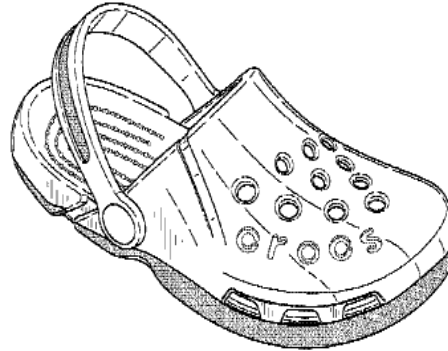
- In the USA, protects the way an article looks, including
  - its shape and configuration, as well as
  - surface ornamentation applied to the article



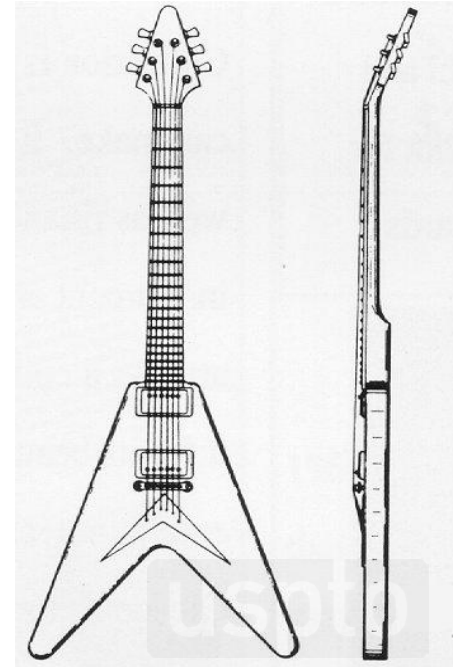
March, 2017



Christian Dior  
Couture



Crocs





# Plant Patent



US00PP25124P2

(12) **United States Plant Patent**  
**van der Knaap**

(10) **Patent No.:** **US PP25,124 P2**  
(45) **Date of Patent:** **Nov. 25, 2014**

(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**

(58) **Field of Classification Search**

CPC ..... **A01H 5/00**

USPC ..... **Plt/421**

See application file for complete search history.

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



# 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



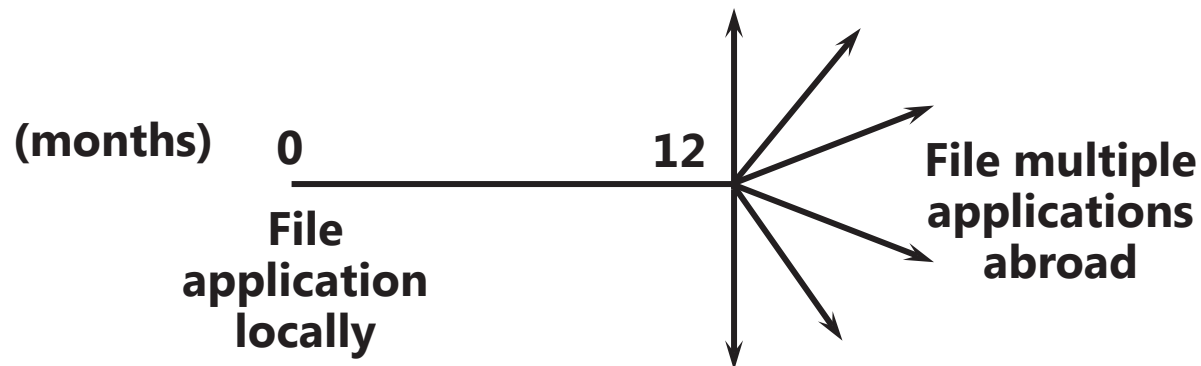
# Direct Filing (Paris Convention)

- 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
  - <http://www.wipo.int/treaties/en/ip/paris/>





# 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



**WIPO**  
WORLD INTELLECTUAL PROPERTY ORGANIZATION



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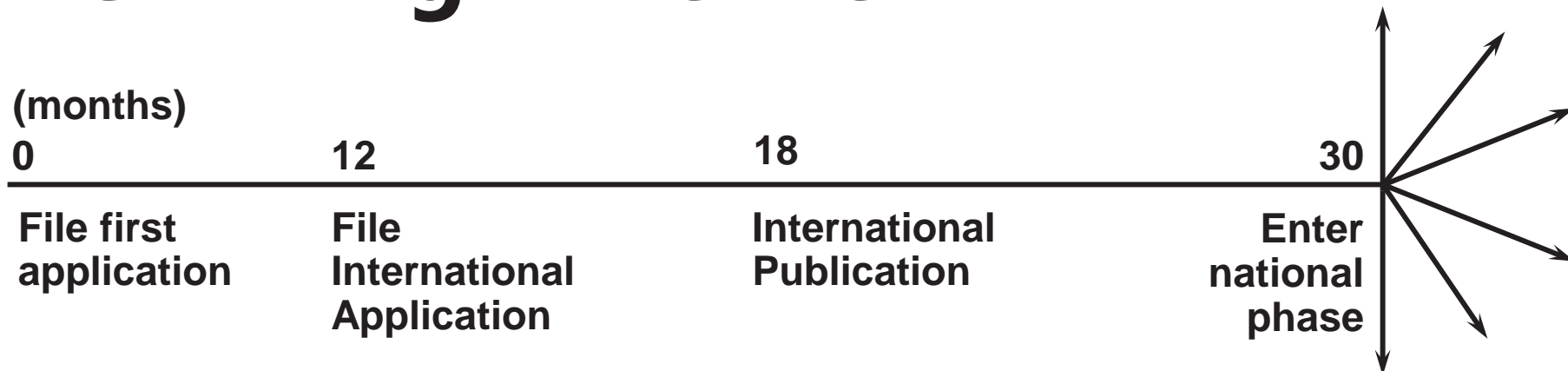
# International Patent?

- 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



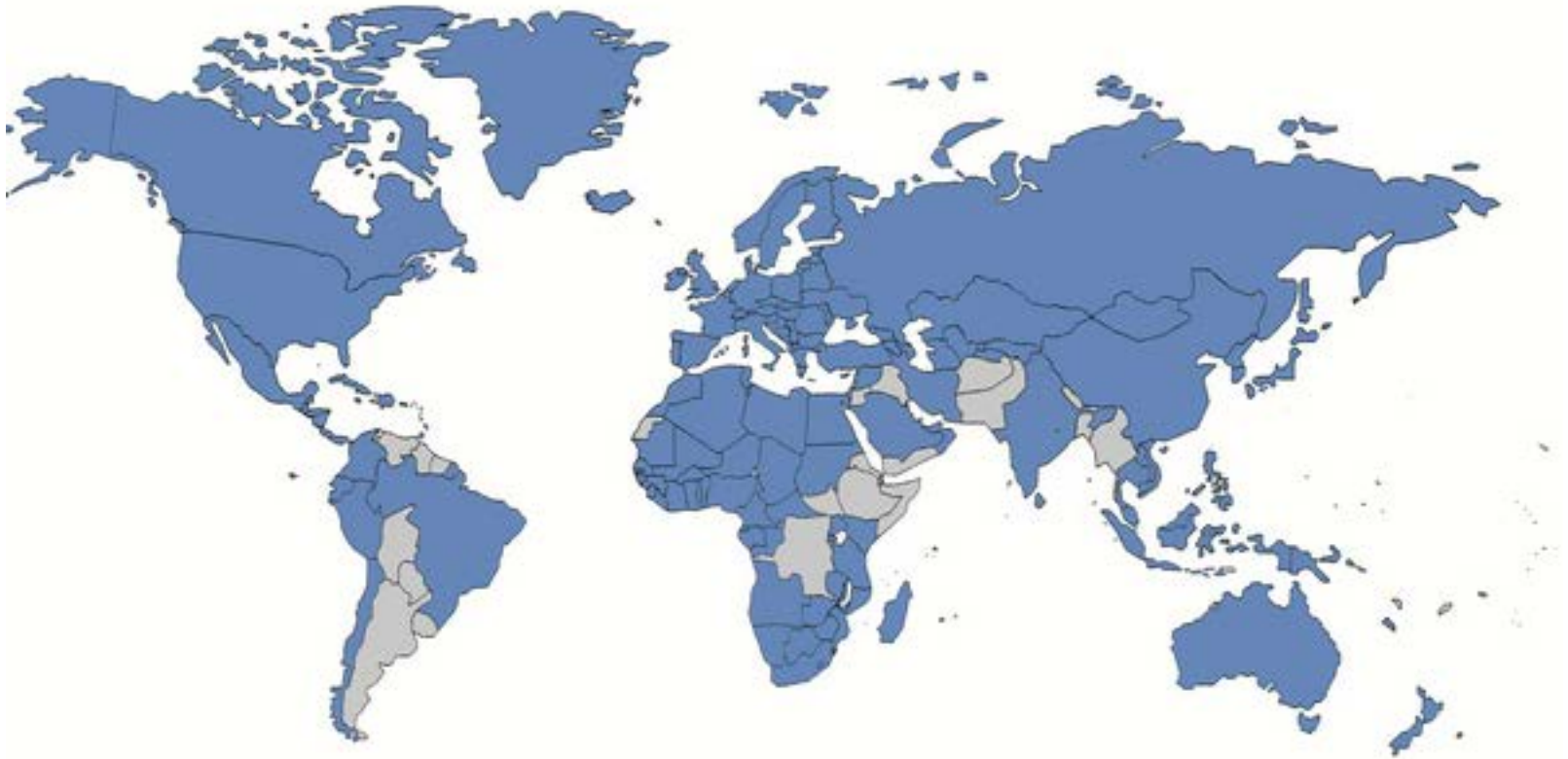
- Local patent application filed first
  - single international application filed at 12 months, claiming priority under the Paris Convention
    - one set of formalities requirements
    - one international phase prosecution
    - translations and national/regional fees and prosecution not required until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

# 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

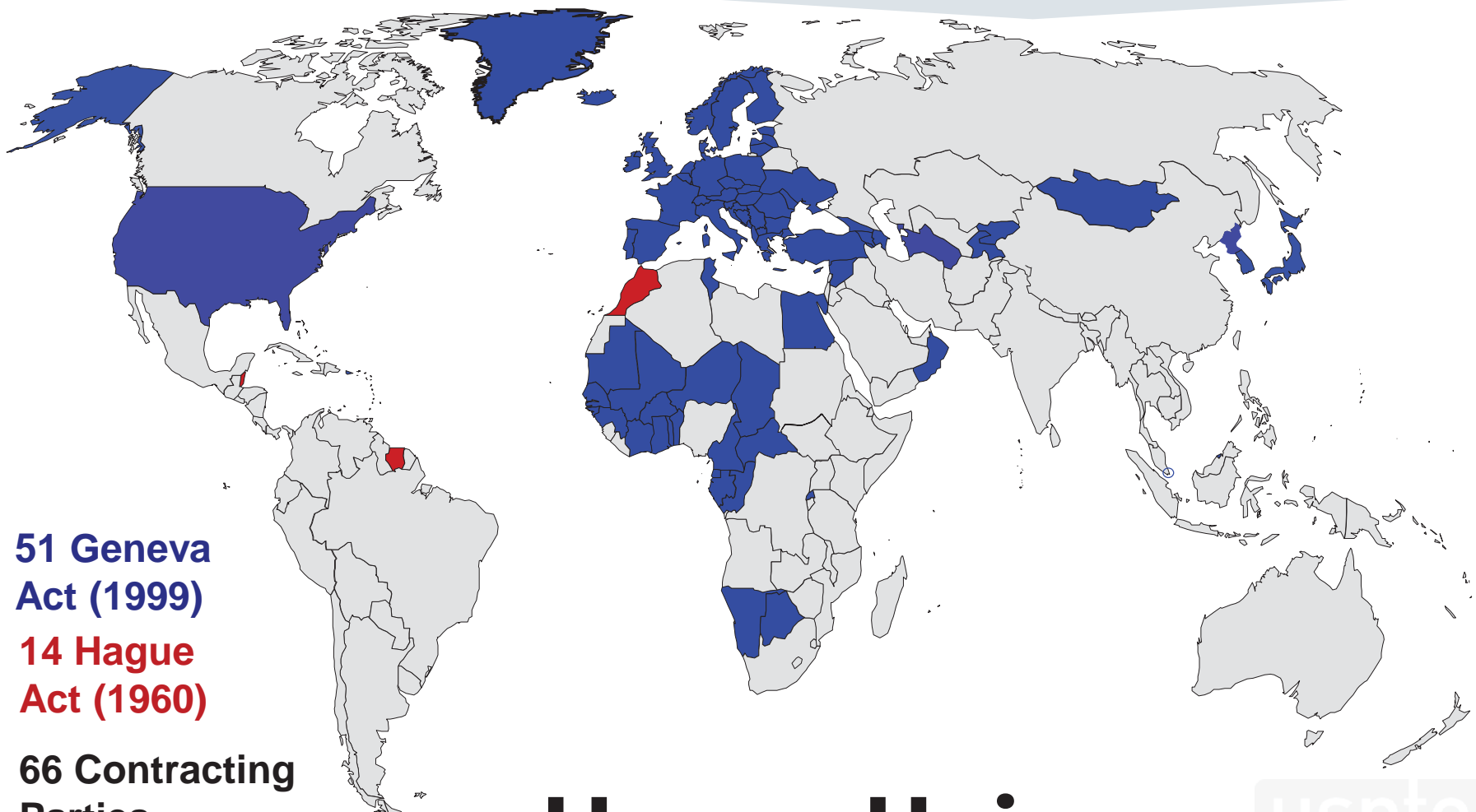


# PCT Filing Strategies

- 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

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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
  - <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
  - 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:
  - <http://www.wipo.int/hague/en/>
- USPTO Hague website:
  - <http://www.uspto.gov/patent/initiatives/hague-agreement-concerning-international-registration-industrial-designs>



# 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/>



# 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](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](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
  - <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](http://www.ipdl.inpit.go.jp/homepg_e.ipdl)



# USPTO Website – www.uspto.gov

- Search Patents
- Image File Wrapper
- Electronic Filing
- Fees

The screenshot shows the USPTO website homepage. At the top, the USPTO logo and 'UNITED STATES PATENT AND TRADEMARK OFFICE' are displayed. Navigation links for 'About Us', 'Jobs', and 'Contact Us' are in the top right. A search bar with the placeholder 'Search uspto.gov' is also present. Below the header, a navigation bar features tabs for 'Patents', 'Trademarks' (which is highlighted), 'IP Policy', and 'Learning and Resources'. A 'Quick links' button is on the right of the navigation bar. The main content area under the 'Trademarks' tab is organized into a grid. The top row includes 'Getting started' (with links like Trademark basics, Process overview, Trademark FAQs, etc.), 'Application process' (with links like Searching trademarks, Apply online, etc.), 'Maintaining a trademark registration' (with links like Keeping your registration alive, Forms to file, etc.), and 'Tools & links' (with links like Apply online (TEAS), Check application status (TSDR), Trademark fees, etc.). The bottom row features 'Learn about the process' (with sub-sections for Patents and Trademarks), 'Fees and payment', and 'Initiatives' (specifically the Enhanced Patent Quality Initiative).

# Electronic Filing – EFS-Web

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

The screenshot shows the EFS-Web interface for unregistered efilers. The title bar reads "EFS Unregistered". Below the title bar are three tabs: "Unregistered eFilers", "Registered eFilers", and "Please Read Announcements". The "Unregistered eFilers" tab is selected. The main content area has a heading "Welcome to Electronic Patent Filing for UNREGISTERED eFILERS". Below this heading is a red warning message: "A submission has not been filed officially at the USPTO until the e-filer executes the Submit function and the documents are received at the USPTO Eastern Time. The Acknowledgement Receipt is evidence of this submission. All items denoted by \* are required." Below the warning is a yellow advisory box with two messages: "Advisory (16APR2012) Online credit card processing in EFS-Web and EFS-Web Contingency will be unavailable Saturday, April 21, 6pm until 8pm(ET), due to Pay.gov maintenance." and "Advisory (6APR2012) When accessing EFS-Web and Private PAIR with Firefox, an error message may appear on the Authentication Page stating: Java Not Enabled. Please visit Java.com to upgrade to Java version6 update31. See the Announcements Page for more info." Below the advisory box is an "IMPORTANT:" section with a link to "Legal Framework for using EFS-Web". The main section is titled "Sign-on as an UNREGISTERED eFILER". It contains three input fields: "e-Filer Last Name:", "e-Filer First Name:", and "e-Filer E-Mail Address:". Below these fields is a section for "Main Functions" with two radio buttons: "New application" and "Existing application/patent". The "New application" radio button is selected. Below the radio buttons is a note: "(This includes new filings of continuation, divisional, and continuation-in-part applications. A request for continued examination (RCE) and continued prosecution application (CPA) are considered existing documents and must be filed as a registered eFiler.)". At the bottom of the form are three buttons: "Privacy Policy", "Cancel", and "Continue".

EFS Unregistered

Unregistered eFilers Registered eFilers Please Read Announcements

**Welcome to Electronic Patent Filing for UNREGISTERED eFILERS**

A submission has not been filed officially at the USPTO until the e-filer executes the Submit function and the documents are received at the USPTO Eastern Time. The Acknowledgement Receipt is evidence of this submission.  
All items denoted by \* are required.

**Advisory (16APR2012)** Online credit card processing in EFS-Web and EFS-Web Contingency will be **unavailable Saturday, April 21, 6pm until 8pm(ET)**, due to Pay.gov maintenance.

**Advisory (6APR2012)** When accessing EFS-Web and Private PAIR with **Firefox**, an error message may appear on the Authentication Page stating: Java Not Enabled. Please visit [Java.com](http://Java.com) to upgrade to Java version6 update31. See the [Announcements Page](#) for more info.

**IMPORTANT:** Please read [Legal Framework for using EFS-Web](#).

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