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

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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>
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<tbody>
<tr>
<td>BW Botswana</td>
<td>AL Albania</td>
<td>IS Iceland</td>
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<td>GH Ghana</td>
<td>AT Austria</td>
<td>IT Italy</td>
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<td>GM Gambia</td>
<td>BE Belgium</td>
<td>LI Liechtenstein</td>
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<td>KE Kenya</td>
<td>BG Bulgaria</td>
<td>LT Lithuania</td>
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<td>LS Lesotho</td>
<td>CH Switzerland</td>
<td>LU Luxembourg</td>
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<td>MW Malawi</td>
<td>CY Cyprus</td>
<td>LV Latvia</td>
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<td>MZ Mozambique</td>
<td>CZ Czech Republic</td>
<td>MC Monaco</td>
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<td>NA Namibia</td>
<td>DE Germany</td>
<td>MK Macedonia</td>
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<td>SD Sudan</td>
<td>DK Denmark</td>
<td>MT Malta</td>
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<td>SL Sierra Leone</td>
<td>EE Estonia</td>
<td>NL Netherlands</td>
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<td>SZ Swaziland</td>
<td>FI Finland</td>
<td>NO Norway</td>
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<td>TZ United Republic of Tanzania</td>
<td>FR France</td>
<td>PL Poland</td>
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<td>UG Uganda</td>
<td>GB United Kingdom</td>
<td>PT Portugal</td>
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<td>ZM Zambia</td>
<td>GR Greece</td>
<td>RO Romania</td>
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<td>ZW Zimbabwe</td>
<td>HR Croatia</td>
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<td>EA (EA)</td>
<td>HU Hungary</td>
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<td>TR Turkey</td>
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### 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
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 so as to control a paper feed operation; a paper feed driving intermediate gear; a print control lever adapted to be moved in association with the paper feed control cam and be releasably engaged therewith; a paper feed control lever adapted to be moved in association with the paper feed control cam and be releasably engaged with the ratchet wheel and an electromagnetic which is capable of generating a first return output for driving the paper feed control lever and a second return output for driving the paper feed control lever and the paper lever, whereas the paper feed control cam has such a shape as to engage the paper lever 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
Plant Patent

(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 ‘CURALIME’
(50) Latin Name: Curcuma elisatophilos
Varietal Denomination: Curalime

(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 ................................................ P06/421

(58) Field of Classification Search
CPC .................................................. A01H 5/00
USPC .................................................. P06/421
See application file for complete search history.

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

ABSTRACT
A new and distinct cultivar of Curcuma plant named ‘Curalime’, 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

- 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
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
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
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/](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
Public Search Page

[Image of the USPTO Patent Full-Text and Image Database search page]

Data current through October 25, 2016.

Patents from 1790 through 1975 are searchable only by Issue Date, Patent Number, and Current US Classification.
When searching for specific numbers in the Patent Number field, patent numbers must be seven characters in length, excluding commas, which are optional.
THANK YOU!

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