

Insights: Alerts

## 4 Key Takeaways: The Hague Agreement & Design Filings – Things You Need to Know & Do

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Kilpatrick Townsend partner **Babak Kusha**, along with a panel of other thought leaders, recently presented a Knowledge Group webinar on the topic of “The Hague Agreement and Design Filings.” The Hague Agreement is an international treaty that provides a design protection registration system for designated member countries and intergovernmental organizations.

**Key takeaways from the presentation include:**

- **The Hague System is short for the WIPO-administered Hague System for the International Registration of Industrial Designs.**
  - Hague Convention Treaty went into effect for the U.S. on May 13, 2015.
  - U.S. design patents resulting from applications filed on or after May 13, 2015 will have a 15-year term.
  - U.S. applicants are allowed to request design protection in the European Union and 66 contracting parties of the Geneva Act of the Hague Agreement.
  - Non-U.S. applicants can file a Hague design application designating the U.S. for examination by the USPTO.
- **Worldwide Hague International applications grew by over 35% in 2016.**
  - The high growth is due to the Hague System’s expansion to:
    - Japan
    - U.S.
    - The Republic of Korea
  - The Hague System continues to expand geographically:
    - 66 members
    - 83 countries
  - The Hague Agreement offers a simplified procedure for filing in all member countries, there are some advantages:
    - A single set of formalities.
    - A single set of drawings is used in all designated countries.
    - Drawing requirements may be different in some countries.
    - Local examination process and legal standards remain unchanged.

- Advice: Carefully plan and select countries where product is sold or sourced and consider strengths/issues for enforcement.
- **Here are two views of The Hague System.**
  - Applicant's view – what is good:
    - A cost-effective way to get design protection in many countries.
    - Can include many designs in one application.
    - Single, unified process.
    - Overcome some shortcoming in national systems – due to harmonization.
  - Attorney's view:
    - Will need to know laws in every jurisdiction.
    - Local associate is now out of the loop.
    - O.K. if national or regional office does not substantively examine.
    - Likely to be much more expensive to fix, so D.I.R.F.T. (do it right the first time).
    - Getting the best design rights.
    - Should know the laws in every designated country.
    - Minimize challenges for enforcement.
    - Push past formalities.
- **Should clients use the Hague Convention?**
  - Yes, when it makes business sense for the client.
  - Benefits:
    - Minimizes law firm fees – avoid multiple filings, one fee to be paid.
    - Minimizes administration – bypasses additional 6-month inquiry.
    - Broader and quicker initial coverage.
    - Application will publish, but publication can be delayed.
  - Challenges:
    - Similar up-front official fees.
    - One size does not fit all.
    - Limited, albeit growing, membership.
    - Insufficient experience to know where problems may arise.

## Related People

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