Kilpatrick

Insights: Perspectives

4 Key Takeaways: The Hague Agreement: Recent Trends and Developments

MARCH 28, 2018

KILPATRICK TOWNSEND

4 KEY TAKEAWAYS

The Hague Agreement: Recent Trends and Developments

Kilpatrick Townsend partner Babak Kusha, along with a fellow thought leader, recently presented a Knowledge Group webinar on the topic of "The Hague Agreement and Design Filings: Recent Trends and Developments in 2018." Below are key points from the latest presentation that provides an update to his first presentation in October 2017.

Key takeaways include:

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The Hague System continues to expand with significant new members, including Canada, Russia, and the UK -- which is the most recent and the 54th member of the 1999 Act and 68th member of the Hague Union:

- ◊ Russia joined as of February 28, 2018.
- ◊ The 1999 Act will enter into force in the UK on June 13, 2018.
- ◊ Canada is amending law to join by ~2019.

Factors favoring client's decision to file a Hague International Design Application (IDA):

- ◊ Value of the designation and publications fees.
  - Recording in the International Register.
  - Publication in the International Design Bulletin.
- ◊ A valuable international business asset.
- ◊ Cost calculus: what is the tipping point for cost effectiveness?
  - Probably when the client wants to file in three to four countries.
  - Compare: for an 8 Fig, 1 design, 2 page/500 word design:
    - Direct: U.S. ~$3,500 - $4000, EU ~$2,100, Japan ~$2,400 = ~$8,000 - $8,500.
    - Hague IDA: Designating U.S., EU, & Japan ~$6,100.

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Factors for practitioners:

- ◊ More efficient asset management.
  - All the asset procurement strategy and thinking is done once to prepare a set of design patent applications.
  - Client receives proper advice and quality work and design drawings for the initial filing. Such drawings are prepared at the time of filing with proper due consideration.
  - Efficiencies are realized with an integrated process.
  - Using the Hague IDA, the entire series of U.S. and foreign applications are managed under the same authority from the start.
- ◊ Current U.S. design practitioners, especially those with international design

- Efficiencies are realized with an integrated process.
- Using the Hague IDA, the entire series of U.S. and foreign applications are managed under the same authority from the start.

◊ Current U.S. design practitioners, especially those with international design experience are best suited to leverage their experience to help procure good rights for their clients using the Hague System.

Canada Update:

- Canada will join in 2019.
- Designs are registrable.
- Requirement for novelty – a disclosure must be within 12 months of the priority date of the design in the application.
- Utilitarian function – protection is not available for features applied to a useful article that are dictated solely by a utilitarian function of the article.
- One design per application – need for divisional practice.
- Self-collision – in case of self-collision, the later-filed design would not be blocked by the initial design if it was filed within 12 months of the filing date of the initial registered design.

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For more information, please contact Babak Kusha at bkusha@kilpatricktownsend.com

www.kilpatricktownsend.com

Related People



Babak Kusha
t 415.273.7512
bkusha@ktslaw.com