



Insights: Perspectives

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

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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 - \$4,000, 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 experience are best suited to leverage their experience to help procure good rights for their clients using the Hague System.

- 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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Related People



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