



U.S. Implementation of the Hague Agreement – Practical Considerations and Guidance for Design Patent Applicants

It is expected that the U.S. will implement provisions of the Hague Agreement later this year. This will enable an applicant to seek design protection in all member countries by filing a single design patent application. Additionally, the mechanics for recording changes or renewing the registration will be streamlined compared to current processes, requiring only a single step. The list of member countries is expected to grow, and with the addition of the Republic of Korea this summer, there will be 62 member countries. Other countries, such as Canada, Japan and China, are expected to join once the U.S. has signed on.

Applicants need be wary of certain pitfalls, though. While a Hague application can contain up to 100 designs, many member countries do not permit that approach. For instance, in the U.S., an application can only contain a “single inventive design.” Therefore, a Hague application with multiple designs likely will force the applicant to decide whether to file multiple divisional applications to protect the additional designs or to abandon some of the designs that were included in the original Hague application. Either way, that can be a costly undertaking.

We believe that U.S. applicants will appreciate being able to rely upon the Hague Agreement to obtain patent protection in the more popular member jurisdictions such as the European Union. However, when filing a Hague application, it is crucial to understand the drawing requirements and examination procedures of the member countries designated by the applicant to ensure successful registration in all designated member countries. This will be especially true for non-U.S. applicants seeking U.S. design patent protection through the Hague system, in view of the strict examination procedures employed by the U.S. Patent Office. The national drawing requirements include rules concerning the number and type of views that should be presented, whether photographs are permitted, whether surface shading is permitted, and whether subject matter can be disclaimed in the drawings.

When design protection is sought in the U.S. or abroad under the Hague system, we recommend that applicants obtain the skilled guidance of U.S. counsel. If we can help, please contact Ed Ellis, the head of our patent practice, at ellis@leasonellis.com.

NEWS, MEDIA, AND UPDATES:

IP Today came out with its listing of top trademark firms. See <http://goo.gl/DqkxcU>. Leason Ellis is ranked among the top fifty firms!

Paul Fields will discuss U.S. trademark infringement proceedings in a workshop at the 33rd Annual Conference of the European Community Trade Mark Association (ECTA) in Alicante, Spain on June 18, 2014. See <http://conference.ecta.org/programme>.

As part of its ongoing outreach to independent inventors, entrepreneurs and businesses, the United States Patent and Trademark Office, in cooperation with Congressman Hakeem Jeffries, hosted a seminar in Brooklyn on May 17, 2014. USPTO officials conducted an all-day workshop alongside intellectual property professionals, like our own David Leason, in providing attendees with valuable information about the different types of IP protection and the patent and trademark application process. See <http://goo.gl/AV1fGL>.

Marty Schwimmer appeared on another episode of This Week in Law, this time to speak about parody and satire. Check it out at <http://twit.tv/show/this-week-in-law/253>.

Marty Schwimmer was also one of the four trademark bloggers who appeared at Meet the Bloggers X at INTA 2014 on May 12, 2014 at the Royal Hong Kong Yacht Club. See bit.ly/1kSHcxt.



Marty Schwimmer at Meet the Bloggers at INTA 2014

Mel Garner participated in a mock oral argument for the New York Intellectual Property Law Association at its Annual Meeting on May 20, 2014. The CLE workshop was entitled “Mock Oral Argument Contemplating the Implications of the Revised Statement for Attorney Fees under 35 U.S.C. § 285.” See <http://goo.gl/Y25RDC>.

Peter Sloane was a panelist in a CLE webinar on “Trademark Application Pre-Filing Strategies: Overcoming the Obstacles” on April 8, 2014. See <http://goo.gl/mQHwQf>.

Joel Felber was quoted in an online article of Westfair Business Publications. The article, titled “Neutrality of web turned on its head,” addressed the deal between Comcast and Netflix, the first in which a content provider has agreed to pay for Internet access since a federal appeals court struck down the Federal Communications Commission’s net neutrality rules in January. See <http://goo.gl/uWSXc9>.

Peter Sloane and Jonathan Thomas have teamed up once again to publish an article in the Federal Bar Council Quarterly. This time, Peter and Jonathan wrote about the Second Circuit’s decision in Starbucks Corp. v. Wolfe’s Borough Coffee, Inc. d/b/a Black Bear Micro Roastery, 736 F.3d 198 (2d Cir. 2013). The article can be found at <http://goo.gl/kyaOYo>.

Peter Sloane moderated a Roundtable for the International Trademark Association at our offices on March 20, 2014. The topic of the INTA Roundtable was “Trademark Litigation from A to Z.” See <http://goo.gl/Ke98Z9>.

Representing Party City in a Canadian domain name proceeding, Leason Ellis obtained a favorable decision to recover the domain names party-city.ca and partycitycanada.ca. You can find a copy of the decision at www.cira.ca/assets/Documents/Legal/Dispute/2014/00245-partycity-ca.pdf.

