

U.S. Implementation of the Hague Agreement



Hague Agreement Public Forum
Madison South Auditorium
United States Patent and Trademark Office
Tuesday, January 14, 2014



Hague Forum Agenda

- **Overview of the Hague System**
 - Basic Principles & Procedures
 - Road to U.S. membership
- **Discussion of Rules in USPTO NPRM**
 - New subpart I specific to “int’l design apps” (IDAs)
 - Changes to existing rules to accommodate IDAs
- **Fees and associated rules in USPTO NPRM**

Hague Overview



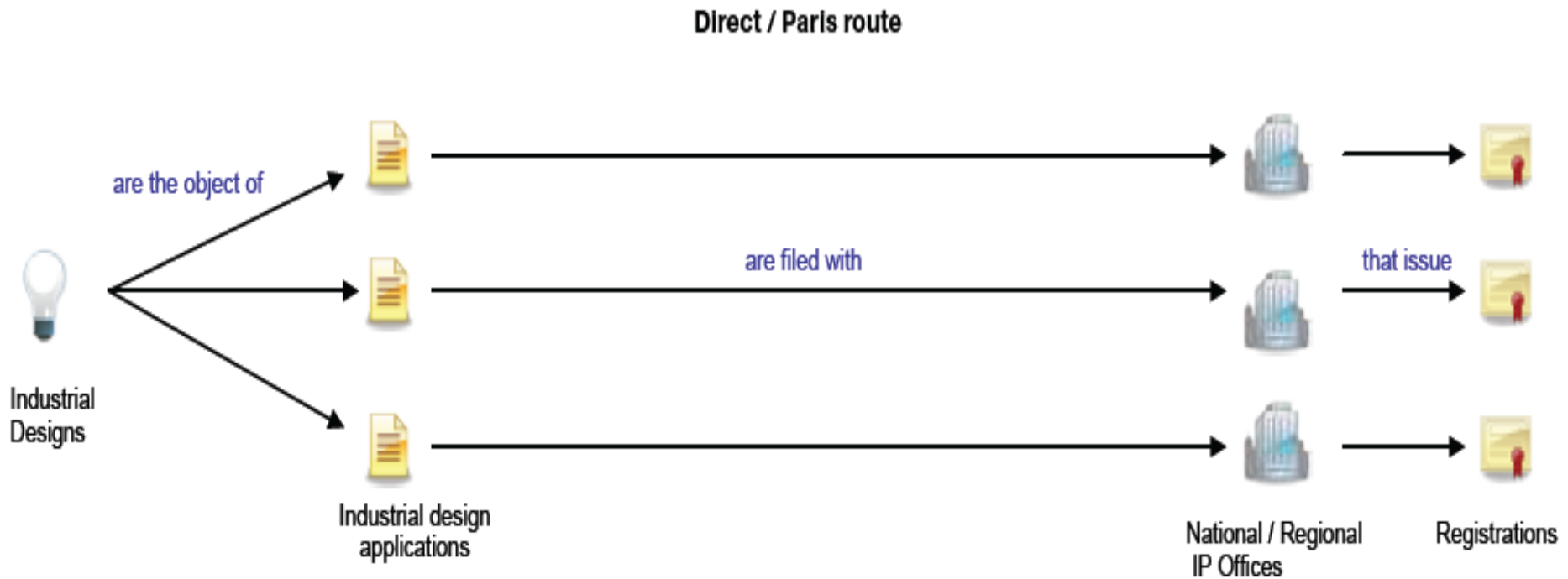
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Hague System: Basic Principles & Procedures





Direct/Paris Route Filings



**2013 Hague Yearly Review (WIPO)*

http://www.wipo.int/export/sites/www/freepublications/en/designs/930/wipo_pub_930_2013.pdf



Hague System: Basic Concept

- Centralized acquisition and maintenance of industrial design rights by
 - filing a *single international design application*
 - for a *single international registration*
 - with *effect in one or more designated Contracting Parties.*



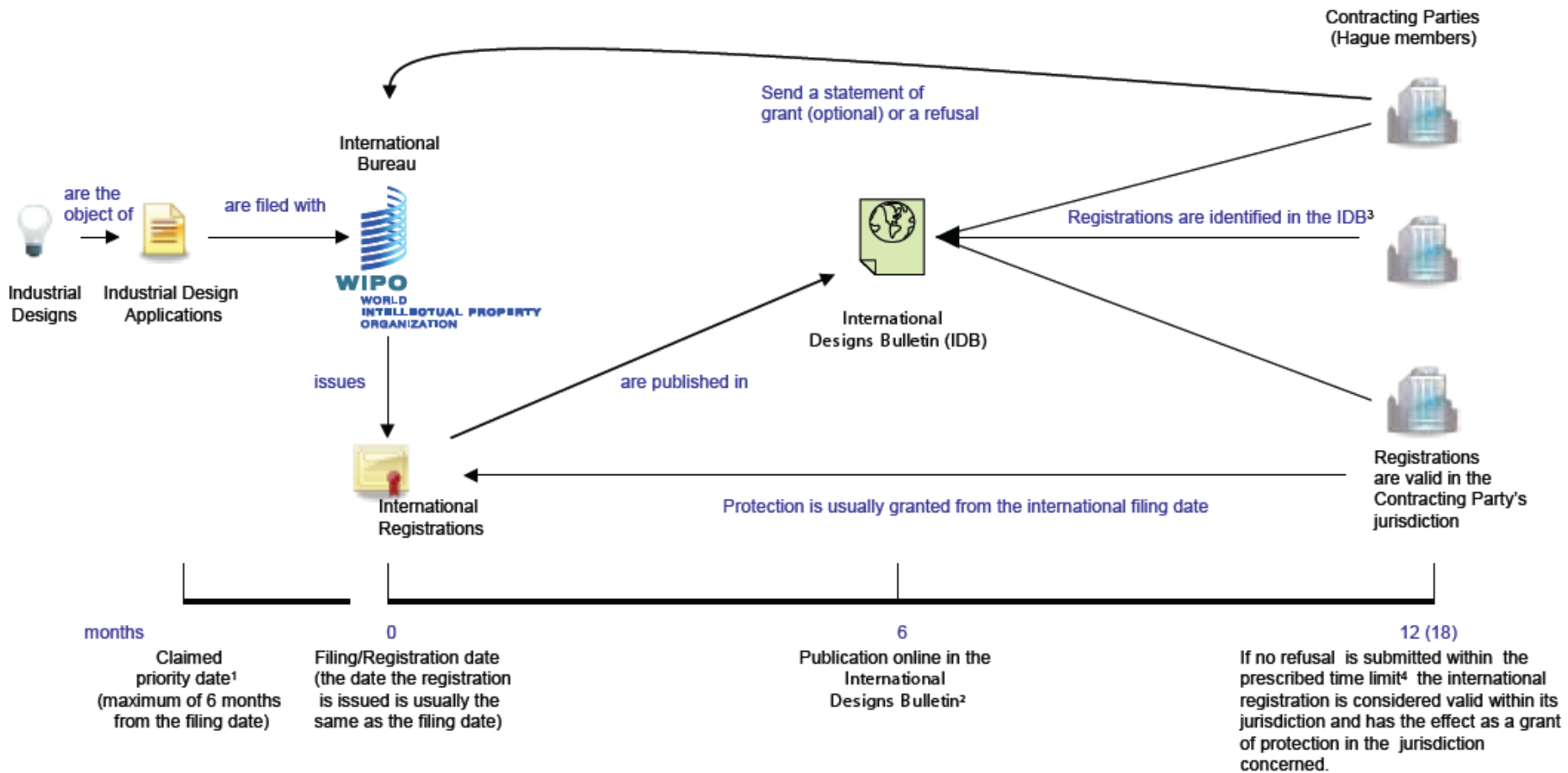
Comparison with PCT & Madrid

- Like PCT and Madrid: a procedural treaty
- Like Madrid, unlike PCT: a registration treaty
 - Acquisition and maintenance of rights
- Unlike Madrid, it's a “one-stop shop”
 - No basic application required
 - Filings directly with WIPO
 - www.wipo.int/hague/en
 - Self-designation possible
 - No “office of origin” role



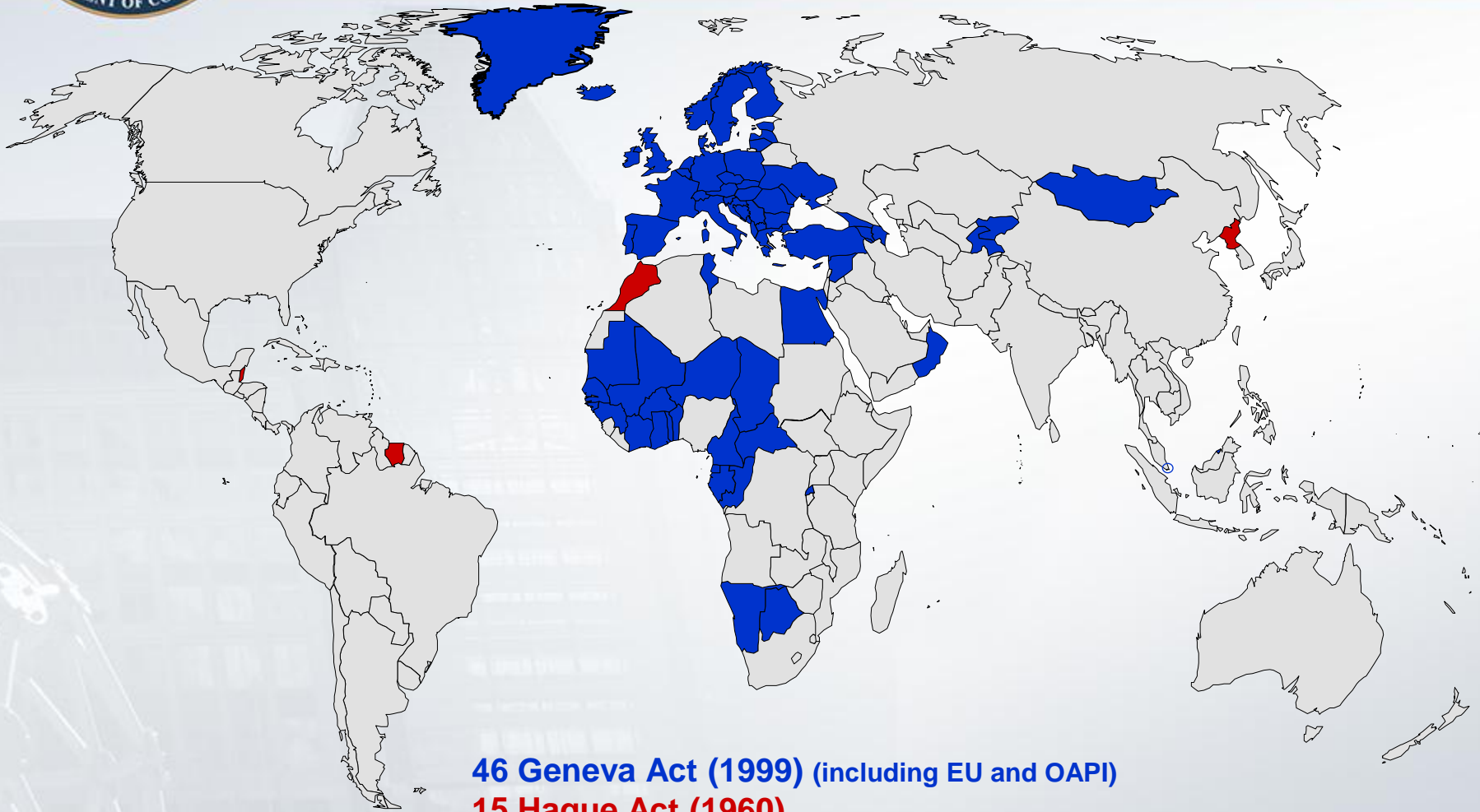
Hague System

The Hague system





Hague Union



61 Contracting Parties



Who can use the Hague System?

- Hague System is a closed system
- Need entitlement to file – “Contracting Party”
 - Nationality
 - Domicile
 - Habitual residence
 - Real and effective industrial or commercial establishment



Filing an International Application

- Language: English, French, or Spanish
- Directly with WIPO, electronically or on paper
- Indirectly through USPTO
- Up to 100 different designs (same Locarno class)
- Single set of requirements apply
- Single set of fees is to be paid (in CHF)



Role of International Bureau (IB)

- Examination of Formalities
- Translation into two other languages
- Recording of the IR in the International Register
- Crediting of designation fees to accounts of CPs
- Publication in the International Designs Bulletin
 - every Friday on WIPO's website

<http://www.wipo.int/hague/en/bulletin/haguebulletin/index.jsp>



Procedure at Designated CP

- **Normal Substantive Examination by Office:**
 - To the extent it applies to national filings
 - However, no “formalities” examination, as this is handled by the IB
- **Possible Refusal:**
 - Made on same substantive grounds as for national filings
 - Communicated within time limit (6 or 12 months) depending on CP



Hague System in 2012

Description	Number of apps/regs	Number of designs	Growth
International Applications	2604	12,454	+3.5%
International Registrations	2440	11,971	+8.1%
Designations in International Registrations	12,786	60,356	+9.7%
Renewals of International Registrations	3,120	11,872	+13.9%
International Registrations in Force	26,284	110,158	+1.3%



Illustrative Statistics and Figures

Table A.5.2 Designs contained in registrations for the top 10 origins and designated Hague members, 2012

Origin	Designated Hague member									
	EU	CH	TR	UA	SG	NO	HR	MA	LI	RS
Germany	2,690	3,365	1,809	608	345	650	862	278	388	473
Switzerland	2,171	2,014	1,179	969	995	707	531	729	701	264
France	1,081	973	664	217	498	171	198	549	55	95
Italy	735	808	270	136	127	94	68	56	111	27
Austria	183	237	86	56	49	41	75	0	32	166
Netherlands	114	186	147	102	76	175	45	38	2	13
Belgium	133	135	121	80	56	57	76	103	24	80
United States of America	469	118	98	35	32	0	0	23	0	0
Finland	107	102	92	92	78	43	84	0	78	0
Turkey	181	29	36	73	1	1	48	0	0	44
Others	1,097	835	608	485	274	450	389	77	108	332
Total	8,961	8,802	5,110	2,853	2,531	2,389	2,376	1,853	1,499	1,494

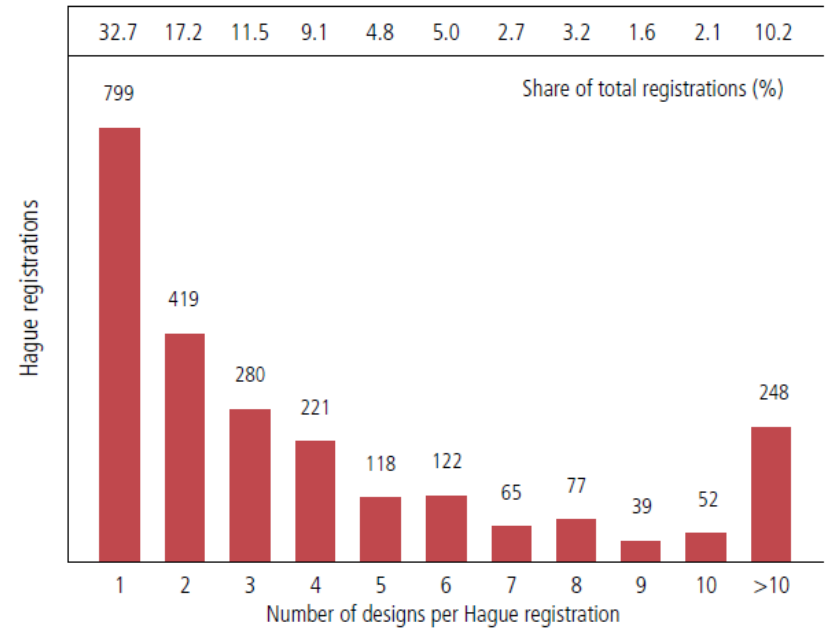
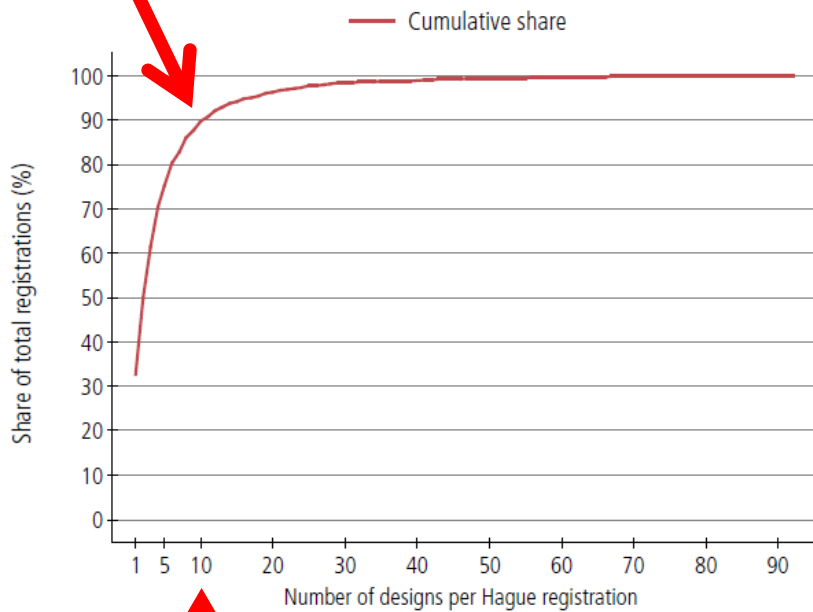
Note: The top 10 origins are based on the number of designs contained in Hague registrations. EU (European Union), CH (Switzerland), TR (Turkey), UA (Ukraine), SG (Singapore), NO (Norway), HR (Croatia), MA (Morocco), LI (Liechtenstein) and RS (Serbia).

Source: WIPO Statistics Database, February 2013



Illustrative Statistics and Figures

Figure A 2.3 Distribution of designs per international registration, 2012



Source: WIPO Statistics Database, February 2013



Illustrative Statistics and Figures

Table A.1.2 Top Hague applicants

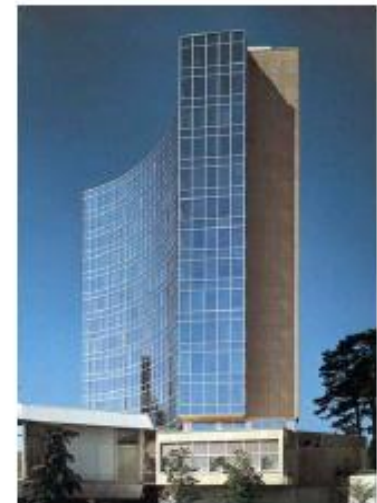
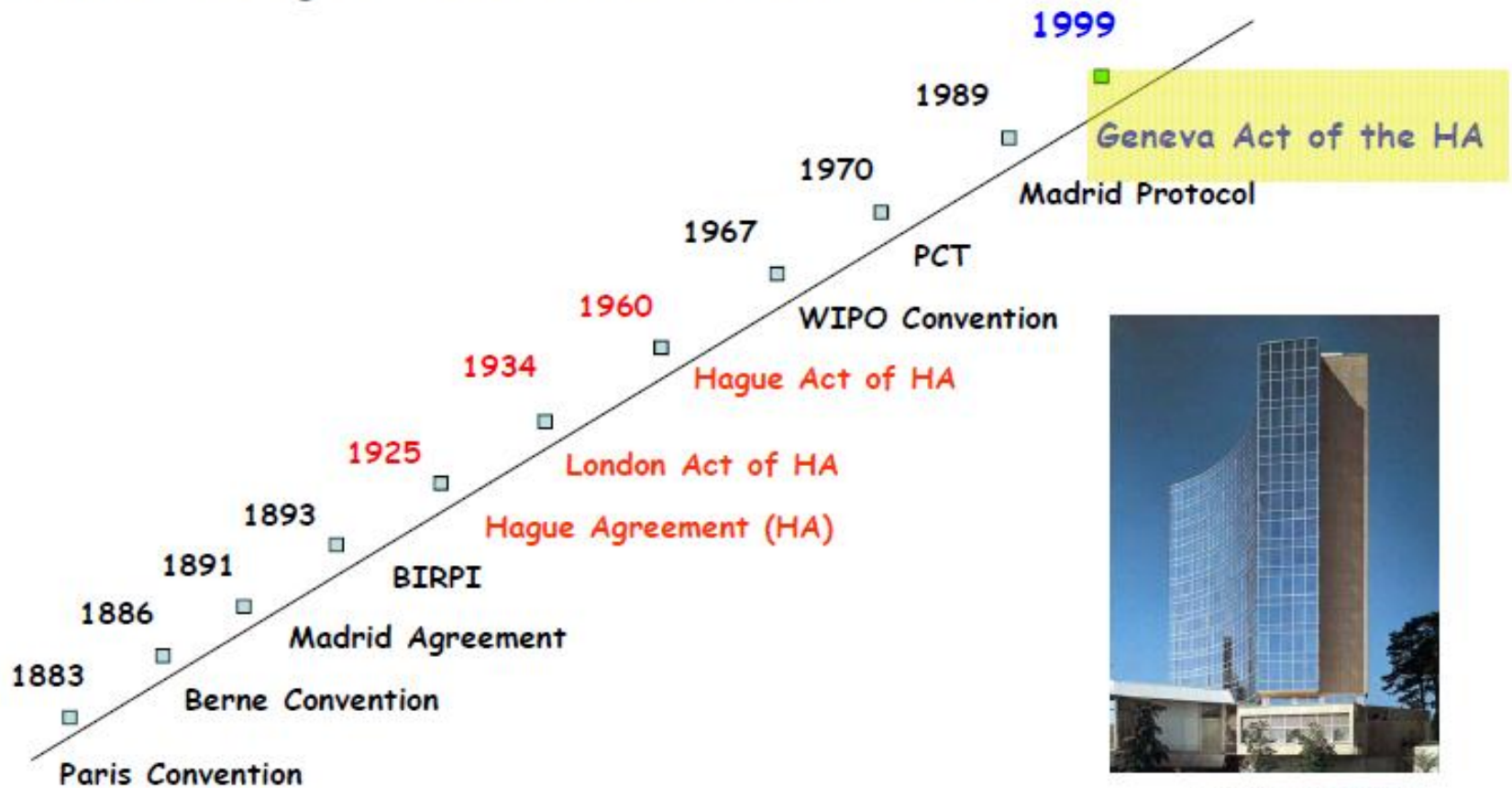
2012 Rank	Applicant's Name	Origin	Hague International Applications		
			2010	2011	2012
1	SWATCH AG (SWATCH SA)(SWATCH LTD)	Switzerland	75	79	81
2	DAIMLER AG	Germany	36	55	75
3	KONINKLIJKE PHILIPS ELECTRONICS N.V.	Netherlands	87	64	67
4	THE PROCTER & GAMBLE COMPANY	United States of America	129	167	57
5	AUDI AG	Germany	0	0	54
6	SOCIÉTÉ DES PRODUITS NESTLÉ S.A.	Switzerland	24	47	43
7	VOLKSWAGEN AG	Germany	46	38	40
8	LIDL STIFTUNG & CO. KG	Germany	20	28	32
9	HERMES SELLIER	France	14	15	29
9	THE GILLETTE COMPANY	United States of America	44	56	29
11	ALFRED KÄRCHER GMBH & CO. KG	Germany	18	15	25
12	SAVERGLASS	France	0	3	23
13	THUN SPA	Italy	0	8	22
14	VESTEL BEYAZ ESYA SANAYI VE TICARET ANONIM SIRKETI	Turkey	52	40	19
15	HENKEL AG & CO. KGAA	Germany	4	10	16
15	KOZIOL IDEAS FOR FRIENDS GMBH	Germany	0	5	16
17	CARTIER CRÉATION STUDIO SA	Switzerland	18	11	13
17	PHILIP MORRIS BRANDS	Switzerland	0	3	13
17	SALOMON S.A.S.	France	0	7	13
17	TOD'S S.P.A.	Italy	0	7	13
21	VITRA PATENTE AG	Switzerland	0	0	11
21	HANSGROHE SE	Germany	10	8	11
21	MAPED	France	12	14	11
21	RENAULT SAS	France	0	0	11
25	NOVARTIS AG	Switzerland	0	9	10

Source: WIPO Statistics Database, February 2013

Hague System: The Road to U.S. Membership



Hague System and Other Major Events From 1883



WIPO | HAGUE
The International
Design System



Road to U.S. Membership

- **July 6, 1999** – United States signed Agreement
- **December 7, 2007** – The Senate considered; Advice and consent to ratification agreed to in Senate
- **December 18, 2012** – President Obama signed into law the Patent Law Treaties Implementation Act of 2012, implementing legislation for the Hague Agreement (and the Patent Law Treaty (PLT))
- **November 29, 2013** – Notice of Proposed Rulemaking Published in Federal Register



Notice of Proposed Rulemaking

- Notice of Proposed Rulemaking can be found in the Federal Register at:
- <https://www.federalregister.gov/articles/2013/11/29/2013-28262/changes-to-implement-the-hague-agreement-concerning-international-registration-of-industrial-designs>
- Deadline for Comments...



Where to Submit Comments

- By **electronic mail over the Internet** addressed to: AC87.comments@uspto.gov (*preferred*)
- By **postal mail** addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, marked to the attention of Boris Milef, Senior PCT Legal Examiner, Office of PCT Legal Administration
- By **electronic mail over the Internet** via the **Federal eRulemaking Portal**. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions



What's Ahead on the Road to U.S. Membership?

- Review and consideration of public comments
- Preparation of final rules
- Information technology and processing preparation for membership
- Continued collaboration with WIPO to integrate systems, processing and operation

Discussion of Proposed Rules



Boris Milef
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United States Patent and Trademark Office



Proposed Changes to Regulations (37 CFR)

- Notice of Proposed Rulemaking published
 - 78 Fed. Reg. 71870 (November 29, 2013)
- Implements Title I of the Patent Law Treaties Implementation Act of 2012 (PLTIA), Public Law 112-211, 126 Stat. 1527 (2012)
 - Enacted December 18, 2012



Proposed Changes to Regulations (37 CFR)

- New subpart I specific to international design applications (IDA)
 - USPTO as an office of indirect filing
 - Form and content requirements
 - National processing provisions
- Changes to various existing rules to accommodate IDAs

Discussion of Proposed Rules:

New Subpart I





New Subpart I - § 1.1011 Applicant

Applicants - Filing through the USPTO:

- Applicant must have at least one of the following U.S. connections:
 - Nationality
 - Domicile
 - Habitual residence
 - Real and effective industrial or commercial establishment



New Subpart I - § 1.1011 Applicant (con't)

Applicants - U.S. examination phase:

- If U.S. is designated, the IDA may be refused in the U.S. examination phase if the applicant is not:
 - Sole or joint inventors
 - Legal representative of deceased or legally incapacitated inventor
 - Assignee/obligated assignee/person having sufficient proprietary interest



New Subpart I - § 1.1021 Contents

§ 1.1021 sets forth:

- Mandatory contents for IDAs
- Additional mandatory contents
- Optional contents
- Certain requirements where the U.S. is designated



New Subpart I - § 1.1021 Mandatory Contents

Mandatory contents (§1.1021(a)):

IDA shall be in English, French, or Spanish and shall contain:

1. Request for international registration
2. Prescribed data concerning the applicant
3. Copies of the reproduction(s) of the industrial design(s) as prescribed
4. Indication of the product(s) that constitute the industrial design or in relation to which the industrial design is to be used



New Subpart I - § 1.1021 Mandatory Contents (con't)

Mandatory contents (con't)

5. Designation of a Contracting Party (CP)
6. Basis for applicant's entitlement to file
7. An indication of applicant's CP
8. Specify the number of industrial designs (not to exceed 100) and number of reproductions
9. Prescribed fees/payment information



New Subpart I - § 1.1021 Additional Mandatory Contents

Additional mandatory contents (§1.1021(b)):

- Where the IDA designates a CP that requires for a filing date:
 - i. Identity of the creator
 - ii. A brief description of the reproduction or of the characteristic features of the industrial design, **and/or**
 - iii. A claim
- Then, these respective additional mandatory contents are also required



New Subpart I - § 1.1021 Optional Contents (con't)

Optional contents (§ 1.1021(c)):

1. A request for deferred or immediate publication
2. Identity of the creator and brief description (if not mandatory)
3. The name/address of applicant's representative
4. A claim of priority under the Paris Convention
5. A declaration, for purposes of Article 11 of the Paris Convention, concerning a showing at an international exhibition



New Subpart I - § 1.1021 Optional Contents (con't)

Optional contents (con't)

6. Any declaration, statement or other relevant indication specified in the Admin. Instructions
7. A statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned
8. A proposed translation of any text matter contained in the IDA for purposes of recording and publication



New Subpart I - § 1.1021 Contents – U.S. Designation

Where U.S. is designated (§ 1.1021(d)):

IDA must include:

1. A claim
2. Indications concerning the identity of the creator(s)
3. The inventor's oath or declaration
 - Information required under §§ 1.63(b) and 1.64(b) that may be presented in an ADS may be satisfied by presenting such information in the IDA



New Subpart I - § 1.1022 Form and Signature

The IDA shall be:

- presented on the IB's form (DM/1) or a form having the same contents and format
- signed by the applicant



New Subpart I - § 1.1023 Filing Date in the United States

- The filing date of an IDA in the United States is the international registration date
- Provides for review of the filing date upon petition. The petition must include:
 1. A showing that the IDA is entitled to the requested filing date, and
 2. Petition fee (§ 1.17(f))



New Subpart I - § 1.1024 Description

- IDAs that designate the U.S. *must* include a specification as prescribed by 35 U.S.C. 112
- Provides that the description requirements set forth in Rule 11(2) (i.e., that the description “shall concern those features that appear in the reproductions”) may apply to designated CPs other than the U.S.



New Subpart I - § 1.1025 Claim

- For IDAs that designate the U.S.:
 - *the specific wording of the claim shall be in formal terms to the ornamental design for the article (specifying name of article) as shown, or as shown and described*
- More than one claim is neither required nor permitted for purposes of the United States.



New Subpart I - § 1.1026 Reproductions

- Reproductions shall comply with Rule 9 and Part Four of the Administrative Instructions
 - Rule (9)(4): a CP may refuse on grounds that the reproductions “are not sufficient to disclose fully the industrial design”
- Some notable provisions:
 - Photographs and/or other graphic representations
 - Color or black/white
 - Shading/hatching permitted



New Subpart I - § 1.1026 Reproductions (con't)

- Some notable provisions (con't):
 - Must be of “professional standard” and “of a quality permitting all details of the industrial design to be clearly distinguished and permitting publication”
 - Matter shown but for which protection is not sought may be indicated in the description and/or by dotted or broken lines



New Subpart I - § 1.1041 Representation

- Applicant may appoint a representative **before the IB** in accordance with Rule 3
 - May be made in the IDA or in a separate communication signed by the applicant
 - No restriction as to who may be appointed, but only one representative may be appointed
 - If more than one representative is indicated, the one indicated first is considered the representative
 - A law firm is regarded as one representative



New Subpart I - § 1.1041 Representation (con't)

- **Before the USPTO as an indirect office**, applicant may be represented by a practitioner registered (§ 11.6) or granted limited recognition (§§ 11.9(a) or (b))
 - May act pursuant to § 1.34 or be appointed in writing signed by the applicant specifying the practitioner's name and registration number



New Subpart I - § 1.1045 Transmittal to the IB

- Transmittal of the IDA to the IB is subject to security review and payment of the transmittal fee
 - Applicant will be notified of the transmittal and of the receipt date accorded to the IDA
- Any follow-on submission received by the Office after transmittal will generally not be forwarded to the IB



New Subpart I - § 1.1051 Petition to Excuse Delay

35 U.S.C. 387:

“An applicant’s failure to act within prescribed time limits in connection with requirements pertaining to an international design application **may be excused as to the United States** upon a showing satisfactory to the Director of **unintentional delay** and under such conditions, including a requirement for payment of the fee specified in section 41 (a)(7), as may be prescribed by the Director.”



New Subpart I - § 1.1051 Petition to Excuse Delay (con't)

A petition under § 1.1051 requires:

1. A copy of any IB invitation setting a prescribed time limit for which applicant failed to timely act
2. The required reply
3. The petition fee (§ 1.17(u))
4. A certified copy/English translation of the IDA (if required)
5. A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional



New Subpart I - § 1.1051 Petition to Excuse Delay (con't)

- The “required reply” may be:
 - The filing of a continuing application
 - A filing date petition under § 1.1023(b) is required if the IDA has not been accorded an international reg. date
 - A grantable petition under § 1.1052 to convert to a regular design application



New Subpart I - § 1.1052 Conversion to Ch.16 Design

35 U.S.C. 384(a):

“...Notwithstanding the provisions of this part, any international design application designating the United States that otherwise meets the requirements of chapter 16 may be treated as a design application under chapter 16.”



New Subpart I - § 1.1052 Conversion (con't)

- Conversion under § 1.1052 requires:
 - U.S. to have been designated
 - IDA that meets the requirements under § 1.53(b) for a filing date for a design application
 - IDA must have been filed with the Office as an indirect office
 - fee set forth in § 1.17(v)
 - petition filed prior to WIPO publication of the IR



New Subpart I - § 1.1052 Conversion (con't)

- If conversion is granted prior to transmittal of the IDA to the IB:
 - IDA will be converted *in toto*
 - no refund of transmittal fee
- If conversion is granted after transmittal of the IDA to the IB:
 - effective only for the U.S.
 - no refund of transmittal fee or fees forwarded to the IB



New Subpart I - § 1.1052 Conversion (con't)

- Conversion will not be granted in an abandoned IDA absent a grantable petition under § 1.1051



New Subpart I National Processing Provisions

- National processing provisions §1.1061 et al.



New Subpart I- § 1.1061 Rules Applicable

- §1.1061(a) provides:
“The rules relating to applications for patents for other inventions or discoveries are also applicable to international design applications designating the United States, except as provided in this chapter or required by the [Hague] Articles or Regulations”
- §1.1061(b) specifically excludes:
 - § 1.84 (drawing requirements)
 - §§ 1.152-1.154 (U.S. design applications)



New Subpart I- § 1.1062 Examination

- Examination pursuant to Title 35 U.S.C.
- Prohibits refusals based on requirements relating to *form or content* provided for under the Treaty or additional to or different from those requirements
- *Timing: Any notification of refusal* to be sent to the IB within 12 months from publication of the IR
 - Exception where delay was unintentional



New Subpart I- § 1.1063

Notification of Refusal

A notification of refusal shall contain or indicate:

1. International registration number
2. Grounds for refusal
3. Where the grounds of refusal refer to similarity with an industrial design that is the subject of an earlier application or registration, a copy of a reproduction of the earlier industrial design and information concerning the earlier industrial design as required under Hague Rule 18(2)(b)(iv)
4. A time period for reply under § 1.134 and § 1.136



New Subpart I- § 1.1063 Notification of Refusal (con't)

- Replies
 - must be filed directly with the Office and not through the IB
 - U.S. rules governing replies to Office actions in regular applications apply to replies to notifications of refusal



New Subpart I- § 1.1064 1 Independent & Distinct Design

- Only one independent and distinct design may be claimed
- Otherwise, the examiner shall require applicant to elect one independent and distinct design for prosecution
 - May be made in the notification of refusal or other Office action



New Subpart I- § 1.1066 Correspondence

- The address of applicant's representative (or if no such address, applicant's address) set forth in the published IR will be used as the correspondence address unless changed
 - May be changed by the parties set forth in §1.33(b)(1) or (b)(3) in accordance with §1.33(a)



New Subpart I- § 1.1067 Title; Inventor's Oath

- *Title*: May be established by the Office if not present; must designate the particular article
- *Inventor's oath or declaration*: Provides for notifying the applicant in a notice of allowability that an inventor's oath or declaration is required no later than the date on which the issue fee is paid to avoid abandonment



New Subpart I- § 1.1069 Notification of Division

- Provides for sending of a *notification of division* to the IB in a divisional application of an IDA filed as a result of a restriction requirement in the IDA
 - Informs the IB of the designs in the IR that are being pursued in a U.S. divisional
- The examiner may require applicant to identify the corresponding designs if unclear

Discussion of Proposed Rules:

Proposed Changes to Current Rules





Proposed Changes to Current Rules

§ 1.9 - Definitions

- **“national application” and “nonprovisional application”**
 - include IDAs for which the Office has received a copy of the international registration from the IB pursuant to Article 10
- **“international design application”**
 - Reference to “design application” or “application for a design patent” in the rules includes IDAs unless otherwise clear from wording



Proposed Changes to Current Rules § 1.6 and § 1.8

- Prohibits filing by facsimile with the Office
 - IDAs
 - color drawings in IDAs
- If filed by facsimile, no receipt date will be accorded



Proposed Changes to Current Rules

§ 1.14 - Access

Provides access to:

- Unpublished applications referred to in published IDAs, under certain conditions
- The national examination file of the IDA, under certain conditions
- The file of the USPTO indirect office:
 - Where contained in an accessible national examination file
 - Where domestic benefit is claimed under 35 U.S.C. 386(c) in a patent or published application



Proposed Changes to Current Rules

§ 1.41 - Inventorship

Inventorship (§ 1.41(f)):

- The creator(s) set forth in the publication of the international registration under Article 10(3) are considered to be the inventors
 - Correctable under § 1.48



Proposed Changes to Current Rules

§ 1.46 Applicants

§ 1.46 Applicants (assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest in the matter):

- must be identified as the applicant in the published IR or changed pursuant to §1.46(c)
 - An update or correction of an applicant's name (but not a change in the person) recorded at the IB pursuant to Article 16 will be recognized in the national application



Proposed Changes to Current Rules § 1.53(d)(CPA) & §1.114 (RCE)

§ 1.53(d) – prohibits CPAs in IDAs

- CPA is ch.16 filing
 - Different statutory and regulatory requirements

§ 1.114 – prohibits RCEs in IDAs



Proposed Changes to Current Rules

§ 1.55 - Priority

Provides for foreign priority

- to IDAs that designate a country other than U.S.
- in IDAs that are national applications
 - 6-month priority period is subject to Hague Rule 4(4)(expiry on nonworking day)
 - Priority claim may be presented in an ADS (§1.76(b)(6)) or in accordance with the treaty
 - Time period for filing claim/certified copy set forth in § 1.55(g)



Proposed Changes to Current Rules

§ 1.78 – Domestic Benefit

- Provides for domestic benefit claims (35 U.S.C. 120, 121, 365(c) or 386(c)):
 - *To* IDAs that designate the U.S.
 - the Office may require a certified copy of a non-U.S. origin IDA and any necessary translation
 - *In* IDAs that designate the U.S.
 - benefit claim must be in an ADS in an IDA that is a national application



Proposed Changes to Current Rules

§ 1.97 - IDS

IDS- first time period for submission (§ 1.97(b)):

- The Office shall consider an IDS submitted within three months of the date of publication of the IR under Article 10(3) or before the mailing date of a first Office action on the merits without the need for a fee or statement under §1.97(e)



Proposed Changes to Current Rules

§ 1.155 - “rocket docket”

- § 1.155 - the “rocket docket” procedure is available in an IDA



Proposed Changes to Current Rules

§ 1.211 - Publication

§ 1.211 - excludes IDAs from publication by the Office

– Published by WIPO in English

- 35 U.S.C. 390: The WIPO publication of an IDA that designates the U.S. is deemed a publication under 35 U.S.C. 122(b)



Additional Items

- 15 year patent term
 - Applies to patents issuing from IDAs and domestic U.S. design applications filed on or after the date of entry into force of the treaty with respect to the U.S.
- U.S. design patent rights begin upon issuance of patent

Proposed Fees



Jenny McDowell
Associate Counsel
Office of General Law
United States Patent and Trademark Office



Two Ways To File and Pay For International Design Application

- File directly with WIPO and pay relevant fees to WIPO
- File with the USPTO as an office of indirect filing and pay transmittal fee to USPTO
 - Pay USPTO all fees due
 - Pay WIPO all fees, except transmittal fee (due to USPTO)



File application with WIPO (Direct Filing)

- Pay in Swiss Francs
- WIPO website calculator tallies the fees due
- 37 CFR 1.1031(b) provides that the Schedule of Fees is available on WIPO's website



Illustrative fees owed if IDA is filed directly with WIPO

- Basic Fee (one design) = 397 CHF
- Each additional design in same application = 19 CHF
- Publication Fee = 17 CHF
- Each additional page (where reproductions are on paper) = 150 CHF
- Additional Word Fee (> 100 words) = 2 CHF
- Designation Fees – for the countries applicant specifies



How direct filing works

- Administrative Instruction 801 allows payment of fees in various ways:
 - Debit through an account established with the IB
 - Swiss postal check account or any of the specified bank accounts of the IB
 - Credit card
- If applicant pays an insufficient amount to WIPO, WIPO will invite applicant to correct deficiency, or abandonment will result



File through USPTO (Indirect Filing)

- An applicant may file an IDA through the USPTO as an office of indirect filing
 - All fees described above are due plus transmittal fee
- Two ways to pay fees for indirect filing:
 - Pay USPTO all fees due, including transmittal fee
 - Pay WIPO – pay USPTO transmittal fee, and then pay through the WIPO website



How Indirect Filing Works

- If applicant files with USPTO as an office of indirect filing and chooses to submit fees through USPTO, then:
 - Pay USPTO in US dollars
 - All fees due no later than the date of payment of the transmittal fee
 - Transmittal Fee = \$130
 - USPTO sends all of these fees (and application) to WIPO, except the transmittal fee



Designation Fees

- As set forth in the Treaty, fee is determined by looking at Swiss Franc amount on WIPO's website
- Standard versus individual designation fees
- The individual designation fee for the United States is split into two parts



“Individual Designation Fee” where USPTO is designated

- Both the Treaty and the legislative history indicate that many of the fees charged for IDAs should reflect those charged for domestic design applications
- The **actual amounts** will be listed on WIPO website, which will be in Swiss Francs
- First part individual designation fee – reflects U.S. design filing, search and exam fees: \$190 micro, \$380 small; \$760 other entities



Reduced Fees – Small Entities

- Assert small entity status by paying small entity fee
- § 1.27(c)(3): provides that payment of the small entity first part of the individual designation fee for the U.S. to the IB in an IDA will be treated as a written assertion of entitlement to small entity status



Reduced Fees – Micro Entities

- Must have filed certification of micro entity status
- § 1.29(e): allows the micro entity certification in an IDA to be signed by a person authorized to represent the applicant before the IB



Second Part Individual Designation Fee

- Reflects the U.S. issue fee
- Applicant can pay the fee either by:
 - WIPO website – in Swiss Francs
 - Submitting directly to USPTO - the amount stated in the Notice of Allowance, in U.S. dollars. The fees are currently:
 - \$140 micro; \$280 small; \$560 other than small or micro



Conversion of currency

- USPTO intends to transmit fees regularly to WIPO
- If a deficiency occurs as a result of exchange rate fluctuation from when an applicant pays the USPTO in U.S. dollars and when the USPTO transmits the funds to WIPO in Swiss Francs, the IB may invite the applicant to pay the difference within a specified period



Other USPTO fees

- § 1.1023(b): Petition fee to review filing date of international design application
 - 37 CFR 1.17(f) petition fee, which is:
 - \$100 – micro
 - \$200 – small
 - \$400 – other than small or micro
- § 1.1051(a)(3): Petition fee to excuse applicant's failure to act within prescribed time limits in an international application:
 - \$850 small
 - \$1,700 large
 - No micro entity discount provided by statute



Other USPTO fees (cont'd)

- §1.17(v): Petition fee to convert filing an international design application under 37 CFR 1.1052 to a design application under 35 USC Ch.16
 - \$180
- No renewal or maintenance fees in USPTO



WIPO Website

http://www.wipo.int/hague/en/how_to/file/fees.html

Thank You!



Hague Agreement Public Forum
Madison South Auditorium
United States Patent and Trademark Office
Tuesday, January 14, 2014