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2901 Basic Hague Agreement Principles [R-07.2015]

I. OVERVIEW

The Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, July 2, 1999 (hereinafter "Hague Agreement") is an international agreement that enables an applicant to file a single international design application which may have the effect of an application for protection for the design(s) in countries and/or intergovernmental organizations that are parties to the Hague Agreement (the "Contracting Parties") designated in the application. The United States is a Contracting Party to the Hague Agreement, which took effect with respect to the United States on May 13, 2015. The Hague Agreement is administered by the International Bureau of the World Intellectual Property Organization ("the International Bureau").

II. BASIC FLOW UNDER THE HAGUE AGREEMENT

A. Filing

An international design application may be filed by an applicant "indirectly" through the U.S. Patent and Trademark Office ("USPTO") or "directly" with the International Bureau. If the application is filed through the USPTO, the Office will confirm that the required transmittal fee has been paid, perform a security review, and check that the required indications demonstrating applicant's entitlement to file the application through the USPTO are present in the application submission. If the transmittal fee is paid and the application clears security review and contains the indications establishing applicant's entitlement to file the application through the USPTO, the application will be transmitted to the International Bureau and the applicant will be notified of the transmittal. The USPTO will also notify the applicant and the International Bureau of the receipt date of the application.

B. Formal Examination by the International Bureau

Regardless of whether the application is filed indirectly through a Contracting Party or directly with the International Bureau, the International Bureau examines the application to determine whether the applicable formal requirements under the Hague Agreement and Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement have been satisfied. If the applicable

requirements have been satisfied, the International Bureau will accord the application a filing date and register the industrial design in the International Register. If the International Bureau finds that the international design application does not satisfy the applicable requirements, it will invite the applicant to make the required corrections within a prescribed time limit. The failure to timely respond to the invitation may result in abandonment of the application or removal of the designation of a Contracting Party pursuant to Hague Agreement Article 8.

C. Registration and Publication

If the international design application satisfies all applicable requirements, the International Bureau will register the international design application in the International Register and accord a date of international registration. Pursuant to Hague Agreement Article 10(2), the international registration date will be either the filing date of the international design application or the date of receipt of any additional mandatory content item required under Hague Agreement Article 5(2), if such date is later than the filing date. The international registration includes all the data contained in the international design application (including any priority claim where the earlier filing is not more than six months prior to the international filing date), the reproduction(s) of the design, the registration number and registration date, and the class of the International Classification determined by the International Bureau.

The international registration is published by the International Bureau. The applicant may request that publication occur immediately after registration or that publication be deferred for up to 30 months from the filing date (or priority date, if applicable). Deferment of publication is not possible if a Contracting Party is designated that does not permit deferred publication. Absent a request for immediate publication or deferment, the registration will be published approximately six months after the date of international registration. The publication includes the data from the international registration and the reproductions of the industrial design.

D. Examination by the Offices of the Designated Contracting Parties

Following publication of the international registration by the International Bureau, the offices of the designated Contracting Parties proceed with examination if required under their

respective laws. As a result of that examination, the office may notify the International Bureau of a refusal of protection for its territory. A refusal of protection, if any, must be notified to the International Bureau within sixmonths from the date of publication of the international registration. However, any Contracting Party whose office is an examining office, or whose law provides for the possibility of opposition to the grant of protection, may declare that the refusal period of six months is extended to 12 months.

Pursuant to 35 U.S.C. 389, the USPTO will examine international design applications designating the United States based on the published international registration received from the International Bureau. Where it appears that the applicant is not entitled to a patent under the law of the United States with respect to any industrial design that is the subject of the international registration, the Office will send a notification of refusal to the International Bureau, normally within 12 months from the publication of the international registration. The applicant may reply to such notification directly to the USPTO. Any further Office action, such as a subsequent non-final rejection, a final rejection, or an allowance, will be sent directly to the applicant.

2902 Definitions [R-07.2015]

Definitions of relevant terms are set forth in 35 U.S.C. 381, 37 CFR 1.9 and 1.1001, Article 1 of the Hague Agreement, and Rule 1 of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement.

As used in MPEP Chapter 2900, "Article" means an article of the Hague Agreement; "Rule," when capitalized, means a rule under the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement; and "Administrative Instruction" means the Administrative Instruction for the Application of the Hague Agreement referred to in Rule 34.

2903 Declarations under the Hague Agreement Made by the United States of America [R-07.2015]

The Geneva Act of the Hague Agreement, and the declarations made thereto, took effect with respect to the United States on May 13, 2015.

Pursuant to Article 5(2)(a) and Rule 11(3), the United States declared that an international design application designating the United States must contain a claim and that the specific wording of the claim shall be in formal terms to the ornamental design for the article as shown, or as shown and described. See 37 CFR 1.1021(d) and MPEP § 2909, subsection IV. Additionally, pursuant to Rule 8(1), the United States declared that an international design application designating the United States must also contain an oath or declaration of the creator and indications concerning the identity of the creator. Id.

Pursuant to Article 11(1)(b), the United States declared that where the United States is designated in an international design application, it is not possible for an applicant to request the deferment of publication of the ensuing international registration.

Pursuant to Article 13(1), the United States declared that only one independent and distinct design may be claimed in a single application. See MPEP § 2920.05(b) and 1504.05.

Pursuant to Rule 18(1)(b), the United States declared that it is extending the time period within which to provide a refusal (12 months) and when the international registration shall produce effect as a grant of protection. The United States provides industrial design rights through USPTO issuance of a U.S. design patent. See 35 U.S.C. 171-173 and 389 and MPEP § 2920.05(a) and 2950.

Pursuant to Article 7(2) and Rule 12(3), the United States declared that the prescribed designation fee referred to in Article 7(1) shall be replaced by an individual designation fee that is payable in a first part at filing and second part payable upon allowance of the application. See MPEP § 2910 and 2920.06. The amounts of the first and second part individual designation fees are subject to future changes. See Article 7(2).

Pursuant to Rule 13(4), the United States declared that the period of one month referred to in Rule 13(3) shall be replaced by a period of six months with respect to the United States in light of the security clearance required under United States law.

Pursuant to Article 16(2), the United States declared that changes in ownership recorded by the International Bureau pursuant to Article 16(1)(i) must be recorded with the USPTO through submission of documentation supporting that change in ownership to have effect. See 35 U.S.C. 261 and MPEP § 301-302. Pursuant to Article 17(3), the United States declared that that the maximum duration of protection for designs is 15 years from grant. 35 U.S.C. 173.

2904 Who May File An International Design Application [R-07.2015]

Hague Article 3

Entitlement to File an International Application

Any person that is a national of a State that is a Contracting Party or of a State member of an intergovernmental organization that is a Contracting Party, or that has a domicile, a habitual residence or a real and effective industrial or commercial establishment in the territory of a Contracting Party, shall be entitled to file an international application.

Pursuant to Article 3 of the Hague Agreement, to be entitled to file an international design application, a person must: (1) be a national of a Contracting Party or of a State that is a member of an intergovernmental organization that is a Contracting Party; or (2) have a domicile, habitual residence, or real and effective industrial or commercial establishment in the territory of a Contracting Party.

Article 1(ix) of the Hague Agreement defines a "person" as a natural person or a legal entity, and Article 1(xiii) defines a "Contracting Party" as a State or intergovernmental organization that is a party to the Hague Agreement.

A list of the Contracting Parties to the Hague Agreement is maintained on the website of the World Intellectual Property Organization (www.wipo.int/hague/en/members/).

2905 Where to File An International Design Application

[R-07.2015]

Hague Article 4

Procedure for Filing the International Application

(1) [Direct or Indirect Filing]

(a) The international application may be filed, at the option of the applicant, either directly with the International Bureau or through the Office of the applicant's Contracting Party.

(b) Notwithstanding subparagraph (a), any Contracting Party may, in a declaration, notify the Director General that international applications may not be filed through its Office.

(2) [Transmittal Fee in Case of Indirect Filing] The Office of any Contracting Party may require that the applicant pay a transmittal fee to it, for its own benefit, in respect of any international application filed through it.

Pursuant to Article 4 of the Hague Agreement, an international design application may be filed either directly with the International Bureau or indirectly through the office of the applicant's Contracting Party. However, Contracting Parties may notify the International Bureau that applications may not be filed indirectly through their office. See Article 4(1)(b). As such, only certain offices may allow for "indirect" filing. The WIPO website provides information on which Contracting Parties permit "indirect" filing through their office.

See www.wipo.int/hague/en/declarations/declarations.html.

Article 1(xiv) of the Hague Agreement defines the "applicant's Contracting Party" as the Contracting Party from which the applicant derives its entitlement to file an international design application under Hague Agreement Article 3 or, if there is more than one such Contracting Party, the one Contracting Party among those Contracting Parties that the applicant expressly identifies as the "applicant's Contracting Party" in the international design application.

2905.01 Filing Through the USPTO as an Office of Indirect Filing

[R-07.2015]

35 U.S.C. 382 Filing international design applications.

(a) IN GENERAL.

Any person who is a national of the United States, or has a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the United States, may

file an international design application by submitting to the Patent and Trademark Office an application in such form, together with such fees, as may be prescribed by the Director.

(b) REQUIRED ACTION.

The Patent and Trademark Office shall perform all acts connected with the discharge of its duties under the treaty, including the collection of international fees and transmittal thereof to the International Bureau. Subject to chapter 17, international design applications shall be forwarded by the Patent and Trademark Office to the International Bureau, upon payment of a transmittal fee.

(c) APPLICABILITY OF CHAPTER 16.

Except as otherwise provided in this chapter, the provisions of chapter 16 shall apply.

(d) APPLICATION FILED IN ANOTHER COUNTRY.

An international design application on an industrial design made in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17 if the international design application is filed—

- (1) in a country other than the United States;
- (2) at the International Bureau; or
- (3) with an intergovernmental organization.

37 CFR 1.1002 The United States Patent and Trademark Office as an office of indirect filing.

(a) The United States Patent and Trademark Office, as a nooffice of indirect filing, shall accept international design applications where the applicant's Contracting Party is the United States.

(b) The major functions of the United States Patent and Trademark Office as an office of indirect filing include:

- (1) Receiving and according a receipt date to international design applications;
- (2) Collecting and, when required, transmitting fees due for processing international design applications;
- (3) Determining compliance with applicable requirements of part 5 of this chapter; and
- (4) Transmitting an international design application to the International Bureau, unless prescriptions concerning national security prevent the application from being transmitted.

37 CFR 1.1011 Applicant for international design application.

(a) Only persons who are nationals of the United States or who

have a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the territory of the United States may file international design applications through the United States Patent and Trademark Office.

(b) Although the United States Patent and Trademark Office will accept international design applications filed by any person referred to in paragraph (a) of this section, an international design application designating the United States may be refused by the Office as a designated office if the applicant is not a person qualified under 35 U.S.C. chapter 11 to be an applicant.

37 CFR 1.1012 Applicant's Contracting Party.

In order to file an international design application through the United States Patent and Trademark Office as an office of indirect filing, the United States must be applicant's Contracting Party (Articles 4 and 1(xiv)).

37 CFR 1.1045 Procedures for transmittal of international design application to the International Bureau.

(a) Subject to paragraph (b) of this section and payment of the transmittal fee set forth in § 1.1031(a), transmittal of the international design application to the International Bureau shall be made by the Office as provided by Rule 13(1). At the same time as it transmits the international design application to the International Bureau, the Office shall notify the International Bureau of the date on which it received the application. The Office shall also notify the applicant of the date on which it received the application and of the transmittal of the international design application to the International Bureau.

(b) No copy of an international design application may be transmitted to the International Bureau, a foreign designated office, or other foreign authority by the Office or the applicant, unless the applicable requirements of part 5 of this chapter have been satisfied.

(c) Once transmittal of the international design application has been effected under paragraph (a) of this section, except for matters properly before the United States Patent and Trademark Office as an office of indirect filing or as a designated office, all further correspondence concerning the application should be sent directly to the International Bureau. The United States Patent and Trademark Office will generally not forward communications to the International Bureau received after

transmittal of the application to the International Bureau. Any reply to an invitation sent to the applicant by the International Bureau must be filed directly with the International Bureau, and not with the Office, to avoid abandonment or other loss of rights under Article 8.

Only persons who are nationals of the United States or who have a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the United States may file international design applications through the USPTO. See 35 U.S.C. 382(a) and 37 CFR 1.1011(a). In addition, in order to file an international design application through the USPTO, the United States must be applicant's Contracting Party. See 37 CFR 1.1012 and Hague Agreement Article 4. Thus, an international design application may be filed through the USPTO only if: (1) the applicant, or each applicant if there is more than one applicant, is a national of the United States or has a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the United States; and (2) the United States is the applicant's Contracting Party, or each applicant's Contracting Party if there is more than one applicant.

The official form for presenting the international design application, "Application for International Registration" (form DM/1), includes boxes to indicate both applicant's entitlement to file the international design application and applicant's Contracting Party. See MPEP § 2909.01.

International design applications may be filed through the USPTO as an office of indirect filing via EFS-Web, mail, or hand delivery to the Customer Service Window at the USPTO's Alexandria headquarters. The street address is: U.S. Patent and Trademark Office, Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314. The mailing address for delivery by the U.S. Postal Service is: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. It should be noted that the Priority Mail Express provisions of 37 CFR 1.10 apply to the filing of all applications and papers filed in the U.S. Patent and Trademark Office, including international design applications and related papers and fees. It should be further noted, however, that the filing of an international design application is excluded from the Certificate of Mailing or Transmission procedures under 37 CFR 1.8. Facsimile transmission may not be used for the filing of an international design application or the

filing of color drawings under 37 CFR 1.1026. See 37 CFR 1.6(d) (3) and (4), 37 CFR 1.8(a)(2)(i)(K). See MPEP § 502 for more information on depositing correspondence with the USPTO.

Payment of the transmittal fee specified in 37 CFR 1.1031(a) is required for international design applications filed through the USPTO as an office of indirect filing. In addition, international design applications filed with the USPTO are subject to national security review. See 35 U.S.C. 382(b). The international design application will not be transmitted to the International Bureau if the transmittal fee has not been paid or the necessary national security clearance has not been obtained. See 37 CFR 1.1045.

Upon receipt of an international design application, the USPTO will review the application for the required indications establishing each applicant's entitlement to file the international design application through the USPTO, payment of the transmittal fee, and national security. If the indications are not sufficient to establish each applicant's entitlement to file the international design application through the USPTO, the transmittal fee has not been paid, or the necessary national security clearance has not been obtained, the Office will notify the applicant accordingly via Form PTO-2320, "Notification Of Receipt And Transmittal Of The International Design Application To The IB And Invitation To Pay Fee." Form PTO-2320 does not set a time period to cure the deficiency but instead warns the applicant that an international design application that is not received by the International Bureau within six months from receipt of the application by the USPTO will receive a filing date as of the date on which the International Bureau receives the application, rather than the USPTO receipt date, subject to Hague Agreement Rule 14(2).

If the conditions for transmitting the international design application to the International Bureau have been satisfied, the application will be transmitted to the International Bureau. The applicant will be notified via Form PTO-2320 of the transmittal of the application to the International Bureau and of the receipt date of the international design application by the USPTO.

The Office will generally not forward any submission filed in an international design application to the International Bureau that is received after the application has been transmitted to the International Bureau. Applicants are cautioned that any reply to an invitation sent to the applicant by the International Bureau

must be filed directly with the International Bureau, and not with the Office, to avoid abandonment or other loss of rights under Hague Agreement Article 8. See 37 CFR 1.1045(c).

2906 Filing Date Requirements [R-07.2015]

Hague Article 9 Filing Date of the International Application

(1) [International Application Filed Directly] Where the international application is filed directly with the International Bureau, the filing date shall, subject to paragraph (3), be the date on which the International Bureau receives the international application.

(2) [International Application Filed Indirectly] Where the international application is filed through the Office of the applicant's Contracting Party, the filing date shall be determined as prescribed.

(3) [International Application with Certain Irregularities] Where the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau.

Hague Rule 14 Examination by the International Bureau

(1) [Time Limit for Correcting Irregularities] If the International Bureau finds that the international application does not, at the time of its receipt by the International Bureau, fulfill the applicable requirements, it shall invite the applicant to make the required corrections within three months from the date of the invitation sent by the International Bureau.

(2) [Irregularities Entailing a Postponement of the Filing Date of the International Application] Where the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau. The irregularities which are prescribed as entailing a postponement of the filing date of the international application are the following:

(a) the international application is not in one of the prescribed languages;

(b) any of the following elements is missing from the international application:

(i) an express or implicit indication that international registration under the 1999 Act or the 1960 Act is sought;

- (ii) indications allowing the identity of the applicant to be established;
- (iii) indications sufficient to enable the applicant or its representative, if any, to be contacted;
- (iv) a reproduction, or, in accordance with Article 5(1)(iii) of the 1999 Act, a specimen, of each industrial design that is the subject of the international application;
- (v) the designation of at least one Contracting Party.

(3) [International Application Considered Abandoned; Reimbursement of Fees] Where an irregularity, other than an irregularity referred to in Article 8(2)(b) of the 1999 Act, is not remedied within the time limit referred to in paragraph (1), the international application shall be considered abandoned and the International Bureau shall refund any fees paid in respect of that application, after deduction of an amount corresponding to the basic fee.

Hague Rule 13 International Application Filed Through an Office

(3) [Filing Date of International Application Filed Indirectly] Subject to Rule 14(2), the filing date of an international application filed through an Office shall be

(i) where the international application is governed exclusively by the 1999 Act, the date on which the international application was received by that Office, provided that it is received by the International Bureau within one month of that date;

(ii) in any other case, the date on which the International Bureau receives the international application.

(4) [Filing Date Where Applicant's Contracting Party Requires a Security Clearance] Notwithstanding paragraph (3), a Contracting Party whose law, at the time that it becomes party to the 1999 Act, requires security clearance may, in a declaration, notify the Director General that the period of one month referred to in that paragraph shall be replaced by a period of six months.

Hague Rule 6 Languages

(1) [International Application] The international application shall be in English, French or Spanish.

The filing date of an international design application is accorded by the International Bureau pursuant to Article 9 and Rules 14(2) and 13(3) of the Hague Agreement. The filing date of an international design application in the United States is not

necessarily the same date as the filing date accorded by the International Bureau. See MPEP § 2908. The filing date accorded by the International Bureau is referred to as the international filing date.

Pursuant to Rule 14(2), the International Bureau will accord the international design application a filing date only if the application is in one of the prescribed languages. The prescribed languages, set forth in Hague Agreement Rule 6, are English, French, and Spanish. In addition, the international design application must include:

- (1) an indication that international registration under the Hague Agreement is requested;
- (2) a sufficient indication of the applicant's identity;
- (3) a sufficient indication to allow the applicant or its representative to be contacted;
- (4) a reproduction or specimen of each industrial design that is the subject of the application; and
- (5) the designation of at least one Contracting Party.

If the international design application does not fulfill the applicable requirements, the International Bureau will invite the applicant to make the required corrections within a prescribed time limit. See Rule 14(1). If the defect concerns a missing element required under Rule 14(2) and the applicant timely provides the missing element required under Rule 14(2), the date on which the missing element is received by the International Bureau will be the filing date accorded by the International Bureau. Where the defect, other than a defect referred to in Article 8(2)(b), is not timely remedied, the international design application shall be considered abandoned. Failure to timely remedy a defect referred to in Article 8(2)(b) will result in the international design application being deemed not to contain the designation of the Contracting Party concerned. See MPEP § 2907. With respect to an international design application filed indirectly through the office of a Contracting Party that is governed exclusively by the 1999 Geneva Act, the international filing date will be the date the international design application was received in the office of the Contracting Party, subject to Rule 14(2), and provided that the application is received by the International Bureau within the time period specified in Rule 13(3). The time period specified in Rule 13(3) is one month from the date of receipt of the application by the Contracting Party

or six months from the date of receipt where the Contracting Party has notified the International Bureau that it requires security clearance before communicating the application. The United States has notified the International Bureau that it requires a security clearance. See MPEP § 2903.

2907 International Registration and Date of the International Registration [R-07.2015]

Hague Article 10 International Registration, Date of the International Registration, Publication and Confidential Copies of the International Registration

(1) [International Registration] The International Bureau shall register each industrial design that is the subject of an international application immediately upon receipt by it of the international application or, where corrections are invited under Article 8, immediately upon receipt of the required corrections. The registration shall be effected whether or not publication is deferred under Article 11.

(2) [Date of the International Registration]

(a) Subject to subparagraph (b), the date of the international registration shall be the filing date of the international application.

(b) Where the international application has, on the date on which it is received by the International Bureau, an irregularity which relates to Article 5(2), the date of the international registration shall be the date on which the correction of such irregularity is received by the International Bureau or the filing date of the international application, whichever is the later.

Hague Rule 15 Registration of the Industrial Design in the International Register

(1) [Registration of the Industrial Design in the International Register] Where the International Bureau finds that the international application conforms to the applicable requirements it shall register the industrial design in the International Register and send a certificate to the holder.

(2) [Contents of the Registration] The international registration shall contain

(i) all the data contained in the international application, except any priority claim under Rule 7(5)(c) where the date of the earlier filing is more than six months before the filing date of the international application;

(ii) any reproduction of the industrial design;

(iii) the date of the international registration;

(iv) the number of the international registration;

(v) the relevant class of the International Classification, as

determined by the International Bureau.

Hague Article 5 Contents of the International Application

(2) [Additional Mandatory Contents of the International Application]

(a) Any Contracting Party whose Office is an Examining Office and whose law, at the time it becomes party to this Act, requires that an application for the grant of protection to an industrial design contain any of the elements specified in subparagraph (b) in order for that application to be accorded a filing date under that law may, in a declaration, notify the Director General of those elements.

(b) The elements that may be notified pursuant to subparagraph (a) are the following:

(i) indications concerning the identity of the creator of the industrial design that is the subject of that application;

(ii) a brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application;

(iii) a claim.

(c) Where the international application contains the designation of a Contracting Party that has made a notification under subparagraph (a), it shall also contain, in the prescribed manner, any element that was the subject of that notification.

If the International Bureau determines that the international design application conforms to the applicable requirements, it will register the industrial design in the International Register. See Article 10(1) and Rule 15. Pursuant to Article 10(2), the date of international registration will be the international filing date (see MPEP § 2906) unless there is an applicable requirement under Hague Agreement Article 5(2) that has not been satisfied, in which case the date of international registration will be the date that a timely correction satisfying the outstanding requirement(s) of Article 5(2) is received, or the international filing date, whichever is later.

Hague Agreement Article 5(2) sets forth additional mandatory elements of an international design application that may be required by certain Contracting Parties. Where the international design application contains the designation of a Contracting Party that has notified the International Bureau that it requires

an element under Article 5(2), then the international design application must contain that element. The additional elements that may be required under Article 5(2) are: (1) an indication identifying the creator of the industrial design; (2) a brief description of the reproduction or of the characteristic features of the industrial design; and (3) a claim.

If the international design application does not comply with the applicable requirements, including any missing element required under Article 5(2), the International Bureau will invite the applicant to remedy the defect within a prescribed time limit.

See Rule 14(1). Where the defect relates to a missing requirement under Article 5(2), or to a special requirement notified to the International Bureau in accordance with the Regulations under the Hague Agreement (e.g., the requirement for an oath or declaration of the creator pursuant to Rule 8), the failure to timely comply with the invitation will result in the international design application being deemed not to contain the designation of the Contracting Party concerned. See Article 8(2)(b).

2908 Filing Date in the United States [R-07.2015]

35 U.S.C. 384 Filing date

(a) IN GENERAL.

Subject to subsection (b), the filing date of an international design application in the United States shall be the effective registration date. 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.

(b) REVIEW.

An applicant may request review by the Director of the filing date of the international design application in the United States. The Director may determine that the filing date of the international design application in the United States is a date other than the effective registration date. The Director may establish procedures, including the payment of a surcharge, to review the filing date under this section. Such review may result in a determination that the application has a filing date in the United States other than the effective registration date.

35 U.S.C. 381 Definitions

(a) IN GENERAL.

When used in this part, unless the context otherwise indicates—
(1) the term 'treaty' means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva on July 2, 1999;

(2) the term 'regulations'

(A) when capitalized, means the Common Regulations under the treaty; and

(B) when not capitalized, means the regulations established by the Director under this title;

(3) the terms 'designation', 'designating', and 'designate' refer to a request that an international registration have effect in a Contracting Party to the treaty;

(4) the term 'International Bureau' means the international intergovernmental organization that is recognized as the coordinating body under the treaty and the Regulations;

(5) the term 'effective registration date' means the date of international registration determined by the International Bureau under the treaty;

(6) the term 'international design application' means an application for international registration; and

(7) the term 'international registration' means the international registration of an industrial design filed under the treaty.

(b) RULE OF CONSTRUCTION.

Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.

37 CFR 1.1023 Filing date of an international design application in the United States.

(a) Subject to paragraph (b) of this section, the filing date of an international design application in the United States is the date of international registration determined by the International Bureau under the Hague Agreement (35 U.S.C. 384 and 381(a)(5)).

(b) Where the applicant believes the international design application is entitled under the Hague Agreement to a filing date in the United States other than the date of international registration, the applicant may petition the Director under this paragraph to accord the international design application a filing date in the United States other than the date of international registration. Such petition must be accompanied by the fee set forth in § 1.17(f) and include a showing to the satisfaction of the Director that the international design application is entitled to such filing date.

Pursuant to 35 U.S.C. 384(a), the filing date of an international design application in the United States is the "effective registration date", subject to review pursuant to 35 U.S.C. 384(b). The "effectiveregistration date" means "the date of international registration determined by the International Bureau under the treaty". See 35 U.S.C. 381(a)(5).

Pursuant to 35 U.S.C. 384(b), an applicant may request review by the Director of the filing date of the international design application in the United States. The procedure for requesting such review is set forth in 37 CFR 1.1023(b). Pursuant to 37 CFR 1.1023(b), where the applicant believes the international design application is entitled under the Hague Agreement to a filing date in the United States other than the date of international registration, the applicant may petition the Director under 37 CFR 1.1023(b) to accord the international design application a filing date in the United States other than the date of international registration. Such petition must be accompanied by the fee set forth in 37 CFR 1.17(f) and include a showing to the satisfaction of the Director that the international design

application is entitled to such filing date.

2909 Contents of the International Design Application [R-07.2015]

Hague Article 5 Contents of the International Application

(1) [Mandatory Contents of the International Application]

The international application shall be in the prescribed language or one of the prescribed languages and shall contain or be accompanied by

- (i) a request for international registration under this Act;
- (ii) the prescribed data concerning the applicant;
- (iii) the prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with paragraph (5), the international application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design;
- (iv) an indication of the product or products which constitute the industrial design or in relation to which the industrial design is to be used, as prescribed;
- (v) an indication of the designated Contracting Parties;
- (vi) the prescribed fees;
- (vii) any other prescribed particulars.

(2) [Additional Mandatory Contents of the International Application]

(a) Any Contracting Party whose Office is an Examining Office and whose law, at the time it becomes party to this Act, requires that an application for the grant of protection to an industrial design contain any of the elements specified in subparagraph (b) in order for that application to be accorded a filing date under that law may, in a declaration, notify the Director General of those elements.

(b) The elements that may be notified pursuant to subparagraph (a) are the following:

- (i) indications concerning the identity of the creator of the industrial design that is the subject of that application;
- (ii) a brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application;
- (iii) a claim.

(c) Where the international application contains the designation

of a Contracting Party that has made a notification under subparagraph (a), it shall also contain, in the prescribed manner, any element that was the subject of that notification.

(3) [Other Possible Contents of the International Application] The international application may contain or be accompanied by such other elements as are specified in the Regulations.

(4) [Several Industrial Designs in the Same International Application] Subject to such conditions as may be prescribed, an international application may include two or more industrial designs.

(5) [Request for Deferred Publication] The international application may contain a request for deferment of publication.

Hague Rule 7 Requirements Concerning the International Application

(1) [Form and Signature] The international application shall be presented on the official form. The international application shall be signed by the applicant.

(2) [Fees] The prescribed fees applicable to the international application shall be paid as provided for in Rules 27 and 28.

(3) [Mandatory Contents of the International Application] The international application shall contain or indicate

(i) the name of the applicant, given in accordance with the Administrative Instructions;

(ii) the address of the applicant, given in accordance with the Administrative Instructions;

(iii) the Contracting Party or Parties in respect of which the applicant fulfills the conditions to be the holder of an international registration;

(iv) the product or products which constitute the industrial design or in relation to which the industrial design is to be used, with an indication whether the product or products constitute the industrial design or are products in relation to which the industrial design is to be used; the product or products shall preferably be identified by using terms appearing in the list of goods of the International Classification;

(v) the number of industrial designs included in the international application, which may not exceed 100, and the number of reproductions or specimens of the industrial designs accompanying the international application in accordance with Rule 9 or 10;

(vi) the designated Contracting Parties;
(vii) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.

(4) [Additional Mandatory Contents of an International Application]

(a) With respect to Contracting Parties designated under the 1999 Act in an international application, that application shall contain, in addition to the indications referred to in paragraph (3)(iii), the indication of the applicant's Contracting Party.

(b) Where a Contracting Party designated under the 1999 Act has notified the Director General, in accordance with Article 5(2)(a) of the 1999 Act, that its law requires one or more of the elements referred to in Article 5(2)(b) of the 1999 Act, the international application shall contain such element or elements, as prescribed in Rule 11.

(c) Where Rule 8 applies, the international application shall, as applicable, contain the indications referred to in paragraphs (2) or (3) thereof and be accompanied by any relevant statement, document, oath or declaration referred to in that Rule.

(5) [Optional Contents of an International Application]

(a) An element referred to in item (i) or (ii) of Article 5(2)(b) of the 1999 Act or in Article 8(4)(a) of the 1960 Act may, at the option of the applicant, be included in the international application even where that element is not required in consequence of a notification in accordance with Article 5(2)(a) of the 1999 Act or in consequence of a requirement under Article 8(4)(a) of the 1960 Act.

(b) Where the applicant has a representative, the international application shall state the name and address of the representative, given in accordance with the Administrative Instructions.

(c) Where the applicant wishes, under Article 4 of the Paris Convention, to take advantage of the priority of an earlier filing, the international application shall contain a declaration claiming the priority of that earlier filing, together with an indication of the name of the Office where such filing was made and of the date and, where available, the number of that filing and, where the priority claim relates to less than all the industrial designs contained in the international application,

the indication of those industrial designs to which the priority claim relates or does not relate.

(d) Where the applicant wishes to take advantage of Article 11 of the Paris Convention, the international application shall contain a declaration that the product or products which constitute the industrial design or in which the industrial design is incorporated have been shown at an official or officially recognized international exhibition, together with the place where the exhibition was held and the date on which the product or products were first exhibited there and, where less than all the industrial designs contained in the international application are concerned, the indication of those industrial designs to which the declaration relates or does not relate.

(e) Where the applicant wishes that publication of the industrial design be deferred, the international application shall contain a request for deferment of publication.

(f) The international application may also contain any declaration, statement or other relevant indication as may be specified in the Administrative Instructions.

(g) The international application may be accompanied by a statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned.

(6) [No Additional Matter] If the international application contains any matter other than that required or permitted by the 1999 Act, the 1960 Act, these Regulations or the Administrative Instructions, the International Bureau shall delete it ex officio. If the international application is accompanied by any document other than those required or permitted, the International Bureau may dispose of the said document.

(7) [All Products to Be in Same Class] All the products which constitute the industrial designs to which an international application relates, or in relation to which the industrial designs are to be used, shall belong to the same class of the International Classification.

35 U.S.C. 383 International design application.

In addition to any requirements pursuant to chapter 16, the international design application shall contain—

- (1) a request for international registration under the treaty;
- (2) an indication of the designated Contracting Parties;
- (3) data concerning the applicant as prescribed in the treaty and

the Regulations;

(4) copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international design application, presented in the number and manner prescribed in the treaty and the Regulations;

(5) an indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed in the treaty and the Regulations;

(6) the fees prescribed in the treaty and the Regulations; and

(7) any other particulars prescribed in the Regulations.

37 CFR 1.1021 Contents of the international design application.

(a) Mandatory contents.

The international design application shall be in English, French, or Spanish (Rule 6(1)) and shall contain or be accompanied by:

(1) A request for international registration under the Hague Agreement (Article 5(1)(i));

(2) The prescribed data concerning the applicant (Article 5(1)(ii) and Rule 7(3)(i) and (ii));

(3) The prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international design application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with Article 5(5), the international design application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design (Article 5(1)(iii));

(4) An indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed (Article 5(1)(iv) and Rule 7(3)(iv));

(5) An indication of the designated Contracting Parties (Article 5(1)(v));

(6) The prescribed fees (Article 5(1)(vi) and Rule 12(1));

(7) The Contracting Party or Parties in respect of which the applicant fulfills the conditions to be the holder of an international registration (Rule 7(3)(iii));

(8) The number of industrial designs included in the international design application, which may not exceed 100, and the number of reproductions or specimens of the industrial designs accompanying the international design application (Rule

7(3)(v));

(9) The amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions (Rule 7(3)(vii)); and

(10) An indication of applicant's Contracting Party as required under Rule 7(4)(a).

(b) Additional mandatory contents required by certain Contracting Parties.

(1) Where the international design application contains the designation of a Contracting Party that requires, pursuant to Article 5(2), any of the following elements, then the international design application shall contain such required element(s):

(i) Indications concerning the identity of the creator of the industrial design that is the subject of that application (Rule 11(1));

(ii) A brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application (Rule 11(2));

(iii) A claim (Rule 11(3)).

(2) Where the international design application contains the designation of a Contracting Party that has made a declaration under Rule 8(1), then the international application shall contain the statement, document, oath or declaration specified in that declaration (Rule 7(4)(c)).

(c) Optional contents. The international design application may contain:

(1) Two or more industrial designs, subject to the prescribed conditions (Article 5(4) and Rule 7(7));

(2) A request for deferment of publication (Article 5(5) and Rule 7(5)(e)) or a request for immediate publication (Rule 17);

(3) An element referred to in item (i) or (ii) of Article 5(2)(b) of the Hague Agreement or in Article 8(4)(a) of the 1960 Act even where that element is not required in consequence of a notification in accordance with Article 5(2)(a) of the Hague Agreement or in consequence of a requirement under Article 8(4)(a) of the 1960 Act (Rule 7(5)(a));

(4) The name and address of applicant's representative, as prescribed (Rule 7(5)(b));

(5) A claim of priority of one or more earlier filed applications in accordance with Article 6 and Rule 7(5)(c);

(6) A declaration, for purposes of Article 11 of the Paris Convention, that the product or products which constitute the industrial design or in which the industrial design is incorporated have been shown at an official or officially recognized international exhibition, together with the place where the exhibition was held and the date on which the product or products were first exhibited there and, where less than all the industrial designs contained in the international design application are concerned, the indication of those industrial designs to which the declaration relates or does not relate (Rule 7(5)(d));

(7) Any declaration, statement or other relevant indication as may be specified in the Administrative Instructions (Rule 7(5)(f));

(8) A statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned (Rule 7(5)(g));

(9) A proposed translation of any text matter contained in the international design application for purposes of recording and publication (Rule 6(4)).

(d) Required contents where the United States is designated. In addition to the mandatory requirements set forth in paragraph (a) of this section, an international design application that designates the United States shall contain or be accompanied by:

(1) A claim (§ 1.1021(b)(1)(iii) and 1.1025);

(2) Indications concerning the identity of the creator (i.e., the inventor, see § 1.9(d)) in accordance with Rule 11(1); and

(3) The inventor's oath or declaration (§ 1.63 and 1.64).

The requirements in §§ 1.63(b) and 1.64(b)(4) to identify each inventor by his or her legal name, mailing address, and residence, if an inventor lives at a location which is different from the mailing address, and the requirement in § 1.64(b)(2) to identify the residence and mailing address of the person signing the substitute statement, will be considered satisfied by the presentation of such information in the international design application prior to international registration

The elements of an international design application fall into three categories: (1) mandatory contents; (2) additional mandatory contents; and (3) optional contents.

I. MANDATORY CONTENTS

Mandatory contents are those items required in all international design applications. Such contents are set forth in Article 5(1) and Rule 7 of the Hague Agreement and 37 CFR 1.1021(a). Specifically, the international design application must be in English, French, or Spanish, it must be presented on the official form (see MPEP § 2909.01) and signed by the applicant, and it must include: (1) a request for international registration under the Hague Agreement; (2) the prescribed data concerning the applicant; (3) the prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international design application, presented in the prescribed manner (where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with Article 5(5) of the Hague Agreement, the international design application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design); (4) an indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed; (5) an indication of the designated Contracting Parties; (6) the prescribed fees; (7) the Contracting Party or Parties in respect of which the applicant fulfills the conditions to be the holder of an international registration; (8) the number of industrial designs included in the international application, which may not exceed 100, and the number of reproductions or specimens of the industrial designs accompanying the international application; (9) the amount of the fees being paid and the method of payment or instructions to debit the required amount of fees to an account opened with the International Bureau and the identification of the party effecting the payment or giving the instructions; and (10) an indication of applicant's Contracting Party as required under Rule 7(4)(a).

II. ADDITIONAL MANDATORY CONTENTS

Additional mandatory contents are elements that are required by certain Contracting Parties and therefore are mandatory in any international design application that designates such Contracting Parties (see Article 5(2) and Rule 7 of the Hague

Agreement and 37 CFR 1.1021(b)).

Such additional mandatory contents may consist of, pursuant to Article 5(2) of the Hague Agreement, indications concerning the identity of the creator, a brief description of the reproduction or of the characteristic features of the industrial design, (iii) a claim, and/or, pursuant to Rule 8(1) of the Hague Agreement, a statement, document, oath, or declaration.

III. OPTIONAL CONTENTS

Optional contents are items that may be included in an international design application. Optional contents are addressed in Rule 7(5) of the Hague Agreement and 37 CFR 1.1021(c) and may include: (1) two or more industrial designs, subject to the prescribed conditions; (2) a request for deferment of publication or a request for immediate publication; (3) any of the additional mandatory elements discussed above, even if such elements are not required by any Contracting Party designated in the international design application; (4) the name and address of applicant's representative, as prescribed; (5) a claim of priority of one or more earlier filed applications; (6) a declaration, for purposes of Article 11 of the Paris Convention, that the product or products that constitute the industrial design, or in which the industrial design is incorporated, have been shown at an official or officially recognized international exhibition, together with the place where the exhibition was held and the date on which the product or products were first exhibited there and, where less than all the industrial designs contained in the international application are concerned, the indication of those industrial designs to which the declaration relates or does not relate; (7) any declaration, statement, or other relevant indications as may be specified in the Administrative Instructions; (8) a statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned; and (9) a proposed translation of any text matter contained in the international application for purposes of recording and publication.

IV. REQUIRED CONTENTS WHERE THE UNITED STATES IS DESIGNATED

As set forth in 37 CFR 1.1021(d), in addition to the mandatory requirements otherwise required for international design applications, an international design application designating the

United States must also include: (1) a claim (37 CFR 1.1021(b)(1)(iii) and 37 CFR 1.1025); (2) indications concerning the identity of the creator (i.e., the inventor, see 37 CFR 1.9(d)) in accordance with Rule 11(1); and (3) the inventor's oath or declaration (37 CFR 1.63 and 1.64).

A claim is a filing date requirement for design applications in the United States. See 35 U.S.C. 171. The United States has declared, pursuant to Article 5(2), that an international design application designating the United States must contain a claim. See MPEP § 2903. Consequently, an international design application designating the United States that does not contain a claim will not be registered by the International Bureau in the international register and thus will not be entitled to a filing date in the United States. See MPEP § 2907 and 2908. In such case, the International Bureau will invite the applicant to submit the claim within a prescribed time limit and will accord a date of international registration as of the date of receipt of the claim (assuming there are no other defects). Failure to timely submit the claim in response to the invitation by the International Bureau will result in the application being deemed not to contain the designation of the United States. See Article 8(2)(b).

Pursuant to Rule 8(1), the United States has declared that an international design application designating the United States must contain an oath or declaration of the creator and indications concerning the identity of the creator. See MPEP § 2903.

The requirements for the inventor's oath or declaration are set forth in 37 CFR 1.63 and 1.64. 37 CFR 1.1021(d) further provides that the requirements in 37 CFR 1.63(b) and 1.64(b)(4) to identify each inventor by his or her legal name, mailing address, and residence, if an inventor lives at a location which is different from the mailing address, and the requirement in 37 CFR 1.64(b)(2) to identify the residence and mailing address of the person signing the substitute statement will be considered satisfied by the presentation of such information in the international design application prior to international registration. If the inventor's oath or declaration has not been filed, the International Bureau will invite the applicant to submit the inventor's oath or declaration within a prescribed time limit. Failure to timely submit the inventor's oath or declaration in response to the invitation by the International Bureau will result in the application being deemed not to contain the

designation of the United States. See Article 8(2)(b).

An international design application designating the United States must include a specification as prescribed by 35 U.S.C. 112 and preferably include a brief description of the reproductions pursuant to Rule 7(5)(a) describing the view or views of the reproductions. See 37 CFR 1.1024. The Office encourages applicants filing international design applications that designate the United States to include a brief description in the application describing the views of the reproductions, as such description is helpful for examination and may, in some cases, help avoid issues concerning the scope of the claimed design or sufficiency of disclosure. Furthermore, a description of the view or views of the reproductions may be required by the Office in a nonprovisional international design application, as defined by 37 CFR 1.9(a)(3), pursuant to 37 CFR 1.1067. See MPEP § 2920.04(a), subsection II.

An international design application designating the United States may not contain a request for deferment of publication. See 37 CFR 1.1028. In addition, specimens are not permitted in international design applications designating the United States. See 37 CFR 1.1027.

2909.01 Official Form for the Application for International Registration [R-07.2015]

37 CFR 1.1022 Form and signature

(a) The international design application shall be presented on the official form (Rules 7(1) and 1(vi)).

(b) The international design application shall be signed by the applicant.

Hague Rule 7 Requirements Concerning the International Application

(1) [Form and Signature] The international application shall be presented on the official form. The international application shall be signed by the applicant.

Hague Rule 1 Definitions

(1) [Abbreviated Expressions] For the purposes of these Regulations,

(vi) "official form" means a form established by the International Bureau or an electronic interface made available

by the International Bureau on the web site of the Organization, or any form or electronic interface having the same contents and format;

The international design application must be presented on the "official form." Pursuant to Hague Agreement Rule 1(vi), "official form" means a form established by the International Bureau or an electronic interface made available by the International Bureau on the website of the Organization, or any form or electronic interface having the same contents and format. The form established by the International Bureau for filing an international design application is the form DM/1, "Application for International Registration". The DM/1 form and instructions for completing the form are currently available on the website of the International Bureau at www.wipo.int/hague/en/forms/.

Proper usage of the DM/1 form will help ensure that the mandatory, additional mandatory and optional content items for an international design application are present upon filing. Form DM/1 provides applicant with specific spaces to set forth: (1) information concerning the applicant; (2) a correspondence address for the International Bureau where there are multiple applicants and no appointed representative; (3) applicant's entitlement to file an international design application; (4) applicant's Contracting Party; (5) the appointed representative; (6) information concerning the creator; (7) the number of industrial designs and reproductions included in the application; (8) the applicable product and Locarno classification (MPEP § 907); (9) a brief description; (10) a claim; (11) the designated Contracting Parties; (12) any priority claim; (13) information regarding any international exhibition where any of the designs was shown; (14) a request for immediate or deferred publication; and (15) the signature of the applicant or the applicant's representative. The DM/1 form also includes a "Payment of Fees" section that allows the applicant to identify the method of payment and to instruct the International Bureau to debit the required fees to a current account established with the International Bureau.

2909.02 Reproductions (Drawings) [R-07.2015]

37 CFR 1.1026 Reproductions

Reproductions shall comply with the requirements of Rule 9 and

Part Four of the Administrative Instructions.

Hague Rule 9 Reproductions of the Industrial Design

(1) [Form and Number of Reproductions of the Industrial Design]

(a) Reproductions of the industrial design shall, at the option of the applicant, be in the form of photographs or other graphic representations of the industrial design itself or of the product or products which constitute the industrial design. The same product may be shown from different angles; views from different angles shall be included in different photographs or other graphic representations.

(b) Any reproduction shall be submitted in the number of copies specified in the Administrative Instructions.

(2) [Requirements Concerning Reproductions]

(a) Reproductions shall be of a quality permitting all the details of the industrial design to be clearly distinguished and permitting publication.

(b) Matter which is shown in a reproduction but for which protection is not sought may be indicated as provided for in the Administrative Instructions.

(3) [Views Required]

(a) Subject to subparagraph (b), any Contracting Party bound by the 1999 Act which requires certain specified views of the product or products which constitute the industrial design or in relation to which the industrial design is to be used shall, in a declaration, so notify the Director General, specifying the views that are required and the circumstances in which they are required.

(b) No Contracting Party may require more than one view where the industrial design or product is two-dimensional, or more than six views where the product is three-dimensional.

(4) [Refusal on Grounds Relating to the Reproductions of the Industrial Design] A Contracting Party may not refuse the effects of the international registration on the ground that requirements relating to the form of the reproductions of the industrial design that are additional to, or different from, those notified by that Contracting Party in accordance with paragraph (3)(a) have not been satisfied under its law. A Contracting Party may however refuse the effects of the international registration on the ground that the reproductions contained in the international registration are not sufficient to disclose fully the industrial design.

Administrative instructions concerning reproductions contained

in Part Four of the Administrative Instructions for the Application of the Hague Agreement ("Administrative Instructions") are set forth below:

Hague Administrative Instructions Section 401:

Presentation of Reproductions

(a) One and the same international application may comprise both photographs and other graphic representations, in black and white or in color.

(b) Each reproduction accompanying an international application shall be submitted in a single copy.

(c) The photographs or other graphic representations accompanying an international application filed on paper shall be either pasted or printed directly onto a separate sheet of A4 paper which is white and opaque. The separate sheet of paper shall be used upright and shall not contain more than 25 reproductions.

(d) The reproductions accompanying an international application must be arranged in the orientation in which the applicant wishes them to be published. Where that application is filed on paper, a margin of at least 5 millimeters should be left around the representation of each industrial design.

(e) Each reproduction must fall within a right-angled quadrilateral containing no other reproduction or part of another reproduction and no numbering. The photographs or other graphic representations shall not be folded, stapled or marked in any way.

Hague Administrative Instructions Section 402

Representation of the Industrial Design

(a) The photographs and other graphic representations shall represent the industrial design alone, or the product in relation to which the industrial design is to be used, to the exclusion of any other object, accessory, person or animal.

(b) The dimensions of the representation of each industrial design appearing in a photograph or other graphic representation may not exceed 16 x 16 centimeters, and in respect of at least one representation of each design, one of those dimensions must be at least 3 centimeters. With respect to the filing of international applications by electronic means, the International Bureau may establish a data format, the particulars of which shall be published on the web site of the Organization, to ensure compliance with these maximum and minimum dimensions.

(c) The following shall not be accepted:

(i) technical drawings, particularly with axes and dimensions;

(ii) explanatory text or legends in the representation.

Hague Administrative Instructions Section 403

Disclaimers and Matter That Does Not Form Part of the Industrial Design or the Product in Relation to Which the Industrial Design is to be Used

(a) Matter which is shown in a reproduction but for which protection is not sought may be indicated

(i) in the description referred to in Rule 7(5)(a) and/or

(ii) by means of dotted or broken lines or coloring.

(b) Notwithstanding Section 402(a), matter that does not form part of the industrial design or the product in relation to which the industrial design is to be used may be shown in a reproduction if it is indicated in accordance with paragraph (a).

Hague Administrative Instructions Section 404

Requirements for Photographs and Other Graphic Representations

(a) The photographs supplied must be of professional standard and have all the edges cut at right angles. The industrial design must be shown against a neutral plain background. Photographs retouched with ink or correcting fluid shall not be allowed.

(b) Graphic representations must be of professional standard produced with drawing instruments or by electronic means and, where the application is filed on paper, must further be produced on good quality white, opaque paper, all of whose edges are cut at right angles. The industrial design represented may comprise shading and hatching to provide relief. Graphic representations executed by electronic means may be shown against a background, provided that it is neutral and plain and has only edges cut at right angles.

Hague Administrative Instructions Section 405

Numbering of Reproductions and Legends

(a) The numbering stipulated for multiple international applications shall appear in the margin of each photograph or other graphic representation. When the same industrial design is represented from different angles, the numbering shall consist of two separate figures separated by a dot (e.g., 1.1, 1.2, 1.3, etc. for the first design, 2.1, 2.2, 2.3, etc. for the second design, and so on).

(b) The reproductions shall be submitted in ascending numerical order.

(c) Legends to indicate a specific view of the product (e.g., "front view", "top view", etc.) may be indicated in association

with the numbering of the reproduction.

Reproductions in international design applications must comply with the requirements of Hague Agreement Rule 9 and Part Four of the Administrative Instructions. See 37 CFR 1.1026.

Pursuant to Rule 9, the reproductions of the industrial design shall, at the option of the applicant, be in the form of photographs or other graphic representations of the industrial design itself or of the product or products which constitute the industrial design. The same product may be shown from different angles; views from different angles shall be included indifferent photographs or other graphic representations. Pursuant to Administrative Instruction 401, only a single copy of each reproduction should be submitted.

The reproductions must be of a quality permitting all the details of the industrial design to be clearly distinguished and permitting publication. See Rule 9(2). The reproductions should represent the industrial design alone, or the product in relation to which the industrial design is to be used, without any other object, accessory, person, or animal. However, the reproduction may show matter for which protection is not sought if such matter is indicated as provided for in Administrative Instruction 403. Pursuant to Rule 9(3)(a), a Contracting Party may require certain specified views of the product or products which constitute the industrial design or in relation to which the industrial design is to be used, if the Contracting Party has appropriately notified the International Bureau of the required views and the circumstances under which they are required. Information concerning specified views required by a Contracting Party pursuant to Rule 9(3)(a) is set forth in the section "Specific Requirements Concerning Views" of WIPO form DM/1. INF, "How to file an international application" currently available at WIPO's website at www.wipo.int/hague/en/forms/.

Additional formal requirements for the reproductions (e.g., margins, paper, backgrounds, etc.) are set forth in the Administrative Instructions. In addition, technical requirements regarding image files, such as resolution, minimum and maximum image size, border width, etc., are set forth on the website of the International Bureau at www.wipo.int/hague/en/how_to/file/prepare.html. Reproductions may be filed through the USPTO as an office of indirect filing via EFS-Web as PDF or JPEG files in accordance with the EFS-Web Legal Framework. See MPEP § 502.05

and 2909.02(a).

2909.02(a) Reproductions Submitted Through EFS-Web [R-07.2015]

Reproductions of industrial designs are required in international design applications and may be submitted as drawings, photographs, or a combination thereof, and may be in black and white or in color. See Rule 9 and Part Four of the Administrative Instructions for the Application of the Hague Agreement. Reproductions may be submitted through EFS-Web as PDF or JPEG files as set forth below. Technical requirements regarding image files, such as resolution, minimum and maximum image size, border width, etc., are also set forth on the website of the International Bureau at www.wipo.int/hague/en/how_to/file/prepare.html.

Reproductions may be submitted as single page PDF or JPEG files by attaching the file(s) using the "Attach Reproductions" section of the "Attach Documents" screen. Alternatively, applicants may attach reproductions as PDFs (including multi-page PDFs) using the "Attach Documents other than Reproductions" section of the "Attach Documents" screen. Attaching compliant reproductions via the "Attach Reproductions" section, rather than the "Attach Documents other than Reproductions" section, may help to avoid incurring additional perpage publication fees that might otherwise be required by the International Bureau. Each image file attached through the "Attach Reproductions" section should contain only one view of the design. The "Attach Reproductions" section will prompt the user to assign a design and view number to each file attached under this section.

In accordance with the technical requirements set forth by the International Bureau, EFS-Web will not permit submission of any PDF or JPEG file via the "Attach Reproductions" section that exceeds a file size of two megabytes. For JPEG submissions, EFS-Web will provide warnings where requirements pertaining to image resolution and minimum and maximum dimensions have not been satisfied; EFS-Web does not check color mode or border size for JPEG images. For PDF submissions via the "Attach Reproductions" section, EFS-Web will not permit submission of any PDF file that is more than one page. In addition, EFS-Web does not check color mode, border size, resolution, or maximum or minimum dimensions of the reproduction (other than certain minimum and maximum page size dimensions) for PDF images. It is the responsibility of applicants to ensure that reproductions satisfy all applicable

requirements.

Users attaching reproductions under either the "Attach Reproductions" section or the "Attach Documents other than Reproductions" section should use the document description "drawings - only black and white line drawings" or "drawing - other than black and white line drawings", as appropriate.

EFS-Web will provide a warning to users about the possibility of incurring additional per page publication fees where reproductions are attached via the "Attach Documents other than Reproductions" section. EFS-Web will also provide a warning to users where a new international design application does not contain an indication that at least one reproduction is attached. See MPEP § 502.05 for additional information on using EFS-Web.

2909.03 Annexes [R-07.2015]

Annexes to the DM/1 form are used to provide certain required or optional items relevant to a particular designated Contracting Party. Annex forms specific to particular Contracting Parties are currently available on the website of the International Bureau at www.wipo.int/hague/en/forms/.

Annex forms specific to the designation of the United States include annexes for submitting the inventor's oath or declaration, an information disclosure statement, and a certification of micro entity status.

2910 International Design Application Fees [R-07.2015]

37 CFR 1.1031 International design application fees.

(a) International design applications filed through the Office as an office of indirect filing are subject to payment of a transmittal fee (35 U.S.C. 382(b) and Article 4(2)) in the amount of \$120.

(b) The Schedule of Fees annexed to the Regulations (Rule 27(1)), a list of individual designation fee amounts, and a fee calculator may be viewed on the Web site of the World Intellectual Property Organization, currently available at <http://www.wipo.int/hague>.

(c) The following fees required by the International Bureau may be paid either directly to the International Bureau or through the Office as an office of indirect filing in the amounts specified on the World Intellectual Property Organization Web site described in paragraph (b) of this section:

- (1) International application fees (Rule 12(1)); and
- (2) Fee for descriptions exceeding 100 words (Rule 11(2)).

(d) The fees referred to in paragraph (c) of this section may be paid as follows:

(1) Directly to the International Bureau in Swiss currency (see Administrative Instruction 801); or

(2) Through the Office as an office of indirect filing, provided such fees are paid no later than the date of payment of the transmittal fee required under paragraph (a) of this section.

Any payment through the Office must be in U.S. dollars. Applicants paying the fees in paragraph (c) of this section through the Office may be subject to a requirement by the International Bureau to pay additional amounts where the conversion from U.S. dollars to Swiss currency results in the International Bureau receiving less than the prescribed amounts.

(e) Payment of the fees referred to in Article 17 and Rule 24 for renewing an international registration ("renewal fees") is not required to maintain a U.S. patent issuing on an international design application in force. Renewal fees, if required, must be submitted directly to the International Bureau. Any renewal fee submitted to the Office will not be transmitted to the International Bureau.

Hague Agreement Rule 12

Fees Concerning the International Application

- (1) [Prescribed Fees]

(a) The international application shall be subject to the payment

of the following fees:

- (i) a basic fee;
- (ii) a standard designation fee in respect of each designated Contracting Party that has not made a declaration under Article 7(2) of the 1999 Act or under Rule 36(1), the level of which will depend on a declaration made under subparagraph(c);
- (iii) an individual designation fee in respect of each designated Contracting Party that has made a declaration under Article 7(2) of the 1999 Act or under Rule 36(1);
- (iv) a publication fee.

(b) The level of the standard designation fee referred to in subparagraph (a)(ii) shall be as follows:

- (i) for Contracting Parties whose office does not carry out any examination on substantive ground:.....one
- (ii) for Contracting Parties whose office carries out examination on substantive grounds, other than as to novelty:.....two
- (iii) for Contracting Parties whose office carries out examination on substantive grounds, including examination as to novelty either ex officio or following opposition by third parties:three

(c)

(i) Any Contracting Party whose legislation entitles it to the application of level two or three under subparagraph (b) may, in a declaration, notify the Director General accordingly.

A Contracting Party may also, in its declaration, specify that it opts for the application of level two, even if its legislation entitles it to the application of level three.

(ii) Any declaration made under item (i) shall take effect three months after its receipt by the Director General or at any later date indicated in the declaration. It may also be withdrawn at any time by notification addressed to the Director General, in which case such withdrawal shall take effect one month after its receipt by the Director General or at any later date indicated in the notification. In the absence of such a declaration, or where a declaration has been withdrawn, level one will be deemed to be the level applicable to the standard designation fee in respect of that Contracting Party.

(2) [When Fees to Be Paid] The fees referred to in paragraph (1) are, subject to paragraph (3), payable at the time of filing the international application, except that, where the international application contains a request for deferment of publication, the

publication fee may be paid later, in accordance with Rule 16(3) (a).

(3) [Individual Designation Fee Payable in Two Parts]

(a) A declaration under Article 7(2) of the 1999 Act or under Rule 36(1) may also specify that the individual designation fee to be paid in respect of the Contracting Party concerned comprises two parts, the first part to be paid at the time of filing the international application and the second part to be paid at a later date which is determined in accordance with the law of the Contracting Party concerned.

Pursuant to Hague Agreement Rule 12, an international design application is subject to the following fees: (1) basic fee; (2) standard designation fee(s); (3) individual designation fee(s); and (4) publication fee. Also, pursuant to Hague Agreement Rule 11(2), an additional fee is required where the application contains a description that exceeds 100 words. In addition, a transmittal fee is required for an international design application filed through the USPTO as an office of indirect filing.

The International Bureau provides a Fee Calculator where users can input the appropriate data concerning their international design applications, and the Fee Calculator will determine the total amount of fees required (excluding any required transmittal fee) in Swiss currency.

See [www.wipo.int/hague /en/fees/calculator.jsp](http://www.wipo.int/hague/en/fees/calculator.jsp).

I. TRANSMITTAL FEE

International design applications filed through the USPTO as an office of indirect filing are subject to payment of a transmittal fee. See 37 CFR 1.1031(a). Payment of the transmittal fee must be in U.S.dollars. The USPTO will not transmit the international design application to the International Bureau if the transmittal fee has not been paid. See 37 CFR 1.1045. Applicants are cautioned that an international design application not received by the International Bureau within six months from the date the international design application is received by the USPTO will not be entitled to a filing date as of the date of receipt of the application by the USPTO. See Hague Agreement Rule 13.

II. BASIC FEE, PUBLICATION FEE, AND DESIGNATION FEES

The amount of the basic fee (Rule 12(1)(i)) is set forth in the Schedule of Fees and is dependent upon the number of designs included in the international design application. The amount of the publication fee (Rule 12(1)(iv)) is also set forth in the Schedule of Fees and is dependent upon the number of reproductions to be published and the form in which the reproductions are submitted. The Schedule of Fees is currently available on the website of the International Bureau at www.wipo.int/hague/en/fees/sched.htm.

A separate designation fee applies with respect to each Contracting Party designated in an international design application. The standard designation fee (Rule 12(1)(ii)) applies with respect to the designation of any Contracting Party that has not specifically set an individual designation fee.

The standard designation fee varies between levels 1-3, depending on the form of examination performed by each designated Contracting Party and on any specific agreement between such Contracting Party and the International Bureau.

The standard designation fees are set forth in the Schedule of Fees.

The individual designation fee (Rule 12(1)(iii)) applies where an application designates a Contracting Parties that has made a declaration under Article 7(2) of the Hague Agreement setting an individual designation fee.

The United States has made a declaration under Article 7(2) and requires an individual designation fee that is payable in a first part at filing and second part payable upon allowance of the application by the USPTO. See MPEP § 2903 and 2920.06. The first and second parts of the individual designation fee for the United States are discounted for small and micro entities. See 37 CFR 1.27 and MPEP § 509.02 and 509.03 for requirements for establishing small entity status, and 37 CFR 1.29 and MPEP § 509.04 for requirements for establishing micro entity status. With respect to international design applications, the payment by any party of the small entity first part of the individual designation fee for the United States to the International Bureau will be treated as a written assertion of entitlement to small entity status. See 37 CFR 1.27(c)(3). In addition, a micro entity certification may be signed by a person authorized to represent the applicant in the international design application under 37

CFR 1.1041 before the International Bureau where the micro entity certification is filed with the International Bureau. See 37 CFR 1.28(e).

Individual designation fees are set forth on the website of the International Bureau. See www.wipo.int/hague/en/fees/individ-fee.html.

The Fee Calculation Sheet included with the DM/1 form also specifies the amount of the basic fee, publication fee, designation fees, and the additional fee where the description exceeds 100 words. Also included is a listing of the level of the standard designation fee applicable to respective Contracting Parties.

III. PAYMENT OF FEES THROUGH THE USPTO WHEN APPLICATION FILED THROUGH USPTO AS AN OFFICE OF INDIRECT FILING

Certain international fees payable to the International Bureau may be paid through the USPTO as an office of indirect filing, provided such fees are paid no later than the date of payment of the transmittal fee. See 37 CFR 1.1031(c). Applicants are not required to pay such fees through the USPTO but rather may pay such fees directly to the International Bureau. Furthermore, any payment of such fees through the USPTO must be in U.S. dollars. As all payments made to the International Bureau must be in Swiss currency, the U.S. dollar amount collected may, when converted to Swiss currency, be different than the required Swiss currency amount. Accordingly, applicants are cautioned that paying such international fees through the USPTO may still result in a requirement by the International Bureau to pay additional amounts where the conversion from U.S. dollars to Swiss currency results in the International Bureau receiving less than the prescribed amounts. Any payment in response to an invitation from the International Bureau requiring additional fees must be made directly to the International Bureau within the period set in the invitation to avoid abandonment of the application pursuant to Article 8 of the Hague Agreement. To avoid receiving an invitation from the International Bureau requiring additional fees, applicants may wish to consider including authorization in the fee payment section of the DM/1 form to allow the International Bureau to debit the required fees to a current account established with the International Bureau. See Administrative Instruction 801 and MPEP § 2909.01.

Applicant may charge international design application fees to a USPTO deposit account when filing an international design application through the USPTO as an office of indirect filing. However, a general authorization to charge such fees will only be effective with respect to the transmittal fee required under 37 CFR 1.1031(a). See 37 CFR 1.25. In addition, international design application fees may not be paid through the USPTO after the date of payment of the transmittal fee. See 37 CFR 1.1031(c). Nor may any renewal fees referred to in Hague Agreement Rule 24 for renewing an international registration be paid through the USPTO. See 37 CFR 1.1031(e).

2911 Representation [R-07.2015]

37 CFR 1.1041 Representation in an international design application.

(a) The applicant may appoint a representative before the International Bureau in accordance with Rule 3.

(b) Applicants of international design applications may be represented before the Office as an office of indirect filing by a practitioner registered (§ 11.6) or granted limited recognition (§ 11.9(a) or (b)) to practice before the Office in patent matters. Such practitioner may act pursuant to § 1.34 or pursuant to appointment by the applicant. The appointment must be in writing signed by the applicant, must give the practitioner power to act on behalf of the applicant, and must specify the name and registration number or limited recognition number of each practitioner. An appointment of a representative made in the international design application pursuant to Rule 3(2) that complies with the requirements of this paragraph will be effective as an appointment before the Office as an office of indirect filing.

Hague Rule 3 Representation Before the International Bureau

(1) [Representative; Number Representatives]

(a) The applicant or the holder may have a representative before the International Bureau.

(b) Only one representative may be appointed in respect of a given international application or international registration. Where the appointment indicates several representatives, only the one indicated first shall be considered to be a representative and be recorded as such.

(c) Where a partnership or firm composed of attorneys or patent or trademark agents has been indicated as representative to the International Bureau, it shall be regarded as one representative.

(2) [Appointment of the Representative]

(a) The appointment of a representative may be made in the international application, provided that the application is signed by the applicant.

(b) The appointment of a representative may also be made in a separate communication which may relate to one or more specified international applications or international registrations of the same applicant or holder. The said communication shall be signed by the applicant or the holder.

(c) Where the International Bureau considers that the appointment

of a representative is irregular, it shall notify accordingly the applicant or holder and the purported representative.

Rule 3 of the Hague Agreement provides for the appointment by the applicant of a representative before the International Bureau. Rule 3 does not provide for any requirement as to professional qualification, nationality, or domicile regarding who may be appointed to represent the applicant before the International Bureau. The appointment may be made in the international design application or in a separate communication. See Rule 3(2).

With respect to representation before the USPTO as an office of indirect filing, 37 CFR 1.1041(b) provides that applicants of international design applications may be represented before the Office as an office of indirect filing by a practitioner registered (37 CFR 11.6) or granted limited recognition (37 CFR 11.9(a) or (b)) to practice before the Office (37 CFR 11.6). Such practitioner may act pursuant to 37 CFR 1.34 or pursuant to appointment by the applicant. The appointment must be in writing signed by the applicant, must give the practitioner power to act on behalf of the applicant, and must specify the name and registration number or limited recognition number of each practitioner. An appointment of a representative made in the international design application pursuant to Rule 3(2) that complies with the requirements of 37 CFR 1.1041(b) will be effective as an appointment before the Office as an office of indirect filing. For purposes of representation before the Office during prosecution of an international design application that became a national application (see 37 CFR 1.9(a)(1)), the regulations governing national applications shall apply. See 37 CFR 1.1061(a).

2912 Correspondence in Respect of International Design Applications Filed With the USPTO as an Office of Indirect Filing [R-07.2015]

37 CFR 1.1042 Correspondence respecting international design applications filed with the Office as an office of indirect filing.

The applicant may specify a correspondence address for correspondence sent by the Office as an office of indirect filing. Where no such address has been specified, the Office will use as the correspondence address the address of applicant's appointed representative (§ 1.1041) or, where no representative is appointed, the address as specified in Administrative Instruction 302.

Hague Administrative Instructions Section 302

Address for Correspondence

Where there are two or more applicants or new owners with different addresses and no representative is appointed, one address for correspondence shall be indicated. Where no such address has been indicated, the address of the person named first shall be treated as the address for correspondence.

Pursuant to 37 CFR 1.1042, the applicant may specify a correspondence address for correspondence sent by the USPTO as an office of indirect filing. The official form (DM/1 form) used for filing an international design application includes boxes for specifying an address to be used for correspondence sent by the International Bureau. See MPEP §2909.01. Applicants may specify a different address than specified on the DM/1 form for the purpose of correspondence sent by the USPTO as an office of indirect filing. Where no such address has been specified, the Office will use as the correspondence address of applicant's appointed representative (see 37 CFR 1.1041) or, where no representative is appointed, the address as specified in section 302 of the Administrative Instructions.

2913 Relief from Prescribed Time Limits [R-07.2015]

35 U.S.C. 387 Relief from prescribed time limits.

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.

37 CFR 1.1051 Relief from prescribed time limits.

(a) If the delay in an applicant's failure to act within prescribed time limits under the Hague Agreement in connection with requirements pertaining to an international design application was unintentional, a petition may be filed pursuant to this section to excuse the failure to act as to the United States. A grantable petition pursuant to this section must be accompanied by:

(1) A copy of any invitation sent from the International Bureau setting a prescribed time limit for which applicant failed to timely act;

(2) The reply required under paragraph (c) of this section, unless previously filed;

(3) The fee as set forth in § 1.17(m);

(4) A certified copy of the originally filed international design application, unless a copy of the international design application was previously communicated to the Office from the International Bureau or the international design application was filed with the Office as an office of indirect filing, and a translation there of into the English language if it was filed in another language;

(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 pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(6) A terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(b) Any request for reconsideration or review of a decision refusing to excuse the applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international design application upon petition filed

pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to excuse or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under the provisions of § 1.136.

(c) Reply. The reply required may be:

(1) The filing of a continuing application. If the international design application has not been subject to international registration, the reply must also include a grantable petition under § 1.1023(b) to accord the international design application a filing date; or

(2) A grantable petition under § 1.1052, where the international design application was filed with the Office as an office of indirect filing.

(d) Terminal disclaimer. Any petition pursuant to this section must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period beginning on the due date for the reply for which applicant failed to timely act and ending on the date of filing of the reply required under paragraph (c) of this section and must also apply to any patent granted on a continuing design application that contains a specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to the application for which relief under this section is sought. Pursuant to 35 U.S.C. 387, 37 CFR 1.1051 sets forth a petition procedure to excuse, with respect to the United States, an applicant's failure to act within prescribed time limits under the Hague Agreement in connection with requirements pertaining to an international design application where the delay in applicant's failure to act was unintentional. The petition must be accompanied by: (1) a copy of any invitation sent from the International Bureau setting a prescribed time limit for which applicant failed to timely act; (2) the reply required under 37 CFR 1.1051(c), unless previously filed; (3) the fee as set forth in 37 CFR 1.17(m); (4) a certified copy of the originally filed international design application, unless a copy of the international design application was previously communicated to the Office from the International Bureau or the international design application was filed with the USPTO as an office of indirect filing; (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 pursuant to this paragraph was unintentional; and (6) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.1051(d). The Director may require additional information where there is a question whether the delay was unintentional.

Pursuant to 37 CFR 1.1051(c), the "reply" required for a grantable petition under 37 CFR 1.1051(a) may be: (1) the filing of a continuing application and, if the international design application has not been subject to international registration, a grantable petition under 37 CFR 1.1023(b) to accord the international design application a filing date; or (2) a grantable petition under 37 CFR 1.1052, where the international design application was filed with the Office as an office of indirect filing. See MPEP § 2914.

Pursuant to 37 CFR 1.1051(d), any petition under 37 CFR 1.1051(a) must be accompanied by a terminal disclaimer and fee as set forth in 37 CFR 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period beginning on the due date for the reply for which applicant failed to timely act and ending on the date of filing of the reply required and must also apply to any patent granted on a continuing design application that contains a specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to the application for which relief under 37 CFR 1.1051 is sought.

Where a petition under 37 CFR 1.1051(a) is refused by the Office, any request for reconsideration or review of the decision must be filed within two months of the decision or within such time as set in the decision. Unless the decision indicates otherwise, the two-month time period may be extended under the provisions of 37 CFR 1.136. See 37 CFR 1.1051(b).

2914 Conversion of an International Design Application to a Design Application Under 35 U.S.C. Chapter 16 [R-07.2015]
35 U.S.C. 384 Filing date.

(a) IN GENERAL.

Subject to subsection (b), the filing date of an international design application in the United States shall be the effective registration date. 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.

(b) REVIEW.

An applicant may request review by the Director of the filing date of the international design application in the United States. The Director may determine that the filing date of the international design application in the United States is a date other than the effective registration date. The Director may establish procedures, including the payment of a surcharge, to review the filing date under this section. Such review may result in a determination that the application has a filing date in the United States other than the effective registration date.

37 CFR 1.1052 Conversion to a design application under 35 U.S.C. chapter 16.

(a) An international design application designating the United States filed with the Office as an office of indirect filing and meeting the requirements under § 1.53(b) for a filing date for an application for a design patent may, on petition under this section, be converted to an application for a design patent under § 1.53(b) and accorded a filing date as provided therein.

A petition under this section must be accompanied by the fee set forth in § 1.17(t) and be filed prior to publication of the international registration under Article 10(3). The conversion of an international design application to an application for a design patent under § 1.53(b) will not entitle applicant to a refund of the transmittal fee or any fee forwarded to the International Bureau, or the application of any such fee toward the filing fee, or any other fee, for the application for a design patent under § 1.53(b). The application for a design patent resulting from conversion of an international design application must also include the basic filing fee (§ 1.16(b)), the search fee (§ 1.16(l)), the examination fee (§ 1.16(p)), the inventor's oath or declaration (§ 1.63 or 1.64), and a surcharge if required

by § 1.16(f).

(b) An international design application will be converted to an application for a design patent under § 1.53(b) if a decision on petition under this section is granted prior to transmittal of the international design application to the International Bureau pursuant to § 1.1045. Otherwise, a decision granting a petition under this section will be effective to convert the international design application to an application for a design patent under § 1.53(b) only for purposes of the designation of the United States.

(c) A petition under this section will not be granted in an abandoned international design application absent a grantable petition under § 1.1051.

(d) An international design application converted under this section is subject to the regulations applicable to a design application filed under 35 U.S.C. chapter 16.

Pursuant to 35 U.S.C. 384(a), "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." 37 CFR 1.1052 sets forth a procedure for converting an international design application designating the United States to a design application under 35 U.S.C. chapter 16. The requirements for a filing date for a design application under 35 U.S.C. chapter 16 are set forth in 37 CFR 1.53(b). 37 CFR 1.1052(a) provides that an international design application designating the United States filed with the Office as an office of indirect filing and meeting the requirements under 37 CFR 1.53(b) for a filing date for an application for a design patent may, on petition, be converted to an application for a design patent under 37 CFR 1.53(b) and accorded a filing date as provided therein.

A grantable petition to convert under 37 CFR 1.1052(a) must be accompanied by the fee set forth in 37 CFR 1.17(t) and be filed prior to publication of the international registration under Article 10(3) of the Hague Agreement. The conversion of an international design application to an application for a design patent under 37 CFR 1.53(b) will not entitle applicant to a refund of the transmittal fee or any fee forwarded to the International Bureau, and such fees will not be applied toward the filing fee, or any other fee, required for the application for a design patent under 37 CFR 1.53(b). Conversion will not be granted unless the application for a design patent resulting from conversion of an

international design application includes the applicable basic filing fee, search fee, examination fee, inventor's oath or declaration, and any required surcharge. In addition, a petition to convert under 37 CFR 1.1052(a) will not be granted in an abandoned application absent a grantable petition for relief from prescribed time limits under 37 CFR 1.1051. See 37 CFR 1.1052(c). An international design application converted under 37 CFR 1.1052 is subject to the regulations applicable to a design application filed under 35 U.S.C. chapter 16. See 37 CFR 1.1052(d).

Pursuant to 37 CFR 1.1052(b), if a decision granting a petition to convert under 37 CFR 1.1052(a) is issued prior to transmittal of the international design application to the International Bureau under 37 CFR 1.1045, then the decision will be effective to convert the international design application to an application for a design patent under 37 CFR 1.53(b) for all purposes.

In such case, the application materials will not be communicated to the International Bureau, and the USPTO will treat the international design application submission as an application for a design patent filed under 37 CFR 1.53(b). If, however, a decision granting a petition to convert under 37 CFR 1.1052(a) is issued after the application materials have been communicated to the International Bureau under 37 CFR 1.1045, then the decision will only be effective as to the United States, and the International Bureau will continue to process the international design application under the provisions of the Hague Agreement. In such case, because the international design application will have been converted to an application for a design patent under 37 CFR 1.53(b) with respect to the designation of the United States, the Office will, upon grant of the petition, treat the designation of the United States in the international design application as not being made.

2915-2919 [Reserved]

2920 National Processing of International Design Applications Designating the United States [R-07.2015]

35 U.S.C. 389 Examination of international design application.

(a) IN GENERAL.

The Director shall cause an examination to be made pursuant to this title of an international design application designating the United States.

(b) APPLICABILITY OF CHAPTER 16.

All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16.

(c) FEES.

The Director may prescribe fees for filing international design applications, for designating the United States, and for any other processing, services, or materials relating to international design applications, and may provide for later payment of such fees, including surcharges for later submission of fees.

(d) ISSUANCE OF PATENT.

The Director may issue a patent based on an international design application designating the United States, in accordance with the provisions of this title. Such patent shall have the force and effect of a patent issued on an application filed under chapter 16.

37 CFR 1.9 Definitions.

(a) (1) A national application as used in this chapter means either a U.S. application for patent which was filed in the Office under 35 U.S.C. 111, an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

(3) A nonprovisional application as used in this chapter means either a U.S. national application for patent which was filed in the Office under 35 U.S.C. 111(a), an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement

in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

Hague Article 10

International Registration, Date of the International Registration, Publication and Confidential Copies of the International Registration

(3) [Publication]

(a) The international registration shall be published by the International Bureau. Such publication shall be deemed in all Contracting Parties to be sufficient publicity, and no other publicity may be required of the holder.

(b) The International Bureau shall send a copy of the publication of the international registration to each designated Office.

Hague Article 14 Effects of the International Registration

(1) [Effect as Application Under Applicable Law]

The international registration shall, from the date of the international registration, have at least the same effect in each designated Contracting Party as a regularly-filed application for the grant of protection of the industrial design under the law of that Contracting Party.

Hague Article 12 Refusal

(1) [Right to Refuse] The Office of any designated Contracting Party may, where the conditions for the grant of protection under the law of that Contracting Party are not met in respect of any or all of the industrial designs that are the subject of an international registration, refuse the effects, in part or in whole, of the international registration in the territory of the said Contracting Party, provided that no Office may refuse the effects, in part or in whole, of any international registration on the ground that requirements relating to the form or contents of the international application that are provided for in this Act or the Regulations or are additional to, or different from, those requirements have not been satisfied under the law of the Contracting Party concerned.

The Office will examine an international design application designating the United States pursuant to Title 35 United States

Code. See 35 U.S.C. 389(a). An applicant does not need to file any submissions with the Office to initiate examination of an international design application designating the United States. Rather, published international design registrations that designate the United States will be systematically received from the International Bureau pursuant to Hague Agreement Article 10(3) and examined in due course.

Upon receipt of the publication under Article 10(3), the Office will establish an application file for examination. Where the Office was also the office of indirect filing, the application file established as the office of indirect filing will be used as the application for examination, thus retaining the same application number. The Office will send a filing receipt to the applicant shortly after receipt of the publication under Article 10(3) indicating the U.S. application number, U.S. filing date, inventorship, applicant, and other relevant application data of record.

The U.S. application file will be made available to the public via public PAIR after publication under Article 10(3) of an international registration designating the United States. Prior to publication, access will only be provided in accordance with 37 CFR 1.14. See 37 CFR 1.14(j).

Pursuant to 37 CFR 1.9(a)(1), the term "national application" as used in the U.S. rules includes an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10. Pursuant to 37 CFR 1.9(a)(3), the term "nonprovisional application" as used in the U.S. rules includes an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10. An international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10 is also referred to herein as a "nonprovisional international design application".

2920.01 Inventorship [R-07.2015]

37 CFR 1.41 Inventorship.

(f) The inventorship of an international design application

designating the United States is the creator or creators set forth in the publication of the international registration under Hague Agreement Article 10(3). Any correction of inventorship must be pursuant to § 1.48.

Pursuant to 37 CFR 1.41(f), the inventorship of an international design application designating the United States is the creator or creators set forth in the publication of the international registration under Hague Agreement Article 10(3).

Inventorship may be corrected in accordance with the provisions of 37 CFR 1.48(a). See MPEP § 602.01(c) et seq. for a detailed discussion of correction of inventorship, correcting or updating the name of an inventor, and adjusting the order of the names of joint inventors. Note that a request to correct the inventorship filed under 37 CFR 1.48(a) should identify the inventorship change and must be accompanied by a signed application data sheet (ADS) including the legal name, residence, and mailing address of the inventor or each actual joint inventor (see 37 CFR 1.76(b)(1)) and the processing fee set forth in 37 CFR 1.17(i). The application data sheet submitted with a request under 37 CFR 1.48(a) must identify the information being changed with underlining for insertions and strike-through or brackets for text removed. See MPEP § 602.01(c)(1). In addition, in accordance with 37 CFR 1.48(c), a request to correct or change the inventorship under 37 CFR 1.48(a) filed after the Office action on the merits has been given or mailed in the application must also be accompanied by the fee set forth in 37 CFR 1.17(d).

37 CFR 1.48(b) provides that an oath or declaration as required by 37 CFR 1.63, or a substitute statement in compliance with 37 CFR 1.64, will be required for any actual inventor who has not yet executed such an oath or declaration. Accordingly, where an inventor is added pursuant to 37 CFR 1.48(a) after publication of the international registration, an executed oath or declaration from the inventor will be required. See MPEP § 2920.04(c).

The name of an inventor may be corrected or updated and the order of the names of the joint inventors may be adjusted in accordance with the provisions of 37 CFR 1.48(f). 37 CFR 1.48(f) specifically provides that any request to correct or update the name of the inventor or a joint inventor, or the order of the names of joint inventors, in a nonprovisional application must include: (1) an application data sheet in accordance with 37 CFR 1.76 that

identifies each inventor by his or her legal name in the desired order (identifying the information that is being changed as required by 37 CFR 1.76(c)(2)); and (2) the processing fee set forth in 37 CFR 1.17(i). In addition to the corrected application data sheet, the request should also identify the desired inventor name change. See MPEP § 602.01(c)(2).

2920.02 Applicant [R-07.2015]

The rules governing the applicant for patent set forth in 37 CFR 1.42-1.46 are generally applicable to nonprovisional international design applications. See 37 CFR 1.1061; see also MPEP § 605.01 for a detailed discussion regarding the applicant for patent.

With respect to applicants under 37 CFR 1.46 (i.e., the assignee, the person to whom the inventor is under an obligation to assign the invention, or the person who otherwise shows sufficient proprietary interest in the matter), 37 CFR 1.46(b) provides that if a nonprovisional international design application is applied for by a person other than the inventor under 37 CFR 1.46(a) (i.e., the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter), that person must have been identified as the applicant in the publication of the international registration under Hague Agreement Article 10(3). Thus, a 37 CFR 1.46 applicant identified as the applicant in the publication of the international registration is the applicant in the nonprovisional international design application.

Any request to change the applicant under 37 CFR 1.46 after an original applicant has been specified must include an application data sheet under 37 CFR 1.76 specifying the applicant in the applicant information section in accordance with 37 CFR 1.76(c)(2) and must comply with 37 CFR 3.71 and 3.73. See 37 CFR 1.46(c)(2). In a nonprovisional international design application, the original applicant specified is the person identified as the applicant in the publication of the international registration under Hague Agreement Article 10(3). Thus, if there is a change of applicant under 37 CFR 1.46 (e.g., from the inventor to the assignee, or from one assignee to another assignee), the new applicant must establish its ownership of the application under 37 CFR 3.71(b) and 3.73. See MPEP § 605.01, subsection II.

Any request to correct or update the name of the applicant under

37 CFR 1.46 must include an application data sheet under 37 CFR 1.76 specifying the correct or updated name of the applicant in the applicant information section. See 37 CFR 1.46(c)(1). Thus, if there is no change in the applicant itself but just the applicant's name (due to a correction or name change), the applicant need only submit an application data sheet specifying the correct or updated name in the applicant information section. Any corrected application data sheet must identify the information being changed with underlining for insertions and strike-through or brackets for text removed as required by 37 CFR 1.76(c)(2). A change in the name of the applicant under 37 CFR 1.46 recorded pursuant to Hague Agreement Article 16(1)(ii) will also be effective to change the name of the applicant in a nonprovisional international design application. See 37 CFR 1.46(c)(1). Hague Agreement Article 16(1)(ii) provides for recording in the International Register by the International Bureau of a change in the name of the holder. Under Article 16(2), such recording has the same effect as if made in the office of each of the designated Contracting Parties. Thus, where the applicant under 37 CFR 1.46 in a nonprovisional international design application is the holder of the international registration, correction or update of the applicant's name may be made through the mechanism under Article 16(1)(ii).

2920.03 Correspondence Address [R-07.2015]

37 CFR 1.1066 Correspondence address for a nonprovisional international design application.

(a) Unless the correspondence address is changed in accordance with § 1.33(a), the Office will use as the correspondence address in a nonprovisional international design application the address according to the following order:

- (1) The correspondence address under § 1.1042;
- (2) The address of applicant's representative identified in the publication of the international registration; and
- (3) The address of the applicant identified in the publication of the international registration.

(b) Reference in the rules to the correspondence address set forth in § 1.33(a) shall be construed to include a reference to this section for a nonprovisional international design application.

37 CFR 1.1066(a) sets forth how the Office will establish the

correspondence address for a nonprovisional international design application in the absence of a communication from the applicant changing the correspondence address. Specifically, 37 CFR 1.1066(a) provides that, unless the correspondence address is changed in accordance with 37 CFR 1.33(a), the Office will use as the correspondence address in a nonprovisional international design application the address according to the following order: (i) the correspondence address under 37 CFR 1.1042; (ii) the address of the applicant's representative identified in the publication of the international registration; and (iii) the address of the applicant identified in the publication of the international registration.

See MPEP § 601.03(a) for further information regarding changing the correspondence address in an application.

2920.04 Elements of a Nonprovisional International Design Application [R-07.2015]

2920.04(a) Specification [R-07.2015]

I. TITLE

37 CFR 1.1067 Title, description, and inventor's oath or declaration.

(a) The title of the design must designate the particular article. Where a nonprovisional international design application does not contain a title of the design, the Office may establish a title. No description, other than a reference to the drawing, is ordinarily required in a nonprovisional international design application.

The title of the design identifies the article in which the design is embodied by the name generally known and used by the public. In general, the practice set forth in MPEP § 1503.01 with regard to titles in design applications filed under 35 U.S.C. chapter 16 applies to nonprovisional international design applications. Thus, for example, the title may be directed to the entire article embodying the design while the claimed design shown in the reproductions may be directed to only a portion of the article. However, the title may not be directed to less than the claimed design shown in the reproductions.

Since 37 CFR 1.1067 requires that the title must designate the

particular article, and since the claim must be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described, the title and claim must correspond. See 37 CFR 1.1025. When the title and claim do not correspond, the title should be objected to under 37 CFR 1.1067 as not corresponding to the claim.

Form paragraphs 15.05.01 and 15.59 may be used in nonprovisional international design applications as appropriate.

¶ 15.05.01 Title of Design Invention

The title of a design being claimed must correspond to the name of the article in which the design is embodied or applied to. See MPEP § 1503.01 and 37 CFR 1.153 or 37 CFR 1.1067.

¶ 15.59 Amend Title

For [1], the title [2] amended throughout the application, original oath or declaration excepted, to read: [3]

Examiner Note:

1. In bracket 1, insert reason.
2. In bracket 2, insert - should be - or - has been -.

II. DESCRIPTION

37 CFR 1.1067 Title, description, and inventor's oath or declaration.

(a) The title of the design must designate the particular article. Where a nonprovisional international design application does not contain a title of the design, the Office may establish a title. No description, other than a reference to the drawing, is ordinarily required in a nonprovisional international design application.

No description of the design in the specification beyond a brief description of the drawing is generally necessary, since as a rule the illustration in the drawing views is its own best description. In re Freeman, 23 App. D.C. 226 (App. D.C. 1904). However, while not required, such a description is not prohibited and may be incorporated into the specification. Descriptions of the figures are not required to be written in any particular format, however, if they do not describe the views of the drawing clearly and accurately, the examiner should object to the unclear and/or inaccurate descriptions and suggest language which

provides a clear and accurate description of the views.

In addition to the figure descriptions, statements that are permissible in the specification of a design application filed under 35 U.S.C. chapter 16 are permissible in the specification of a nonprovisional international design application. See MPEP § 1503.01, subsection II for a list of such permissible statements. This includes, for example, statements indicating the nature and environmental use of the claimed design, and statements indicating the purpose of broken lines in the drawing, for example, environmental structure or boundaries that form no part of the design to be patented. In addition, Administrative Instruction 403 permits matter shown in a reproduction for which protection is not sought to be indicated in the description and/or by means of broken or dotted lines or coloring. Accordingly, the specification may include statements explaining that protection is not sought for certain features shown in the reproduction, or that protection is not sought for matter shown in a specified color in the reproduction. When protection is not sought for portions of subject matter shown in a reproduction, applicants are strongly encouraged to indicate such subject matter by means of broken lines (or coloring) and include a statement in the specification explaining the meaning of the broken lines (or coloring). See MPEP § 2920.05(c).

The specification of a nonprovisional international design application is not permitted to include statements describing matters that are directed to function or are unrelated to the design. In addition, the specification may not include statements that describe or suggest other embodiments of the claimed design which are not illustrated in the drawing disclosure, except one that is a mirror image of that shown or has a shape and appearance that would be evident from the one shown. However, such statements may be included in the design application as originally filed to provide antecedent basis for a future amendment. In addition, statements which attempt to broaden the scope of the claimed design beyond that which is shown in the drawings are not permitted.

The form paragraphs set forth in MPEP § 1503.01, subsection II, pertaining to the description may be used in nonprovisional international design applications. In addition, the following form paragraphs may be used to amend the specification by examiner's amendment to include a description of broken lines or

coloring, as appropriate:

¶ 29.22 Description of Broken Lines Added by Examiner's Amendment (International Design Application)

The following sentence has been added to the specification immediately preceding the claim:

The broken line showing of [1] is for the purpose of illustrating [2] and forms no part of the claimed design.

Examiner Note:

1. This form paragraph should only be used in an international design application in an Examiner's Amendment for explaining the meaning of the broken lines.
2. In bracket 1, insert name of structure.
3. In bracket 2, insert-portions of the "article" or environmental structure.

¶ 29.24 Description of Broken Lines as Boundary of Design Added by Examiner's Amendment (International Design Application)

The following sentence has been added to the specification immediately preceding the claim:

The [1] broken line(s) define the bounds of the claimed design and form no part thereof.

Examiner Note:

1. This form paragraph should only be used in an international design application in an Examiner's Amendment for explaining the meaning of the broken line(s).
2. In bracket 1, insert type of broken line, e.g. dashed or dot-dash or dot-dot-dash.

¶ 29.26 Description of Coloring Added by Examiner's Amendment (International Design Application)

The following sentence has been added to the specification immediately preceding the claim:

The portion of the design shown in the color [1] is for the purpose of illustrating [2] and forms no part of the claimed design.

Examiner Note:

1. This form paragraph should only be used in an international design application in an Examiner's Amendment for explaining the meaning of color used in the reproductions.
2. In bracket 1, identify the color indicating the matter excluded from the claim.

3. In bracket 2, insert - portions of the "article" - or - environmental structure.

III. CLAIM

37 CFR 1.1025 The claim.

The specific wording of the claim in an international design application designating the United States 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.

The form and content of a claim in a nonprovisional international design application is set forth in 37 CFR 1.1025.

A design patent application may only include a single claim. The specific wording of the claim must be in formal terms to the ornamental design for the article (the article which embodies the design or to which it is applied) as shown, or as shown and described. The description of the article in the claim should be consistent in terminology with the title of the invention. See MPEP § 2920.04(a), subsection I.

When the specification includes a proper descriptive statement of the design (see MPEP § 2920.04(a), subsection II), or a proper showing of modified forms of the design or other descriptive matter has been included in the specification, the words "and described" must be added to the claim following the term "shown" ; i.e., the claim must read "The ornamental design for (the article which embodies the design or to which it is applied) as shown and described." Unless the claim was amended by the applicant pursuant to 37 CFR 1.121, the examiner should not object to the claim as to matters of form but rather should amend the claim by examiner's amendment to include the words "and described."

Form paragraphs 15.62, 15.63 and 15.64 may be used in international design applications as appropriate.

¶ 15.62 Amend Claim "As Shown"

For proper form (37 CFR 1.153 or 37 CFR 1.1025), the claim [1] amended to read: "[2] claim: The ornamental design for [3] as shown."

Examiner Note:

1. In bracket 1, insert - must be - or - has been -.
2. In bracket 2, insert - I - or - We -.

3. In bracket 3, insert title of the article in which the design is embodied or applied.

¶ 15.63 Amend Claim "As Shown and Described"

For proper form (37 CFR 1.153 or 37 CFR 1.1025), the claim [1] amended to read: "[2] claim: The ornamental design for [3] as shown and described."

Examiner Note:

1. In bracket 1, insert - must be - or - has been -.
2. In bracket 2, insert - I - or - We -.
3. In bracket 3, insert title of the article in which the design is embodied or applied.

¶ 15.64 Addition of "And Described" to Claim

Because of [1] - and described - [2] added to the claim after "shown."

Examiner Note:

1. In bracket 1, insert reason.
2. In bracket 2, insert - must be - or - has been -.

2920.04(b) Reproductions (Drawings) [R-07.2015]

37 CFR 1.1026 Reproductions.

Reproductions shall comply with the requirements of Rule 9 and Part Four of the Administrative Instructions.

Every nonprovisional international design application must include a reproduction of the claimed design. A reproduction may be either a drawing or a photograph of the industrial design.

As the drawing or photograph constitutes the entire visual disclosure of the claim, it is of utmost importance that the drawing or photograph be a clear and complete depiction of the design applied to the article designated in the title, and that nothing regarding the design sought to be patented is left to conjecture.

Formal requirements for reproductions applicable to nonprovisional international design applications are set forth in Hague Agreement Rule 9 and Part Four of the Administrative Instructions. See 37 CFR 1.1026. Rule 9 and the relevant provisions of the Administrative Instructions are reproduced in MPEP § 2909.02. Notable provisions include, for example, the ability to submit reproductions in black and white or in color (Administrative Instruction 401), numbering of reproductions by

design and view number separated by a dot (Administrative Instruction 405), and the use of coloring to indicate matter shown in a reproduction for which protection is not sought (Administrative Instruction 403). Drawing requirements set forth in 37 CFR 1.84 do not apply to nonprovisional international design applications, except for those set forth in 37 CFR 1.84(c). See 37 CFR 1.1061(b).

Reproductions published as part of the international registration have been reviewed by the International Bureau for compliance with the formal requirements of Hague Agreement Rule 9 and Part Four of the Administrative Instructions and thus should not be objected to by the examiner on such grounds. See Hague Agreement Article 12(1). Amended reproductions that are submitted directly to the Office pursuant to 37 CFR 1.121 are not subject to review by the International Bureau and thus may be objected to under 37 CFR 1.1026 as to matters of form where appropriate. Form Paragraph 29.10 may be used to object to amended reproductions that fail to comply with the formal requirements of Hague Agreement Rule 9 and Part Four of the Administrative Instructions.

¶ 29.10 Reproductions Objected to, Amended Reproductions Do Not Comply With Formal Requirements

The amended reproductions received on [1] are objected to because [2]. See 37 CFR 1.1026.

Examiner Note:

1. Use this form paragraph in an international design application to object to amended reproductions that fail to comply with the formal requirements for reproductions set forth in Rule 9 of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement and Part Four of the Administrative Instructions thereunder. Do not use this form paragraph to object to reproductions that were contained in the international registration published by the International Bureau.
 2. In bracket 1, insert the date the amended reproductions were received.
 3. In bracket 2, insert the reason for the objection, for example, - the reproductions are not of a quality permitting all the details of the industrial design to be clearly distinguished - or - the reproductions contain explanatory text or legends -.
 4. Follow this form paragraph with form paragraph 15.05.04.
- When inconsistencies are found among the views, the examiner

should object to the reproductions and request that the views be made consistent. Pursuant to Hague Agreement Rule 9(4), “[a] Contracting Party may however refuse the effects of the international registration on the ground that the reproductions contained in the international registration are not sufficient to disclose fully the industrial design.” When the inconsistencies are of such magnitude that the overall appearance of the design is unclear, the claim should be rejected under 35 U.S.C. 112(a) and (b), as nonenabling and indefinite. See MPEP § 1504.04, subsection I.

¶ 29.11 Reproductions Objected to, Design Not Fully Disclosed in Reproductions

The reproductions are objected to for failing to fully disclose the industrial design because [1]. See 37 CFR 1.1026 and Rule 9 of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement.

Examiner Note:

1. Use this form paragraph in an international design application where the reproductions are not sufficient to fully disclose the industrial design, but such failure does not render the claimed invention non-enabled and/or indefinite under 35 U.S.C. 112. This may occur, for example, where there are minor inconsistencies in the illustration of the design among the different views of the design. Where the failure to fully disclose the industrial design in the reproductions renders the claimed invention non-enabled and/or indefinite under 35 U.S.C. 112, use form paragraph 15.21 or 15.22, as appropriate, instead of this form paragraph.

2. In bracket 1, explain why the reproductions are not sufficient to fully disclose the industrial design.

3. Follow this form paragraph with form paragraph 15.05.04.

The practice set forth in MPEP § 1503.02 I-IV with respect to views, surface shading, broken lines, and surface treatment is generally applicable to nonprovisional international design applications.

In addition to the use of broken or dotted lines to indicate matter shown in a reproduction for which protection is not sought, Administrative Instruction 403 permits such matter to be indicated in the description and/or by coloring. See MPEP § 2920.05(c) regarding considerations under 35 U.S.C. 112 when indicating matter pursuant to Administrative Instruction 403.

Form paragraph 29.20 may be used in an international design application as appropriate.

¶ 29.20 Matter Not Forming Part of Design (International Design Application)

Matter, such as environmental structure or portions of the "article," which is shown in a reproduction but for which protection is not sought may be indicated by statement in the description and/or by means of dotted or broken lines or coloring in the reproduction. See 37 CFR 1.1026 and Hague Agreement Administrative Instruction 403.

Examiner Note:

Use this form paragraph only in an international design application.

2920.04(c) Inventor's Oath or Declaration [R-07.2015]

37 CFR 1.1021 Contents of the international design application.

(d) Required contents where the United States is designated. In addition to the mandatory requirements set forth in paragraph(a) of this section, an international design application that designates the United States shall contain or be accompanied by:

(3) The inventor's oath or declaration (§ 1.63 and 1.64). The requirements in § 1.63(b) and 1.64(b)(4) to identify each inventor by his or her legal name, mailing address, and residence, if an inventor lives at a location which is different from the mailing address, and the requirement in § 1.64(b)(2) to identify the residence and mailing address of the person signing the substitute statement will be considered satisfied by the presentation of such information in the international design application prior to international registration.

37 CFR 1.1067 Title, description, and inventor's oath or declaration.

(b) An international design application designating the United States must include the inventor's oath or declaration. See § 1.1021(d). If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed

by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136 (see § 1.136(c)).

International design applications designating the United States are required to contain the inventor's oath or declaration (37 CFR 1.63 and 1.64). See 37 CFR 1.1021(d)(3). The International Bureau reviews international design applications designating the United States to ensure that the required inventor's oath or declaration is provided for the inventors identified in the international design application. The inventor's oath or declaration is communicated by the International Bureau to the Office when the published international registration is sent to the Office pursuant to Hague Agreement Article 10(3).

Section 1.1067(b) provides for notifying the applicant in a notice of allowability of a requirement to provide the inventor's oath or declaration. As compliance with the requirement for the inventor's oath or declaration will have been reviewed by the International Bureau, the need to notify the applicant in a notice of allowability that an inventor's oath or declaration is required should be rare, e.g., where an inventor is added pursuant to 37 CFR 1.48(a) after publication of the international registration and an executed oath or declaration from the inventor has not been received. See 37 CFR 1.48(b).

2920.05 Examination [R-07.2015]

35 U.S.C. 389 Examination of international design application.

(a) IN GENERAL.

The Director shall cause an examination to be made pursuant to this title of an international design application designating the United States.

(b) APPLICABILITY OF CHAPTER 16.

All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16.

(c) FEES.

The Director may prescribe fees for filing international design applications, for designating the United States, and for any

other processing, services, or materials relating to international design applications, and may provide for later payment of such fees, including surcharges for later submission of fees.

(d) ISSUANCE OF PATENT.

The Director may issue a patent based on an international design application designating the United States, in accordance with the provisions of this title. Such patent shall have the force and effect of a patent issued on an application filed under chapter 16.

37 CFR 1.1062 Examination.

(a) Examination.

The Office shall make an examination pursuant to title 35, United States Code, of an international design application designating the United States.

(b) Timing.

For each international design application to be examined under paragraph (a) of this section, the Office shall, subject to Rule 18(1)(c)(ii), send to the International Bureau within 12 months from the publication of the international registration under Rule 26(3) a notification of refusal (§ 1.1063) where it appears that the applicant is not entitled to a patent under the law with respect to any industrial design that is the subject of the international registration.

37 CFR 1.1063 Notification of Refusal.

(a) A notification of refusal shall contain or indicate:

(1) The number of the international registration;

(2) The grounds on which the refusal is based;

(3) A copy of a reproduction of the earlier industrial design and information concerning the earlier industrial design, where the grounds of refusal refer to similarity with an industrial design that is the subject of an earlier application or registration;

(4) Where the refusal does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate; and

(5) A time period for reply under § 1.134 and 1.136, where a reply to the notification of refusal is required.

(b) Any reply to the notification of refusal must be filed directly with the Office and not through the International Bureau. The requirements of § 1.111 shall apply to a reply to a notification of refusal.

International design applications designating the United States are examined pursuant to title 35, United States Code.

All questions of substance and, unless otherwise required by the Hague Agreement or Regulations thereunder, procedures regarding an international design application designating the United States shall be determined as in the case of design applications filed under 35 U.S.C. chapter 16. See 35 U.S.C. 389. Accordingly, the practices set forth in MPEP § 1504.01 (Statutory Subject Matter for Designs), 1504.02 (Novelty), 1504.03 (Nonobviousness), 1504.04 (Considerations Under 35 U.S.C. 112), 1505 (Restriction), and 1504.06 (Double Patenting) are generally applicable to international design applications designating the United States. While there is substantial overlap in examining practices with respect to international design applications designating the United States and design applications filed under 35 U.S.C. chapter 16, there are also differences. These differences include:

(1) the Office sends a Notification of Refusal to the International Bureau for forwarding to the holder of the international registration where it is determined that the conditions for the grant of a patent are not met in respect of any or all designs that are the subject of international registration;

(2) upon issuance of a patent, the Office sends a statement of grant of protection to the International Bureau indicating that protection is granted in the United States to those designs that are the subject of the international registration and covered by the patent.

Regulations concerning international design applications are set forth in 37 CFR Part 1, subpart I.

2920.05(a) Notification of Refusal [R-07.2015]

Hague Article 12 Refusal

(2) [Notification of Refusal]

(a) The refusal of the effects of an international registration shall be communicated by the Office to the International Bureau in a notification of refusal within the prescribed period.

(b) Any notification of refusal shall state all the grounds on which the refusal is based.

Hague Rule 18 Notification of Refusal

(1) [Period for Notification of Refusal]

(a) The prescribed period for the notification of refusal of the effects of an international registration in accordance with Article 12(2) of the 1999 Act or Article 8(1) of the 1960 Act shall be six months from the publication of the international registration as provided for by Rule 26(3).

(b) Notwithstanding subparagraph (a), any Contracting Party whose Office is an Examining Office, or whose law provides for the possibility of opposition to the grant of protection, may, in a declaration, notify the Director General that, where it is designated under the 1999 Act, the period of six months referred to in that subparagraph shall be replaced by a period of 12 months.

(c) The declaration referred to in subparagraph (b) may also state that the international registration shall produce the effect referred to in Article 14(2)(a) of the 1999 Act at the latest

(i) at a time specified in the declaration which may be later than the date referred to in that Article but which shall not be more than six months after the said date or

(ii) at a time at which protection is granted according to the law of the Contracting Party where a decision regarding the grant of protection was unintentionally not communicated within the period applicable under subparagraph(a) or (b); in such a case, the Office of the Contracting Party concerned shall notify the International Bureau accordingly and endeavor to communicate such decision to the holder of the international registration concerned promptly thereafter.

(2) [Notification of Refusal]

(a) The notification of any refusal shall relate to one international registration, shall be dated and shall be signed by the Office making the notification.

(b) The notification shall contain or indicate

(i) the Office making the notification,

(ii) the number of the international registration,

(iii) all the grounds on which the refusal is based together with a reference to the corresponding essential provisions of the law,

(iv) where the grounds on which the refusal is based refer to similarity with an industrial design which has been the subject of an earlier national, regional or international application or

registration, the filing date and number, the priority date (if any), the registration date and number (if available), a copy of a reproduction of the earlier industrial design (if that reproduction is accessible to the public) and the name and address of the owner of the said industrial design, as provided for in the Administrative Instructions,

(v) where the refusal does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate,

(vi) whether the refusal may be subject to review or appeal and, if so, the time limit, reasonable under the circumstances, for any request for review of, or appeal against, the refusal and the authority to which such request for review or appeal shall lie, with the indication, where applicable, that the request for review or the appeal has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal, and

(vii) the date on which the refusal was pronounced.

37 CFR 1.1063 Notification of Refusal.

(a) A notification of refusal shall contain or indicate:

(1) The number of the international registration;

(2) The grounds on which the refusal is based;

(3) A copy of a reproduction of the earlier industrial design and information concerning the earlier industrial design, where the grounds of refusal refer to similarity with an industrial design that is the subject of an earlier application or registration;

(4) Where the refusal does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate; and

(5) A time period for reply under § 1.134 and 1.136, where a reply to the notification of refusal is required.

(b) Any reply to the notification of refusal must be filed directly with the Office and not through the International Bureau. The requirements of § 1.111 shall apply to a reply to a notification of refusal.

Under Article 12 of the Hague Agreement, "the Office of any designated Contracting Party may, where the conditions for the grant of protection under the law of that Contracting Party are not met in respect of any or all of the industrial designs that are the subject of an international registration, refuse the

effects, in part or in whole, of the international registration in the territory of the said Contracting Party, provided that no Office may refuse the effects, in part or in whole, of any international registration on the ground that requirements relating to the form or contents of the international design application that are provided for in this Act or the Regulations or are additional to, or different from, those requirements have not been satisfied under the law of the Contracting Party concerned." This refusal of effect is called a "notification of refusal." See Article 12(2). The notification of refusal is transmitted to the International Bureau who, without delay, transmits a copy of the notification to the holder of the international registration. Hague Agreement Rule 18 prescribes a time period for sending of the notification of refusal and the content of the notification.

In accordance with 37 CFR 1.1062(b), a notification of refusal is to be sent to the International Bureau within 12 months from the publication of the international registration where it appears that the applicant is not entitled to a patent under the law of the United States with respect to any industrial design that is the subject of the international registration. The notification of refusal may be sent after this 12-month period where the failure to send the notification within the 12-month period was unintentional.

The notification of refusal contains or indicates: (1) the number of the international registration; (2) the grounds on which the refusal is based; (3) a copy of a reproduction of the earlier industrial design and information concerning the earlier industrial design, where the grounds of refusal refer to similarity with an industrial design that is the subject of an earlier application or registration; (4) where the refusal does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate; and (5) a time period for reply under 37 CFR 1.134 and 1.136 where a reply to the notification of refusal is required. See 37 CFR 1.1063(a).

The grounds of refusal may be in the form of a rejection based on a condition for patentability under title 35, United States Code (e.g., 35 U.S.C. 171, 102, 103, or 112), a requirement for restriction (where more than one independent and distinct design is presented in the application), and/or an objection (where not

prohibited by Article 12(1) of the Hague Agreement). The grounds of refusal may also be based on applicant's action, including cancellation of industrial designs in the international design application by amendment or by an express abandonment of the application pursuant to 37 CFR 1.138 prior to examination. Objections based on requirements relating to the form or content of the application provided for in the Hague Agreement and Regulations thereunder are not prohibited by Article 12(1) where the International Bureau is not responsible for verifying compliance with such requirements. Such may arise, for example, where the applicant submits amended drawings directly to the Office in the course of examination that fail to comply with the formal requirements applicable to reproductions under Hague Agreement Rule 9 and Part Four of the Administrative Instructions. Nor does Article 12(1) prohibit objections based on inconsistencies among the views of the reproductions or incorrect or inaccurate statements contained in the description. As in the case of Office actions in design applications filed under 35 U.S.C. chapter 16, copies of references cited by the examiner should be included with the notification of refusal. In addition, because Hague Agreement Rule 18(2)(b)(iv) does not distinguish references used in a ground of refusal based on where the reference originated from, the examiner should also include any U.S. patent or U.S. patent application publication used in a ground of refusal (e.g., a rejection under 35 U.S.C. 102 or 103). See 37 CFR 1.1063(a)(3). Copies of references cited by the applicant in an information disclosure statement do not need to be included with the notification of refusal. The notification of refusal should include a time period for reply under 37 CFR 1.134 and 1.136 to avoid abandonment where a reply to the notification of refusal is required. This time period will normally be made in the Office Action Summary, Form PTOL-326, accompanying a Notification of Refusal cover sheet, Form PTO-2319. Not all notifications of refusal will require a reply. For example, where the international registration contains multiple industrial designs and all but one design is cancelled by preliminary amendment prior to examination, and the remaining design is determined by the examiner to be allowable, then a notice of allowance will be sent concurrently with a notification of refusal, refusing the effects of the international registration in the United States with respect to the industrial

design or designs that have been cancelled. Such a notification of refusal, otherwise known as a "Notification of Partial Refusal," (Form PTO-2321) will be communicated to the International Bureau but will not set a time period for reply to the notification of refusal, as no reply to the refusal is required.

Any reply to the notification of refusal must be filed directly with the Office and not through the International Bureau. See 37 CFR 1.1063(b). A reply to the notification of refusal is subject to the requirements of 37 CFR 1.111.

Any further Office action following the notification of refusal, such as a Final Rejection, will normally be sent directly to the applicant.

2920.05(b) One Independent and Distinct Design [R-07.2015]

Hague Article 13 Special Requirements Concerning Unity of Design

(1) [Notification of Special Requirements] Any Contracting Party whose law, at the time it becomes party to this Act, requires that designs that are the subject of the same application conform to a requirement of unity of design, unity of production or unity of use, or belong to the same set or composition of items, or that only one independent and distinct design may be claimed in a single application, may, in a declaration, notify the Director General accordingly. However, no such declaration shall affect the right of an applicant to include two or more industrial designs in an international application in accordance with Article 5(4), even if the application designates the Contracting Party that has made the declaration.

(2) [Effect of Declaration] Any such declaration shall enable the Office of the Contracting Party that has made it to refuse the effects of the international registration pursuant to Article 12(1) pending compliance with the requirement notified by that Contracting Party.

37 CFR 1.1064 One independent and distinct design.

(a) Only one independent and distinct design may be claimed in a nonprovisional international design application.

(b) If the requirements under paragraph (a) of this section are not satisfied, the examiner shall in the notification of refusal

or other Office action require the applicant in the reply to that action to elect one independent and distinct design for which prosecution on the merits shall be restricted. Such requirement will normally be made before any action on the merits but may be made at any time before the final action. Review of any such requirement is provided under § 1.143 and 1.144.

Only one independent and distinct design may be claimed in a nonprovisional international design application. See 37 CFR 1.1064. Under Article 13 of the Hague Agreement, a Contracting Party whose law at the time it becomes party to the Hague Agreement requires, *inter alia*, that only one independent and distinct design may be claimed in a single application, can refuse the effects of the international registration on grounds of noncompliance with such requirement. U.S. law requires that only one independent and distinct design may be claimed in a single application. See *In re Rubinfeld*, 270 F.2d 391 (CCPA 1959); *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967); MPEP § 1504.05.

The practice set forth in MPEP § 1504.05 is generally applicable to nonprovisional international design applications. If more than one independent and distinct design is claimed in the nonprovisional international design application, the examiner should in the notification of refusal or other Office action require the applicant in the reply to that action to elect one independent and distinct design for which prosecution on the merits shall be restricted. The requirement should normally be made before any action on the merits but may be made at any time before the final action. Review of any such requirement is provided under 37 CFR 1.143 and 1.144.

2920.05(c) Considerations Under 35 U.S.C.112 [R-07.2015]

The requirements of 35 U.S.C. 112(a) and (b) apply to nonprovisional international design applications. See 35 U.S.C. 389. Accordingly, the practice set forth in MPEP § 1504.04 regarding considerations under 35 U.S.C. 112 is generally applicable to nonprovisional international design applications. This section addresses certain additional considerations relevant to international design applications.

As discussed in MPEP § 2920.04(b), Administrative Instruction 403 allows matter shown in a reproduction for which protection is not sought to be indicated "(i) in the description referred to in Rule 7(5)(a) and/or (ii) by means of dotted or broken lines or

coloring." When using broken or dotted lines or coloring in a reproduction to indicate matter shown in a reproduction for which protection is not sought, applicants are encouraged to include an explanation of the purpose of the broken or dotted lines or coloring in the description. This may help to avoid uncertainty as to the scope of the claimed design. Similarly, applicants are encouraged not to simply rely on a description to indicate matter shown in a reproduction for which protection is not sought, but rather to also identify the matter for which protection is not sought through the use of broken or dotted lines or coloring. The following form paragraphs may be used where the presence of undescribed broken lines or color renders the scope of the claimed design unclear.

¶ 29.21 Rejection, 35 U.S.C. 112(b) - Undescribed Broken Lines (International Design Application)

The claim is rejected for failing to particularly point out and distinctly claim the invention as required in 35 U.S.C. 112(b). The claim is indefinite because the reproductions include, infigure(s) [1], broken lines that are not described in the specification, and the scope of the claimed design cannot be determined.

If the broken line(s) represent portions of the article or environmental structure for which protection is not sought, applicant may overcome this rejection by inserting a statement similar to the following into the specification immediately preceding the claim, provided such statement does not introduce new matter (see 35 U.S.C. 132):

The broken line showing of [2] is for the purpose of illustrating [3] and forms no part of the claimed design.

Examiner Note:

1. Use this form paragraph in an international design application where the reproductions include broken lines that are not described in the specification, and the scope of the claimed design cannot be determined.
2. In bracket 1, insert the number(s) of the figure(s) containing the broken lines.
3. In bracket 2, insert name of structure.
4. In bracket 3, insert - portions of the "article" - or - environmental structure.

¶ 29.23 Rejection, 35 U.S.C. 112(b) - Undescribed Broken Lines as Boundary of Design (International Design Application)

The claim is rejected for failing to particularly point out and distinctly claim the invention as required in 35 U.S.C. 112(b). The claim is indefinite because the reproductions include, infigure(s) [1], broken lines that are not described in the specification, and the scope of the claimed design cannot be determined.

If the broken line(s) represent a boundary line for which protection is not sought, applicant may overcome this rejection by inserting a statement similar to the following into the specification immediately preceding the claim, provided such statement does not introduce new matter (see 35 U.S.C. 132):

The [2] broken line(s) define the bounds of the claimed design and form no part thereof.

Examiner Note:

1. Use this form paragraph in an international design application where the reproductions include broken lines that are not described in the specification, and the scope of the claimed design cannot be determined.
2. In bracket 1, insert the number(s) of the figure(s) containing the broken lines.
3. In bracket 2, insert type of broken line, e.g. dashed or dot-dash or dot-dot-dash.

¶ 29.25 Rejection, 35 U.S.C. 112(b) - Unclear Use of Coloring (International Design Application)

The claim is rejected for failing to particularly point out and distinctly claim the invention as required in 35 U.S.C. 112(b). The claim is indefinite because the reproductions include coloring, in figure(s) [1], that is not described in the specification, and the scope of the claimed design cannot be determined.

If the coloring identifies matter for which protection is not sought, applicant may overcome this rejection by inserting a statement similar to the following into the specification immediately preceding the claim, provided such statement does not introduce new matter (see 35 U.S.C. 132):

The portion of the design shown in the color [2] is for the purpose of illustrating [3] and forms no part of the claimed design.

Examiner Note:

1. Use this form paragraph in an international design application where the reproductions include coloring that is not described in the specification, and the scope of the claimed design cannot be determined.
2. In bracket 1, insert the number(s) of the figure(s) containing the coloring.
3. In bracket 2, identify the color indicating the matter excluded from the claim.
4. In bracket 3, insert - portions of the "article" - or - environmental structure.

Similar to the use of form paragraph 15.20.02 in design applications filed under 35 U.S.C. chapter 16, form paragraph 29.27 may be used in an international design application to suggest how a rejection under 35 U.S.C. 112(a) and (b) as nonenabling and indefinite due to an insufficient drawing disclosure may be overcome.

¶ 29.27 Suggestion To Overcome Rejection Under 35 U.S.C. 112(a) and (b) (International Design Application)

Applicant may indicate that protection is not sought for those portions of the reproductions which are considered indefinite and nonenabling in the rejection under 35 U.S.C. 112 above by amending the reproductions to color those portions or convert those portions to broken lines and by amending the specification to include a statement that the portions of the [1] shown in broken lines form no part of the claimed design or a statement that the portions of the [1] shown by coloring form no part of the claimed design provided such amendments do not introduce new matter (see 35 U.S.C. 132 , 37 CFR 1.121).

Examiner Note:

1. Use this form paragraph only in an international design application.
2. In bracket 1, insert title of the article.

2920.05(d) Foreign Priority [R-07.2015]

35 U.S.C. 386 Right of priority.

(a) NATIONAL APPLICATION.

In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172, a national application shall be entitled to the right of priority based on

a prior international design application that designated at least 1 country other than the United States.

(b) PRIOR FOREIGN APPLICATION.

In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172 and the treaty and the Regulations, an international design application designating the United States shall be entitled to the right of priority based on a prior foreign application, a prior international application as defined in section 351(c) designating at least 1 country other than the United States, or a prior international design application designating at least 1 country other than the United States.

37 CFR 1.55 Claim for foreign priority.

(a) In general.

An applicant in a nonprovisional application may claim priority to one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) and (b), and 35 U.S.C. 386(a) or (b) and this section.

(b) Time for filing subsequent application. The nonprovisional application must be:

(1) Filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, subject to paragraph (c) of this section (a subsequent application); or

(2) Entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of a subsequent application that was filed within the period set forth in paragraph (b)(1) of this section.

(c) Delayed filing of subsequent application. If the subsequent application has a filing date which is after the expiration of the period set forth in paragraph (b)(1) of this section, but within two months from the expiration of the period set forth in paragraph (b)(1) of this section, the right of priority in the subsequent application may be restored under PCT Rule 26 bis.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. A petition to restore the right of priority under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application, or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120,

121, 365(c), or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application. Any petition to restore the right of priority under this paragraph must include:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(d) Time for filing priority claim

(1) Application under 35 U.S.C. 111(a). The claim for priority must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application in an original application filed under 35 U.S.C. 111(a), except as provided in paragraph (e) of this section. The claim for priority must be presented in an application data sheet (§ 1.76(b)(6)) and must identify the foreign application to which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply if the later-filed application is:

(i) An application for a design patent; or

(ii) An application filed under 35 U.S.C. 111(a) before November 29, 2000.

(2) Application under 35 U.S.C. 371. The claim for priority must be made within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371, except as provided in paragraph (e) of this section.

(e) Delayed priority claim. Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 35 U.S.C. 386(a) or (b) not presented in the manner required by paragraph (d) or (m) of this section during pendency

and within the time period provided by paragraph (d) of this section (if applicable) is considered to have been waived. If a claim for priority is considered to have been waived under this section, the claim may be accepted if the priority claim was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a)-(d) or (f), 365(a) or (b), or 386(a) or (b) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or (b) in an application datasheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A certified copy of the foreign application, unless previously submitted or an exception in paragraph (h), (i), or (j) of this section applies;

(3) The petition fee as set forth in § 1.17(m); and

(4) A statement that the entire delay between the date the priority claim was due under this section and the date the priority claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(f) Time for filing certified copy of foreign application

(1) Application under 35 U.S.C. 111(a). A certified copy of the foreign application must be filed within the later of four months from the actual filing date of the application, or sixteen months from the filing date of the prior foreign application, in an original application under 35 U.S.C. 111(a) filed on or after March 16, 2013, except as provided in paragraphs (h), (i), and (j) of this section. The time period in this paragraph does not apply in a design application.

(2) Application under 35 U.S.C. 371. A certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371. If a certified copy of the foreign application is not filed during the international stage in an international application in which the national stage commenced on or after December 18, 2013, a certified copy of the foreign application must be filed within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four

months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior foreign application, except as provided in paragraphs (h), (i), and (j) of this section.

(3) If a certified copy of the foreign application is not filed within the time period specified [in] paragraph (f)(1) of this section in an application under 35 U.S.C. 111(a) or within the period specified in paragraph (f)(2) of this section in an international application entering the national stage under 35 U.S.C. 371, and an exception in paragraph (h), (i), or (j) of this section is not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g).

(g) Requirement for filing priority claim, certified copy of foreign application, and translation in any application.

(1) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application, unless filed with a petition under paragraph (e) or (f) of this section, or with a petition accompanied by the fee set forth in § 1.17(g) which includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application in a design application. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in this section:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When deemed necessary by the examiner.

(3) An English language translation of a non-English language foreign application is not required except:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this

chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When specifically required by the examiner.

(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

(h) Certified copy in another U.S. patent or application.

The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will be considered satisfied in a reissue application if the patent for which reissue is sought satisfies the requirement of this section for a certified copy of the foreign application and such patent is identified as containing a certified copy of the foreign application. The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will also be considered satisfied in an application if a prior-filed nonprovisional application for which a benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) contains a certified copy of the foreign application and such prior-filed nonprovisional application is identified as containing a certified copy of the foreign application.

(i) Foreign intellectual property office participating in a priority document exchange agreement. The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) The foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy;

(2) The claim for priority is presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and the applicant provides the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign

application;

(3) The copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign application is filed, within the period specified in paragraph (g)(1) of this section; and

(4) The applicant files in a separate document a request that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy where, although the foreign application was not filed in a participating foreign intellectual property office, a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy. The request must identify the participating intellectual property office and the subsequent application by the application number, day, month, and year of its filing in which a copy of the foreign application was filed. The request must be filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), or four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or the request must be accompanied by a petition under paragraph (e) or (f) of this section.

(j) Interim copy. The requirement in paragraph (f) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) A copy of the original foreign application clearly labeled as "Interim Copy," including the specification, and any drawings or claims upon which it is based, is filed in the Office together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority);

(2) The copy of the foreign application and separate cover sheet are filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months

from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or with a petition under paragraph(e) or (f) of this section; and

(3) A certified copy of the foreign application is filed within the period specified in paragraph (g) (1) of this section.

(k) Requirements for certain applications filed on or after March 16, 2013. If a nonprovisional application filed on or after March 16, 2013, other than a nonprovisional international design application, claims priority to a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(l) Inventor's certificates. An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant, when submitting a claim for such right as specified in this section, must include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's

certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

(m) Time for filing priority claim and certified copy of foreign application in an international design application designating the United States. In an international design application designating the United States, the claim for priority may be made in accordance with the Hague Agreement and the Hague Agreement Regulations. In a nonprovisional international design application, the priority claim, unless made in accordance with the Hague Agreement and the Hague Agreement Regulations, must be presented in an application data sheet (§1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. In a nonprovisional international design application, the priority claim and certified copy must be furnished in accordance with the time period and other conditions set forth in paragraph (g) of this section.

(n) Applications filed before September 16, 2012. Notwithstanding the requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section that any priority claim be presented in an application data sheet (§ 1.76), this requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section will be satisfied by the presentation of such priority claim in the oath or declaration under § 1.63 in a nonprovisional application filed under 35 U.S.C. 111(a) before September 16, 2012, or resulting from an international application filed under 35 U.S.C. 363 before September 16, 2012. The provisions of this paragraph do not apply to any priority claim submitted for a petition under paragraph (c) of this section to restore the right of priority to a foreign application.

(o) Priority under 35 U.S.C. 386(a) or (b). The right of priority under 35 U.S.C. 386(a) or (b) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

(p) Time periods in this section. The time periods set forth in this section are not extendable, but are subject to 35 U.S.C. 21(b) (and § 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4).

Pursuant to 35 U.S.C. 386(a) and 37 CFR 1.55, a nonprovisional application may make a claim of foreign priority in accordance with the conditions and requirements of 35 U.S.C. 119(a)-(d) and 172 with respect to a prior international design application that designates at least one country other than the United States. Pursuant to 35 U.S.C. 386(b) and 37 CFR 1.55, an international design application designating the United States may make a claim of foreign priority in accordance with the conditions and requirements of 35 U.S.C. 119(a)-(d) and 172 and the Hague Agreement and Regulations thereunder with respect to a prior foreign application, international application (PCT) designating at least one country other than the United States, or a prior international design application designating at least one country other than the United States. The provisions of 35 U.S.C. 386(a) and (b) apply to nonprovisional applications, international applications (PCT) and international design applications filed on or after May 13, 2015, and patents issued therefrom. See 37 CFR 1.55(o) and MPEP § 213 et seq. and 1504.10.

In an international design application designating the United States, the claim for priority may be made in accordance with the Hague Agreement and the Hague Agreement Regulations. See 37 CFR 1.55(m). Alternatively, in a nonprovisional international design application, the foreign priority claim may be presented in an application data sheet (37 CFR 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The priority claim and certified copy must be furnished in accordance with the time period and other conditions set forth in 37 CFR 1.55(g).

Pursuant to 35 U.S.C. 119(a) and 172, and 37 CFR 1.55(b)(1), the nonprovisional international design application must be filed not later than six months after the date on which the foreign application was filed, or be entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of an application that was filed within this six month period. Where a nonprovisional international design application directly claims priority to a foreign application, the six month period is measured with respect to the U.S. filing date of the international design application, which may or may not be the same as the international filing date assigned by the International Bureau.

See MPEP § 2906-2908. Where there was a delay in filing the subsequent application within this six month period, the right of priority may be restored under the conditions set forth in 37 CFR 1.55(c) and MPEP § 213.03, subsection III.

2920.05(e) Benefit Claims Under 35 U.S.C.386(c) [R-07.2015]

35 U.S.C. 386 Right of priority.

(c) PRIOR NATIONAL APPLICATION.

In accordance with the conditions and requirements of section 120, an international design application designating the United States shall be entitled to the benefit of the filing date of a prior national application, a prior international application as defined in section 351(c) designating the United States, or a prior international design application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international design application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application as defined in section 351(c) which designated but did not originate in the United States or a prior international design application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.

37 CFR 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application. An applicant in a nonprovisional application, other than for a design patent, or an international application designating the United States may claim the benefit of one or more prior-filed provisional applications under the conditions set forth in 35 U.S.C. 119(e) and this section.

(d) Claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application. An applicant in a nonprovisional application (including a nonprovisional application resulting from an international application or international design application), an

international application designating the United States, or an international design application designating the United States may claim the benefit of one or more prior-filed copending nonprovisional applications, international applications designating the United States, or international design applications designating the United States under the conditions set forth in 35 U.S.C. 120, 121, 365(c), or 386(c) and this section.

(1) Each prior-filed application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, each prior-filed application must either be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States;

(ii) An international design application entitled to a filing date in accordance with § 1.1023 and designating the United States; or

(iii) A nonprovisional application under 35 U.S.C. 111(a) that is entitled to a filing date as set forth in § 1.53(b) or(d) for which the basic filing fee set forth in § 1.16 has been paid within the pendency of the application.

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application, international application designating the United States, or international design application designating the United States that claims the benefit of one or more prior-filed nonprovisional applications, international applications designating the United States, or international design applications designating the United States must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number), international application number and international filing date, or international registration number and filing date under § 1.1023. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application, international application, or international design

application.

(3)

(i) The reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section must be submitted during the pendency of the later-filed application.

(ii) If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(C) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) Except as provided in paragraph (e) of this section, failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the prior-filed application.

(4) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(5) Cross-references to other related applications may be made when appropriate (see § 1.14), but cross-references to applications for which a benefit is not claimed under title 35, United States Code, must not be included in an application data sheet (§ 1.76(b)(5)).

(6) If a nonprovisional application filed on or after March 16, 2013, other than a nonprovisional international design application, claims the benefit of the filing date of a nonprovisional application or an international application designating the United States filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the later-filed application. An applicant is not required to provide such a statement if either:

(i) The application claims the benefit of a nonprovisional application in which a statement under § 1.55(k), paragraph (a)(6) of this section, or this paragraph that the application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013 has been filed; or

(ii) The applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the later filed application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(7) Where benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) to an international application or an international design application which designates but did not originate in the United States, the Office may require a certified copy of such application together with an English translation thereof if filed in another language.

(e) Delayed claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application. If the reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section is presented after the time period provided by paragraph (d)(3) of this section, the claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed copending

nonprovisional application, international application designating the United States, or international design application designating the United States may be accepted if the reference required by paragraph (d)(2) of this section was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed application must be accompanied by:

(1) The reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section to the prior-filed application, unless previously submitted;

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (d)(3) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(j) Benefit under 35 U.S.C. 386(c). Benefit under 35 U.S.C. 386(c) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

(k) Time periods in this section. The time periods set forth in this section are not extendable, but are subject to 35 U.S.C. 21 (b) (and § 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4). Pursuant to 35 U.S.C. 386(c), in accordance with the conditions and requirements of 35 U.S.C. 120, an international design application designating the United States is entitled to claim the benefit of the filing date of a prior nonprovisional application, international application (PCT) designating the United States, or international design application designating the United States, and a nonprovisional application is entitled to the benefit of a prior international design application designating the United States. See MPEP § 211 and 1504.20.

An international design application designating the United States may not claim benefit to a provisional application. See 37 CFR 1.78(a).

An application claiming benefit under 35 U.S.C. 386(c) to an international design application designating the United States may identify the international design application by the U.S. application number or by the international registration number

and U.S. filing date under 37 CFR 1.1023. See 37 CFR 1.78(d)(2). To obtain benefit of the filing date of a prior international design application designating the United States, the international design application must be entitled to a filing date in accordance with 37 CFR 1.1023. See 37 CFR 1.78(d)(1)(ii). When a later-filed international design application designating the United States is claiming the benefit of a prior-filed application under 35 U.S.C. 120, 121, 365(c), or 386(c), the later-filed application must be copending with the prior application or with an intermediate application similarly entitled to the benefit of the filing date of the prior application.

In determining whether an international design application designating the United States is copending with a prior-filed application, it is the U.S. filing date of the international design application that is relevant, which may or may not be the same as the international filing date assigned by the International Bureau. See MPEP § 2906-2908. Thus, if the international design application designating the United States has an international filing date before, but a U.S. filing date after, the date of abandonment of the prior-filed application, the benefit claim should be refused because the international design application designating the United States does not comply with the copendency requirement of 35 U.S.C. 120.

For purposes of determining the effective filing date under AIA 35 U.S.C. 100(i)(1)(B) with regard to a benefit claim under 35 U.S.C. 386(c) to a prior-filed international design application designating the United States, the U.S. filing date of the international design application rather than the international filing date, if different, should be used.

2920.05(f) Information Disclosure Statement in an International Design Application Designating the United States [R-07.2015]

An extensive discussion of Information Disclosure Statement (IDS) practice is set forth in MPEP § 609. Although not specifically stated therein, the duty to disclose information material to patentability as defined in 37 CFR 1.56 is placed on individuals associated with the filing and prosecution of an international design application designating the United States in the same manner as for a domestic national application. An international design application designating the United States has the effect

of a U.S. patent application and thus is subject to 37 CFR 1.56. See 35 U.S.C. 385 ("An international design application designating the United States shall have the effect, for all purposes, from its filing date determined in accordance with section 384, of an application for patent filed in the Patent and Trademark Office pursuant to chapter 16."). See also 35 U.S.C. 389(b) ("All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16.").

Pursuant to 37 CFR 1.56(c), individuals associated with the filing or prosecution of a patent application for purposes of 37 CFR 1.56 are: "(1) Each inventor named in the application; (2) Each attorney or agent who prepares or prosecutes the application; and (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, the applicant, an assignee, or anyone to whom there is an obligation to assign the application." For example, individuals who are neither inventors nor practitioners but who are substantively involved in the preparation or prosecution of an international design application designating the United States and who are associated with the inventor, the applicant, an assignee, or anyone to whom there is an obligation to assign the application, have a duty of disclosure under 37 CFR 1.56. In addition, the requirement under 37 CFR 1.63(c) and 1.64(c) that a person may not execute the inventor's oath or declaration for an application unless that person is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 is applicable to the inventor's oath or declaration filed in an international design application designating the United States. See 37 CFR 1.1021(d).

Applicant must adhere to the requirements set forth in 37 CFR 1.97 and 1.98 to ensure consideration of an IDS by the examiner. When filing an international design application, an applicant may submit an IDS as an annex to the international design application. See MPEP § 2909.03.

The International Bureau will send the annex to the USPTO when the published international registration is sent to the Office pursuant to Hague Agreement Article 10(3). However, the Office

would prefer to receive the IDS from the applicant after publication of the international registration. Pursuant to 37 CFR 1.97(b)(5), the IDS will be considered by the Office if filed by the applicant within three months of the date of publication of the international registration under Hague Agreement Article 10(3). The Office may also consider an IDS filed after this three month period as provided in 37 CFR 1.97. See MPEP § 609 for further information.

2920.06 Allowance [R-07.2015]

A Notice of Allowability For a Design Application (form PTOL-37D) is used whenever a nonprovisional international design application has been placed in condition for allowance. See MPEP § 1302.03 for further information concerning the Notice of Allowability.

In addition, a Notice of Allowance (form PTOL-85 (Hague)) is sent to the applicant requiring payment of the issue fee (i.e., second part of the U.S. designation fee). See 37 CFR 1.311 and 1.18(b). The Notice of Allowance and the Notice of Allowability are communicated to the applicant at the correspondence address of record in the application.

The International Bureau is also notified of the communication of the Notice of Allowance to the applicant.

Since the Notice of Allowability is used whenever an application has been placed in a condition for allowance, the Notice of Allowability does not constitute a refusal of the effects of the international registration. However, a Notification of Partial Refusal (form PTO-2321) may be sent to the International Bureau concurrent with the sending of the Notice of Allowance to the applicant where all the designs contained in the international registration have not been allowed and were not previously the subject of a notification of refusal (e.g., all designs but the allowed design were removed by preliminary amendment prior to examination). See MPEP § 2920.05(a).

The issue fee specified in the Notice of Allowance form PTOL-85 (Hague) may be paid directly to the Office or through the International Bureau. An issue fee paid through the International Bureau shall be in the amount specified on the website of WIPO, currently available at www.wipo.int/hague, at the time the fee is paid. See 37 CFR 1.18(b)(3). The International Bureau accepts payment only in Swiss currency (see Hague Agreement Rule 28(1))

and all fee amounts specified on the WIPO website are in Swiss currency). Further, any change in entity status from that shown in the Notice of Allowance must be communicated directly to the Office in accordance with U.S. rules, as instructed in the Notice of Allowance.

2921-2929 [Reserved]

**2930 Corrections and Other Changes in the International Register
[R-07.2015]**

Hague Rule 22 Corrections in the International Register

(1) [Correction] Where the International Bureau, acting ex officio or at the request of the holder, considers that there is an error concerning an international registration in the International Register, it shall modify the Register and inform the holder accordingly.

(2) [Refusal of Effects of Correction] The Office of any designated Contracting Party shall have the right to declare in a notification to the International Bureau that it refuses to recognize the effects of the correction. Rules 18 to 19 shall apply mutatis mutandis.

Hague Article 16 Recording of Changes and Other Matters Concerning

International Registrations

(1) [Recording of Changes and Other Matters] The International Bureau shall, as prescribed, record in the International Register (i) any change in ownership of the international registration, in respect of any or all of the designated Contracting Parties and in respect of any or all of the industrial designs that are the subject of the international registration, provided that the new owner is entitled to file an international application under Article 3,

(ii) any change in the name or address of the holder,

(iii) the appointment of a representative of the applicant or holder and any other relevant fact concerning such representative,

(iv) any renunciation, by the holder, of the international registration, in respect of any or all of the designated Contracting Parties,

(v) any limitation, by the holder, of the international registration, in respect of any or all of the designated Contracting Parties, to one or some of the industrial designs that are the subject of the international registration,

(vi) any invalidation, by the competent authorities of a designated Contracting Party, of the effects, in the territory of that Contracting Party, of the international registration in respect of any or all of the industrial designs that are the subject of the international registration,

(vii) any other relevant fact, identified in the Regulations, concerning the rights in any or all of the industrial designs

that are the subject of the international registration.

(2) [Effect of Recording in International Register] Any recording referred to in items (i), (ii), (iv), (v), (vi) and (vii) of paragraph (1) shall have the same effect as if it had been made in the Register of the Office of each of the Contracting Parties concerned, except that a Contracting Party may, in a declaration, notify the Director General that a recording referred to in item (i) of paragraph (1) shall not have that effect in that Contracting Party until the Office of that Contracting Party has received the statements or documents specified in that declaration.

37 CFR 1.1065 Corrections and other changes in the International Register.

(a) The effects of any correction in the International Register by the International Bureau pursuant to Rule 22 in a pending nonprovisional international design application shall be decided by the Office in accordance with the merits of each situation, subject to such other requirements as may be imposed.

A patent issuing from an international design application may only be corrected in accordance with the provisions of title 35, United States Code, for correcting patents. Any correction under Rule 22 recorded by the International Bureau with respect to an abandoned nonprovisional international design application will generally not be acted upon by the Office and shall not be given effect unless otherwise indicated by the Office.

(b) A recording of a partial change in ownership in the International Register pursuant to Rule 21(7) concerning a transfer of less than all designs shall not have effect in the United States.

Hague Agreement Rule 22 provides for correction of errors in the International Register by the International Bureau, acting ex officio, or at the request of the holder. Under Rule 22(2), a designated Contracting Party may refuse the effects of correction. Upon receipt of a correction under Rule 22 in a pending application, the Office will make a determination whether to give effect to the correction or to refuse the correction in accordance with the merits of each situation, subject to such other requirements as may be imposed. Corrections under Rule 22 received in abandoned applications will generally not be acted upon by the Office and will not be given effect unless otherwise indicated by the Office. U.S. patents, including U.S. patents

issuing from international design applications, may only be corrected in accordance with the provisions of title 35, United States Code, for correcting patents. Such provisions are contained, for example, in 35 U.S.C. chapter 25. See, e.g., MPEP § 1401 et seq., 1480 and 1481.

Article 16(1) provides for the recording of certain changes in the International Register by the International Bureau. Pursuant to Article 16(2), a Contracting Party may, in a declaration, notify the International Bureau that a recording of a change in ownership of the international registration shall not have that effect in that Contracting Party until the Office of that Contracting Party has received the statements or documents specified in that declaration. The United States has made a declaration under Article 16(2). See MPEP § 2903. In addition, the recording of a partial change in ownership by the International Bureau in the International Register concerning a transfer of less than all designs shall not have effect in the United States. See 37 CFR 1.1065(b). Section 1.1065(b) does not limit the right of the owner to assign or otherwise transfer a portion of his or her interest in the application, or to record such transfer in the Office, but rather simply provides that the recording of such a transfer in the International Register will not have effect in the United States.

2931-2939 [Reserved]

2940 Statement of Grant of Protection [R-07.2015]

Hague Rule 18 bis Statement of Grant of Protection

(1) [Statement of Grant of Protection Where No Notification of Refusal Has Been Communicated]

(a) An Office which has not communicated a notification of refusal may, within the period applicable under Rule 18(1)(a) or (b), send to the International Bureau a statement to the effect that protection is granted to the industrial designs, or some of the industrial designs, as the case may be, that are the subject of the international registration in the Contracting Party concerned, it being understood that, where Rule 12(3) applies, the grant of protection will be subject to the payment of the second part of the individual designation fee.

(b) The statement shall indicate

(i) the Office making the statement,

(ii) the number of the international registration,

(iii) where the statement does not relate to all the industrial designs that are the subject of the international registration, those to which it relates,

(iv) the date on which the international registration produced or shall produce the effect as a grant of protection under the applicable law, and

(v) the date of the statement.

(c) Where the international registration was amended in a procedure before the Office, the statement shall also contain or indicate all amendments.

(d) Notwithstanding subparagraph (a), where Rule 18(1)(c)(i) or (ii) applies, as the case may be, or where protection is granted to the industrial designs following amendments in a procedure before the Office, the said Office must send to the International Bureau the statement referred to in subparagraph (a).

(e) The applicable period referred to in subparagraph(a) shall be the period allowed pursuant to Rule 18(1)(c)(i) or(ii), as the case may be, to produce the effect as a grant of protection under the applicable law, with respect to a designation of a Contracting Party having made a declaration under either of the aforementioned Rules.

(2) [Statement of Grant of Protection Following a Refusal]

(a) An Office which has communicated a notification of refusal and which has decided to either partially or totally withdraw such refusal, may, instead of notifying a withdrawal of refusal

in accordance with Rule 18(4)(a), send to the International Bureau a statement to the effect that protection is granted to the industrial designs, or some of the industrial designs, as the case may be, that are the subject of the international registration in the Contracting Party concerned, it being understood that, where Rule 12(3) applies, the grant of protection will be subject to the payment of the second part of the individual designation fee.

(b) The statement shall indicate

(i) the Office making the notification,

(ii) the number of the international registration,

(iii) where the statement does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate,

(iv) the date on which the international registration produced the effect as a grant of protection under the applicable law, and

(v) the date of the statement.

(c) Where the international registration was amended in a procedure before the Office, the statement shall also contain or indicate all amendments.

(3) [Recording, Information to the Holder and Transmittal of Copies] The International Bureau shall record any statement received under this Rule in the International Register, inform the holder accordingly and, where the statement was communicated, or can be reproduced, in the form of a specific document, transmit a copy of that document to the holder.

37 CFR 1.1068 Statement of grant of protection.

Upon issuance of a patent on an international design application designating the United States, the Office may send to the International Bureau a statement to the effect that protection is granted in the United States to those industrial design or designs that are the subject of the international registration and covered by the patent.

Upon issuance of a patent on a nonprovisional international design application, the Office will send to the International Bureau a statement that protection is granted in the United States to the industrial design or designs that are the subject of the international registration and covered by the patent. See 37 CFR 1.1068. The sending of such a statement is provided for under Hague Agreement Rule 18 bis and serves the purpose of providing notice to the public and third parties through publication of the

statement by the International Bureau in the International Designs Bulletin that protection for an industrial design has been granted in the United States.

2941-2949 [Reserved]

2950 Grant of Protection Only Upon Issuance of Patent; Term of Design Patent [R-07.2015]

35 U.S.C. 389 Examination of international design application.

(a) IN GENERAL.

The Director shall cause an examination to be made pursuant to this title of an international design application designating the United States.

(b) APPLICABILITY OF CHAPTER 16.

All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16.

(c) FEES.

The Director may prescribe fees for filing international design applications, for designating the United States, and for any other processing, services, or materials relating to international design applications, and may provide for later payment of such fees, including surcharges for later submission of fees.

(d) ISSUANCE OF PATENT.

The Director may issue a patent based on an international design application designating the United States, in accordance with the provisions of this title. Such patent shall have the force and effect of a patent issued on an application filed under chapter 16.

35 U.S.C. 173 Term of design patent.

Patents for designs shall be granted for the term of 15 years from the date of grant.

37 CFR 1.1071 Grant of protection for an industrial design only upon issuance of a patent.

A grant of protection for an industrial design that is the subject of an international registration shall only arise in the United States through the issuance of a patent pursuant to 35 U.S.C. 389(d) or 171, and in accordance with 35 U.S.C. 153.

37 CFR 1.1031 International design application fees.

(e) Payment of the fees referred to in Article 17 and Rule 24 for renewing an international registration ("renewal fees") is not required to maintain a U.S. patent issuing on an international design application in force.

A grant of protection for an industrial design that is the subject of an international registration shall only arise in the United States through the issuance of a patent pursuant to 35 U.S.C. 389(d) or 171, and in accordance with 35 U.S.C. 153. See 37 CFR 1.1071. The Office does not regard the failure to send a notification of refusal within the period referenced in 37 CFR 1.1062(b) to confer patent rights or other effect under Article 14(2). The Hague Agreement is not self-executing, and title I of the Patent Law Treaties Implementation Act of 2012 (PLTIA) provides for patent rights only upon issuance of a patent. See 35 U.S.C. 389(d) added by the PLTIA, 126 Stat. at 1531; see also S. Exec. Rep. No. 110-7, at 5 ("The proposed Act makes no substantive changes in U.S. design patent law with the exception of the following: the provision of limited rights to patent applicants between the date that their international design application is published by the IB and the date on which they are granted a U.S. patent based on that application; the extension of a patent term for designs from fourteen to fifteen years from grant; and allowing the USPTO to use a published international design registration as a basis for rejecting a subsequently filed national patent application that is directed at the same or a similar subject matter.").

U.S. patents issued from international design applications shall be effective for a term of fifteen years from the date of grant. Payment of the fees referred to in Article 17 and Rule 24 for renewing an international registration ("renewal fees") is not required to maintain in force a U.S. patent issuing on an international design application. See 37 CFR 1.1031(e).