



# “Examination of Hague Applications”

TC 2900

FY 2022-Q4

# Note

*The materials used in this training have been updated since the original delivery, but the teaching points and analysis remain the same.*

# Learning outcomes

By the end of this training, the participant will be able to:

- Recognize why we have a Hague agreement, e.g., how it benefits applicants.
- Describe how a Hague application flows.
- Distinguish between direct and indirect Hague applications.
- Recognize an application as being a Hague application.
- Understand the key differences between a Hague application and a regular design application.
- Determine effective filing date for a Hague application.
- Define/use new terms related to Hague applications.
- Learn where to go for assistance with a Hague application.



# Part-A Training – Content page

## Section 1. Hague

- An Introduction
- Roles in the Hague Process

# Part-A training – content page (cont.)

## Section 2. Hague Applications

- Timeliness Goal
- MPEP
- Administrative Instructions
- Refusals
- Reproductions
- Figure Numbering
- Figure Description
- [No] CPA in Hague
- International Transmissions

# Hague- an introduction

# Hague agreement

- The **Hague Agreement** provides a mechanism for registering up to 100 industrial designs in multiple member countries and intergovernmental organizations by means of a single application, filed in one language, with one set of fees.
- These member countries and intergovernmental organizations are referred to as the “Contracting Parties.”
- The system is administered by WIPO.

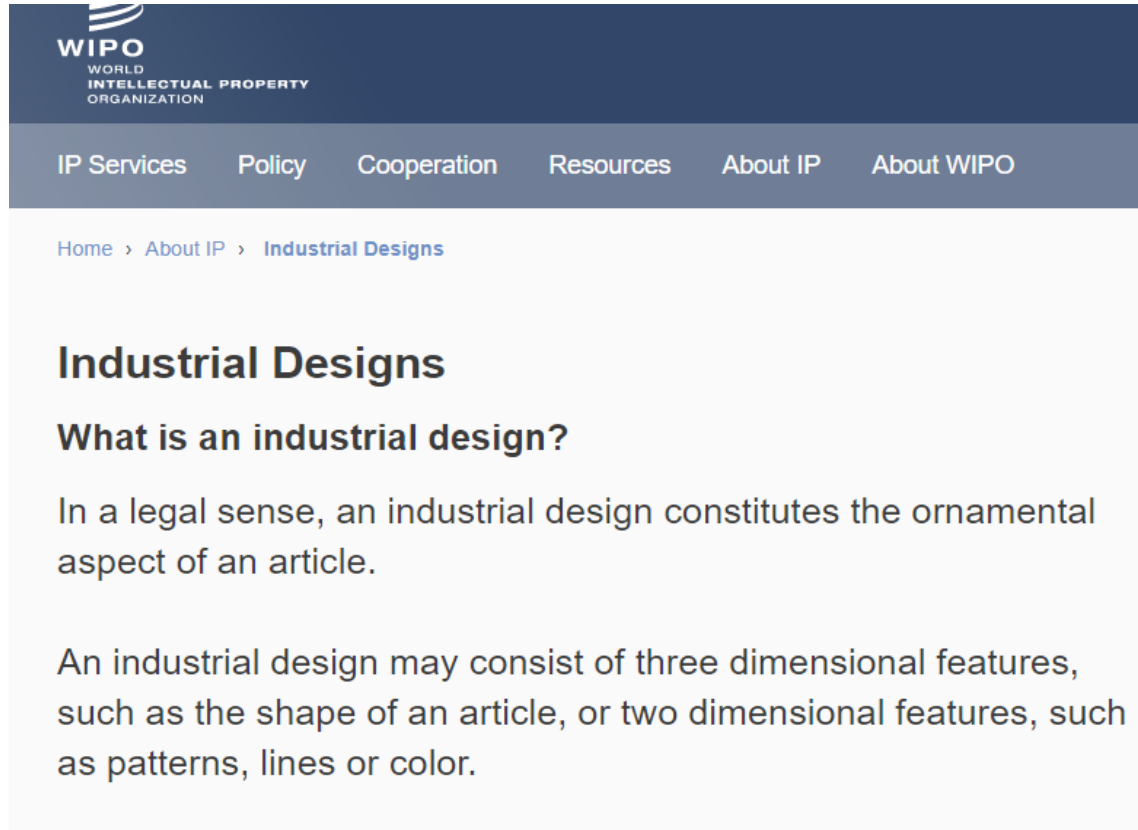
# History of the Hague agreement

- On May 13, 2015, the United States officially became a Contracting Party to the Geneva Act of the Hague Agreement.
- **Geneva Act (1999)**
  - Offices have up to 12 months to refuse protection.
  - Entered in force on December 23, 2003.
  - Took effect with respect to the United States on May 13, 2015.

*MPEP 2901*



# Industrial design



The screenshot shows the WIPO website header with the logo and navigation menu. The main content area features a breadcrumb trail, a title, and two paragraphs of text.

WIPO  
WORLD  
INTELLECTUAL PROPERTY  
ORGANIZATION

IP Services Policy Cooperation Resources About IP About WIPO

Home › About IP › [Industrial Designs](#)

## Industrial Designs

### What is an industrial design?

In a legal sense, an industrial design constitutes the ornamental aspect of an article.

An industrial design may consist of three dimensional features, such as the shape of an article, or two dimensional features, such as patterns, lines or color.

# Industrial designs – examples



## Designing for business success

A top manager at Procter and Gamble talks to WIPO Magazine about the role of industrial design in a successful product range.



## Design and disability

Design which takes account of users with disabilities often results in better overall designs.

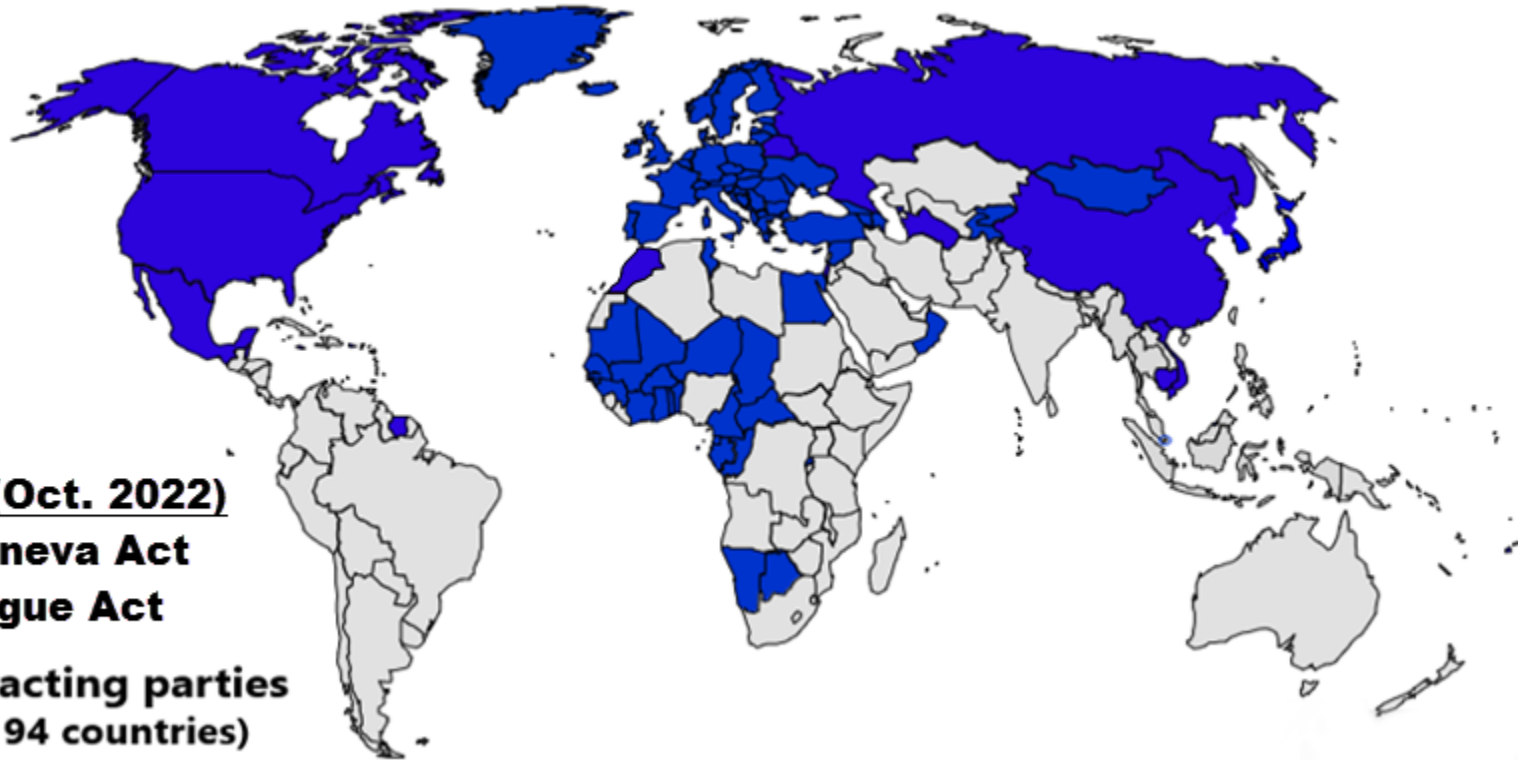


## Design law and fashion

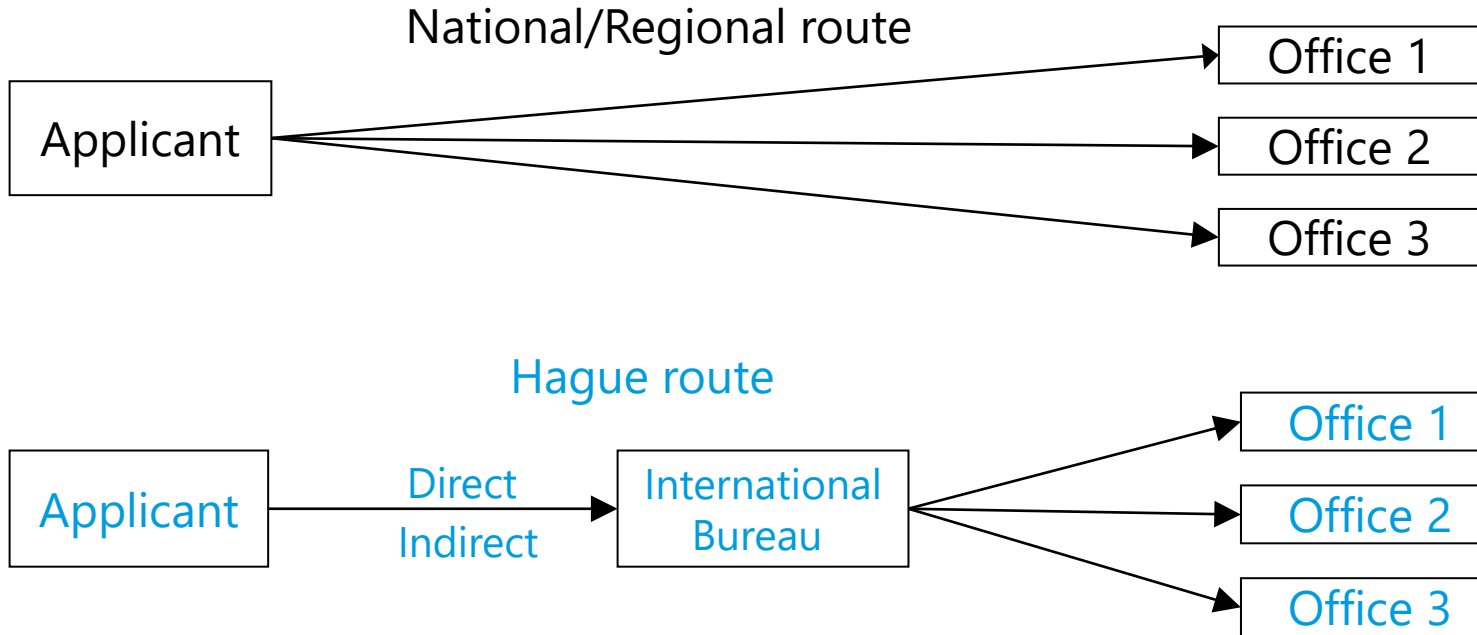
Industrial design law is at the heart of the European fashion industry.

<https://www.wipo.int/designs/en/>

# Hague union

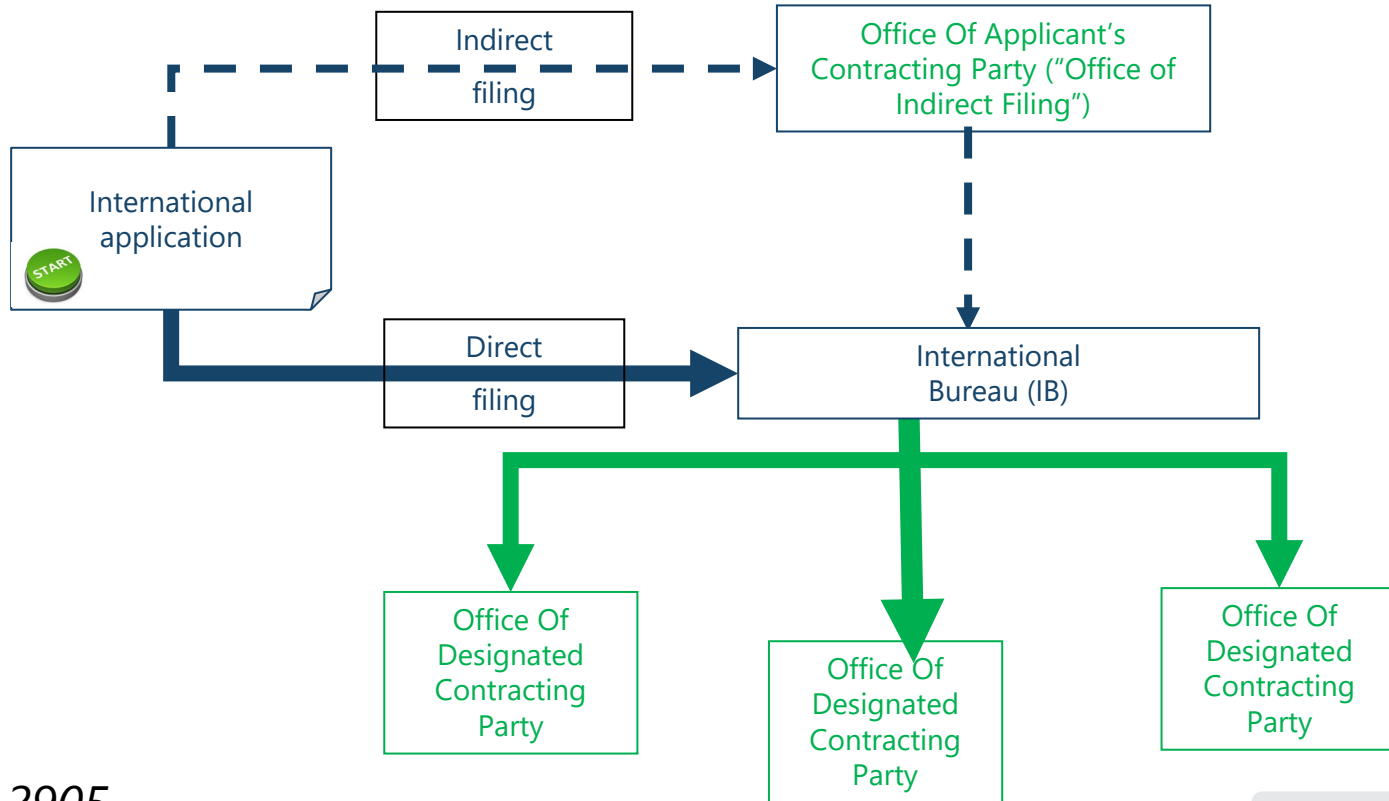


# Filings: National vs. Hague



MPEP 2905

# Hague system procedure



MPEP 2905



# Roles in the Hague process

Three main actors:

- ✓ International Bureau (IB) / WIPO
- ✓ Office of a Designated Contracting Party (CP)
- ✓ Office of Indirect Filing (OIF)

*MPEP 2905*

# Roles in the Hague process (*cont.*)

## International Bureau (IB)

- Office of direct filing
- Examines all applications for compliance with treaty requirements (**formal requirements**).
- Registers designs in the International Register.
- Publishes registrations in the International Design Bulletin.
- Communicates published registrations to designated CPs.
- Transmits refusals by designated CPs to holders.
- Processes renewals of registrations.
- Records changes and corrections in the International Register.

*MPEP 2901(II)(B) & (C)*

# Roles in the Hague process (*cont.*)

## Office of a Designated Contracting Party

- Conducts substantive examination to the extent required under its national/regional law.
- Some Contracting Parties (CPs) will republish
  - USPTO will be issuing a design patent that gives effect to the design rights (republishing).

*MPEP 2901(II)(D)*



# Roles in the Hague process (cont.)

## Office of Indirect Filing (OIF)

- Many Contracting Parties do not provide for filing through their offices.
- Performs a nominal review of the international design application (IDA). The IDA is an application for international registration of a design filed under the Hague Agreement.
  - Checks that the applicant is entitled to file through its office.
  - May conduct a national security review
  - May require payment of a transmittal fee
- USPTO as an OIF conducts a national security review and requires payment of a transmittal fee.

MPEP 2905, 37 CFR 1.9(n)

# Overview of Hague applications

# Hague – A patent examiner's perspective

## HAGUE BASICS

- In the U.S., Hague applications are 35/ series cases.
- For example:
  - 35/5xx,xxx (Direct filing)
  - 35/0xx,xxx (Indirect filing)
- They are 'Special New' cases in PE2E.
- They are **time sensitive**.

# Hague applications – the difference

## HAGUE BASICS

- Hague international applications are published unlike 29/ series design applications.
- The filing process is different when compared with 29/ series design applications.
- Substantive examination procedures remain the same.
- Enforcement will stay the same.

*MPEP 2901(II)(C)*

# Some basic principles effects of international registration

## Geneva Act (1999), Article 14(2)

The international registration has the **effect of a grant of protection** in a designated Contracting Party, if not timely refused, or the refusal is withdrawn.

- The USPTO has **12 months** from publication to send a notification of refusal (37 CFR 1.1062(b)).
  - The refusal may be sent after this 12-month period where the refusal was unintentionally not communicated within this 12-month period.

*MPEP 2901(II)(D)*

# TC timeliness goal

HAGUE TIMELINESS

11 months to mail first action from the  
date of the International Registration  
Publication Date.

# TC timeliness goal basics

Looking up “International Registration Publication Date.”

In DAV:

Hague	
International Registration Number...	DM/ [redacted]
International Registration Publica...	09/21/2018
International Registration Date	08/08/2018
International Filing Date	08/08/2018

In PALM:

Secrecy Order: NO  
Status Date: 10/15/2018  
Lost Case: NO  
International Registration Publication Date: 09/21/20

The IR Pub date is also listed on the HAGUE.IR\_PUB sheet in DAV.

WIPO International Registration Publication Data

\*\*\* Note : All dates are in YYYYMMDD format \*\*\*

Bulletin No. 37/2018

International Registration No.	International Registration Date	International Filing Date	Int. Reg. Publication Date
DM/ [redacted]	20180705	20180705	20180921



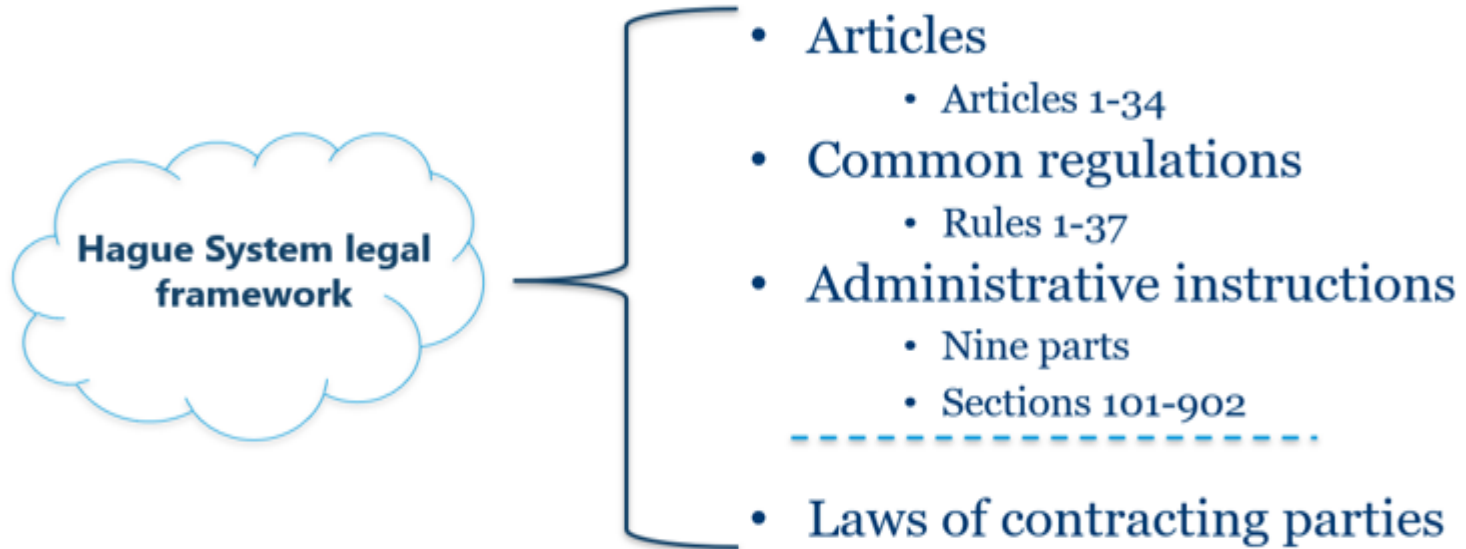
# Hague application basics

U.S. statutes and regulations implementing the Geneva Act and other relevant materials:

- 35 U.S.C. §§ 381 to 390
- 37 C.F.R. §§ 1.1001 to 1.1071
- MPEP 2900
- MPEP 1500
- Hague Agreement Articles, Regulations and Administrative Instructions



# Hague Application basics (*cont.*)



# Hague Application basics (*cont.*)

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**. (MPEP 2901(II)(B))

*A Contracting Party cannot refuse the effects of international registration on grounds that requirements relating to the form or contents of the application have not been satisfied. (Article 12)*

# Hague application basics (*cont.*)

## Effective filing date:

- Determination of the “effective filing date” must be done during examination by considering the actual filing date, and whether the application is entitled to a right of priority to an earlier foreign or domestic filing date.
- Pursuant to 35 U.S.C. 384(a), **the U.S. filing date for the Hague application is the international registration date.** See *MPEP 2908*.
- While in most cases, the international registration date and the international filing date will be the same, it is possible for the international registration date to be later than the international filing date. See *MPEP 2906-2907*.

# Hague application basics (*cont.*)

EFFECTIVE FILING DATE

## PE2E

Application Contents x Application Data x

Create Bib Data Sheet View IPF Assignment Data View IPR

Hague

International Registration Number (Hague)	DM/ [redacted]
International Registration Publication Date	06/12/2020
International Registration Date	12/11/2019
International Filing Date	12/11/2019

International Registration Number: DM/ [redacted]

## PALM

### Application Number Information

Application Number: 35/ [redacted] [Assignments](#)

Filing or 371(c) Date: 12/11/2019 [DAV](#)

Effective Date: 12/11/2019

Application Received: 06/12/2020

Patent Number:

Issue Date: 00/00/0000

Date of Abandonment: 00/00/0000

Attorney Docket Number: [redacted]

Status: 30 /DOCKETED NEW CASE - READY

Confirmation Number: [redacted]

Hague International Filing Date: 12/11/2019

Title of Invention: [redacted]

International Registration Publication Date: 06/12/2020



# Hague application basics (cont.)

## Office communications

- The types of Office communications in OC or responses from applicants are generally the same for Hague as they would be for U.S. design applications.

# Hague application basics (cont.)

## Refusal

- A Refusal is to be sent to the IB where it appears that the applicant is not entitled to a patent with respect to any industrial design that is the subject of the international registration. 37 CFR 1.1062(b). A Refusal is the first office action that refuses the effects of international registration. A Refusal may be a:
  - Rejection
  - Restriction
  - Quayle
    - For example, a rejection following a restriction is NOT a refusal.

MPEP 2901(II)(D) & MPEP 2920.05(a)

# Hague application basics (*cont.*)

## Reproductions

A reproduction refers to photographs, drawings or other graphic representations that illustrate the design.

### Relevant provisions:

- Rule 9
- Part Four of the Administrative Instructions
- Additional technical requirements for image files:  
[https://www.wipo.int/hague/en/docs/reproductions\\_technical\\_requirements.pdf](https://www.wipo.int/hague/en/docs/reproductions_technical_requirements.pdf)

See *MPEP 2909.02* and 37 C.F.R. 1.1026

# Hague application basics (*cont.*)

Applicant **cannot** file a CPA in Hague  
International Design Applications!!

See *37 CFR 1.53(d)(ii)*



# Hague application basics (*cont.*)

Properly filed 312 amendments may be used in Hague applications.

# Hague – the international design system

## **Mailing/Transmission of the office actions to the applicants:**

- Refusals are transmitted from the USPTO solely to the IB. It is the responsibility of the IB to forward the refusal to the applicant. This is irrespective of whether there is any POA on file or not.
- All other office actions are mailed directly to the applicant's address of correspondence on file or made available via Patent Center/PAIR for applicants opting for electronic notification (e-Office action). The IB is not involved.

*MPEP 2920.05(a) and 2901(II)(D)*

# Hague – The International Design system

## Issue Fee payment process

- Applicant can either pay the issue fee to the USPTO (in dollars) or through the IB (in Swiss francs). Where payment is made through the IB, the IB will notify the USPTO, and a IFEE document will appear in the application file showing payment.
- The issue fee amount due in a Hague application is the issue fee amount in effect as of the international registration date. Because of this, notice of allowances sent on the same day in a 29/ and in a 35/ for the same entity status may indicate different issue fee due amounts.

*MPEP 2920.06*

# Hague application examination

# Hague Application basics

## Reproductions

A reproduction refers to a drawing figure. It may be a photograph, line drawing, or other graphic representation that illustrates the design.

Relevant provisions:

- [Hague Rule 9](#)
- [Part Four of the Administrative Instructions](#)
- Additional technical requirements for image files:  
[www.wipo.int/hague/en/how\\_to/file/prepare.html](http://www.wipo.int/hague/en/how_to/file/prepare.html)

See *MPEP 2909.02 and 37 C.F.R. 1.1026.*

# Hague application basics (*cont.*)

## Figure Descriptions

Examiners of Hague cases should not object to figure descriptions for not being formatted as independent / complete sentences.

The following is acceptable:

- 1.1 : Front
- 1.2 : Back
- 1.3 : Left

See Hague Administrative Instructions Section 405.

# Hague Application basics (cont.)

Here are some of the main differences between Hague applications and U.S. applications.

In Hague applications -

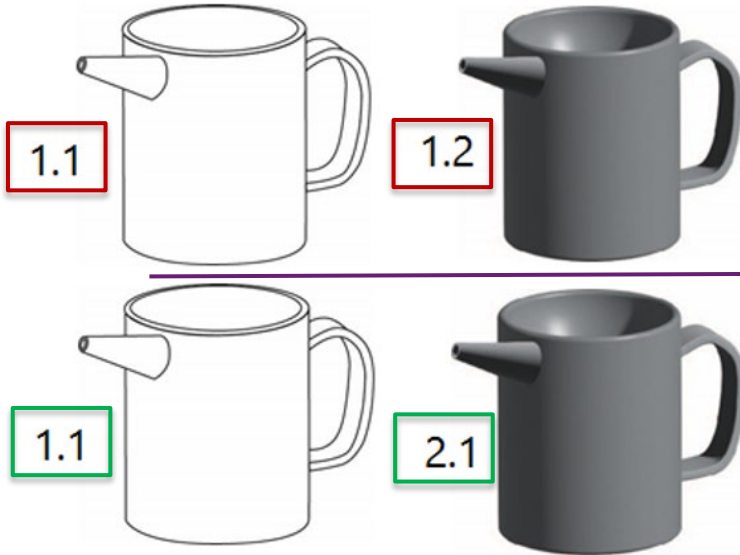
- Drawing deficiencies are not objected to under 37 CFR 1.84 or 1.152.
- Figure numbering uses a system of numbers: 1.1, 1.2, 1.3 etc. Different embodiments start with the next consecutive number: 2.1, 3.1 etc. Sole figures are listed as 1, 2, etc., (or 1.0, 2.0, etc. for older Hague cases)
- Applicants may use different techniques to describe unclaimed elements and environment, including:
  - Broken or dotted lines
  - Coloring or color washes (i.e. uniform transparent shading)
  - Disclaimer statements in the description

MPEP 2920.05(c) for broken lines & 2920.04(b) for shading.

# Hague application basics (*cont.*)

## Reproductions using different mediums (Guidance examples when U.S. is examining)

No mixing of the reproductions using different mediums in the same design (embodiment); No mixing of the representations in black & white and in color in the same design (embodiment).  
(See MPEP 1503.02(V), fourth paragraph.)



**Not acceptable in the same Design 1.**

An objection based on inconsistencies or a rejection under 35 USC 112(a) and (b) may be appropriate.

**Acceptable when in separate Designs 1 and 2.**

Restriction may still be appropriate.



# Hague application basics (*cont.*)

## Brief/Repetitive Figure Descriptions

Hague applications should not be objected to because a feature description also includes figure descriptions (repetitive of the brief description). For example:

1.1 Front view

1.2 Back view

1.3 Left side view

1.4 Right side view

Figure 1.1 is a front view of an electric unicycle scooter showing our new design; figure 1.2 is a back view thereof; figure 1.3 is a left side view thereof; figure 1.4 is a right side view thereof;

*The examiner cannot require removal of the repetition of the figure descriptions. They may simply suggest removal of repetitive descriptions for clarity without making a requirement.*

# Hague application basics (*cont.*)

## Figure Descriptions – Descriptive Language

An application with Title “Aquarium” contains the following descriptive language -

*The shipping container will be converted into an aquarium; companies can feature their branding on the sides of the container or inside using 3D brands; illumination around the edges will help to display any branding / animals or fish inside the tank.*

The descriptive language in the specification may either be objected to for containing the impermissible content or rejected under 35 U.S.C. 171 or 35 U.S.C. 112 - depending on how the claim is worded.

# Hague application basics (*cont.*)

## Figure Descriptions – Functional Language

“...The specification of a non-provisional international design application is not permitted to include statements describing matters that are directed to function or are unrelated to the design.”

MPEP 2920.04(a)(II). Form paragraphs 15.41 and/or 15.46.01, set forth in MPEP 1503.01(II), may be used.

# Hague application basics (*cont.*)

## Missing figure descriptions

### SPECIFICATION

**Design No./Product(s):**

1.-2 Charging Station for an electric vehicle

Modular multi-service station comprising a charging terminal for electric vehicles, storage spaces, and a high point adapted for Telecom and Digital service needs.

**Hague applications are required to have brief figure descriptions as per rule 37 CFR 1.1067.**

# Hague application examination

**The original filing is missing figure descriptions.**

## Design No./Product(s):

1. Caulking tool smoothing pillow

**The examiner objects to the specification due to the lack of figure descriptions and suggests an amendment.**

### Objection to the Specification

The specification is objected to for the following reason:

- The specification is objected to under 37 CFR 1.1067 for failing to provide figure descriptions. The description should indicate the type of view shown in the corresponding figure, such as "front view," "perspective view," "top view," etc. The descriptions of the figures are not required to be written in any particular format; however, they must describe the views of the reproductions clearly and accurately. See *Hague Rule 7(5)(a)*, *37 CFR 1.1024*, and *MPEP 2920.04(a)(II)*. For this reason, the specification must be amended to include independent figure descriptions following the indication of Design No./Product(s). The following is suggested:

#### -- Descriptions of the Reproduction(s):

- 1.1 is a top, front, and left-side perspective view of the CAULKING TOOL SMOOTHING PILLOW showing our new design;
- 1.2 is a bottom plan view thereof;
- 1.3 is a right-side elevation view thereof;
- 1.4 is a rear elevation view thereof;
- 1.5 is a front elevation view thereof; and
- 1.6 is a top plan view thereof. --

# Hague application examination (*cont.*)

## Figure Descriptions - Objections

Objections to figure descriptions based on purely formal matters should not be given.

Examiners may, however, request/suggest correction without making a requirement:

*"The following formal matters are noted: [ ]*

*Applicant is not required to correct the above-noted formal matters but may wish to do so to place the application in better form."*

# Hague Application examination (*cont.*)

## Figure descriptions - Objections

Example of an acceptable **objection with a substantive basis**:

*“The examiner objects to the statement below because transparent and translucent have two different appearances. In the reproduction 1.1 and 1.2 it appears the cover is fully transparent as all of the features are clearly visible. Therefore, for clarity of disclosure, the statement should be amended to remove “translucent” from the description”.*

# Hague – the international design system

**Hague office actions /File Wrapper available on Patent Center**

<https://patentcenter.uspto.gov/>

**Search at the Hague Express (Hague Registrations):**

<http://www.wipo.int/designdb/en/>

**Search at the Global Design Database (Design in all countries):**

<http://www.wipo.int/designdb/hague/en/>

**Hague Administrative Instructions**

[Administrative Instructions for the Application of the Hague Agreement \(wipo.int\)](#)

**Hague Rules**

[Hague System – Common Regulations \(wipo.int\)](#)



# Learning outcomes

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**Thank you!**

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