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Subject: Comments from Bill Fryer to the USPTO on Hague Agreement Draft Rules- Feb. 4, 2014

February 4, 2014

USPTO

Communications Manager

Subject: Comments to the USPTO on Hague Agreement Draft Rules

Dear Manager: I am enclosing my subject comments as an attachment prepared using Microsoft Word.

I would appreciate confirmation that these comments were received on time and the are in proper form for your use.

Thank you,

Bill Fryer

TO: United States Patent and Trademark Office (PTO)

FROM: William T. Fryer III, Professor Emeritus, University of Baltimore School of Law,
Baltimore, MD, and Patent Attorney since 1957

Date: February 4, 2014

SUBJECT: Comments on the Draft Rules to Implement the Hague Agreement

SUMMARY: Draft Rules on the Hague Agreement Concerning the Hague Agreement Concerning the International Registration of Industrial Designs (Hague Agreement) implementation are at the public comment stage, after significant effort by the PTO that is widely appreciated. These comments on the Draft Rules have several suggested changes, additions and questions. An Index is provided.

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I □ INTRODUCTION

It is my privilege to submit these comments. I congratulate the PTO staff in completing the excellent Draft Rules, which are compressive and detailed. They are in good form for public review. I hope my comments are useful in preparing the final rules. Please contact me if there are any questions on my comments, or if I can help in any other way.

I participated in each of the meetings of experts that drafted the Draft Hague Agreement, and I attended the diplomatic conference. At each of these meetings I represented the American Bar Association, Section of Intellectual Property law. I have been a consultant and expert witness in several legal proceedings on design patent law and procedure. In my academic role as a full time professor for over 30 years, I have written extensively on design protection, including a book on the Hague Agreement, published by Kluwer Law International in 2005, available on

Amazon.com, describing the Hague Agreement development and operation. My web site has more CV details and web publications □ URL www.fryer.com, and some of my other articles can be found on the academic web site at URL www.ssrn.org .

II □ Clarifications □ Reduce Confusion in Identifying Hague Agreement Rights and Other Aspects of Hague Agreement.

The Draft Rules use the concept of merging all design applications arriving at the PTO, keeping the Hague Agreement U. S. filed applications on there way to WIPO and returned to the PTO separated by the identification □international design application.□ It is suggested, for several reasons, that the related Hague Agreement U. S. design patent be identified as an □international design patent□.

This change is consistent with the Draft Rules Introductory explanation on how the rights are obtained -- Federal Register (FR) page 71886, middle column, second paragraph. The suggested change clarifies that the rights are subject to the Hague Agreement, with its closed system features, for example, only membership participation, assignment of International Registration rights, and renewal features.

In working with others on this treaty implementation I have seen confusion in separating the U. S. national design patent and patent based on an international design application. It would reduce confusion in use of the Hague Agreement if the PTO rules facilitated this distinction by using the suggested identification.

My decision to include this comment as the first one to present in my comments came from a short exercise I conducted to teach the Hague Agreement organization. I created a flow chart to explain development of U. S. design patent rights. If you try this exercise, you will find that the key elements of that diagram must be WIPO, PTO, and International Registration (IR). It is simpler to distinguish on the diagram the national design patent rights from the Hague Agreement rights by drawing a separate flow path from the IR to the PTO for the IR associated U. S. international design application, and to identifying the end product as an □international design patent.□ These international design patent rights are distinct in several ways.

As a test for this idea,. I suggest that in the Draft Rules explanation of the Hague Agreement, on FR page 71870, beginning in the Summary (middle column), that this suggested change would fit in effectively. In addition to a separate title for the □international design patent,□ I suggest that the Hague Agreement educational materials alert users that there are unique rights associated with a Hague Agreement based international design patent.

I do not see any provision in the PLTIA that would prohibit the implementation of the suggested change.

Draft Rules, FR page 71900, section 3.1 Definitions, may be a suitable place to put the □international design patent□ definition.

III □ Post Refusal PTO Examination of an International Design Application □ Suggest Rule to Confirm Right to Continue PTO Prosecution

In discussions with PTO staff recently, I mentioned this important point. The Diplomatic Conference transcript has many references that confirm the PTO right to continue International design application prosecution, for example, after new prior art is found. Other Hague Agreement diplomatic Conference participants expressed displeasure with this post refusal practice on new prior art, as they did on the delay that examination added in obtaining U. S. design patent rights.

It can be argued effectively that post refusal examination is implicit in the general provision that U. S. law and practice will apply in the examination of international design applications. On the other hand, there is an argument that the refusal procedure cuts off that right to add new prior art to the examination, or other post refusal actions.

My suggestion is to add in the Draft Rules a provision that confirms this important post refusal practice. In view of the history on this topic, this suggested addition should avoid a lot of controversy and perhaps litigation.

IV □ When Should the U.S. Have Access to a Deferred International Registration?

Deferment of an International Registrations (IRs) is a complex subject, and many countries provide this feature. A review of a deferred IR may be important from rights evaluation and prior art effect points of view. The U. S. decided to declare that IR applications requesting deferment could not be filed in the U. S. The Hague Agreement development history of this topic is in my book, for example on page 52.

Even though there is no deferment of the U.S. international design application, the U.S. has to consider an option allowed by the Hague Agreement to receive a copy of all deferred IRs at the time of IR. Only if the U. S. is designated in the International design application will WIPO send a copy of the IR at time of publication. The IR document gap is the U. S. does not have a copy of a deferred IR from the time of registration/deferment until it is published on the WIPO web site.

A deferred IR must be kept confidential, usually, by the PTO during deferment, so the public does not have access to the document, but an examining office can use it in anticipation of the forthcoming publication and existing rights. A relatively small percentage of IRs are deferred, since publication has several benefits. The question is whether the U. S. should give WIPO notice that it wants to receive a copy of all deferred IR.

It is suggested that the PTO review again the question of whether to obtain copies of deferred IRs. The Draft Rules Introduction, FR at page 71874, explains the deferment procedure, apparently indicating that the U. S. will not request copies of deferred IRs at the time of registration/deferment. The PTO position on this topic should be clarified.

A complete review of deferred IR use in design patent practice cannot be given here. A few comments will be made about the Draft Rules approach and practice in other countries that may be helpful. A fundamental question in pre-AIA and AIA patent law is whether an invention has been "patented," 35 U.S.C., section 102(a), by the applicant (pre and current AIA). Some countries may provide that design rights begin at the IR effective date filing date. A copy of the deferred IR may be useful in making the determination of whether the design has been patented.

Another consideration is when a deferred IR that has been subsequently published is prior art under section 102 (pre and current AIA). It appears the IR would be prior art at the time of publication, so no advanced notice of the deferred IR is needed for U. S. examination, and the U. S. design patent examiners will have the WIPO Bulletin online for search purposes.

V - Need for PTO Frequent Road Shows on the Hague Agreement Use

I complement the PTO on its road show educational programs in general, and particularly the Forum that was held on the Hague Agreement Draft Rules. Road shows are essential at the start of major changes in U. S. laws and practice. I suggest that there be frequent PTO educational programs, including webinars, for U. S. and foreign practitioner on the Hague Agreement use and other U. S. design patent practice.

In particular, for the Hague Agreement, I suggest that the PTO participate in international intellectual Property meetings outside the U. S. to keep Hague Agreement users abreast of Hague Agreement best practices. These meetings will offer an efficient place to gather valuable feedback on issues that need to be resolved. This global outreach has proven to be very effective for the U. S. on the Madrid Protocol. The EU has initiated similar approaches on the Community Design. Another avenue of cooperation, already taken by the PTO, is to work with the major design user countries, and joint educational programs on the Hague and national practice would be a useful next step.

Respectfully Submitted

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