From: SCHWAB, J.
Sent: Friday, January 17, 2014 3:31 PM
To: Gerk, David
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Subject: Hague Forum

David:

The January 14, 2014 Webinar was highly informative. Please thank all participants.

I had ten of the Firm's patent attorneys attend the Webinar and we offer the following comments for consideration.

I. Amendment of Drawings to Comply with U.S. Practice

1. Concern has been expressed where formal drawings are provided to the USPTO in compliance with U.S. practice which do not include a portion of the design as shown in e.g., the photograph (or other depiction) that was originally used for filing the international application, and/or shows a portion of the photograph content in dotted lines.

2. Some Examiners consider this a "broadening" of the disclosure.

3. Has any consideration been given to this issue, and will any guidelines be provided with respect to it?

II. Closed System

1. It is clear that applicants must qualify under one of the various eligibility criteria. It is unclear whether the resultant grant can later be transferred to a party that does not meet the eligibility criteria.

2. If transfer is restricted to only eligible transferees, it is suggested that any grant contain a **notice** of the restriction so that the public may be made aware of the restriction. We are aware of some opinions by others studying the Geneva Act that concludes that the Art. 3 definition relates to who can **file** and the Art. 16 provision relates to who can **record** a transfer—but does not expressly address the propriety of the transfer itself. A clarification by the Office would be helpful.

3. Pragmatically, the restriction issue may be less draconian, because the maintenance of an established business in the United States would permit the transfer. Nonetheless, many large international companies maintain patent portfolios in offshore jurisdictions which are not signatories to the Hague Treaty.

4. Will there be any statement in the regulations relating to the transfer restriction?

III. The Requirement For Locally Admitted Counsel For Prosecution

1. In countries where a response to substantive examination is required, it is our understanding it will it be necessary for an applicant to retain a representative that is admitted to practice before the United States Patent and Trademark Office.

2. Where no refusal is made by the USPTO to a filing through the International Bureau, it is our understanding a U.S. design patent will issue without the participation of admitted practitioners. What assurances or provisions have been received from the International Bureau that inappropriate activities will be addressed?

IV. Timing of Official Actions

1. The USPTO communications will be forwarded through WIPO and then to the applicant.

2. What operative dates will be used for response times?

V. Continuation Practice

1. RCE filings are not permitted for design applications and this is consistent with current U.S. practice regarding designs.

2. The outline also indicates that Continuation practice is also not permitted. We understand that if a Continuation application is filed in the United States the application would be converted from an international filing and treated as a domestic filing.

3. Would the filing of the Continuation therefore render the issued patent a U.S. Design Patent that would not be subject to the potential ambiguities concerning transfer?

VI. Filing of Divisionals

1. It is our understanding that divisionals can be filed in the United States, and will be considered as domestic U.S. filings rather than international filings. If this is correct, it is unclear whether the first elected embodiment, if granted will have transfer restrictions, whereas the divisionals will be freely transferable.

2. It is also unclear whether the filing of divisionals (or an election not to file some or all of the divisionals) will have a "file wrapper estoppel" impact on the interpretation of the preferred embodiment given the recent Federal Circuit decision in the Pacific Coast case that principles of file wrapper estoppel are applicable to design patents.

VII. Possible Strategy

Although likely not a subject for the issuance of regulations, we would ask whether the following protocol is available:

(a) File a domestic U.S. design application in the United States. (The need to apply for an export license would be eliminated.)

(b) File an international application with WIPO, claiming priority to the U.S. filing. The WIPO filing could include additional embodiments.

(c) The illustrations for the WIPO filing would include U.S. drawings and less expensive reproductions that are acceptable in other member countries. This would also permit obtaining protection on multiple embodiments in a single application, with reduced cost.

(d) The international filing would be directly with WIPO and the transmittal fee from the USPTO as an indirect filing office would be avoided.

Thank you in advance for your consideration of these comments.

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