

# 4 KEY TAKEAWAYS

## The Hague Agreement & Design Filings – Things You Need to Know & Do

Kilpatrick Townsend partner [Babak Kusha](#), along with a panel of other thought leaders, recently presented a Knowledge Group webinar on the topic of “The Hague Agreement and Design Filings.” The Hague Agreement is an international treaty that provides a design protection registration system for designated member countries and intergovernmental organizations.

**Key takeaways from the presentation include:**

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### The Hague System is short for the WIPO-administered Hague System for the International Registration of Industrial Designs.

- Hague Convention Treaty went into effect for the U.S. on May 13, 2015.
- U.S. design patents resulting from applications filed on or after May 13, 2015 will have a 15-year term.
- U.S. applicants are allowed to request design protection in the European Union and 66 contracting parties of the Geneva Act of the Hague Agreement.
- Non-U.S. applicants can file a Hague design application designating the U.S. for examination by the USPTO.

### Worldwide Hague International applications grew by over 35% in 2016.

- > The high growth is due to the Hague System’s expansion to:
  - Japan
  - U.S.
  - The Republic of Korea
- > The Hague System continues to expand geographically:
  - 66 members
  - 83 countries
- > The Hague Agreement offers a simplified procedure for filing in all member countries, there are some advantages:
  - A single set of formalities.
  - A single set of drawings is used in all designated countries.
    - Drawing requirements may be different in some countries.
    - Local examination process and legal standards remain unchanged.
- > Advice: Carefully plan and select countries where product is sold or sourced and consider strengths/issues for enforcement.

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### Here are two views of The Hague System.

- > Applicant’s view – what is good:
  - A cost-effective way to get design protection in many countries.
  - Can include many designs in one application.
  - Single, unified process.
  - Overcome some shortcoming in national systems – due to harmonization.
- > Attorney’s view:
  - Will need to know laws in every jurisdiction.
  - Local associate is now out of the loop.
    - O.K. if national or regional office does not substantively examine.
  - Likely to be much more expensive to fix, so D.I.R.F.T. (do it right the first time).
  - Getting the best design rights.
    - Should know the laws in every designated country.
    - Minimize challenges for enforcement.
  - Push past formalities.

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### Should clients use the Hague Convention?

- > Yes, when it makes business sense for the client.
- > Benefits:
  - Minimizes law firm fees – avoid multiple filings, one fee to be paid.
  - Minimizes administration – bypasses additional 6-month inquiry.
  - Broader and quicker initial coverage.
  - Application will publish, but publication can be delayed.
- > Challenges:
  - Similar up-front official fees
  - One size does not fit all.
  - Limited, albeit growing, membership.
  - Insufficient experience to know where problems may arise.

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