Designating Japan, the Republic of Korea and the United States of America
- How to Maximize your Chances to be Granted Protection?

Design Seminar, organized in cooperation by the Finnish Patent and Registration Office and the World Intellectual Property Organization

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Contents:

- Designating the United States of America, Japan and the Republic of Korea – Impact on the Hague System;
- Designating the United States of America: it is easy but must be done with care!
- Issues Common to Japan and the Republic of Korea
- WIPO’s Reaction to Help Users
- Strategic Considerations Relating to Designation of Japan, the Republic of Korea, the United States of America and the European Union in the same international application
I. Designating the United States of America, Japan and the Republic of Korea – Impact on the Hague System

«Examining jurisdictions» under the Hague System:

• Some declarations may only be made by a CP with an Examining Office (Art.1(xvii) of the 1999 Act);

• Specific elements required by USPTO, JPO and KIPO
Impacts on the Application’s Contents:

Specific Elements Required by JPO, KIPO and the USPTO
## US, JP and KR Specificities

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*X = Checked and enforced by the IB – no omission possible*
RoK : Designations and Decisions
Figures from Day 1 to October 31, 2017 – Source: Internal (unofficial) statistics
Japan: Designations and Decisions (per IR*)

Figures from Day 1 to October 31, 2017 – Source: Internal (unofficial) statistics

* JPO issues notifications of refusal per design. These figures are adjusted to represent the number of notifications of refusal per IR for the sake of comparison with the UPSTO and KIPO.
USA: Designations and Decisions

Figures from Day 1 to October 31, 2017 – Source: Internal (unofficial) statistics

- Designations
- Refusals per IR
- Grants of Protection per IR
- Invitations to pay second part of the Designation Fee

Waveform data series
Grounds of Refusals by KIPO against all Filings

Total number of designs in IR’s designating ROK: 7536
- Designs in IR designating KR recorded up to October 31, 2017

The sample contains 3075 Designs with 4077 Refusal Grounds
- The Refusal Grounds analyzed represent a representative sample of all the refusals received from KIPO

Primary Refusal Grounds
1. Insufficient Disclosure
   - 2079 Designs (67.50%)
2. Conflict App/Reg
   - [including Related Designs issue]
   - 695 Designs (22.50%)
3. Lack of Novelty
   - 439 Designs (14%)
4. Ambiguous Product Indication
   - 248 Designs (8%)

Source: Internal (unofficial) statistics
Grounds of Refusals by JPO against all Filings

Total number of designs in IR’s designating JP: 4980
- Designs in IR designating JP recorded up to October 31, 2017

The sample contains 2279 Designs with a total of 2971 Refusal Grounds raised by the JPO
- The Refusal Grounds analyzed represent a representative sample of all the refusals from JPO and recorded up to October 31, 2017

Primary Refusal Grounds
1. Insufficient Disclosure
   - 1388 Designs (61%)
2. Lack of Novelty
   - including lack of submission of priority documents
   - 460 Designs (20%)
3. Conflict App/Reg
   - including related designs issue
   - 447 Designs (19.6%)
4. Ambiguous Product Indication
   - 315 Designs (14%)

Source: Internal (unofficial) statistics
Grounds of Refusals by USPTO against all Filings

**Total number of designs in IR’s designating US: 9611**
- Designs in IR’s designating US recorded up to October 31, 2017

**The sample contains 3660 designs with a total of 5036 Refusal Grounds**
- The Refusal Grounds analyzed represent a representative sample of all the refusals received from USPTO up to October 31, 2017
- The 3660 designs refused correspond to a total number of 1296 IR’s refused

**Primary Refusal Grounds**

1. **Unity of Design**
   - 2839 Designs (77.50 %) [618 IR’s]
2. **Insufficient Disclosure**
   - 971 Designs (26.50 %)
3. **Formal**
   - (Objections to specification, legend, format, title, description)
   - 788 Designs (21.50 %)
4. **Ambiguous Product Indication**
   - 171 Designs (4.60 %)

Source: Internal (unofficial) statistics
USPTO, JPO & KIPO Refusal Grounds per Design Recorded from day 1 up to October 31, 2017

* USPTO refusals on ground of Unity of design per IR: 47.70 %
USPTO, JPO & KIPO
Refusal Grounds per Design
Recorded from day 1 up to October 31, 2017

* The 2839 designs refused by the USPTO on ground of Unity of design are contained in 618 IR’s
II. Designating the United States of America: it is easy but must be done with care!

- Article 5(2)(a) of the 1999 Act
  - **CLAIM:** The ornamental design for ...... as shown and described.
  - “Indicate an article in the blank space provided.”
  - “Only one article shall be indicated, irrespective of the number of industrial designs contained in the present international application.”

- Examples:

  The ornamental design for a motor car as shown and described.
  
  OR
  
  The ornamental design for a rear door panel for vehicles as shown and described.

**NOTE:** products in the same class (here: in class 12) may be included in an international registration but only ONE claim for only ONE product.
Designating the United States of America; it is easy but must be done with care!

- Declaration under Rule 8(1) of the Common Regulations: Identity of the creator and an oath/declaration by the creator is mandatory.

- Standard text for an Oath or Declaration is contained in Annex I to Form DM/1 and the E-Filing interface.

- If there are several creators, each of them shall sign the Oath or Declaration.

- The Oath or Declaration for each creator may be attached as a .pdf file, or be filled in directly on the website during the E-filing process.

- The standard USPTO form of an Oath/Declaration of Inventorship can also be found in different languages at the following addresses: http://www.uspto.gov/sites/default/files/forms/aia_oathdecl_guide.pdf and http://www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012.
Designating the United States of America; it is easy but must be done with care!

- Article 11(1)(b) of the 1999 Act
  - No deferment of the publication of the international registration.

- Rule 18(1)(b) of the Common Regulations
  - Refusal period of 12 months from the date of publication of the IR in the International Designs Bulletin on the WIPO website.

- Duty of Candor
  - The *Information Disclosure Statement* forms (SB08a/SB08b/SB08a-EFS-web) are available on the USPTO website: [http://www.uspto.gov/forms/aia_forms.jsp](http://www.uspto.gov/forms/aia_forms.jsp).
Designating the United States of America: it is easy but must be done with care!

- Article 7(2) of the 1999 Act and Rule 12(3) of the Common Regulations

- Individual designation fee to be paid in two parts: the first part to be paid at the time of filing of the international application and the second part to be paid upon its allowance.

- Upon receipt of the notice of allowance through the International Bureau the second part of the individual designation fee may be paid either directly to the USPTO (in US dollars) or through the IB (in Swiss francs).

- NOTE: Where the second part of the fee is paid through the International Bureau, the payment must be received by the IB by the due date (for example, if paid through a bank transfer, the correct amount must be on the WIPO’s bank account by the due date).

- Following receipt of the payment of the second part of the fee, USPTO will issue grant of the patent.
Designating the United States of America: it is easy but must be done with care!

- Amount of the individual designation fee:
  - Reductions for small entity applicants and micro-entity applicants
  - If the applicant claims **micro entity status**, the certification form is mandatory.
  - Certification form (**PTO/SB/15A** or **PTO/SB/15B**), along with the instructions for its completion and signature, is available on the United States Patent and Trademark Office web site: [http://www.uspto.gov/forms/aia_forms.jsp](http://www.uspto.gov/forms/aia_forms.jsp).

- **NOTE**: Individual designation fee for the US is for one design (or a group of patentably indistinct designs)
  - In the case of a multiple international registration, following restriction of the designation of the US in the IR to one design (or a group of patentably indistinct designs), fees to be paid to the USPTO when filing divisional applications for the remaining designs.
Multiple International Registrations vs. Requirement of Unity of Design

United States Patent and Trademark Office (USPTO): Declaration under Article 13(1) of the 1999 Act (unity of design)

- Only one independent and distinct design may be claimed in a single application (= one inventive step).

- Where multiple designs are contained in an international registration:
  • USPTO will issue a refusal on the ground of requirement of unity of design under its national law (together with substantive grounds, if any), and
  • request the restriction of the international registration to one group of patentably indistinct designs; for the other designs the holder may file divisional applications.
Unity of Design

- Indistinct designs or obvious variations:

**DM/087960**: Designs 1-8 “Storage Boxes”
Unity of Design

- Indistinct designs or obvious variations:

  Group 1: Designs 1-4
  Group 2: Designs 5-8

Designs grouped together have the same basic design characteristics:

- similar in overall appearance
- similar in visual impression
- similar in shape/configuration
III. Issues Common to Japan and the Republic of Korea

- Related design system;
- Product indication;
- Class 32;
- Prior divulgation;
- Submission of priority documents/other documents
Bear in Mind: Japan and Republic of Korea

- Multiple Embodiments? Related designs?
  Then, identify your ‘principal’ design

- Be Specific in the product indication
  - Sports installation (D089511)
  - Mixed martial arts ring

- Do not file for logos under class 32
Multiple Embodiments? Related designs? Then, identify your ‘principal’ design

Under the related design systems of Japan and the Republic of Korea, a design may be registered as a design related to another design to which it is similar and identified as a principal design, under the condition that both designs belong to the same applicant/holder.

Failure to do so may lead to a refusal by the Office concerned on the ground of conflict with a prior similar design.
Prior Divulgation

- KR: Attach documentation in support of a declaration concerning exception to lack of novelty under dedicated E-filing tab;
- JP: File original documentation in support of a declaration concerning exception to lack of novelty directly with JPO

With respect to the designation of Japan, the Japan Patent Office (JPO) requires that the supporting documentation be submitted to it directly within 30 days from the date of publication of the international registration in the *International Designs Bulletin*. 
Submission of Priority Documents to KIPO and JPO

- KR: Attach your priority document under dedicated tab
- JP: File your original priority document with JPO

PAY ATTENTION TO DEADLINES for submission of priority documents! 3 months from the international publication date. No extension possible!

- Why don’t you make the international application the priority application?
Multiple International Registrations vs. Requirement of Unity of Design

- Japan Patent Office (JPO): Declaration under Article 13(1) of the 1999 Act (unity of design)

- Article 7 of the Design Act of Japan, which requires that only one independent and distinct design may be included in a single application is applied only to national applications;

- JPO divides the IR internally, and issues separate SGPs or NoRs for each design (on substantive grounds, if any).
DM/088200: Notification of refusal on the ground of lack of unity of design by JPO

- Design No. 1 includes two or more designs judged by the national examination standard, JPO issued a NoR on the ground of lack of unity of design.
- In such a case, if the holder deletes either of them, protection can be granted to the amended design. At the same time, the holder may file divisional national application(s) for the deleted design(s), keeping the filing date.
- SGP following refusal issue by the JPO (for the amended design)

LANCOME PARFUMS ET BEAUTE & CIE
PARIS (FR)
Six views:

JP: Front, back, top, bottom, left, right view by the orthographic projection method are mandatory (Declaration under Rule 9 (3))
KR, US: Six views are recommended, not mandatory
Tips!!!

- Always explain in the description the presence of shading or dotted lines when designating JP and KR;

- Always remember to provide a legend (using the legend feature of E-filing) when designating any of the three Examining offices.

...as these tricks improve the clarity of the disclosure...
IV. WIPO’s Reaction to Help Users

- Intelligent E-filing system to keep it simple
  - Prevention of omission or systemic mistakes
  - Prepopulated declarations and claim

- Links to national websites for guidance
  - on prior art issues
  - the applicable level of fees (USPTO)
  - on related design practice (JPO and KIPO)
Guidance on Preparing and Providing Reproductions in Order to Forestall Possible Refusals on the Ground of Insufficient Disclosure of an Industrial Design by Examining Offices
I. NOT ENOUGH VIEWS

Examining Offices may consider that the design has not been sufficiently disclosed if the whole configuration of the product in which the claimed design is embodied is not fully shown.

EXAMPLE OF POSSIBLE PROBLEMATIC PRACTICE

The following example involves a bookstand. Only a certain part of the product is shown in the reproductions without any explanation regarding the lack of some views.

Indication of the product: "Bookstand"

III. UNCLEAR RELIEF OR CONTOURS OF SURFACES OF A THREE-DIMENSIONAL PRODUCT

It may be considered by Examining Officers that the design has not been sufficiently disclosed if the scope of the claimed design has not been clearly defined with the submitted views in combination with any additional written description.

EXAMPLE OF POSSIBLE PROBLEMATIC PRACTICE

The contours of a three-dimensional product with curved surfaces have not been clearly shown in the representation since shading is not provided in the drawings.

Indication of the product: "Pharmaceutical tablet"

Legends

1.1) Perspective (front, top and right); 1.2) Top; 1.3) Bottom; 1.4) Front.

Description

The parts shown by means of broken lines in the reproductions are not part of the claimed design. The left side view, the right side view and the back view are omitted because they are identical with the front view, respectively.
V. Strategic Considerations Relating to Designation of Japan, the Republic of Korea, the United States of America and the European Union

in the same international application
Remember: Refusals on Substantive Grounds only

- In particular, Offices cannot formally:
  - Oppose to color
  - Oppose to photographs or CADs
  - Oppose to surface shading or dotted line
  - Require surface shading
  - Require a description
  - Require a legend

- It’s **your** liberty under the Hague System to use these or not
Rule 9(4) of the Common Regulations

- No refusal on formal grounds.

- Refusal possible on the ground «that the reproductions contained in the international registration are not sufficient to disclose fully the industrial design»

- Criteria for sufficient disclosure of an industrial design may be different from one jurisdiction to another.
What causes the disclosure of the design to be insufficient or unclear?

- Lack of/or inadequate surface shading
- Lack of a description to clarify the scope of protection
- Insufficient number of views
- Lack of consistency among the views

*Don’t mix drawings and photograph of the design!*
Benefits for Design Owners

- **Simple**
  - a single electronic procedure
  - a single filing Office

- **Savings**
  - low registration fees
  - no need to pay foreign agents for filings

- **Effective**
  - a single application produces simultaneously the same legal effect in many countries
  - a fixed deadline for confirmation or refusal
  - a single, flexible title to manage
Using the Hague System to Get a Registered Community Design (RCD):

- No differences in the legal effects
- Some practical advantages
  - All views and description published in the International Designs Bulletin
  - Cheaper to maintain

More importantly: one-stop shop
- Neighboring States of the European Union no luxury
- Major markets (Japan, Republic of Korea, United States of America, Russian Federation, China (coming))
- KR, EU, JP and US in the same application!!!
A Change of Paradigm for Users...

- It is possible to be successful before all Offices
  - *Success stories start to abound*

- Hague Bonuses!
  - JP: Multiple designs filed together are not refused
DM/088980, Sinituote Oy: Sand sifter [household]

Description: Sand sifter for use with a cleaning bucket; front view is omitted because it is identical with the back view; right side view is omitted because it is identical with the left side view

Statement of Grant of Protection in US, JP, KR, NO
Reproduction Examples That Have Passed the Disclosure Test Before All Concerned Offices (1)

D089713 – Hilti Aktiengesellschaft

D087535 – Softbank Robotics
Reproduction Examples That Have Passed the Disclosure Test Before All Concerned Offices (2)

D089858 – Ninebot (Beijing) Tech

D086974 – Babybjörn AB
Reproduction Examples That Have Passed the Disclosure Test Before All Concerned Offices (3)

1.1 DM/087381 Salvatore Ferragamo S.P.A

1.7

1.8 DM/088913 Stadler Form Aktiengesellscaft

DM/086602 Columbus McKinnon Industrial Products GMBH
Kiitos!