

Hague Agreement Concerning the International Registration of Industrial Designs

Ratification of the 1999 Act: United States of America

1. On February 13, 2015, the Government of the United States of America deposited with the Director General of the World Intellectual Property Organization (WIPO) its instrument of ratification of the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs.
2. The instrument of ratification was accompanied by the following declarations:
 - the declaration referred to in Article 5(2)(a) of the 1999 Act and Rule 11(3) of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement, including specific wording of the claim that shall be in formal terms to the ornamental design for the article (specifying name of article) as shown, or as shown and described;
 - the declaration referred to in Article 7(2) of the 1999 Act and Rule 12(3) of the Common Regulations, that, in connection with an international application in which the United States of America is designated, the prescribed designation fee shall be replaced by an individual designation fee. The declaration further specifies that the individual designation fee to be paid comprises 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. The details of the declaration and the amount of the individual designation fee will be the subject of a further information notice;
 - the declaration referred to in Article 11(1)(b) of the 1999 Act, that the law of the United States of America does not provide for the deferment of the publication of an industrial design;
 - the declaration referred to in Article 13(1) of the 1999 Act, that, in accordance with the law of the United States of America, only one independent and distinct design may be claimed in a single application;
 - the declaration referred to in Article 16(2) of the 1999 Act, whereby the recording of a change in ownership of an international registration in the International Register shall not have effect in the United States of America until the United States Patent and Trademark Office (USPTO) has received the required statements or documents;

- the declaration required under Article 17(3)(c) of the 1999 Act, specifying that the maximum duration of protection for industrial designs provided for by the law of the United States of America is 15 years from grant;
- the declaration referred to in Rule 8(1) of the Common Regulations relating to the creator and specific contents required under subparagraph (1)(b);
- the declaration referred to in Rule 13(4) of the Common Regulations, notifying that the period of one month referred to in paragraph (3) of the said Rule shall be replaced by a period of six months, in light of the security clearance required by the law of the United States of America;
- the declaration referred to in Rule 18(1)(b) of the Common Regulations, whereby the prescribed period of six months for notifying a refusal of protection is replaced by a period of 12 months.

CONTENTS OF AN INTERNATIONAL APPLICATION DESIGNATING THE UNITED STATES OF AMERICA

3. Accordingly and in compliance with subsequent exchanges with the USPTO, where the United States of America is designated in an international application, it shall contain (in addition to mandatory contents which must be contained in every international application or accompany it and/or optional contents of an international application):

- a claim made for (specifying name of article) as shown, or as shown and described, and
- an oath or declaration of the creator and indications concerning the identity of the creator.

4. The claim and the oath or declaration will be part of the E-filing interface and the DM/1 form for the application for international registrations. It is recalled that pursuant to Article 10(2)(b) of the 1999 Act failure to include a claim in an international application designating the United States of America will affect the date of the international registration. In such a case, the date of the international registration shall be the date on which the correction of such an irregularity was received by the International Bureau or the filing date of the international application, whichever is the later.

5. Furthermore, where the United States of America is designated in an international application, it is not possible for an applicant to request the deferment of publication of the ensuing international registration. It is also recalled that, in accordance with the declaration made under Article 13(1) of the 1999 Act, in the case that the international registration designating the United States of America contains two or more distinct designs, the USPTO will be entitled to refuse the effects of the international registration pursuant to Article 12(1) of the 1999 Act pending compliance with the requirement as indicated in the notification of refusal.

6. It is recalled that pursuant to Rule 18*bis*(1)(a) of the Common Regulations, where Rule 12(3) applies, the effect as grant of protection is subject to the payment of the second part of the individual designation fee. Furthermore, in accordance with the law of the United States of America, the protection for industrial designs is a single term of 15 years from the grant of a design patent. The payment of the individual designation fee will cover the total period of protection, i.e., 15 years.

7. Regarding the declaration made by the Government of the United States of America under Rule 18(1)(b), it is understood that the United States of America provides industrial design rights through USPTO issuance of a design patent and that the USPTO will communicate a statement of grant of protection concerning industrial designs for which protection is granted in the United States of America. It is further understood that the declaration covers both situations under Rule 18(1)(c)(i) and (ii).

DOCUMENTATION IN SUPPORT OF THE CHANGE IN OWNERSHIP RECORDED IN THE INTERNATIONAL REGISTER

8. Regarding the declaration under Article 16(1) of the 1999 Act, the owner will still need to record the change in ownership with the USPTO by submitting to it the appropriate documentation supporting that change in ownership. The documents shall meet the criteria set forth in 35 U.S.C. 261 (refer to the web site of the USPTO at <http://www.uspto.gov/web/offices/pac/mpep/s301.html>).

ENTRY INTO FORCE OF THE 1999 ACT WITH RESPECT TO THE UNITED STATES OF AMERICA

9. The 1999 Act and the declarations made will enter into force with respect to the United States of America on May 13, 2015.

10. The ratification of the 1999 Act by the United States of America brings the number of Contracting Parties to this Act to 48. Therefore, the total number of Contracting Parties to the Hague Agreement is 63. A list of the Contracting Parties to the Hague Agreement is available on the WIPO web site at the following address:
<http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/hague.pdf>.

March 23, 2015