



INTELLECTUAL PROPERTY

ALERT

U.S. HOUSE OF REPRESENTATIVES PASSES PATENT LAW TREATIES IMPLEMENTATION ACT CHANGES TO DESIGN PATENT LAW ON THE WAY

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Notable changes to the design patent law in the United States are upcoming as a result of the United States House of Representatives passage of the Patent Law Treaties Implementation Act (the Act) on December 5. The Act, which was passed by the Senate in a unanimous vote on September 22, 2012, will now head to President Obama for his anticipated approval. The Act will be effective one year after approval.

The Act provides for implementation of the provisions of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (the Hague Agreement) and the Patent Law Treaty (the PLT). While both of these treaties were originally signed by the President and ratified by the Senate in 2007, the necessary implementation legislation is required prior to making them effective.

Once made effective, the aspects of the Act related to the Hague Agreement will streamline the filing of international applications by allowing any person who is a national of the United States, or has a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the United States to file an international design application with the United States Patent and Trademark Office. When filing such an application, a United States applicant must designate the countries among those that are parties to the Hague Agreement that the applicant intends to obtain rights in. After an initial review by the International Bureau for

certain formalities, the application will then be forwarded to the designated countries for examination and/or registration. Accordingly, one practical import of the Hague Agreement is the elimination of the necessity of using foreign counsel when filing a design application in jurisdictions outside of the United States.

The provisions of the Act related to enactment of the PLT are intended to bring current formal procedures for filing patent applications in the United States in line with those of foreign countries and will allow for, among other things, revival of unintentionally abandoned international applications and restoration of priority rights.

There are other notable changes made by the Act, such as extending the term of granted design patents from 14 years to 15 years for those applications filed after the effective date of the Act. Additionally, an applicant will be able to include up to 100 different designs in a single international design application. It must be noted, however, that normal restriction practice will still apply to those applications that designate the United States. Another change is that the publication of an international design application designating the United States will be treated as a "publication" under United States law, thereby providing the applicant with provisional rights. These provisional rights, which do not exist under current United States law, will allow the applicant or subsequent owner of an issued design

patent to seek pre-issuance damages for the infringement of a design patent that issued from such an international application.

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