

**DEPARTMENT OF COMMERCE****United States Patent and Trademark Office****37 CFR Parts 1, 3, 5 and 11****[Docket No. PTO–P–2013–0025]****RIN 0651–AC87****Changes To Implement the Hague Agreement Concerning International Registration of Industrial Designs****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Notice of proposed rulemaking.

**SUMMARY:** Title I of the Patent Law Treaties Implementation Act of 2012 (“PLTIA”) amends the patent laws to implement the provisions of the 1999 Geneva Act of the Hague Agreement Concerning International Registration of Industrial Designs (“Hague Agreement”) and is to take effect on the entry into force of the Hague Agreement with respect to the United States. The Hague Agreement provides that an applicant is entitled to apply for design protection in Hague Agreement member countries and with intergovernmental organizations by filing a single, standardized international design application in a single language. The United States Patent and Trademark Office (USPTO or Office) proposes changes to the rules of practice to implement title I of the PLTIA.

**DATES:** *Comment Deadline Date:* Written comments must be received on or before January 28, 2014.

**ADDRESSES:** Comments should be sent by electronic mail message over the Internet addressed to: *AC87.comments@uspto.gov*. Comments may also be submitted by postal mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313–1450, marked to the attention of Boris Milef, Senior PCT Legal Examiner, Office of PCT Legal Administration.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (*http://www.regulations.gov*) for additional instructions on providing comments via the Federal eRulemaking Portal.

Although comments may be submitted by postal mail, the Office prefers to receive comments by electronic mail message over the Internet because the Office may easily share such comments with the public. Electronic comments are preferred to be submitted in plain text, but also may be

submitted in ADOBE® portable document format or MICROSOFT WORD® format. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into ADOBE® portable document format.

The comments will be available for public inspection at the Office of the Commissioner for Patents, currently located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Comments also will be available for viewing via the Office’s Internet Web site (*http://www.uspto.gov*) and at *http://www.regulations.gov*. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

**FOR FURTHER INFORMATION CONTACT:** Boris Milef, Senior PCT Legal Examiner, Office of PCT Legal Administration, at (571) 272–3288.

**SUPPLEMENTARY INFORMATION:**

*Executive Summary: Purpose:* The Hague Agreement provides that an applicant is entitled to apply for design protection in all member countries and with intergovernmental organizations by filing a single, standardized international design application in a single language. Title I of the PLTIA amends Title 35 to implement the provisions of the Hague Agreement and is to take effect on the entry into force of the Hague Agreement with respect to the United States. This notice proposes changes to the relevant rules of practice in Title 37, Chapter I of the Code of Federal Regulations to implement title I of the PLTIA.

*Summary of Major Changes to U.S. Practice:* The major changes to U.S. practice in title I of the PLTIA pertain to: (1) Standardizing formal requirements for international design applications; (2) establishing the USPTO as an office through which international design applications may be filed; (3) providing a right of priority with respect to international design applications; (4) treating an international design application that designates the United States as having the same effect from its filing date as that of a national design application; (5) providing provisional rights for published international design applications that designate the United States; (6) setting the patent term for design patents issuing from both national design applications under chapter 16 and international design applications designating the United States to 15 years from the date of patent

grant; (7) providing for examination by the Office of international design applications that designate the United States; and (8) permitting an applicant’s failure to act within prescribed time limits in an international design application to be excused as to the United States under certain conditions.

The Office is specifically proposing to revise the rules of practice (37 CFR parts 1, 3, 5, and 11) to provide for the filing of international design applications by U.S. applicants in the USPTO as an office of indirect filing. The Office would transmit the international design application and any collected international fees to the International Bureau of the World Intellectual Property Organization (“WIPO”), subject to national security review and payment of a transmittal fee. The International Bureau would review the application for compliance with the applicable formal requirements under the Hague Agreement.

The Office also proposes to revise the rules of practice to set forth the formal requirements of an international design application, including specific content requirements where the United States is designated. Specifically, an international design application designating the United States would have to identify the inventor and include a claim and the inventor’s oath or declaration. The proposed rules also specify that an international design application designating the United States may be refused by the Office as a designated office if the applicant is not a person qualified under 35 U.S.C. chapter 11 to be an applicant.

The Office also proposes to revise the rules of practice to provide for examination of international design applications that designate the United States. International design applications are reviewed by the International Bureau for compliance with formal requirements under the Hague Agreement. Where these requirements have been met, the International Bureau would register the industrial design in the International Register and, subsequently, publish the international registration and send a copy of the publication to each designated office. Since international registration would only occur after the International Bureau finds that the application conforms to the applicable formal requirements, examination before the Office would generally be limited to substantive matters. With certain exceptions, the Hague Agreement imposes a time period of up to 12 months from the date of publication of the international registration for an examining office to refuse an

international design application. The rules are proposed to be revised to provide for the applicability of the requirements of 35 U.S.C. chapter 16 to examination of international design applications consistent with the Hague Agreement, and to provide for the various notifications to the International Bureau required of an examining office under the Hague Agreement.

The Office is also proposing to revise the rules of practice to provide for: (1) Review of a filing date established by the International Bureau; (2) excusing an applicant's failure to act within prescribed time limits in connection with an international design application; (3) priority claims with respect to international design applications; (4) payment of fees; and (5) treatment of international design applications for national security review.

**Costs and Benefits:** This rulemaking is not economically significant under Executive Order 12866 (Sept. 30, 1993).

**Background:** The 1999 Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs ("Hague Agreement"), negotiated under the auspices of WIPO, is the latest revision to the 1925 Hague Agreement Concerning the International Deposit of Industrial Designs ("1925 Agreement"). The United States is not a party to the 1925 Agreement, and did not join any of the subsequent Acts revising the 1925 Agreement, because those agreements either did not provide, or did not adequately provide, for substantive examination of international design applications by national offices. The Hague Agreement, adopted at a diplomatic conference on July 2, 1999, is the first Act that adequately provides for a system of individual review by the national offices of Contracting Parties.

In accordance with Article 28, the Hague Agreement will enter into force for the United States three months after the date that the United States deposits its instrument of ratification with the Director General of the International Bureau of WIPO or at any later date indicated in the instrument. As stated in the President's November 13, 2006, Letter of Transmittal to the Senate, the United States would not deposit its instrument of ratification until the necessary implementing legal structure has been established domestically. Treaty Doc. 109–21. Title I of the PLTIA, enacted on December 18, 2012, amended title 35 United States Code, in order to implement the Hague Agreement. See Public Law 112–211, §§ 101–103, 126 Stat. 1527, 1527–33 (2012). Its provisions are to take effect on the entry into force of the Hague

Agreement with respect to the United States. These proposed rules implement title I of the PLTIA.

The main purpose of the Hague Agreement is to facilitate protection for industrial designs by allowing applicants to apply for protection in those countries and intergovernmental organizations that are Contracting Parties to the Hague Agreement by filing a single standardized application in a single language. Currently, a U.S. design applicant seeking global protection generally has to file separate design applications in each country or intergovernmental organization for which protection is sought, complying with the formal requirements imposed by each country or intergovernmental organization. The Hague Agreement simplifies the application process and reduces the costs for applicants seeking to obtain rights globally. The Hague Agreement also provides for centralized international registration of designs and renewal of registrations. The Hague Agreement imposes a time limit on a Contracting Party to refuse the effects of international registration in that Contracting Party if the conditions for the grant of protection under the law of that Contracting Party are not met.

Major provisions of the Hague Agreement as implemented by title I of the PLTIA include the following:

Article 3 of the Hague Agreement provides that "[a]ny person that is a national of a State that is a Contracting Party or of a State member of an intergovernmental organization that is a Contracting Party, or that has a domicile, a habitual residence or a real and effective industrial or commercial establishment in the territory of a Contracting Party, shall be entitled to file an international application." Article 4(1)(a) provides that "[t]he international application may be filed, at the option of the applicant, either directly with the International Bureau or through the Office of the applicant's Contracting Party." Article 4(2) allows "[t]he Office of any Contracting Party [to] require that the applicant pay a transmittal fee to it, for its own benefit, in respect of any international application filed through it."

Section 101(a) of the PLTIA adds 35 U.S.C. 382 to implement the provisions of Articles 3 and 4. 126 Stat. at 1528. Section 382(a) provides that "[a]ny 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, may file an international design application by submitting to the United States Patent and Trademark Office an application in

such form, together with such fees, as may be prescribed by the Director." *Id.* Section 382(b) requires the Office to "perform all acts connected with the discharge of its duties under the [Hague Agreement], including the collection of international fees and the transmittal thereof to the International Bureau." *Id.* Transmittal of the international design application would be subject to 35 U.S.C. chapter 17 and payment of a transmittal fee. *Id.*

Article 5 of the Hague Agreement and Rule 7 of the "Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement" ("Hague Agreement Regulations" or "Regulations") concern the contents of an international design application. Article 5(1) requires the international design application to be in one of the prescribed languages and specifies the contents required for all international design applications. Specifically, it provides that the application "shall contain or be accompanied by (i) a request for international registration under [the Hague Agreement]; (ii) the prescribed data concerning the applicant; (iii) the prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with [Article 5(5)], the international application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design; (iv) an indication of the product or products which constitute the industrial design or in relation to which the industrial design is to be used, as prescribed; (v) an indication of the designated Contracting Parties; (vi) the prescribed fees; and (vii) any other prescribed particulars."

Article 5(2) of the Hague Agreement and Rule 11 of the Hague Agreement Regulations set forth additional mandatory contents that may be required by any Contracting Party whose Office is an Examining Office and whose law, at the time it becomes party to the Hague Agreement, so requires. Specifically, Article 5(2) provides that "an application for the grant of protection to an industrial design [may], in order for that application to be accorded a filing date under that law" be required to contain, any of the following elements: "(i) indications concerning the identity of the creator of the industrial design that is the subject of that application; (ii) a

brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application; and (iii) a claim.”

Section 101(a) of the PLTIA adds 35 U.S.C. 383 to provide that, “[i]n addition to any requirements pursuant to chapter 16, the international design application shall contain—(1) a request for international registration under the treaty; (2) an indication of the designated Contracting Parties; (3) data concerning the applicant as prescribed in the treaty and the Regulations; (4) copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international design application, presented in the number and manner prescribed in the treaty and the Regulations; (5) an indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed in the treaty and the Regulations; (6) the fees prescribed in the treaty and the Regulations; and (7) any other particulars prescribed in the Regulations.” 126 Stat. at 1529–30.

Article 6 of the Hague Agreement provides a right of priority with respect to international design applications. Article 6(1) provides that “[t]he international design application may contain a declaration claiming, under Article 4 of the Paris Convention, the priority of one or more earlier applications filed in or for any country party to that Convention or any Member of the World Trade Organization.” Article 6(2) provides that “[t]he international design application shall, as from its filing date and whatever may be its subsequent fate, be equivalent to a regular filing within the meaning of Article 4 of the Paris Convention.”

Section 101(a) of the PLTIA adds 35 U.S.C. 386 to provide for a right of priority with respect to international design applications. Section 386(a) provides that “[i]n accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172, a national application shall be entitled to the right of priority based on a prior international design application that designated at least 1 country other than the United States.” 126 Stat. at 1529. Section 386(b) provides that “[i]n accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172 and the treaty and the Regulations, an international design application designating the United States shall be entitled to the right of priority based on a prior foreign application, a prior international

application as defined in section 351(c) designating at least 1 country other than the United States, or a prior international design application designating at least 1 country other than the United States.” *Id.* Section 386(c) provides for domestic benefit claims with respect to international design applications designating the United States in accordance with the conditions and requirements of 35 U.S.C. 120. 126 Stat. at 1529–30.

Article 7 of the Hague Agreement and Rule 12 of the Hague Agreement Regulations provide for designation fees. Under Article 7(2) and Rule 12(3), the designation fee may be an “individual designation fee.” Article 7(2) provides that for any Contracting Party whose Office is an Examining Office, the “amount may be fixed by the said Contracting Party . . . for the maximum period of protection allowed by the Contracting Party concerned.” Rule 12(3) provides that the individual designation fee may “comprise two parts: The first part to be paid at the time of filing the international design application, and the second part to be paid at a later date which is determined in accordance with the law of the Contracting Party concerned.” Rule 12(1) lists other fees concerning the international design application, including the basic fee and publication fee.

Article 8(1) of the Hague Agreement and Rule 14 of the Hague Agreement Regulations provide that the International Bureau will examine the international design application for compliance with the requirements of the Hague Agreement and Regulations and invite the applicant to make any required correction within a prescribed time limit. Under Article 8(2), the failure to timely comply with the invitation will result in abandonment of the application, except where the irregularity concerns a requirement under Article 5(2) or a special requirement under the Regulations, in which case the failure to timely correct will result in the application being deemed not to contain the designation of the Contracting Party concerned.

Article 9 of the Hague Agreement establishes the filing date of an international design application. Article 9(1) provides that “[w]here the international application is filed directly with the International Bureau, the filing date shall, subject to [Article 9(3)], be the date on which the International Bureau receives the international application.” Article 9(2) provides that “[w]here the international application is filed through the Office of the applicant’s Contracting Party, the

filing date shall be determined as prescribed.” The filing date of an international application filed with an office of indirect filing is prescribed in Rule 13(3) of the Regulations.

Article 9(3) provides that “[w]here the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau.” Rule 14(1) sets forth the time limit in which the applicant is required to correct such irregularities, and Rule 14(2) sets forth the irregularities entailing postponement of the filing date of the international design application.

The PLTIA adds 35 U.S.C. 384, which provides in subsection (a) that the filing date of an international design application in the United States shall be the “effective registration date” subject to review under subsection (b). 126 Stat. at 1529. The term “effective registration date” is defined in § 381(a)(5), added by the PLTIA, as “the date of international registration determined by the International Bureau under the treaty.” 126 Stat. at 1528. Section 384(b) provides that “[a]n applicant may request review by the Director of the filing date of the international design application in the United States,” and that “[t]he Director may determine that the filing date of the international design application in the United States is a date other than the effective registration date.” 126 Stat. at 1529. It also authorizes the Director to “establish procedures, including the payment of a surcharge, to review the filing date under this section.” *Id.* Section 384(a) also provides that “any international design application designating the United States that otherwise meets the requirements of chapter 16 may be treated as a design application under chapter 16.” *Id.*

Article 10(1) of the Hague Agreement provides that “[t]he International Bureau shall register each industrial design that is the subject of an international application immediately upon receipt by it of the international application or, where corrections are invited under Article 8, immediately upon receipt of the required corrections.” Article 10(2) provides that “[s]ubject to subparagraph (b), the date of the international registration shall be the filing date of the international application.” Article 10(2)(b) provides that “[w]here the international application has, on the date on which it

is received by the International Bureau, an irregularity that relates to Article 5(2), the date of the international registration shall be the date on which the correction of such irregularity is received by the International Bureau or the filing date of the international application, whichever is the later.” Under Rule 15(2) of the Regulations, “the international registration shall contain (i) all the data contained in the international application . . . ; (ii) any reproduction of the industrial design; (iii) the date of the international registration; (iv) the number of the international registration; [and] (v) the relevant class of the International Classification, as determined by the International Bureau.”

Article 10(3)(a) of the Hague Agreement provides that “[t]he international registration shall be published by the International Bureau.” Under Article 10(3)(b), “[t]he International Bureau shall send a copy of the publication of the international registration to each designated Office.”

Section 101(a) of the PLTIA adds 35 U.S.C. 390 to provide that “[t]he publication under the treaty of an international design application designating the United States shall be deemed a publication under [35 U.S.C.] 122(b).” 126 Stat. at 1531.

Article 10(4) of the Hague Agreement provides that the International Bureau shall, subject to Articles 10(5) and 11(4)(b), keep each international application and international registration confidential until publication. Under Article 10(5)(a), “[t]he International Bureau shall, immediately after registration has been effected, send a copy of the international registration, along with any relevant statement, document or specimen accompanying the international application, to each Office that has notified the International Bureau that it wishes to receive such a copy and has been designated in the international application.”

Article 11 of the Hague Agreement provides for deferment of publication under certain conditions. Article 11(3) prescribes the procedure where a request for deferment is filed in an international design application designating a Contracting Party that has made a declaration under Article 11(1)(b) stating that deferment is not possible under its law.

Article 12(1) of the Hague Agreement provides that “[t]he Office of any designated Contracting Party may, where the conditions for the grant of protection under the law of that Contracting Party are not met in respect of any or all of the industrial designs

that are the subject of an international registration, refuse the effects, in part or in whole, of the international registration. . . .” Article 12(1) further provides that “no Office may refuse the effects, in part or in whole, of any international registration on the ground that requirements relating to the form or contents of the international application that are provided for in [the Hague Agreement] or the Regulations or are additional to, or different from, those requirements have not been satisfied under the law of the Contracting Party concerned.” Article 12(2) provides that the refusal of the effects of an international registration shall be communicated to the International Bureau within the prescribed period and shall state the grounds on which the refusal is based. Under Rule 18(1) of the Hague Agreement Regulations, the prescribed period for sending the notification of refusal is six months from publication, or twelve months from publication where an office makes a declaration under Rule 18(1)(b). The declaration under Rule 18(1)(b) may state that the international registration shall produce the effects under Article 14(2)(a) at the latest “at a time specified in the declaration which may be later than the date referred to in that Article but which shall not be more than six months after the said date” or “at a time at which protection is granted according to the law of the Contracting Party where a decision regarding the grant of protection was unintentionally not communicated within the period applicable under [Rule 18(1)(a) or (b)].” See Rule 18(1)(c).

Rule 18(2) provides that the notification of refusal “shall contain or indicate (i) the Office making the notification, (ii) the number of the international registration, (iii) all the grounds on which the refusal is based . . . , (iv) where the refusal . . . is based [on] an earlier national, regional or international application or registration, the filing date and number, the priority date (if any), the registration date and number (if available), a copy of a reproduction of the earlier industrial design (if . . . accessible to the public) and the name and address of the owner . . . , (v) where the refusal does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate, (vi) whether the refusal may be subject to review or appeal . . . , and (vii) the date on which the refusal was pronounced.”

Article 12(3) of the Hague Agreement provides that “[t]he International Bureau shall, without delay, transmit a copy of the notification of refusal to the

holder,” and that “[t]he holder shall enjoy the same remedies as . . . if the international registration had been the subject of an application for a grant of protection under the law applicable to the Office that communicated the refusal.” Under Article 12(4), “[a]ny refusal may be withdrawn, in part or in whole, at any time.”

Article 13 of the Hague Agreement permits a Contracting Party to notify the Director General in a declaration, where the Contracting Party’s “law, at the time it becomes party to this Act, requires that designs [in the] application conform to a requirement of unity of design, unity of production or unity of use, . . . or that only one independent and distinct design may be claimed in a single application.”

Under Article 14(1) of the Hague Agreement, “[t]he international registration shall, from the date of the international registration, have at least the same effect in each designated Contracting Party as a regularly filed application for the grant of protection of the industrial design under the law of that Contracting Party.”

Section 101(a) of the PLTIA adds 35 U.S.C. 385 to provide that “[a]n international design application designating the United States shall have the effect, for all purposes, from its filing date . . . of an application for patent filed in the Patent and Trademark Office pursuant chapter 16 [of Title 35 of the United States Code].” 126 Stat. at 1529. The PLTIA also amends 35 U.S.C. 154 to provide for provisional rights in international design applications that designate the United States. 126 Stat. at 1531–32.

Article 14(2) of the Hague Agreement provides that “[i]n each designated Contracting Party the Office of which has not communicated a refusal in accordance with Article 12, the international registration shall have the same effect as a grant of [design protection] under the law of that Contracting Party at the latest from the date of expiration of the period allowed for it to communicate a refusal or, where a Contracting Party has made a corresponding declaration under the Regulations, at the latest at the time specified in that declaration.” Article 14(2)(b) provides that “[w]here the Office of a designated Contracting Party has communicated a refusal and has subsequently withdrawn, in part or in whole, that refusal, the international registration shall, to the extent that the refusal is withdrawn, have the same effect in that Contracting Party as a grant of [design protection] under the law of said Contracting Party from the date on which the refusal was withdrawn.” Rule

18(4) of the Hague Agreement Regulations sets forth the required contents of a notification of withdrawal of refusal. Alternatively, under Rule 18*bis*(2), the office of a Contracting Party may send the International Bureau a statement of grant of protection in lieu of a notification of withdrawal of refusal.

Article 16 of the Hague Agreement and Rule 21 of the Hague Agreement Regulations provide for the recording of certain changes in the International Register by the International Bureau, such as changes in ownership or the name or address of the holder. Under Article 16(2), any such recording at the International Bureau “shall have the same effect as if it had been made in the Register of the Office of each of the Contracting Parties concerned, except that a Contracting Party may, in a declaration, notify the Director General that a recording [of a change in ownership] shall not have that effect in that Contracting Party until the Office of that Contracting Party has received the statements or documents specified in that declaration.”

Under Article 17 of the Hague Agreement, an “international design registration shall be effected for an initial term of five years counted from the date of international registration” and “may be renewed for additional terms of five years in accordance with the prescribed procedure and subject to payment of the prescribed fees.” The initial term of protection and additional terms may be replaced by a maximum period of protection allowed by a Contracting Party. *See* Article 7(2). The PLTIA amends 35 U.S.C. 173 to set the term of a design patent to 15 years from date of grant. 126 Stat. at 1532.

The PLTIA adds 35 U.S.C. 387 to allow the Director to establish procedures, including a requirement for payment of the fee specified in 35 U.S.C. 41(a)(7), to excuse as to the United States “[a]n applicant’s failure to act within prescribed time limits in connection with requirements pertaining to an international design application” upon a showing of unintentional delay. 126 Stat. at 1530.

Hague Agreement Rule 8, as recently amended by the Hague Union Assembly and to enter into force as of January 1, 2014 (*see WIPO Assembly Draft Report*, H/A/32/3 Prov. (October 2, 2013), available at [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=29895](http://www.wipo.int/meetings/en/details.jsp?meeting_id=29895)) provides for special requirements concerning the applicant and the creator. Under Rule 8(1)(a)(ii), “[w]here the law of a Contracting Party bound by the 1999 Act requires the furnishing of an oath or declaration of

the creator, that Contracting Party may, in a declaration, notify the Director General of that fact.” Rule 8(1)(b) provides that the declarations referred in Rule 8(1)(a)(i) and (a)(ii) shall specify the form and mandatory contents of any required statement, document, oath or declaration. Rule 8(3) provides that “[w]here an international application contains the designation of a Contracting Party that has made the declaration referred to in paragraph (1)(a)(ii) it shall also contain indications concerning the identity of the creator of the industrial design.” *See* discussion of § 1.1021(d).

Relevant documents, including the implementing legislation (title I of the PLTIA), Senate Committee Reports, and the Transmittal Letter, are available on the Web site at [http://www.uspto.gov/patents/int\\_protect/index.jsp](http://www.uspto.gov/patents/int_protect/index.jsp). This Web site also contains a link to WIPO’s Web site, which makes available relevant treaty documents, at [http://www.wipo.int/hague/en/legal\\_texts/](http://www.wipo.int/hague/en/legal_texts/).

#### Discussion of Specific Rules

The following is a discussion of proposed amendments to Title 37 of the Code of Federal Regulations, Parts 1, 3, 5 and 11.

*Rules referencing priority or benefit under 35 U.S.C. 119, 120, 121, or 365:* The Office proposes to reference 35 U.S.C. 386(a) and (b) where the current rules contain a reference to priority under 35 U.S.C. 119(a)–(d) or 365(a) or (b); and to reference 35 U.S.C. 386(c) where the current rules contain a reference to benefit under 35 U.S.C. 120, 121, or 365(c). Section 101(a) of the PLTIA adds 35 U.S.C. 386 to provide for a right of priority with respect to international design applications. 126 Stat. at 1529–30. The proposed references are required to account for the right of priority established under 35 U.S.C. 386.

*Section 1.4:* Section 1.4(a)(2) is proposed to be amended to include a reference to the proposed rules relating to international design applications in subpart I.

*Section 1.5:* Section 1.5(a) is proposed to be amended to provide that the international registration number may be used on correspondence directed to the Office to identify an international design application. The international registration number is the number assigned by the International Bureau upon registration of the international design in the International Register. *See* Rule 15 of the Regulations.

*Section 1.6:* Section 1.6(d)(3) is proposed to be amended to include the filing of an international design application among the correspondence

for which facsimile transmission is not permitted, and if submitted, will not be accorded a receipt date. This is consistent with the treatment of the filing of national patent applications and international applications under the Patent Cooperation Treaty (“PCT”).

Section 1.6(d)(4) is proposed to be amended to prohibit the filing of color drawings by facsimile in an international design application. This is consistent with the treatment of color drawings in national applications and international applications under the PCT.

Section 1.6(d)(6) is proposed to be amended to change “a patent application” to “an application” to clearly prohibit the submission of correspondence by facsimile in an international design application that is subject to a secrecy order under §§ 5.1 through 5.5.

*Section 1.8:* Section 1.8(a)(2)(i) is proposed to be amended to add a new paragraph (K) to include the filing of an international design application among the correspondence that will not receive benefit from a Certificate of Mailing or Transmission. *See* discussion of § 1.6(d)(3), *supra*.

*Section 1.9:* Sections 1.9(a)(1) and 1.9(a)(3) are proposed to be amended to include in the definitions of “national application” and “nonprovisional application,” respectively, an international design application filed under the Hague Agreement for which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10. Pursuant to 35 U.S.C. 385, added by section 101(a) of the PLTIA, an international design application that designates the United States has the effect from its filing date of an application for patent filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. chapter 16. 126 Stat. at 1529. The filing date of an international design application is, subject to review, the international registration date. *See* discussion of § 1.1023, *infra*. Under Article 10, the International Bureau will send a copy of the international registration to each designated office after publication (Article 10(3)) or, upon notification by the Contracting Party, immediately after international registration (Article 10(5)). Consequently, the Office will receive a copy of the international registration pursuant to Article 10 only if the United States has been designated.

Sections 1.9(l) and 1.9(m) are proposed to be added to define “Hague Agreement,” “Hague Agreement Article,” “Hague Agreement Regulations,” and “Hague Agreement

Rule” as used in chapter I of Title 37 of the Code of Federal Regulations (“CFR”).

Section 1.9(n) is proposed to be added to define “international design application” as used in chapter I of Title 37 of the CFR. Section 1.9(n) further provides that unless otherwise clear from the wording, reference to “design application” or “application for a design patent” in chapter I of the CFR includes an international design application that designates the United States.

Section 1.14: Section 1.14(a)(1) is proposed to be amended to add a reference to added paragraph (j) concerning international design applications.

Section 1.14(a)(1)(ii) is proposed to be amended to replace the reference to “abandoned application that has been published as a patent application publication” with a reference to “abandoned published application.” This change is consistent with the language of § 1.11(a) to which § 1.14(a)(1)(ii) refers. In addition, the term “published application” is defined in § 1.9(c) as “an application for patent which has been published under 35 U.S.C. 122(b).” Pursuant to 35 U.S.C. 374 and 35 U.S.C. 390, international applications and international design applications that designate the United States and are published under the respective treaty, “shall be deemed a publication under section 122(b).” Accordingly, a published application for purposes of § 1.14 will include a publication by the International Bureau of either an international application under the PCT or an international design application under the Hague Agreement that designates the United States. Access to such published applications is permitted under PCT Article 30 and Hague Agreement Article 10. In contrast, the term “patent application publication” refers to a publication by the Office under § 1.215. The Office does not intend to publish international design applications (see § 1.211), as international design applications are published by the International Bureau under the Hague Agreement in English. See Hague Agreement Article 10(3) and Rule 6(2). See also 35 U.S.C. 390, added by the PLTIA, deeming a publication under the Hague Agreement as a publication under 35 U.S.C. 122(b). 126 Stat. at 1531. In addition, the Office does not publish applications for design patents under 35 U.S.C. chapter 16. See § 1.211(b).

Sections 1.14(a)(1)(iv)–(vi) are proposed to be amended to include a publication of an international registration under Hague Agreement

Article 10(3) among the publications for which access to an unpublished application may be obtained. Section 1.14(a)(1)(iv) is proposed to be amended to permit access to the file contents of an unpublished abandoned application where the application is identified in the publication of an international registration under Hague Agreement Article 10(3), or where benefit of the application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). Section 1.14(a)(1)(v) is proposed to be amended to permit access to the file contents of an unpublished pending application where benefit of the application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, an international publication under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). Section 1.14(a)(1)(vi) is proposed to be amended to permit access to a copy of the application as originally filed of an unpublished pending application if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3).

Section 1.14(a)(1)(vii) is proposed to be amended consistent with amendments to § 1.14(a)(1)(iv)–(vi).

Section 1.14(j) is proposed to be added to set forth the conditions under which the records of an international design application maintained by the Office will be made available to the public.

Section 1.14(j)(1) provides that with respect to an international design application maintained by the Office in its capacity as a designated office for national processing, the records associated with the international design application may be made available as provided under § 1.14(a)–(i). Under Hague Agreement Article 10(5), the Office is to keep international design registrations confidential until publication of the international registration by the International Bureau. This provision does not alter the

Office’s long-standing practice to make application files available to the public to satisfy the Constitutionally mandated quid pro quo requiring public disclosure of patented inventions. See *United States ex rel. Pollok v. Hall*, 1889 Dec. Comm’r Pat. 582, 48 O.G. 1263 (DC 1988) (recognizing that the rights of exclusivity and confidentiality stem from Article I, Section 8, clause 8, of the Constitution in holding that the Office must make available to the public an abandoned application specifically referenced in a patent); P.J. Federico, *Commentary on the New Patent Act*, reprinted in 75 J. Pat. & Trademark Off. Soc’y 161, 196–197 (1993) (as background discussion to the addition of section 122 to the 1952 Patent Act, noting that for nearly 100 years the Office has had regulations requiring that applications be maintained confidential while recognizing public accessibility when an abandoned application is referenced in later issued patent); see also *Metropolitan West Side Elevated Railroad Company et al. v. Siemens*, 1898 Dec. Comm’r Pat. 220, 222 85 O.G. 290 (Comm’r Pat. 1898); *In re Reed Mfg. Co.*, 1900 Dec. Comm’r Pat. 140, 92 O.G. 2001 (Comm’r Pat. 1900); *Ex parte Lewis and Unger*, 1903 Dec. Comm’r Pat. 303, 106 O.G. 543 (Comm’r Pat. 1903); *In re Doman*, 1905 Dec. Comm’r Pat. 101, 115 O.G. 804 (Comm’r Pat. 1905). As a designated office, the Office will establish a file for national processing upon receipt of the published international registration from the International Bureau. In such cases, the records of the application file will be available pursuant to § 1.14(a)(ii)–(iii). The provisions of § 1.14(j)(1) provide for access to such international design applications maintained by the Office for national processing, thus treating international design applications the same as regular national applications.

Section 1.14(j)(2) provides that with respect to an international design application maintained by the Office in its capacity as an office of indirect filing (§ 1.1002), the records of the international design application may be available under § 1.14(j)(1) when they are contained in the file of the international design application maintained by the Office for national processing. Also, if benefit of the international design application is claimed under 35 U.S.C. 386(c) in a U.S. patent or published application, the file contents may be made available to the public, or a copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written

request, and payment of the appropriate fee (§ 1.19(b)). The Office plans to use the application file maintained by the Office as an office of indirect filing as the file for national processing as a designated office. Consequently, the records maintained by the Office as an office of indirect filing may be available where the records are part of the file maintained by the Office as a designated office and are available pursuant to § 1.14(j)(1). The records maintained by the Office as an office of the indirect filing may also be available where benefit to the international design application is claimed under 35 U.S.C. 386(c) in a U.S. patent or published application. Under the provisions of 35 U.S.C. 386(c) and 35 U.S.C. 388, applicants may claim benefit to an international design application that designates the United States provided the application claiming benefit of the international design application is filed before the date of withdrawal, renunciation, cancellation, or abandonment of the international application, either generally or as to the United States.

**Section 1.16:** Sections 1.16(b), (l) and (p) are proposed to be amended to clarify that the design application fees specified therein are applicable to design applications filed under 35 U.S.C. 111. The other provisions of section 1.16 are not proposed to change.

**Section 1.17:** Section 1.17(f) is proposed to be amended to specify the fee for filing a petition under § 1.1023 to review the filing date of an international design application in the United States. Section 101(a) of the PLTIA adds 35 U.S.C. 384, which provides that the filing date of an international application in the United States is the effective registration date (35 U.S.C. 384(a)), and authorizes the Director to establish procedures, including the payment of a surcharge, to review the filing date, which may result in a determination that the application has a filing date in the United States other than the effective registration date (35 U.S.C. 384(b)). 126 Stat. at 1529. The review procedure authorized under 35 U.S.C. 384(b) is set forth in proposed § 1.1023, discussed *infra*, which requires, *inter alia*, the fee set forth in § 1.17(f). Under 35 U.S.C. 389(b), added by the PLTIA, all questions of procedures regarding an international design application designating the United States, unless required by the Hague Agreement and regulations thereunder, shall be determined as in the case of applications filed under 35 U.S.C. chapter 16. 126 Stat. at 1530. Accordingly, pursuant to the authority under 35 U.S.C. 389(b), the fee for filing

a petition to review the filing date of an international design application under § 1.1023 is the same as the fee for filing a petition to accord a filing date in a national application (*see* §§ 1.53(e) and 1.57(a)).

Section 1.17(u) is proposed to be added to set forth the fee for filing a petition to excuse an applicant's failure to act within prescribed time limits in an international design application. Section 101(a) of the PLTIA adds 35 U.S.C. 387 to provide that an applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international design application may be excused as to the United States upon a showing satisfactory to the Director of unintentional delay and under such conditions, including a requirement for payment of the fee specified in 35 U.S.C. 41(a)(7), as may be prescribed by the Director. 126 Stat. at 1530. The conditions for excusing an applicant's failure to act within the prescribed time limits in an international design application are set forth in proposed § 1.1051, discussed *infra*. These requirements include, *inter alia*, the requirement to pay the fee set forth in § 1.17(u). The fee set forth in § 1.17(u) does not include a micro entity amount as this fee is set under 35 U.S.C. 41(a)(7) as amended by section 202(b)(1)(A) of the PLTIA, and not section 10(a) of the AIA. Section 10(b) of the AIA provides that the micro entity discount applies to fees set under section 10(a) of the AIA. *See* Pub. L. 112–29, 125 Stat. 284, 316–17 (2011). The Office will consider including a micro entity amount in § 1.17(u) in the event that patent fees are again set or adjusted under section 10(a) of the AIA.

Section 1.17(v) is proposed to be added to specify the fee for filing a petition under § 1.1052 to convert an international design application to a design application under 35 U.S.C. chapter 16. *See* discussion of § 1.1052, *infra*. The petition fee is not being set pursuant to section 10(a) of the AIA. Rather, the Office is setting this fee in this rulemaking pursuant to its authority under 35 U.S.C. 41(d)(2), which provides that fees for all processing, services, or materials relating to patents not specified in 35 U.S.C. 41 are to be set at amounts to recover the estimated average cost to the Office of such processing, services, or materials.

The Office uses an Activity Based Information (“ABI”) methodology to determine the estimated average costs (or expense) on a per process, service, or material basis including the particular processes and services addressed in this rulemaking. The ABI

analysis includes compiling the Office costs for a specified activity, including the direct-expense (*e.g.*, direct personnel compensation, contract services, maintenance and repairs, communications, utilities, equipment, supplies, materials, training, rent and program-related information technology (“IT”) automation), an appropriate allocation of allocated direct expense (*e.g.*, rent, program-related automation, and personnel compensation benefits such as medical insurance and retirement), and an appropriate allocation of allocated indirect expense (*e.g.*, general financial and human resource management, nonprogram specific IT automation, and general Office expenses). The direct expense for an activity plus its allocated direct expense and allocated indirect expense is the “fully burdened” expense for that activity. The “fully burdened” expense for an activity is then divided by production measures (number of that activity completed) to arrive at the fully burdened per-unit cost for that activity. The cost for a particular process is then determined by ascertaining which activities occur for the process, and how often each such activity occurs for the process. The ABI analysis in this rulemaking is based upon fiscal year 2012 expense. The prospective fees are calculated using the ABI expense and applying adjustment factors to estimate the cost in fiscal year 2015 expense, as fiscal year 2015 may be the next opportunity to consider whether to revisit the fees under section 10(a) of the AIA. This analysis uses 2012 expense as a proxy and adjusts for yearly inflation in the out-years.

The Office is estimating the fiscal year 2015 cost in this rulemaking by using the projected change in the Consumer Price Index for All Urban Consumers (“CPI-U”) for fiscal years 2013, 2014, and 2015, as the CPI-U is a reasonable basis for determining the change in Office costs between fiscal year 2012 and fiscal year 2015. The individual CPI-U during each fiscal year is multiplied together to obtain a cumulative CPI-U from fiscal year 2013 through fiscal year 2015. The CPI-U increase for fiscal year 2013 is forecasted to be 2.1 percent. The CPI-U increase for fiscal year 2014 is forecasted to be 2.2 percent. The CPI-U increase for fiscal year 2015 is forecasted to be 2.2 percent. *See* <http://www.whitehouse.gov/sites/default/files/omb/budget/fy2014/assets/spec.pdf>. Thus, the estimated fiscal year 2015 cost amounts are calculated by multiplying the actual expense amount for fiscal year 2012 by 1.066 (1.021



multiplied by 1.022 multiplied by 1.022 equals 1.066). The estimated fiscal year 2015 cost amounts are then rounded to the nearest ten dollars by applying standard arithmetic rules so that the resulting fee amounts will be convenient for international design application users.

The processing of a petition to convert an international design application to a design application under 35 U.S.C. chapter 16 involves review and preparation of a decision for the petition. An estimate for the number of hours required for a GS-12, Step 5 attorney to review the petition and draft a decision is two hours. The ABI analysis indicates that the estimated fully burdened expense during fiscal year 2012 to review and prepare a decision for the petition is \$172 (\$86 fully burdened labor cost per hour multiplied by 2). Thus, the Office estimates the fiscal year unit cost to review the petition and draft a decision, using the estimated CPI-U increase for fiscal years 2013, 2014, and 2015, is \$183 (\$172 multiplied by 1.066), which, when rounded to the nearest ten dollars, is a proposed fee for conversion of \$180. Additional information concerning the Office's analysis of the estimated fiscal year 2015 costs for converting an international design application to a design application under 35 U.S.C. chapter 16 is available upon request.

**Section 1.18:** Section 1.18(b)(3) is proposed to be added to provide that an issue fee paid through the International Bureau in an international design application designating the United States shall be in the amount specified on the Web site of the WIPO, available at: <http://www.wipo.int/hague>. The option for applicants to pay the issue fee through the International Bureau is provided for in Hague Agreement Rule 12(3)(c) and is in lieu of paying the issue fee under § 1.18(b)(1). Article 7(2) permits a Contracting Party to declare that the prescribed designation fee shall be replaced by an individual designation fee, whose amounts can be changed in further declarations. The International Bureau accepts payment only in Swiss currency (see Hague Agreement Rule 28(1)) and all fee amounts specified on the WIPO Web site are in Swiss currency.

**Section 1.25:** Section 1.25(b) is proposed to be amended to provide that international design application fees (§ 1.1031) may be charged to a deposit account.

**Section 1.27:** Section 1.27(c)(3) is proposed to be amended to provide that the payment, by any party, of the exact amount of the small entity first part of the individual designation fee for the

United States (Hague Agreement Rule 12(1)(a)(iii)) to the International Bureau in an international design application will be treated as a written assertion of entitlement to small entity status. The proposed change to § 1.27(c)(3) will permit applicants paying fees to the International Bureau in an international design application designating the United States to establish small entity status for the purposes of the United States.

**Section 1.29:** Section 1.29(e) is proposed to be amended to provide that a micro entity certification filed in an international design application may be signed by a person authorized to represent the applicant under § 1.1041(a) before the International Bureau where the micro entity certification is filed with the International Bureau.

**Section 1.41:** Section 1.41(f) is proposed to be added to set forth the inventorship in an international design application designating the United States. Specifically, the inventorship of an international design application designating the United States is the creator or creators set forth in the publication of the international registration under Hague Agreement Article 10(3). Any correction of inventorship must be pursuant to § 1.48.

**Section 1.46:** Section 1.46(b) is proposed to be amended to provide that if an application entering the national stage under 35 U.S.C. 371, or an international design application before the United States as a designated office, is applied for by a person other than the inventor under § 1.46(a) (i.e., the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter, as provided under 35 U.S.C. 118) that person must have been identified as the applicant for the United States in the international stage of the international application or as the holder in the publication of the international registration under Hague Agreement Article 10(3). The proposed amendment does not change the current practice with respect to national stage applications under 35 U.S.C. 371, where a person seeking to become an applicant under § 1.46 in the national phase was not named as an applicant for the United States in the international phase. In such case, that person must comply with the requirements under § 1.46(c), including the requirements of §§ 3.71 and 3.73, to be an applicant in the national phase. The proposed amendment treats international design applications in the same manner as international applications under the

PCT. *See* discussion of § 1.1011(b), *infra*, regarding who may be an applicant for an international design application designating the United States.

Section 1.46(c) is proposed to be amended to provide that any request to correct or update the name of the applicant under this section must include an application data sheet under § 1.76 specifying the correct or updated name of the applicant in the applicant information section (§ 1.76(b)(7)), except that correction of the name of the applicant may be made pursuant to Hague Agreement Article 16 for an international design application. Section 1.46(c) is also proposed to be amended to provide that any request to replace the original applicant with an applicant under § 1.46 must include an application data sheet under § 1.76 specifying the applicant in the applicant information section (§ 1.76(b)(7)) and comply with §§ 3.71 and 3.73.

Article 16(1)(ii) provides for recording in the International Register by the International Bureau of a change in the name and address of the holder. Under Article 16(2), such recording has the same effect as if made in the Office of each of the designated Contracting Parties. Accordingly, § 1.46(c) is proposed to be amended to recognize a change in the *name* of the holder (i.e., applicant) in an international design application designating the United States, where the name change was recorded by the International Bureau pursuant to Article 16. Article 16 also provides for the recording of a change in ownership of the international registration, the effect of which may be made subject to the Office of the Contracting Party receiving the statement or documents it specifies in a declaration. In such case, the new owner may become an applicant in the international design application before the Office for national processing in accordance with the procedure set forth in § 1.46(c).

**Section 1.53:** Section 1.53(d)(1)(ii) is proposed to be amended to provide that a continued prosecution application ("CPA") of a prior nonprovisional application may be filed where the prior nonprovisional application is a design application, but not an international design application, that is complete as defined by § 1.51(b). Under current § 1.53(d), a CPA may be filed where the prior nonprovisional application is a design application that is complete as defined by § 1.51(b). The filing of a CPA of a prior nonprovisional international design application would not be appropriate, as a CPA is a design application under 35 U.S.C. chapter 16



and thus subject to different statutory and regulatory requirements relative to a nonprovisional international design application.

*Section 1.55:* Section 1.55(b) is proposed to be amended to provide that the six-month period specified in that paragraph is subject to Hague Agreement Rule 4(4). Rule 4(4) provides that if a period expires on a day on which the International Bureau or the Office concerned is not open to the public, the period shall expire on the first subsequent day on which the International Bureau or the Office concerned is open to the public. Section 101(a) of the PLTIA adds 35 U.S.C. 386(b) which provides: “[i]n accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172 and the treaty and the Regulations, an international design application designating the United States shall be entitled to the right of priority based on a prior foreign application . . . .” 126 Stat. at 1529. Thus, pursuant to 35 U.S.C. 386(b), the priority period in an international design application designating the United States is subject to extension under Rule 4(4).

Section 1.55(m) is proposed to be added to set forth the time for filing a priority claim and certified copy of a foreign application in an international design application designating the United States. Section 1.55(m) provides that in an international design application designating the United States, the claim for priority may be made in accordance with the Hague Agreement and the Hague Agreement Regulations. Section 1.55(m) further provides that for purposes of the United States, the priority claim may also be presented in an application data sheet (§ 1.76(b)(6)), filed directly with the Office after publication of the international design application under Article 10(3) of the Hague Agreement, identifying the foreign application for which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The priority claim and certified copy must be furnished in accordance with the time period and other conditions set forth in paragraph (g).

*Section 1.57:* Section 1.57(a) is proposed to be amended by revising paragraph (a) to include a new paragraph (a)(3) and to renumber paragraph (3) as paragraph (4). Section 101(a) of the PLTIA adds 35 U.S.C. 386 to provide for a right of priority to an international design application. 126 Stat. at 1529–30. Accordingly, § 1.57(a) is proposed to be amended to provide

for incorporation by reference to an inadvertently omitted portion of the specification or drawings based on a benefit claim under 1.78 to an international design application present upon filing, and to provide that any amendment to an international design application that designates the United States pursuant to § 1.57(a) shall be effective only as to the United States, and shall have no effect on the filing date of the application.

*Section 1.76:* Section 1.76(b)(6) is proposed to be amended to provide that the foreign priority information section of the application data sheet may include the intellectual property authority rather than country of filing. This change is for consistency with the requirements of 35 U.S.C. 119(b) and § 1.55.

*Section 1.78:* Section 101(a) of the PLTIA adds 35 U.S.C. 386(c) to provide for benefit claims with respect to international design applications designating the United States in accordance with the conditions and requirements of 35 U.S.C. 120. 126 Stat. at 1529–30. Accordingly, § 1.78(c) is proposed to be amended to provide for benefit claims under 35 U.S.C. 386(c). Section 1.78(c)(1)(iii) is added to provide that the prior-filed application to which benefit is claimed may be an international design application designating the United States that is entitled to a filing date as set forth in § 1.1023.

Section 1.78(c)(2) is proposed to be amended to provide that the reference required under § 1.78(c)(2) may identify an international design application by international registration number and international registration date.

Section 1.78(c)(7) is proposed to be added to provide that where benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) to an international application or an international design application, which designates but did not originate in the United States, the Office may require a certified copy of such application together with an English translation thereof if filed in another language. The authority to require a certified copy of an international design application that designates the United States but did not originate in the United States, and an English translation thereof, is provided in 35 U.S.C. 386(c). Similar authority with respect to international applications that designate the United States but do not originate in the United States is provided in 35 U.S.C. 365(c). Since international applications are published under PCT Article 21(2), and international design applications are published under Hague Agreement

Article 10(3), the Office would not ordinarily require a certified copy of the international application or international design application pursuant to § 1.78(c)(7). Rather, the Office foresees the authority under § 1.78(c)(7) to be used primarily in instances where the international application or international design application did not publish under the respective treaty, or where there is a question as to the content of the disclosure of the application as of its filing date, and the certified copy and any English translation are needed to determine entitlement to the benefit of the filing date of the international application or international design application in order to, for example, overcome a prior art reference.

Section 1.78(d) is proposed to be amended to provide for acceptance of a delayed benefit claim to an international application designating the United States pursuant to the petition procedure set forth therein.

*Section 1.84:* Section 1.84(y) is proposed to be amended to include a cross reference to international design application reproductions in proposed § 1.1026.

*Section 1.85:* Section 1.85(a) is proposed to be amended to provide that if a drawing in an international design application designating the United States meets the requirements of § 1.1026, the drawing may be admitted for examination. Section 1.85(c) is proposed to be amended to provide that if a drawing in an international design application does not comply with § 1.1026 at the time an application is allowed, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing to avoid abandonment.

*Section 1.97:* Section 1.97(b)(3) is proposed to be added to provide that an information disclosure statement may be filed within three months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application. An information disclosure statement may also be submitted with the international design application. *See* Hague Agreement Rule 7(5)(g) (“The international application may be accompanied by a statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned.”).

*Section 1.105:* Section 1.105(a)(1) is proposed to be amended to make a requirement for information under

§ 1.105 applicable to international design applications and supplemental examination proceedings.

*Section 1.114:* Section 1.114(e) is proposed to be amended to provide that a request for continued examination may not be filed in an international design application. This is consistent with the treatment of applications for design patents under 35 U.S.C. chapter 16.

*Section 1.155:* Section 1.155 is proposed to be amended to provide for expedited examination of an international design application that designates the United States. To qualify for expedited examination, § 1.155(a)(1) provides that the international design application must be published pursuant to Hague Agreement Article 10(3).

*Section 1.211:* Section 1.211(b) is proposed to be amended to provide that an international design application under 35 U.S.C. chapter 38 shall not be published by the Office under § 1.211. International registrations are published by the International Bureau pursuant to Article 10(3) of the Hague Agreement. The international registration includes the data contained in the international design application and any reproduction of the industrial design. See Rule 15(2) of the Regulations.

*Section 1.312:* Section 1.312 is proposed to be amended to provide that where the issue fee is paid in an international design application through the International Bureau, the date of payment of the issue fee for purposes of determining the timeliness of an amendment under § 1.312 will be the date the issue fee is recorded by the Office. This date will be indicated as the accounting date in the Office's Revenue Accounting and Management System. Under the Hague Agreement, the issue fee may be paid through the International Bureau. An amendment under § 1.312 filed after payment of the issue fee to the International Bureau but before the fee is recorded by the Office would be untimely under the current rule. Because of the inherent time lag between payment of the issue fee to the International Bureau and crediting of the issue fee to the account of the Office, the Office may not have sufficient information at the time of receipt of the amendment under § 1.312 to determine whether such amendment may be entered under the current rule. The proposed amendment to § 1.312 is more favorable to applicants and would facilitate processing of such amendments by the Office. In addition, since the application will not be scheduled for printing as a patent until the issue fee is recorded by the Office,

the proposed amendment would not delay issuance of the patent.

A new subpart I is proposed to be added to provide for international and national processing of international design applications.

*Section 1.1001:* Section 1.1001 is proposed to be added to include definitions of terms used in subpart I.

*Section 1.1002:* Section 1.1002 is proposed to be added to indicate the major functions of the USPTO as an office of indirect filing. These include: (1) Receiving and according a receipt date to international design applications; (2) collecting and, when required, transmitting fees for processing international design applications; (3) determining compliance with applicable requirements of part 5 of chapter I of Title 37 of the CFR; and (4) transmitting an international design application to the International Bureau, unless prescriptions concerning national security prevent the application from being transmitted.

*Section 1.1003:* Section 1.1003 is proposed to be added to indicate the major functions of the USPTO as a designated office. These include: (1) Accepting for national examination international design applications which satisfy the requirements of the Hague Agreement, Regulations and the regulations; (2) performing an examination of the international design application in accordance with 35 U.S.C. chapter 16; and (3) communicating the results of examination to the International Bureau.

*Section 1.1004:* Section 1.1004 is proposed to be added to indicate the major functions of the International Bureau. These include: (1) Receiving international design applications directly from applicants and indirectly from an office of indirect filing; (2) collecting required fees and crediting designation fees to the accounts of the Contracting Parties concerned; (3) reviewing international design applications for compliance with prescribed formal requirements; (4) translating international design applications into the required languages for recordation and publication; (5) recording international design applications in the International Register; and (6) publishing international design applications in the International Designs Bulletin.

*Section 1.1011:* Section 1.1011(a) is proposed to be added to specify who may file an international design application through the USPTO. Under Article 3, any person that is a national of a State that is a Contracting Party or a State member of an intergovernmental

organization that is a Contracting Party, or that has a domicile, a habitual residence or a real and effective industrial or commercial establishment in the territory of a Contracting Party, shall be entitled to file an international application. Under Article 4(1), the international application may be filed, at the option of the applicant, either directly with the International Bureau or through the Office of the applicant's Contracting Party (*i.e.*, an office of indirect filing). In accordance with Articles 3 and 4(1), § 1.1011(a) specifies that only persons who are nationals of the United States or who have a domicile, a habitual residence or a real and effective industrial or commercial establishment in the territory of the United States may file international design applications through the United States Patent and Trademark Office.

Section 1.1011(b) is proposed to be added to provide that although the USPTO will accept international design applications filed by any person referred to in § 1.1011(a), an international design application designating the United States may be refused by the Office as a designated office if the applicant is not a person qualified under 35 U.S.C. chapter 11 to be an applicant. The PLTIA does not distinguish a person qualified to be an applicant for an international design application designating the United States from a person qualified to be an applicant in a national design application under 35 U.S.C. 171–173. See section 101(a) of the PLTIA, which adds: 35 U.S.C. 389(b) (“All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16.”); 35 U.S.C. 382(c) (“Except as otherwise provided in this chapter, the provisions of chapter 16 shall apply.”); and 35 U.S.C. 383 (“In addition to any requirements pursuant to chapter 16, the international design application shall contain . . .”). 126 Stat. at 1528–30.

*Section 1.1021:* Section 1.1021 is proposed to be added to specify the contents of the international design application.

Section 1.1021(a) specifies the mandatory contents of an international design application. The international design application must be in English, French or Spanish. In addition, the application shall contain or be accompanied by: (1) A request for international registration under the Hague Agreement (Article 5(1)(i)); (2) the prescribed data concerning the

applicant (Article 5(1)(ii) and Rule 7(3)(i) and (ii)); (3) the prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international design application, presented in the prescribed manner, however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with Article 5(5), the international design application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design (Article 5(1)(iii)); (4) an indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed (Article 5(1)(iv) and Rule 7(3)(iv)); (5) an indication of the designated Contracting Parties (Article 5(1)(v)); (6) the prescribed fees (Article 5(1)(vi) and Rule 12(1)); (7) the Contracting Party or Parties in respect of which the applicant fulfills the conditions to be the holder of an international registration (Rule 7(3)(iii)); (8) the number of industrial designs included in the international application, which may not exceed 100, and the number of reproductions or specimens of the industrial designs accompanying the international application (Rule 7(3)(v)); (9) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions (Rule 7(3)(vii)); and (10) an indication of applicant's Contracting Party as required under Rule 7(4)(a).

Section 1.1021(b) sets forth additional mandatory contents that may be required by certain Contracting Parties. These include: (1) Elements referred to in Article 5(2)(b) required for a filing date in the designated Contracting Party for which a declaration was made by that Contracting Party; and (2) a statement, document, oath or declaration required pursuant to Rule 8(1) by a designated Contracting Party. The elements that may be required under Article 5(2)(b) are: (i) Indications concerning the identity of the creator; (ii) a brief description of the reproduction or of the characteristic features of the industrial design; and (iii) a claim.

Section 1.1021(c) identifies optional contents that the international design application may contain. These include: (1) Two or more industrial designs, subject to the prescribed conditions (Article 5(4) and Rule 7(7)); (2) a request

for deferment of publication (Article 5(5) and Rule 7(5)(e)); (3) an element referred to in item (i) or (ii) of Article 5(2)(b) of the Hague Agreement or in Article 8(4)(a) of the 1960 Act even where that element is not required in consequence of a notification in accordance with Article 5(2)(a) of the Hague Agreement or in consequence of a requirement under Article 8(4)(a) of the 1960 Act (Rule 7(5)(a)); (4) the name and address of applicant's representative, as prescribed (Rule 7(5)(b)); (5) a claim of priority under Article 4 of the Paris Convention, as prescribed (Rule 7(5)(c)); (6) a declaration, for purposes of Article 11 of the Paris Convention, that the product or products which constitute the industrial design, or in which the industrial design is incorporated, have been shown at an official or officially recognized international exhibition, together with the place where the exhibition was held and the date on which the product or products were first exhibited there and, where less than all the industrial designs contained in the international application are concerned, the indication of those industrial designs to which the declaration relates or does not relate (Rule 7(5)(d)); (7) any declaration, statement or other relevant indication as may be specified in the Administrative Instructions (Rule 7(5)(f)); (8) a statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned (Rule 7(5)(g)); and (9) a proposed translation of any text matter contained in the international application for purposes of recording and publication (Rule 6(4)).

Section 1.1021(d) is proposed to be added to set forth the required contents for an international design application that designates the United States. Section 1.1021(d) provides that, in addition to the mandatory requirements set forth in § 1.1021(a), an international design application that designates the United States shall contain or be accompanied by: (1) A claim (§§ 1.1021(b)(1)(iii) and 1.1025); (2) indications concerning the identity of the creator (Rule 11(1)); and (3) the inventor's oath or declaration (§§ 1.63 and 1.64). Section 1.1021(d)(3) further provides that the requirements in § 1.63(b) and § 1.64(b)(4) to identify each inventor by his or her legal name, mailing address, and residence, if an inventor lives at a location which is different from the mailing address, and the requirement in § 1.64(b)(2) to identify the residence and mailing address of the person signing the

substitute statement, will be considered satisfied by the presentation of such information in the international design application prior to international registration.

Under Article 5(2), a Contracting Party may require an international design application to contain certain additional elements, where the law of that Contracting Party, at the time it becomes a party to the Hague Agreement, requires the application to contain such elements to be accorded a filing date. The elements set forth in Article 5(2) are: (1) Indications concerning the identity of the creator of the industrial design; (2) a brief description of the reproduction or of the characteristic features of the industrial design; and (3) a claim. Article 5(2) permits a Contracting Party to notify the Director General of the elements required in order for the application to be accorded a filing date.

A claim is a filing date requirement for design applications in the United States. While the PLTIA, in implementing the Patent Law Treaty, eliminates the requirement for a claim as a filing date requirement in utility applications, it does not eliminate the requirement for a claim as a filing date requirement for design applications. See section 202 of the PLTIA amending 35 U.S.C. 171 to provide that "[t]he filing date of an application for patent for design shall be the date on which the specification as prescribed by [35 U.S.C.] 112 and any required drawings are filed." 126 Stat. 1535. The specific wording of the claim shall be as prescribed in § 1.1025. *Id.*

Consequently, an international design application that designates the United States but does not contain a claim will not be registered by the International Bureau in the international register and thus will not be entitled to a filing date in the United States. See 35 U.S.C. 384 and Article 10(2). In such case, the International Bureau will invite the applicant to submit the claim within a prescribed time limit, and will accord a date of international registration as of the date of receipt of the claim (assuming there are no other filing date defects). See Article 10(2)(b). Failure to timely submit the claim in response to the invitation by the International Bureau will result in the application being deemed not to contain the designation of the United States. See Article 8(2)(b).

Section 1.1021(d) also requires an international design application designating the United States to contain indications concerning the identity of the creator of the industrial design and the inventor's oath or declaration

(§§ 1.63 or 1.64). The identity of the creator and the inventor's oath or declaration are requirements applicable to design applications under 35 U.S.C. chapter 16. *See, e.g.*, 35 U.S.C. 115 and 35 U.S.C. 101. The PLTIA provides for parity in the treatment of international design applications designating the United States with design applications under 35 U.S.C. chapter 16, except where otherwise provided by the PLTIA, Hague Agreement, or Regulations. *See, e.g.*, 35 U.S.C. 389(b) ("All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16."); 35 U.S.C. 382(c) ("Except as otherwise provided in this chapter, the provisions of chapter 16 shall apply."); and 35 U.S.C. 383 ("In addition to any requirements pursuant to chapter 16, the international design application shall contain . . ."). 126 Stat. at 1528–30. *See also* discussion of Hague Agreement Rule 8, *supra*.

**Section 1.1022:** Section 1.1022 is proposed to be added to specify form and signature requirements for international design applications. Section 1.1022(a) provides that the international design application shall be presented on the official form or any form having the same contents and format. *See* Rules 7(1) and 1(vi). Section 1.1022(b) provides that the international design application shall be signed by the applicant. *Id.*

**Section 1.1023:** The filing date of an international design application in the United States is set forth in 35 U.S.C. 384, added by section 101 of the PLTIA, which provides "[s]ubject to subsection (b), the filing date of an international design application in the United States shall be the effective registration date." 126 Stat. at 1529. The term "effective registration date" is defined in 35 U.S.C. 381(a)(5) as "the date of international registration determined by the International Bureau under the treaty." 126 Stat. at 1528. Accordingly, § 1.1023(a) is proposed to be added to set forth that the filing date of an international design application in the United States is the date of international registration determined by the International Bureau, subject to review under subsection (b).

Section 1.1023(b) is proposed to be added to set forth a procedure to review the filing date of an international design application. Pursuant to 35 U.S.C. 384(b), "[t]he Director may establish procedures, including the payment of a surcharge, to review the filing date

under this section. Such review may result in a determination that the application has a filing date in the United States other than the effective registration date." 126 Stat. at 1529. Accordingly, § 1.1023(b) provides that where the applicant believes the international design application is entitled under the Hague Agreement to a filing date in the United States other than the date of international registration, the applicant may petition the Director to accord the international design application a filing date in the United States other than the date of international registration. Section 1.1023(b) requires that the petition be accompanied by the fee set forth in § 1.17(f) and include a showing to the satisfaction of the Director that the international design application is entitled to such filing date.

**Section 1.1024:** Section 1.1024 is proposed to be added to set forth the requirements of a description, where contained in the international design application. WIPO form "Application for International Registration" (DM/1) includes a section (Box 9) entitled "Description." Rule 11(2) provides: "[w]here the international application contains a description, the latter shall concern those features that appear in the reproductions of the industrial design and may not concern technical features of the operation of the industrial design or its possible utilization. If the description exceeds 100 words, an additional fee, as set out in the Schedule of Fees, shall be payable." Pursuant to Article 5(2), a Contracting Party may require "a brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application" where such is a filing date requirement under its national law. *See* Article 5(2)(b)(ii). Rule 7(5)(a) allows the applicant to include in the international design application the description referred to in Article 5(2)(b)(ii) even if not required by a Contracting Party pursuant to Article 5(2).

At the time the United States becomes party to the Hague Agreement, the requirements for a filing date for an application for design patent will be governed by 35 U.S.C. 171, as amended under Section 202 of the PLTIA, which states in subsection (c): "[t]he filing date of an application for patent for design shall be the date on which the specification as prescribed by [35 U.S.C.] 112 and any required drawings are filed." 126 Stat. 1535. A "brief description of the reproduction or of the characteristic features of the international design" is not a *per se* filing date requirement in the United

States. Rather, 35 U.S.C. 112(a) requires, *inter alia*, that the "specification shall contain a written description of the invention." This requirement may be satisfied by the reproductions. *See In re Daniels*, 144 F.3d 1452, 1456, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998) ("It is the drawings of the design patent that provide the description of the invention."); *In re Klein*, 987 F.2d 1569, 1571, 26 USPQ2d 1133, 1134 (Fed. Cir. 1993) ("[U]sual[ly] in design applications, there is no description other than the drawings"); *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1464, 43 USPQ2d 1887, 1893 (Fed. Cir. 1997) ("A design patent contains no written description; the drawings are the claims to the patented subject matter."); *Ex parte Tayama*, 24 USPQ2d 1614, 1617 (Bd. Pat. App. & Int'f 1992) ("[D]esign applications must meet the requirements of 35 U.S.C. 112, first paragraph. While this *ordinarily* requires little if any detailed description, some design applications may require a disclosure as detailed as that in a complex utility application. There is no 'per se' rule with respect to the extent of the disclosure necessary in a design application. The adequacy of the disclosure must be determined on a case-by-case basis."). Nevertheless, applicants should consider whether including additional written description of the invention (in Box 9 of the DM/1 form or otherwise) is needed to comply with 35 U.S.C. 112. Furthermore, the Office encourages the inclusion of a brief description of the views of the reproduction, as required for design applications filed under 35 U.S.C. chapter 16. *See, e.g.*, § 1.153(b) ("No description, other than a reference to the drawing, is ordinarily required . . ."); § 1.154(b) ("The specification should include . . . 4) Description of the figure or figures of the drawing"); and MPEP 1503.01, II ("Descriptions of the figures are not required to be written in any particular format, however, if they do not describe the views of the drawing clearly and accurately, the examiner should object to the unclear and/or inaccurate descriptions and suggest language which is more clearly descriptive of the views."). Such figure descriptions are helpful for examination and may, in some cases, avoid potential issues under 35 U.S.C. 112.

Thus, § 1.1024(a) is proposed to be added to provide that an international design application designating the United States must include a specification as prescribed by 35 U.S.C. 112, and preferably include a brief description of the view or views of the reproduction.

Section 1.1024(b) provides that the description requirements set forth in Rule 11(2) may apply to designations of Contracting Parties other than the United States that require a description. Applicants are cautioned that a characteristic features statement may serve to later limit the claim in the United States. *See McGrady v. Aspenglas Corp.*, 487 F. Supp. 859, 208 U.S.P.Q. 242 (S.D.N.Y. 1980); MPEP 1503.01.

**Section 1.1025:** Section 1.1025 is proposed to be added to set forth that the specific wording of the claim in an international design application designating the United States shall be in formal terms to the ornamental design for the article (specifying name of article) as shown, or as shown and described. Section 1.1025 also provides that more than one claim is neither required nor permitted for purposes of the United States. Under Rule 11(3), a declaration requiring a claim pursuant to Article 5(2) “shall specify the exact wording of the required claim.”

**Section 1.1026:** Section 1.1026 is proposed to be added to provide that reproductions shall comply with the requirements of Rule 9 and Part Four of the Administrative Instructions. Rule 9 sets forth the requirements for reproductions in international design applications, including the form and number of reproductions, and references the requirements of the Administrative Instructions. Part Four of the Administrative Instructions sets forth requirements concerning the presentation of the reproductions (Section 401), representation of the industrial design (Section 402), disclaimer (Section 403), requirements for photographs and other graphic representations (Section 404), numbering of reproductions (Section 405), requirements for specimens (Section 406), and relation with a principal industrial design or a principal application or registration (Section 407).

**Section 1.1027:** Section 1.1027 provides that where a request for deferment of publication has been filed in respect of a two-dimensional industrial design, the international design application may include specimens of the design in accordance with Rule 10 and Part Four of the Administrative Instructions. Section 1.1027 further provides that neither a request for deferment of publication nor specimens are permitted in an international design application that designates the United States or any other Contracting Party that does not permit deferment of publication. Under the Hague Agreement, specimens are

only permitted where a request for deferment of publication has been made. *See* Article 5(1)(iii) and Rule 10(1). However, a request for deferment of publication is not permitted in an international design application that designates a Contracting Party that has made a declaration under Article 11(1)(b) that its applicable law does not provide for deferment of publication. *See* Article 11(3).

**Section 1.1031:** Section 1.1031 is proposed to be added to provide for payment of the international design application fees.

Section 1.1031(a) provides that international design applications filed through the Office as an office of indirect filing are subject to payment of a transmittal fee in the amount of \$130. Under the Hague Agreement, an office of indirect filing may require payment of a transmittal fee. *See* Article 4(2). Section 101(a) of the PLTIA adds 35 U.S.C. 382(b), which provides that the international design application and international fees shall be forwarded by the Office to the International Bureau “upon payment of a transmittal fee.” 126 Stat. at 1528. Accordingly, § 1.1031(a) provides for the payment of a transmittal fee. The transmittal fee is not being set pursuant to section 10(a) of the AIA. Rather, the Office is setting this fee pursuant to its authority under 35 U.S.C. 41(d)(2) in this rulemaking, which provides that fees for all processing, services, or materials relating to patents not specified in 35 U.S.C. 41 are to be set at amounts to recover the estimated average cost to the Office of such processing, services, or materials. *See* 35 U.S.C. 41(d)(2).

The transmittal fee for an international design application filed under the Hague Agreement through the USPTO as an office of indirect filing involves the following activities, which the Office considered in estimating the fiscal year 2012 costs: (1) Processing incoming paper (\$2); (2) processing application fees (\$7); (3) application indexing/scanning (\$65); (4) routing classification/security screening (\$4); (5) second-level security screening and licensing and review processing (\$1); (6) initial bibliographic data entry (\$17); (7) copying and mailing (\$9); (8) performing processing section functions (\$11); and (9) performing Hague file maintenance (\$2).

Applying the ABI methodology discussed above, the Office has thus estimated the fiscal year 2012 unit cost to transmit an international design application and international fees to the International Bureau as the sum total of the aforementioned activities, resulting in a total unit cost of \$118. Using the

estimated CPI-U increase for fiscal years 2013, 2014 and 2015, the Office estimates the fiscal year 2015 unit cost to transmit the international design application and the international fees to the International Bureau is \$126 (\$118 multiplied by 1.066), which, when rounded to the nearest ten dollars, is a proposed fee for transmittal of \$130. Additional information concerning the Office’s analysis of the estimated fiscal year 2012 costs for receiving and transmitting international design applications and international fees to the International Bureau is available upon request.

Section 1.1031(b) provides that the Schedule of Fees, a list of individual designation fee amounts, and a fee calculator may be viewed on the Web site of the WIPO, available at: <http://www.wipo.int/hague>. Under the Hague Agreement, the International Bureau is responsible for collecting the required fees set forth in the Schedule of Fees annexed to the Regulations (Rule 27(1)) and the individual designation fees referred to in Rule 12(1)(a)(iii). Where the required fees have not been paid, the International Bureau will invite the applicant to pay the required fees to avoid abandonment of the application. *See* Article 8 and Rule 14. The fees set forth in the Schedule of Fees and the list of individual designation fee amounts may be viewed on the Web site of the WIPO, available at: <http://www.wipo.int/hague>. This Web site also includes a fee calculator tool to assist applicants in calculating the total amount of fees for filing an international design application.

Section 1.1031(c) provides that the following fees required by the International Bureau may be paid either directly to the International Bureau or through the Office as an office of indirect filing in the amounts specified on the WIPO Web site described in § 1.1031(b): (1) The international application fees (Rule 12(1)); and (2) the fee for descriptions exceeding 100 words (Rule 11(2)). The fees referred to in Hague Agreement Rule 12(1) include a basic fee, standard designation fees, individual designation fees, and a publication fee. Rule 12(3)(b) states that the Rule 12(1) reference to individual designation fees is construed as a reference to only the first part of the individual designation fee for any Contracting Party with a designation fee comprised of two parts.

Section 1.1031(d) provides that the fees referred to in § 1.1031(c) may be paid directly to the International Bureau in Swiss currency. *See* Rule 27(2)(a). Administrative Instructions to the Hague Agreement set forth the various

modes of payment accepted by the International Bureau. *See* Administrative Instruction 801. These include: (1) Payment by debit through an account established with the International Bureau; (2) payment into the Swiss postal check account or any of the specified bank accounts of the International Bureau; or (3) payment by credit card.

Section 1.1031(d) also provides for payment of the fees referred to in § 1.1031(c) through the Office as an office of indirect filing, provided such fees are paid no later than the date of payment of the transmittal fee required under § 1.1031(a). Any payment through the Office must be in U.S. dollars. Section 1.1031(d) also provides that applicants paying fees through the Office may be subject to a requirement by the International Bureau to pay additional amounts where the conversion from U.S. dollars to Swiss currency results in the International Bureau receiving less than the prescribed amounts. Under Rule 28(1), “[a]ll payments made under these Regulations to the International Bureau shall be in Swiss currency irrespective of the fact that, where the fees are paid through an Office, such Office may have collected those fees in another currency.” Consequently, the fees collected by the Office for forwarding to the International Bureau must be converted to Swiss currency. If the converted amount at the time the Office transfers the fees to the International Bureau in Swiss currency is less than the amount required by the International Bureau, the International Bureau may invite the applicant to pay the deficiency. Any payment in response to the invitation must be made directly to the International Bureau within the period set in the invitation.

The proposed rules do not provide for a fee for renewing an international registration with respect to the United States. Article 7 provides for a designation fee for each designated Contracting Party. Article 7(1) provides for a “prescribed” designation fee (also referred to as “standard” designation fee, *see* Rule 11). However, Article 7(2) allows a Contracting Party to make a declaration replacing the prescribed designation fee with an individual designation fee “in connection with any international application in which it is designated, and in connection with the renewal of any international registration resulting from such an international application.” Pursuant to Article 7(2), the amount of the individual designation fee may be fixed by the Contracting Party “for the initial term of protection and for each term of renewal

or for the maximum period of protection allowed by the Contracting Party concerned.” Article 7(2) further provides that the individual designation fee may not be higher than the equivalent of the amount which the office of a Contracting Party would be entitled to receive for a grant of protection for an equivalent period to the same number of designs.

Thus, while Article 7(2) permits a Contracting Party to fix an individual designation fee for renewing an international registration in respect of that Contracting Party, it does not require such fee. Rather, the individual designation fee fixed by the Contracting Party may be for the maximum period of protection allowed by the Contracting Party. Furthermore, the PLTIA does not require payment of a fee for renewing an international registration with respect to the United States. In addition, the PLTIA does not require renewal of the international registration to obtain the maximum period of protection in the United States. *See, e.g.*, 35 U.S.C. 173 as amended by the PLTIA, 126 Stat. at 1532 (“Patents for designs shall be granted for the term of 15 years from the date of grant.”). Accordingly, the proposed rules do not provide a fee for renewing an international design application with respect to the United States.

The Office notes that Article 17(3) provides that any extension of the initial five-year term of protection accorded by an international registration is subject to renewal. However, the Hague Agreement allows a Contracting Party to provide greater protection under its national law than provided under the Hague Agreement. *See* Article 2(1) (“The provisions of this Act shall not affect the application of any greater protection which may be accorded by the law of a Contracting Party . . .”). Furthermore, the records of the diplomatic conference adopting the Hague Agreement make clear that renewal of the international registration for a designated Contracting Party that requires payment of a single designation fee for the entire 15-year (or more) period of protection is not required to obtain the full period of protection in that Contracting Party. *See WIPO Records of the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Design (Geneva Act) June 16 to July 6, 1999*, 254, ¶ 15.08 (2002), discussing Article 15 of the Basic Proposal presented to the diplomatic conference which, after minor amendment, became Article 17 (“It would be compatible with paragraphs (1) to (3) for a

Contracting Party to stipulate a single 15-year (or more) period and to require payment of an initial individual designation fee for the whole period. In such case, protection would be maintained in its territory for that whole period, whether the international registration were renewed or not.”).

*Section 1.1035:* Section 1.1035(a) is proposed to be added to provide, in accordance with Article 6 of the Hague Agreement, that the international design application may claim, under Article 4 of the Paris Convention, the priority of one or more earlier applications filed in or for any country party to that Convention or any Member of the World Trade Organization. Proposed § 1.1035(a) further provides, in accordance with Rule 7(5)(c), that the priority claim must contain an indication of the name of the office where such filing was made and of the date and, where available, the number of that filing, and where the priority claim relates to less than all the industrial designs contained in the international design application, the indication of those industrial designs to which the priority claim relates or does not relate.

While Article 6 of the Hague Agreement provides for priority under the Paris Convention, the Hague Agreement does not specifically provide for domestic benefit claims. Section 101(a) of the PLTIA adds 35 U.S.C. 386(c) to specifically provide for the benefit in accordance with the conditions and requirements of 35 U.S.C. 120 of the filing date of a prior national application, a prior international application as defined in 35 U.S.C. 351(c) designating the United States, or a prior international design application designating the United States. 126 Stat. at 1529–30. Accordingly, § 1.1035(b) is proposed to be added to provide that an international design application designating the United States may claim benefit under 35 U.S.C. 120, 121, 365(c) or 386(c) to an earlier filed application in accordance with § 1.78. It is noted that § 1.78 requires the domestic benefit claim to be included in an application data sheet (“ADS”), and that the Hague Agreement does not provide for submission of an ADS as an optional content item of the international design application. *See* Rules 7(5) and 7(6). Notwithstanding, if the ADS is included with the submission of the international design application to the Office as an indirect office, the ADS will be included in the national application file maintained by the Office as a designated office, and accordingly, will not have to

be submitted again. *See* discussion of § 1.14(j).

*Section 1.1041:* Section 1.1041 is proposed to be added to cover representation in an international design application.

Section 1.1041(a) provides that the applicant or the holder may appoint a representative before the International Bureau in accordance with Rule 3. With respect to who may be appointed to represent the applicant before the International Bureau, the Hague Agreement does not provide for any requirement as to professional qualification, nationality or domicile. The appointment may be made in the international design application or in a separate communication. *See* Rule 3(2).

Requirements as to the appointment of a representative before the office of a Contracting Party are outside the scope of the Hague Agreement, and are exclusively a matter for the Contracting Party. Accordingly, § 1.1041(b) is proposed to be added to provide that applicants of international design applications may be represented before the Office as an office of indirect filing by a practitioner registered (§ 11.6) or granted limited recognition (§ 11.9(a) or (b)) to practice before the Office (§ 11.6). Section 1.1041(b) further provides that such practitioner may act pursuant to § 1.34 or be appointed, in writing signed by the applicant, giving the practitioner power to act on behalf of the applicant and specifying the name and registration number or limited recognition number of each practitioner. Section 1.1041(b) also provides that an appointment of a representative made in the international design application pursuant to Rule 3(2) that complies with the requirements of this paragraph will be effective as an appointment before the Office as an office of indirect filing. For purposes of representation before the Office in an international design application that becomes a national application (*see* § 1.9(a)(1)), the regulations governing national applications shall apply. *See* § 1.1061(a).

*Section 1.1045:* Section 1.1045 is proposed to be added to set forth the procedures for transmittal of international design applications to the International Bureau. Section 101(a) of the PLTIA adds 35 U.S.C. 382, which states, in subsection (b): “[s]ubject to chapter 17, international design applications shall be forwarded by the Patent and Trademark Office to the International Bureau, upon payment of a transmittal fee.” 126 Stat. at 1528. Rule 13(1) requires an office of indirect filing to notify the applicant and the International Bureau of the receipt date

of an international design application, and to notify the applicant that the international design application has been transmitted to the International Bureau. Accordingly, § 1.1045(a) is proposed to be added to provide that, subject to § 1.1045(b) and payment of the transmittal fee set forth in § 1.1031(a), transmittal of the international design application to the International Bureau shall be made by the Office as provided by Rule 13(1). Section 1.1045(a) further provides that at the same time as it transmits the international design application to the International Bureau, the Office shall notify the International Bureau of the date on which it received the application, and that the Office shall also notify the applicant of the date on which it received the international design application and the date on which it transmitted the application to the International Bureau.

Because transmittal of the international design application is subject to 35 U.S.C. chapter 17, § 1.1045(b) is proposed to be added to provide that no copy of an international design application may be transmitted to the International Bureau, a foreign designated office, or other foreign authority by the Office or the applicant, unless the applicable requirements of part 5 of this chapter have been satisfied.

Under the Hague Agreement, formalities review of the international design application is performed by the International Bureau, not the office of indirect filing. The functions of the office of indirect filing are *de minimis*, *i.e.*, receiving and transmitting the international design application and international fees. There is no provision in the Hague Agreement for filing follow-on submissions with the office of indirect filing. Accordingly, § 1.1045(c) is proposed to be added to provide that once transmittal of the international design application has been effected, except for matters properly before the USPTO as an office of indirect filing or as a designated office, all further correspondence concerning the application should be sent directly to the International Bureau, and that the Office will generally not forward communications to the International Bureau received after transmittal of the application to the International Bureau. Section 1.1045(c) further provides that any reply to an invitation sent to the applicant by the International Bureau must be filed directly with the International Bureau, and not with the Office, to avoid abandonment or other loss of rights under Article 8.

*Section 1.1051:* Section 1.1051 is proposed to be added to set forth conditions under which an applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international design application may be excused as to the United States upon a showing of unintentional delay. Section 101(a) of the PLTIA adds 35 U.S.C. 387, which gives the Director authority to prescribe such conditions, including the payment of the fee specified in 35 U.S.C. 41(a)(7), to excuse an applicant's failure to act within prescribed time limits in an international design application as to the United States where the delay was unintentional. 126 Stat. at 1530; *see* discussion of § 1.17(u), *supra*. Under proposed § 1.1051(a), a petition to excuse applicant's failure to act within the prescribed time limits must be accompanied by: (1) A copy of any invitation sent from the International Bureau setting a prescribed time limit for which applicant failed to timely act; (2) the reply required under § 1.1051(c), unless previously filed; (3) the fee as set forth in § 1.17(u); (4) a certified copy of the originally filed international design application, unless a copy of the international design application was previously communicated to the Office from the International Bureau or the international design application was filed with the Office as an office of indirect filing; and (5) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The requirements for a copy of the invitation sent from the International Bureau setting a prescribed time limit for which applicant failed to timely act, and for a certified copy of the originally filed international design application (unless a copy of the international design application was previously communicated to the Office from the International Bureau or the international design application was filed with the Office as an office of indirect filing) are needed because the Office may not have a record of the international design application. For example, the Office may not have a record where the international design application was filed directly with the International Bureau and was not published.

Section 1.1051(b) provides that any request for reconsideration or review of a decision refusing to excuse the applicant's failure to act within prescribed time limits in connection



with requirements pertaining to an international design application upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to excuse or within such time as set in the decision. Section 1.1051(b) further provides that, unless a decision indicates otherwise, the two-month time period may be extended under the provisions of § 1.136.

Section 1.1051(c) provides that the reply required may be: (1) The filing of a continuing application and, if the international design application has not been subject to international registration, a grantable petition under § 1.1023(b) to accord the international design application a filing date; or (2) a grantable petition under § 1.1052, where the international design application was filed with the Office as an office of indirect filing.

Under the Hague Agreement, the International Bureau reviews international design applications for compliance with the requirements of the treaty and Regulations. If these requirements have not been met, the International Bureau will invite the applicant to make the required corrections. *See* Hague Agreement Article 8(1). Depending on the correction required, failure to timely comply with the invitation will result in the application being considered abandoned or deemed not to contain the designation of the Contracting Party for which the deficiency relates. *See* Hague Agreement Article 8(2). The Hague Agreement does not provide for continued processing of an international design application that has been abandoned under Article 8 (or for processing the application for a particular Contracting Party after the designation of that Contracting Party has been deemed not to be contained in the application), based on the Office excusing applicant's failure to timely comply with the invitation pursuant to 35 U.S.C. 387. For example, the Hague Agreement does not provide for forwarding by the International Bureau to the applicant of a notification of refusal in an abandoned international application. Accordingly, the Office is proposing to provide relief under 35 U.S.C. 387 by permitting the applicant to file a continuing application claiming benefit to an international design application under the conditions of 35 U.S.C. 386(c) and 120. Upon grant of the petition under this section, applicant's delay will be excused for the purpose of establishing dependency or reinstatement of the U.S. designation in accordance with 35 U.S.C. 120, 386(c) and 388. The ability to file a continuing

application is similarly provided in the rule governing the procedure for revival of an abandoned national application. *See* 37 CFR 1.137(c). Alternatively, § 1.1051(c) provides that the reply may be a grantable petition under § 1.1052 to convert the international design application to an application under 35 U.S.C. chapter 16.

*Section 1.1052:* Section 1.1052 is proposed to be added to set forth a procedure for converting an international design application designating the United States to a design application under 35 U.S.C. chapter 16. Section 101(a) of the PLTIA adds 35 U.S.C. 384(a), the second sentence of which provides: "[n]otwithstanding the provisions of this part, any international design application designating the United States that otherwise meets the requirements of chapter 16 may be treated as a design application under chapter 16." 126 Stat. at 1529. The requirements for a filing date for a design application under 35 U.S.C. chapter 16 are set forth in § 1.53(b). Accordingly, § 1.1052(a) provides that an international design application designating the United States filed with the Office as an office of indirect filing and meeting the requirements under § 1.53(b) for a filing date for an application for a design patent may, on petition under this section, be converted to an application for a design patent under § 1.53(b) and accorded a filing date as provided therein.

Section 1.1052(a) further provides that the petition must be accompanied by the fee set forth in § 1.17(v) and be filed prior to publication of the international registration under Article 10(3). The requirement that a grantable petition be filed prior to publication under Article 10(3) is necessary in view of the timing requirements under the Hague Agreement to issue a notification of refusal and to avoid expending Office resources processing and examining the application under two different statutory schemes.

Section 1.1052(a) also provides that the conversion of an international design application to an application for a design patent under § 1.53(b) will not entitle applicant to a refund of the transmittal fee or any fee forwarded to the International Bureau, or the application of any such fee toward the filing fee, or any other fee, for the application for a design patent under § 1.53(b). In addition, § 1.1052(a) provides that the application for a design patent resulting from conversion of an international design application must also include the basic filing fee (§ 1.16(b)), the search fee (§ 1.16(l)), the examination fee (§ 1.16(p)), the

inventor's oath or declaration (§§ 1.63 or 1.64), and a surcharge if required by § 1.16(f). These provisions are similar to those applicable to converting an application under 35 U.S.C. 111(b) to an application under 35 U.S.C. 111(a). *See* § 1.53(c)(3).

Section 1.1052(b) provides that an international design application will be treated as an application for a design patent under § 1.53(b) if a decision on petition under this section is granted prior to transmittal of the international design application to the International Bureau pursuant to § 1.1045. Otherwise, a decision granting a petition under this section will be effective to treat the international design application as an application for a design patent under § 1.53(b) only for purposes of the United States. Thus, pursuant to § 1.1052(b), if the Office grants the petition prior to transmittal of the international design application to the International Bureau, the Office will treat the international design application submission as an application for a design patent under § 1.53(b). Once transmittal of the application under § 1.1045 has occurred, the grant of the petition will only be effective as to the United States, and the International Bureau will continue to process the international design application under the provisions of the Hague Agreement.

Section 1.1052(c) provides that a petition under § 1.1052 will not be granted in an abandoned international design application absent a grantable petition under § 1.1051.

Sections 1.1061–1.1070 relate to national processing of an international design application designating the United States.

*Section 1.1061:* Section 1.1061(a) is proposed to be added to provide that the rules relating to applications for patents for other inventions or discoveries are also applicable to international design applications designating the United States, except as otherwise provided in chapter I of Title 37 of the CFR or required by the Articles or Regulations. Section 1.1061(a) is similar to current § 1.151 with respect to design applications under 35 U.S.C. chapter 16 ("The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided."). Section 101(a) of the PLTIA adds 35 U.S.C. 389(b) to provide that all questions of procedures regarding international design applications designating the United States shall be determined as in the case of applications filed under 35 U.S.C. chapter 16, except where otherwise required by the Hague

Agreement and the Regulations (126 Stat. at 1530). Section 1.1061(b) is proposed to be added to identify, consistent with the Hague Agreement and the Regulations, certain regulations that do not apply to international design applications.

*Section 1.1062:* Section 1.1062(a) is proposed to be added to provide that the Office shall make an examination pursuant to Title 35 of the United States Code of an international design application designating the United States. Examination of international design applications designating the United States is mandated by 35 U.S.C. 389(a), which was added by section 101(a) of the PLTIA (126 Stat. at 1530).

Section 1.1062(a) further provides, in accordance with Article 12(1), that an international design application may not be refused on grounds that requirements relating to the form or contents of the international design application provided for in the Hague Agreement or the Regulations or additional to, or different from, those requirements have not been satisfied.

Section 1.1062(b) concerns the timing of certain actions in international design applications. Pursuant to Hague Agreement Article 12, where the conditions for the grant of protection under the law of the Contracting Party are not met, a notification of refusal of the effects of international registration must be communicated to the International Bureau within the prescribed period. Rule 18(1) sets forth the period for communicating the notification of refusal. While Rule 18(1)(a) sets forth the prescribed period as six months from the date of publication, this period may be extended by a Contracting Party pursuant to a declaration made under Rule 18(1)(b) (extending the six-month period to twelve months). Furthermore, the declaration under Rule 18(1)(b) may also include, *inter alia*, a statement under Rule 18(1)(c)(ii) (providing for the later communication of a decision regarding the grant of protection where a decision regarding the grant of protection was unintentionally delayed by the office of the Contracting Party). Section 1.1062(b) is proposed to be added to provide that for each international design application to be examined, the Office shall, subject to Rule 18(1)(c)(ii), send to the International Bureau within 12 months from the publication of the international registration under Rule 26(3) a notification of refusal (§ 1.1063) where it appears that the applicant is not entitled to a patent under the law with respect to any industrial design that is the subject of the international registration.

The Office intends to send all notifications of refusal prior to the expiration of the 12-month period set forth in § 1.1062(b). Any failure by the Office to do so would be unintentional pursuant to Rule 18(1)(c)(ii).

The Office does not regard the failure to send the notification of refusal within the period referenced in § 1.1062(b) to confer patent rights or other effect under Article 14(2). The Hague Agreement is not self-executing, and the PLTIA provides for patent rights only upon issuance of a patent. *See* 35 U.S.C. 389(d) added by the PLTIA, 126 Stat. at 1531; *see also* S. Exec. Rep. No. 110–7, at 5 (“The proposed Act makes no substantive changes in U.S. design patent law with the exception of the following: the provision of limited rights to patent applicants between the date that their international design application is published by the IB and the date on which they are granted a U.S. patent based on that application; the extension of a patent term for designs from fourteen to fifteen years from grant; and allowing the USPTO to use a published international design registration as a basis for rejecting a subsequently filed national patent application that is directed at the same or a similar subject matter.”). Furthermore, the PLTIA requires an international design application that designates the United States to be examined by the Office pursuant to Title 35 of the United States Code. *See* 35 U.S.C. 389(a). Granting of patent rights without examination is inconsistent with 35 U.S.C. 389(a). The absence of a notification of refusal is not a patent. *See* 35 U.S.C. 153 (“Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon and shall be recorded in the Patent and Trademark Office.”).

*Section 1.1063:* Section 1.1063(a) is proposed to be added to provide, in accordance with Rule 18(2), that a notification of refusal shall contain or indicate: (1) The number of the international registration; (2) the grounds on which the refusal is based; (3) where the grounds of refusal refer to similarity with an industrial design that is the subject of an earlier application or registration, a copy of a reproduction of the earlier industrial design and information concerning the earlier industrial design as required under Rule 18(2)(b)(iv); and (4) a time period for reply to the notification under § 1.134 and § 1.136 to avoid abandonment.

Pursuant to Article 12, the Office communicates the notification of refusal

directly to the International Bureau, which then transmits without delay a copy of the notification of refusal to the holder. Rule 18(2)(vi) provides that the notification of refusal shall indicate whether the refusal is subject to review or appeal, and if so, the time limit for requesting review or appeal.

Accordingly, the notification of refusal communicated by the Office will set a time period for reply under § 1.134 and § 1.136 to avoid abandonment.

Section 1.1063(b) is proposed to be added to provide that any reply to the notification of refusal must be filed directly with the Office and not through the International Bureau. Section 1.1063(b) further provides that the requirements of § 1.111 shall apply to a reply to a notification of refusal.

Under the Hague Agreement, any reply to the notification of refusal must be filed directly with the Office. The applicant may not file a reply to a notification of refusal through the International Bureau. Any further correspondence from the Office will normally be sent directly to the applicant. The procedures applicable to design applications under chapter 16 are generally applicable to international design applications after communication of the notification of refusal. *See* Article 12(3)(b) and 35 U.S.C. 389(b); *see also* WIPO, *Guide to the International Registration of Industrial Designs Under the Hague Agreement*, B.I.L.39, ¶ 9.23 (Jan. 2012) (“Where the holder of an international registration receives, through the International Bureau, a notification of refusal, he has the same rights and remedies (such as review of, or appeal against, the refusal) as if the industrial design had been filed directly with the Office that issued the notification of refusal. The international registration is, therefore, with respect to the Contracting Party concerned, subject to the same procedures as would apply to an application for registration filed with the Office of that Contracting Party.”). Thus, for example, the provisions of 35 U.S.C. 133 and §§ 1.134 through 1.136 govern the time to reply to an Office action, including a notification of refusal, and the consequence for failure to timely reply (*i.e.*, abandonment).

Because the procedures following the notification of refusal are governed by national practice, the failure of an applicant to renew an international registration pursuant to Article 17(2) does not affect the pendency status of an international design application before the Office. Otherwise, applicants in international design applications would not have the same rights and remedies as applicants in national design

applications, as required under Article 12(3)(b) and 35 U.S.C. 389. Similarly, the failure to renew a registration under Article 17(2) does not impact an applicant's ability to file a continuing application under 35 U.S.C. 120, 121, 365(c) or 386(c), as the critical inquiry under 35 U.S.C. 120 is the presence of copendency.

*Section 1.1064:* Section 1.1064 is proposed to be added to provide for requirements relating to only one independent and distinct design in international design applications.

Article 13 permits a Contracting Party whose law at the time it becomes party to this Act, requires that designs in the application conform to a requirement of unity of design, unity of production or unity of use, or that only one independent and distinct design may be claimed in a single application, to notify the Director General in a declaration. Section 1.1064(a) is proposed to provide that only one independent and distinct design may be claimed in an international design application designating the United States.

Section 1.1064(b) specifies that if the requirements under 1.1064(a) are not satisfied, the examiner shall in the notification of refusal or other Office action require the applicant in the reply to that action to elect one independent and distinct design for which prosecution on the merits shall be restricted. Section 1.1064(b) further specifies that such requirement will normally be made before any action on the merits but may be made at any time before the final action. Review of any such requirement is provided under §§ 1.143 and 1.144. The procedure set forth in 1.1064(b) is analogous to the procedures applicable to national applications. *See* § 1.142.

*Section 1.1066:* Section 1.1066 is proposed to be added to specify the correspondence address for an international design application. Unlike other types of applications before the Office, an applicant does not need to file any further submissions with the Office to initiate examination under § 1.1062 of an international design application designating the United States. Rather, published international design registrations that designate the United States will be systematically received from the International Bureau and examined in due course. Accordingly, § 1.1066(a) is proposed to set forth how the Office will establish the correspondence address for an international design application in the absence of a communication from the applicant changing the correspondence address. Specifically, § 1.1066(a) provides that, unless changed in

accordance with § 1.1066(b), the Office will use as the correspondence address the address of the representative identified in the publication of the international registration, or if there is no address for the representative, the address of the applicant identified therein.

Section 1.1066(b) provides that the correspondence address may be changed by the parties set forth in § 1.33(b)(1) or (b)(3) in accordance with § 1.33(a).

Section 1.1066(c) is proposed to be added to provide that a reference in the rules to the correspondence address set forth in § 1.33(a) shall be construed to include a reference to § 1.1066 for a nonprovisional application that is an international design application.

*Section 1.1067:* Section 1.1067(a) is proposed to be added to provide for a title in an international design application. The Hague Agreement does not require that an international design application contain a title. The Office believes a title that identifies the article in which a design is embodied is helpful to the public in understanding the nature and use of the article embodying the design after the patent has issued. In addition, a U.S. patent must contain a title of the invention. *See* 35 U.S.C. 154(a)(1) ("Every patent shall contain a short title of the invention . . ."). Accordingly, pursuant to § 1.1067(a), the applicant may provide a title of the design that designates the particular article in an international design application that is before the Office for examination. Section 1.1067(a) further provides that where an international design application does not contain a title of the design, the Office may establish a title. In determining the title, the Office may look to the particular article specified in the claim.

Section 1.1067(b) is proposed to be added to provide that if the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136. As explained above, Hague Agreement Rule 8, as recently passed by the Hague Union Assembly, accommodates current U.S. law regarding the inventor's oath or declaration. Where the presence of the required inventor's oath or declaration

is verified by the International Bureau as part of its formalities review, the need to notify the applicant in a notice of allowability to provide the inventor's oath or declaration should be rare; *e.g.*, where an inventor added pursuant to § 1.48(a) has not executed an oath or declaration. *See* § 1.48(b).

*Section 1.1069:* Section 1.1069 is proposed to be added to provide for the sending of a notification of division to the International Bureau. Under Rule 18(3), where an international registration is divided before the office of a designated Contracting Party to overcome a ground of refusal stated in a notification of refusal, the office must notify the International Bureau with data concerning the division as specified in Administrative Instruction 502 ("notification of division"). Accordingly, § 1.1069(a) is proposed to be added to provide for the notification of division required under Rule 18. Section 1.1069(a) provides that where, following a notification of refusal requiring an election of an independent and distinct design, a divisional application claiming benefit under 35 U.S.C. 386(c) and 121 to the international design application is filed for the non-elected design(s), the Office shall notify the International Bureau. Section 1.1069(a) further provides that the notification to the International Bureau shall indicate: (1) The number of the international registration concerned; (2) the numbers of the industrial designs which have been the subject of the division with the Office concerned; and (3) the divisional application number(s).

Section 1.1069(b) is proposed to be added to provide that the Office may require the applicant, in a divisional application that is subject to a notification under § 1.1069(a), to identify the design in the international design application that is the subject of the divisional application. Because an international design application may contain up to 100 designs (*see* Rule 7(3)(v)) and, furthermore, uses a different numbering system for reproductions than is used in design applications filed under 35 U.S.C. chapter 16 (*see* Administrative Instruction 405 of the Hague Agreement), in some cases it may not be readily apparent how the design in the divisional application corresponds to the design of the parent international design application for purposes of the notification of division. Accordingly, in such cases, the Office may seek applicant's assistance to identify the corresponding design pursuant to § 1.1069(b).

*Section 1.1070:* Section 1.1070 is proposed to be added to provide for the

sending of a notification of invalidation to the International Bureau. Article 15 provides that the office of the Contracting Party in whose territory the effects of the international registration have been invalidated shall, where it is aware of the invalidation, notify the International Bureau of the invalidation ("notification of invalidation"). Rule 20 provides that where the effects of an international registration are invalidated in a designated Contracting Party and the invalidation is no longer subject to any review or appeal, the office of the Contracting Party whose competent authority has pronounced the invalidation shall, where it is aware of the invalidation, notify the International Bureau accordingly. Rule 20 further specifies the required contents of the notification of invalidation. In accordance with Article 15 and Rule 20, § 1.1070(a) provides that where a design patent that was granted from an international design application is invalidated in the United States, and the invalidation is no longer subject to any review or appeal, the patentee shall inform the Office. Section 1.1070(b) provides that after receiving a notification of invalidation under § 1.1070(a) or through other means, the Office will notify the International Bureau in accordance with Rule 20.

**Section 3.1:** Section 3.1 is proposed to be amended to include an international design application that designates the United States of America within the definition of "application" for purposes of Part 3 of Title 37 of the CFR. The effect of this definitional change will allow assignments (or other documents affecting title) of international design applications that designate the United States to be submitted to the Office for recording. The proposed change to § 3.1 is in response to 35 U.S.C. 385, added under the PLTIA, which provides that an international design application designating the United States has the effect, for all purposes, of an application for patent filed in the Office pursuant to 35 U.S.C. chapter 16. 126 Stat. at 1529.

**Section 3.21:** Section 3.21 is proposed to be amended to provide that an assignment relating to an international design application that designates the United States must identify the international design application by the international registration number or by the U.S. application number assigned to the international design application.

**Section 5.1:** Section 5.1(b) is proposed to be amended to change the definition of "application" as used in Part 5 of Title 37 of the CFR to include international design applications, and to provide consistency with the definitions in § 1.9. Section 5.1(b) is also proposed

to be amended to include a definition of "foreign application" to permit simplification of other rules contained in Part 5.

**Section 5.3:** Section 5.3(d) is proposed to be amended to clarify that an international design application that is subject to a secrecy order will not be mailed, delivered, or otherwise transmitted to the international authorities or the applicant.

**Section 5.11:** The title of § 5.11 is proposed to be amended to more accurately describe when a foreign filing license is required. Section 5.11(a) is also proposed to be amended to clarify that a foreign filing license is not required to file an international design application in the Office as an office of indirect filing. Sections 5.11(b), (c), (e) and (f) are proposed to be amended to change "foreign patent application" to "foreign application," as the provisions of 35 U.S.C. 184 are not limited to "patent" applications but include other types of applications; e.g., registrations of industrial designs.

**Section 5.12:** Section 5.12 is proposed to be amended for consistency with the definition of application in § 5.1(b), and to indicate that the grant of a foreign filing license may be on an official notice other than the filing receipt; e.g., in the case of international applications filed under the Patent Cooperation Treaty, on the "Notification of the International Application Number and of the International Filing Date" (Form PCT/RO/105).

**Section 5.13:** Section 5.13 is proposed to be amended to provide that a "corresponding" application for purposes of this section may be an international design application.

**Section 5.14:** Section 5.14(c) is proposed to be amended for clarity and internal consistency, as this subsection is directed to an "application to be filed or exported abroad."

**Section 5.15:** Section 5.15(a) is proposed to be amended for consistency with the definition of "application" in 5.1(b) and to remove redundancies.

**Section 11.10:** Section 11.10(b)(3)(iii) is proposed to be amended to include international design application in the definition of patent application for purposes of § 11.10.

### Rulemaking Considerations

**A. Administrative Procedure Act:** This rulemaking implements title I of the PLTIA and the Hague Agreement. The changes proposed in this rulemaking (except for the setting of some fees) establish procedures for the filing, processing, and examination of international design applications and revise existing rules of practice to

account for international design applications in accordance with title I of the PLTIA and to ensure that the rules of practice are consistent with the Hague Agreement. Therefore, the changes proposed in this rulemaking involve rules of agency practice and procedure, and/or interpretive rules. See *Bachow Commc'ns Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals are procedural where they do not change the substantive standard for reviewing claims); *Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive).

Accordingly, prior notice and opportunity for public comment for these proposed changes are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). See *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336–37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for "interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice") (quoting 5 U.S.C. 553(b)(A)). The Office, however, is publishing these proposed changes for comment as it seeks the benefit of the public's views on the Office's proposed implementation of title I of the PLTIA and the Hague Agreement.

**B. Regulatory Flexibility Act:** For the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes proposed in this notice will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b).

The notable changes proposed in this notice are to revise the rules of practice to implement title I of the PLTIA. The changes to the rules of practice proposed in this notice involve: (1) The establishment of procedures for the filing, processing, and examination of international design applications; and (2) the revision of existing rules of practice to account for international design applications. The proposed rules impose no additional required burdens on any applicant, since seeking design protection by filing an international design application is merely an optional alternative to seeking design protection by filing a national design application.

The proposed rules will benefit applicants by streamlining the process for obtaining international protection of an industrial design in Contracting Parties to the Hague Agreement by the filing of a single, standardized international design application in a single language.

As of 2013, there are 60 Contracting Parties that are members to the Hague system. In 2011, the most recent year available, 2,531 international design applications were filed via the Hague system. In that same year, 2,363 international design registrations issued through the Hague system. In comparison, the USPTO received 32,799 design applications in 2012, the most recent year for which data is available. In 2012, the USPTO issued 21,951 design patents. Approximately 49.6% of the design applications filed in 2012 were filed by an entity claiming small entity status. None of the proposed rules disproportionately affect small entities.

The fees and requirements referenced in this proposed rulemaking do not have a significant economic impact because they are comparable to the fees and requirements an applicant has in a national design application. Section 385 requires that an "international design application designating the United States shall have the effect, for all purposes from its filing date . . . of an application for patent filed in the Patent and Trademark Office pursuant to chapter 16." Such fees include an issue fee, if applicable, and paid directly to the USPTO, and a petition fee for review of a filing date.

The USPTO proposes to set only two new fees based on cost recovery, as discussed in further detail in prior sections: A transmittal fee, payable to the USPTO for transmitting the international design application to WIPO when an applicant files the application with the USPTO as an office of indirect filing, and a conversion fee when an applicant seeks to have the Office treat an international design application as a national design application under 35 U.S.C. chapter 16. The transmittal fee is proposed to be set at \$130. The USPTO estimates that approximately 1,000 applications will be filed indirectly with the USPTO annually and will thus require payment of a transmittal fee. Of these, the Office estimates that approximately 500 will be filed by an entity that is a small entity based on USPTO design application filings in 2012. The conversion fee is proposed to be set at \$180. The USPTO estimates that approximately 20 applicants will pay the conversion fee annually, and of these, approximately

10 will be filed by an applicant that is a small entity.

The other fees mentioned in this proposed rulemaking are not USPTO fees at all, but rather, are created through the treaty process and WIPO's Common Regulations. For example, the USPTO does not collect and retain at the time of payment the following fees: WIPO Basic Fee, WIPO Publication Fee, WIPO Extra Word Fee, and Designation Fees (including the United States individual designation fee first part). Thus, the proposed rules referencing non-USPTO fees impose no economic impact upon applicants. The petition fee for excusable delay is set forth by statute, 35 U.S.C. 41(a)(7), as amended by 202(b)(1)(A) of the PLTIA, 126 Stat. 1535, at \$850 for small entities and \$1,700 for all other entities, beginning on December 18, 2013.

For the foregoing reasons, the changes proposed in this notice will not have a significant economic impact on a substantial number of small entities.

*C. Executive Order 12866 (Regulatory Planning and Review):* This rulemaking has been determined to be significant for purposes of Executive Order 12866 (Sept. 30, 1993).

*D. Executive Order 13563 (Improving Regulation and Regulatory Review):* The Office has complied with Executive Order 13563. Specifically, the Office has, to the extent feasible and applicable: (1) Made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

*E. Executive Order 13132 (Federalism):* This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

*F. Executive Order 13175 (Tribal Consultation):* This rulemaking will not: (1) Have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

*G. Executive Order 13211 (Energy Effects):* This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

*H. Executive Order 12988 (Civil Justice Reform):* This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

*I. Executive Order 13045 (Protection of Children):* This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

*J. Executive Order 12630 (Taking of Private Property):* This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

*K. Congressional Review Act:* Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq.*), prior to issuing any final rule, the United States Patent and Trademark Office will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this notice are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this notice is not expected to result in a "major rule" as defined in 5 U.S.C. 804(2).

*L. Unfunded Mandates Reform Act of 1995:* The changes set forth in this notice do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local,

and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. *See* 2 U.S.C. 1501 *et seq.*

*M. National Environmental Policy Act:* This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. *See* 42 U.S.C. 4321 *et seq.*

*N. National Technology Transfer and Advancement Act:* The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions that involve the use of technical standards.

*O. Paperwork Reduction Act:* The Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This rulemaking involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501–3549). New information will be collected and a new information collection request to authorize the collection of new information involved in this notice is being submitted to OMB under the title “Hague Agreement.” The proposed collection will be available at the OMB’s Information Collection Review Web site ([www.reginfo.gov/public/do/PRAMain](http://www.reginfo.gov/public/do/PRAMain)).

The Office is submitting the information collection to OMB for its review and approval because this notice of proposed rulemaking will add the following to a collection of information for an international design application filed through the Office:

- (1) Application for International Registration (§ 1.1022)
- (2) Claim and Reproductions (§ 1.1021)
- (3) Transmittal Letter (§§ 1.4, 1.5)
- (4) Appointment of a Representative (§ 1.1041)
- (5) Petition to Excuse a Failure to Comply with a Time Limit (§ 1.1051)
- (6) Petition to Convert to a Design Application under 35 U.S.C. chapter 16 (§ 1.1052)
- (7) Petition to Review a Filing Date (§ 1.1023(b))

- (8) Fee Authorization (§ 1.25)
- (9) Petition to the Commissioner (§§ 1.181, 182, and 183)

### I. Summary

The Patent Law Treaties Implementation Act of 2012 (PLTIA) amends the patent laws to implement the provisions of the Geneva Act of the Hague Agreement Concerning International Registration of Industrial Designs (Hague Agreement) in title I, and the Patent Law Treaty (PLT) in title II. The Hague Agreement facilitates intellectual property protection for industrial designs by creators in member countries and intergovernmental organizations that are Contracting Parties to the Hague Agreement through a single standardized application filed directly with the International Bureau (IB) of the World Intellectual Property Organization (WIPO) or indirectly through an appropriate Contracting Party’s Office, such as the United States Patent and Trademark Office. It is administered by the IB of WIPO located in Geneva, Switzerland.

Thus, under the Hague Agreement, a U.S. design applicant could file an international design application in English with the USPTO, which will forward the application to the IB. The industrial design may be eligible for protection both domestically and abroad in all Contracting Parties to the Agreement.

The IB ascertains whether the international design application complies with formal requirements, records the international design application in the international register, and publishes the international registration in the International Designs Bulletin. The international registration contains all of the data of the international application, any reproduction of the industrial design, date of the international registration, number of the international registration, and relevant class of the International Classification.

The IB will provide a copy of the publication of the international registration to each Contracting Party designated by the applicant. A designated Contracting Party may perform a substantive examination of the design application. If designated, the Office will perform a substantive examination of patentability of the international design application, as in the case of a regular design application filed under 35 U.S.C. chapter 16.

The Hague Agreement enables applicants from a Contracting Party to obtain protection of their designs with minimal formality and expense.

Additionally, under the Hague Agreement, the international registration can be centrally maintained by the IB. For example, through the IB, applicants can record changes of their representative or changes in ownership, and renew their international registration.

### II. Data

*Needs and Uses:* This information collection is necessary for design applicants to file an international design application under the Hague Agreement through the Office as an office of indirect filing pursuant 35 U.S.C. 382. The Office uses this information to process the international design application under the Hague Agreement and forward the design application to the IB. The IB ascertains whether the international application complies with the formal requirements, records the international design application in the international register, and publishes the international design application.

*Title of Collection:* International Design Applications (Hague Agreement).

*OMB Control Number:* 0651–00xx.

*Form Number(s):* WIPO DM/1.

*Type of Review:* New Collection.

*Method of Collection:* By mail, facsimile, hand delivery, or electronically to the Office.

*Affected Public:* Individuals or households; businesses or other for-profits; and not-for-profit institutions.

*Estimated Number of Respondents:* 3,310.

*Estimated Time per Response:* The Office estimates that the responses in this collection will take the public approximately 15 minutes (0.25 hours) to 6 hours.

*Estimated Total Annual Respondent Burden Hours:* 12,315 hours per year.

*Estimated Total Annual Respondent Cost Burden:* \$4,790,535 per year.

*Estimated Total Annual Non-hour Respondent Cost Burden:* \$2,403,302 per year.

### III. Solicitation

The Office is soliciting comments to:

- (1) Evaluate whether the proposed information requirement is necessary for the proper performance of the functions of the Office, including whether the information will have practical utility;
- (2) evaluate the accuracy of the Office’s estimate of the burden, including the validity of the methodology and assumptions used;
- (3) enhance the quality, utility, and clarity of the information to be collected; and
- (4) minimize the burden of collecting the information on those who are to respond, including through the use of

appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology; e.g., permitting electronic submission of responses.

Interested persons are requested to send comments regarding this information collection by January 28, 2014, to: (1) The Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10202, 725 17th Street NW., Washington, DC 20503, Attention: Desk Officer for the United States Patent and Trademark Office; and (2) The Office of PCT Legal Administration by electronic mail message over the Internet addressed to [rbacares@uspto.gov](mailto:rbacares@uspto.gov), or by mail addressed to: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of "Rafael Bacares, Legal Examiner, Office of PCT Legal Administration International Design Applications (Hague Agreement)."

#### List of Subjects

##### 37 CFR Part 1

Administrative practice and procedure, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

##### 37 CFR Part 3

Administrative practice and procedure, Patents, Trademarks.

##### 37 CFR Part 5

Classified information, Foreign relations, Inventions and patents.

##### 37 CFR Part 11

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and recordkeeping requirements.

For the reasons set forth in the preamble, 37 CFR parts 1, 3, 5 and 11 are proposed to be amended as follows:

#### PART 1—RULES OF PRACTICE IN PATENT CASES

- 1. The authority citation for 37 CFR part 1 is amended to read as follows:

**Authority:** 35 U.S.C. 2(b)(2) and the Patent Law Treaties Implementation Act of 2012.

- 2. Section 1.4 is amended by revising paragraph (a)(2) to read as follows:

##### § 1.4 Nature of correspondence and signature requirements.

- (a) \* \* \*
- (1) \* \* \*
- (2) *Correspondence in and relating to a particular application or other*

*proceeding in the Office.* See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B, §§ 1.31 to 1.378; of international applications in subpart C, §§ 1.401 to 1.499; of *ex parte* reexaminations of patents in subpart D, §§ 1.501 to 1.570; of international design applications in subpart I, §§ 1.1001 to 1.1070; of extension of patent term in subpart F, §§ 1.710 to 1.785; of *inter partes* reexaminations of patents in subpart H, §§ 1.902 to 1.997; and of the Patent Trial and Appeal Board in parts 41 and 42 of this title.

\* \* \* \* \*

- 3. Section 1.5 is amended by revising paragraph (a) to read as follows:

##### § 1.5 Identification of patent, patent application, or patent-related proceeding.

(a) No correspondence relating to an application should be filed prior to receipt of the assigned application number (*i.e.*, U.S. application number, international application number, or international registration number as appropriate). When correspondence directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application, or the international registration number of an international design application. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence. Applicants may use either the Certificate of Mailing or Transmission procedure under § 1.8 or the Express Mail procedure under § 1.10 for resubmissions of returned correspondence if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned correspondence is not resubmitted within the two-week period, the date of receipt of the resubmission will be considered to be the date of receipt of the

correspondence. The two-week period to resubmit the returned correspondence will not be extended. In addition to the application number, all correspondence directed to the Patent and Trademark Office concerning applications for patent should also state the name of the first listed inventor, the title of the invention, the date of filing the same, and if known, the group art unit or other unit within the Patent and Trademark Office responsible for considering the correspondence and the name of the examiner or other person to which it has been assigned.

\* \* \* \* \*

- 4. Section 1.6 is amended by revising paragraphs (d)(3), (d)(4), and (d)(6) to read as follows:

##### § 1.6 Receipt of correspondence.

\* \* \* \* \*

(d) \* \* \*

(3) Correspondence that cannot receive the benefit of the certificate of mailing or transmission as specified in § 1.8(a)(2)(i)(A) through (D), (F), (I), and (K) and § 1.8(a)(2)(iii)(A), except that a continued prosecution application under § 1.53(d) may be transmitted to the Office by facsimile;

(4) Color drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.173, 1.437, or 1.1026;

\* \* \* \* \*

(6) Correspondence to be filed in an application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application;

\* \* \* \* \*

- 5. Section 1.8 is amended by revising paragraphs (a)(2)(i)(I) and (a)(2)(i)(J), and adding a new paragraph (a)(2)(i)(K), to read as follows:

##### § 1.8 Certificate of mailing or transmission.

(a) \* \* \*

(2) \* \* \*

(i) \* \* \*

(I) The filing of a third-party submission under § 1.290;

(J) The calculation of any period of adjustment, as specified in § 1.703(f); and

(K) The filing of an international design application.

\* \* \* \* \*

- 6. Section 1.9 is amended by revising paragraphs (a)(1) and (a)(3), and adding new paragraphs (l), (m), and (n) to read as follows:

##### § 1.9 Definitions.

(a) \* \* \*

(1) A national application as used in this chapter means either a U.S. application for patent which was filed



in the Office under 35 U.S.C. 111, an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

\* \* \* \* \*

(3) A nonprovisional application as used in this chapter means either a U.S. national application for patent which was filed in the Office under 35 U.S.C. 111(a), an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

\* \* \* \* \*

(l) Hague Agreement as used in this chapter means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva, Switzerland, on July 2, 1999, and Hague Agreement Article as used in this chapter means an Article under the Hague Agreement.

(m) Hague Agreement Regulations as used in this chapter means the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement; and Hague Agreement Rule as used in this chapter means one of the Hague Agreement Regulations.

(n) An international design application as used in this chapter means an application for international registration of a design filed under the Hague Agreement. Unless otherwise clear from the wording, reference to "design application" or "application for a design patent" in this chapter includes an international design application that designates the United States.

■ 7. Section 1.14 is amended by revising the introductory text of paragraph (a)(1), revising paragraphs (a)(1)(ii) through (a)(1)(vii), and adding a new paragraph (j), to read as follows:

**§ 1.14 Patent applications preserved in confidence.**

(a) \* \* \*

(1) Records associated with patent applications (see paragraph (g) for international applications and paragraph (j) for international design applications) may be available in the following situations:

\* \* \* \* \*

(ii) *Published abandoned applications.* The file of an abandoned

published application is available to the public as set forth in § 1.11(a). A copy of the application-as-filed, the file contents of the published application, or a specific document in the file of the published application may be provided to any person upon request, and payment of the appropriate fee set forth in § 1.19(b).

(iii) *Published pending applications.*

A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending published application may be provided to any person upon request, and payment of the appropriate fee set forth in § 1.19(b). If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy. The Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (i) of this section.

(iv) *Unpublished abandoned applications (including provisional applications) that are identified or relied upon.* The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written

request, and payment of the appropriate fee (§ 1.19(b)).

(v) *Unpublished pending applications (including provisional applications) whose benefit is claimed.* A copy of the file contents of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ 1.19(b)), if the benefit of the application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, or in an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed, or a specific document in the file of the pending application may also be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b)). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vi) *Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.* A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ 1.19(b)), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vii) *When a petition for access or a power to inspect is required.* Applications that were not published or patented, that are not the subject of a benefit claim under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3), or are not identified in a U.S. patent, a statutory invention

registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3), are not available to the public. If an application is identified in the file contents of another application, but not the published patent application or patent itself, a granted petition for access (see paragraph (i)) or a power to inspect (see paragraph (c)) is necessary to obtain the application, or a copy of the application.

\* \* \* \* \*

(j) *International design applications.*

(1) With respect to an international design application maintained by the Office in its capacity as a designated office (§ 1.1003) for national processing, the records associated with the international design application may be made available as provided under paragraphs (a) through (i) of this section.

(2) With respect to an international design application maintained by the Office in its capacity as an office of indirect filing (§ 1.1002), the records of the international design application may be available under paragraph (j)(1) of this section where contained in the file of the international design application maintained by the Office for national processing. Also, if benefit of the international design application is claimed under 35 U.S.C. 386(c) in a U.S. patent or published application, the file contents may be made available to the public, or a copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b)).

■ 8. Section 1.16 is amended by revising the introductory text of paragraphs (b), (l) and (p) to read as follows:

**§ 1.16 National application filing, search, and examination fees.**

\* \* \* \* \*

(b) Basic fee for filing each application under 35 U.S.C. 111 for an original design patent:

\* \* \* \* \*

(l) Search fee for each application under 35 U.S.C. 111 for an original design patent:

\* \* \* \* \*

(p) Examination fee for each application under 35 U.S.C. 111 for an original design patent:

\* \* \* \* \*

■ 9. Section 1.17 is amended by revising paragraph (f) and adding new

paragraphs (u) and (v) to read as follows:

**§ 1.17 Patent application and reexamination processing fees.**

\* \* \* \* \*

(f) For filing a petition under one of the following sections which refers to this paragraph:

By a micro entity (§ 1.29)—\$100.00

By a small entity (§ 1.27(a))—\$200.00

By other than a small or micro entity—\$400.00

§ 1.36(a)—for revocation of a power of attorney by fewer than all of the applicants.

§ 1.53(e)—to accord a filing date.

§ 1.57(a)—to accord a filing date.

§ 1.182—for decision on a question not specifically provided for.

§ 1.183—to suspend the rules.

§ 1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.

§ 1.741(b)—to accord a filing date to an application under § 1.740 for extension of a patent term.

§ 1.1023—to review the filing date of an international design application.

\* \* \* \* \*

(u) For filing a petition to excuse applicant's failure to act within prescribed time limits in an international design application (35 U.S.C. 387 and § 1.1051):

By a small entity (§ 1.27(a))—\$850.00

By other than a small entity—\$1,700.00

(v) For filing a petition to convert an international design application to a design application under 35 U.S.C. chapter 16 (35 U.S.C. 384 and § 1.1052)—\$180.00

■ 10. Section 1.18 is amended by adding a new paragraph (b)(3) to read as follows:

**§ 1.18 Patent post allowance (including issue) fees.**

\* \* \* \* \*

(b) \* \* \*

(3) For an international design application designating the United States, where an issue fee is paid through the International Bureau (Hague Agreement Rule 12(3)(c)) as an alternative to paying the issue fee under paragraph (b)(1): The amount specified on the Web site of the World Intellectual Property Organization, available at: <http://www.wipo.int/hague>.

\* \* \* \* \*

■ 11. Section 1.25 is amended by revising the first sentence of paragraph (b) to read as follows:

**§ 1.25 Deposit accounts.**

\* \* \* \* \*

(b) Filing, issue, appeal, international-type search report, international application processing, international design application fees (§ 1.1031), petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. \* \* \*

\* \* \* \* \*

■ 12. Section 1.27 is amended by revising paragraph (c)(3) to read as follows:

**§ 1.27 Definition of small entities and establishing status as a small entity to permit payment of small entity fees; when a determination of entitlement to small entity status and notification of loss of entitlement to small entity status are required; fraud on the Office.**

\* \* \* \* \*

(c) \* \* \*

(3) *Assertion by payment of the small entity basic filing, basic transmittal, basic national fee, or international search fee.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in §§ 1.16(a), 1.16(b), 1.16(c), 1.16(d), 1.16(e), the small entity transmittal fee set forth in § 1.445(a)(1), the small entity international search fee set forth in § 1.445(a)(2) to a Receiving Office other than the United States Receiving Office in the exact amount established for that Receiving Office pursuant to PCT Rule 16, the small entity first part of the individual designation fee for the United States (Hague Agreement Rule 12(1)(a)(iii)) to the International Bureau in an international design application, or the small entity basic national fee set forth in § 1.492(a), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing, basic transmittal, or basic national fee is inadvertently selected in error.

\* \* \* \* \*

■ 13. Section 1.29 is amended by revising the first sentence of paragraph (e) to read as follows:

**§ 1.29 Micro entity status.**

\* \* \* \* \*

(e) Micro entity status is established in an application by filing a micro entity certification in writing complying with the requirements of either paragraph (a) or paragraph (d) of this section and signed either in compliance with § 1.33(b) or in an international design application by a person authorized to represent the applicant under § 1.1041(a) before the International Bureau where the micro entity certification is filed with the International Bureau. \* \* \*

\* \* \* \* \*

■ 14. Section 1.41 is amended by adding a new paragraph (f) to read as follows:

**§ 1.41 Inventorship.**

\* \* \* \* \*

(f) The inventorship of an international design application designating the United States is the creator or creators set forth in the publication of the international registration under Hague Agreement Article 10(3). Any correction of inventorship must be pursuant to § 1.48.

■ 15. Section 1.46 is amended by revising paragraphs (b) and (c) to read as follows:

**§ 1.46 Application for patent by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter.**

\* \* \* \* \*

(b) If an application under 35 U.S.C. 111 is made by a person other than the inventor under paragraph (a) of this section, the application must contain an application data sheet under § 1.76 specifying in the applicant information section (§ 1.76(b)(7)) the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter. If an application entering the national stage under 35 U.S.C. 371 or an international design application before the United States as a designated office is applied for by a person other than the inventor under paragraph (a) of this section, the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter must have been identified as the applicant for the United States in the international stage of the international application or as the holder in the publication of the international registration under Hague Agreement Article 10(3).

(c) Any request to correct or update the name of the applicant under this section must include an application data sheet under § 1.76 specifying the correct or updated name of the applicant in the applicant information section (§ 1.76(b)(7)) except that correction of the name of the applicant may be made pursuant to Hague Agreement Article 16 for an international design application. Any request to replace the original applicant with an applicant under this section must include an application data sheet under § 1.76 specifying the applicant in the applicant information section (§ 1.76(b)(7)) and comply with §§ 3.71 and 3.73 of this title.

\* \* \* \* \*

■ 16. Section 1.53 is amended by revising paragraph (d)(1)(ii) to read as follows:

**§ 1.53 Application number, filing date, and completion of application.**

\* \* \* \* \*

(d) \* \* \*

(1) \* \* \*

(ii) The prior nonprovisional application is a design application, but not an international design application, that is complete as defined by § 1.51(b); and

\* \* \* \* \*

■ 17. Section 1.55 is amended by revising paragraph (b) and adding a new paragraph (m) to read as follows:

**§ 1.55 Claim for foreign priority.**

\* \* \* \* \*

(b) *Time for filing subsequent application.* The nonprovisional application must be filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, or be entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of an application that was filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed. The twelve-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)) and PCT Rule 80.5, and the six-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)) and Hague Agreement Rule 4(4).

\* \* \* \* \*

(m) *Time for filing priority claim and certified copy of foreign application in an international design application designating the United States.* In an international design application designating the United States, the claim for priority may be made in accordance with the Hague Agreement and the Hague Agreement Regulations. For purposes of the United States, the priority claim may also be presented in an application data sheet (§ 1.76(b)(6)), filed directly with the Office after publication of the international registration under Hague Agreement Article 10(3), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The priority claim and certified copy must be furnished in accordance with the time period and other conditions set forth in paragraph (g) of this section.

■ 18. Section 1.57 is amended by revising the introductory text of paragraph (a), redesignating paragraph

(a)(3) as paragraph (a)(4), and adding a new paragraph (a)(3) to read as follows:

**§ 1.57 Incorporation by reference.**

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, international application, or international design application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

\* \* \* \* \*

(3) Any amendment to an international design application that designates the United States pursuant to this paragraph shall be effective only as to the United States, and shall have no effect on the filing date of the application.

\* \* \* \* \*

■ 19. Section 1.76 is amended by revising paragraph (b)(6) to read as follows:

**§ 1.76 Application data sheet.**

\* \* \* \* \*

(b) \* \* \*

(6) *Foreign priority information.* This information includes the application number, country (or intellectual property authority), and filing date of each foreign application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55.

\* \* \* \* \*

■ 20. Section 1.78 is amended by revising the introductory text of paragraphs (c) and (d), revising paragraphs (c)(1)(i) through (c)(1)(ii) and (c)(2), and adding new paragraph (c)(1)(iii) and (c)(7) to read as follows:

**§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.**

\* \* \* \* \*

(c) *Claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional, international application, or international design application.* An applicant in a nonprovisional application, an

international application designating the United States, or an international design application designating the United States may claim the benefit of one or more prior-filed copending nonprovisional applications, international applications designating the United States, or international design applications designating the United States under the conditions set forth in 35 U.S.C. 120, 121, 365(c), or 386(c) and this section.

(1) \* \* \*

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States;

(ii) A nonprovisional application under 35 U.S.C. 111(a) that is entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) for which the basic filing fee set forth in § 1.16 has been paid within the pendency of the application; or

(iii) An international design application designating the United States and entitled to a filing date as set forth in § 1.1023.

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application, international application designating the United States, or international design application designating the United States that claims the benefit of one or more prior-filed nonprovisional applications, international applications designating the United States, or international design applications designating the United States must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number), international application number and international filing date, or international registration number and international registration date. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application, international application, or international design application.

\* \* \* \* \*

(7) Where benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) to an international application or an international design application which designates but did not originate in the United States, the Office may require a certified copy of such application together with an English translation thereof if filed in another language.

(d) *Delayed claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* If the reference required by 35 U.S.C. 120 and paragraph (c)(2) of this section is presented after the time period provided by paragraph (c)(3) of this section, the claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed copending nonprovisional application, international application designating the United States, or international design application designating the United States may be accepted if the reference identifying the prior-filed application by application number, international application number and international filing date, or international registration number and filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed application must be accompanied by:

\* \* \* \* \*

■ 21. Section 1.84 is amended by revising paragraph (y) to read as follows:

**§ 1.84 Standards for drawings.**

\* \* \* \* \*

(y) *Types of drawings.* See § 1.152 for design drawings, § 1.1026 for international design reproductions, § 1.165 for plant drawings, and § 1.173(a)(2) for reissue drawings.

■ 22. Section 1.85 is amended by revising paragraphs (a) and (c) to read as follows:

**§ 1.85 Corrections to drawings.**

(a) A utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. Except as provided in § 1.215(c), any patent application publication will not include drawings filed after the application has been placed on the files for examination. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (§ 1.135(c)). If a drawing in a design application meets the requirements of § 1.84(e), (f), and (g) and is suitable for reproduction, but is not otherwise in compliance with § 1.84, the drawing may be admitted for examination. Similarly, if a drawing in an international design application designating the United States meets the

requirements of § 1.1026, the drawing may be admitted for examination.

\* \* \* \* \*

(c) If a corrected drawing is required or if a drawing does not comply with § 1.84 or § 1.1026 at the time an application is allowed, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing in compliance with § 1.84 or § 1.1026, whichever is appropriate, to avoid abandonment. This time period is not extendable under § 1.136 (see § 1.136(c)).

■ 23. Section 1.97 is amended by redesignating paragraphs (b)(3) and (b)(4) as paragraphs (b)(4) and (b)(5), respectively, and adding a new paragraph (b)(3) to read as follows:

**§ 1.97 Filing of information disclosure statement.**

\* \* \* \* \*

(b) \* \* \*

(3) Within three months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application;

\* \* \* \* \*

■ 24. Section 1.105 is amended by revising the introductory text of paragraph (a)(1) to read as follows:

**§ 1.105 Requirements for information.**

(a)(1) In the course of examining or treating a matter in a pending or abandoned application, in a patent, in a supplemental examination proceeding, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

\* \* \* \* \*

■ 25. Section 1.114 is amended by redesignating paragraph (e)(5) as paragraph (e)(6), revising paragraph (e)(4), and adding new paragraph (e)(5) to read as follows:

**§ 1.114 Request for continued examination.**

\* \* \* \* \*

(e) \* \* \*

(4) An application for a design patent;

(5) An international design application; or

(6) A patent under reexamination.

■ 26. Section 1.155 is amended by revising paragraph (a)(1) to read as follows:

**§ 1.155 Expedited examination of design applications.**

(a) \* \* \*

(1) The application must include drawings in compliance with § 1.84, or for an international design application that designates the United States, published pursuant to Hague Agreement Article 10(3);

\* \* \* \* \*

■ 27. Section 1.211 is amended by revising paragraph (b) to read as follows.

**§ 1.211 Publication of applications.**

\* \* \* \* \*

(b) Provisional applications under 35 U.S.C. 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16, international design applications under 35 U.S.C. chapter 38, and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section.

\* \* \* \* \*

■ 28. Section 1.312 is revised to read as follows.

**§ 1.312 Amendments after allowance.**

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue. For purposes of this section, where the issue fee is paid in an international design application through the International Bureau, the date of payment of the issue fee will be the date the issue fee is recorded by the Office.

■ 29. Subpart I to part 1 is added to read as follows:

**Subpart I—International Design Application****General Information**

Sec.

- 1.1001 Definitions related to international design applications.
- 1.1002 The United States Patent and Trademark Office as an office of indirect filing.
- 1.1003 The United States Patent and Trademark Office as a designated office.
- 1.1004 The International Bureau.

**Who May File An International Design Application**

- 1.1011 Applicant for international design application.

**The International Design Application**

- 1.1021 Contents of the international design application.
- 1.1022 Form and signature.
- 1.1023 Filing date of an international design application in the United States.
- 1.1024 The description.

- 1.1025 The claim.
- 1.1026 Reproductions.
- 1.1027 Specimens.

**Fees**

- 1.1031 International design application fees.

**Priority**

- 1.1035 The priority claim in an international design application.

**Representation**

- 1.1041 Representation in an international design application.

**Transmittal of the International Design Application to the International Bureau**

- 1.1045 Procedures for transmittal of international design application to the International Bureau.

**Relief From Prescribed Time Limits; Conversion to a design Application Under 35 U.S.C. Chapter 16**

- 1.1051 Relief from prescribed time limits.
- 1.1052 Conversion to a design application under 35 U.S.C. chapter 16.

**National Processing of International Design Applications**

- 1.1061 Rules applicable.
- 1.1062 Examination.
- 1.1063 Notification of Refusal.
- 1.1064 One independent and distinct design.
- 1.1066 Correspondence address for an international design application.
- 1.1067 Title and the inventor's oath or declaration.
- 1.1069 Notification of Division.
- 1.1070 Notification of Invalidation.

**Subpart I — International Design Application****General Information****§ 1.1001 Definitions related to international design applications.**

(a) *Article* as used in this subpart means an article of the Hague Agreement;

(b) *Regulations* as used in this subpart means the “Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement”;

(c) *Rule* as used in this subpart means one of the Regulations;

(d) *Administrative Instructions* as used in this subpart means the Administrative Instructions referred to in Rule 34;

(e) *1960 Act* as used in this subpart means the Act signed at the Hague on November 28, 1960, of the Hague Agreement;

(f) Other terms and expressions in subpart I not defined in this section are as defined in Article 1, Rule 1, and 35 U.S.C. 381.

**§ 1.1002 The United States Patent and Trademark Office as an office of indirect filing.**

(a) The United States Patent and Trademark Office, as an office of indirect filing, shall accept international design applications where the applicant's Contracting Party is the United States.

(b) The major functions of the United States Patent and Trademark Office as an office of indirect filing include:

(1) Receiving and according a receipt date to international design applications;

(2) Collecting and, when required, transmitting fees due for processing international design applications;

(3) Determining compliance with applicable requirements of part 5 of this chapter; and

(4) Transmitting an international design application to the International Bureau, unless prescriptions concerning national security prevent the application from being transmitted.

**§ 1.1003 The United States Patent and Trademark Office as a designated office.**

(a) The United States Patent and Trademark Office will act as a designated office (“United States Designated Office”) for international design applications in which the United States has been designated as a Contracting Party in which protection is sought.

(b) The major functions of the United States Designated Office include:

(1) Accepting for national examination international design applications which satisfy the requirements of the Hague Agreement, the Regulations and the regulations;

(2) Performing an examination of the international design application in accordance with 35 U.S.C. chapter 16; and

(3) Communicating the results of examination to the International Bureau.

**§ 1.1004 The International Bureau.**

(a) The International Bureau is the World Intellectual Property Organization located at Geneva, Switzerland. It is the international intergovernmental organization which acts as the coordinating body under the Hague Agreement and the Regulations.

(b) The major functions of the International Bureau include:

(1) Receiving international design applications directly from applicants and indirectly from an office of indirect filing;

(2) Collecting required fees and crediting designation fees to the accounts of the Contracting Parties concerned;

(3) Reviewing international design applications for compliance with prescribed formal requirements;

(4) Translating international design applications into the required languages for recordation and publication;

(5) Recording international design applications in the International Register;

(6) Publishing international design applications in the International Designs Bulletin; and

(7) Sending copies of the publication of the international registration to each designated office.

### Who May File an International Design Application

#### § 1.1011 Applicant for an international design application.

(a) Only persons who are nationals of the United States or who have a domicile, a habitual residence or a real and effective industrial or commercial establishment in the territory of the United States may file international design applications through the United States Patent and Trademark Office.

(b) Although the United States Patent and Trademark Office will accept international design applications filed by any person referred to in paragraph (a) of this section, an international design application designating the United States may be refused by the Office as a designated office if the applicant is not a person qualified under 35 U.S.C. chapter 11 to be an applicant.

### The International Design Application

#### § 1.1021 Contents of the international design application.

(a) *Mandatory contents.* The international design application shall be in English, French or Spanish (Rule 6) and shall contain or be accompanied by:

(1) A request for international registration under the Hague Agreement (Article 5(1)(i));

(2) The prescribed data concerning the applicant (Article 5(1)(ii) and Rule 7(3)(i) and (ii));

(3) The prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international design application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with Article 5(5), the international design application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design (Article 5(1)(iii));

(4) An indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed (Article 5(1)(iv) and Rule 7(3)(iv));

(5) An indication of the designated Contracting Parties (Article 5(1)(v));

(6) The prescribed fees (Article 5(1)(vi) and Rule 12(1));

(7) The Contracting Party or Parties in respect of which the applicant fulfills the conditions to be the holder of an international registration (Rule 7(3)(iii));

(8) The number of industrial designs included in the international design application, which may not exceed 100, and the number of reproductions or specimens of the industrial designs accompanying the international design application (Rule 7(3)(v));

(9) The amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions (Rule 7(3)(vii)); and

(10) An indication of applicant's Contracting Party as required under Rule 7(4)(a).

(b) *Additional mandatory contents required by certain Contracting Parties.*

(1) Where the international design application contains the designation of a Contracting Party that requires, pursuant to Article 5(2), any of the following elements, then the international design application shall contain such required element(s):

(i) Indications concerning the identity of the creator of the industrial design that is the subject of that application (Rule 11(1));

(ii) A brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application (Rule 11(2));

(iii) A claim (Rule 11(3)).

(2) Where the international design application contains the designation of a Contracting Party that has made a declaration under Rule 8(1), then the international application shall contain the statement, document, oath or declaration specified in that declaration (Rule 7(4)(c)).

(c) *Optional contents.* The international design application may contain:

(1) Two or more industrial designs, subject to the prescribed conditions (Article 5(4) and Rule 7(7));

(2) A request for deferment of publication (Article 5(5) and Rule 7(5)(e));

(3) An element referred to in item (i) or (ii) of Article 5(2)(b) of the Hague

Agreement or in Article 8(4)(a) of the 1960 Act even where that element is not required in consequence of a notification in accordance with Article 5(2)(a) of the Hague Agreement or in consequence of a requirement under Article 8(4)(a) of the 1960 Act (Rule 7(5)(a));

(4) The name and address of applicant's representative, as prescribed (Rule 7(5)(b));

(5) A claim of priority under Article 4 of the Paris Convention, as prescribed (Rule 7(5)(c));

(6) A declaration, for purposes of Article 11 of the Paris Convention, that the product or products which constitute the industrial design or in which the industrial design is incorporated have been shown at an official or officially recognized international exhibition, together with the place where the exhibition was held and the date on which the product or products were first exhibited there and, where less than all the industrial designs contained in the international design application are concerned, the indication of those industrial designs to which the declaration relates or does not relate (Rule 7(5)(d));

(7) Any declaration, statement or other relevant indication as may be specified in the Administrative Instructions (Rule 7(5)(f));

(8) A statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned (Rule 7(5)(g));

(9) A proposed translation of any text matter contained in the international design application for purposes of recording and publication (Rule 6(4)).

(d) *Required contents where the United States is designated.* In addition to the mandatory requirements set forth in paragraph (a) of this section, an international design application that designates the United States shall contain or be accompanied by:

(1) A claim (§§ 1.1021(b)(1)(iii) and 1.1025);

(2) Indications concerning the identity of the creator (Rule 11(1)); and

(3) The inventor's oath or declaration (§§ 1.63 and 1.64). The requirements in § 1.63(b) and § 1.64(b)(4) to identify each inventor by his or her legal name, mailing address, and residence, if an inventor lives at a location which is different from the mailing address, and the requirement in § 1.64(b)(2) to identify the residence and mailing address of the person signing the substitute statement, will be considered satisfied by the presentation of such information in the international design

application prior to international registration.

#### **§ 1.1022 Form and signature.**

(a) The international design application shall be presented on the official form or any form having the same contents and format (Rules 7(1) and 1(vi)).

(b) The international design application shall be signed by the applicant.

#### **§ 1.1023 Filing date of an international design application in the United States.**

(a) Subject to paragraph (b) of this section, the filing date of an international design application in the United States is the date of international registration determined by the International Bureau under the Hague Agreement (35 U.S.C. 384 and 381(a)(5)).

(b) Where the applicant believes the international design application is entitled under the Hague Agreement to a filing date in the United States other than the date of international registration, the applicant may petition the Director under this paragraph to accord the international design application a filing date in the United States other than the date of international registration. Such petition must be accompanied by the fee set forth in § 1.17(f) and include a showing to the satisfaction of the Director that the international design application is entitled to such filing date.

#### **§ 1.1024 The description.**

(a) An international design application designating the United States must include a specification as prescribed by 35 U.S.C. 112 and preferably include a brief description of the view or views of the reproduction.

(b) The description requirements set forth in Rule 11(2) may apply to designations of Contracting Parties other than the United States that require a description.

#### **§ 1.1025 The claim.**

The specific wording of the claim in an international design application designating the United States shall be in formal terms to the ornamental design for the article (specifying name of article) as shown, or as shown and described. More than one claim is neither required nor permitted for purposes of the United States.

#### **§ 1.1026 Reproductions.**

Reproductions shall comply with the requirements of Rule 9 and Part Four of the Administrative Instructions.

#### **§ 1.1027 Specimens.**

Where a request for deferment of publication has been filed in respect of a two-dimensional industrial design, the international design application may include specimens of the design in accordance with Rule 10 and Part Four of the Administrative Instructions. Neither a request for deferment of publication nor specimens are permitted in an international design application that designates the United States or any other Contracting Party which does not permit deferment of publication.

#### **Fees**

#### **§ 1.1031 International design application fees.**

(a) International design applications filed through the Office as an office of indirect filing are subject to payment of a transmittal fee (35 U.S.C. 382(b) and Article 4(2)) in the amount of \$130.

(b) The Schedule of Fees annexed to the Regulations (Rule 27(1)), a list of individual designation fee amounts, and a fee calculator may be viewed on the Web site of the World Intellectual Property Organization, available at: <http://www.wipo.int/hague>.

(c) The following fees required by the International Bureau may be paid either directly to the International Bureau or through the Office as an office of indirect filing in the amounts specified on the World Intellectual Property Organization Web site described in paragraph (b) of this section:

(1) International application fees (Rule 12(1)); and  
(2) Fee for descriptions exceeding 100 words (Rule 11(2)).

(d) The fees referred to in paragraph (c) of this section may be paid as follows:

(1) Directly to the International Bureau in Swiss currency (*see* Administrative Instruction 801); or  
(2) Through the Office as an office of indirect filing, provided such fees are paid no later than the date of payment of the transmittal fee required under paragraph (a) of this section. Any payment through the Office must be in U.S. dollars. Applicants paying the fees in paragraph (c) of this section through the Office may be subject to a requirement by the International Bureau to pay additional amounts where the conversion from U.S. dollars to Swiss currency results in the International Bureau receiving less than the prescribed amounts.

#### **Priority**

#### **§ 1.1035 The priority claim in an international design application.**

(a) The international design application may claim under Article 4

of the Paris Convention, the priority of one or more earlier applications filed in or for any country party to that Convention or any Member of the World Trade Organization. The priority claim must contain an indication of the name of the Office where such filing was made and of the date and, where available, the number of that filing, and where the priority claim relates to less than all the industrial designs contained in the international design application, the indication of those industrial designs to which the priority claim relates or does not relate (Article 6 and Rule 7(5)(c)).

(b) An international design application designating the United States may claim benefit under 35 U.S.C. 120, 121, 365(c) or 386(c) to an earlier filed application in accordance with § 1.78.

#### **Representation**

#### **§ 1.1041 Representation in an international design application.**

(a) The applicant or the holder may appoint a representative before the International Bureau in accordance with Rule 3.

(b) Applicants of international design applications may be represented before the Office as an office of indirect filing by a practitioner registered (§ 11.6) or granted limited recognition (§§ 11.9(a) or (b)) to practice before the Office in patent matters. Such practitioner may act pursuant to § 1.34 or be appointed, in writing signed by the applicant, giving the practitioner power to act on behalf of the applicant and specifying the name and registration number or limited recognition number of each practitioner. An appointment of a representative made in the international design application pursuant to Rule 3(2) that complies with the requirements of this paragraph will be effective as an appointment before the Office as an office of indirect filing.

#### **Transmittal of International Design Application to the International Bureau**

#### **§ 1.1045 Procedures for transmittal of international design application to the International Bureau.**

(a) Subject to paragraph (b) of this section and payment of the transmittal fee set forth in § 1.1031(a), transmittal of the international design application to the International Bureau shall be made by the Office as provided by Rule 13(1). At the same time as it transmits the international design application to the International Bureau, the Office shall notify the International Bureau of the date on which it received the application. The Office shall also notify



the applicant of the date on which it received the application and of the transmittal of the international design application to the International Bureau.

(b) No copy of an international design application may be transmitted to the International Bureau, a foreign designated office, or other foreign authority by the Office or the applicant, unless the applicable requirements of part 5 of this chapter have been satisfied.

(c) Once transmittal of the international design application has been effected under paragraph (a) of this section, except for matters properly before the United States Patent and Trademark Office as an office of indirect filing or as a designated office, all further correspondence concerning the application should be sent directly to the International Bureau. The United States Patent and Trademark Office will generally not forward communications to the International Bureau received after transmittal of the application to the International Bureau. Any reply to an invitation sent to the applicant by the International Bureau must be filed directly with the International Bureau, and not with the Office, to avoid abandonment or other loss of rights under Article 8.

#### **Relief From Prescribed Time Limits; Conversion to a Design Application Under 35 U.S.C. Chapter 16**

##### **§ 1.1051 Relief from prescribed time limits.**

(a) If the delay in an applicant's failure to act within prescribed time limits under the Hague Agreement in connection with requirements pertaining to an international design application was unintentional, a petition may be filed pursuant to this section to excuse the failure to act as to the United States. A grantable petition pursuant to this section must be accompanied by:

(1) A copy of any invitation sent from the International Bureau setting a prescribed time limit for which applicant failed to timely act;

(2) The reply required under paragraph (c) of this section, unless previously filed;

(3) The fee as set forth in § 1.17(u);

(4) A certified copy of the originally filed international design application, unless a copy of the international design application was previously communicated to the Office from the International Bureau or the international design application was filed with the Office as an office of indirect filing, and a translation thereof into the English language if it was filed in another language; and

(5) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(b) Any request for reconsideration or review of a decision refusing to excuse the applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international design application upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to excuse or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under the provisions of § 1.136.

(c) *Reply.* The reply required may be:

(1) The filing of a continuing application. If the international design application has not been subject to international registration, the reply must also include a grantable petition under § 1.1023(b) to accord the international design application a filing date; or

(2) A grantable petition under § 1.1052, where the international design application was filed with the Office as an office of indirect filing.

##### **§ 1.1052 Conversion to a design application under 35 U.S.C. chapter 16.**

(a) An international design application designating the United States filed with the Office as an office of indirect filing and meeting the requirements under § 1.53(b) for a filing date for an application for a design patent may, on petition under this section, be converted to an application for a design patent under § 1.53(b) and accorded a filing date as provided therein. A petition under this section must be accompanied by the fee set forth in § 1.17(v) and be filed prior to publication of the international registration under Article 10(3). The conversion of an international design application to an application for a design patent under § 1.53(b) will not entitle applicant to a refund of the transmittal fee or any fee forwarded to the International Bureau, or the application of any such fee toward the filing fee, or any other fee, for the application for a design patent under § 1.53(b). The application for a design patent resulting from conversion of an international design application must also include the basic filing fee (§ 1.16(b)), the search fee (§ 1.16(l)), the examination fee (§ 1.16(p)), the inventor's oath or declaration (§§ 1.63 or

1.64), and a surcharge if required by § 1.16(f).

(b) An international design application will be treated as an application for a design patent under § 1.53(b) if a decision on petition under this section is granted prior to transmittal of the international design application to the International Bureau pursuant to § 1.1045. Otherwise, a decision granting a petition under this section will be effective to treat the international design application as an application for a design patent under § 1.53(b) only for purposes of the United States.

(c) A petition under this section will not be granted in an abandoned international design application absent a grantable petition under § 1.1051.

#### **National Processing of International Design Applications**

##### **§ 1.1061 Rules applicable.**

(a) The rules relating to applications for patents for other inventions or discoveries are also applicable to international design applications designating the United States, except as otherwise provided in this chapter or required by the Articles or Regulations.

(b) The provisions of §§ 1.84 and 1.152–1.154 shall not apply to international design applications.

##### **§ 1.1062 Examination.**

(a) *Examination.* The Office shall make an examination pursuant to Title 35 of the United States Code of an international design application designating the United States. An international design application may not be refused on grounds that requirements relating to the form or contents of the international design application provided for in the Hague Agreement or the Regulations or additional to, or different from, those requirements have not been satisfied.

(b) *Timing.* For each international design application to be examined under paragraph (a) of this section, the Office shall, subject to Rule 18(1)(c)(ii), send to the International Bureau within 12 months from the publication of the international registration under Rule 26(3) a notification of refusal (§ 1.1063) where it appears that the applicant is not entitled to a patent under the law with respect to any industrial design that is the subject of the international registration.

##### **§ 1.1063 Notification of Refusal**

(a) A notification of refusal shall contain or indicate:

(1) The number of the international registration;

(2) The grounds on which the refusal is based;

(3) Where the grounds of refusal refer to similarity with an industrial design that is the subject of an earlier application or registration, a copy of a reproduction of the earlier industrial design and information concerning the earlier industrial design as required under Hague Rule 18(2)(b)(iv); and

(4) A time period for reply to the notification under § 1.134 and § 1.136 to avoid abandonment.

(b) Any reply to the notification of refusal must be filed directly with the Office and not through the International Bureau. The requirements of § 1.111 shall apply to a reply to a notification of refusal.

**§ 1.1064 One independent and distinct design.**

(a) Only one independent and distinct design may be claimed in an international design application designating the United States.

(b) If the requirements under paragraph (a) of this section are not satisfied, the examiner shall in the notification of refusal or other Office action require the applicant in the reply to that action to elect one independent and distinct design for which prosecution on the merits shall be restricted. Such requirement will normally be made before any action on the merits but may be made at any time before the final action. Review of any such requirement is provided under §§ 1.143 and 1.144.

**§ 1.1066 Correspondence address for an international design application.**

(a) Unless changed in accordance with paragraph (b) of this section, the Office will use as the correspondence address the address of applicant's representative identified in the publication of the international registration, or if there is no address for the representative, the address of the applicant identified therein.

(b) The correspondence address may be changed by the parties set forth in § 1.33(b)(1) or (b)(3) in accordance with § 1.33(a).

(c) Reference in the rules to the correspondence address set forth in § 1.33(a) shall be construed to include a reference to this section for a nonprovisional application that is an international design application.

**§ 1.1067 Title and inventor's oath or declaration.**

(a) The title of the design must designate the particular article. Where an international design application does not contain a title of the design, the Office may establish a title.

(b) An international design application designating the United States must include the inventor's oath or declaration. *See* § 1.1021(d). If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136 (*see* § 1.136(c)).

**§ 1.1069 Notification of Division.**

(a) Where, following a notification of refusal in an international design application requiring an election of an independent and distinct design under § 1.1064(b), a divisional application claiming benefit under 35 U.S.C. 386(c) and 121 to the international design application is filed for the non-elected design(s), the Office shall notify the International Bureau. The notification to the International Bureau shall indicate:

(1) The number of the international registration concerned;

(2) The numbers of the industrial designs which have been the subject of the divisional application(s); and

(3) The divisional application number(s).

(b) The Office may require the applicant in a divisional application that is subject to a notification under paragraph (a) of this section to identify the design in the international design application pursued in the divisional application.

**§ 1.1070 Notification of Invalidation.**

(a) Where a design patent that was granted from an international design application is invalidated in the United States, and the invalidation is no longer subject to any review or appeal, the patentee shall inform the Office.

(b) After receiving a notification of invalidation under paragraph (a) of this section or through other means, the Office will notify the International Bureau in accordance with Hague Rule 20.

**PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE**

■ 30. The authority citation for part 3 continues to read as follows:

**Authority:** 15 U.S.C. 1123; 35 U.S.C. 2(b)(2).

■ 31. Section 3.1 is amended by revising the definition of "Application" to read as follows:

**§ 3.1 Definitions.**

\* \* \* \* \*

*Application* means a national application for patent, an international patent application that designates the United States of America, an international design application that designates the United States of America, or an application to register a trademark under section 1 or 44 of the Trademark Act, 15 U.S.C. 1051 or 15 U.S.C. 1126, unless otherwise indicated.

\* \* \* \* \*

■ 32. Section 3.21 is revised to read as follows:

**§ 3.21 Identification of patents and patent applications.**

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number; *e.g.*, 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international application number; *e.g.*, PCT/US2012/012345. An assignment relating to an international design application which designates the United States of America must identify the international design application by the international registration number or by the U.S. application number assigned to the international design application. If an assignment of a patent application filed under § 1.53(b) is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by the name of each inventor and the title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application under § 1.53(c) is executed before the provisional application is filed, it must identify the provisional application by the name of each inventor and the title of the invention so that there can be no mistake as to the provisional application intended.

**PART 5—SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES**

■ 33. The authority citation for 37 CFR part 5 continues to read as follows:

**Authority:** 35 U.S.C. 2(b)(2), 41, 181–188, as amended by the Patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100–418, 102 Stat. 1567; the Arms Export Control Act, as amended, 22 U.S.C. 2751 *et seq.*; the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 *et seq.*; the Nuclear Non Proliferation Act of 1978, 22 U.S.C. 3201 *et seq.*; and the delegations in the regulations under these Acts to the Director (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

■ 34. Section 5.1 is amended by revising paragraph (b) to read as follows:

**§ 5.1 Applications and correspondence involving national security.**

\* \* \* \* \*

(b) *Definitions.* (1) Application as used in this part includes provisional applications (§ 1.9(a)(2) of this chapter), nonprovisional applications (§ 1.9(a)(3)), international applications (§ 1.9(b)), or international design applications (§ 1.9(n)).

(2) Foreign application as used in this part includes, for filing in a foreign country, foreign patent agency, or international agency (other than the United States Patent Trademark Office) any of the following: An application for patent, international application, international design application, or application for the registration of a utility model, industrial design, or model.

\* \* \* \* \*

■ 35. Section 5.3 is amended by revising paragraph (d) to read as follows:

**§ 5.3 Prosecution of application under secrecy orders; withholding patent.**

\* \* \* \* \*

(d) International applications and international design applications under secrecy order will not be mailed, delivered, or otherwise transmitted to the international authorities or the applicant. International applications under secrecy order will be processed up to the point where, if it were not for the secrecy order, record and search copies would be transmitted to the international authorities or the applicant.

■ 36. Section 5.11 is amended by revising the heading and paragraphs (a) through (c), (e)(3)(i), and (f) to read as follows:

**§ 5.11 License for filing in, or exporting to, a foreign country an application on an invention made in the United States.**

(a) A license from the Commissioner for Patents under 35 U.S.C. 184 is required before filing any application for patent including any modifications, amendments, or supplements thereto or divisions thereof or for the registration of a utility model, industrial design, or model, in a foreign patent office or any

foreign patent agency or any international agency other than the United States Receiving Office or the United States Patent and Trademark Office as an office of indirect filing for international design applications, if the invention was made in the United States, and:

(1) An application on the invention has been filed in the United States less than six months prior to the date on which the application is to be filed, or

(2) No application on the invention has been filed in the United States.

(b) The license from the Commissioner for Patents referred to in paragraph (a) would also authorize the export of technical data abroad for purposes relating to the preparation, filing or possible filing and prosecution of a foreign application without separately complying with the regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730–774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce) and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy).

(c) Where technical data in the form of a patent application, or in any form, are being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign application, without the license from the Commissioner for Patents referred to in paragraphs (a) or (b) of this section, or on an invention not made in the United States, the export regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730–774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce) and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy) must be complied with unless a license is not required because a United States application was on file at the time of export for at least six months without a secrecy order under § 5.2 being placed thereon. The term “exported” means export as it is defined in 22 CFR part 120, 15 CFR part 734 and activities covered by 10 CFR part 810.

\* \* \* \* \*

(e) \* \* \*

(3) \* \* \*

(i) A license is not, or was not, required under paragraph (e)(2) of this section for the foreign application;

\* \* \* \* \*

(f) A license pursuant to paragraph (a) of this section can be revoked at any time upon written notification by the Patent and Trademark Office. An authorization to file a foreign application resulting from the passage of six months from the date of filing of a United States patent application may be revoked by the imposition of a secrecy order.

■ 37. Section 5.12 is amended by revising paragraph (a) to read as follows:

**§ 5.12 Petition for license.**

(a) Filing of an application on an invention made in the United States will be considered to include a petition for license under 35 U.S.C. 184 for the subject matter of the application. The filing receipt or other official notice will indicate if a license is granted. If the initial automatic petition is not granted, a subsequent petition may be filed under paragraph (b) of this section.

\* \* \* \* \*

■ 38. Section 5.13 is revised to read as follows:

**§ 5.13 Petition for license; no corresponding application.**

If no corresponding national, international design, or international application has been filed in the United States, the petition for license under § 5.12(b) must also be accompanied by a legible copy of the material upon which a license is desired. This copy will be retained as a measure of the license granted.

■ 39. Section 5.14 is amended by revising paragraph (c) to read as follows:

**§ 5.14 Petition for license; corresponding U.S. application.**

\* \* \* \* \*

(c) Where the application to be filed or exported abroad contains matter not disclosed in the United States application or applications, including the case where the combining of two or more United States applications introduces subject matter not disclosed in any of them, a copy of the application as it is to be filed or exported abroad, must be furnished with the petition. If, however, all new matter in the application to be filed or exported is readily identifiable, the new matter may be submitted in detail and the remainder by reference to the pertinent United States application or applications.

■ 40. Section 5.15 is amended by revising paragraphs (a), (b), (d) and (e) to read as follows:

**§ 5.15 Scope of license.**

(a) Applications or other materials reviewed pursuant to §§ 5.12 through

5.14, which were not required to be made available for inspection by defense agencies under 35 U.S.C. 181, will be eligible for a license of the scope provided in this paragraph. This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign application, if such changes to the application do not alter the general nature of the invention in a manner that would require the United States application to have been made available for inspection under 35 U.S.C. 181. Grant of this license authorizes the export and filing of an application in a foreign country or to any foreign patent agency or international patent agency when the subject matter of the foreign application corresponds to that of the domestic application. This license includes authority:

(1) To export and file all duplicate and formal application papers in foreign countries or with international agencies;

(2) To make amendments, modifications, and supplements, including divisions, changes or supporting matter consisting of the illustration, exemplification, comparison, or explanation of subject matter disclosed in the application; and

(3) To take any action in the prosecution of the foreign application provided that the adding of subject matter or taking of any action under paragraphs (a)(1) or (2) of this section does not change the general nature of the invention disclosed in the application in a manner that would require such application to have been made available for inspection under 35 U.S.C. 181 by including technical data pertaining to:

(i) Defense services or articles designated in the United States Munitions List applicable at the time of foreign filing, the unlicensed exportation of which is prohibited pursuant to the Arms Export Control

Act, as amended, and 22 CFR parts 121 through 130; or

(ii) Restricted Data, sensitive nuclear technology or technology useful in the production or utilization of special nuclear material or atomic energy, dissemination of which is subject to restrictions of the Atomic Energy Act of 1954, as amended, and the Nuclear Non-Proliferation Act of 1978, as implemented by the regulations for Unclassified Activities in Foreign Atomic Energy Programs, 10 CFR part 810, in effect at the time of foreign filing.

(b) Applications or other materials which were required to be made available for inspection under 35 U.S.C. 181 will be eligible for a license of the scope provided in this paragraph. Grant of this license authorizes the export and filing of an application in a foreign country or to any foreign patent agency or international patent agency. Further, this license includes authority to export and file all duplicate and formal papers in foreign countries or with foreign and international patent agencies and to make amendments, modifications, and supplements to, file divisions of, and take any action in the prosecution of the foreign application, provided subject matter additional to that covered by the license is not involved.

\* \* \* \* \*

(d) In those cases in which no license is required to file or export the foreign application, no license is required to file papers in connection with the prosecution of the foreign application not involving the disclosure of additional subject matter.

(e) Any paper filed abroad or transmitted to an international patent agency following the filing of a foreign application that changes the general nature of the subject matter disclosed at the time of filing in a manner that would require such application to have been made available for inspection under 35 U.S.C. 181 or that involves the disclosure of subject matter listed in

paragraphs (a)(3)(i) or (ii) of this section must be separately licensed in the same manner as a foreign application. Further, if no license has been granted under § 5.12(a) on filing the corresponding United States application, any paper filed abroad or with an international patent agency that involves the disclosure of additional subject matter must be licensed in the same manner as a foreign application.

\* \* \* \* \*

## PART 11—REPRESENTATION OF OTHERS BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

■ 41. The authority citation for 37 CFR part 11 continues to read as follows:

**Authority:** 5 U.S.C. 500, 15 U.S.C. 1123; 35 U.S.C. 2(b)(2), 32, 41.

■ 42. Section 11.10 is amended by revising paragraph (b)(3)(iii) to read as follows:

### § 11.10 Restrictions on practice in patent matters.

\* \* \* \* \*

(b) \* \* \*

(3) \* \* \*

(iii) Particular patent or patent application means any patent or patent application, including, but not limited to, a provisional, substitute, international, international design, continuation, divisional, continuation-in-part, or reissue patent application, as well as any protest, reexamination, petition, appeal, or interference based on the patent or patent application.

\* \* \* \* \*

Dated: November 20, 2013.

**Teresa Stanek Rea,**

*Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office.*

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