

A Mark-Up and Commentary on the Patent Law Treaties Implementation Act of 2012

DESIGN.
A. BARTHOLDI.
Statue.
No. 11,023. Patented Feb. 18, 1879



Copyright by Statue for Liberty and American Republics, Inc., N.Y.

by Dennis Crouch

A Mark-Up and Commentary on the Patent Law Treaties Implementation Act of 2012

Dennis Crouch

Associate Professor of Law

University of Missouri School of Law

www.patentlyo.com

Notes: DRAFT

Dennis Crouch, December 9, 2012

Table of Contents

A Mark-Up and Commentary on the Patent Law Treaties Implementation Act of 2012	2
Introduction.....	4
Effective Dates.....	6
Summary of New Law from the Congressional Research Service.	7
35 U.S.C. 100 Definitions.	9
35 U.S.C. 102 Conditions for patentability; novelty.	10
35 U.S.C. 111 Application.	11
35 U.S.C. 115 Inventor’s oath or declaration.	13
35 U.S.C. 120 Benefit of earlier filing date in the United States.....	16
35 U.S.C. 154 Contents and term of patent; provisional rights.....	17
35 U.S.C. 171 Patents for designs.....	19
35 U.S.C. 172 Right of priority.	19
35 U.S.C. 173 Term of design patent.	19
35 U.S.C. 289 Additional remedy for infringement of design patent.	20
35 U.S.C. 365 Right of priority; benefit of the filing date of a prior application.....	21
35 U.S.C. 366 Withdrawn international application.....	22
New Section: 35 U.S.C. 381 Definitions	23
New Section: 35 U.S.C. 382 Filing international design applications	24
New Section: 35 U.S.C. 383 International design application	25
New Section: 35 U.S.C. 384 Filing date.....	26
New Section: 35 U.S.C. 385 Effect of international design application	26
New Section: 35 U.S.C. 386. Right of priority	27
New Section: 35 U.S.C. 387. Relief from prescribed time limits.....	28
New Section: 35 U.S.C. 388 Withdrawn or abandoned international design application.....	29
New Section: 35 U.S.C. 389 Examination of international design application	30
New Section: 35 U.S.C. 390 Publication of international design application	31

Introduction.

On December __, 2012, President Obama enacted the Patent Law Treaties Implementation Act of 2012, Public Law No 112-__ (S. 3486).

The new law is designed to implement two patent law treaties:

- (1) **The Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva on July 2, 1999** (“Hague Agreement”) and
- (2) **The Patent Law Treaty** (“PLT”).

Both treaties were ratified by the Senate without opposition, and both are intended to simplify the formal obligations and reduce costs for American rights-holders when seeking patent protection outside the United States. A corollary result is that that treaty implementation also eases the obligations of foreign rights-holders when seeking patent protection within the United States.

The Hague Agreement

Implementation of the Hague Agreement creates an international design application that can serve as the basis for filing industrial design applications in countries around the world. The new provisions are codified in ten new sections of the Patent Act and a handful of amendments within the statute. See 35 U.S.C. §§ 381 – 390. In addition to the added statutory language, the USPTO is also required to “perform all acts connected with the discharge of its duties under the treaty.” 35 U.S.C. 382. One such obligation is to forward any international application to the International Bureau of WIPO who would then publish the application. Currently, most international design applications are filed directly with WIPO. However, it seems that the US structure will likely encourage applicants to file the international application in the US first.

The international design application is roughly the design parallel to the international utility patent application known as the PCT application. This should significantly reduce the cost of obtaining design protection in additional countries. Although the Hague Agreement is an important step, global industrial design laws vary widely. The next relatively small step toward harmonization would be to rationalize the various rules and laws regarding drawings in design patent applications. Drawings are especially important for design rights because those drawings typically define the scope of rights being claimed. At this point,

harmonization on this front does not necessarily require further negotiations within the Hague Agreement but could instead be accomplished through bilateral and multilateral agreement between the various offices administering the design rights.

For domestic applicants, the new law extends the term of design patents by an extra year to 15-years as calculated from the design patent's date of issuance. In the US, no maintenance fees are due and so design patents tend to remain in force for their entire 15-years unless subject to any terminal disclaimers.

International design patent applications are published soon after filing. However, an applicant can delay the publication for up to 30-months. Upon publication, those design applications will be considered prior art as of the application filing date. The publication will also create the prospect of provisional rights under 35 U.S.C. 154(d)(1) to allow a patentee to collect back-damages against unauthorized pre-issuance usage of the design by someone with actual knowledge of the pending application. For several reasons, provisional rights been only marginally useful for utility patent holders. However, there is some expectation that provisional rights will be more useful for design patent holders because (1) the patents more often cover products released on the market during the application period; (2) design inventions are more often copied but those copies easier to identify; and (3) design patents are more rarely amended during prosecution.

Patent Law Treaty

The Patent Law Treaty is a procedural treaty that is designed to limit formal and procedural requirements that countries can place on patent applicants and patentees. The Patent Law Treaty also provides a particular filing date standard.

The key change is that a utility application will now be given a filing date even if filed without claims. 35 U.S.C. 111. The quasi-requirement of drawings is also removed from the filing date requirement. Thus, the filing date requirement will now read as follows: "The filing date of an application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office." *Id.* Some applicants will rely upon this change to reduce the immediate transaction costs of moving from a provisional application filed without claims to a non-provisional application that previously required claims.

Purpose

This volume is intended to serve as helpful tool in understanding implementation of the new provisions of the law and should be especially helpful for those wanting to understand how the law has changed.

Effective Dates.

Implementation Date	Provisions being Implemented
Later of (a) 1-year from enactment or (b) entry into force of the treaty	Hague Agreement
Shall take effect on the date that is 1 year after the date of the enactment of this Act and applies to all patents and patent applications regardless of filing or issue date. However, the amendments to 35 U.S.C. 111 only apply to applications with an effective filing date on or after the 1-year date. Finally, the changes stemming from the Patent Law Treaty “shall have no effect with respect to any patent that is the subject of litigation in an action commenced” before the 1-year date.	Patent Law Treaty changes

Summary of New Law from the Congressional Research Service.

Commentary: The following is a brief summary of the new law that was created by the Congressional Research Service (CRS). CRS is a division of the Library of Congress that works exclusively for the United States Congress to provide policy and legal analysis to committees and Members of both the House and Senate, regardless of party affiliation.

* * * * *

Patent Law Treaties Implementation Act of 2012 - Amends federal patent law to implement the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (Hague Treaty) and the Patent Law Treaty. (Both treaties were ratified by the Senate on December 7, 2007.)

Standardizes application procedures to be consistent with other member countries.

Title I: Hague Agreement Concerning International Registration of Industrial Designs - (Sec. 101) Allows any person who is a U.S. national, or has a domicile, habitual residence, or real and effective industrial or commercial establishment in the United States, to file an international design application for international registration with the U.S. Patent and Trademark Office (USPTO) (thereby enabling U.S. applicants to file a single application with USPTO instead of separate applications in multiple countries).

Directs the USPTO to collect and transmit international fees and forward international design applications to the intergovernmental International Bureau recognized as the coordinating body under the Hague Treaty and its common regulations.

Requires an international design application on an industrial design made in the United States to constitute the filing of an application in a foreign country if such application is filed: (1) in a country other than the United States, (2) at the International Bureau, or (3) with an intergovernmental organization.

Requires the filing date of an international design application in the United States to be the effective registration date, except that any international design application designating the United States that otherwise meets the requirements of federal patent law (notwithstanding the implementation of the treaty) may be treated as a design application under existing federal laws applicable to design patents.

Permits applicants to request a review of the filing date of an international design application in the United States. Authorizes the USPTO Director to determine that such filing date is a date other than the effective registration date.

Sets forth requirements for determining the right of priority of national applications and prior foreign and national applications with earlier filing dates.

Directs the Director to provide for the examination of international design applications designating the United States. Authorizes the Director to issue patents based on such applications.

(Sec. 102) Extends provisional rights (the right to obtain royalties from persons who sell or engage in certain activities involving the invention during the period beginning on the date the application is published and ending on the date the patent is issued) to such international design applications filed under the treaty that designate the United States.

Title II: Patent Law Treaty Implementation - (Sec. 201) Revises patent application procedures with respect to filing dates, fees, and surcharges for fees, oaths, or declarations and claims submitted after the filing date. Authorizes the Director to prescribe conditions on references to previously filed applications.

Permits the Director to establish procedures to revive an unintentionally abandoned patent application, accept an unintentionally delayed payment of the fee for issuing each patent, or accept an unintentionally delayed response by the patent owner in a reexamination proceeding, upon petition by the applicant or patent owner.

Authorizes the Director to: (1) prescribe regulations and fees for the extension of application periods for inventors who previously filed provisional applications or applications for the same invention in a foreign country, (2) establish procedures to accept an unintentionally delayed claim for priority under the Patent Cooperation Treaty and to accept a priority claim that pertains to an application that was not filed within the specified priority period but was filed within the extended application period.

Directs the USPTO to maintain a register of interests in patents and applications for patents. Applies patent assignment requirements to interests that constitute an assignment, grant, or conveyance.

35 U.S.C. 100 Definitions.

Commentary: This is a conforming amendment to ensure the international design application counts as an effective priority document.

* * * * *

When used in this title unless the context otherwise indicates -

...

(i)(1) The term "effective filing date" for a claimed invention in a patent or application for patent means-

(A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), ~~or 365(b)~~, or 386(b) or to the benefit of an earlier filing date under section 120, 121, ~~or 365(c)~~, or 386(c).

(2) The effective filing date for a claimed invention in an application for reissue or reissued patent shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

35 U.S.C. 102 Conditions for patentability; novelty.

Commentary: Ensures that the international design application counts as a prior art document as of its filing date, so long as the application is eventually published as an application or the patent issued

* * * * *

(a) Novelty; Prior Art- A person shall be entitled to a patent unless--

(1) the claimed invention was patented or, described in a printed publication in this or a foreign country, or in public use or, on sale in this country, more than one year prior, or otherwise available to the public before the effective filing date of the application for patent in the United States, claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

...

(d) Patents and Published Applications Effective as Prior Art- For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application--

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), ~~or 365(b)~~, 386(a), or 386(b), or to claim the benefit of an earlier filing date under section 120, 121, ~~or 365(c)~~, or 386(c) based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

35 U.S.C. 111 Application.

Commentary: This amendment comes from the patent law treaty and rewrites the minimum filing requirements necessary in order to obtain a filing date. It provides the USPTO Director authority to set the timing of the filing of the oath and claims. The result is that non-provisional applications can be filed without any claims.

* * * * *

(a) IN GENERAL.-

(1) WRITTEN APPLICATION.-An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) CONTENTS.-Such application shall include-

(A) a specification as prescribed by section 112;

(B) a drawing as prescribed by section 113; and

(C) an oath or declaration as prescribed by section 115.

(3) FEE AND OATH OR DECLARATION, AND CLAIMS.-The application ~~must~~ shall be accompanied by the fee required by law. The fee, ~~and~~ oath or declaration, and 1 or more claims may be submitted after the filing date of the application, specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. ~~(4) FAILURE TO SUBMIT.-~~ Upon failure to submit the fee, ~~and~~ oath or declaration and 1 or more claims within such prescribed period, the application shall be regarded as abandoned, ~~unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath or declaration was unavoidable or unintentional.~~

(4) FILING DATE - The filing date of an application shall be the date on which ~~the a~~ specification, with or without claims, and any required drawing are ~~is~~ received in the United States Patent and Trademark Office.

(b) PROVISIONAL APPLICATION.-

(1) AUTHORIZATION.-A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include-

(A) a specification as prescribed by section 112(a); and

(B) a drawing as prescribed by section 113.

(2) CLAIM.-A claim, as required by subsections (b) through (e) of section 112, shall not be required in a provisional application.

(3) FEE.- ~~(A)~~The application must be accompanied by the fee required by law. ~~(B)~~The fee may be submitted after the ~~specification and any required drawing are submitted,~~ filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. ~~(C)~~Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, ~~unless it is shown to the satisfaction of the Director that the delay in submitting the fee was unavoidable or unintentional.~~

(4) FILING DATE.-The filing date of a provisional application shall be the date on which ~~the a specification and any required drawing are,~~ with or without claims, is received in the United States Patent and Trademark Office.

(5) ABANDONMENT.-Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3), if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

(6) OTHER BASIS FOR PROVISIONAL APPLICATION.-Subject to all the conditions in this subsection and section 119(e), and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.-A provisional application shall not be entitled to the right of priority of any other application under section 119, ~~or 365(a), or 386(a)~~ or to the benefit of an earlier filing date in the United States under section 120, 121, ~~or 365(c), or 386(c)~~.

(8) APPLICABLE PROVISIONS.-The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 131 and 135.

(c) Prior Filed Application- Notwithstanding the provisions of subsection (a), the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under subsection (a) to a previously filed application, specifying the previously filed application by application number and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date.

35 U.S.C. 115 Inventor's oath or declaration.

Commentary: Conforming amendment to include priority claims to international design applications.

* * * * *

(a) Naming the Inventor; Inventor's Oath or Declaration- An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application. Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.

(b) Required Statements- An oath or declaration under subsection (a) shall contain statements that--

(1) the application was made or was authorized to be made by the affiant or declarant;
and

(2) such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

(c) Additional Requirements- The Director may specify additional information relating to the inventor and the invention that is required to be included in an oath or declaration under subsection (a).

(d) Substitute Statement-

(1) IN GENERAL- In lieu of executing an oath or declaration under subsection (a), the applicant for patent may provide a substitute statement under the circumstances described in paragraph (2) and such additional circumstances that the Director may specify by regulation.

(2) PERMITTED CIRCUMSTANCES- A substitute statement under paragraph (1) is permitted with respect to any individual who--

(A) is unable to file the oath or declaration under subsection (a) because the individual--

(i) is deceased;

(ii) is under legal incapacity; or

(iii) cannot be found or reached after diligent effort; or

(B) is under an obligation to assign the invention but has refused to make the oath or declaration required under subsection (a).

(3) CONTENTS- A substitute statement under this subsection shall--

(A) identify the individual with respect to whom the statement applies;

(B) set forth the circumstances representing the permitted basis for the filing of the substitute statement in lieu of the oath or declaration under subsection (a); and

(C) contain any additional information, including any showing, required by the Director.

(e) Making Required Statements in Assignment of Record- An individual who is under an obligation of assignment of an application for patent may include the required statements under subsections (b) and (c) in the assignment executed by the individual, in lieu of filing such statements separately.

(f) Time for Filing- A notice of allowance under section 151 may be provided to an applicant for patent only if the applicant for patent has filed each required oath or declaration under subsection (a) or has filed a substitute statement under subsection (d) or recorded an assignment meeting the requirements of subsection (e).

(g) Earlier-Filed Application Containing Required Statements or Substitute Statement-

(1) EXCEPTION- The requirements under this section shall not apply to an individual with respect to an application for patent in which the individual is named as the inventor or a joint inventor and who claims the benefit under section 120, 121, ~~or 365(c)~~, or 386(c) of the filing of an earlier-filed application, if--

(A) an oath or declaration meeting the requirements of subsection (a) was executed by the individual and was filed in connection with the earlier-filed application;

(B) a substitute statement meeting the requirements of subsection (d) was filed in connection with the earlier filed application with respect to the individual; or

(C) an assignment meeting the requirements of subsection (e) was executed with respect to the earlier-filed application by the individual and was recorded in connection with the earlier-filed application.

(2) COPIES OF OATHS, DECLARATIONS, STATEMENTS, OR ASSIGNMENTS-

Notwithstanding paragraph (1), the Director may require that a copy of the executed oath or declaration, the substitute statement, or the assignment filed in connection with the earlier-filed application be included in the later-filed application.

(h) Supplemental and Corrected Statements; Filing Additional Statements-

(1) IN GENERAL- Any person making a statement required under this section may withdraw, replace, or otherwise correct the statement at any time. If a change is made in the naming of the inventor requiring the filing of 1 or more additional statements under this section, the Director shall establish regulations under which such additional statements may be filed.

(2) SUPPLEMENTAL STATEMENTS NOT REQUIRED- If an individual has executed an oath or declaration meeting the requirements of subsection (a) or an assignment meeting the requirements of subsection (e) with respect to an application for patent, the Director may not thereafter require that individual to make any additional oath, declaration, or other statement equivalent to those required by this section in connection with the application for patent or any patent issuing thereon.

(3) SAVINGS CLAUSE- A patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under this section if the failure is remedied as provided under paragraph (1).

(i) Acknowledgment of Penalties- Any declaration or statement filed pursuant to this section shall contain an acknowledgment that any willful false statement made in such declaration or statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.

35 U.S.C. 120 Benefit of earlier filing date in the United States.

Commentary: Conforming amendment to include priority claims to international design applications.

* * * * *

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 in an application previously filed in the United States, or as provided by section 363 or 385, names an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

35 U.S.C. 154 Contents and term of patent; provisional rights.

Commentary: Amends the provisional right provision (d) to provide for provisional rights based upon a published international design application. There is also a conforming amendment to confirm that a non-provisional application that claims priority to an international design application will have a 20 year term that begins on the date of the filing of the international design application.

* * * * *

(a) IN GENERAL.-

(1) CONTENTS.-Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.

(2) TERM.-Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, ~~or 365(c)~~, or 386(c), from the date on which the earliest such application was filed.

(3) PRIORITY.-Priority under section 119, 365(a), ~~or 365(b)~~, 386(a), or 386(b)- shall not be taken into account in determining the term of a patent.

(4) SPECIFICATION AND DRAWING.-A copy of the specification and drawing shall be annexed to the patent and be a part of such patent.

....

(d) PROVISIONAL RIGHTS.-

(1) IN GENERAL.- In addition to other rights provided by this section, a patent shall include the right to obtain a reasonable royalty from any person who, during the period beginning on the date of publication of the application for such patent under section 122(b), or in the case of an international application filed under the treaty defined in

section 351(a) designating the United States under Article 21(2)(a) of such treaty or an international design application filed under the treaty defined in section 381(a)(1) designating the United States under Article 5 of such treaty, the date of publication of the application, and ending on the date the patent is issued-

(A)

(i) makes, uses, offers for sale, or sells in the United States the invention as claimed in the published patent application or imports such an invention into the United States; or

(ii) if the invention as claimed in the published patent application is a process, uses, offers for sale, or sells in the United States or imports into the United States products made by that process as claimed in the published patent application; and

(B) had actual notice of the published patent application and, in a case in which the right arising under this paragraph is based upon an international application designating the United States that is published in a language other than English, had a translation of the international application into the English language.

(2) RIGHT BASED ON SUBSTANTIALLY IDENTICAL INVENTIONS.- The right under paragraph (1) to obtain a reasonable royalty shall not be available under this subsection unless the invention as claimed in the patent is substantially identical to the invention as claimed in the published patent application.

(3) TIME LIMITATION ON OBTAINING A REASONABLE ROYALTY.- The right under paragraph (1) to obtain a reasonable royalty shall be available only in an action brought not later than 6 years after the patent is issued. The right under paragraph (1) to obtain a reasonable royalty shall not be affected by the duration of the period described in paragraph (1).

(4) REQUIREMENTS FOR INTERNATIONAL APPLICATIONS-

(A) EFFECTIVE DATE.- The right under paragraph (1) to obtain a reasonable royalty based upon the publication under the treaty defined in section 351(a) of an international application designating the United States shall commence on the date of publication under the treaty of the international application, or, if the publication under the treaty of the international application is in a language other than English, on the date on which the Patent and Trademark Office receives a translation of the publication in the English language.

(B) COPIES.- The Director may require the applicant to provide a copy of the international application and a translation thereof.

35 U.S.C. 171 Patents for designs.

Commentary: No change to this section.

* * * * *

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U.S.C. 172 Right of priority.

Commentary: No change to this section.

* * * * *

The right of priority provided for by subsections (a) through (d) of section 119 and the time specified in section 102 (d) shall be six months in the case of designs. The right of priority provided for by section 119 (e) shall not apply to designs.

35 U.S.C. 173 Term of design patent.

Commentary: Shifts design patent term from 14-years to 15-years as calculated from the date of design patent issuance.

* * * * *

Patents for designs shall be granted for the term of ~~fourteen~~ 15 years from the date of grant.

35 U.S.C. 289 Additional remedy for infringement of design patent.

Commentary: No change to this section.

* * * * *

Whoever during the term of a patent for a design, without license of the owner,

(1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or

(2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

35 U.S.C. 365 Right of priority; benefit of the filing date of a prior application.

Commentary: Conforming amendments for international design application priority.

* * * * *

(a) In accordance with the conditions and requirements of subsections (a) through (d) of section 119, a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States.

(b) In accordance with the conditions and requirements of section 119(a) and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States.

(c) In accordance with the conditions and requirements of section 120, an international application designating the United States shall be entitled to the benefit of the filing date of a prior national application, a prior international application designating the United States, or a prior international design application as defined in section 381(a)(6) designating the United States ~~or a prior international application designating the United States~~, and a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States or a prior international design application as defined in section 381(a)(6) which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.

35 U.S.C. 366 Withdrawn international application

Commentary: Conforming amendments for international design application priority.

* * * * *

Subject to section 367 of this part, if an international application designating the United States is withdrawn or considered withdrawn, either generally or as to the United States, under the conditions of the treaty and the Regulations, before the applicant has complied with the applicable requirements prescribed by section 371 (c) of this part, the designation of the United States shall have no effect after the date of withdrawal, and shall be considered as not having been made, unless a claim for ~~the benefit of a prior filing date under section 365 (c) of this part~~ section was made in a national application, or an international application designating the United States, or a claim for benefit under section 386(c) was made in an international design application designating the United States, filed before the date of such withdrawal. However, such withdrawn international application may serve as the basis for a claim of priority under section 365 (a) and (b) ~~of this part,~~ or under section 386(a) or (b), if it designated a country other than the United States.

New Section: 35 U.S.C. 381 Definitions

Commentary: Definitions for the international design application requirements.

* * * * *

(a) In General- When used in this part, unless the context otherwise indicates--

(1) the term 'treaty' means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva on July 2, 1999;

(2) the term 'regulations'--

(A) when capitalized, means the Common Regulations under the treaty; and

(B) when not capitalized, means the regulations established by the Director under this title;

(3) the terms 'designation', 'designating', and 'designate' refer to a request that an international registration have effect in a Contracting Party to the treaty;

(4) the term 'International Bureau' means the international intergovernmental organization that is recognized as the coordinating body under the treaty and the Regulations;

(5) the term 'effective registration date' means the date of international registration determined by the International Bureau under the treaty;

(6) the term 'international design application' means an application for international registration; and

(7) the term 'international registration' means the international registration of an industrial design filed under the treaty.

(b) Rule of Construction- Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.

New Section: 35 U.S.C. 382 Filing international design applications

Commentary: Part (a) identifies who is eligible to file an international design application at the USPTO. Part (c) refers to “Chapter 16.” That “chapter” of the patent act includes the three specific design patent statutes 35 U.S.C. 171, 172, and 173.

* * * * *

(a) In General- Any person who is a national of the United States, or has a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the United States, may file an international design application by submitting to the Patent and Trademark Office an application in such form, together with such fees, as may be prescribed by the Director.

(b) Required Action- The Patent and Trademark Office shall perform all acts connected with the discharge of its duties under the treaty, including the collection of international fees and transmittal thereof to the International Bureau. Subject 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.

(c) Applicability of Chapter 16- Except as otherwise provided in this chapter, the provisions of chapter 16 shall apply.

(d) Application Filed in Another Country- An international design application on an industrial design made in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17 if the international design application is filed--

(1) in a country other than the United States;

(2) at the International Bureau; or

(3) with an intergovernmental organization.

New Section: 35 U.S.C. 383 International design application

Commentary: Additional requirements of an international design application.

* * * * *

In 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.

New Section: 35 U.S.C. 384 Filing date

Commentary: This section makes clear, *inter alia*, that an international design applications filed anywhere will qualify as a US application so long as the application meets the filing requirements of a US design patent application.

* * * * *

(a) In General- Subject to subsection (b), the filing date of an international design application in the United States shall be the effective registration date. Notwithstanding 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.

(b) Review- An applicant may request review by the Director of the filing date of the international design application in the United States. The 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. The 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.

New Section: 35 U.S.C. 385 Effect of international design application

Commentary: The key is that an international design application must designate the US in order to qualify as a priority document.

* * * * *

An international design application designating the United States shall have the effect, for all purposes, from its filing date determined in accordance with section 384, of an application for patent filed in the Patent and Trademark Office pursuant to chapter 16.

New Section: 35 U.S.C. 386. Right of priority

(a) National Application- In 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.

(b) Prior Foreign Application- In 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.

(c) Prior National Application- In accordance with the conditions and requirements of section 120, an international design application designating the United States shall be entitled to the benefit of the filing date of a prior national application, a prior international application as defined in section 351(c) designating the United States, or a prior international design application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international design application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application as defined in section 351(c) which designated but did not originate in the United States or a prior international design application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.

New Section: 35 U.S.C. 387. Relief from prescribed time limits

Commentary: USPTO has authority to forgive timing failures associated with an international design application. The reference to section 41(a)(7) is for revival of unintentionally abandoned applications.

* * * * *

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 section 41(a)(7), as may be prescribed by the Director.

New Section: 35 U.S.C. 388 Withdrawn or abandoned international design application

Subject to sections 384 and 387, if an international design application designating the United States is withdrawn, renounced or canceled or considered withdrawn or abandoned, either generally or as to the United States, under the conditions of the treaty and the Regulations, the designation of the United States shall have no effect after the date of withdrawal, renunciation, cancellation, or abandonment and shall be considered as not having been made, unless a claim for benefit of a prior filing date under section 386(c) was made in a national application, or an international design application designating the United States, or a claim for benefit under section 365(c) was made in an international application designating the United States, filed before the date of such withdrawal, renunciation, cancellation, or abandonment. However, such withdrawn, renounced, canceled, or abandoned international design application may serve as the basis for a claim of priority under subsections (a) and (b) of section 386, or under subsection (a) or (b) of section 365, if it designated a country other than the United States.

New Section: 35 U.S.C. 389 Examination of international design application

Commentary: Examination of the international design application is focused on ensuring that the fees have been paid.

* * * * *

(a) In General- The Director shall cause an examination to be made pursuant to this title of an international design application designating the United States.

(b) Applicability of Chapter 16- 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.

(c) Fees- The Director may prescribe fees for filing international design applications, for designating the United States, and for any other processing, services, or materials relating to international design applications, and may provide for later payment of such fees, including surcharges for later submission of fees.

(d) Issuance of Patent- The Director may issue a patent based on an international design application designating the United States, in accordance with the provisions of this title. Such patent shall have the force and effect of a patent issued on an application filed under chapter 16.

New Section: 35 U.S.C. 390 Publication of international design application

Commentary: The publication of an international design registration designating the United States will be treated as a “publication” under U.S. law, thereby providing the possibility of obtaining pre-issuance damages for the infringement of certain United States design patents. Likewise, the publication will serve to create prior art as of its filing date.

* * * * *

The publication under the treaty of an international design application designating the United States shall be deemed a publication under section 122(b).