

Foreign Design Patent Protection

A U.S. design or utility patent gives its owner the right to exclude others from commercializing the patented product only in the United States. As a result, foreign patents must be obtained to provide coverage in non-domestic markets. Foreign design patent protection can be effective at preventing foreign companies that manufacture your products from using your molds and tooling to replicate your product, particularly after the manufacturing relationship has ended. Additionally, the European Union and countries such as China and Japan have laws that allow customs officials to enforce certain design patent rights.

Foreign filing of design patents differs in certain key aspects from that of utility patents. First, the decision as to where to file has to be made much earlier than with utility patents. Second, the drawing requirements can vary country to country. Finally, the patent terms are different in many jurisdictions.

TIMING

After filing a U.S. utility patent application, the owner has one year to file applications abroad and still claim the benefit of the earlier U.S. filing date in the counterpart foreign applications. A popular approach is to file a Patent Cooperation Treaty (PCT) application, which preserves the ability to file in almost 200 countries for a still further 18 to 19 months (or approximately 30 to 31 months from the earliest U.S. filing date). A PCT application allows the applicant to deal with issues pertaining to patentability up front, before the application branches out into each country of interest. By the end of the 30 to 31 months, the applicant often has a good idea whether the subject matter can be protected and how meaningful that protection should be.

However, the period for filing a U.S. design patent overseas is much shorter. A patent owner has only six months from the earliest U.S. filing date to make foreign filings which claim priority to the U.S. application, and there is no equivalent PCT application. Therefore, a U.S. applicant must decide in which countries to pursue a design patent at an earlier date than it would for a utility patent. In addition, the owner does not have the benefit of an initial examination of design patentability that it receives with the PCT application for utility patents.

The U.S. recently joined the Hague System for the International Registration of Industrial Designs, and as of 2015, U.S. applicants can use the Hague System to attain some procedural efficiencies when filing in numerous foreign countries. However, a Hague application does not operate like a PCT application, and there are some potential downsides to using the system that should be carefully considered.

DRAWING REQUIREMENTS

Be aware that the rules and practice governing figures in design applications may differ abroad. Solid lines in the figures of a U.S. design patent illustrate the features that one is trying to protect, whereas dashed lines are used to indicate unclaimed environment or boundaries, or both. Some countries, such as Canada and the countries of the European Union, also permit the use of dashed lines. However, other countries, such as China, do not allow dashed lines and thus require patent applicants to prepare a different version of the drawings. The use of surface shading can also vary country to country.

In some cases, the differences in drawing requirements among foreign countries can affect the initial U.S. filing strategy. Accordingly, it's helpful in the early stages of a design application to have an idea of the countries in which you plan to pursue design protection.

PATENT TERMS

The term during which a design patent is in force varies significantly from country to country. In the U.S., design applications filed on or after May 13, 2015 have a term of 15 years from their issue date. China has 10-year design patent terms, while European community design registrations can be kept in force up to 25 years assuming periodic renewal fees are paid. Awareness of the patent term differences can help you estimate when competitors may try to copy the look of your product in a given country.

CONCLUSION

Design applications present distinct foreign filing considerations as compared to utility applications. Being aware of these considerations can smooth the patenting process and in some cases improve the ultimate coverage that is obtained.