

Publishing Design Patent Applications: Time to Act

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Last summer I wrote a paper² with this same title explaining why now is the time to commence universal publication of all design patent applications filed in the United States. Indeed, recent events have made this the perfect time to legislate such transparency.

The United States has now deposited its instrument of ratification of the Geneva Act of the Hague Agreement Concerning International Registration of Industrial Designs. The Geneva Act will enter into force, in respect to the United States, on May 13, 2015. The Final Rules were published by the USPTO on April 2, 2015. U.S. applicants will be able to file under Hague, have their Hague-filed applications published by the International Bureau of the World Intellectual Property Organization at 6 months from filing, and be eligible following such international publication for provisional rights to recover a reasonable royalty under 35 U.S.C. 154(d).

For the reasons stated in my earlier paper, all U.S. design applicants—not just Hague applicants—should have the benefits that come from this type of universal examination transparency. Transparency places design patent applicants into the driver's seat, able to head off those that may be tempted to copy a product incorporating the published design. They can develop a filing plan which meets their circumstances and know exactly when their application will be published making provisional rights available.

Importantly, the published application will produce an immediate prior art effect retroactive to its filing date once published—for both anticipation and obviousness purposes. Thus, those who would subsequently seek to obtain patents on the same design or obvious variants would be blocked.

Armed with the knowledge from published pending patent filings, competitors will have the opportunity at an early point in their commercialization process to design away from designs covered by published claims. They can thereby avoid the potential exposure under provisional rights, as well as the potential for post issuance infringement liability for the infringer's total profits (35 U.S.C. 289).

The public will benefit from the opportunity to provide input into the examination process. Public input during the examination phase carries with it the promise of a higher quality examination and more

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² Griswold, Gary L., *Publishing Design Patent Applications: Time to Act*, Patently-O (August 24, 2014), available at <http://patentlyo.com/patent/2014/08/publishing-design-applications.html> and IPO L.J. (August 26, 2014), available at http://www.ipo.org/wp-content/uploads/2014/08/design_patent_gg_article.pdf

certain patent validity. Competitors will have the ability to provide patent examiners with prior art that might otherwise not surface or be overlooked.

This is possible because the America Invents Act (AIA) offers a brief time window after publication of an application for public submissions of prior art to patent examiners. The limited duration of this opportunity assures that the speed of examination is not negatively impacted. Public input of this type can have the collateral benefit of lessening the likelihood that a PGR or IPR will be initiated based upon missed or overlooked prior art during the patent application filing and examination process.

Publication of domestic design patent applications should occur, as it does for international design patent applications under Hague, six months after the U. S. filing. In my earlier paper, I explained the reasons that 18 month publication used for utility patent application publication is inappropriate for design applications. The short examination pendency before design applications mature into issued patents dictates that design patent applications be published at six months.

Understandably, concerns over this move to transparency have been expressed by those who have grown comfortable with the pre-Hague status quo. Adapting to any new regime requires adjustments to new opportunities and new challenges. Utility patent practitioners have blazed the trail here, having gone through a major change-in-practice drill with the America Inventor's Protection Act (AIPA) and AIA. In the end, the transparency that early publication would provide and the benefits that it would offer to clients argue strongly for professionals to embrace this change.

An important goal of the patent system is to promptly and efficiently grant valid patents on inventions that stimulate marketplace innovation. Publishing design patent applications advances that goal.