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The Hague Agreement Facilitates International Protection for Designs

By Kevin R. Casey

Inventors may obtain one of three types of patents in the United States. They are, in order of decreasing number of granted patents, (1) utility patents, which cover the functional features of a machine, article of manufacture, composition of matter or process; (2) design patents, which cover the ornamental aspects of utilitarian objects; and (3) plant patents, which cover asexually reproduced plants. The patent types are not mutually exclusive. Thus, if a product has both functional and ornamental features, an inventor can obtain both utility and design patent protection for that product.



FIG. 2 illustrates the ornamental features of a dispensing applicator with a concave grip as protected by U.S. Design Patent No. D663,836, obtained for Stradley client Adhezion Biomedical LLC.

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The IP Group Welcomes Phil Foret and Lisa Scher



Intellectual property attorney **Philip J. Foret** has joined the firm as a partner in our Malvern, Pennsylvania, office. He was most recently co-chair of the IP group at Dilworth Paxson LLP. Phil represents clients in the full range of IP matters, including counseling and opinions, patent and trademark prosecution, trademark and copyright matters, and transactional due diligence. He has assisted many clients in developing worldwide patent and trademark portfolios with comprehensive strategies for enforcement, competitive landscapes, and licensing and protecting commercial embodiments. He helps companies leverage both IP rights and technology through licensing, technology, joint development and research agreements. Phil's experience spans many industries, including consumer and pet products, food science, industrial chemicals, pharmaceuticals, biotechnology, medical devices, stem cell

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Foreign Protection for Utility Patents

Since 1978, U.S. inventors have been able to extend their utility patent applications to foreign countries using the Patent Cooperation Treaty (PCT). The PCT is an international patent law treaty that allows the U.S. applicant to file one application, “an international application,” in a standardized format in English in the U.S. Receiving Office (the U.S. Patent and Trademark Office, or USPTO). The PCT application is acknowledged as a regular national or regional filing in as many countries or regions that are signatories to the PCT as the applicant “designates,” “elects,” or names to be countries or regions in which patent protection is desired. In short, the PCT facilitates worldwide filing of utility patent applications.

A Void for Design Patents

Until earlier this year, however, an inventor had to file a separate application in each intended country or region of interest to obtain worldwide design patent protection. Such filings required U.S. applicants to expend significant time and incur significant costs on a design application (generally called industrial designs outside the United States) in each respective country or region. A treaty like the PCT for utility patents was clearly needed for design patents.

The Void Is Filled by the Hague Agreement

That treaty arrived on May 13, 2015, when (a) the United States became a member of the Hague Union and (b) the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (Hague Agreement) became effective in this country. U.S. applicants can now file a single international design application electronically either directly with the World Intellectual Property Organization (WIPO) in Geneva, Switzerland, or indirectly with the USPTO to obtain protection for up to 100 industrial designs in the countries (currently over 60) that are parties to the Hague Agreement. (If the application is filed through the USPTO, the USPTO will transmit the application to WIPO on behalf of the applicant.)

The applicant must designate, upon filing the application, the countries or regions where design patent protection is desired. A fee is associated with filing in each designated country. Therefore, the larger the number of designated countries, the higher the total fee. The filing fee is expected to be significantly less, however, than the initial, combined cost of filing



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directly in multiple foreign countries.

No translations are needed; filing the international design application in English suffices. WIPO reviews the application for compliance with formal requirements (there is no consideration of prior art or substantive review). WIPO’s single formalities review eliminates the need for each country to conduct its own formalities examination. If WIPO determines that the application complies with formal requirements, then the application is published and transmitted to the countries designated by the applicant.

Each designated country has six or 12 months from publication to refuse registration, depending on the level of substantive examination provided under that country’s law. Such a refusal must be based on substantive examination and not formalities objections. Some countries will conduct a full substantive examination; other countries will simply grant registration of the application. When the applicant designates the United States, the USPTO will examine the application according to standard U.S. prosecution procedures. Therefore, the United States will continue to substantively examine design applications and to grant design rights in the form of U.S. design patents in the same way, whether the application is filed pursuant to the Hague Agreement or as a United States design patent application. U.S. design patents resulting from applications filed on or after May 13, 2015, will have a 15-year term, however, rather than the previous 14-year term for U.S. design patents.

A single international design application replaces a series of applications that otherwise would have been filed with individual national (or regional) patent offices. Thus, the Hague Agreement offers applicants increased filing efficiencies and potential cost savings in pursuing protection for their innovative industrial designs. Applicants that use the streamlined design application process of the Hague Agreement are also expected to

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technology, industrial manufacturing processes and systems, telecommunications, data systems technology, financial services, business methods, and sporting goods. In addition to his deep IP counseling practice, Phil has experience in IP litigation, representing clients in patent infringement cases in federal courts and arbitrations, as well as filing amicus briefs with the U.S. Court of Appeals for the Federal Circuit and the U.S. Supreme Court in the seminal *In re Bilski* case. He has also successfully argued domain name disputes before the National Arbitration Forum and has resolved trademark disputes through administrative proceedings before the Trademark Trial and Appeal Board.



Lisa Scher has joined Stradley Ronon as an IP lawyer resident in our Malvern, Pennsylvania, office. Lisa is a trademark attorney who has handled trademark preparation and prosecution matters both domestically and internationally. After beginning her career as a trademark examining attorney with the United States Patent and Trademark Office, Lisa has worked continuously in private practice. Her inside perspective on prosecuting federal trademark applications and her vast experience combine to give her unique tools when counseling clients. Lisa's experience extends beyond trademark preparation and prosecution, having recently resolved a trademark infringement matter brought by a Fortune 500 company against a much smaller client. She also negotiates and drafts trademark-related licenses. ■

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obtain the benefits of predictable patent prosecution and maintenance costs and improved consistency in foreign design application filings. Still further, the publication of the international design application can create provisional rights that do not exist under current U.S. design application procedures, which do not allow for publication of pending design applications. The many advantages offered by the Hague Agreement may prove useful to applicants that plan to manufacture or sell utilitarian products having ornamental aspects, and wish to protect their industrial designs, outside the United States.

The Future

The Hague system is expected to experience significant growth over the next few years with the addition of several countries to the list of members. Canada, China and Russia are among the countries exploring membership in the near future, for example, and the system will become increasingly appealing as additional countries agree to the terms of the Hague Agreement. To follow progress and keep informed about the Hague system, including geographic coverage and a guide for users, see WIPO's website at <http://www.wipo.int/hague/en/>. You can also learn more at <http://www.uspto.gov/patent/initiatives/hague-agreement-concerning-international-registration-industrial-designs>. ■

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IP Client Spotlight

Stradley Ronon is proud to handle matters involving patent, trademark, copyright, trade secrets and related areas of IP law for Adhezion Biomedical LLC. Based in Wyomissing, Pennsylvania, Adhezion is a privately held medical device company focused on the development and commercialization of highly differentiated, cyanoacrylate-based surgical, wound-management, and infection-prevention technologies. The vision of the Adhezion team is to redefine the way cyanoacrylate-based surgical adhesives and sealants are used in medicine. Its mission is to develop unique cyanoacrylate formulations that address specific medical and surgical modalities. Adhezion has a robust product pipeline under development and several products that are being commercialized

in the United States and overseas markets.

One aspect of Stradley's representation has been to obtain utility patent protection for the adhesives and sealants developed by Adhezion. Stradley has also been involved in obtaining patent protection for the ornamental features of Adhezion's dispensing applicators. (See the accompanying article on design patent protection.) Taken together, Adhezion's utility and design patents comprise a valuable patent portfolio. Still further, Stradley took steps to block third parties from registering Adhezion's trademarks under the top-level domain name .XXX and, more recently, has taken similar steps now that the launch of the controversial .SEX generic top-level domain is imminent. ■

SPEAKING OF. . .

Stradley Ronon Partner Serves as Judge for Malvern Prep "Shark Tank" Challenge and Speaks at Federal Circuit Historical Society Event

Stradley Ronon IP Chair [Kevin Casey](#) served on a panel of judges for Malvern Preparatory School's "Shark Tank Challenge" on Oct. 15. Malvern's seventh-grade Academy students created an improved packaging design for a product of their choice that resolves the environmental issue of wasteful packaging material. The students also used graphic design to create a brand and logo for their packaged product. The judging panel, made up of professionals with engineering and educational expertise, gave feedback on the environmental and economic benefits of each design and judged the participants on the redesign's sustainability, effectiveness and design. The competition was based on the popular network television show "Shark Tank."

Kevin also presented "The Barbed Wire Invention: An External Factor Affecting American Legal Development" at The Federal Circuit Historical Society luncheon during the Federal Circuit Bar Association's 2015 Bench & Bar Conference in Dana Point, California. The discussion focused on the changes in rules of law fostered by the invention of the barbed wire fence and its impact in five areas of law, namely antitrust, property, tort, fencing and patent law.

23 Stradley Ronon Attorneys Named 2016 Best Lawyers in America

Twenty-three Stradley Ronon attorneys, including several in the IP group, were named to the recently released 2016 edition of *The Best Lawyers in America*, regarded as a definitive guide to legal excellence in the region. The chosen lawyers received high ratings from their peers in the publication's annual survey for their "abilities, professionalism and integrity." The IP attorneys who were honored include [Kevin Casey](#) (Litigation – Intellectual Property/ Patent Law/ Trademark Law), [Joe Rossi](#) (Patent Law) and [Keith Duffill](#) (Litigation – Intellectual Property).

Kevin Casey Listed in 2015 edition of Chambers USA

IP Chair [Kevin Casey](#) was listed in the most recent edition of the prestigious legal directory Chambers USA: America's Leading Lawyers for Business. Attorney rankings within *Chambers USA* come from extensive independently conducted research and in-depth interviews with clients and attorneys. The rankings are based on technical legal ability, professional conduct, client service, commercial astuteness, diligence, commitment and other qualities most valued by the client. The directory described Kevin as "very knowledgeable" and "highly regarded for his work in patent and trademark prosecution and dispute resolution." ■