

DAS and Designs

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Disclaimer

This is a class. You are here to learn, not to get legal advice. I am not your lawyer and you are not my client.

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It started in Paris in 1883

- Paris Convention for the Protection of Industrial Property
- “The countries of the Union **may** require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing ...”

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Action item ...

- Get your own PDF copy of the Bodenhausen book
- Or you can buy a printed copy
- <https://shop.oppedahl.com>

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Paris Article 4

- You file in an Office of First Filing
- Within six months you file in an Office of Second Filing
- The second application is able to claim priority from the first application

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Patent Law Treaty

- Note that many countries, including the US, belong to the Patent Law Treaty, which permits Restoration of the Right of Priority under certain circumstances, including eight months for design applications

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If US is OSF

- See 35 USC § 119(a-d)
- See 37 CFR § 1.55
- See MPEP § 210
- In the case of the USPTO, for design applications this must be accomplished before the patent issues

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Depositing Offices for Designs

- AU, CA, CL, CN, ES, GE, IN, JP, KR, NO, US
- You might be claiming priority from a Hague Agreement application that designates at least one State that is not yours
- Conspicuously absent is EM

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You might be claiming priority from a utility patent application

- AR, AU, BR, CL, CN, DK, EA, EE, EP, ES, FI, GB, GE, IN, IL, JP, KR, MA, NE, NO, NZ, SE, US

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You might be claiming priority from a utility model application

- CL, CN, ES, FI, GE

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You might be claiming priority from a PCT application

- RO/AU, RO/BR, RO/CL, RO/CN, RO/DK, RO/EA, RO/EP, RO/ES, RO/FI, RO/GE, RO/IB, RO/IN, RO/IL, RO/MA, RO/NE, RO/NO, RO/SE
- Conspicuously absent – RO/US

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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 (Hague) 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 (Hague) 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) (PCT) designating at least 1 country other than the United States, or a prior international design application (Hague) designating at least 1 country other than the United States.

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Paris Article 4

- SAOSIT
- Applicant in Office of Second Filing needs to be the same as the applicant in the Office of First Filing
- Or successor in title
- This is not an idle requirement

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SAOSIT

- When you file a US application that might serve as a priority document
...
- Pay attention to who your applicant is
- Application Data Sheet

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Must claim from oldest priority app

- Filed design priority App1 disclosing design A in OFF – October 4, 2019
- Filed design priority App2 disclosing design A in OFF – October 10, 2019
- Can you file in OSF on April 10, 2020 directed to design A, claiming priority only from App2?

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Must claim from oldest priority app

- Filed design priority App1 disclosing design A in OFF – October 4, 2019
- Filed design priority App2 disclosing designs A and B in OFF – October 10, 2019
- Can you file in OSF on April 10, 2020 directed to design B, claiming priority only from App2?

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Abandoned LNRO

- Filed October 4, 2019
- On October 9, abandoned LNRO
- Filed October 10, 2019
- Can you wait until April 10, 2020 to file in OSF?

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Can you claim design domestic benefit from a US provisional?

- No. But see 37 CFR § 1.53(c)(3) for converting a US provisional to a US non-provisional.

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Certified copies: legacy approach

- The legacy approach is that counsel in the place of first filing obtain a physical certified copy of the priority application from the Office of first filing
- They physically send the physical certified copy to counsel in the place of second filing
- Counsel physically sends the physical certified copy to the Office of second filing

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Certified copies: legacy approach – docketing for instructing counsel

triggering event	docket to clear	docket to set
instructions sent to foreign counsel		docket to order a physical certified copy (PCC) from office of first filing
PCC arrives	clear docket	docket to send PCC to foreign counsel
PCC sent	clear docket	docket to check that courier says it delivered PCC
PCC delivered	clear docket	docket to check that foreign Office acks receipt of PCC
PCC received by foreign counsel	clear docket	docket to check that foreign Office acks receipt of PCC
foreign Office acks receipt	clear docket	

This requires setting and clearing at least five dockets.

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Certified copies: legacy approach – docketing for counsel in place of second filing (US example)

triggering event	docket to clear	docket to set
Instructions received from instructing counsel		docket to request a physical certified copy (PCC) from instructing counsel
Instructing counsel says it has sent the PCC, provides tracking number	clear docket	Set up notification from courier. Set docket to check for receipt of PCC
PCC received	clear docket	docket to check that PCC gets mailed to USPTO
PCC dropped into the mail	clear docket	docket to check that USPS says it delivered PCC
USPS says it delivered PCC	clear docket	docket to check that postcard is received
Post card is received	clear docket	Docket to check for PCC being visible in IFW
PCC is visible in IFW	Clear docket	Docket to check for Box 4 or Box 12 being checked

This requires setting and clearing at least seven dockets.

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Cost of legacy approach

- Legacy approach requires setting and clearing maybe twelve dockets all told
- Legacy approach requires a certified copy fee, an international courier fee, and a domestic delivery fee

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Outbound DAS from the US

- The USPTO's standard ADS is “opt-out” for DAS
- Ways to **fail** to make an application available to DAS include the following:
 - Failure to properly sign the ADS
 - Checking the opt-out box in the ADS
 - Failure to include the ADS in the first EFS-Web filing in the application

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DAS outbound from the US

Here is the “opt-out” language from Form PTO/AIA/14

2. Opt-Out of Authorizations to Permit Access by a Foreign Intellectual Property Office(s)

- ☐ A. Applicant **DOES NOT** authorize the USPTO to permit a participating foreign IP office access to the instant application-as-filed. If this box is checked, the USPTO will not be providing a participating foreign IP office with any documents and information identified in subsection 1A above.

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DAS outbound from the US

Here is the Filing Receipt language
acknowledging the grant of permission

Permission to Access Application via Priority Document Exchange: Yes

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Transaction history

Transaction History	
Date	Transaction Description
01-04-2020	Case Docketed to Examiner in GAU
06-28-2019	Correspondence Address Change
06-17-2019	Case Docketed to Examiner in GAU
06-06-2019	Email Notification
06-06-2019	Application ready for PDX access by participating foreign offices
06-05-2019	Application Dispatched from OIPE
06-05-2019	FITF set to YES - revise initial setting
06-06-2019	Application Is Now Complete
06-06-2019	Application Is Now Complete
06-06-2019	Filing Receipt
06-03-2019	PRO/SE/OS Authorize EPO Access to Search Results
06-03-2019	Applicants have given acceptable permission for participating foreign
06-05-2019	Applicant Has Filed a Verified Statement of Small Entity Status in Compliance with 37 CFR 1.27
06-04-2019	Cleared by OIPE CSR
06-03-2019	IFW Scan & PACR Auto Security Review
06-03-2019	ENTITY STATUS SET TO UNDISCOUNTED (INITIAL DEFAULT SETTING OR STATUS CHANGE)
06-03-2019	Initial Exam Team nn

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DAS outbound from the US

If the filer ***failed*** to make an application available to DAS, then this may be remedied by:

- Filing Form PTO/SB/39
- Filing a word processor document containing equivalent language

In EFS-Web this should be indexed as

“Auth or Resc of Auth to Access Appl by DAS/PDX Office”

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DAS outbound from the US

Best practices:

- In general unless there is a good reason not to do so, each US application that you file that has any chance of being a priority document should be made available to DAS
- For each such application, obtain a Certificate of Availability from DAS
- For each such application, set up “tracking” in DAS

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Accessing office for designs

- AU, CA, CL, CN, ES, GE, IN, JP, KR, NO, US
- Which ID5 member is absent from this list?

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DAS outbound from the US

USPTO will not actually make an application available to DAS until several conditions are satisfied:

- USPTO has formally granted a filing date
- Application has been granted a Foreign Filing License
- Applicant has given permission for release of the application to DAS
- USPTO has formally recognized the permission

The filer should test this by obtaining a Certificate of Availability from DAS

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DAS outbound from the US

Action steps for US counsel for each recently filed US application:

- obtain a Certificate of Availability from DAS
- Set up “tracking” in DAS

This may require filing Form PTO/SB/39

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DAS outbound from the US

Action steps for US counsel for each new non-provisional US application that is filed going forward:

- Use an ADS in the initial EFS-Web filing to give permission for DAS access
- obtain a Certificate of Availability from DAS
- Set up “tracking” in DAS

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Certificate of availability

Get one for every case in your docket

Send to foreign counsel

CERTIFICATE OF AVAILABILITY OF A CERTIFIED INDUSTRIAL DESIGN DOCUMENT IN A DIGITAL LIBRARY

The International Bureau certifies that a copy of the industrial design application indicated below has been available to the WIPO Digital Access Service since the date of availability indicated, and that the industrial design application has been available to the indicated Office(s) as of the date specified following the relevant Office code:

Document details: Country/Office: US

Filing date: 29 Jun 2016 (29.06.2016)

Application number: 29569603














Date of availability of document: 27 Feb 2018 (27.02.2018)

The following Offices can retrieve this document by using the access code:

AU, CA, CL, CN, ES, GE, IN, JP, KR, NO, US

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Workbench

IP Right	Priority Number	Filing date	Access Code	Date of Availability	Last Accessed	Tracked By	Comments
Design	JP 2020-006765	2020-01-09		2020-01-10			 WADA
Design	US 296520	2020-01-05		2020-01-21			 BM D098-3
Design	US 296520	2019-08-27		2019-08-30			 LX01.D009
Design	CN 201930	2019-07-03		2019-12-27	2020-01-03 10:20:11.0		 C02 D001
Design	US 296935	2019-06-03		2019-06-06			 XC D010

1 2 3 4 5 6 7 8 9 10

Add Tracking Remove Tracking

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Notifications

<input type="checkbox"/>	Subject	IP Right	Priority Number	Received
<input type="checkbox"/>	This document is also tracked by following user(s): 'carl@ppedahl.com'.	Design	US 2965202	2020-03-31 00:46:59.0
<input type="checkbox"/>	This document is also tracked by following user(s): 'a@mtiplaw.com'.	Patent	US 62411157	2020-03-30 21:02:06.0
<input type="checkbox"/>	This document is also tracked by following user(s): 'p12@sheppardmullin.com'.	Patent	US 62411157	2020-03-30 19:13:33.0
<input type="checkbox"/>	This document is also tracked by following user(s): 'ard@s@mtiplaw.com'.	Patent	US 62411157	2020-03-30 17:11:41.0
<input type="checkbox"/>	This document is also tracked by following user(s): 'tabor@a@mtiplaw.com'.	Patent	US 62411157	2020-03-30 17:01:05.0
<input type="checkbox"/>	This document is also tracked by following user(s): 'p12@n@dsiplaw.com'.	Patent	US 62411157	2020-03-30 16:42:25.0
<input type="checkbox"/>	Accessing office 'IB' successfully retrieves this document.	Patent	US 627040	2020-03-30 11:02:58.0
<input type="checkbox"/>	Accessing office 'IB' successfully retrieves this document.	Patent	US 6282501	2020-03-30 10:51:22.0

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Retrieval history

Retrieval History for Priority Document Number: CN 201931508231		
RETRIEVAL DATE	AUTHORIZED OFFICE	COMMENTS
2020-01-03 10:20:11	US	Retrieved successfully
Close		

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Paris inbound to the US

- If the new US filing is a design application, and if priority document was filed in
AU, CA, CL, CN, ES, GE, IN, JP, KR, NO
- Maybe foreign counsel will provide a Certificate of Availability from DAS, in which case you can relax, otherwise:
 - Obtain the DAS access code from foreign counsel
 - Obtain a Certificate of Availability from DAS
 - Set up tracking in DAS
- Make sure that USPTO actually retrieves the priority document
- Docket to watch for acknowledgment in Box 4 or Box 12
- Docket to watch for a tracking notification from DAS

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Paris inbound to the US

- If the new US filing is a design application, and if priority document was filed in AU, CA, CL, CN, ES, GE, IN, JP, KR, NO
- Include the priority information in a suitably signed ADS, preferably at time of filing, along with the DAS access code
- Make very sure the priority information in the ADS is accurate (copy and paste from trusted source)
- Despite your having made an accurate DAS retrieval request, it is unfortunately your fault if USPTO fails to retrieve the ECC timely

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Hague Agreement inbound work to US

- Many US design patents issue from Hague filings with defective priority claims
- This happens because the applicant failed to provide a CC prior to issuance
- For priority applications filed in AU, CA, CL, CN, ES, GE, IN, JP, KR, NO:
 - DAS will save the day so long as the DAS access code was provided in the Hague Form DM/1, or
 - the filer can provide it in Form PTO/SB/38
- For priority applications filed elsewhere than in AU, CA, CL, CN, ES, GE, IN, JP, KR, NO, a PCC must be provided to USPTO
- Watch for acknowledgment in Box 4 or Box 12

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Hague Agreement outbound work from US

- US practitioners should get into the habit of providing the DAS access code (the confirmation code) in the Hague Form DM/1.
- Failure to provide the CC to a designated Office may lead to the priority claim being defective.
- Opposing counsel TYFNIL is likely to notice such failure even if it went unnoticed during prosecution
- Example: Japan

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The screenshot shows the JPO website with the following elements:

- Header:** JPO JAPAN PATENT OFFICE logo, Google Custom Search bar, and Text size options (S, M, L).
- Navigation Menu:** HOME, Announcements, Systems/Procedures, Related Services, Statistics/References, About JPO, FAQs.
- Breadcrumbs:** Home > Systems/Procedures > Designs > [International Design Application](#) > Geneva Act (Hague Agreement) > [Hague] Submission of priority documents using digital access service (DAS) to Japan Patent Office as the designated Contracting Party.
- Main Content:**
 - Title:** [Hague] Submission of priority documents using digital access service (DAS) to Japan Patent Office as the designated Contracting Party.
 - Text:** For Hague registrations with international registration dates on or after January 1, 2020, and with DAS access codes, the JPO will retrieve the priority documents through the DAS.
 - Text:** When the priority documents cannot be retrieved due to incomplete description of access codes, the JPO will send the Notification to the holders and invite them to correct the DAS access code or to submit the printed Priority documents to the JPO.

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Inbound work to USPTO – consequences of failure

- For a US design application, “failure” means the CC failed to reach the USPTO prior to issuance
- “failure” also means failure to obtain Examiner acknowledgment in Box 4 or Box 12
- If the practitioner fails to notice the failure, then opposing counsel will likely notice it
TYFNIL

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4 and 16 failure

- For US design patent applications, there is no 4-and-16 limit
- The priority claim can be presented any time before issue
- The CC can be provided any time before issue
- It is a Best Practice to provide the CC early enough for it be to acknowledged in Box 4 or Box 12

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Troubleshooting inbound DAS failure

Does the blame lie with the US practitioner?

- Did the US practitioner mistype a digit of the priority application number in the ADS or Form PTO/SB/38?
- Did the US practitioner mistype the country code?
- Did the US practitioner mistype the priority filing date?
- Did the US practitioner mistype the DAS Access Code?

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Troubleshooting inbound DAS failure

Or does the blame lie with the Office where the priority application was filed?

- Did that Office somehow fail to make the application available for electronic retrieval?
- Did that Office somehow report an incorrect Access Code to the foreign practitioner?

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Troubleshooting inbound DAS failure

Or does the blame lie with the USPTO?

- Did the USPTO actually already successfully retrieve the electronic copy of the priority application, but failed to get it into IFW?
- Does the USPTO claim incorrectly that the priority application was not available in DAS?

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Troubleshooting inbound DAS failure

Or does the blame lie with the foreign practitioner?

- Did the foreign practitioner provide an erroneous priority application number?
- Did the foreign practitioner provide an erroneous priority filing date?
- Did the foreign practitioner provide an incorrect Access Code?

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Troubleshooting inbound DAS failure

From the above discussion, it may be appreciated that it would only require a few mouse clicks in DAS to very quickly work out exactly where the problem lies in a failed retrieval of an electronic certified copy of a priority document.

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Logging in to DAS

- This assumes you already have a WIPO user ID and password
- Go to www.wipo.int
- Click on PCT
- Click on DAS
- Click on “Access the WIPO Digital Access Service”

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Series codes

- Series code 29
- Series code 35

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Form DM/1

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PRIORITY CLAIM – Article 4 of the Paris Convention
☐ The applicant claims the priority of the earlier filing mentioned below.
 Indicate the number of each industrial design for which the priority is claimed. If no industrial design is indicated, it will be understood that the priority claim relates to all industrial designs included in the present application.

Office of earlier filing	No. of earlier filing (if available)	Date of earlier filing (dd/mm/yyyy)	No. of the design (in numerical order)	Access code (if available) ¹³	Annex V provided ¹⁴
					<input type="checkbox"/>
					<input type="checkbox"/>
					<input type="checkbox"/>
					<input type="checkbox"/>
					<input type="checkbox"/>
					<input type="checkbox"/>

☐ If the space provided is not sufficient, check this box and use a continuation sheet.

¹³ The WIPO Digital Access Service (DAS) is an electronic system allowing priority documents to be securely exchanged between participating IP Offices. If the Office of the earlier filing participates in DAS as a "depositing Office", with respect to priority documents for industrial design applications, an access code may be obtained from that Office. If the Office of a designated Contracting Party also participates in DAS as an "accessing Office", with respect to priority documents for industrial design applications, the applicant may provide the access code in this item so that the latter Office is able to access the priority document via DAS. For more information about DAS and its participating Offices, refer to the [WIPO website](#).

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Form AIA/14

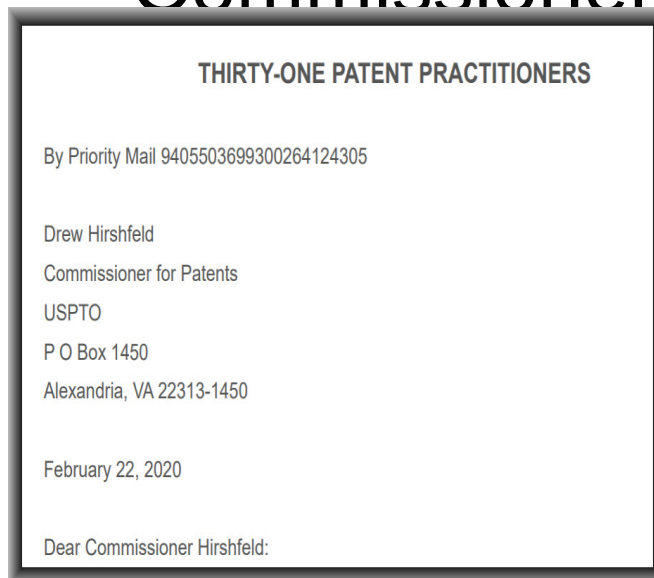
Foreign Priority Information:
 This section allows for the applicant to claim priority to a foreign application. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and 37 CFR 1.55. When priority is claimed to a foreign application that is eligible for retrieval under the priority document exchange program (PDX)ⁱ the information will be used by the Office to automatically attempt retrieval pursuant to 37 CFR 1.55(i)(1) and (2). Under the PDX program, applicant bears the ultimate responsibility for ensuring that a copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign priority application is filed, within the time period specified in 37 CFR 1.55(g)(1).

Application Number	Country ⁱ	Filing Date (YYYY-MM-DD)	Access Code ⁱ (if applicable)

Additional Foreign Priority Data may be generated within this form by selecting the **Add** button.

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Recent letter to Commissioner



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Recent initiatives

- Commissioner for Patents has been asked:
 - RO/US to become Depositing Office
 - USPTO to reformat Form PTO/SB/38
 - USPTO to retrieve ***when asked*** rather than aging the retrieval

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Former Form PTO/SB/38



OPTION B

This Request may be used for the infrequent circumstance when a claim for priority to an application filed in a participating foreign intellectual property office was made prior to that foreign intellectual property office becoming a participating foreign intellectual property office.

Please retrieve the priority application identified in Columns A and B:

	A	B		
	Code for Participating Office (e.g., EP) or WIPO DAS Depositing Office (e.g., AU, BR, CN, DK, EA, EE, ES, FI, GB, IB, IN, JP, KR, MA, NL, NZ, SE)	Application to be retrieved		
		App. No.	Filing Date	Access Code (for WIPO DAS Depositing Office)
1	NL	2008324	07-17-2018	E 94A
2				

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Reformatted Form PTO/SB/38



OPTION B

This Request may be used for the infrequent circumstance when a claim for priority to an application filed in a participating foreign intellectual property office was made prior to that foreign intellectual property office becoming a participating foreign intellectual property office.

Please retrieve the priority application identified in Columns A and B:

	A	B		
	Code for Participating Office (e.g., EP) or WIPO DAS Depositing Office (e.g., AU, BR, CN, DK, EA, EE, ES, FI, GB, IB, IN, JP, KR, MA, NL, NZ, SE)	Application to be retrieved		
		App. No.	Filing Date	Access Code (for WIPO DAS Depositing Office)
1				
2				

This form was reformatted February 2020!

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Next letter

Dear Executive Director Archambeau:

We write to you as design practitioners and applicants for protection of industrial designs. Many of the undersigned are members of the Industrial Designs Listserv, a community of design practitioners.

We are writing to request that the European Union Intellectual Property Office become a participating office in the WIPO Digital Access Service (DAS).

We thank you for your consideration of this request.

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Next webinar

Learning to be paperless with PCT (Covid-19 issues)

30th March, 2020

Many readers of this blog are already set up to be paperless in all of their PCT activities. This blog article is directed specifically to those who had not, until now, gotten set up to be paperless with PCT. Such filers are affected by [this announcement today](#) from WIPO:

Due to the effects of the COVID-19 pandemic on the operations of the International Bureau and of postal systems worldwide, the International Bureau, also in its function as receiving Office, has suspended the sending of PCT documents (e.g. PCT Forms, letters) on paper.

If you are a filer who has not, until now, gotten set up to be paperless with PCT, then I strongly urge you to attend two free webinars which will take place on Wednesday, April 1 and Thursday, April 2. In these webinars, you will:

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Next few webinars

- Get Patents Fast
- Don't end up like the owner of that CRISPR patent
- Docketing PCT
- Picking a PCT Searching Authority
- Picking a PCT Receiving Office
- Making smart use of PCT Declarations
- National phase or bypass continuation?
- Sequence listings

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Join the communities

- Join the Designs listserv
- Subscribe to the *Ant-Like Persistence* blog

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Getting help

- At USPTO:
 - PDX@uspto.gov
 - EBC at +1 571-272-4100
- At WIPO
 - pct.eservices@wipo.int
 - +41 22 338 9523

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Thank you!

- Be sure to complete the evaluation form

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