



## American Intellectual Property Law Association

January 24, 2018

Japan Patent Office  
Mr. Tomoki Sawai, Director General, Patent and Design Examination Department  
3-4-3 Kasumigaseki  
Chiyoda-ku Tokyo 100-8915  
Japan

### **Re: AIPLA Recommendations For The Continued Improvement of the Japan Design System**

Dear Mr. Sawai:

The American Intellectual Property Law Association (AIPLA) welcomes this opportunity to submit these suggestions as the Japan Patent Office continues its work for further improvement of its design system in order to promote creation of innovative designs valuable in the global context and realize an appropriate protection environment for them.

AIPLA, headquartered in the United States, is a national bar association of approximately 13,500 members who are primarily practitioners engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA is writing to provide its suggestions and recommendations to advance harmonization efforts between the JPO and the United States Patent and Trademark Office ("USPTO") in the field of industrial design practice. Both countries possess highly-sophisticated design systems and legal practitioners in this field, so AIPLA is pleased to have this opportunity to offer a few suggestions in an effort to further advance the global practice of design law.

AIPLA's suggestions and recommendations for increased harmonization between JPO and USPTO design practice are provided below:

## I. JPO requirement to show entire article in which GUI design is embodied

In the field of practice of protecting graphical user interfaces (“GUIs”), the JPO and USPTO have very different disclosure requirements. In the USPTO, a design applicant is required only to show the perimeter of a display screen on which the claimed GUI subject matter is embodied.<sup>1</sup> In contrast, the JPO requires that all sides of an article (for example, a smartphone or home appliance) be depicted in drawings of a design application (although the article itself is not necessarily claimed), despite that the claimed GUI design is embodied only in a display screen located on one side of the article. JPO’s current filing requirements for GUIs indicate that JPO’s philosophy regarding design protection is focused on the underlying *article*, which stands in contrast to focusing on the claimed *design* as embodied in an article.

The JPO’s current requirements for GUI design filings increase the costs and complexities for applicants in preparing a design application with the intent of obtaining design protection in Japan, whether that application be a Japanese national design application excluding a foreign priority claim, a U.S. national design application that will be used as a *Paris Convention* priority document for filing in the JPO, or an international design application filed under the *Hague Agreement Concerning the International Registration of Industrial Designs*.

AIPLA respectfully submits that the global practice of design law would benefit greatly if JPO relaxed its requirements that all sides of an article be shown in a design application claiming a GUI design or other surface ornamentation which is embodied in a display screen included as part of an article, and respectfully requests that the JPO amend its practice rules for this subject matter.

## II. JPO requirement for “functional use” statement in design applications

Design applications filed with the JPO are generally required to include a “functional use” statement describing the nature of use of the article in which the claimed design is embodied. AIPLA recognizes that, for classification purposes, additional information may sometimes be necessary if the title, drawings, and specification of a design application are inadequate to indicate the type of article in which the claimed design is embodied. Indeed, the USPTO occasionally requires that a design applicant provide an off-the-record statement describing the nature of the article to which a claimed design has been applied—and/or amend the title of an application—if the original contents of the application do not permit the USPTO to accurately classify a design.

However, the JPO’s requirement for a “functional use” statement goes beyond what is required for adequate classification purposes. The need to include a functional use statement in a Japanese design application increase the costs and complexities for applicants in preparing a design application with the intent of obtaining design protection in Japan, for all of the same reasons explained in Section I above. In addition, the need to include a functional use statement in a Japanese design

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<sup>1</sup> The European Union Intellectual Property Office’s disclosure requirements for GUI designs are in harmony with the USPTO’s requirements.

application may inadvertently affect the validity of—or unnecessarily limit a patent owner’s ability to enforce—an issued Japanese design.

Accordingly, AIPLA respectfully requests that the JPO relax or eliminate its requirements with respect to functional use statements for designs, and instead require off-the-record clarifying statements and/or title amendments in design applications only to the extent necessary to achieve adequate design classification.

### III. Full implementation of WIPO Digital Access Service for design applications

Both the USPTO and the JPO have lagged behind other major patent offices in fully implementing WIPO’s Digital Document Access Service (“DAS”) for both providing and obtaining access to filed design applications that are being used as priority documents under the *Paris Convention*. The lack of full availability of DAS for design applications increases the costs associated with protecting designs in the U.S. and Japan, and increases the likelihood that errors are made in the process of obtaining, delivering, and submitting priority applications.

AIPLA’s representatives have in the past requested that the USPTO make efforts to fully implement the DAS system for design applications. Likewise, AIPLA respectfully requests that the JPO, in its capacities as both a depositing office and as an accessing office, attempt to make continued progress towards full implementation of DAS with respect to design applications.

Again, AIPLA appreciates the opportunity to provide these comments. Please contact us if you would like us to provide additional information on any issues discussed above.

Very truly yours,



Myra H. McCormack

President, American Intellectual Property Law Association