

AIPLA

American Intellectual Property Law Association

September 20, 2018

Design Registration System Planning Office
Design Division, Patent and Design Examination Department
Japan Patent Office
3-4-3, Kasumigaseki, Chiyoda-Ku 100-8915
Japan

Via Email: PA1D40@jpo.go.jp

Re: Comments on Issues in Reviewing the Design Registration System

Dear Sir or Madame:

The American Intellectual Property Law Association (AIPLA) welcomes this opportunity to submit comments to the Japan Patent Office on issues in reviewing the Design Registration System.

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 for establishing best practices for JPO industrial design prosecution, which will also work to promote harmonization of industrial design prosecution worldwide. As such, AIPLA's suggestions and recommendations on issues in reviewing the Design Registration System are attached for your reference.

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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 in the attached document.

Very truly yours,

A handwritten signature in cursive script that reads "Myra McCormack".

Myra H. McCormack
President
American Intellectual Property Law Association

Encls.

AIPLA Comments on Issues in Reviewing the Design Registration System

September 20, 2018

(1) Protection of GUI Design

In order for graphical user interface (GUI) designs to be protected under the existing Design Act, GUIs must be recorded/displayed on articles. Furthermore, infringement of designs is limited to the acts of manufacturing, using, assigning, leasing, exporting or importing the article to the design.

1. What are your views on including the following GUI designs as the subjects of protection under the Design Act?
 - GUIs not recorded on articles (GUIs on cloud platforms, GUIs provided by networks, etc.)
 - **GUIs not recorded on articles should be permitted. We understand that orthographic views of the underlying article from all sides (*i.e.*, front, rear, left, right, top and bottom) are not required provided the design cannot be seen from those sides, and also that the article itself does not need to be claimed as part of the design. We further suggest that at most only a portion of the article (*e.g.*, a portion of the display screen) needs to be shown.**
 - GUIs displayed on things other than articles (GUIs projected on walls or the human body, GUIs displayed using augmented reality (AR) or virtual reality (VR), etc.)
 - **GUIs displayed on things other than articles should be permitted.**
 - GUIs irrelevant to the article's function (wall papers, content, etc.)
 - **GUIs that are irrelevant to the article's function should be permitted.**
2. What are your views on considering as an infringement the act of uploading GUIs to cloud servers or providing software, GUIs included, via networks? What is the appropriate way to do so—to create a new definition of use (Article 2 (3) of the Design Act), or establish a new category of acts deemed to constitute infringement (Article 38 of the Design Act)?
 - **The act of uploading GUIs to cloud servers or providing software, including GUIs, via networks should be considered infringement as a form of “use” under the Design Act. To the extent this is not considered “use,” we recommend expanding the definition of “use” to include, *e.g.*, uploading. We believe this is simpler than establishing a new category of acts deemed to constitute infringement.**

(2) Protection of Spatial Design

Building (real estate) exteriors are not the subject of protection under the existing Design Act. In addition, design rights cannot be obtained for the interior design of stores, offices, etc. as they do not meet the requirement of one application per design.

1. What are your views on including building (real estate) exteriors as the subject of protection under the Design Act?
 - **Building exteriors should be protectable and designs protection should be available for the same.**
2. What are your views on including the interior design of stores, offices, etc. as the subject of protection under the Design Act?

- **The interior designs of stores, offices, etc. should be protectable under the Design Act.**

(3) Expansion of the Related Design System

There is a system allowing registration of designs similar to the principal design as related designs for the purpose of protecting a group of similar designs filed by the same applicant under the existing Design Act. Filing of related designs is allowed until the day before the publication date of the design gazette containing the principal design.

1. What are your views on allowing the filing of related designs after the publication date of the design gazette containing the principal design?
 - **At the outset, we favor a multiple design filing system as set forth in Question (5) as a replacement to the Related Design System.**
 - **For a multiple design filing system (or if the Related Design System remains), one should be permitted to file for related designs after the publication date of the principal design if a related parent application is still pending. However, it should not be permitted to file for protection on a related design after registration of the principal or parent application has occurred *and* there ceases to be a co-pending application.**
2. What are your views on allowing the registration of related designs that are similar only to a related design?
 - **Related designs should be allowable within the same application, so long as they satisfy a similarity requirement, e.g., the designs are patentably indistinct.**
3. How should the duration of design rights for related designs be set? (Should the duration be set in accordance with the duration of design rights for the principal design?)
 - **The duration of design rights for related designs should be set in accordance with the duration of the design rights for the principal design. Once the term for a principal design has been set, no related application should be permitted to issue having a term that extends beyond the term of the principal design.**

(4) Extension of Duration of Design Right

The duration of design rights established under the existing Design Act is 20 years from the registration date.

1. What are your views on extending the duration of design rights to 25 years?
 - **The duration of design rights should be extended to 25 years.**
2. What are your views on changing the starting date for calculating the duration of design rights from the registration date to the filing date?
 - **The starting date for calculating the duration of design rights should remain the registration date.**

(5) Introduction of the Multiple Design Filing System

Under the existing Design Act, multiple designs may not be included in a single application for filing design applications.

1. What are your views on allowing multiple designs to be filed in a single application?
 - **It should be allowable to file and pursue multiple designs in a single application, so long as the designs are related by a similarity standard.**
2. If multiple designs were allowed, what are your views on introducing limitations as in other countries?
 - Is it appropriate to set a limit on the number of designs to be filed in a single application?
 - **For logistical reasons, it is appropriate to set a limit on the number of designs to be filed in a single application. An appropriate limit may be 100 designs, which we understand is the limit for the Hague system, and JPO may want to consider additional fees for filing, e.g., more than 20 designs in a single application.**
 - Is it necessary to limit the scope of articles that can be filed in a single application to similar articles?
 - **For classification and searching purposes, it is helpful to limit the scope of articles that can be filed in a single application to similar articles. This can be effected by limiting the scope to articles to, e.g., the same Locarno class or to a more narrow scope based on a similarity standard.**

(6) Review of the Classification Table of Articles

Not stating a classification equivalent to that in the classification table of articles provided by ministerial ordinance in the design application is regarded as a reason for refusal under the existing Design Act, resulting in a delay in rights acquisition. What are your views on establishing a mechanism that does not treat this as an immediate reason for refusal?

- **A mechanism should be implemented that does not treat the failure to provide a classification as an immediate reason for refusal. If an applicant does not furnish the classification, the Office should provide a proposed classification, which the Applicant may amend in a subsequent response or elect to amend at a later date during review and prosecution of the application.**