



American Intellectual Property Law Association

August 7, 2023

IP Australia
Terry Moore
Director, Domestic Policy & Legislation
IP Australia
PO Box 200
Woden ACT 2606 Australia
consultation@ipaustalia.gov.au

RE: AIPLA Recommendations for The Continued Improvement of IP Australia’s Design System

Dear Ms. Moore:

Further to the consultation notice from IP Australia at the embedded [URL](#), the American Intellectual Property Law Association (“AIPLA”) welcomes this opportunity to provide views on two of the three topics in this round of consultation.

AIPLA, headquartered in the United States, is a national bar association of approximately 7,000 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.

A primary purpose of providing AIPLA’s views is to advance harmonization efforts for industrial design protection globally, and to support efficient and balanced means for obtaining industrial design protection around the world. Despite international advancements such as growing adoption of the Hague Agreement for the Registration of Industrial Designs (“Hague System”) and discussion of the Design Law Treaty (“DLT”) by the Standing Committee on Trademarks, Industrial Designs, and Geographic Indications of the World Intellectual Property Organization, important substantive and procedural aspects of industrial design protection remain inconsistent and unharmonized from jurisdiction to jurisdiction. With a membership that includes intellectual property leaders worldwide in fields such as industrial design, AIPLA is well positioned to support harmonization efforts, which will advance the global practice of design law. In this spirit, AIPLA would like to present the following views:

I. Virtual Designs

In general, AIPLA supports allowing the protection of virtual designs. At this time, AIPLA is providing comments specifically regarding graphical user interfaces (“GUIs”), a subset of virtual designs.

IP Australia Should Provide Design Protection of GUIs in Australia

AIPLA understands that in Australia there is currently no industrial design protection available for the growing GUI industry in Australia. This status is reflected by the Registrar of Designs' 2017 ruling in *Apple* that a display screen is not a new and distinctive design because the display screen at rest (*i.e.*, turned off) is simply a blank screen. Australia's position regarding GUI design protection is contrary to a growing global consensus to provide industrial design protection for GUIs and other emerging technologies. Companies investing substantial resources in the design of their GUIs to enhance their customers' user experience/user interface (“UX/UI”). Most prominent design jurisdictions, including the United States, European Union, China, Japan, and South Korea, currently provide design protection for GUIs. Further, harmonization efforts are in full swing (*see, e.g.*, the Industrial Design 5's joint recommendations in support of best practices to protect GUIs). Australia is one of the few prominent jurisdictions that continues to deny industrial design protection for GUIs. AIPLA respectfully submits that the global practice of design law would benefit substantially were Australia to change its laws to provide design protection for GUIs.

In the response to the May 2020 public consultation, IP Australia provided reasons opposing broader virtual design protection. Although IP Australia was persuaded to protect virtual designs as products themselves, indicating that “...protection should not be linked to physical products to remain technology neutral and inclusive of emerging technologies,” IP Australia ultimately decided against moving forward with the proposed change due to alleged increased burdens on businesses in freedom to operate (“FTO”) and validity challenges related to these virtual designs. *See* Response to public consultation, May 2020 at pp. 4-5. This appears to be the only obstacle left in moving forward with the proposed change with respect to all virtual designs. GUIs are directly tied to a physical product (*e.g.*, an electronic display). While FTO burdens and validity challenges may be more problematic for other virtual designs such as in virtual reality, this is not so with GUIs. GUIs themselves are necessarily tied to display screens, and businesses, including Australian entities doing business globally, must comply with GUI design patents issued across the globe. Thus, Australian businesses, and others with global markets, should already be performing FTO analyses to comply with GUI design patents granted in other jurisdictions. Accordingly, design patent families that include AU family members, assuming the claimed design is consistent across the family, should not create additional work. As for validity concerns, this is simply a feature of the patent system and examination process. If the concern is undiscovered virtual design art that is later used to invalidate the virtual design patent, this does not appear to be applicable to GUIs that are tied to specific products.

II. Partial Designs

Partial design claiming (indicating unclaimed portions using broken lines) is still prohibited in Australia. This position conflicts with the Hague System and the 90 jurisdictions under its agreement.

In the response to the May 2020 public consultation, IP Australia provided reasons opposing partial design claiming. IP Australia agreed that alignment towards the Hague System could assist Australians filing designs outside of Australia, yet, argued that permitting partial design claiming would increase the burdens on businesses in FTO and validity challenges to partial designs. The above response with respect to FTO and validity concerns with GUIs is equally applicable to partial claiming. Australian businesses, and others with global markets, should already be performing FTO analyses to comply with global partial design patents, and thus IP Australia’s permitting partial designs would not increase this burden on businesses. AIPLA believes concerns surrounding validity are overestimated. Validity concerns rest on the examination process; examiners are well equipped to tackle partial designs. The 90 jurisdictions currently under the Hague System—including the European Union, United States, China, Japan, South Korea, and Canada—all allow partial designs, and examiners in these jurisdictions regularly examine partial designs.

IP Australia has previously voiced concern about limited consistency in international approaches to partial design protection. However, limited consistency in international partial design practices are mere friction and should not prevent forward progress. The Hague System represents a growing number of jurisdictions that are pursuing harmonization in their design practices. Applicants from countries including the European Union, United States, China, Japan, South Korea, and Canada, where partial claiming practices are trending toward consistency, obtain comparable design protection in each jurisdiction. They cannot do so in Australia, which denies a partial claiming option.

Comparing IP Australia’s utility practice to IP Australia’s position on partial design claiming, inconsistency is apparent. IP Australia’s current AU Utility Patent practice conflicts with its current position on preventing partial design claiming. When an applicant describes a utility patent embodiment, the applicant is not required to claim *every* element that exists in that embodiment. Rather, an applicant may selectively choose, within reason, particular elements and combination of elements in an independent claim. This is not so with AU design patents, in which an applicant is required to claim the *entire* design. If this design patent approach were applied to utility patents, it would constrain a utility applicant to claim every feature of the embodiment, which would likely be too limiting. Allowing partial design claiming would make IP Australia’s patent rules consistent internationally and better protect Australian design applicants.


Assuming Partial Design Claiming is Allowed, IP Australia Should Replace the Statement of Newness and Distinctiveness with an Optional Figure Description

If IP Australia implements AIPLA’s recommendation to permit partial design claiming, the practice of requiring applicants to include a statement of Newness and Distinctiveness would be redundant and could possibly conflict with visual-based portion claiming. For example, there may be instances in which the visual-based portion claimed conflicts with the Statement of Newness and Distinctiveness, and the two must be reconciled on a case-by-case basis. This could result in uncertainty for applicants and may increase costs associated with

filing, prosecuting, and defending design applications in Australia. Therefore, if IP Australia allows partial design claiming, AIPLA suggests IP Australia eliminate the requirement for a statement of Newness and Distinctiveness. Applicants may still wish to describe what is visually shown (for example, to explain the meaning of broken lines), so the statement of Newness and Distinctiveness should be replaced with an optional figure description.

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.

Sincerely,

A handwritten signature in blue ink, appearing to read "B. Batzli".

Brian H. Batzli
President
American Intellectual Property Law Association