

3 Optimal Design Examinations Based on Evaluations by Applicants

For the purpose of preparing basic data for promoting efforts to maintain and improve the quality of design examinations and for considering developing the relevant quality management arrangements, I conducted (1) a survey on overseas design examination quality management, (2) a domestic trial questionnaire survey, (3) an interview survey, and (4) an expert panel's discussions, focusing on external evaluations (evaluations of design examinations by applicants/agents).

There was a 54.6% response collection rate for the domestic trial questionnaire survey. About 90% of respondents viewed examiners' overall procedures in the past year as appropriate. About 85% saw notices of reasons for refusal of design registration applications as appropriate. In free description columns, respondents provided many specific opinions or information on appropriate and inappropriate examinations. Based on the trial survey results, I tested methods for evaluations of design examinations by applicants and the like, and considered optimal design examinations based on the evaluation results.

I Introduction

In the report in March 2008 on targets that the Japan Patent Office should achieve in fiscal 2008, the Ministry of Economy, Trade and Industry called for promoting efforts to maintain and improve the quality of design examinations, and for developing quality management arrangements.

As for patent examinations, the Quality Management Office, created in April 2007, has taken leadership in conducting ex-post objective measurement and analysis of examination results. It developed arrangements to have the measurement and analysis findings reflected in actions for maintaining and improving the quality of examinations. As a precondition for quality management, a survey was conducted in fiscal 2007 on quality control methods, based on evaluations by applicants.

In order to maintain and improve the quality of design examinations, the JPO has so far tried to accelerate examinations, and increase the transparency of the process for developing design examination standards, to share understanding with design system users and secure the transparency and fairness of examinations. Since fiscal 2008, the JPO Design Division has conducted the quality management for design examinations, and considered testing specific quality management methods. Not only internal evaluations through ex-post checks on examination results, but also external evaluations by applicants and the like are important for objective analysis of examination results.

Toward the future development of quality management methods for design examinations,

this study focused on external evaluations (evaluations of design examinations by applicants/agents). I surveyed and analyzed practical problems and user needs regarding present design examinations, to prepare basic data for considering how design examinations and their quality management should be, from the viewpoint of outside design system users.

Specifically, I conducted the following three surveys. Based on findings from the surveys, I analyzed optimal design examinations, and issues with quality management methods. Finally, an expert committee considered these matters.

- Survey on overseas design examination quality management policies
- Evaluations of design examinations by applicants etc. (a domestic trial questionnaire survey)
- Domestic interview survey

II Overseas Design Examination Quality Management

Among foreign countries that examine substantive requirements regarding design registration applications as Japan does, the United States and South Korea have taken leadership in studying design examination quality evaluations. Regarding the United States and South Korea, a study on patent examination quality management was conducted as given in a report on the "Quality Management System that Takes into Consideration Evaluations by Patent Applicants and the Like" (Institute of Intellectual Property, March 2008). Based on the report, this study conducted a questionnaire and other surveys focusing on design examination quality

evaluations, covering intellectual property authorities and agents.

1 USA

The United States Patent and Trademark Office implements quality assurance policies through the review and improvement of examinations, to manage the quality of design and other patent examinations. The USPTO has created the Office of Patent Quality Assurance, that manages and coordinates examination reviews independently from the examination division. The examination reviews can be divided into two categories – End-check Reviews, and In-process Reviews.

Since 2006, the USPTO has also implemented the Customer Panel Quality Survey, where applicants and the like evaluate design and other patent examinations. The survey covers domestic applications in all technology categories. The same questionnaires are used for designs and other patents. The questionnaire survey takes place every quarter, covering some 1,000 representatives selected among customers filing six or more patent applications in 12 months. Survey results are not made in public.

Questioned on the Customer Panel Quality Survey, U.S. patent application agents said that survey results should be published, and that questions on design patents should be separated from those for other patents. They also said that a greater emphasis should be placed on questions about the examination quality.

2 South Korea

The Korean Intellectual Property Office (KIPO) created an examination evaluation division in August 2000, to implement the examination evaluation system, covering examinations of patent, utility model, trademark and design registration applications. Evaluations are divided into three categories – evaluations by examination evaluators, those by peer team leaders, and those by examination team leaders.

As a survey of evaluations by applicants and the like, the KIPO has also awarded contracts to outside researchers to conduct a biannual customer satisfaction telephone survey of 1,000 domestic customers, chosen on a random sampling basis since 2003. The survey covers (1) trademarks, (2) designs, (3) patents and utility models (for machinery, metals and construction), (4) patents and utility models (for chemistry and

biotechnology), (5) patents and utility models (for electrics and electronics) and (6) patents and utility models (for information and communications). The same questions are used for all of them.

Although the survey results are not reflected directly in examinations, the KIPO uses the results for improving the examination system, and to enhance customers' satisfaction with the examination section and their overall satisfaction.

Questioned on the customer satisfaction survey, some patent application agents in South Korea favorably evaluated the KIPO as listening to and reflecting customer opinions. But some others said they had doubts about the reflection of survey results in KIPO operations. Some agents said questions in the survey, though appropriate, should be somewhat more technical.

III Design Examination Evaluations by Applicants (domestic trial questionnaire survey)

In order to collect basic data for considering methods for examination evaluations by outside design system users, and for optimal design examinations for the Japan Patent Office's examination quality management, I conducted a trial questionnaire survey of domestic design registration applicants and their agents. The survey covered a total of about 1,000 samples among domestic applicants/agents who filed seven or more design registration applications in fiscal 2008. I sent and collected questionnaires on design system users' evaluations of examinations for about 3,300 design registration applications, chosen among those on which final decisions were made in fiscal 2008, in addition to questionnaires for finding problems with its trial efforts.

All survey recipients were given four questionnaires – Questionnaire A (respondent information), Questionnaire B (evaluation of quality of overall examination procedures), Questionnaire C (evaluation of quality of examinations for specific design registration applications), and Questionnaire D (opinions on the method for collection of design system users' evaluations). Hereinafter, these questionnaire categories are indicated.

Within the survey period of about four weeks, I received responses from 540 out of 989 survey recipients. This response collection rate of 54.6% is higher than for usual questionnaire surveys.

1 Satisfaction with design examinations (Questionnaire B)

About 90% of the respondents evaluated overall procedures of design application examinations over the past one year as appropriate. In free description columns, 151 appropriate and 136 inappropriate cases were specified.

The appropriate cases included three regarding the prior design search, 19 regarding the swiftness of examinations, 34 regarding written notices of reasons for refusal of applications, 13 regarding responses to opinions and refusal of applications, and 40 regarding examiners' responses.

The inappropriate cases included four regarding the prior design search, seven regarding the swiftness of examinations, 26 regarding written notices of reasons for refusal of applications, six regarding responses to opinions and refusal of applications, and four regarding examiners' responses.

2 Key points of design examinations (Questionnaire B)

I found that applicants/agents paid attention to "the appropriateness of the prior design search (Japan Design Gazette, prior designs, catalogues, magazines and other publications)," "examiners' persistent decisions," "the appropriateness of descriptions in written notices of reasons for refusal of applications," "the appropriateness of responses to interview, telephone and other communications" and "understanding of goods and product categories related to specific designs", in evaluating for their satisfaction with examination procedures.

3 Descriptions in written notices of reasons for refusal of applications (Questionnaire C)

About 85% of the respondents evaluated descriptions in written notices of reasons for refusal of applications as "sufficiently understandable" or "rather understandable," indicating these notices have been generally viewed as appropriate. The most frequently cited reason for respondents' failure to understand descriptions in written notices of reasons for refusal of applications was that "explanations about reasons for designs' lack of novelty or creativity were insufficient."

4 Descriptions of decisions of refusal (Questionnaire C)

About 75% of the respondents evaluated descriptions of decisions of refusal as "sufficiently understandable" or "rather understandable," indicating these descriptions have been generally viewed as appropriate. Both applicants and agents tended to give lower ratings for descriptions of decisions of refusal than the about 85% positive evaluations for descriptions of reasons for refusal. This tendency was stronger for agents. The most frequently cited reason for respondents' failure to understand descriptions of decisions of refusal, was that "explanations about the failure to eliminate reasons for designs' lack of novelty or creativity were insufficient." Complaints written in free description columns were related to examiners' decisions, insufficient explanations about grounds for refusal, and the absence of responses to written opinions.

5 Communications with examiners (Questionnaire C)

More than 90% of the respondents evaluated interviews and telephone/fax communications (exchange of opinions, presentation of draft amendments, etc.) with examiners as appropriate, indicating such communications are generally viewed as useful.

6 Comparison of JPO and foreign examination procedures (Questionnaires B and C)

While noting that it was difficult to compare examination procedures of the JPO and foreign patent offices because of differences in procedures, systems and standards for decisions, respondents said that examinations in Japan were swifter than in foreign countries, and that the prior design search and examinations in Japan were more accurate and less variable. Responses on comparison of domestic vs. overseas (U.S. and South Korean) applications on a case-by-case basis tended to endorse these views.

7 Method for collection of evaluations by applicants and the like (Questionnaire D)

More than 80% of the respondents said they would cooperate in future surveys on evaluations of design examination quality, indicating that this

kind of survey is viewed as important.

Of the respondents, 17.1% said Questionnaires A to C included questions that were difficult to answer or understand. In free description columns, some respondents said that Questionnaire B included questions on overseas conditions that were difficult to answer due to differences in procedures, standards and systems. Other opinions said that questions and response standards in the questionnaire were vague, and that it was burdensome to select cases that were considered problematic. Regarding Questionnaire C, respondents said that the identification of specific cases was burdensome, that design registration applications that had been accepted immediately should not be subject to a survey because it is difficult to respond to questions on these applications, and that questions and response standards were vague.

Regarding questionnaire forms, many respondents said they prefer multiple-choice questions that are easier to answer. At the same time, many said questions subject to free-description answers should be adopted in addition to multiple-choice questions.

On points that should be considered in collecting evaluations by applicants and the like and on requests regarding the survey method, the most frequently cited opinion was that consideration should be given to the handling and recording of specific information. Other opinions in free description columns were related to consideration for respondents' burdens, the selection of specific cases, disclosure and feedback of survey results, etc.

IV Domestic Interview Survey

I conducted an interview survey covering a total of 20 parties -- 11 applicants and nine agents -- chosen among applicants and agents which received the domestic questionnaire survey.

1 Method for trial survey on design examination evaluations by applicants

Most of respondents in the interview survey agreed that design examination evaluations by applicants/agents and their relevant opinions should be collected regularly through surveys like the trial questionnaire survey.

About half of respondents in the interview survey evaluated the quality and volume of questionnaires as appropriate. As questionnaires were not structured for dividing applications into

related and partial design categories for separate analyses, an opinion among respondents was that questionnaires should be restructured to enable separate analyses. Another opinion said the method for a survey on evaluations by applicants and the like should be improved as one of the quality management techniques.

As for the questionnaire survey form, many respondents said they would like to electronically write answers instead of handwriting.

Regarding question forms, respondents said that multiple-choice questions are good for reducing respondents' burdens, but there are problems which multiple-choice alone cannot cover, so free description columns are necessary for problems and improvement suggestions. The opinion was raised that it would be easier to write in one free description column for all questions, rather than for each question.

As for the frequency of the regular survey, responses ranged from every six months to several year intervals. None of the respondents complained that the four-week period between the distribution and collection of questionnaires was too short. When setting the survey period, however, we may have to take respondents' convenience into account. For example, we may have to exclude any long-vacation season from the survey period.

Many respondents called for making survey results public, and some expressed the desire to consult others' opinions. Some said that after the survey, they would like to see how survey results would be analyzed, and its effects.

On Questionnaire C that ask questions on specific examination cases designated for the survey, many respondents said cases including some intermediate actions like the notification of reasons for refusal should be designated, because no response could be made about cases in which design registration applications were accepted immediately. Some said that the designation of specific cases could eliminate respondents' burden of selecting cases, and make it easier for respondents to make responses. But many said respondents should be allowed to select specific cases in addition to designated ones. As for an appropriate number of cases for the designation, many said 10 would be excessive. Requested numbers ranged from five to less than 10.

2 Design examination procedures

On the notification of reasons for refusal, the trial description of reasons was welcomed as

giving specific reasons for refusal. But some respondents said the description should be expanded further.

For decisions of refusal, some respondents said they want responses to written opinions, as well as the grounds for the decisions.

The prior design search was evaluated as appropriate. As key points for evaluating the prior design search, respondents cited the appropriate scope of search, the appropriateness of specific literatures for search, and other points related to the quality of search, in addition to the type of literatures for search.

Responding applicants viewed their interview, telephone, fax and other direct communications with examiners as important and effective, and called for more diverse and flexible communications.

Examinations were generally evaluated as sufficiently fast. But some respondents noted that if design registrations were too fast, it could affect related or overseas design registration applications. An opinion among respondents said some cases were characterized by fast first actions and slow second actions.

3 Other requests

As for design examination information measures that were not positively taken up for this survey, many respondents called for providing and expanding information about the prior design search, examination decisions, and the utilization of design rights.

V Optimal Design Examinations Based on (Trial) Evaluations by Applicants, and Quality Management Problems and Analysis

1 Significance and roles of (trial) evaluations by applicants/agents in quality management

In the interview survey, many respondents said evaluations by applicants and the like would be useful, as they could contribute to maintaining and improving the quality of design examinations and become a communications means. An opinion among the respondents said the method for a survey on evaluations by applicants and the like should be improved as one of quality management means.

“External evaluations” of design examinations are significant for directly

confirming evaluations of the examination quality, and for measuring and improving the effects of quality management means. These have been incorporated into quality management at foreign patent offices. The JPO is urged to develop some method to efficiently and sufficiently collect evaluations of design examinations by applicants/agents.

2 Trial method for evaluations by applicants and agents

In the trial questionnaire survey, I sent questionnaires to applicants/agents and collected responses. There was a high response collection rate (about 55%), and many respondents said they would also cooperate in this kind of survey in the future. In the interview survey as well, many respondents said it is desirable to conduct this kind of survey. Therefore, I suspect that the necessity of this kind of survey has been recognized as important.

Given the above response collection rate, I suspect the questionnaire survey method as generally appropriate. In the interview survey, however, many respondents said they would like to electronically write answers instead of handwriting.

Regarding questionnaire forms, many respondents said they prefer multiple-choice questions that are easier to answer. At the same time, many said questions subject to free-description answers should be adopted in addition to multiple-choice questions.

Regarding questionnaire forms, many respondents said they prefer multiple-choice questions that are easier to answer. At the same time, some said there are problems that cannot be taken up by multiple-choice questions alone, so questions subject to free-description answers should also be provided. Therefore, it may be desirable to combine multiple choice (scale) questions with free description questions. A single free description column at the end of a questionnaire may be desirable for reducing the burden on respondents and making it easier for surveyors to analyze responses.

The trial survey results indicated no specific characteristics for the applicants or agents as survey recipients. When quality management means are improved, it may be appropriate to make questionnaires similar for applicants and agents as much as possible, to facilitate comparison of responses.

One problem is whether overall examination

procedures or case-by-case ones should be subjected to a survey. Some said questions about respondents' satisfaction with overall examination procedures in each survey would make little sense. But some others said "if questions about overall examination procedures allowed respondents to point out problems that could not be taken up for specific cases, they would be useful for looking into such problems or issues. Questions about specific cases would allow respondents to identify real problems with specific cases in line with details of examinations. It would be appropriate to take these points into account and decide whether to target overall examinations or specific cases, according to the survey objectives.

Survey targets were selected from among design system users who filed a certain number of design registration applications, and received final decisions on specific applications within a certain period of time. In Questionnaire C, some specific cases were designated for the survey on a random sampling basis. Although no major problems emerged with this trial survey, we may have to take into account respondents' safekeeping of relevant documents and the freshness of their memories, in considering how to reduce the burden on respondents and improve the accuracy of surveys.

This trial survey covered a total of about 4,700 specific design registration applications, and a total of about 1,000 applicants/agents. Actual responses covered about 2,800 specific applications by 540 applicants/agents.

This trial survey featured a high response collection rate (54.8% for applicants, 54.2% for agents). The rate's high level could be attributed to the first trial survey on design examinations. If more surveys are conducted on design examinations, some means may have to be devised to maintain response collection rates at high levels.

As for the survey frequency, the interview survey found that many respondents viewed a regular survey as appropriate, despite some resulting burdens on responding applicants/agents. None of the respondents in the interview survey said the four-week period between the distribution and collection of questionnaires for this trial questionnaire survey was too short. When setting the survey period, however, we may have to take respondents' convenience into account.

Requests by respondents in the survey included the disclosure and feedback of survey

results. In the interview survey, most of interviewees said that survey results should be published as a matter of course.

A dominant opinion in the survey and in the survey results consideration panel was that the appropriate handling of information should be taken into account.

3 Details of questionnaires for trial domestic survey

In response to Questionnaire B's Question 1 on overall design examinations, a high percent (about 90%) of respondents evaluated "recent procedures of examiners" as "appropriate" or "rather appropriate."

In response to Questionnaire C's Question 1-(2) on descriptions of reasons for refusal of specific applications, a high percent (about 85%) of respondents evaluated such descriptions as "sufficiently understandable" or "rather understandable." In responding to Questionnaire C's Question 2, both applicants and agents gave a lower rating to decisions of refusal, than to notices of reasons for refusal. Agents' rating of such decisions was remarkably lower. More than 90% of respondents welcomed their interview, telephone and fax communications with examiners in Question 5 of Questionnaire C, and indications of amendments in Question 6 of Questionnaire C.

Impressions of specific cases where examinations were viewed as inappropriate may remain strong in the memory of applicants and agents, affecting their evaluations of overall examinations (as found in the interview survey). We will have to consider this point when comparing evaluations of overall and case-specific examinations.

Future issues include analyses on how evaluations of case-specific examinations would affect those of overall examinations, what factors exist behind the difference between these evaluations, and what survey methods would be effective for minimizing these effects or factors. For example, we should refrain from subjecting all evaluations uniformly to statistical processing. Evaluations of case-specific examinations should be left out of statistical processing, and used for looking into problems and issues and supplementing other survey results. Evaluations may thus be used for different purposes. Furthermore, it may be effective to use interviews to supplement questionnaire surveys, when surveyors want to directly confirm

applicants' opinions indicated in questionnaires or obtain more details of such opinions.

As for contents of questionnaires, it may be desirable to reduce questions in Questionnaire A (respondent information) as much as possible, and leave only minimum requirements for analysis, in consideration of the burden on respondents.

On Questionnaire B (overall design examinations), many respondents in the interview survey complained that the questionnaire failed to address examination procedure differences between design registrations application categories, including the partial design category. In the future, we may have to consider modifying the questionnaire to allow responses to be analyzed on a category-by-category basis. Question 1 (design examiners' recent procedures) in the questionnaire asked respondents to describe reasons for their evaluations – “appropriate” and “inappropriate.” Reasons regarding “descriptions in notices (including references) of reasons for refusal and decisions of refusal” were most frequently cited. The free description column for this question was useful for asking questions on specific reasons and cases in the interview survey. On Question 2 (comparison of domestic and overseas design examinations), respondents in the interview survey complained that the question was difficult to answer because of differences between domestic and overseas design systems. On Question 3 (key points for measuring satisfaction with examination procedures), I found that applicants/agents paid attention to “the appropriateness of the prior design search,” “examiners' persistent decisions,” “the appropriateness of descriptions in written notices of reasons for refusal of applications,” “the appropriateness of responses to interview, telephone and other communications”, and “understanding of goods and product categories related to specific designs.” Therefore, it may be useful to place emphasis on these points in analyzing a questionnaire survey and conducting an interview survey.

As for Questionnaire C (specific cases), many respondents apparently desired that questions on specific cases designated by the questioner would be combined with those on cases that could be selected by respondents. On the appropriate number of cases for the designation, many respondents in the interview survey said 10 would be excessive. Requested numbers ranged from five to less than 10. On the selection of specific cases subject to questions, a

dominant opinion among respondents was that “it would be desirable to designate cases among those in which a notice of reasons for refusal was made at least once.” An opinion about questions said that questions specialized for design registration application categories or methods would not be necessary, and that free description columns should made be available for specific categories or methods if necessary.

4 Optimal design examinations based on trial evaluations by applicants and the like

(1) Accuracy of examiners' decisions

In the interview survey, an opinion among respondents said that the scope of similarity, the creativity and other key points should be decided on according to each category of goods or products, and that information about the scope of similarity and the creativity for each category of goods or products was insufficient for clarification of decisions. One reason for such opinion was that respondents did not know design right maps, registered picture samples and other references made available on the JPO website, nor how to use such information. Therefore, the JPO should expand the range of information including specific cases. It should not only provide information, but also publicize how to use information and publicize information in easy-to-understand forms.

(i) Accurate understanding of product categories and designs

In the questionnaire survey, some respondents selected a view that whether examiners understand details of design registration applications would be important for measuring the satisfaction of applicants and the like with examinations. In free descriptions and the interview survey, these respondents said that applicants' communications with examiners would be important for gaining examiners' understanding of applications, and that they wanted examiners to understand not only shapes of designs but also uses of relevant goods, conditions of relevant goods categories, and backgrounds of designs. Interview, telephone, fax and other communications with examiners would be useful for examiners' understanding of these details, they said. Some respondents proposed the presentation of relevant goods, explanations about products, factory visits, and other measures to promote examiners' understanding of design

shapes and product backgrounds.

(ii) **Appropriate prior design search**

A finding from the questionnaire survey is that applicants viewed an appropriate prior design search as important, and interpreted cited prior designs as roughly appropriate. According to free descriptions in the questionnaire survey and responses in the interview survey, some respondents noted that they were uncertain about whether the prior design search was done accurately, because they had to read reference literatures cited in official gazettes to check up the scope of the prior design search. Regarding these points, the JPO may have to reduce applicants' burdens and worries, and clarify relevant procedures.

(iii) **Low variance in decisions**

An opinion given in the questionnaire survey said low variance in decisions meant that there were no gaps between decisions after examinations, nor between examiners. In the interview survey, respondents urged the JPO to implement the feedback of decisions and smooth takeovers upon replacement of examiners, as internal control measures.

(2) Smooth communications with applicants/agents

On a trial basis, examiners describe specific reasons for decisions in written notices of reasons for refusal as a basic communications means between applicants/agents and examiners. In the questionnaire survey, 84.9% of respondents viewed descriptions of reasons in such notices as "sufficiently understandable" or "rather understandable." Many respondents welcomed and favored the trial descriptions. Examiners' interview, telephone, fax and other communications with applicants/agents and their indications of amendments were generally welcomed as useful. In order to inform applicants of examination-based decisions accurately and promote smooth communications, examiners may have to make more efforts to enhance descriptions in written notices of reasons for refusal, and flexibly respond to various contacts.

(3) Other

- Speed of examinations

In the interview survey, respondents were roughly satisfied with the speed of examinations, which has been a demand of design registration applicants. Nevertheless, some respondents

noted that although the speed of first actions had no problems and were satisfactory, second actions were slow for some cases. Therefore, examiners may have to take care to reduce such variability.

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