

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

ASAHI SEIMEI OTEMACHI BLDG.18F  
6-1 Otemachi 2-chome  
Chiyoda-ku Tokyo, 100-0004, JAPAN



TEL: 81 3 5205 3321  
FAX: 81 3 5205 3391  
URL: <http://www.jipa.or.jp/>

November 4, 2020

Mr. Daren Tang  
Director General  
World Intellectual Property Organization (WIPO)  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland  
Via email: [ai2ip@wipo.int](mailto:ai2ip@wipo.int)

## **Re: JIPA Submission on WIPO/IP/AI/2/GE/20/1 REV (REVISED ISSUES PAPER ON INTELLECTUAL PROPERTY POLICY AND ARTIFICIAL INTELLIGENCE)**

Dear Director General Daren Tang:

The Japan Intellectual Property Association (JIPA) appreciates the opportunity to provide comments on the REVISED ISSUES PAPER. JIPA, with its membership of 1335 companies (as of November 4, 2020), including 971 Japanese major companies, represents world's largest users of IP systems. We submit opinions and comments to domestic and international intellectual property related organizations regarding improvement of the intellectual property systems and operations. JIPA has carefully reviewed the Third Session of Conversation on Intellectual Property (IP) and Artificial Intelligence (AI) and respectfully submits comments. It would be appreciated if WIPO would take our comments into consideration.

### **1. Issue1 : Definition**

#### **1-1 Definition of "AI output"**

JIPA applauds WIPO for its first step of providing definitions, especially defining terms for "AI Output" from the angle of "human intervention". By this, we can better discuss the significant issue of whether or not to recognize AI as an inventor based on the common understanding.

#### **1-2 JIPA's Suggestion**

In view of the importance of these definitions being universally accepted to help

harmonization, JIPA would like to make some suggestions.

First, we should fill the gap in the definitions of the WIPO Paper. AI-assisted is defined as the generation of an output with material human intervention, and AI-generated is defined as that with no human intervention. So, in between, there should be “with immaterial human intervention”. Importantly, this missing portion is where some call for the amendment of the law and we are having lively discussions today.

After filling this gap, we should scrutinize both definitions and terms to which such definitions are given. Following is the explanation in the case of inventions under the patent law.

i) The current definitions based on the materiality of human intervention may need to be reconsidered. Inventor eligibility under the current law may provide more distinctive definitions. For example, AI Output can be classified into three categories.

- The 1st category is an invention generated by AI with intervention of an eligible human inventor, that is, a human who is deemed to be eligible under the laws of a jurisdiction,
- The 2nd category is that with intervention of an ineligible human inventor, and
- The 3rd category is that without human intervention.

ii) Also, we encourage WIPO to select simple and transparent terms to which definitions are given, or even terms using numbers such as 1, 2, and 3.

### **1-3 Advantages**

(1) First, this can categorize AI Output more clearly.

In WIPO Paper, materiality is used, but there is no definition for materiality. Constantly evolving technologies will make it significantly difficult to define it from a technical point of view.

On the other hand, inventor eligibility is the legal requirement courts in respective jurisdictions judge, so it can serve as more distinctive criteria.

(2) Secondly, all practitioners can have a common understanding of the law and issues they are discussing.

The 1st category is legally protectable today. So we can discuss the operations or practices under the current law. The 2nd category is not legally protectable, so we should discuss whether or not to amend the law in response to the demand to do so. In the 3rd category, we should discuss what to consider in preparation for the inventions which could possibly be created sometime in the future.

(3) Thirdly, we can provide definitions in a more neutral way.

In WIPO Paper, one definition is given to the term “AI-assisted” and another definition is given to the two terms, AI-generated and generated autonomously by AI. Many practitioners have exercised their ingenuities to select various terms to which definitions are given. Unfortunately, that may have complicated our discussions. We encourage WIPO to select terms which are simple and transparent.

## **2. Issue13: Trademark**

### **2-1 General/Brand**

(1) As for the examinations, many users expect, first and foremost at this moment, the introduction of AI for the purpose of improving examination quality and efficiency-in other words, a complementary application of AI to conventional search operations. Outside of examinations, the challenges for using AI for the entire process are: i) who should be responsible for the infringement of trademark rights owing to the unclear ownership of AI? and ii) organizing the problems and creating rules for the malicious use of AI for unauthorized or bad-faith applications and other purposes.

(2) For the first step, in order to improve search efficiency and accuracy, we need to focus the target of considering the introduction of AI on decreasing the amount of missed tasks by humans and improving the search speed. We predict that AI will evolve along the way and that humans will become more tolerant toward the technologies and outputs of AI. It will be after a certain degree of infrastructure (legal) development has been achieved that we should work on the second step, that is, the further utilization of AI.

(3) Regarding brand recognition, as long as humans undertake the role of branding (marketing), it is unlikely that the introduction of AI will have a major impact, while we would expect novel naming patterns created by AI. For the time being, we should leave it to humans as to how to develop them for branding and create business opportunities.

### **2-2 Infringement**

(1) There are potential challenges to cope with when businesses using AI expand. In the marketplace, for example, when AI acts as if it, by itself, conducts transactions and infringes trademark rights, we will face the question of who will be the infringing

entity and what the act of using a trademark means.

(2) Currently, AI is often used to perform only specific tasks, but in the future it is possible that AI may be able to deal with various issues in the same way as humans, and to have a human-like awareness to make comprehensive judgments. Therefore, we need to carefully examine the pros and cons of the use of AI in the medium and long term.

### **2-3 Malicious use**

(1) It is undesirable that unauthorized or bad-faith applications be filed through the improper use of AI. One example is the use of AI to file trademark applications with intent to sell to the others, in an exhaustive manner, for marks that AI has efficiently created (or combined to produce new patterns). This is an issue not limited to AI use. However, since AI-created marks are likely to be registered and applications can be made in large numbers, we are concerned that the number of bad acts will grow rapidly.

(2) These concerns are, in short, about the malicious use of AI for not only the intellectual property but also the society, so it may be an infrastructure problem about AI use in a wider range (e.g., international rules on using AI). Given the fact that there is competition between application examiners introducing AI and applicants utilizing AI, it is vital that we set guidelines on the use of AI.

### **2-4 Examination/ registration**

(1) When AI is used for prior trademark searches, it may influence the registrability of trademarks, depending on the method. If AI is used as a tool to assist searches, it is thought that the efficiency and accuracy of the search can be improved. For example, AI may be used, preliminarily before human examiners judge the registrability, to identify clearly dissimilar trademarks from the huge amount of data detected in a search and exclude them before making similarity judgments.

(2) On the other hand, if AI alone conducts a search and also makes a judgment on registrability based on the search results, it is very likely that the judgment will lack validity or a false judgment will be made due to malfunction, given the current accuracy of AI. This causes the risk that there will be more false registrations and that the quality of examinations cannot be guaranteed.

(3) If the quality of examinations is not guaranteed and the examination results

become unstable, there will be no fairness among the applicants, and trust in the registration will be impaired. Therefore, it is necessary to establish a mechanism and rules to ensure the quality of the examination, such as confirming in prior trial experiments whether AI is conducting the search in accordance with the examination rules, standards and criteria and assigning an examiner to confirm the validity of the conducts by AI during the stage immediately after the introduction of AI.

(4) Safeguard measures related to registration, etc. should be implemented. These include the provision of options to provide relief by a human examiner to applicants. If a risk management problem is revealed in the future, appropriate solutions should be provided so that the applicant can avoid the burden.

## **2-5 Future response**

Finally, it is specialized AI fine-tuned through learning that has reached the practical level. Innovation is necessary for general-purpose AI to reach the same level. However, it will be too late to consider this after we use AI in an even more sophisticated manner. It is necessary to work on this issue and prepare from now, particularly because innovation can occur suddenly and we need to recognize the speed at which ICT-related developments are made.

In closing, we thank WIPO again for the opportunity to provide these comments. JIPA will continue supporting WIPO's efforts and leadership to guide the discussion on IP and AI. If you have any questions, require further information, or wish to discuss JIPA's comments or any other issues, please let us know.

Sincerely,



Yuji TODA

President

Japan Intellectual Property Association