



Seiwa Patent & Law (IP Information Section)

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The Revised Design Examination Guidelines regarding “graphic image on a screen” designs entered into force on April 1, 2016¹, in Japan

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Summary

There is a class 14-04 for Graphical User Interfaces [computer screen layout] in the International Design Classification or Locarno Classification². However, in Japan a design for a GUI cannot be registered under the title “GUI”. It is instead necessary to indicate a product to which the GUI design is applied, e.g., “Mobile phone” or “Digital Video Disc Player”. “Part VII, Chapter IV, Design Including a Graphic Image on a Screen in the Revised Design Examination Guidelines” published on March 11, 2016, includes the examination standards related to a design for a “graphic image displayed on a display of an article”, “graphic image displayed on a screen” or “graphic image on a screen”. In this article we will explain how to file a design application for protecting a design for a “Graphical User Interface [computer screen layout]” and “Icons (for Computers)” at the JPO under the Revised Examination Guidelines by using the term “graphic image on a screen” or GIOS.

Table of Contents

1. The Revised Design Examination Guidelines apply to design applications filed at the JPO on or after April 1, 2016.
2. What is changed under the Revised Design Examination Guidelines?
3. Indication of an article and representations showing a design.
4. A design cannot be separated from an article to which the design is applied.
5. Registration requirements for “Creative difficulty” related to a design for a graphic image on a screen.
6. Conclusion

1. The Revised Design Examination Guidelines apply to design applications filed at the JPO on or after April 1, 2016.

The three examples below are cited from the English version of the Revised Design Examination Guidelines “Part VII Individual Applications for Design Registration, Chapter IV Design Including a Graphic Image on a Screen”³, hereinafter referred to as “English version.”

¹ https://www.jpo.go.jp/shiryou/kijun/kijun2/gazou_ishou_kaitei.htm

On March 11, 2016, the Design Examination Standards Office announced on the website above that the part related to a design for graphic image displayed on a screen in the Revised Design Examination Standards will apply for applications filed at the JPO on or after April 1, 2016.

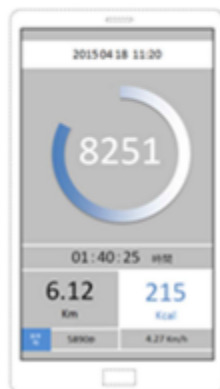
² <http://www.wipo.int/classifications/nivilo/locarno10/index.htm?lang=EN>

³ https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/design_es.htm

https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/design_es/0704.pdf

[Case example 1 of a graphic design on a screen that is found to constitute a design of the computer with additional function]

“Computer with a pedometer function”



Graphic image displaying step count data

*For the sake of convenience of explanation, the matters described in the application and other drawings were omitted.

[Case example 2 of a graphic design on a screen that is found to constitute a design of the computer with additional function]

“Computer with a function of creating postcards”

[Graphic image view]



This graphic image on a screen is to enable the article to perform its function by entering data from the address book

*For the sake of convenience of explanation, the matters described in the application and other drawings were omitted.

[Case example 3 of a graphic design on a screen that is found to constitute a design of the computer with additional function]

“Computer with a machining center control function”

[Front view]



This graphic image on a screen is to set the content of cutting work

*For the sake of convenience of explanation, the matters described in the application and other drawings were omitted.

[English version, 74.4.1.1.1.3.2]

Under the Revised Design Examination Guidelines it is expected that a “graphic image on a screen” (GIOS) which is **(i) recorded by installing software in an article after the article is put on the market, and (ii) recorded by installing software in a computer so that the computer can work as a special machine with a special function**, may be able to be registered at the JPO, similarly to some graphic images on a screen which have already been registered under the former Design Examination Guidelines.

2. What is changed under the Revised Design Examination Guidelines?

2-1. Graphic image on a screen appears because the image is recorded by installing software in an article after the article is put on the market

The following table shows the subject matter to be registered under the former Design Examination Guidelines and the Revised Design Examination Guidelines⁴.

Former Design Examination Guidelines	Revised Design Examination Guidelines
<ul style="list-style-type: none"> ■ The graphic image displayed on the display of the article is <ul style="list-style-type: none"> ➤ a graphic image recorded in the article in advance (74.1.2 and 74.5.1.1.1.1.2) ➤ a graphic image for making necessary indications for performing the functions of the article (74.1.1 and 74.5.1.1.1.1.1) <p style="text-align: center;">or</p> ➤ the graphic image on the screen is produced for use in the operation for enabling the article to perform its function (74.2 and 74.5.1.1.1.2) 	<ul style="list-style-type: none"> ■ The graphic image displayed on the display of the article is <ul style="list-style-type: none"> ➤ a graphic image recorded in the article (including a graphic image of an updated relating to the function of the article) (Revised Guidelines 74.4.1.1.1.2 and 74.4.1.1.2.3) ➤ a graphic image for making necessary indications for performing the functions of the article (Revised Guidelines 74.4.1.1.1.1) <p style="text-align: center;">or</p> ➤ the graphic image on the screen is produced for use in the operation for enabling the article to perform its function (Revised Guidelines 74.4.1.1.2.1)

As shown in the above table, the JPO stated that the former Design Examination Guidelines, which stipulate that a graphic image on a screen should be recorded in the article in advance, would be relaxed to allow registration of a GIOS recorded in the article at **any time, including after purchase of the article**.

2-2. Examples

⁴ https://www.jpo.go.jp/seido/s_ishou/pdf/isho_text_h27/21.pdf

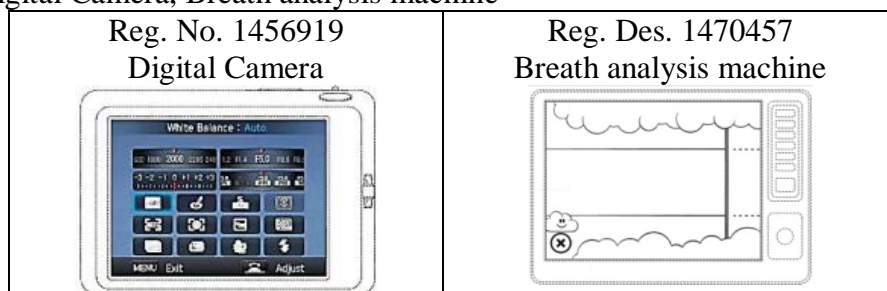
The documents issued on March 9, 2016, on the JPO website (Slide Nos. 86, 85).

https://www.jpo.go.jp/seido/s_ishou/isho_text_h27.htm

https://www.jpo.go.jp/shiryou/kijun/kijun2/gazou_ishou_kaitei.htm

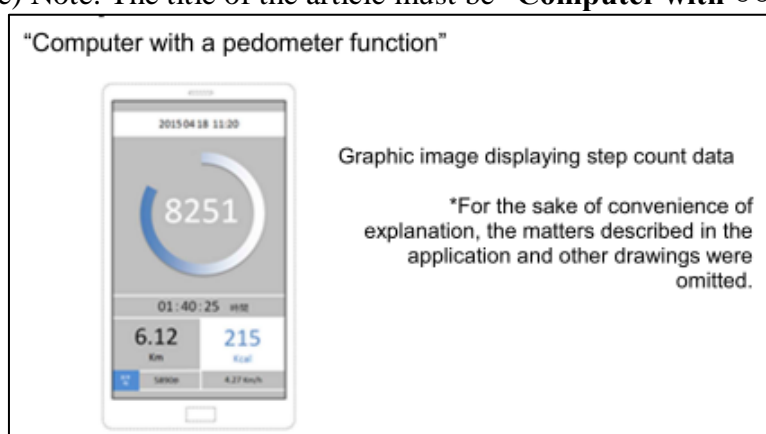
(1) Examples of a GIOS already registered under the former Design Examination Guidelines

- GIOS recorded in the article in advance
 - * GIOS recorded in the machine with a special purpose,
- e.g. Digital Camera, Breath analysis machine



(2) Examples of GIOS that can be registered under the Revised Design Examination Guidelines

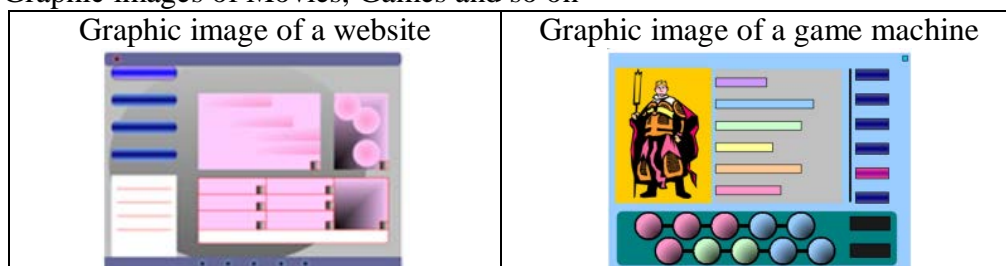
- GIOS recorded in an article that appears because the function of the article is updated
 - * GIOS having a concrete function which is recorded in a computer (PC, Tablet or smartphone) Note: The title of the article must be “**Computer with ○○○ function**”



[English version, 74.4.1.1.1.3.2]

(3) Examples of GIOS that cannot be registered⁵

- Subject matter displaying a graphic image based on signals sent from outside of the article
 - * Graphic image of a website
 - * Graphic image of software used through the Internet including Cloud Computing
 - * Graphic image of a TV program
- Graphic image shown on a display showing a movie (Contents)
 - * Graphic images of Movies, Games and so on



⁵ https://www.jpo.go.jp/seido/s_ishou/pdf/isho_text_h27/21.pdf

The documents issued on March 9, 2016, on the JPO website (Slide No. 85)

3. Indication of an article and representations showing the design.

3-1. Title of the article or Indication of a product to which the design is applied

The title of the article should be “**Computer with ○○○ function**” when a design application for a GIOS for a computer is filed at the JPO.

“The graphic image shown on a display recorded in a computer by using software realizing a concrete function will be an appropriate subject matter to be registered as a graphic image on the display for a computer with an additional function.”⁶

The following are examples of registrable designs.

- Computer with a Home Menu function
- Computer with a pedometer function
- Computer with a route guidance function
- Computer with a camera function
- Computer with a machining center control function

The GIOS for a special-purpose machine which has been registered conventionally can be registered.

Examples: Digital camera, Mobile phone, Mobile information terminal, Breath analysis machine, and Video Disc Player, etc.

However, the following titles of articles cannot be allowed since their function indicated in the title of the article is considered to be abstract, general or not a single function.

Examples: Computer with office work processing function, Computer with decision making function or Computer with mobile information terminal function.

3-2. “Explanation of the article” in the application request

In the Japanese design application Request it is necessary to include a statement explaining that (i) the subject GIOS is shown to provide necessary indications for performing the function of the article, or (ii) the subject GIOS is used in the operation of the article in order to enable the article to perform its function.

Examples:

- (i) [Article to the design] Mobile phone

[Front view]



[Description of Article to the Design]

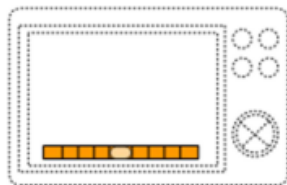
The article is a mobile phone having an azimuth measurement function. The figure displayed on the display part in the front view indicates the measured azimuth, and the compass rotates according to the measured azimuth.

⁶ https://www.jpo.go.jp/seido/s_ishou/pdf/isho_text_h27/21.pdf

The documents issued on March 9, 2016, on the JPO website (Slide Nos. 85 and 93)

(ii) [Article to the Design] Digital camera

[Front view]



Indication of information for supporting
taking pictures or vidoes (level indication)

[Description of Article to the Design]

The article is a digital camera with a level function that senses the tilt of the camera.

The figure displayed on the display part in the front view is the level indication for confirming that the level is horizontal when taking pictures or vidoes.

[English version, 74.4.1.1.1.1]

3-3. Representations or Drawings attached to the application request

(1) It is necessary to show a product shape in a dotted line and the subject graphic image on a screen in a solid line.

At least three orthographic views showing the product should be included in the drawings. One of the following views can be omitted.

- (i) One of Front or Rear views
- (ii) One of Right or Left side views
- (iii) One of Top plan or Bottom plan views

(2) The omitted view should be referred to in a statement in the application request, e.g. as follows:

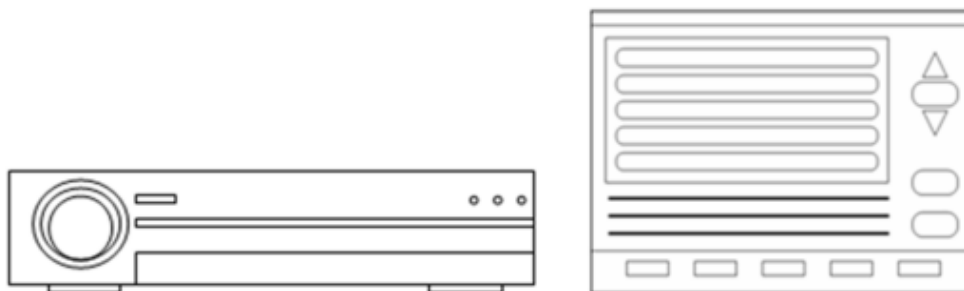
- (i) Both views are shown in the same or mirror image
- (ii) The omitted views do not show the part depicted by a solid line.

(3) Graphic image view:

The term “graphic image view” means a view only showing a graphic image taken from a display which is used together with a separate product and is allowed by the JPO for the drawings attached to an application request for a GIOS for a product which has no display but is used together with a separate display when the product is used.

Example: A graphic image on a screen for a magnetic disk recorder and shown on a display separated from a recorder but is used together with the recorder.

“Magnetic disk recorder”



(Example of a graphic image displayed on another article that is used with the article in an integrated manner (e.g., a television monitor))

[English version, 74.4.1.1.1.2.2]

3-4.Similarity judgment regarding GIOS designs

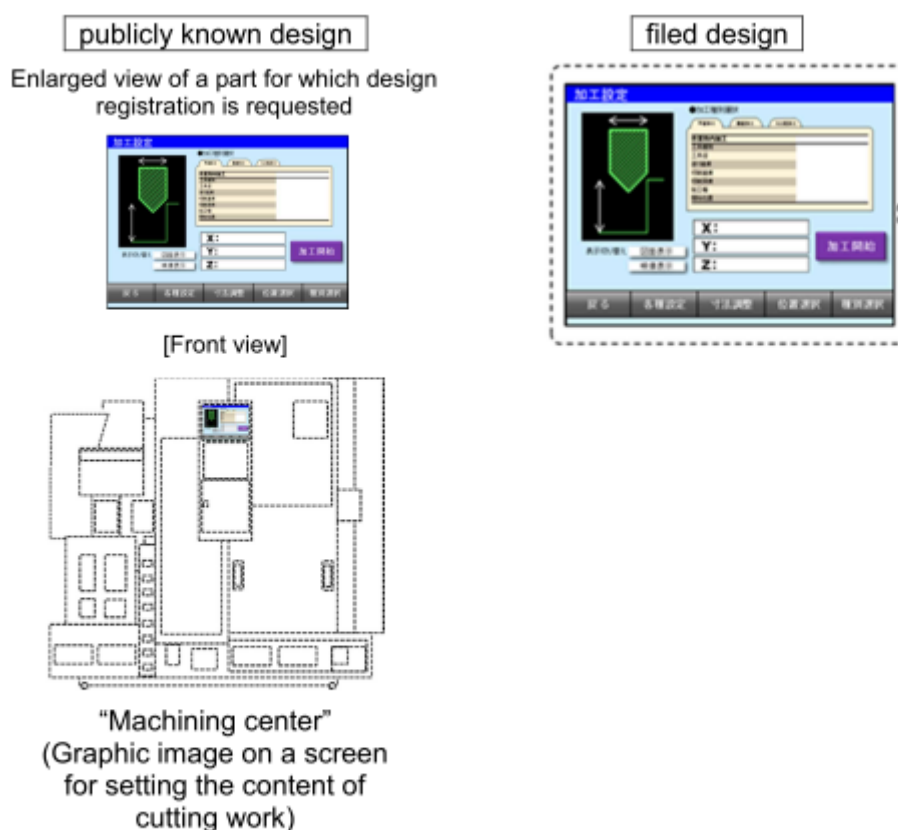
Under Article 3 of the Japanese Design Law a design shall have novelty. This means that the filed design is considered not to be identical or similar to prior designs. Similarity is decided on the basis of first (i) whether the articles to which the designs are applied are identical or similar, and (ii) whether the designs or appearance of the article are identical or similar to each other.

Item 74.4.2.2.1 of the Revised Design Examination Guidelines stipulates that the above criteria apply to a GIOS. Moreover, a third criterion, (iii) **whether functions and usages of the two designs are identical or similar to each other**, is also taken into consideration when judging similarity.

The standards stipulate as follows.

“A graphic image on a screen is in the shape, patterns or colors, or any combination thereof, of a part of an article. In order for designs including graphic images on a screen to be similar, the usage and functions of the graphic images of the two designs to be compared must be identical or similar.” [English version, 74.4.2.2.1]

The above criteria must be kept in mind when we judge similarity of designs for a GIOS for a computer with a function. For example, a computer with a machining center control is not considered identical or similar to a machining center itself since there are differences in the actual articles.



*For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

4. A design cannot be separated from an article to which the design is applied.

The Revised Design Examination Guidelines maintain the principle that a design should be not separated from the article to which the design is applied

In Japan there have been discussions on how to realize protection for a design regarding a GIOS before the revised Design Law 2006 was established.

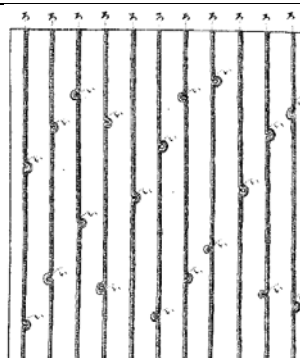
4-1. Background of the Design Examination Guidelines revision

On February 5, 2016, the Design Examination Standards Office of the Industrial Structure Council Intellectual Property Committee published the result of its study under the title “Outline of the Revision of the Design Examination Guidelines”⁷ and “Outline of the comments contributed to the Outline of the Revision of the Design Examination Guidelines”⁸ The former report was drafted by the Design Examination Standards Working Group and issued in January 2016, by the Design Examination Standards Office. It includes a report drafted in November 2015. The latter report is a report related to comments contributed for the Draft of the revised Design Examination Guidelines from December 21 2015⁹ to January 19, 2016.

4-2. Basics of the Revised Design Examination Guidelines

In principle in Japan a design should be not separated from a product to which the design is applied. Article 1 of the 1888 Design Act (first industrial Design Law in Japan) stipulates that a new design for a shape, pattern or colors should apply to an industrial article. Among the registered design in those days a design for fabrics shown in only one view can be found.

Registered design No. 1 (JP,0000001,S)¹⁰
Title: “Design for Woven stripes”



Article 1 of the Design Law 1921 changed the phrase “for an industrial article” to “relate to an article” and Article 2 of the Design Law 1959 stipulates that “Design” in this Law means the “shape, pattern or color or a combination of these in an article which produces an aesthetic impression on the sense of sight.”¹¹ Thus in Japan, the idea that a design cannot be constructed if it is separated from an article is prevalent. In a Supreme Court judgment issued on March 19, 1974, 1970 (Gyo-Tsu) No. 45, Hose case, the judges stated “We believe that a design is viewed as an integral part of an article”.

In practice, it is necessary to submit a figure showing a product shape in a solid line or dotted line together with a pattern or ornamentation in the drawings attached to the

⁷ https://www.jpo.go.jp/shiryoutou/toushin/toushintou/pdf/isyou_seido_160205_gazo/01.pdf

⁸ https://www.jpo.go.jp/iken/151221_gazo_kekka.htm

⁹ http://www.jpo.go.jp/iken_e/draft_revision_151221.htm

¹⁰ Please access the following website and type 1 to retrieve the published registered design.
https://www4.j-platpat.inpit.go.jp/eng/ishow/isbs_en/ISBS_EN_GM101_Top.action

¹¹ AIPPI/Japan 1988

application request even when it is only desired to register a two-dimensional design, i.e., a pattern or ornamentation. For a very thin article like a sheet it is allowed to submit a single figure but a statement should also be submitted to point out that the rear view is omitted since no pattern is shown on the rear side. Therefore, we believe that a design for a LOGO (Class 32-00 under Locarno Classification) may be extremely difficult to register at the JPO considering the requirements regarding articles and drawings.

Under the Revised Design Examination Guidelines the traditional principle that a design cannot be separated from the article is maintained and therefore it should be noted that it is necessary for a GIOS for a computer to indicate **“Computer with ○○○ function”** in the title of article.

5. Registration requirements for “Creative difficulty” related to GIOS.

For a design to be registered it should not have been an easy creation.

The above first to fourth paragraphs explaining the rules in the Revised Design Examination Guidelines are applied to design applications which are filed on or after April 1, 2016.

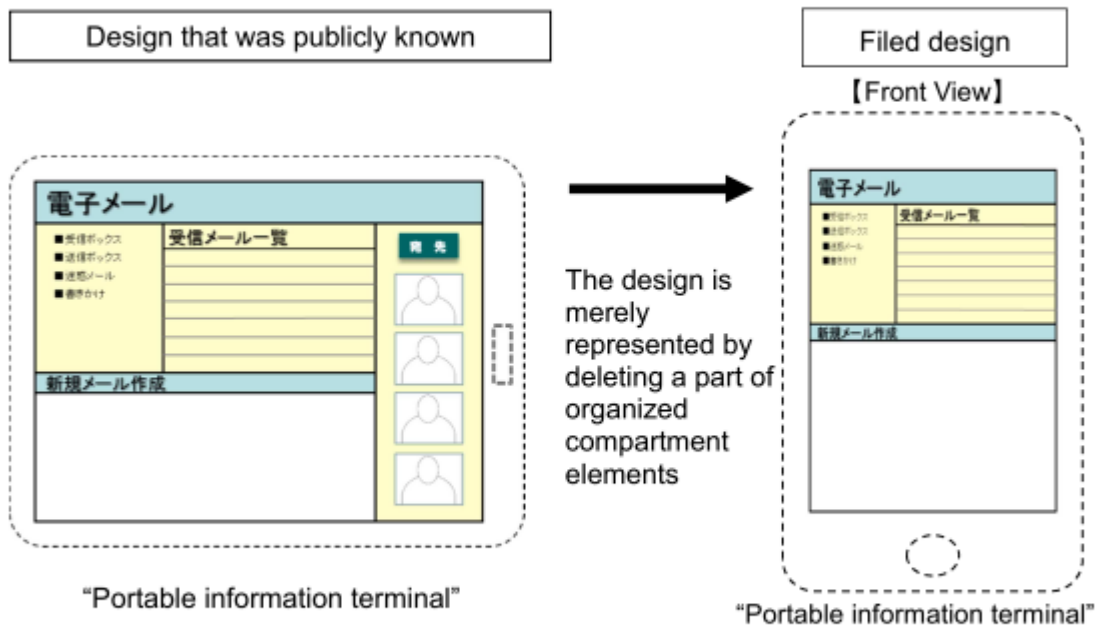
The JPO has further announced that the Revised Design Examination Guidelines include an amendment of the standards for examination under Article 3, paragraph 2 of the Japanese Design Law, Item 74.4.3 of the Revised Design Examination Standards, in order to provide users with a clearer explanation of the unchanged requirements regarding creative difficulty. The revised standards Item 74.4.3 applies to applications to be examined on and after April 1, 2016.

“Application of the provision of Article 3(2) of the Design Act is to be determined by making a determination as to whether or not, in the constitution of designs including a graphic image on a screen (all designs found to be under Articles 2(1) and 2(2) of the Design Act), the constituent elements or specific constitution on which the designs are based were publicly known or widely known prior to the filing of the application for design registration, and whether or not those constituent elements have been added almost as they are or by only adding an ordinary modification regularly seen in the art thereto and this change is a mere combination that is an ordinary technique in the art or all of or part of the constituent elements have been merely replaced” [English version, 74.4.3]

The Revised Design Examination Guidelines Item 74.4.3.1 clearly states that the scope of the knowledge of the person who judges the creative difficulty is that of a person having ordinary skill in the art of the design, and covers not only ordinary knowledge in the same industry but also ordinary knowledge regarding a GIOS. Article 3, paragraph 2 relating to creative difficulty can be widely applied to not only the same kind of article but also articles in different industries.

[Case example]

Design that merely represents a graphic image on a screen that was publicly known, almost as it is, by deleting a part of organized compartment elements



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[English version, 74.4.3]

6. Conclusion

As stated above, a GUI itself is difficult to register at the JPO. It may be necessary to discuss with a Japanese Attorney what drawings or representations the JPO may smoothly accept. We of course will be happy to assist our clients and associates in obtaining registration of a design for a graphic image on a screen at the JPO.

END