



Court Cases Related to Picture Provided by Image Display for Operation of Article

Minako Mizuno (partner/patent attorney)

Seiwa Patent & Law (Tokyo, JAPAN)

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Abstract

On May 30, 2017, the Intellectual Property High Court (hereinafter “IP High Court”) affirmed four trial decisions issued by a collegial body of trial examiners of the JPO¹. The original trial decisions supported the examiners’ final rejections of four design applications filed by the same applicant for a graphic image related to a car with a video system, and the applicant appealed the cases to the IP High Court against the trial decisions. In the judgments on all four cases, the IP High Court suggested that the wording “*a picture provided by an image display for the operation ... of the article*” in Article 2(2)² of the Japan Design Law refers to being able to operate an article by using a figure shown on a screen instead of an operation button or physical parts such as used in household electrical appliances or information equipment. We hereby explain the judgment on one of the four cases for better understanding of the Japan Design Law and practice related to on-screen graphic images³.

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¹ The four judgments issued by the IP High Court were appealed to the Supreme Court and judgments by the Supreme Court on these four cases are still awaited.

² Article 2 (1) “*Design’ in this Law means a shape, pattern or color or any combination thereof in an article (including part of an article – hereinafter referred to as ‘the article’ except in Article 8) which produces an aesthetic impression through the sense of sight.*”

Article 2 (2) “*In the preceding item, a shape, pattern or color or any combination thereof in a part of the article shall include a picture provided by an image display for the operation (limited to the operation for keeping the article concerned in an operative condition for consummating its function) of the article and that it is shown on the article concerned or the article used as an integral part thereof.*”

Article 2 (3), (4) are omitted.

(English translation of the Japanese Design Law is cited from AIPPI/Japan 2016version)

³ Under the Japan Design Law, it is not allowed to indicate “GUI” or “icon” as the title of an article or a design to be registered since it is necessary to indicate a title of an article to which the subject design is applied in a design application request as a three-dimensional product. Relating to the Japan Design Law, we discuss the matter of a “GUI” or “icon” by using the words “a graphic image on a screen” or “Screen Design” translated from “GAMEN DEZAIN” in Japanese.



I. FACTS

1. Four cases related to a graphic image projected by a video system of a car

On May 30, 2017, the IP High Court separately issued judgments on four cases, i.e., H28 (Gyo-ke) 10239, H28 (Gyo-ke) 10240, H28 (Gyo-ke) 10241 and H28 (Gyo-ke) 10242. All the cases were appealed to the IP High Court to challenge trial decisions issued on demands for appeal (Appeal Nos. 2016-8799, 2016-8801, 2016-8802 and 2016-8803) on October 5, 2016. These trial decisions were made by a collegial body of trial examiners of the JPO, who affirmed the final rejections of the applications issued on February 17, 2016, by a JPO Examiner under Article 3, the body of paragraph 1 of the Japan Design Law, on the ground that the subject designs were judged not to meet the definition stipulated under Article 2(2) and therefore the subject designs were not considered to be designs capable of being used in industrial manufacture.

Each one of the applications (Design Appl. Nos. 2015-5576, 2015-5578, 2015-5579 and 2015-5580) is related to a graphic image on a screen for a car with a video system and shown in representations attached to the application request as a set of six-view drawings of a car in a dotted line and figures showing a graphic image on a screen⁴ in a solid line within a frame depicted by a dot-dash-dot line under the label “reduced graphic image view”.

The four design applications commonly included a statement explaining the article as follows.

“The subject article is composed of a car with a video system and graphic image views which are projected by a video system of the car and appear on a display which is used together with the car including, e.g., the road surface surrounding the car, the floor of a vehicle parking lot or an exhibition hall.”

The figures included with the three cases, i.e., H28(Gyo-Ke) 10239, to 10241, show graphic image views which would be useful for the driver, however, the figures submitted for the case H28(Gyo-Ke) 10242 show graphic image views which would be useful mainly for attracting the attention of a pedestrian who crosses a road.

This article will discuss the court decision on H28 (Gyo-Ke) 10239.

⁴ In all four cases the applicant stated that “screen” has a broad meaning and includes road surface or floor which can act as a screen.



2. Case H28 (Gyo-ke) 10239
2-1. Statements in the application request

The judgment on case (Gyo-ke) 10239 attached a copy of statements on the subject article and a design JP2015-5576 and its representations as an attachment, as shown below.

Title of the article: Car with a video system

Explanation of the article: The subject article is composed of a car with a video system and graphic image views⁵ which are projected by a video system of the car and appear on a display which is used together with the car, e.g., the road surface surrounding the car, the floor of a vehicle parking lot or an exhibition hall. The function of a car is generally assumed to be “run”, “turn” and “stop”. Each graphic image for the subject article is “a graphic image to be used for operation” which is used to enable the article to perform its functions. 1. Move forward (1) A driver or a fellow passenger unlocks a car [Reduced graphic image view 1 (Reference view showing the design in use 1)] and [Reduced graphic image view 2 (Reference view showing the design in use 2)] (2) The driver starts the engine [Reduced graphic image view 3 (Reference view showing the design in use 3)] (3) The driver performs the act for forward movement [Reduced graphic image view 4 (Reference view showing the design in use 4)] and [Reduced graphic image view 5 (Reference view showing the design in use 5)] (4) The following actions are repeated until the car starts running [Reduced graphic image view 7 (Reference view showing the design in use 7)] and [Reduced graphic image view 8 (Reference view showing the design in use 8)] (5) The car runs. 2. Move back (1) A driver or a fellow passenger unlocks a car [Reduced graphic image view 9 (Reference view showing the design in use 9)] and [Reduced graphic image view 10 (Reference view showing the design in use 10)] (2) The driver starts the engine [Reduced graphic image view 11 (Reference view showing the design in use 11)] (3) The driver performs the act for backward movement [Reduced graphic image view 12 (Reference view showing the design in use 12)] and [Reduced graphic image view 13 (Reference view showing the design in use 13)] (4) The following actions are repeated until the car starts running [Reduced graphic image view 14 (Reference view showing the design in use 14)] to [Reduced graphic image view 16 (Reference view showing the design in use 16)] (5) The car runs.

Explanation of the design: The only area surrounded by a dot-dash-dot line is the part to be registered as a partial design.

⁵ Graphic image view is used only where an image is shown on a display which is used together with another article. In this case a car is another article and the graphic image is shown on a display which is used together with the car since the image is exposed by a video system of the car.



2-2. Representations attached to the application request

The representations included a set of six-view⁶ dotted-line drawings showing a car, sixteen reduced graphic image views and sixteen reference views showing the design in use. For details of the drawings included in the representations, please see the Annex.

2-3. Point of trial decision

The collegial body of trial examiners of the JPO affirmed the Examiner's final rejection on the ground that the subject graphic image on a screen does not meet the definition of a design to be registered under Article 2(2) of the Japan Design Law.

Under Article 2(2) of the Japan Design Law a graphic image on a screen should be provided for use in the operation of the article in order to enable the article to perform its function. The subject graphic image as shown in reduced graphic image views 1 to 16 in the drawings attached to the subject application does not show a graphic image being used for operation of the article. They appear to show only the operating condition of the car in being unlocked prior to being put into motion. Therefore, the subject graphic image cannot be considered to be a graphic image on a screen defined under Article 2(2), and therefore the subject graphic image cannot be granted registration under Article 3, main paragraph.

2-4. Appellant's argument

The appellant argued that the subject graphic image should be considered to show a registrable design by arguing their understanding of Article 2(2) of the Japan Design Law 2006, particularly the meaning of "operation", "limited to the operation for keeping the article concerned in an operative condition for consummating its function", "a picture provided by an image display for the operation of the article" and "visibility" of the subject graphic image. The appellant argued that in light of the spirit of the Design Law, the subject graphical image should be an appropriate subject for a design to be protected under the Law since the subject design shows a close relationship between transition of a graphical image and operation of the article.

⁶ Under the Design Examination Guidelines which entered into effect as of April 1, 2016, it is not necessary to submit a set of six-view drawings depicted by a dotted line for an article which is used in an integrated manner with another article on which a graphic image on a screen appears if a graphic image view is submitted. The subject design was filed in 2015 and therefore a set of six-view dotted line drawings were submitted.



II. COURT JUDGMENT

The IP High Court affirmed the trial decision and dismissed the appeal referring to the legislative history of the Japan Design Law amended in 2006, the meaning of a graphic image on a screen defined by Article 2(2) of the Law, and the reason why the subject graphic image on a screen is considered not to satisfy the definition of a design to be registered under Article 2(2).

1. Legislative history of the Japan Design Law amended in 2006, and the meaning of Article 2(2)

Article 2(2) was introduced into the Japan Design Law by 2006 Law No. 55. In the industry of household electrical appliances or information equipment, appliances to be operated through a figure or picture shown on a screen display or so called “Screen Design” which replaced operation buttons or physical parts, had increased before this amendment. Before 2006 a “Screen Design” or graphic image shown on a display which is separated from an appliance to be operated but which receives a signal or is operated from the appliance was considered not to be registrable under the Japan Design Law. In 2006, the Design Law was amended and Article 2(2) was established to protect a “Screen Design” under the Design Law.

As the legislative history shows, the wording “a picture provided by an image display for the operation of the article” is intended to indicate something capable of operating an article by using a figure shown on a screen which replaces an operation button or physical parts used in electrical or information appliances or systems. Therefore, unless there are special circumstances⁷, the wording “a picture provided by an image display for the operation of the article” should be understood to mean that the figure which is used for operation of the article shown on a screen and can be selected or designated by users.

2. The subject graphic image on a screen cannot satisfy the definition of a registrable design under Article 2(2).

The subject image only prompts a driver to operate physical parts, i.e., engine key, shift lever, brake pedal or accelerator pedal, by showing operating states prior to unlocking to before or after putting the vehicle in motion. The driver does not operate the article (Car with video system) by choosing or specifying a figure shown on the subject image. The subject image may not be considered to be a figure used for operation of an article nor is it

⁷ The court does not indicate what a special circumstances means. We assume that the usage of the graphic image on a screen concerned cannot be considered to be a special circumstance by the court.



shown on an image where it can be selected or designated. There are no special circumstances in the subject graphic image in this case. Therefore, the subject image does not correspond to “a picture provided by an image display for the operation of the article”, and thus the subject design does not correspond to a design capable of being used in industrial manufacture defined under Article 3, main paragraph.

III. JAPAN DESIGN LAW AND GUI

1. Title of the article and GUI or Graphical Use Interface

“Graphical User Interface [Computer screen layout]” and “Icons [for computers]” are found in the Locarno classification on the WIPO website as an indication of goods. However, users who wish to protect their GUI or Icon at the Japan Patent Office should avoid indicating “GUI” or “Icon” as the title of the article in a Japanese design application request because the Japan Design Law has been defined to protect an appearance of product which has a three-dimensional body. Therefore it is recommended that users who wish to protect their GUI or Icon should submit the design as a partial design in which the shape of the article can be depicted by a dotted line and the GUI or Icon itself be shown in a solid line.

2. The Japan Design Law and Design Examination Guidelines

Since April 1, 2007, when the 2006-revised Japan Design Law entered into force, the JPO has examined many applications for a graphic image on a screen under Article 2(2). On the basis of their experience, the JPO decided to replace some provisions regarding a graphic image on a screen in the Design Examination Guidelines with more relaxed and understandable ones. As of April 1, 2016, amended standards in Part VII, Chapter IV, “Design Including a Graphic Image on a Screen” became effective. The following website will be informative for users who wish to know more about how to handle an application for a graphic image on a screen in Japan since April 1, 2016.

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

3. Points of the four decisions

Returning to the original four cases, in 2006, the Japan Design Law introduced Article 2(2) to broaden the subject of a graphic image on a screen to match the actual circumstances surrounding product development in various industries. Under the new Article 2(2), the article of a design application should be a graphic image on a screen which is provided for use in the operation of the article in order to enable the article to perform its function. Moreover, under Article 2(2), in a case where an article and a display which are separated



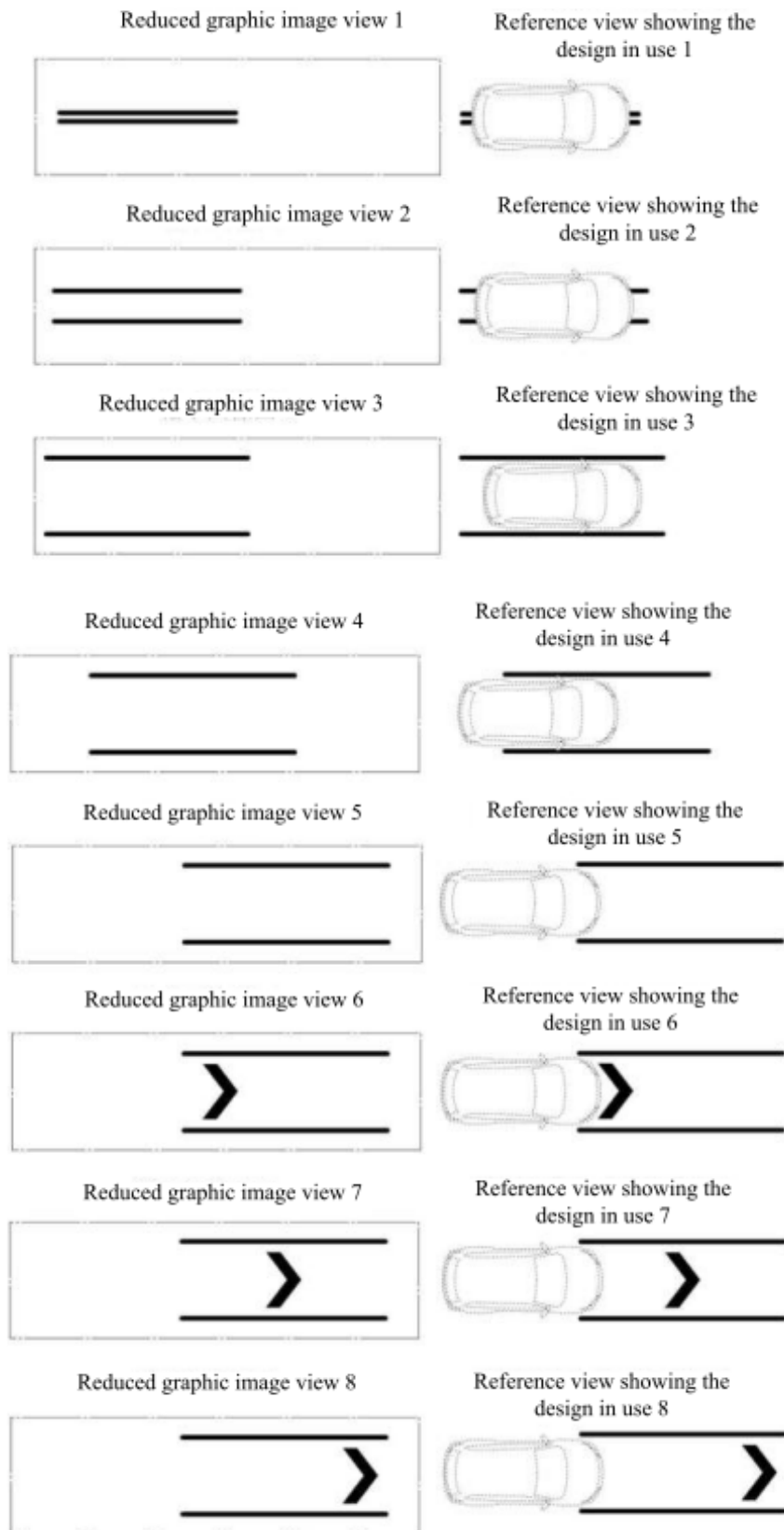
from each other but work together, a graphic image on a screen of the display could be an appropriate subject for a design if the graphic image for operation is used to enable the article to perform its function. It should be noted that it is still necessary to clearly indicate that the subject graphic image on a screen should be applied to an article having a three-dimensional body.

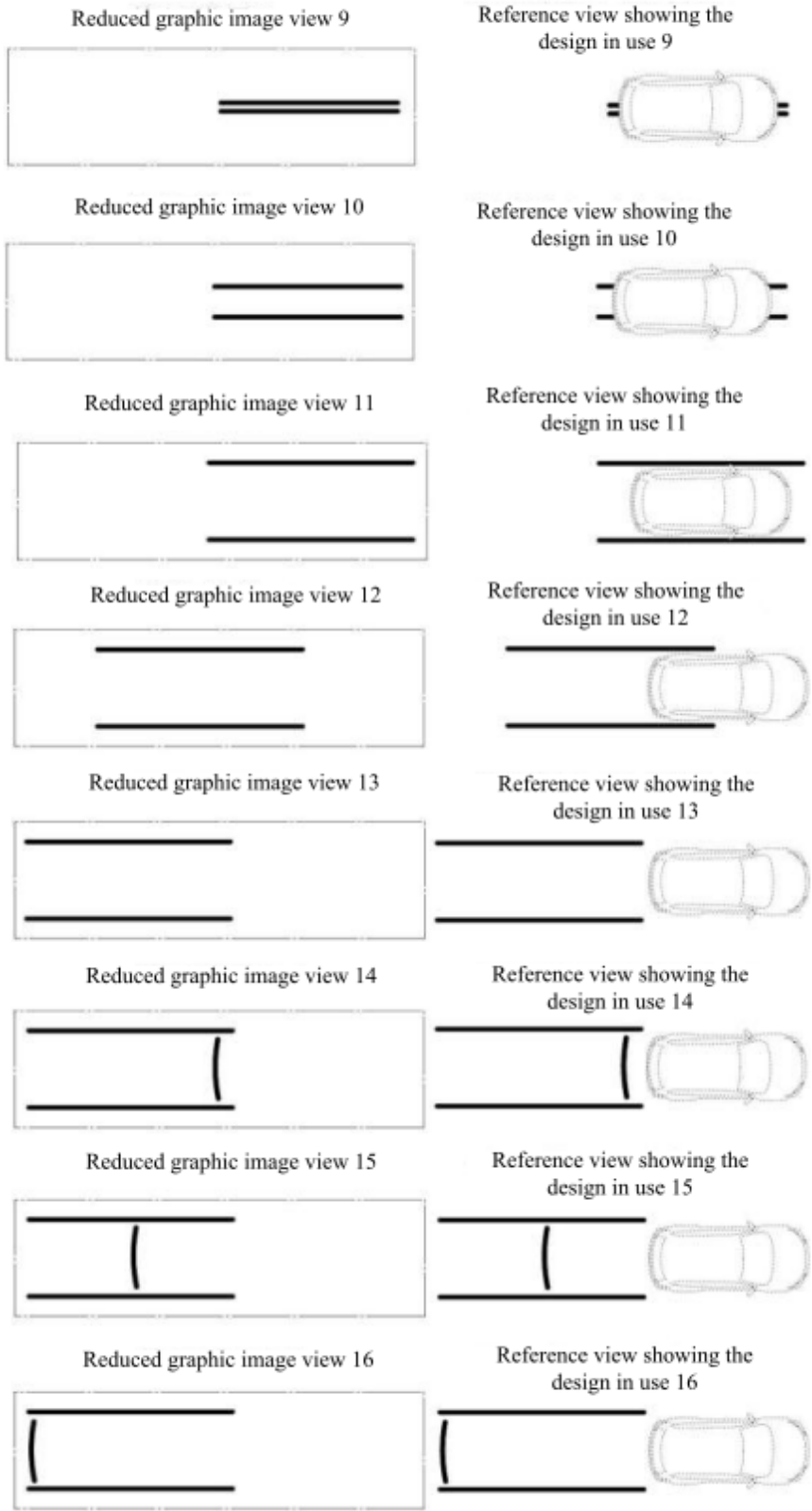
In light of the spirit of the Design Law amendment, the IP High Court made a decision that the subject graphic images on a screen which are projected from a video system of a car are not appropriate subject matter under Article 2(2) and Article 3, the body of paragraph 1 of the Japan Design Law.

The appellant of the four cases has submitted appeals to the Supreme Court and therefore we are looking forward to the judgments issued by the Supreme Court on these controversial cases.

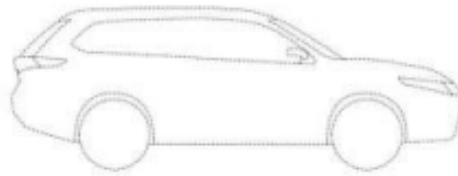
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ANNEX: DRAWINGS INCLUDED IN THE REPRESENTATIONS

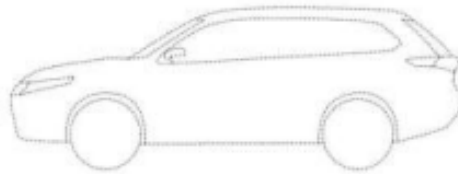




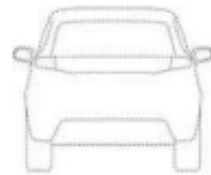
Front View



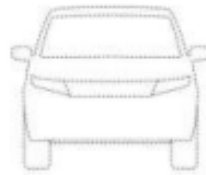
Rear View



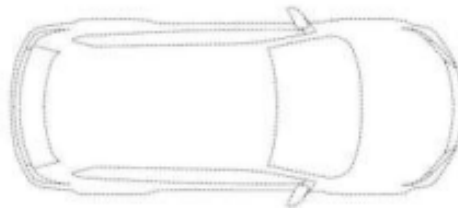
Left Side View



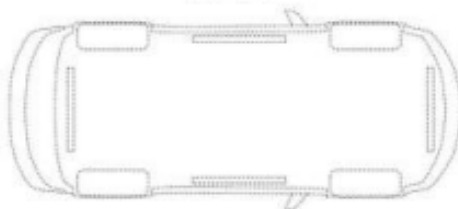
Right Side View



Top View



Bottom View



END