

Bill to Relax the Scope of the Design Law for Screen Design Protection



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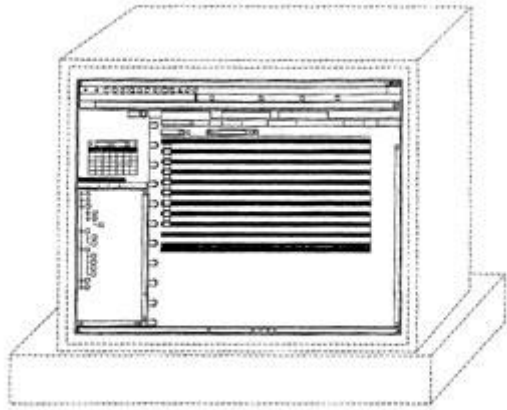
Field of Expertise: Design, Trademark, Litigation

Because of growing importance of product design as a tool for differentiating from other companies' products, in view of business strategy, there recently seems to be an increasing number of articles on product design in newspapers and the like. Heretofore, "product design" used to mean the "design of the physical outlook" of a product. However, with the recent development in use of IT, enterprises are tending to increase investment in development of operation screen data displayed on the screens of electronic machines and instruments by the product's built in software. Operation screen data which are not tied to any particular machine or instrument are also being created on a daily basis.

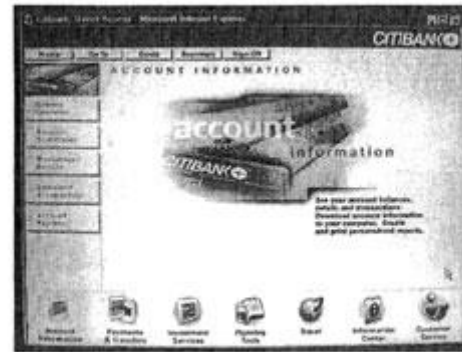
There are, for example, such "operation screen data" as listed below:(* 1

- (1) software application screen data installed or downloaded by a user as need arises to be displayed on the screen of a personal computer (PC);
- (2) website screen data to be displayed on a display screen of a personal computer by accessing the website;
- (3) an operation screen of a dedicated device (i.e., dashboard, DVD recorder, operation screen of POS terminal);
- (4) screen data to be displayed through a display function of a device having hybrid functionality (i.e., initial menu screen necessary for operation of cell-phones, recurring screens, etc.)

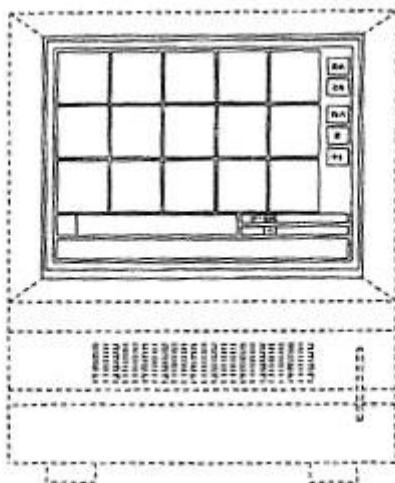
Example of (1)



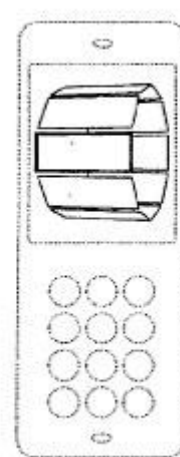
Example of (2)



Example of (3)



Example of (4)



Configuration without having integrity with an article does not qualify as an object of design registration

Can such screen designs as above be protected under the Design Law?

A "design" that can be protected under the Design Law is defined as: the shape, pattern or color or any combination thereof of an article (including parts of the article--hereinafter the same except in Article 8) which produces an aesthetic impression through the sense of sight (the Design Law Article 2(1)). In other words, "design" is the "configuration of" "an article". This implies that "the configuration is integral to the article". That is, unless the configuration is an integral part of the article, the design does not qualify as an object for design registration. As described further below, integrity with an article can also be

expressed as "the article property":

"Software application screen data to be installed on a personal computer (PC) by a user as need arises" in (1) above is not created as part of the design of the device, but is considered to be "a creation of the display content itself, separate from the article." So, as the data has not the article property, it cannot be an object of design registration.

"Website screen data to be displayed on a display screen of a personal computer by accessing the website" in (2) above, likewise, cannot be an object of design registration.

Meanwhile, "an operation screen of a dedicated device" in (3) above is essential for realizing the article's original function, and as the article and its configuration are indivisibly united, the screen satisfies the requirement for having the article property and can therefore be an object of design registration. Since the introduction of the partial design system by the amendment to the Design Law in 1998, there have been seen many examples of registration of display screens of such dedicated devices as "partial designs."

[Requirement 1] Figures and the like shown in a display portion of an article are indispensable in light of the completion of the article;

[Requirement 2] Figures and the like shown in a display portion of an article relate to the function (display function) of the article per se.

In the case of an article with complex functions therein such as a cell-phone, the guideline defines figures as "indispensable in light of the completion of the article," if they show diversified display functions, such that, "a display screen which lists display screen images (display screen per function) for performing respective functions is considered indispensable in light of the completion of the article". The guideline gives an initial menu screen displaying various functions of a cell-phone, as an example of a screen which meets requirement 1. This is because, unless the initial menu screen is displayed, not all of the functions of the cell-phone can be performed. So, an initial menu screen is recognized as an object of design registration since it meets the requirement for being a required part of the article.

Then, in (4) above, what about a screen following the initial menu screen such as, for example, a calendar screen which is shown when a calendar function of the cell-phone is selected?

In light of the guideline, such a screen cannot be regarded as "indispensable in light of the completion of the article", and is therefore cannot be considered for protection under the Design Law.

Limitation of the law and the move to widen protection

In this manner, due to the framework of the requirement for having the article property according to the Design Law, there are limited situations where a screen design displayed on a display screen of an article can be protected. However, in view of requests from the business community that screen designs should be protected more widely, discussions on how to improve the system have been vigorously conducted. As a result, the Design System Subcommittee of Intellectual Property Policy, at the Industrial Structure Council of the Ministry of Economy concluded in February, 2006, that the following designs should also be protected.

■ "In addition to an indispensable screen design in light of the completion of an article, a screen design to be displayed for realization of the usages and functions of an article" (for example, a calendar screen of a cell-phone, a mode-setting screen of a digital camera).

■ "Not only a screen design displayed in a display portion of an article, but also a screen design displayed on an exterior hybrid display device connected to the article" (for example, an operating screen displayed on a television by a DVD player).

*** Inside the parentheses are examples given by the writer**

As for software application screen data displayed on a hybrid display device as well as a website such as (1) above, it was concluded that such data is inappropriate as an object of a design right. (*3) From the viewpoint of legal stability and the like, regarding the necessity to specify effective scope, the inability to specify the extension of an article from its usages/functions is given as the reason.

Thus, in the present ordinary diet session (the 164th), upon hearing this conclusion, the following text was inserted in Article 2(2), after the definition of "a design" as provided in Article 2(1) quoted previously,:

"In the preceding paragraph, shape, pattern, color or any combination thereof, shall include pictures provided by an image display for the operation (limited to operations for keeping the article concerned in an operative condition for consummating its function) of the article and shall also include objects which display something on the article concerned or another object used as one body with the article concerned."

If this bill is passed, the number of screen designs which can be registered as designs will be more extensive than under the current law and we can expect higher protection for screen designs to be obtained, strengthening intellectual property strategy. Meanwhile, it will

become more important to include parties involved in design.

* 1: The illustrated images are: (1) US Design Patent No. 437,601; (2) US Design Patent No. 419,543; (3) Japanese Design Registration No. 1116493; (4) The case example shown in the text of the Patent Office guideline.

* 2: The guideline defines as Requirement 3, "In the case where figures and the like shown on a display portion of an article change, the behavior of the change should be specified." So, where there is no relevance between the aspects of a screen (an image) before and after the changes, the change cannot be filed as a design in motion (dynamic design).

* 3: As for a software application screen, there is a possibility of it being protected by Copyright Law even if it cannot be protected under Design Law. Among judicial precedents, there are cases where copyrightability was recognized, such as, the display screen of architecture software to integrate internal and external design (Case of Sekisan-kun, Osaka District Court precedent March 30, 2000), and all display screens of collaborated applications of a groupware product and the written works in relation to the collaboration (Case of Saibozu, Tokyo District Court precedent September 5, 2002). Some foreign countries (regions) such as the U. S. A. and European Community recognize design registration of such screens.