

15 The Protection of Screen Image Design

– A Comparative Study between Chinese and Japanese Laws – (*)

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New and unique image designs are worth protecting under intellectual property laws and other related laws. An image design may be also protected by the Copyright Law, Trademark Law or Unfair Competition Prevention Law in Japan, yet in practice protections under these laws are not so easy to acquire. Japan strengthened the protection on image design by having revised its Design Act in 2006 to extend the scope of industrial design including image design.

In China, an image design theoretically may also be subject to the protection of Copyright Law, Trademark Law or Anti-Unfair Competition Law, yet in practice these protections are of little significance. Chinese Patent Law may also protect an image design to some extent, but since there's no partial design concept, the right owners or applicants of image designs registered or applied as partial designs in foreign countries will meet some problems. These problems may be partly corrected by changing the way of submitting application documents, and not impede the grant of right, since the substantive examination is not required for design application. However, the status of the right obtained in such a manner is also unstable. More effective approaches should be considered for the needs of providing explicit rules in Chinese legal system, strengthening protection on image design, and meeting international trend of intellectual property system.

The purpose of this research is to investigate the feasibility of providing protection to screen image designs under the patent system in China, by conducting a comparative study between Chinese and Japanese legal systems concerning protection for such intellectual creations.

I Screen Image Designs and Current Status of Protection

The explanation of “screen image designs” addressed in the report has to start with the definition of “graphical user interfaces (GUI)” of electric information devices. A user interface is such a medium that the user exchanges information with a

device in use of an electric device, electric equipment, or software. The usability of a GUI is a key component of success in the market for software product and related products. The recent cycle of renewal or model changes of IT products has become extremely fast. Therefore, the creation of new screen image designs is a significant element affecting competitiveness of products.

Advanced IT nations and regions including the U.S., European Union, Australia, Japan, and South Korea have established respective systems to protect screen image designs. Whereas in most of these countries, screen image designs shall be applied to products, the EU, whose definition of “product” includes “graphic symbols,”

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registers and protects GUIs and screen images to be regarded as product designs.^{(*)1} On the contrary, Japan, when its Design Act was amended in 2006, not only has maintained its decision that screen image designs to be protected shall be applied to tangible articles, but also limits to designs which serve operations to “make a product in a condition to perform its function” as the protectable subject matter, as a result of deliberately considering a balance of interests for all the parties concerned. The Japan Patent Office revised its Design Examination Guidelines in 2007 so that some designs such as webpage designs and image designs on computer screen that may be registered in other countries are excluded from the protectable subject matters under the revised Design Act.^{(*)2}

Since the subject of this research is to compare between Japan and China with regard to the system to protect screen image designs, the author sets, from the perspective of the Japanese Design Law, the scope of “screen image design” in the research as such new image designs that are displayed on liquid crystal displays of electric products when switched on so that the user operates the products to perform its functions.

II Protection of Screen Image Designs in Japan

Comparing with the other types of intellectual creations, a product design has more aspects in the characteristics, so that more comprehensive protection is necessary for product designs. Under the current Japanese legal system, screen image designs are protected under the Design Law and, if

the prescribed requirements are fulfilled, may be also protected under the Copyright Law, Trademark Law, or the Unfair Competition Prevention Law.

1 Protection under the Copyright Law

Theoretically, a design that satisfies the condition of originality may be protected under the Copyright Law. In the Japanese Copyright Law, the definition of “works” covers “artistic works.” Any design in which original and aesthetic thoughts or sentiments are expressed may be deemed an artistic work and therefore protected under the Copyright Law. In addition, provisions for compilations under the Copyright Law may cover designs. The advantage of copyright protection is that the protection is provided automatically for a long period of time without a registration procedure.

In practice, however, designs are less likely protected under the Copyright Law. Since industrial designs are different from works in terms of the necessity for protection, it remains uncertain whether screen image designs may be protected under the Japanese Copyright Law. Theoretically, copyright protection may be provided to an interface or image that fulfills the condition of originality specified in the Copyright Law. In recent years, there are some cases that indicated that software interfaces may be copyrightable as “compilations.”^{(*)3} Nevertheless, the issue of screen image designs is comparatively complex in reality. Since most of them consists of generic, finite, and less alternative expressions, they are not considered protectable under the Copyright Law. It should also be noted that the Copyright Law does not prohibit third

(*)1 “Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs”, Article 1: “...a. 'design' means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation; b. 'product' means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs; ...”.

(*)2 See II 4 of the report.

(*)3 Nobuhiro Nakayama, *Chosakukenhou* (Copyright Law), (Yuhikaku, 2007), p.106, e.g., the judgment of the Osaka District Court on March 30, 2000 in the “*Sekisan-kun Case*”, 1998(Wa)No.13577; the judgment of the Tokyo District Court on June 30, 2004 in the “*ProLesWeb Case*”, 2003(Wa)No.15478, the judgment of the Tokyo District Court on September 5, 2002 in the “*Cybozu Case*”, 2001(Wa)No.16440.

parties from conducting reverse engineering.

2 Protection under the Unfair Competition Prevention Law

The Unfair Competition Prevention Law, which can effectively prohibit free-riding, plays an important role in the fields where it may be difficult to apply intellectual property laws. Under the Japanese Unfair Competition Prevention Law, an act of unfair competition is stipulated to be using “an indication of goods” similar to the one used by a well-known product or imitating another person’s “configuration of goods.” If a screen image design of a product is considered to be a well-known mark, the design may be protected under the Law. If a screen image design is considered to form a part of the “configuration of goods,” the Law may protect the design for a period of three years from the first sale of the product in the Japanese market by prohibiting any third party from making a complete imitation of the design.^(*4)

There are some cases where the courts indicated whether a screen image might be regarded as a “configuration of goods” or an “indication of goods” to show the origin of the product.^(*5) For example, in the abovementioned *Cybozu* case, whereas the plaintiff sought protection under the Unfair Competition Prevention Law, the court did not find the disputed screen image design to be an “indication of goods” of the software product.^(*6) Furthermore, it should be noted in practice that protection may be unlikely provided to a screen image displayed for the purpose of operation as a “configuration of goods”, because such an image may be considered to be a “common configurations”

of goods from the perspective of standardization.^(*7) In most cases, a screen image design is especially considered to constitute only an element of the “configuration of goods.” Since injunctive remedies under the Unfair Competition Prevention Law is limited to only the act of selling a product that is a complete imitation of the entire configuration of another person’s goods, the effect of protection provided under the Law is limited.

3 Protection under the Trademark Law

The definition of design under the Design Law is highly similar to the definition of “trademark” under the Trademark Law.^(*8) Theoretically, any design that is considered to be distinctive and ingenious may be protected as a trademark. Trademark protection may be provided to a screen image design only if it is used in connection with goods.^(*9) Even a screen image that is regarded as a trademark containing a generic term which is clearly defined by the Japanese Trademark Law as an unregistrable trademark may be registered as a trademark if the image has become distinctive as a result of use over a certain period of time.^(*10) A major advantage of trademark protection is that it gives the design owner an effective injunctive relief for a third party’s imitation and an option to extend the protection period.

In reality, however, the screen image design of a product is rarely used as a trademark and relevant examples are hard to find, because it is more suitable for designers’ needs to register screen image designs under the Design Law. With regard to unregistered designs, it is more likely to

(*4) Article 19 (Exclusion from application, etc.)(1)(v)(a) of the Unfair Competition Prevention Act specifies that a request for such protection of goods against an act of unfair competition might be dismissed if “three years have elapsed from the date they were first sold in Japan.”

(*5) Institute of Intellectual Property, “Hyoji gamenjo ni hyoji sareta gazou dezain ni kansuru hogo ni tsuiteno chosa kenkyu houkokusho” (Study on the protection of image designs displayed on screens), p.103. (March 2002).

(*6) The judgment of the Tokyo District Court in the “*Cybozu* case”, available at <http://www.courts.go.jp/hanrei/pdf/024A64E6B03E207649256C7F0023A164.pdf> (as of January 2008).

(*7) Saburo Moriwaki: “Study on Protection of Image designs Indicated on the Display Screen,” p.14, IIP Bulletin, 2002.

(*8) Article 2, para.1 of the Trademark Act.

(*9) Article 3, para.1 of the Trademark Act.

(*10) Article 3, para.2 of the Trademark Act.

seek protection under the Unfair Competition Prevention Law.

4 Protection under the Design Law

(1) Legislative Background of the Revised Design Act

In this information age, protection of screen image designs has become increasingly important and it was finally reflected to the Japanese Design Act. On March 31, 1993, the Japan Patent Office published the “Guidelines on Treatment of Delineation of Liquid Crystal Displays, etc.”, permitting the filing of a application for registration of an image displayed on a liquid crystal display as long as it satisfies the prescribed requirements.^(*11) In February 2002, the Japan Patent Office published the “Guidelines on Treatment of Delineation of Liquid Crystal Displays, etc. (partial designs applicable version)”,^(*12) specifying that the provisions and requirements concerning the filing of an application for registration of a partial design should be applied to image designs displayed on liquid crystal screens. In January 2004, the Japan Patent Office published the “Guidelines for the Preparation of Design Applications and Drawings”, explaining in detail how to file an application for a “screen image design.” In the revised Design Act in 2006, the provision with respect to screen image designs was added to the definition of “design”^(*13) Subsequently, the Japan Patent Office published the revised “Design Examination Guidelines” in 2007, describing in detail how to apply respective provisions

of the revised Design Act in the design examination procedure. At this stage, legal system was nearly completed in Japan to provide protection of screen image designs.

The Design Examination Guidelines published in 2007 specify the criteria for registration of a “screen image design.” For instance, a screen image design shall apply only to an article and is indispensable for the performance of the functions.^(*14) On the other hand, it explicitly specifies that images displayed in a computer interface, an interface displayed through the Internet, or images displayed in an electronic game device are not registerable.^(*15) Design protection for screen image designs is limited in this way in order to implement the law in a stable manner and to maintain an appropriate balance between the promotion of technology development and the protection of industrial property rights including design. Under the current Design Law, a screen image design is protected only to the extent that the design is an integral part of product.^(*16)

(2) Current Status of Protection under the Design Law

The Design Examination Guidelines in 2007 set four requirements for registerability of a screen image design.^(*17)

- (a) The article to which a design containing graphic image is applied must be admissible as an article under the Design Act.^(*18)
- (b) A graphic image must be provided for use in the operation of the article. However, no registration may be made

(*11) Design Committee: “Study on Protection of ‘The Displayed Images’ under Japanese Design Law,” pp.26-34, Journal of JIPA, Vol.3, No.1, May 2003.

(*12) Japan Patent Office, “Guidelines on Treatment of Delineation of Liquid Crystal Displays, etc.” (applicable to partial designs), February 2002.

(*13) Article 2, para.2 of the Design Act, “The shape, patterns or colors, or any combination thereof, of a part of an article as used in the preceding paragraph shall include those in a graphic image on a screen that is provided for use in the operation of the article (limited to the operations carried out in order to enable the article to perform its functions) and is displayed on the article itself or another article that is used with the article in an integrated manner.”

(*14) Japan Patent Office, “Design Examination Guidelines” (reflecting the revised Design Act in 2006), 74.1 (2007)

(*15) Japan Patent Office, “Design Examination Guidelines” (reflecting the revised Design Act in 2006), 74.4.1.1(2) (2007).

(*16) Intellectual Property Policy Committee of Industrial Structure Council, “*Ishoseido no arikatani tsuite*” (Recommendation for Revision of the Design System), Part 3, Chapter I, 3 (2): Screen designs not subject to protection (February 2006); available at http://www.jpo.go.jp/iken/pdf/iken_ishou_kekka/shiryou02.pdf (as of January 2008)

(*17) Japan Patent Office, “Design Examination Guidelines” (reflecting the revised Design Act in 2006), 74.1 (2007)

(*18) Japan Patent Office, “Design Examination Guidelines” (reflecting the revised Design Act in 2006), 21.1.1.1 (2007).

for an interface displayed when software installed in an article is activated.

- (c) A graphic image must be used to put the article into a state to be enabled to perform its functions. The phrase “a state” means that a condition in which the article is in readiness to perform its function, and does not include a condition in which the article is actually working according to its functions. Screen image design under “the condition in which the article is actually working” such as a computer interface or a webpage design may not be registerable.
- (d) A graphic image must be displayed on the article itself or another article that is used with the article in an integral manner. In most cases, the images representing the respective functions of an article are displayed on the screen attached to the article. In the case of an article that has no screen and is used in combination with an external display device, the screen image design is registerable as the one displayed on the screen of the external display device.

The Japan Patent Office has established rules for formalities of application for design registration. For example, partial designs shall be indicated by solid lines and broken lines. It must be noted that it is not accepted to file an application solely for registration of a screen image so that the applicant is required to designate “the article to the design”. In the case of an image that changes on the screen, the relevance must be recognized in forms before and after the change. Without relevance, the application for design registration would be rejected after the formality examination.^(*19)

In order to be protected under the Design Law, a screen image design must fulfill the general substantive requirements for being recognized as a design. For example, a screen image design must be

practical (industrial applicability), novel, creative (difficulty in creation), different from any designs claimed in prior applications, and must not fall under an explicit provision specifying subject matters that are not subject to design registration.

III Protection of Screen Image Designs in China

In China, development of industrial designs was started up relatively recently. The Chinese intellectual property community has long been discussing how to protect interfaces displayed on screens.

1 Protection under the Copyright Law

Neither the Chinese Copyright Law nor its Enforcement Rules have any provision specifying protection of interfaces displayed by software. Theoretically, screen image designs are protected as “artistic works.” However, a screen image is often designed without sufficient freedom of creation. As a result, a screen image design tends to be regarded as “only possible expression” or “limited expression” and consequently categorized as an “idea” or “thought,” which are not subject to copyright protection. The Computer Software Protection Regulations do not have a provision concerning protection of screen image designs either. A judge who happened to preside over a dispute over a screen image design would have to make a judgment based on his or her own interpretation of the Copyright Law and related laws. The following two recent cases in China concerning this issue are worthy of attention.

As the first case, a Beijing-based company, Jiuqi Software Co. Ltd., filed a lawsuit for copyright infringement against a Shanghai-based company, Tianchen Software Co. Ltd. The plaintiff was the copyright owner of a product called Jiuqi Software.

(*19) Design Examination Guidelines Office, Design Division, Trademark, Design and Administrative Affairs Department, Japan Patent Office: Guidelines on the Preparation of Design Applications and Drawings”, Chapter X: Guidelines on Treatment of Delineation of Liquid Crystal Displays, etc. (partial designs applicable version) p.117, available at http://www.jpo.go.jp/shiryoku/kijun/kijun2/pdf/zumen_guideline/paper10.pdf (as of January 2008).

The defendant developed and launched a product called “Tianchen Software,” which had similar functions as the Jiuqi Software had. The plaintiff asserted that the defendant had infringed the GUI of the Jiuqi Software. The point of dispute in this case was whether a GUI was copyrightable or not under the Copyright Law. The High People's Court of Shanghai after the trial, subsequently to the Intermediate People's Court, rendered the final decision stating that the GUI was not copyrightable because the components of the GUI menu commands of the Jiuqi Software such as command names, buttons, dialogue boxes, windows, scroll bars, and icons used to display certain charts were commonly used in other user interfaces and therefore not creative.^(*20)

In the second case, it was disputed whether a computer router interface was copyrightable or not. The judgment in the first instance stated that, since both parties' router products had almost the same GUI, the defendant's act constituted an infringement of the plaintiff's copyright. However, the court of second instance judged that the dialogue boxes, windows, and other components of the user interface designs displayed in the both parties' products were meant for general purposes and that the selection, arrangement, and layout of the components failed to satisfy the requirements for creativity of work specified in the Copyright Law.^(*21)

In the above two cases, the courts analyzed from the viewpoint of compilations. While the required level of originality is lower in the case of compilations in comparison with fine art works, it is extremely difficult in China, however, to provide copyright protection to screen image designs as compilations.

2 Protection under the Trademark Law and the Anti-Unfair Competition Law

In China, it is uncertain whether the Trademark Law protects screen image designs, since they are likely to be deemed general purpose expressions or functional expressions and therefore may not be registerable as trademarks. It should be also noted that the Chinese Trademark Office and the Trademark Review and Adjudication Board usually do not approve a mark that includes a complicated graphic or structure because such a mark is too complicated to distinguish and lacks distinctiveness.^(*22)

Acts of unfair competition as stipulated in the Chinese Anti-Unfair Competition Law include “without authorization, to use the specific name, package, decoration of the famous or noted commodities, or use a similar name, package, decoration of the famous or noted commodities, which may confuse consumers distinguishing the commodities to the famous or noted commodities.” According to this stipulation, screen image designs of goods may be deemed to fall under the category of “specific package or decoration of the famous commodities” and they may be protected only when they cause relevant public perceptible confusion.

On December 30, 2006, the Supreme Court of the People's Republic of China defined “the specific package and decoration of commodities” in its “interpretation of laws.”^(*23) Based on this interpretation, product design is deemed to be “specific package or decoration of commodities” only when it is very highly creative. It is stipulated that a plaintiff has the burden of proof that the goods are “famous or noted” and that there is “confusion.” As we can see from the above, and as expected, screen image designs have little possibility of being

(*20) Judgment of the Second Intermediate People's Court of Shanghai: (2004)Hu-Er-Zhong-Min-Wu(Zhi)Chu-Zi No.100; Judgment of the People's High Court of Shanghai: (2005)Hu-Gao-Min-San(Zhi)Zhong-Zi No.38.

(*21) Judgment of the People's High Court of Guangdong Province: (2005) Yue-Gao- Fa-Min-San-Zhong-Zi No.92.

(*22) Chinese Trademark Office and Trademark Review and Adjudication Board, “Guideline for Patent Examination” (December 2005), Part 2, Section 5.

(*23) “Interpretation of the Supreme People's Court on Some Issues Concerning the Application of Law in the Trial of Civil Cases Involving Unfair Competition” Article 2.(2007).

protected under the Anti-Unfair Competition Law.

3 Protection under the Patent Law

The Rules for The Implementation of The Chinese Patent Law define “Design” as “any new design of the shape, the pattern or their combination, or the combination of the color with shape or pattern, of a product, which creates an aesthetic feeling and is fit for industrial application.”(Rule 2)

In practice, new designs related to a part of the appearance of a product are included in the registered designs.

It is not found also in the Chinese patent system whether screen image designs fall under the category of product design. In practice, the Guidelines for Patent Examination (2006) published by the Chinese State Intellectual Property Office (SIPO) provide that “a graphic displayed after turning the product on” shall be no subject matter of design patents,^(*24) which may cause misunderstanding. However, more and more applications for design registration relating to products including liquid crystal display design have been filed to SIPO. Design applications are not subject to substantive examination; therefore, the right is usually granted only by filing. However, since there is no partial design system and no related rules for implementation, screen image designs are protected in China as a part constituting the entire product’s design.

Design application is prosecuted in accordance with stipulations related to the Chinese Patent Law, the Rules for The Implementation of The Patent Law, and the Guideline for Patent Examination. Since the scope of protection of patent rights for design is based on drawings or photographs submitted at the time of filing, it is important for the protection of rights to determine how to create drawings or to

present new and creative points of relevant design.

IV Comparison and Evaluation of Legislative Protection Systems for Screen Image Design in China and Japan

The differences in protection of screen image design by intellectual property laws and relevant laws in China and Japan are as follows.

1 Protection under the Copyright Laws

A theory stating that design is also under protection of copyright laws is relatively well-known in China and Japan. Also under judicial systems in both countries, design is regarded as a copyrightable work under the Copyright Laws only if it has sufficient creativity. However, in practice, cases in both countries show that protection of software interfaces or screen image designs is not as facilitated as one could imagine, because these screen image designs are likely to be recognized as lacking sufficient creativity. Moreover, it is unfavorable to a right holder of a new design that the protection under the Copyright Laws is not applied to “idea” and reverse engineering are not usually regarded as infringement of a copyright (whether it violates a contract between a user and a right holder is another argument).

How to protect screen image designs effectively under the Copyright Law was not a pressing issue in Japan when the Design Act was amended in 2006. In China, in order to provide effective protection for screen image designs under the Copyright Law, it only has to lower the requirements for creativity in the implementations of the Copyright Law. First, this would increase the possibility of protection under the Copyright Law by regarding screen image

(*24)SIPO, Guidelines for Patent Examination, Part 1, Chapter III, 6.4.3 (11), Ordinance of State Intellectual Property Office of P.R.C., No.38, issuance: May 24, 2006; enforcement: July 1, 2006.

designs as works of fine art, and second, they could refer to court precedents^(*25) with regard to the protection of website designs as compilations. In practice, however, it is difficult for screen image designs to fulfill the requirements for creativity of compilations. Scholars and legislative institutions should explore countermeasures outside the scope of copyrights.

2 Protection under the Unfair Competition Protection Laws and the Trademark Laws

In Japan, in cases where a screen image design is illegally faked or imitated, if the requirements for the “indication of well-known goods” or “configuration of goods” are fulfilled, it may fall under the protection of the Unfair Competition Protection Law. In practice, it is not easy to satisfy these requirements. In addition, it is a more normal and effective option for designers to file applications for design registrations under the Design Law. Therefore, there seems to be no case to date, where a screen image design is protected by application of the Unfair Competition Protection Law.

In China, no stipulation related to screen image design is in the Anti-Unfair Competition Law at all. Provisions cited as grounds for court judgments are normally only “general clauses.”^(*26) Under the current situation, unregistered screen image designs which are not copyrightable may not be protected under the Anti-Unfair Competition Law, if they are not recognized as “package or decoration of famous or noted commodities.”

While screen image design may be protected in theory under the Trademark Laws, in practice, both in China and Japan, there seems to be no relevant case where a designer claimed for protection under the Trademark Laws. The main cause of this

situation is assumed to be that no screen image design is registered as trademark or there is no actual use of screen image design as trademark. Japanese rights holders of screen image designs usually demands protection under the Design Law, the Copyright Law, and the Unfair Competition Prevention Law. In China, more observation is necessary to see how the Trademark Law functions because the industrial design industry has just started to grow.

3 Protection under the Design Laws

(1) Evaluation of the protection of screen image designs under the Japanese design system

As discussed above, whereas screen image designs are not sufficiently protected under the Copyright Laws, the Unfair Competition Prevention Laws, and the Trademark Laws, in Japan, the Design Act revised in 2006 defined the concept of screen image designs in the definitions of “industrial design” (Article 2, paragraph (2)). Later, the Japan Patent Office stipulated in detail with regard to the application and examination for registration of design including screen image design, in the new “Design Examination Guidelines” in 2007. The author believes the following points regarding the current Japanese design protection system are worthy of note:

(i) While the Japanese Design Law strengthened the protection of screen image designs, it required designation of the “article to the design”, under which they fall and strictly limited the scope of protection of screen image designs to “where the article is put into a state in which the article is enabled to perform its functions” after deliberate consideration.

(ii) The author agrees that the Japanese design system limits the protection for screen image designs to the initial menu after turning the product on and the screen

(*25) The Second Intermediate People’s Court of Beijing: “Legal issues on the case of copyright infringement between Xiamen Xinda Business Information Co.Ltd ” in 《Shenpan qianyan》, December 2004.

(*26) Chinese “Anti-Unfair Competition Law” Article 2: “In the market transactions, a business manager shall follow principles of autonomy, equality, fairness, and faith and trust, and follow business ethics as recognized in public.”

images displayed afterwards and having relevance in forms before and after the change.

(iii) Since the ratio of partial designs in the all design applications and registrations has been increasing,^(*27) it is necessary to examine the application of laws to screen image designs together with the current situation of protection of partial designs. The Japanese Design Act revised in 2006 stipulates that the similarity between the registered design and another design shall be determined based upon the aesthetics impression the aesthetics impression that the designs would create through the eye of their consumers.^(*28) The Design Examination Guidelines published by the Japan Patent Office in 2007 provides a detailed interpretation of how this principle applies to and is used for examination. However, the judgment of similarity between partial designs remains unclear. Recent theories and judicial precedents in Japan tend to use the comprehensive criteria of a “compromise between creation and confusion as well as recognition of the main part.”^(*29)

(iv) It should be noted that the current “Japanese Classification for Industrial Designs” released by the Japan Patent Office on April 1, 2007 is added with a new classification “W” for image design.^(*30) The author recognized that the assignment of the classification had reflected novelty and creativity of screen image design of posterior applications in practice and acquired the function of protection by the classification of “image design” as matter of fact.

(2) Evaluation of the protection of screen image designs under the Chinese patent system

(i) Since it is not possible to file an application for registration of screen image design as a partial design in China, the following issues may arise:

(a) Inconvenience for applicants. Since the relevant public cannot intuitively recognize novel parts of the design, it may have an adverse effect on judicial efficiency. Moreover, the legal position of a “reference drawing of variable usage condition” is not clear so there may be difficulties with the execution of laws.

(b) In China, a design application is not subject to substantive examinations so that the claim of international priority right is usually admitted and a design patent may be granted, even if the documents of the earlier application and the later application are not identical. However, such a design patent may be declared as valid due to lack of novelty resulting from denial of the priority right during the course of invalidation trial or infringement litigation. In the Guidelines for Patent Examination of 2006, it was amended favorably to convention priority right holders^(*31); however, more observation is needed to determine the practical effects of this provision.

(c) Taking Japan as an example, it is stipulated that design applications have a six month period for claiming the international priority right. Under the provisions of the Design Examination Guidelines, in cases where there is a

(*27) Recently, the number of partial design applications accounted for approximately a quarter of the total number of design applications in Japan. See Japan Patent Office, *Wagakuni ni okeru shutsugan to shinsa/shinpan no doko* [Trend of application and examination in Japan], (2002-2006), p.12 (Statics of partial design application). Available at the Japan Patent Office website <http://www.jpo.go.jp/shiryoutoushin/nenji/nenpou2007/honpen/1-1.pdf> (as of January 2008).

(*28) Article 24, paragraph (2) of Japanese Design Act (newly added in 2006): “Whether a registered design is identical with or similar to another design shall be determined based upon the aesthetics impression that the designs would create through the eye of their consumers.”

(*29) Hiromichi Aoki, *Chiteki zaisan toshitenno brand to design* [Brand and design as intellectual property rights] (2007), p.283 to 299; Shuichi Itakura, “*Shingai soshō ni okeru bubun isho no ruihi handan*” [Judgment of similarity of partial design in infringement lawsuit], *Chizai kanri* [Intellectual Management], Vol.57, No.6, p.941.

(*30) Design Division, Trademark, Design and Administrative Affairs Department, Japan Patent Office, “*Nihon isho bunrui ni tsuite*” [Regarding the Japanese Classification for Industrial Design (Enforcement on April 1, 2007)], available at Japan Patent Office website <http://www.jpo.go.jp/shiryoutoushin/sonota/pdf/bunrui/190401.pdf> (as of January 2008).

(*31) SIPO, Guidelines for Patent Examination, Part 4, Chapter V, 7.2.

difference between an application filed in Japan and the earlier application filed in a foreign country, the Japan Patent Office may not admit the priority claim.^(*32) It is obviously a disadvantage for an applicant who filed an earlier application for a design patent (as a whole) in China, and later file an application for partial design in Japan.

(ii) In practice, since no substantive examination is made for a design patent application in China, a design patent for design of entire product including a screen image design (which is not a part of relevant screen image^(*33)) may be granted. However, due to the provision in the Chinese Guideline for Patent Examination that stipulates “graphics displayed after turning the product on” “is not a subject matter of design patent,” screen image designs may be such disadvantaged that it is not practically protected under the current Chinese patent system. If this provision is deleted, it will strengthen actual protection of designs including screen image designs.

(3) The necessity and possibility of protecting screen image designs by introducing a partial design system to China

It is the author’s understanding that the need to enact a partial design system has not yet received much recognition in China, and therefore, there was no consideration for partial design system in the draft of the third amendment of the Patent Law.

Despite the current situation, it seems to be essential to introduce partial design system in the Patent Law. First, it should be clarified that a partial design may be protected under the law like a whole design. This will not drastically increase the number of design applications nor cause deterioration in the quality. Second, implementation of partial design system will satisfy the needs of applicants who apply a

new design to a part of the appearance of a product, and will facilitate to determine the scope of design protection quickly and correctly. Moreover, the partial design system will help applicants and patentees claiming international priority rights to enforce their rights under the laws domestically and abroad. Ultimately, the adoption of partial design system facilitates international harmonization of intellectual property systems.

Industrial nations tend to protect screen image design under industrial property rights. If China does not consider taking appropriate measures, it may become passive with regard to the international protection of intellectual property rights. China should promote legislative protection of screen image designs step by step, naturally considering its current domestic development stage.

When putting the system in place: first, include the relevant provisions in the Guidelines for Patent Examination, such as specifying a novel creative part by using solid lines and broken lines in the application for partial design of the appearance of a product; second, exclude the provision that “graphics displayed after turning the product on” is not a patentable subject matter under the Patent Law from the Guidelines for Patent Examination; third, add the concept of “partial design” to the definition of “design” when amending the Patent Law, or add such an interpretation that partial design is also included in “design” in a relevant provision of the Rules for The Implementation of The Patent Law; and finally, even if screen image design is included in the definition of “design”, the scope of protection should be limited to screen image designs that are linked to the operational functions of a tangible “product”, if necessary.

(*32) Japan Patent Office, *Isho shinsa kijun* [Design Examination Guidelines] (corresponding to amendment of the Design Act in 2006), 71.13 (1).

(*33) If the subject matter of application is a display image design itself, it does not pass the initial step of examination, Guidelines for Patent Examination, Part 1, Chapter III, 6.4.3 (11), Ordinance of SIPO, No.38, issuance: May 24, 2006; enforcement: July 1, 2006.

V Conclusion

Theoretically, the many intellectual property rights and their relevant legal systems, both in China and Japan, are supposed to provide multiple protections for screen image design. In practice, however, protections under the Copyright Laws, the Unfair Competition Protection Laws, the Trademark Laws, and others are not as extensive as one would expect.

It is appropriate and necessary to protect screen image design under industrial property laws. The protection system of screen image designs in Japan under the Design Law, which has been developed since the 1990's to date, is relatively rational, takes domestic and international factors into consideration comprehensively, and maintains the balance of the interests and demands in every field. In this regard, it is significant to study the Japanese systems and investigate points to be considered for designing relevant systems in China.

The current Chinese patent system may practically protect screen image designs to a certain extent, however, some problems may arise during implementation. The easiest and shortest way to eliminate unfavorable factors for the protection of display image designs under the current Chinese patent system is to amend the relevant provisions of the Guidelines for Patent Examination. From a long term viewpoint, clarifying the concept of partial design in the Patent Law, and adding measures for implementation that correspond to the legal provisions pertaining thereto, it is possible to improve substantial protective function for screen image designs. With time, the concept of screen image design may be included in the definition of "industrial design" in China. In that case, the scope of protection and the applicable conditions should be clarified in the relevant laws and implementation regulations.