

Chapter I Design Including a Graphic Image

1. Outline

Previously, only articles were protected under the Design Act. In corresponding to the 2019 revision of the Design Act, graphic images became newly found as designs, and actual graphic images separated from articles also became protected under the Design Act.

Before the enforcement of this revision of the Design Act, under the 2006 revision of the Design Act, graphic images were conventionally protected as a design including a graphic image as a part of an article, such as making graphic images provided for use in the operation of an article subject to protection as a design for a part of an article.

Accordingly, since the 2019 revision of the Design Act, there are mainly two ways, as follows, for an applicant for design registration to obtain design registration for a design including a graphic image.

- (1) Method for obtaining protection as a graphic image design (graphic image itself separated from an article)

(Hereinafter such a design is referred to as a “**graphic image design**.”)

- (2) Method for obtaining protection as a design including a graphic image as a part of an article or building

(Hereinafter such a design is referred to as a “**design including a graphic image on a part of an article etc.**”)

(Hereinafter (1) and (2) above are collectively referred to as a “design including a graphic image.” Furthermore, since this Chapter contains statements about both (1) and (2) above, for the sake of readability, etc., they are indicated using shading and borders, respectively.)

(1) above is unconcerned with what the graphic image is displayed on, and (2) above protects a graphic image created in an integrated manner with an article or building.

In addition to general examination standards, for graphic images in (1) and (2) above, this Chapter summarizes the points to bear in mind when examining a design including a graphic image.

2. Basic concept in examining a design including a graphic image

When examining a design including a graphic image, basically, the examiner should conduct the examination in accordance with the examination standards for each of the requirements for registration as described in Parts II and III.

On the other hand, when examining a design including a graphic image, there are also many separate points that must be kept in mind with respect to **graphic image designs** and **designs including a graphic image on a part of an article etc.**

For this reason, in addition to the basic matters on examining a design including a graphic image, this Chapter focuses on matters that are applicable only when examining a design including a graphic image.

For other matters not described in this Chapter, see the relevant parts of the examination standards describing general designs.

In examining a design including a graphic image, the examiner should first identify whether the design for which the design registration is requested is a **graphic image design** or a **design including a graphic image on a part of an article etc.**

This is because, depending on which of these it is, the requirements etc. for categorization as a design under the Design Act are different.

3. Graphic images subject to protection under the Design Act

3.1 **Graphic image designs**

A **graphic image design** refers to a design in which the graphic image itself is the object of protection under the Design Act, without specifying the article or building on which the graphic image is displayed.

Since the Design Act uses the granting of a powerful exclusive right, that is, a design right, as incentive to encourage development investment, it would be inappropriate to treat all kinds of graphic images as designs under the Design Act. For this reason, the definition in Article 2 of the Design Act limits graphic images subject to protection under the Design Act to those provided for use in the operation of the device or displayed as a result of the device performing its function.

Therefore, in accordance with the purpose of these provisions, the examiner should determine that a graphic image is a design under the Design Act only where it falls under (1) and/or (2) below.

- (1) A graphic image provided for use in the operation of the device (hereinafter referred to as a “graphic image for operation”)
- (2) A graphic image displayed as a result of the device performing its function (hereinafter referred to as a “graphic image for display”)

<Examples of graphic images falling under a graphic image for operation>



Graphic image for purchasing products
(Graphic image of a web)



Graphic image for an icon
(Clicking operation button launches software)

<Examples of graphic images falling under a graphic image for display>



Graphic image displaying medical measurement results



Graphic image displaying time (graphic image projected onto a wall)

Regarding graphic images that fall under neither (1) nor (2) above, for example, the content of a movie or game, the examiner should not determine that such a graphic image is a design under the Design Act.

Furthermore, for the subject matter of an application for **graphic image design** to constitute a **graphic image design** under the Design Act, it must be creatively cohesive as a single design, and it must fall under either a “graphic image for operation” or a “graphic image for display.”

Therefore, as in the example below for instance, where a filed design does not fall under either a “graphic image for operation” or a “graphic image for display”—like in cases where the application for design registration is only for part of an icon (excluding cases where the application is filed as an icon design, and design registration is requested for a part of it)—the examiner should determine that it does not fall under a design under the Design Act.

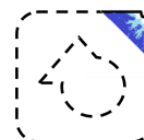
<Example of a design not constituting a graphic image design under the Design Act>



[Article to the Design] Graphic image used in the corner of an icon

[Description of Article to the Design] The design is of a graphic image in the top right corner of an icon and is modelled on Mt Fuji.

* Complies with this requirement if the application is filed as an “icon graphic image” design in which design registration is requested for the corner part



3.2 Designs including a graphic image on a part of an article etc.

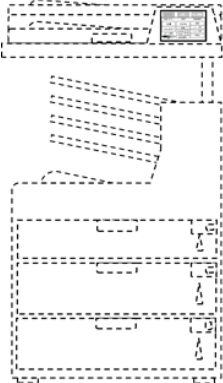
3.2.1 Designs including a graphic image as a part of an article

Graphic images that constitute a **design including a graphic image as a part of an article** are those that are recorded on the article and shown on the display part of the article, and which fall under (1) and/or (2) below.

- (1) A graphic image that is provided for use in the operation of the article in order to enable the article that displays the graphic image to perform its function (hereinafter referred to as a “graphic image for operation for performing the functions of an article”)
- (2) A graphic image for making necessary indications for performing the functions of the article that displays the graphic image (hereinafter referred to as a “graphic image for display necessary for the functions of an article”)

<Examples categorized as a graphic image for operation for performing the functions of an article>

[Front view]

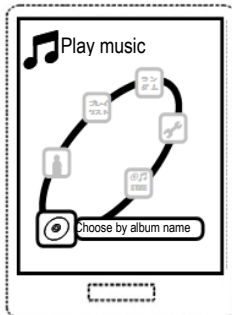


[Partial enlarged view of the display part]

Basic settings	Useful functions	Number of copies
Monochrome/Color	Magnification	Paper selection
Monochrome	100%	Automatic
Full color	Automatic	Tray 1 A4
Copy density	41% A4→A3 70% B5→B4	Tray 2 A3
	70% A3→A4 B4→B5	Manual feed
	Other magnification	

[Article to the Design] Copying machine
[Description of Article to the Design] The graphic images represented in the front view and the partial enlarged view of the display part are for carrying out various settings for the copying.
[Description of the Design] The part represented by the solid line is the part for which the design registration is requested.

[Front view]

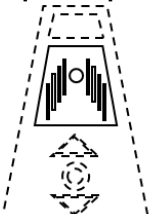


[Article to the Design] Computer with a music playback function
[Description of Article to the Design] The graphic image represented in the front view is for choosing the music selection method.
[Description of the Design] The part represented by the solid line is the part for which the design registration is requested.

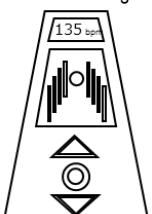
* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

<Examples of graphic images for display necessary for the functions of an article>

[Front view]

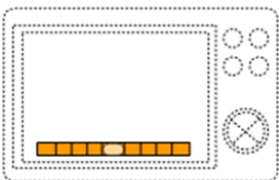


[Reference front view indicating the state of use]



[Article to the Design] Electronic metronome
[Description of Article to the Design] This is an electronic metronome that performs the function of a metronome using a graphic image shown on the display part at the top of the front view. The set tempo is displayed in the upper display window. The tempo and display can be changed using the lower buttons.
[Description of the Design] The part represented by the solid line is the part for which the design registration is requested

[Front view]



[Article to the Design] Digital camera
[Description of Article to the Design] This 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 videos.

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

Regarding graphic images that fall under neither (1) nor (2) above, for example, the content of a movie or game, the examiner should not determine that such a graphic image constitutes a design including a graphic image as a part of an article.

3.2.2 Designs including a graphic image as a part of a building

Prior to the 2019 revision of the Design Act, buildings were not subject to protection under the Design Act. Consequently, designs including a graphic image as a part of a building were not protected under the Design Act. Under the Design

5.3 Exceptions to the “one application per design” in designs including a graphic image

Although filing an application for each design is the general rule under the Design Act, even in cases where it is not found that an application has been filed for each design after making a determination based on sections 5.1 or 5.2, if it complies with the requirements for (1) a design for a set of articles (see Part IV, Chapter III “Design for a Set of Articles”) or (2) an interior design (see Part IV, Chapter IV “Interior Design”), it can be found to be a single design as a design for a set of articles or an interior design.

6. Registration requirements for a design including a graphic image

In order for the subject matter of an application for design registration to be registered as a design including a graphic image, it must comply with all of the requirements for registration prescribed in the Design Act. Basically, it is carried out the same way as a general examination of registration requirements (see Parts II and III). Following are points that require particular attention regarding the key registration requirements under the Design Act with respect to an application filed for a design including a graphic image.

- (1) The subject matter is an industrially applicable design
- (2) The subject matter is novel
- (3) The subject matter involves creative difficulty (is not something that could have been easily created)
- (4) The subject matter is not a design in a later application that is identical or similar to part of a design in a prior application

6.1 The subject matter is an industrially applicable design

When determining whether the subject matter of an application for design registration filed as a design including a graphic image is an industrially applicable design, the examiner should pay attention to the following points concerning a **graphic image design** and points concerning a **design including a graphic image on a part of an article etc.**

6.1.1 The subject matter is an industrially applicable **graphic image design**

In order for a **graphic image design** to be found to be industrially applicable, the subject matter must comply with the following.

- (1) The subject matter is found to be a **graphic image design** under the Design Act (→ see 6.1.1.1)
- (2) The subject matter is a specific design (→ see 6.1.1.2)
- (3) The subject matter is industrially applicable (→ see 6.1.1.3)

6.1.1.1 The subject matter is found to be a **graphic image design** under the Design Act

Under the Design act, a **graphic image design** is protected as a graphic image itself, separated from the article or building. In other words, when making a comprehensive determination based on statement in the application and drawings,

etc. attached to the application, subject matter found to be an article or building, or a part thereof, cannot be found to be a **graphic image design**.

While a graphic image may include three-dimensional images, it does not have physical shape separate from the article or building. Therefore, in cases where a subject matter is submitted as a specimen or model premised on physical shape, etc., or where a description about physical materials is included, the subject matter cannot be found to be an industrially applicable **graphic image design**. In this case, the examiner should determine whether the subject matter is industrially applicable as a design including a graphic image on a part of an article etc. according to its content.

Furthermore, since a **graphic image design** is separated from the article or building, there is no need to specify how it will be displayed in the application for design registration. The drawings attached to the application should instead show the graphic image creating an aesthetic impression through the eye. If the graphic image is shown together with the display equipment, the examiner should proceed with examination as a design including a graphic image as a part of an article (see 3.2.1).

Under the Design Act, not all kinds of graphic images are protected. Only “graphic images for operation” or “graphic images for display” are subject to protection.

Graphic image designs must fall under at least one of these. Graphic images that fall under both “graphic image for operation” and “graphic image for display” are also determined to comply with this requirement. Graphic images that fall under neither do not fall under a design in the Design Act.

A “graphic image for operation” is a graphic image that gives an instruction in order to enable the target device to work according to its function. It refers to a graphic image, which, unless there are special circumstances, contains a figure, etc. used in some operation of the device which is displayed within the graphic image in a way that it can be selected or specified. Since a **graphic image design** is separated from the article, there is no need to specify the equipment mentioned here. If the usage or function intended for the operation (for example, a graphic image for taking photographs) is specified, it would still be found to comply with this requirement.

A “graphic image for display” is a graphic image for display that is related to some function of the device. It refers to a graphic image that includes a display that is related to some function of the device.

6.1.1.2 The subject matter is a specific design

Since the subject matter to be protected as a design is an aesthetic creation, which is an intangible property that can be identified through the statement in the application and drawings, etc. attached to the application, it is sufficient as long as the contents of the filed design can be specifically derived from the statement in the application and drawings, etc. attached to the application; thus, the drawings, etc. attached to the application need only contain elements that are required to specify the contents of the creation of the design.

For a filed **graphic image design** to be recognized as a specific design, based on the ordinary skill in the art of **graphic image design**, the following must be directly derived from the statement in the application and drawings, etc. attached to the application as originally filed: (i) the usage and function of the **graphic image design**, (ii) if requesting design registration for part of a graphic image, the position,

part will be treated as not constituting the design, and will not be considered in the determination of similarity or the determination of creative difficulty.

On the other hand, where it is unclear whether the part is a content display part, in principle, it will be treated as a pattern constituting the design, and if the examiner is unable to make a specific finding on the design, the examiner should determine that the design is not specific.

(Note) Objects, etc. captured using the camera function, etc. on a smartphone are also treated as being equivalent to this.

6.2 The subject matter is novel

The provisions of the items in Article 3, paragraph (1) of the Design Act, which provide for the novelty requirement, should be applied by determining whether or not the filed design including a graphic image is identical to any publicly known design, or whether or not it is categorized as a design similar to a publicly known design (hereinafter this determination is referred to as “determination of similarity”).

For general determination standards concerning the novelty requirement, see Part III, Chapter II, Section 1 “Novelty.” Further points that require particular attention by an examiner when determining similarity of a design including a graphic image are described below.

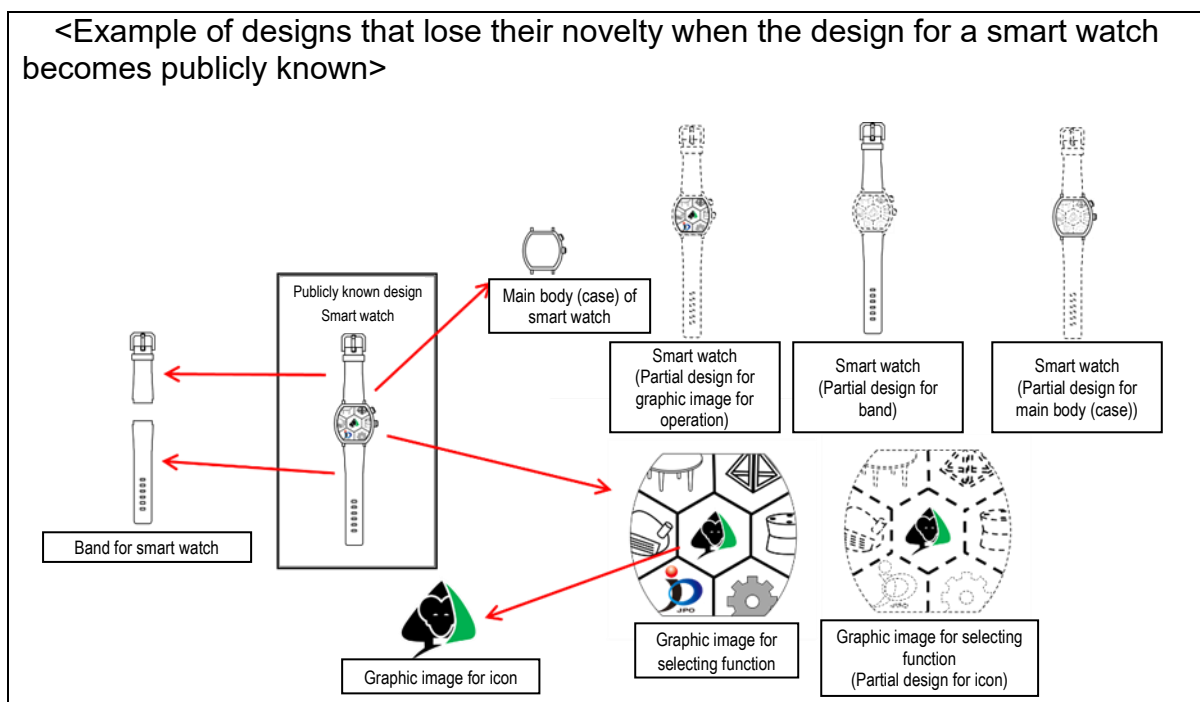
6.2.1 Treatment of cases where a graphic image is displayed on the display part, etc. of an article or building that is published in a publicly known source

Designs that serve as the basis for determining novelty and creative difficulty comprise designs that were publicly known, designs that were described in a distributed publication, and designs that were made publicly available through an electric telecommunication line, as provided in items (i) and (ii) of Article 3, paragraph (1) of the Design Act. In cases where a graphic image is represented in these designs in the display part, etc. of the article or building, in addition to treating the graphic image as information that serves as the basis for determination of novelty and creative difficulty for a design including a graphic image on a part of an article etc., the graphic image displayed on that display part should be treated as information that serves as the basis for determination of novelty and creative difficulty for a **graphic image design**.

In addition, when determining novelty, if the article, etc. contains separately identifiable parts, etc., those parts should also be treated as being a publicly known design (if some parts are hidden inside the article or building, only the parts that appear externally should be treated as a publicly known design), and regarding the parts, each of the designs for which design registration is requested for a part of the article, etc. whose position, size, and scope have been indicated within the article, etc. should also be treated as being a publicly known design.

For example, like in the case below where the publicly known design that has actually been disclosed is a smart watch displaying a graphic image for operation, designs which become publicly known designs and lose their novelty include not only the design of the smart watch, but also the designs of recognizable parts such as the smart watch band and the smart watch main body, the design of the graphic image for operation, the graphic image design for the recognizable icon within the graphic image for operation, and the designs for which design registration is requested for parts of the smart watch and graphic image for operation.

<Example of designs that lose their novelty when the design for a smart watch becomes publicly known>



6.2.2 Method of determining similarity between designs including a graphic image

When determining similarity between designs including a graphic image, whether it is a graphic image design or a design including a graphic image on a part of an article etc., if the two designs being compared fall under all of the requirements in (1) to (3) below, the examiner should determine that the two designs are similar.

- (1) The overall usage and functions of the two designs are identical or similar
- (2) The usage and functions of the graphic image in the two designs are identical or similar
- (3) The shapes, etc. of the two designs are identical or similar

6.2.2.1 The overall usage and functions of the two designs are identical or similar

When determining similarity between designs including a graphic image, the examiner should find the usage and function of the articles, etc. to the design of the two designs based on the purpose of use, state of use, etc. of the article, building, or graphic image, after first taking into account the usage of the article, graphic image or building stated in the column of "Article to the Design." In the case of designs including a graphic image on a part of an article etc., in addition to similarity of usage and function between the articles or buildings to the design, the examiner should also make a finding regarding the usage and function of the graphic images.

The examiner should determine the similarity of the usage and function of the two designs based on the above finding. When doing so, while similarity between designs assumes that the usage and function of the articles, etc. to the designs being compared are identical or similar, since there is no need to make a judgment of similarity based on a comparison of their detailed usage and function, the examiner should determine that there is similarity in the usage and function of the articles, etc. to the design of the two designs if they have commonality in their usage