

**World Intellectual Property Organization**

34, chemin des Colombettes

CH-1211 Geneva 20

Switzerland

Re: Responding to C. 8776

Comments on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs

August 15, 2018

Dear Secretariat,

Thank you very much for the opportunity to provide comments on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs.

We, the Japan Trademark Association (JTA), would be pleased to provide our inputs and detailed questions to the delegations as shown in the following pages.

It would be grateful if they would be helpful for the future fruitful discussions.

Sincerely yours,

Tomohiro NAKAMURA (Mr.)  
Director of the Design Committee  
of the Japan Trademark Association

Tsuyoshi FUJIMOTO (Mr.)  
Member of the Design Committee  
of the Japan Trademark Association  
Attendee of the SCT 39th Session

## LIST OF QUESTIONS TO THE DELEGATIONS

**Q1.** *In your jurisdiction, are there limitations to the types of graphic images subject to protection as in Japan? If there are limitations, how are the graphic images subject to protection defined? Do the functions of products/articles relate to these limitations?*

**Q2.** *In your jurisdiction, are the following graphic images subject to protection under a design act?*

- *Graphic images representing “contents” that are independent from the function of the articles (such as a scene of a film or images from a computer/TV game)*
- *Graphic images provided only for decorative purpose (such as a desktop wallpaper)*
- *Graphic images provided only for conveying information*

**Q3.** *Please tell us about the treatment of the following type of case in your jurisdiction.*

*Does an animated GUI disclosed by multiple static images need to satisfy any requirements to be considered/approved as images related to a single design, for example, that they perform the same function within the product in question, that certain relevance in form is found between the multiple static images, etc.? In such a case, what kind of requirements must be met?*

**Q4.** *In your jurisdiction, are there any provisions/practices which either exclude GUIs/Icons from design registration or limit the scope of design rights in must-fit/must-match provisions, or any similar provisions/practices to must-fit/must-match provisions excluding GUIs/icons from design registration or limiting the effect of design rights?*

**Q5.** *(For jurisdictions in which link between designs and products/articles is not required) Are typeface/type font designs legally or operationally excluded from design protection? If they are excluded from design protection, what are the specific requirements for exclusion?*

**Q6. (For jurisdictions in which link between designs and products/articles is not required, and an examination for determining whether or not designs can be registered is conducted)** In your jurisdiction, when performing a search of prior designs, does the institution responsible for the examination search GUIs and icons designs as applied to all kinds of products/articles? How is the scope of designs subject to design search determined or specified? Does it include publicly known designs, designs already applied for, or designs already registered? How are data about such designs (especially publicly-known designs) collected?

**Q7. (For jurisdictions in which link between designs and products/articles is not required)** How do general users conduct Freedom To Operate (FTO) search before using a certain design? Do they search GUIs and icons designs as applied to all kinds of products/articles? How do they determine the scope of designs subject to design search (registered designs only or including unregistered designs)? Do users have any complaints in terms of clearance costs, for example, that the scope of designs subject to search is too broad?

**Q8.** In your jurisdictions, does the creation, reproduction, transfer or upload of software for displaying GUIs and icons designs on screens, etc. constitute a direct infringement of design rights?

**Q9.** In your jurisdictions, is there any possibility that end users who install or use GUIs and icons could become subject to a claim for infringement of design rights? If there is never such possibility, what kind of legal requirements or operation eliminate such a possibility?

**Q10. (For those jurisdictions in which representation of designs by video files is approved or being considered for approval)** In your jurisdiction, why is the representation of designs by video files approved or being considered for approval? Is that because there are animated GUIs which cannot be represented sufficiently unless video files are used? If so, what kind of GUIs are these?

## 1. Introduction

These days, the importance of User Experience (UX) in business is growing. Since GUIs and Icons improve UX as the interface between users and the services provided, the importance of those designs are also growing. GUIs and Icons designs are very different from traditional product designs because GUIs and Icons are visible in common with traditional product designs, but GUIs and Icons are intangible. At the same time, as digital devices such as smartphones and tablets become more popular, there has been a shift in the media from which people get information from paper to digital, and changes are also being seen in the development of typeface/type font designs. In addition, since items, services and information can be easily distributed to other countries through the Internet, it is natural that the issue of international protection of GUIs, icons and typeface/type font designs is receiving attention. The SCT's efforts working on this issue as an expert committee should be highly regarded.

Regarding the topics mentioned in the Document C. 8776 issued by the secretariat, the Japan Trademark Association (JTA) addresses the questions detailed in 2. and 3. below to each jurisdiction, and in 4. below also gives its opinions about the viewpoints which we consider are necessary when discussing issues in the future.

## 2. The Requirement for a Link between GUIs, Icons, Typeface/Type Font Designs and Article or Product

The Japanese Design Act requires the link of a design and an article<sup>1</sup>. An article is generally understood as having tangible properties<sup>2</sup>. In connection with this, we address the following questions with respect to the subject matter, clearance search and requirements for infringement of a design right.

### 2.1. Subject Matter

#### 2.1.1. Scope of Protection

*Q1. In your jurisdiction, are there limitations to the types of graphic images subject to protection as in Japan? If there are limitations, how are the graphic images subject to protection defined? Do the functions of products/articles relate to these limitations?*

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<sup>1</sup> See SCT/IS/ID/GE/17/INF/2, Slide No. 19.

<sup>2</sup> *Id.* Slide No. 6.

*Q2. In your jurisdiction, are the following graphic images subject to protection under a design act?*

- Graphic images representing “contents” that are independent from the function of the articles (such as a scene of a film or images from a computer/TV game)*
- Graphic images provided only for decorative purpose (such as a desktop wallpaper)*
- Graphic images provided only for conveying information*

Under the Japanese Design Act, only GUIs and Icons which are fixedly recorded in the articles and correspond to "Displayed Images" (i.e. graphic images displayed on the display section of the articles, which are necessary for the said articles to perform their functions) or "Operation Images" (which are the graphic images provided in order to allow operation of the articles) are subject to protection under the Design Act<sup>3</sup>. Graphic images not recorded in articles, such as images from television programs or images on the Internet, images displayed through signals from outside of the articles or images stored in recording media connected to or inserted into the articles, images of contents which are independent from the product such as a single scene of a film or images from a game, or images used only for decorative purposes (desktop wallpaper) are not subject to protection<sup>4</sup>.

We would like to ask each jurisdiction if there are limitations on those graphic image designs that are subject to protection as in Japan, and if there are limitations, what kind of limitations they have.

### **2.1.2. Protection of Animated GUIs**

*Q3. Please tell us about the treatment of the following type of case in your jurisdiction.*

*Does an animated GUI disclosed by multiple static images need to satisfy any requirements to be considered/approved as images related to a single design, for example, that they perform the same function within the product in question, that certain relevance in form is found between the multiple static images, etc.? In such a case, what kind of requirements must be met?*

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<sup>3</sup> *Id.* Slides Nos. 7-10.

<sup>4</sup> *Id.* Slides Nos. 16-18.

In Japan, animated GUIs are subject to protection. Animated GUIs shall be represented by multiple images in one application and such images must be found to be “one design”. If it is acknowledged that (a) multiple images are for the same function of the article and (b) certain relevance in form is found between the images, the GUIs represented by such multiple images is found to be one sequential animated GUIs and can be registered as such<sup>5</sup>.

### 2.1.3. Exclusion from Protection

*Q4. In your jurisdiction, are there any provisions/practices which either exclude GUIs/Icons from design registration or limit the scope of design rights in must-fit/must-match provisions, or any similar provisions/practices to must-fit/must-match provisions excluding GUIs/icons from design registration or limiting the effect of design rights?*

In some jurisdictions, must-fit/must-match regulations and other provisions aim to control the balance between exclusive possession through design protection and free use by third parties of product designs. As for GUIs and Icons, it is possible that the use of standardized designs of Icons is required for the convenience of users, and if so, the exclusive right should not be grant to some kinds of GUIs and icons designs.

This is a question to allow us to determine if there are any jurisdictions in which some kinds of GUIs and icons designs are excluded from protection.

### 2.1.4. Typeface; Type Font

*Q5. (For jurisdictions in which link between designs and products/articles is not required) Are typeface/type font designs legally or operationally excluded from design protection? If they are excluded from design protection, what are the specific requirements for exclusion?*

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<sup>5</sup> *Id.* Slides Nos. 12 and 13.

## 2.2. Conducting Design Search

**Q6. (For jurisdictions in which link between designs and products/articles is not required, and an examination for determining whether or not designs can be registered is conducted)** *In your jurisdiction, when performing a search of prior designs, does the institution responsible for the examination search GUIs and icons designs as applied to all kinds of products/articles? How is the scope of designs subject to design search determined or specified? Does it include publicly known designs, designs already applied for, or designs already registered? How are data about such designs (especially publicly-known designs) collected?*

**Q7. (For jurisdictions in which link between designs and products/articles is not required)** *How do general users conduct Freedom To Operate (FTO) search before using a certain design? Do they search GUIs and icons designs as applied to all kinds of products/articles? How do they determine the scope of designs subject to design search (registered designs only or including unregistered designs)? Do users have any complaints in terms of clearance costs, for example, that the scope of designs subject to search is too broad?*

A few years ago, the Japan Patent Office (JPO) considered easing the requirements which specify that graphic image designs must be linked with particular products/articles. However, it was not possible to obtain the consensus necessary for the revision of the law because some users were concerned that the granting of designs rights to designs of graphic images which are independent from products/articles would have unpredictable results. In other words, there was concern that if the scope of rights is not limited based on particular products/articles, users would be required to conduct design registration searches for all kinds of products/articles in advance to ensure design right clearance when developing GUIs and icons. Under the laws of Japan, to constitute infringement, there must be not only an identity/similarity of forms, but also an identity/similarity between products/articles.

We would like to ask to those jurisdictions where there are no requirements for the link between GUIs/icons designs and specific products/articles, whether they have any concerns about this lack of the requirement of link.



### 2.3. Circumstances Constituting an Infringement of Design Rights

*Q8. In your jurisdictions, does the creation, reproduction, transfer or upload of software for displaying GUIs and icons designs on screens, etc. constitute a direct infringement of design rights?*

*Q9. In your jurisdictions, is there any possibility that end users who install or use GUIs and icons could become subject to a claim for infringement of design rights? If there is never such possibility, what kind of legal requirements or operation eliminate such a possibility?*

The Design Act of Japan subject to a claim for injunction based on a direct infringement of design rights are commercial manufacture, transfer of use or other uses of products in which registered GUI, etc. are installed. Software for displaying GUIs and icons on screens, etc. becomes subject to a claim for injunction only if the provision of such software falls under the requirements for indirect infringement<sup>6</sup>.

In order to constitute infringement, the actions must be performed "as a business" and therefore, in principle, it is unlikely that end users would be required to assume liability for infringement of design rights. However, there is no precedent or court decisions which clearly indicate the scope of "as a business." So as an example, an act of installing GUIs/icons in a product by an employee of a company for business use may be considered to be infringement of design rights.

In Japan, there is a concern that end users may become subject to a claim for infringement of design rights. We would like to ask other jurisdictions whether or not similar concerns exist and if there are no such concerns, what kind of legal requirements or practice mean there is no such concern.

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<sup>6</sup> Article 38 of the Japanese Design Act stipulates "The following acts shall be deemed to constitute infringement of a design right or an exclusive license: (i) acts of producing, assigning, etc. (assigning and leasing and, in the case where the product is a computer program, etc., including providing through an electric telecommunication line, the same shall apply hereinafter) or importing or offering for assignment, etc. (including displaying for the purpose of assignment, etc., the same shall apply hereinafter) any product to be used exclusively for the producing of the article to the registered design or a designs similar thereto as a business"



### 3. Methods Allowed by Offices for the Representation of Animated Designs

*Q10. (For those jurisdictions in which representation of designs by video files is approved or being considered for approval) In your jurisdiction, why is the representation of designs by video files approved or being considered for approval? Is that because there are animated GUIs which cannot be represented sufficiently unless video files are used? If so, what kind of GUIs are these?*

In Japan, animated GUIs are represented by a series of static images. Static images can be diagrams, computer graphics, photographs or any other type of method or representation. In addition, a verbal description (Description of Design) can be added on a voluntary basis in order to further explain the movement and content of the GUIs.

In some jurisdictions, there are limitations on the type of images, the number of static images, and verbal description of the GUIs. We are concerned that these limitations may adversely affect the convenience of users.

If the representation of designs by video files is approved, it is necessary to examine whether it is cost effective for the relevant authorities of each jurisdiction to establish a system for handling the representation of designs by video files. From the point of view of costs for searching by a third party, considering that users may be required to invest in facilities for handling formats for video files, these changes may not necessarily be welcomed. Some may consider that representation should be mainly of static images, and the scope of rights should be thus specified.

On the other hand, since there are jurisdictions in which representation of designs by video files is already approved, it is useful to examine the reasons that the representation of designs by video files was approved in such jurisdictions. We would like to ask such jurisdictions to let us know the reasons for their decision.

### 4. Other Issues

It is said that examination of this topic by the SCT is focused on sharing the experience of each jurisdiction and not for harmonization of legal systems. On the other hand, as seen in the AIPPI resolution<sup>7</sup>, there are some calls for the harmonization of legal systems.

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<sup>7</sup> [https://aippi.org/wp-content/uploads/2017/10/Resolution-on-Graphical-user-interfaces\\_English.pdf](https://aippi.org/wp-content/uploads/2017/10/Resolution-on-Graphical-user-interfaces_English.pdf)

If the SCT aims to not only share information but also to achieve harmonization, it is important to examine whether the protection of GUIs, Icons, Typeface/Type Font Designs offered by the design system supports business while at the same time maintaining a balance between the profits of creators and holders of rights to designs on the one hand and profits of third parties on the other, while at the same time considering whether predictability of business is improved and whether it is cost efficient to establish such a legal system. Discussions on these issues should be interdisciplinary, involving legal experts, technicians and creators who actually design GUIs, Icons, Typeface/Type Font and business experts, and should aim to determine the correct scope of protection and discuss methods for appropriately protecting designs.

End.