

Comments to the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) of the World Intellectual Property Organization (WIPO) on the topic of Graphical User Interface (GUI), Icon and Typeface/Type Font Designs

August 2018

Introduction

Further to the letter of June 11, 2018 from Deputy Director General Wang Binying, the International Trademark Association (INTA) welcomes the opportunity to provide input concerning:

1. The requirement for a link between GUIs, Icons, Typeface/Type Font Designs and the article or product and
2. The methods allowed by offices for the representation of animated designs.

In many instances, GUIs, icons, and fonts have become a key aspect of a company's overall brand. They should therefore be considered an important part of the company's overall IP portfolio. INTA considers that design protection for GUIs, icons, and fonts, should be provided independently from any other form of protection available on the computer program or other technical means of creating it, even if they are projected onto a screen or otherwise only appear when technology is activated.

However, in most of cases, the lifespan of this kind of technology is very short. To the extent that GUIs, icons, and fonts may be eligible for overlapping protection, INTA believes that design law is a good tool to provide short-term protection. Also, this should be without prejudice to protection appropriately provided under other laws, such as copyright, trademark, or the law of unfair competition/passing off.

In 2017, INTA submitted its [responses to the questionnaire on GUI, icon, and typeface/type font designs of WIPO's SCT](#). On that occasion, INTA made several suggestions of ways to harmonize the position on GUIs, icons, and fonts.

INTA Comments

a. Input on the first question - the requirement for a link between GUIs, Icons, Typeface/Type Font Designs and the article or product

In several jurisdictions, there is a requirement for a link between GUIs and the article on which they are displayed. Such requirement is explained by the concern that the scope of the registered designs may otherwise become very broad, thereby providing the design's owner with overbroad rights. This requirement is also based on practical reasons, including that of facilitating searches by examining offices and obviating the need for companies to conduct a *Freedom-to-operate* search beyond their business areas.

However, we believe that this requirement may be problematic, notably for those companies that develop software alone and not hardware but are nonetheless obliged to include hardware in their

application. It has been observed in some of those cases that in order to still be able to apply for GUI design protection, companies use third party proprietary hardware.

For instance, in China, the applicant for a GUI design patent must not only show the GUI but also the hardware on which the GUI is displayed. Because China does not allow broken lines in design patent applications, the scope of the patent includes both the GUI and the hardware shown in the drawings.



The above picture is taken from YANGJIN LI, Beijing IP Court delivers the first judgment on GUI design infringement in China, available at <https://trustinip.com/beijin-ip-court-delivers-the-first-judgment-on-gui-design-infringement-in-china> (accessed 17 April 2018). No infringement was found because the defendant only sold software and, according to the existing rule in China, infringement is found only where the identical or similar design as that of the design patent is adopted on the identical or similar product as that of the design patent.

In contrast, in other jurisdictions, such as the European Union (EU), applicants are not required to show the hardware and GUI designs are protectable on their own. For example:



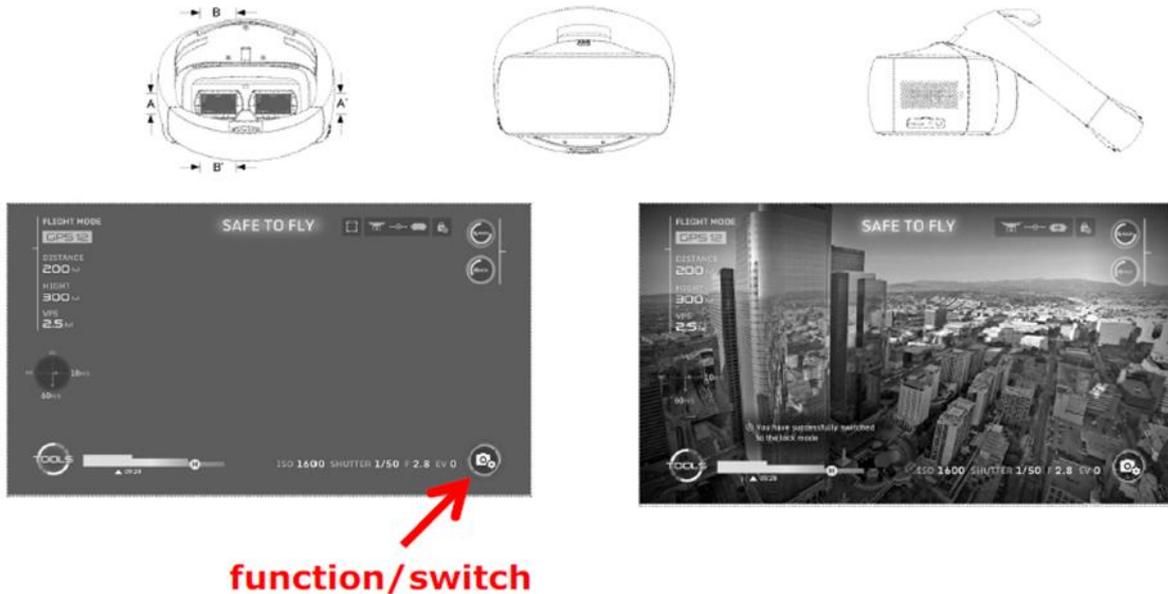
RCD 2533927-0002

It could also be questioned whether a link between the GUI and the product is required for designs of virtual reality (VR) or augmented reality (AR). For VR, for example, screens can be projected in a virtual space generated by head-mount displays. In that case, the article may be a head-mount display (HMD). As for AR, icons or designs can be shown over the real space on the smartphone display.

INTA believes that there is no material difference whether VR or AR designs are projected in a virtual space or on a display, even if that display is worn on the body. As an illustration, we refer to the example below of a Japanese design patent for such a GUI design.

B : Image shown in a display/ **Registered as 2D image**

JPD1580307: Head mount display for drone



Nevertheless, one can easily imagine future designs that are not projected on a display at all but are projected into space and visible by a user, such as a hologram. For this reason, INTA believes that a link between a GUI design and an article should **not** be required in order not to stifle such creative designs in the future and to allow them to be adequately protected regardless of the article which generates the design. Indeed, technology is developing very fast and it is not always possible to foresee where a design can or will be displayed, as this may not be known when creating the design. Moreover, the effort of creating a design (innovation effort) should be protected independently of where it is used, i.e., the scope of protection should not be linked to a particular product. Finally, it should be noted that an immaterial design can be shown by different users in different devices. Therefore, creators should be able to obtain protection for the design independently of the device showing it.

In practice, the transferability of GUIs, icons and fonts across technology means that it is essential, if protection for GUIs, icons and fonts is to be real, that it is NOT dependent on the product that incorporates them.

INTA's view is that users are best placed to determine how to disclose an innovative design for the purposes of applying for its protection. INTA therefore advocates that the designer be given the choice as to how best to represent the design. If the designer wishes to apply to register the GUI or icon in relation to a specific product, she/he should be able to do so. If the designer wishes to register the GUI or icon in the abstract, she/he should be able to do so.

b. Input on the second question - methods allowed by offices for the representation of animated designs

As noted above, INTA believes that users should be free to determine, depending on the particulars of the design protection applied for, how to represent a design.

Importantly, for users of the design system, rights may be lost, including irrevocably, if an application is rejected on a technical matter such as the nature of the representation. A designer, especially an individual designer or SME, can therefore be disadvantaged if a design application outside the designer's home jurisdiction is rejected because the "wrong" representation has been used, even though that representation was accepted in the home jurisdiction.

INTA therefore advocates that color photographs, black and white photographs, drawings (including technical drawings) and other graphic representations, including CAD and video or moving files all be acceptable forms of representations of GUIs, icons and fonts, so long as the representation accurately represents the design.

Some intellectual property offices ("IPOs") such as the Korean Intellectual Property Office (KIPO) already accept three-dimensional ("3D") design files. INTA believes that, in order to keep pace with the progression of technology, animated designs should be allowed to be represented by videos or by a series of static images, at the applicant's preference. INTA recommends that IPOs consistently update their register and practices to match the market reality and adapt their practices to accept e-filing and different new means of representing the design.

As an example, in Peru, where GUI can be protected as industrial designs, the IPO assesses whether the design is new (Article 115 of Decision 486), that is, whether the design has or has not been disclosed to the public prior to the application, and verifies if the application for registration of the industrial design contains the graphic or photographic representation of the industrial design (Article 117 of Decision 486). We note that the GUI, when protected as an industrial design, is protected regardless of the physical product to which it is applied.

INTA recommends that, in order to facilitate multijurisdictional protection for this kind of emerging designs, IPOs provide new and standardized technological means to allow their filing/publication/registration. In this respect, appropriate measures to avoid unauthorized access and use by potential infringers should be considered.

About INTA

INTA is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. INTA's members are more than 7,200 organizations from 191 countries. The Association's member organizations represent some 31,000 trade mark professionals and include brand owners from major corporations as well as small and medium-sized enterprises, law firms and nonprofits. There are also government agency members as well as individual professor and student members. Further information about our Association can be found at www.inta.org.

Should you wish to further discuss any of the points we have raised or additional issues, please contact Carolina Oliveira, INTA Policy Officer -Europe and Staff Liaison for INTA's Designs Committee at coliveira@inta.org.

