

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

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**PROPOSAL BY THE DELEGATIONS OF THE UNITED STATES OF AMERICA
AND JAPAN**

Document prepared by the Secretariat

The Annex to this document contains a proposal by the Delegations of the United States of America and Japan.

[Annex follows]

**Industrial Design and Emerging Technologies: Similarities and Differences in the
Protection of New Technological Designs
Standing Committee on Trademarks, Industrial Designs, and Geographical
Indications (SCT)
World Intellectual Property Organization (WIPO)**

Background:

Industrial design has for over a century focused on the shape, configuration, and surface ornamentation of physical wares – industrial and consumer products ranging from appliances to lighting fixtures to furniture and from shoes to sports cars to jewelry to water fountains. The new and innovative designs for these products served as a clear driver for consumer purchases. Near the end of the 20th century, new technological advancements in electronics began driving industrial design developments into sectors and media not previously contemplated. In particular, the internet, social media, and smart phone and tablet technology have fostered the development of new economic sectors and the need for creative designs of technological designs, including graphical user interface (GUI) and icon designs.

To some degree, industrial design protection for GUIs and icons has already become mainstream, as many jurisdictions around the world regularly are granting industrial design registrations/patents for GUI and icon design innovations. In many of these jurisdictions, these types of designs are among the fastest growing and the types of industrial designs for which design protection is most frequently sought, both by local designers and designers from around the world. However, because of the somewhat unique nature of these design innovations and the short time frame in which jurisdictions have been considering applications for protection for these types of industrial designs, variations exist in the protection provided and the associated eligibility requirements. There is also a lack of information available as to how jurisdictions around the globe are providing protection for GUIs and icon designs as well as in relation to other new and emerging technological designs. Further information and discussions on these subjects would be beneficial to both applicants as well as design offices and governments as they address protection of industrial design rights with regard to these new designs. These new technological designs are significant economic drivers and the WIPO SCT can provide a beneficial forum to deepen the understanding of this topic.

While the importance of GUIs and icons may just now be receiving the high profile media attention they deserve¹, these technologies have been developing for many years. The first icons were believed to be part of the SmallTalk user interface conceived by Xerox in the 1970s. Soon after, in the 1980s, Apple Corporation was the first to operationalize and commercialize icons². In the United States, the first icons protected with a design patent were granted to Xerox Corporation on May 10, 1988, based upon applications filed in 1985, and included a user profile (U.S. Patent No. D295,630,) dividers (U.S. Patent No. D295,631), a “wastebasket” (U.S. Patent No. D295,632), a symbol for a personal computer (U.S. Patent No. D.295,633), and a computer program (U.S. Patent No. D295,634), among other icons.

¹ http://www.nytimes.com/2016/03/22/technology/supreme-court-to-hear-samsung-appeal-on-apple-patent-award.html?_r=0

² <http://web.cecs.pdx.edu/~harry/musings/SmalltalkOverview.html>, also Lees-Maffei, Iconic Designs: 50 Stories about 50 Things, 2014, page 90-91.

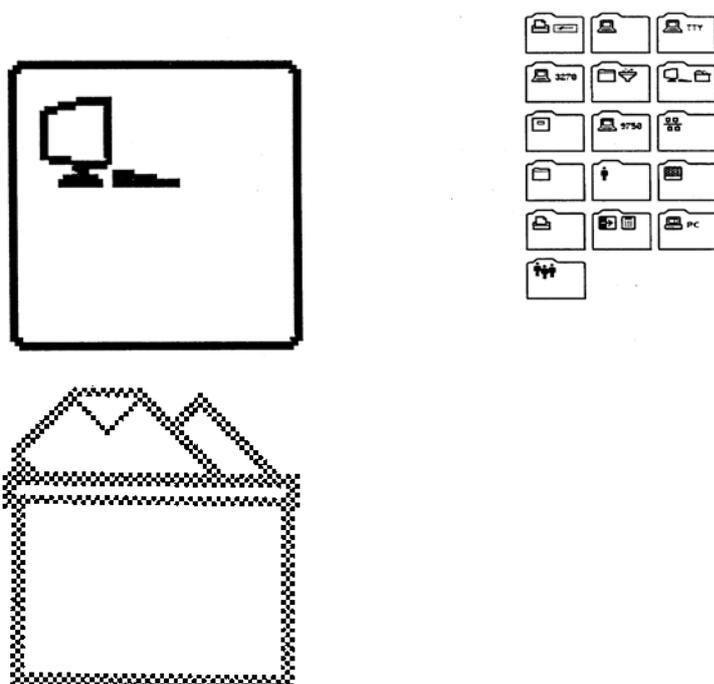
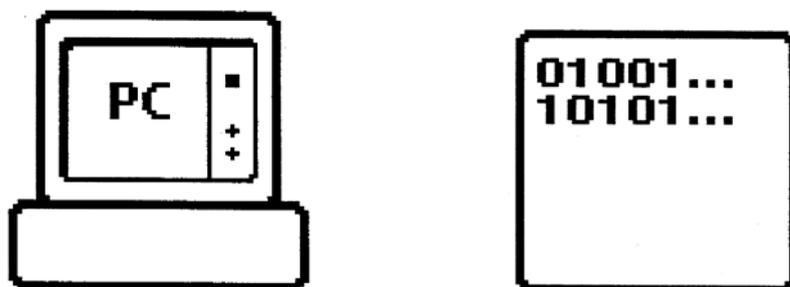


Figure 1: Illustrative icons from Xerox United States design patents.



In the intervening thirty years since icons were first used, and the twenty years since icons were first protected as industrial designs, a multi-billion dollar global industry has developed, building upon the expansion of mobile device technology³. Icons are now commonly associated with mobile device applications, or “apps”, with internet based, global app marketplaces such as Amazon.com, Google Play and the Apple App Store (iTunes). Feeding this global marketplace, are tens of thousands of app developers, the majority of which are now positioned outside of the United States⁴.

³ <http://www.digitaltrends.com/mobile/smartphone-users-number-6-1-billion-by-2020/> (“...Ericsson also estimates 90 percent of the populated globe will have high-speed mobile data coverage by 2020. What’s particularly interesting is where the majority of these new phones will be sold. Ericsson says 80 percent of the new smartphone owners will be located in Asia Pacific, the Middle East, and Africa.”)

⁴ <http://www.boost.co.nz/blog/2013/09/research-the-majority-of-mobile-apps-are-being-developed-outside-the-u-s/>

The ripple effect of the jobs in the telecom, media and technology industries produces economic benefits beyond the companies themselves, contributing significantly to the communities in which these innovators are located⁵ and the communities in which the apps are used⁶.

Illustrative New Technological Designs Today

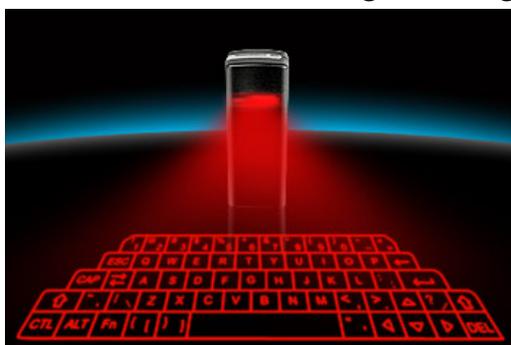


Figure 2: Virtual vkb keyboard⁷



Figure 3: Metro UI Icon set⁸

The recent rapid technological evolution will not end with the new and evolving interfaces for smartphones, tablets or other computing devices in GUI and icon designs. Each day we move closer to breakthroughs that may open up entire new sectors of technologies for which innovators will likely seek protection for their designs. Once futuristic technologies are on the verge of becoming mainstream: driverless cars, holographic projected keyboards, virtual reality displays and similar technologies enter the market each year. The list of economies where design is progressing well beyond “brick and mortar,” and even app technologies, is expanding and the time is ripe for the WIPO SCT, a forum of global experts on industrial design and legal frameworks, to begin discussing industrial design protection for what we might characterize broadly as “new technological designs.”

Illustrative New Technological Designs Tomorrow⁹



Figures 4 and 5: Self-driving concept cars from Rinspeed¹⁰

⁵ See, for example, Minutes of Meeting, World Trade Organization (WTO), Council for Trade-Related Aspects of Intellectual Property Rights (TRIPS Council), Minutes of the TRIPS Council, IP/C/M/80/Add.1 (February 22, 2016), paragraph 408.

⁶ Minutes of the TRIPS Council, paragraph 413, describing a mobile banking platform delivery of banking services to 19 million poor across a large group of countries.

⁷ <http://zeendo.com/info/projected-keyboard-examples/>

⁸ <http://dakirby309.deviantart.com/art/Metro-UI-Icon-Set-725-Icons-280724102>

⁹ These are but a few of the illustrative new technological designs contemplated in the auto industry for coming years. Similar design advancements are occurring across many industries in which innovative industrial designs through media and technology never before contemplated is progressing at an astounding pace.

¹⁰ <http://www.dezeen.com/2014/02/21/driverless-car-concept-vehicle-xchange-by-rinspeed/>



Figure 6: Bosch concept car¹¹

A review of the laws of diverse jurisdictions¹² suggests that differences exist in protecting new technological designs (i.e., GUIs and icons). In particular, jurisdictions vary in areas of eligibility, disclosure requirements and scope of protection. These differences increase the cost to a designer to obtain global protection for their industrial design, which in turn also increases the risk that a copy-cat will take advantage of the low barriers to entry and gaps in, or a lack of protection in, the global market to deprive the innovator of the profit to which he or she is entitled¹³.

How and to what extent does your jurisdiction provide industrial design protection to graphical user interface (GUI) and icon designs? How does the product or article manufacture (e.g., phone, computer, tablet) play into the scope of coverage of design if the design is infringed? Would a GUI or icon design obtained in relation to one type of device (e.g., a smartphone) protect against the design being used on a second device (e.g., the display of an automobile)?

Some jurisdictions' laws, rules or practices expressly provide for the protection of GUIs or icons as industrial designs. The "Industrial Design Practices"¹⁴ of the Canadian Intellectual Property Office, and Section 1504.01(a) of the Manual of Patent Examining Procedure¹⁵ of the United States Patent and Trademark Office are two examples of administrative guidelines from jurisdictions where protection is provided. Other jurisdiction's laws do not expressly exclude icons, but it is understood that, or it has been decided that, GUIs or icons may **not** be protected as industrial designs, because GUIs and icons are considered "digital images," which are not considered two or three dimensional forms in the jurisdiction, or for other reasons.

Of those jurisdictions that are believed to provide protection for GUIs and/or icons, some require that the GUI or icon form part of the finished device to be registered. For example, of those that require an icon to be registered as part of a device, some require that the

¹¹ <http://www.techinsider.io/bosch-concept-car-driverless-car-plans-2016-1>

¹² The Survey conducted by the Design Committee of the Asian Patent Attorneys for their 62nd Council meeting in October 2013 is noted. See:

http://www.apaaonline.org/pdf/APAA_62nd_council_meeting/DesignsCommitteeReports2013/Designs-Committee-Report-2013.pdf, and the corresponding survey responses.

¹³ According to Michael Wong, CEO of Touchpal, an app development company in China and the first Chinese company to win an international competition – the Global Mobile Innovation Award – for app development "many of our innovations were not protected; competitors copied our products. This piracy hinders the innovator's motivation for creating better products for consumers." Minutes of the TRIPS Council, paragraph 459.

¹⁴ Canada Industrial Design Office Practices, Electronic Icons, available from: <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01218.html> (last checked March 27, 2016)

¹⁵ <http://www.uspto.gov/web/offices/pac/mpep/s1504.html#d0e152415>

device and icon be shown in all solid lines. This requirement may prevent an independent designer of an app from being able to obtain industrial design protection for his or her innovative app – at least the icon - in jurisdictions that requires an icon be registered as part of a finished device and be sold as part of that device.

There are also some jurisdictions that protect icons inherently built into a computer or downloadable in general, but otherwise exclude those which appear temporarily when a program is loaded¹⁶. Such a distinction may appear to protect the GUI of a downloadable app to receive industrial design protection, but not any animation or transitory design.

What are the application requirements for obtaining protection for GUI and icon designs in your jurisdiction, that is, how must the design be disclosed? Are there special requirements for animated designs?

Some jurisdictions allow protection for a GUI, but only as a partial design of a physical device such as display or phone. The device must be shown in dotted lines, with the GUI or icon shown in solid lines. The following figure shows a computer monitor in dotted lines, with an icon in solid lines¹⁷.

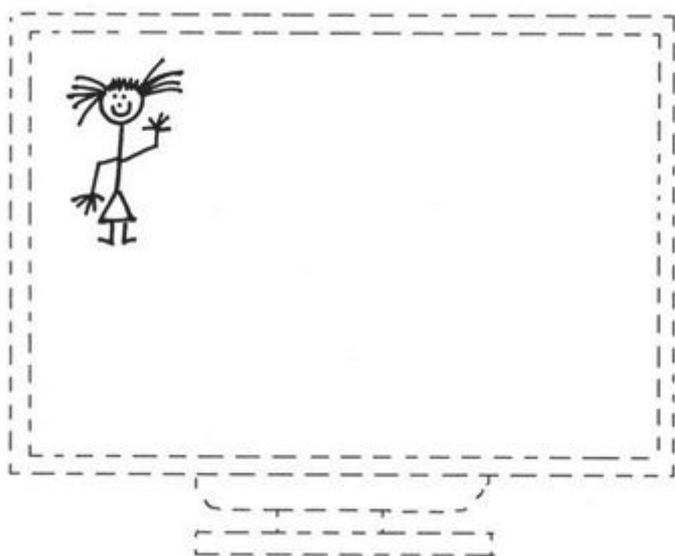


Figure 6: Illustrative Example of an icon as a part of a monitor¹⁸

Additionally, GUIs/icons which are more active in nature, whether they transform, transition, change colors or are otherwise animated, raise further questions when applicants attempt to assess what design offices require to be shown in the industrial design application. Where

¹⁶ See e.g., *Apple Computer Inc., v Design Registry* [2002] FSR 38, which is cited in Reeves and Mendis, *The Current Status and Impact of 3D Printing Within the Industrial Sector: An Analysis of Six Case Studies*, (2015) (available from https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/421550/The_Current_Status_and_Impact_of_3D_Printing_Within_the_Industrial_Sector_-_Study_II.pdf) ("For example, the designs of the interior of chocolate eggs or computer screen icons may only be visible when the chocolate egg is open or the related software is running. However, these designs will not be precluded from registration simply because they are not visible to the user at all times." (footnotes omitted))

¹⁷ See Canada Industrial Design Office Practices, *Electronic Icons*, available from: <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01218.html> (last checked March 27, 2016)

¹⁸ See id.

a jurisdiction protects “animated icons,” the icon is generally required to be shown in the different positions if it moves. This can be accomplished in some jurisdictions through a series of static images when viewed in sequence that provide the appearance of a transitioning image. Some jurisdictions have taken advantage of the information technology (IT) capabilities to facilitate presentation of animated designs to the design office, for example, by allowing applicants to submit animated icons through video type files. The Korean Intellectual Property Office has already been accepting these video type files for several years¹⁹. It is believed that KIPO is also publishing these design rights in electronic form to help retain aspects of the images which could be lost through attempting to convert to a static or paper publication process. Other jurisdictions may require a statement of novelty or other characterizing statements to more specifically address whether the icon is to be protected as part of the hardware of the underlying device or as an icon for a device. These are just some of the diverse practice believed to exist with respect to animated, transitional or moving image designs.

Do letters and Symbols Need to be Disclaimed?

Another area of disparate treatment relates to whether letters, symbols, numerals or words can be protected as the icon or as part of an icon. In some jurisdictions, such elements would need to be disclaimed when protection is sought. A subset of these jurisdictions identify commonly known symbols that need to be disclaimed such as common word processing system symbols, including representative symbols for communication such as symbols like telephone and mail symbols.

Can an industrial design be protected as an industrial design if it is protected by copyright?

Another area of uncertainty is whether an icon or GUI can be protected under the jurisdiction’s copyright laws, and if it can be, whether copyright protection precludes or otherwise affects industrial design protection for certain subject matter. In some jurisdictions, both industrial design rights as well as copyrights may be obtained in relation to new technological designs such as GUIs and icons. In some jurisdictions, if the subject matter is copyrightable, then it cannot receive protection as an industrial design. In others, if copyright is available, but if the design is registered as an industrial design, then copyright protection cannot be obtained in light of the registered design protection.

Is the scope of protection limited by the classification of the industrial design?

Yet another area where outcomes and treatment of new technological designs such as icons appear to vary considerably is the classification of these designs and the consequences of the classification. In some jurisdictions, an icon is classifiable as an icon or a miscellaneous classification, in others, the icon is classified according to the device with which it is used, applied or embodied. In some jurisdictions, the classification appears to limit the scope of protection, but in the European Union, for example, the scope of protection is not related to the classification of the design²⁰.

¹⁹ See Discussion of Industrial Design laws on the Korean Intellectual Property Office website, http://www.kipo.go.kr/kpo/user.tdf?a=user.english.html.HtmlApp&c=93001&catmenu=ek04_01_02 (“...2. Introduction of animated icon designs (in effect as of April, 2011)

An applicant can submit an animated icon design through video files (swf, mpeg, wmv, Animated gif) without transforming to several stabilized images...”); See also <http://www.protectingdesigns.com/design-day-2014-recent-changes-in-gui-design-applications-at-the-korean-intellectual-property-office-kipo> ;

²⁰ See Guidelines for Examination in the Office for Harmonization in the Internal Market (Trademarks and Designs) on Designs, Examination of Applications for Registered Community Designs, version 1.-, July 1, 2014,

[Footnote continued on next page]

Conclusion

In light of the current varied laws and practices regarding the protection of new technological designs and the clear absence of readily accessible information on this same topic, the time is ripe for informational discussions at the WIPO SCT on this particular industrial design topic. Utilizing the technical and legal expertise on industrial design and related intellectual property regimes in relation to these new technological designs and the issues they raise, we believe fruitful discussions can and will result from a discussion of these issues in this forum. As evidenced in this document, there is a shared global interest in the industrial design protection for new technological designs and we very much look forward to discussions on these issues. We invite other delegations to share their experiences in the protection of industrial designs for new technologies.

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[Footnote continued from previous page]

page 36 ("Neither the product indication nor the classification affects the scope of protection of a Community design as such (Article 36(6) CDR). Classification serves exclusively administrative purposes, in particular allowing third parties to search the registered Community designs databases (Article 3(2) CDR).."), which was accessed at: https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/Draft_Guidelines_WP_2/23_examination_of_applications_for_registered_community_designs_en.pdf