

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

Thirty-Seventh Session
Geneva, March 27 to 30, 2017

**ANALYSIS OF THE RETURNS TO THE QUESTIONNAIRE ON GRAPHICAL USER
INTERFACE (GUI), ICON AND TYPEFACE/TYPE FONT DESIGNS**

Document prepared by the Secretariat

I. INTRODUCTION

1. At the thirty-fifth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from April 25 to 27, 2016, the Chair requested the Secretariat to prepare a questionnaire, based on the proposal made by the Delegations of Israel, Japan and the United States of America, entitled “Industrial Design and Emerging Technologies: Similarities and Differences in the Protection of New Technological Designs” (document SCT/35/6). Accordingly, the Secretariat prepared and addressed to all Member States of the World Intellectual Property Organization (WIPO) the *Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs* (hereinafter “the questionnaire”).

2. At the thirty-sixth session of the SCT, held in Geneva from October 17 to 19, 2016, the Secretariat presented a *Compilation of the Replies to the Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs* (document SCT/36/2). After discussions, the Chair requested the Secretariat to:

- invite Member States to submit additional and/or revised replies to the *Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs*;
- invite accredited non-governmental organizations (NGOs) to submit comments and observations on the topic, from the perspective of their experience;
- compile all replies, comments and observations received in a revised document SCT/36/2, to be presented to the next session of the SCT; and
- prepare a document analyzing the replies, comments and observations received, for consideration of the SCT at its next session.

3. Accordingly, the Secretariat prepared document SCT/37/2, analyzing the returns to the questionnaire¹ on the basis of the replies provided by Member States and intergovernmental organizations (IGOs), and taking into account the comments and observations submitted by NGOs.

4. At the thirty-seventh session of the SCT, held in Geneva from March 27 to 30, 2017, the Secretariat presented a revised *Compilation of the Replies to the Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs* (SCT/36/2 Rev.), a corrigendum concerning the English version only of that document (SCT/36/2 Rev. Corr.), as well as an *Analysis of the Returns to the Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs* (document SCT/37/2). After discussions, the Chair requested the Secretariat to:

¹ In total, submissions were received from the following Member States: Argentina, Australia, Austria, Azerbaijan, Belarus, Brazil, Bulgaria, Canada, Chile, China, Colombia, Costa Rica, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Georgia, Germany, Honduras, Hungary, Iceland, Israel, Italy, Japan, Kazakhstan, Kyrgyzstan, Latvia, Lithuania, Malaysia, Mexico, Montenegro, Netherlands, New Zealand, Norway, Oman, Peru, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Saudi Arabia, Serbia, Singapore, Slovakia, South Africa, Spain, Sweden, Switzerland, Turkey, Uganda, Ukraine, United Kingdom, United States of America (59). Replies were also received from the following IGOs: African Intellectual Property Organization (OAPI) and European Union Intellectual Property Office (EUIPO) (2), and the following NGOs: International Association for the Protection of Intellectual Property (AIPPI), International Federation of Intellectual Property Attorneys (FICPI), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA), MARQUES - Association of European Trade Mark Owners (5).

- invite Member States to submit additional and/or revised replies to the *Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs*, as well as relevant examples;
- invite accredited NGOs to submit comments and observations on the topic, from the perspective of their experience;
- compile all replies, examples, comments and observations received in a revised document of SCT/36/2 Rev., for consideration of the SCT at its next session;
- prepare a revised document SCT/37/2, taking into account the additional comments, observations and examples received, for consideration of the SCT at its next session; and
- organize an information session, which will take place at SCT/38, addressing (i) the practices of offices and (ii) the experience of users, with regard to graphical user interface (GUI), icon and typeface/type font designs (see document SCT/37/8).

5. Accordingly, the Secretariat has prepared the present document, updating the analysis of the returns to the questionnaire, contained in document SCT/37/2, on the basis of the additional replies provided by Member States and intergovernmental organizations (IGOs), and taking into account the additional comments and observations submitted by NGOs. Additional replies from the following Member States were received: Brazil, Ecuador, India, Lesotho, Russian Federation, Saudi Arabia, Spain, Viet Nam and Thailand (9). The following non-governmental organization (NGO) submitted additional comments and observations: European Communities Trade Mark Association (ECTA) (1)².

6. The document is divided into four chapters, which follow the structure of the questionnaire, namely “Systems of Protection”, “Application for a Design Patent/Industrial Design Registration”, “Examination of the Application”, and “Scope and Duration of Protection”.

7. The document is supplemented by an Annex, entitled *Quantitative Summary of Replies to the Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs*, containing a table with the number of returns per question and an overview of the replies.

² In total, submissions were received from the following Member States: Argentina, Australia, Austria, Azerbaijan, Belarus, Brazil, Bulgaria, Canada, Chile, China, Colombia, Costa Rica, Croatia, Cyprus, Czech Republic, Denmark, Ecuador, Estonia, Finland, France, Georgia, Germany, Honduras, Hungary, Iceland, India, Israel, Italy, Japan, Kazakhstan, Kyrgyzstan, Latvia, Lesotho, Lithuania, Malaysia, Mexico, Montenegro, Netherlands, New Zealand, Norway, Oman, Peru, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Saudi Arabia, Serbia, Singapore, Slovakia, South Africa, Spain, Sweden, Switzerland, Thailand, Turkey, Uganda, Ukraine, United Kingdom, United States of America (63). Replies were also received from the following IGOs: African Intellectual Property Organization (OAPI) and European Union Intellectual Property Office (EUIPO) (2), and the following NGOs: European Communities Trade Mark Association (ECTA), International Association for the Protection of Intellectual Property (AIPPI), International Federation of Intellectual Property Attorneys (FICPI), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA), MARQUES - Association of European Trade Mark Owners (6).

II. SYSTEMS OF PROTECTION

Question 1 – Does your jurisdiction provide protection for: GUIs, icons, typefaces/type fonts?

8. Protection for graphical user interface (GUIs), icon and typeface/type font designs is provided in almost all jurisdictions that responded to the questionnaire (hereinafter referred to as “responding jurisdictions”). Protection is provided for **GUIs** and **icons** in 95 per cent of the returns; protection is provided for **typefaces/type fonts** in 87 per cent of the returns.

Question 2 – Protection for GUIs, icons, typefaces/type fonts is provided in your jurisdiction under one or several of the following laws: design patent law, registered industrial design law, unregistered industrial design law, copyright law, trademark law, unfair competition law or other laws.

9. A limited number of responding jurisdictions protect GUIs, icons, typefaces/type fonts under one law only, whereas most responding jurisdictions provide protection for GUIs, icons, typefaces/type fonts under several laws.

10. Protection for **GUIs** is provided under one law only in 23 per cent of the returns, as follows:

- registered industrial design law (13 per cent),
- design patent law (5 per cent) or
- copyright law (5 per cent).

11. Protection for **icons** is provided under one law only in 23 per cent of the returns, as follows:

- registered industrial design law (13.3 per cent),
- design patent law (3.3 per cent),
- copyright law (3.3 per cent) or
- trademark law (3.3 per cent).

12. Finally, protection for **typefaces/type fonts** is provided under one law only in 26 per cent of the returns, as follows:

- registered industrial design law (10.5 per cent),
- design patent law (5 per cent) or
- copyright law (10.5 per cent).

13. In most responding jurisdictions, protection is however available under two or more laws, as follows:
- **GUIs** and **icons** can be protected through two or more laws in 77 per cent of the returns;
 - **typefaces/type fonts** can be protected through two or more laws in 74 per cent of the returns.

14. The returns to the questionnaire also revealed 23 possible combinations of different laws to protect GUIs, icons and typeface/type fonts. Among those, the most frequent one associates registered industrial design law, copyright law and trademark law. This combination is applicable for **GUIs** in 12 per cent of the returns, and for **icons** in 18 per cent of the returns.

15. As to **typefaces/type fonts**, the most frequent combination for protection consists of registered industrial design law, unregistered industrial design law, copyright law and unfair competition law. This combination is applicable in 12 per cent of the returns.

Question 3 – To the extent that GUIs, icons, typefaces/type fonts may be eligible for overlapping protection in your jurisdiction via multiple intellectual property rights, such as copyright and a design right (including design patent, registered design or unregistered design), what is the extent of such overlapping rights?

16. The following can be concluded from the responses:

17. First, in many responding jurisdictions, copyright protection is provided only for designs that possess a certain level of artistic creativity. This is the case in 37.5 per cent of the returns, with respect to **GUIs**; in 36 per cent of the returns, with respect to **icons**; and in 39 per cent of the returns, with respect to **typefaces/type fonts**.

18. Second, in approximately one third of responding jurisdictions, full copyright and design overlapping protection can be obtained. This is the case in 34 per cent of the returns, with respect to **GUIs**; in 33 per cent of the returns, with respect to **icons**; and in 35 per cent of the returns, with respect to **typefaces/type fonts**.

19. A small number of returns indicate that full copyright and design overlapping protection can be obtained, but with a reduced term of copyright. This is the case in 5 per cent of the returns, with respect to **GUIs**; in 7 per cent of the returns, with respect to **icons**; and in 6.5 per cent of the returns, with respect to **typefaces/type fonts**.

20. Finally, a small number of responding jurisdictions do not permit any overlapping protection with copyright where the product is intended for production in more than a specific amount of units. This is the case in 5.5 per cent of the returns, with respect to **GUIs**; in 5 per cent of the returns, with respect to **icons**; and in 6.5 per cent of the returns with respect to **typefaces/type fonts**.

III. APPLICATION FOR A DESIGN PATENT/INDUSTRIAL DESIGN REGISTRATION

Question 4 – How may a GUI, icon, typeface/type font be represented in an application for a design patent/industrial design registration in your jurisdiction?

21. GUIs, icons and typeface/type fonts may be represented in the vast majority of responding jurisdictions as follows:
- Black and white photographs, admitted in 97 per cent of the returns for **GUIs**, 95 per cent of the returns for **icons**, and 92 per cent of the returns for **typefaces/type fonts**;
 - Color photographs, admitted in 95 per cent of the returns for **GUIs**, 93.75 per cent of the returns for **icons**, and 90 per cent of the returns for **typefaces/type fonts**;
 - Drawings, including technical drawings, admitted in 65 per cent of the returns for **GUIs**, in 67 per cent of the returns for **icons**, and in 61.5 per cent of the returns for **typefaces/type fonts**. Technical drawings are not accepted in 18 jurisdictions.
22. Other graphic representations (e.g., computer drawings or graphics, CAD drawings) are accepted in 35 per cent of the returns for **GUIs**, in 34 per cent of the returns for **icons**, and in 40 per cent of the returns for **typefaces/type fonts**.
23. In three responding jurisdictions (5 per cent of the returns), other formats enabling an accurate representation of the design (e.g., video and/or audio files, 3D modeling files such as 3DS, DWG, DWF, IGES, 3DM) are admitted for **GUIs** and **icons**.
24. The vast majority of responding jurisdictions allow several forms of representations (95 per cent of the returns in respect of **GUIs** and **icons**; 92 per cent of the returns in respect of **typefaces/type fonts**). However, only one responding jurisdiction allows all forms of representation for **icons**, and only two responding jurisdictions allow all forms of representation for **GUIs**.
25. Three per cent of responding jurisdictions, as far as **GUIs** and **icons** are concerned, and six per cent of responding jurisdictions, as far as **typefaces/type fonts** are concerned, allow only one form of representation, namely drawings, including technical drawings.
26. One NGO advocates that all forms of representations should be acceptable for GUIs, icons and fonts, so long as they accurately represent the design.

Question 5 – Are additional or special requirements applicable to a GUI and/or icon which is animated (moving images design, transformation, transition, change of colors, or any other animation)?

27. There is almost a balance between those responding jurisdictions which have such additional or special requirements (33 per cent of the returns in respect of **GUIs** and 31.25 per cent of the returns in respect of **icons**) and those which do not (37.5 per cent of the returns in respect of **GUIs** and 39 per cent of the returns in respect of **icons**).
28. One NGO advocates that no additional requirements be applicable for GUIs, icons (or fonts) that are animated.

Question 6 – What are the additional or special requirements applicable to a GUI and/or icon which is animated?

29. Among those responding jurisdictions requiring additional or special requirements for animated GUIs and/or icons, series of static images showing a sequence of an animated GUI and/or icon are unanimously accepted (100 per cent of the returns). In over one third of the respondents, this is the only additional or special requirement for animated GUIs and/or icons (42 per cent of the returns in respect of **GUIs** and 43 per cent of the returns in respect of **icons**).

30. Other additional or special requirements for animated GUIs and/or icons are the following:

- a description (in 48 per cent of the returns in respect of **GUIs** and 47 per cent of the returns in respect of **icons**),
- a statement of novelty (in 19 per cent of the returns in respect of **GUIs** and 20 per cent of the returns in respect of **icons**).

Question 7 – Can a GUI and/or icon be patented/registered as such (i.e., independently of the product that incorporates it or in relation to which it is to be used, e.g., smartphone, tablet computer, computer screen)?

31. **GUIs** can be patented/registered *as such* in 69 per cent of responding jurisdictions. **Icons** can be patented/registered *as such* in 67 per cent of responding jurisdictions.

32. One NGO considers that protection for a GUI, icon or font should not be dependent on the product that incorporates it.

Question 8 – If a GUI and/or icon can be patented/registered as such in your jurisdiction, how must it be represented in an application for a design patent/industrial design registration?

33. The most widespread ways of representing a GUI and/or icon in responding jurisdictions where it can be patented/registered *as such* are the following:

- representation of the GUI or icon alone, without the product that incorporates it or in relation to which it is to be used (84 per cent of the returns in respect of **GUIs** and 80 per cent of the returns in respect of **icons**),
- representation of the GUI or icon in solid lines plus the product that incorporates it or in relation to which it is to be used in dotted or broken lines (75.5 per cent of the returns in respect of **GUIs** and 76 per cent of the returns in respect of **icons**).

34. In over one half of responding jurisdictions, both options are allowed in respect of GUIs and icons. In approximately one third of responding jurisdictions, only one form of representation is allowed.

35. One NGO advocates that the designer be given the choice as to how best to represent the design.

Question 9 – Must letters, numerals, words or symbols contained in a GUI and/or icon be disclaimed?

36. The majority of respondents indicate that there is no obligation to disclaim letters, numerals, words or symbols contained in a GUI and/or icon (64.5 per cent of the returns for **GUIs** and 63 per cent of the returns for **icons**). A disclaimer is required in 21.5 per cent of the returns for **GUIs** and 23 per cent of the returns for **icons**.

37. One NGO advocates that the designer seeking protection should be given the option to protect her/his design as she/he thinks best.

Question 10 – Is a GUI and/or icon excluded from protection if it appears only temporarily when a program is loaded?

38. More than two-thirds of the respondents do not exclude a GUI and/or icon from protection if it appears only *temporarily* when a program is loaded (69 per cent of the returns in respect of **GUIs** and **icons**).

39. Two NGOs advocate that protection for GUIs and icons should not be excluded if the GUI/icon appears only temporarily when a program is loaded. If the duration of appearance of the GUI or icon is not so short that the eye cannot perceive it consciously, then the criteria of visibility should be met.

Question 11 – Can typefaces/type fonts be registered as a set?

40. The majority of respondents indicate that typefaces/type fonts can be registered as a set (69.5 per cent of the returns).

Question 12 – With respect to typefaces/type fonts, are there any requirements to provide representation for the entire series of characters (such as the whole alphabet) or for an illustrative group of the entire series of characters in the typeface/type font?

41. The returns to the questionnaire indicate that 43 per cent of the respondents do not provide for any such requirement, while 32 per cent of the respondents do.

42. One NGO supports additional requirements for fonts (such as including all the letters of the relevant alphabet in the font), to ensure that the design is fully disclosed and that users are able to understand what is protected and what is not. Such requirements should however be clear and not overly onerous.

IV. EXAMINATION OF THE APPLICATION

Question 13 – To the extent that your IP Office carries out a substantive examination of an application for a design patent/an industrial design registration, what eligibility criteria are examined with respect to GUIs, icons or typefaces/type fonts?

43. It follows from the returns that the vast majority of IP Offices examine a GUI, icon, typeface/type font for compliance with public order/morality (89 per cent of the returns in respect of **GUIs**, 91 per cent of the returns in respect of **icons**, and 87.5 per cent of the returns in respect of **typefaces/type fonts**). This is the only eligibility criterion examined

in 37 per cent of the returns in relation to **GUIs**, 34.5 per cent of the returns in respect of **icons**, and 42 per cent of the returns in relation to **typefaces/type fonts**.

44. Over one half of the respondents indicate that they carry out examination as to novelty (59.25 per cent of the returns in respect of **GUIs**, 58 per cent of the returns in respect of **icons**, and 52 per cent of the returns in respect of **typefaces/type fonts**).

45. Approximately a quarter of the respondents carry out examination as to:

- originality (26 per cent of the returns for **GUIs**, 25 per cent of the returns for **icons** and 27 per cent of the returns for **typefaces/type fonts**);
- individual character (20 per cent of the returns for **GUIs** and **icons** and 23 per cent of the returns for **typefaces/type fonts**).

46. The returns also revealed that over half of the respondents (61 per cent of the returns for **GUIs** and for **icons** and 54 per cent of the returns for **typefaces/type fonts**) examine GUIs, icons or typefaces/type fonts for compliance with two or more eligibility criteria. It follows from the returns that 15 combinations of these criteria are possible. The most widespread combinations are the following:

- Novelty, individual character and public order/morality (9 per cent of the returns in respect of **GUIs** and **icons**, and 10 per cent of the returns in respect of **typefaces/type fonts**);
- Novelty, originality and public order/morality (13 per cent of the returns in respect of **GUIs** and **icons** and in 10 per cent of the returns in respect of **typefaces/type fonts**);
- Novelty and public order/morality (11 per cent of the returns in respect of **GUIs**, and **icons**, and 6.25 per cent of the returns in respect of **typefaces/type fonts**).

Question 14 – Are the eligibility criteria for GUIs, icons or typefaces/type fonts different from those applied to other industrial designs?

47. Nearly all respondents (97 per cent of the returns in respect of **GUIs**, 98 per cent of the returns in respect of **icons**, and 86.5 per cent of the returns in respect of **typefaces/type fonts**) indicate that the eligibility criteria for GUIs, icons or typefaces/type fonts do not differ from those applied to other industrial designs.

Question 15 – Do you have any further remarks on the examination of GUIs, icons or typefaces/type fonts carried out by your IP Office?

48. Eleven respondents made further remarks which are reproduced in document SCT/36/2 Rev. 2 under comments to Question 15.

49. One NGO advocates that the examination criteria for GUIs and icons be no different to those for other forms of industrial design. The same NGO accepts that for fonts, the additional elements referred to in paragraph 42, above, may also be examined.

V. SCOPE AND DURATION OF PROTECTION

Question 16 – Is the scope of protection of GUI, icon or typeface/type font designs limited by the classification of the industrial design?

50. The majority of respondents (76 per cent of the returns in respect of **GUIs**, 74 per cent of the returns in respect of **icons**, and 66 per cent of the returns in respect of **typefaces/type fonts**) indicate that the scope of protection of GUI, icon or typeface/type font designs is not limited by the classification of the industrial design.

51. Eighteen per cent of the returns in respect of **GUIs**, 19 per cent of the returns in respect of **icons**, and 17 per cent of the returns in respect of **typefaces/type fonts** indicate that the scope of protection is limited by the classification of the industrial design.

Question 17 – Is a GUI and/or icon protected in relation to one product (e.g., a smartphone) also protected against its use in relation to another product (e.g., the display of a car)?

52. Nearly half of the respondents (49 per cent of the returns in respect of **GUIs** and 46.25 per cent of the returns in respect of **icons**) indicate that, if a GUI and/or icon is protected in relation to one product, it is also protected against its use in relation to another product.

53. Nearly a third of the respondents answered negatively to this question (30.5 per cent of the returns in respect of **GUIs** and 32.75 per cent of the returns in respect of **icons**).

Question 18 – Is the duration of protection of GUI, icon or typeface/type font designs the same as the duration of protection of other industrial designs?

54. The vast majority of respondents (92 per cent of the returns in respect of **GUIs**, 94 per cent of the returns in respect of **icons**, and 80 per cent of the returns in respect of **typeface/type font** designs) indicate that the duration of protection of GUI, icon or typeface/type font designs is the same as the duration of protection of other industrial designs.

55. One NGO advocates that the duration of protection for GUI, icon and font designs ought to be the same as for other industrial designs.

VI. CONCLUSION

56. The main trends can be summarized as follows:

- GUIs and icons are almost unanimously protected; typeface/type font designs are also widely protected; in the vast majority of responding jurisdictions, protection is available under several laws;
- In almost all responding jurisdictions, a GUI, icon, typeface/type font design may be represented in black and white or in color photographs; drawings, including technical drawings, are also admitted in many responding jurisdictions;

- One third of responding jurisdictions provide for additional or special requirements applicable to a GUI and/or icon which is animated. In those jurisdictions, the requirement of series of static images showing a sequence of an animated GUI and/or icon is unanimously accepted;
- In more than two thirds of responding jurisdictions, a GUI/icon can be patented/registered *as such*;
- In most responding jurisdictions, there is no obligation to disclaim letters, numerals, words or symbols contained in a GUI and/or icon. With respect to typefaces/type fonts, they can be registered as a set in the majority of responding jurisdictions;
- Nearly all respondents indicate that the eligibility criteria for GUIs, icons or typefaces/type fonts do not differ from those applied to other industrial designs;
- In the majority of responding jurisdictions, the scope of protection of GUI, icon or typeface/type font designs is not limited by the classification of the industrial design. In more than half of responding jurisdictions, if a GUI and/or icon is protected in relation to one product, it is also protected against its use in relation to another product;
- The duration of protection of GUI, icon or typeface/type font designs is generally the same as the duration of protection of other industrial designs.

57. The SCT is invited to consider the contents of the present document.

[Annex follows]