

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

**Thirty-Ninth Session
Geneva, April 23 to 26, 2018**

COMPILATION OF PROPOSALS BY MEMBER STATES AND ACCREDITED
NON-GOVERNMENTAL ORGANIZATIONS (NGOs) ON ASPECTS OF GRAPHICAL
USER INTERFACE (GUI), ICON AND TYPEFACE/TYPE FONT DESIGNS ON WHICH
FURTHER WORK WOULD BE DESIRABLE

INTRODUCTION

1. It is recalled that, in the framework of the thirty-eighth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), which was held in Geneva from October 30 to November 2, 2017, an Information Session on Graphical User Interface (GUI), Icon, Typeface/Type Font Designs took place on October 31, 2017.
2. At the end of the thirty-eighth session of the SCT, the Chair “noted the SCT’s satisfaction with the Information Session on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs and its desire to continue its discussions of the topic”. As next steps, the Chair requested the Secretariat “to invite Member States and accredited NGOs to propose aspects of Graphical User Interface (GUI), icon, typeface/type font designs on which further work would be desirable, and compile all such proposals in a document, for consideration by the SCT at its next session” (see document SCT/38/5, paragraphs 7 and 8).
3. Accordingly, under Circular letter C. 8708 of November 27, 2017, the Secretariat invited Member States of the World Intellectual Property Organization (WIPO) and accredited non-governmental organizations (NGOs) to communicate proposals concerning aspects of GUI, icon, typeface/type font designs on which further work would be desirable.

4. At the closing date to reply to the above-mentioned invitation (*i.e.*, on February 6, 2018), the Secretariat had received proposals from the following Member States: China, Republic of Korea and Tunisia (3). The following accredited NGOs also replied to the invitation: European Communities Trade Mark Association (ECTA), International Association for the Protection of Intellectual Property (AIPPI), International Chamber of Commerce (ICC) and Japan Trademark Association (JTA) (4).
5. The present document compiles all the replies from Member States and accredited NGOs received by the Secretariat. Proposals are reproduced as such and *in extenso* in the present document.
6. The full text of the submissions is posted on the SCT Electronic Forum webpage at <http://www.wipo.int/sct/en/>.

PROPOSALS REGARDING GRAPHICAL USER INTERFACE (GUI) AND ICON DESIGNS

- (1) WIPO's Compilation of the replies to the Questionnaire on GUI, icon and typeface/type font designs has provided an overview of protection of GUIs and icons in different countries and relevant organizations. While the compilation provides useful information and helps to facilitate overall comparison, the State Intellectual Property Office of the People's Republic of China (SIPO) wishes to delve into other questions regarding the protection of GUIs. For example, is it possible for GUIs to be protected as virtual products as opposed to physical products? Does the view of a GUI have to be submitted with a product as its carrier? Does a GUI have to be protected as part of a product? How to distinguish the purely functional part in a GUI? Are the same infringement criteria that apply to other products applicable to GUIs (especially animated interfaces)? Future work as such can be pursued on the basis of simulated cases in combination with the jurisprudence of various countries in the form of an open-ended questionnaire and round table meetings.
- (2) It is proposed to explore the demand for GUI protection from the users' perspective by way of a questionnaire, focusing on uncovering what problems exist for GUI protection for users in their respective countries and regions.
- (3) What concerns China is the relationship between a GUI and the physical product it applies to. SIPO has noted that the following three questions in the questionnaire relate to that issue: Question 7 - Can a GUI and/or icon be patented/registered independently of the product that incorporates it or in relation to which it is to be used? Question 16 - Is the scope of protection of GUI and icons 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)? SIPO believes that the three questions form a sound basis for discussions of the relationship between a GUI and the physical product it applies to. However, different countries only provided very brief responses to those questions. Some countries also mentioned that those questions could not be answered generally because they were closely related to specific cases. Therefore, SIPO proposes to conduct more in-depth and detailed studies on those three questions. It is desirable to use cases, especially infringement cases from the courts, to elaborate the legal provisions and examination practices in various national offices, and to thoroughly explore the relationship between a GUI and the physical product it applies to.

(4) *Scope of Application* - It is important to define the scope of application of aspects of GUI, icon and typeface/type font designs, *i.e.*, through which field of intellectual property these aspects are covered:

- Industrial property
- Copyright

(5) *Means of Protection* - Given the previous question, one or several of the following systems could concern the protection of GUI designs:

- Industrial designs
- Copyright
- Double protection
- Unfair competition
- *Sui generis* system

(6) *Extent of the Protection* - Given that the GUI designs are in fact computer programs expressed by designs (animated or static) that appear on users' screens, the extent of the protection demanded by the owners of the rights needs to be discussed:

- Geographical extent
- Protection period

(7) *Relations with Other Treaties/Harmonization* - Given the specific nature of the question of GUI designs, in particular as regards the practical means of filing and protection, study of possible harmonization with the following treaties is proposed:

- The Hague System¹
- Locarno²
- DLT³
- WCT⁴

(8) *Dispute Resolution* - The question of dispute resolution concerning the ownership of a GUI design should be studied by the Committee, and this with regard to the applicable system:

- National laws
- Alternative Dispute Resolution/Arbitration system

Drawing on the experience gained concerning Internet domain name dispute resolution could also be considered.

(9) Requirements for a connection between graphical user interfaces and physical products for protection of GUIs by design rights, and for their depiction in applications.

(10) Methods allowed for representation of animated GUIs.

(11) The delineation of scope through graphical representations or description.

(12) Requirements to explain the function of GUIs.

¹ Hague Agreement Concerning the International Registration of Industrial Designs
² Locarno Agreement Establishing an International Classification for Industrial Designs
³ Draft Design Law Treaty
⁴ WIPO Copyright Treaty

(13) At the SCT 38th session, the hope that the scope of protection with respect to designs projecting outward from products such as laser keyboards would be expanded was discussed and opinions were solicited; however, we had hoped that the SCT would address issues related to designs which are not specifically 'user interfaces' but nonetheless respond to the surrounding circumstances without interacting with users specifically. For example, graphics which have been projected onto a road from an automobile for pedestrians who are not the user of the automobile.

(14) A new age in which the term 'GUI' will not appropriately describe the design desired to be protected is likely to occur in the not so distant future. In anticipation of this, we hope that a commonly recognized definition of GUI amongst all countries can be agreed upon. Moreover, we hope to discuss these new types of designs which would not fit into the definition of GUI.

(15) We are also interested in GUI designs which could be arranged by the users themselves. For example, in the case in which there are a large number of arrangements that could be set by the user, to what degree should a design owner consider protecting the design, or what is the extent of responsibility for the design owner in connection with any infringement of any other GUIs. This question is particularly relevant in this type of case because it seems that it is so difficult to predict all use modes arranged by users, and how to protect these user modes as a single design. Also we have been concerned that these variously arranged user modes would possibly be considered contributory infringement.

PROPOSALS REGARDING TYPEFACE/TYPE FONT DESIGNS

(16) China does not grant patent protection to typeface/type font designs, but it has done some research in that regard and wishes to discuss with other national offices the following issues by way of case studies: the scope of protection of typeface/type font designs, the specific formality of application documents, methods for determining novelty and inventiveness, as well as criteria for determining infringement of typefaces/type fonts.

(17) It is proposed that countries and organizations providing double protection through both copyright and design laws to typefaces/type fonts be invited to WIPO-organized meetings to introduce their respective legal systems and practices, including criteria for determining infringement and relevant cases.

OTHER PROPOSALS

7. While not exclusively related to GUI, icon and typeface/type font designs, the following proposals have been inserted in the document, insofar as they may relate to new technological designs in their broadest meaning. In addition, they may be relevant to one of the conclusions of the Information Session on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs, namely that it is necessary to determine "what changes intellectual property offices should undertake to adapt their current practices to new technological designs, and what are the legal, technical and infrastructure hurdles to be addressed" (see document SCT/39/2, paragraph 23).

Utilization of artificial intelligence (AI) in design examination and legal protection for AI creation design

(18) *Examination* - Does an Office of each country utilize AI or have plan to do in the process of design examination?

(19) *Examination* - If AI has been utilized, what area is it applied in? (ex: search of prior design, similarity judgement of design).

(20) *Examination* - If it is planned to introduce AI, what area is it prepared for?

(21) *Validation* - AI creation design: In case that user chooses the design that software creates completely (100%), not method of deep learning (in case of combining existing design randomly), is the legal agreement to the person who holds the rights of AI creation prepared? (ex: owner of AI system, application developers, applicant, prohibition of claim of a right, not discussed yet, etc.).

(22) *Validation* - When AI creates a design, is it possible to obtain the registration under the current Design Act?

- Is a creator limited to human under the Design Act?
- Is an applicant limited to human under the Design Act?

(23) *Validation* - When AI creates a design, is it the object of protection under existing copyright law? (ex: not protected, rights of program developer, prohibition of claim of a right, not discussed yet, etc.).

8. *The SCT is invited to consider the content of the present document.*

[End of document]