

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

**Forty-Second Session
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**PROPOSAL BY THE DELEGATIONS OF JAPAN AND THE UNITED STATES OF
AMERICA**

Document prepared by the Secretariat

In a communication dated September 23, 2019, the Delegations of Japan and the United States of America transmitted to the International Bureau of the World Intellectual Property Organization (WIPO) the proposal contained in the Annex to the present document.

[Annex follows]

**PROPOSAL BY JAPAN AND THE UNITED STATES OF AMERICA FOR THE WIPO
STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS
AND GEOGRAPHICAL INDICATIONS**

JOINT RECOMMENDATION:

**INDUSTRIAL DESIGN PROTECTION FOR GRAPHICAL USER
INTERFACE (GUI) DESIGNS**

I. INTRODUCTION

Graphical User Interface designs (GUIs), including icon designs, represent a multi-billion dollar global industry that has been built upon the rapid growth of the mobile device market. For example, icons are commonly associated with mobile device applications, or “apps”, that are available via internet marketplaces.¹

Consumer design preferences regarding electronic interfaces often define commercial success and drive sales, and competitors are increasingly relying on design protection to gain a competitive edge in the marketplace. For SMEs effective design protection can be a critical component of their intellectual property strategy, which allow SMEs to shoulder into the “copy and paste” space of the e-commerce environment. Also, the creation of these mobile device applications is notably dispersed geographically, with the internet making physical location inconsequential in terms of feasibility to develop and commercialize mobile device applications. Stated more directly, the creators of these new designs are spread across the globe – an app designer can do business virtually any place a power outlet and a laptop can exist.

The recent technological evolution however, is not limited to interfaces and icons for smartphones, tablets or other computing devices. Each day we move closer to breakthroughs that will open up entire new sectors of technologies for which designers will likely desire and seek protection for their designs. GUIs are a critical component in the user experience of products ranging from home appliances and televisions to automobiles and fitness devices. 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. Each of these provides a platform for new GUI designs and other types of emerging designs.

It is notable that jurisdictions around the globe are recognizing the value and importance of these designs in new technologies by affording intellectual property protection. As demonstrated by the analysis presented in document SCT/37/2, intellectual property protection for GUIs and icons is now mainstream, with most jurisdictions around the world granting industrial design registrations/patents for new GUI and icon designs.² However, the unique nature of these design innovations and the short time frame in which jurisdictions have been considering protections for these types of industrial designs can result in variations in the availability and protection provided internationally.

¹ Examples of internet marketplaces where these apps are available include Amazon.com, Google Play and the Apple App Store (iTunes).

² Almost all jurisdictions (over 95% or 63 of 66 jurisdictions) that responded to the questionnaire indicated that protection was available for GUI and for icon designs. See SCT 37/2 Rev.

These differences in protection as well as formalities requirements increases the costs to designers in obtaining global protection for their designs, increases the risk of losing protection of the designs in global markets, and weakens motivations for further design creation. In some instances designers realize certain jurisdictions currently are not providing protection for designs in these new technology environments, perhaps because they have not been able to update their law or practice yet or are unsure of how best to update it.

The industrial design community, recognizing these gaps and the opportunity to get ahead of development in these emerging technologies, is actively engaged in this topic through a wide array of legal design expert organizations and conversations. Examples of organizations actively studying this topic include the American Intellectual Property Law Association (AIPLA), the International Association for the Protection of Intellectual Property (AIPPI)³, the International Federation of Intellectual Property Attorneys (FICPI), the Intellectual Property Owners Association (IPO), the International Chamber of Commerce (ICC)⁴, the International Trademark Association (INTA), the Japan Patent Attorneys Association (JPAA), Association of European Trade Mark Owners (MARQUES), and others. Their active engagement in this initiative through their own publications, conferences, and resolutions, demonstrate a global drive for consistent and predictable protections of these vital designs for innovative technologies.

The analysis provided by the work and study of this committee over the last several years, such as in document SCT/37/2, demonstrates that there are several areas now suitable for recommendations regarding successful practices, as jurisdictions are already implementing like-minded approaches to protection.⁵

³ On October 17, 2017, AIPPI passed a resolution setting forth agreed recommendations on “Protection of graphical user interfaces” at its 2017 AIPPI World Congress – Sydney. https://aippi.org/wp-content/uploads/2017/10/Resolution-on-Graphical-user-interfaces_English.pdf; See also AIPPI Summary Report – 2017 – Study Question – General, Protection of graphical user interfaces http://aippi.org/wp-content/uploads/2017/08/SummarReport_GUIs_15August2017_final.pdf

⁴ See Design Protection for Graphical User Interfaces <https://iccwbo.org/publication/design-protection-graphical-user-interfaces-guis/>

⁵ Summary of the WIPO SCT’s consideration of the topic of graphical user interface (GUI) and icon designs and documentation identifying the coalescence of views and experiences.

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).
3. At the thirty-seventh session of the SCT, held in Geneva from March 27 to 30, 2017, the Secretariat presented document SCT/37/2, analyzing the returns to the questionnaire based on the replies provided by Member States and intergovernmental organizations (IGOs), and taking into account the comments and observations submitted by NGOs. Additionally, the Chair requested the Secretariat to organize an information session addressing (i) the practices of offices and (ii) experience of users, with regard to graphical user interface (GUI), icon and typeface/type font designs.
4. The Information Session on Graphical User Interface (GUI), Icon, and Typeface/Type Font Designs was held at the thirty-eighth session of the SCT, in Geneva from October 30 to November 2, 2017. Representatives from government organizations presented on Office practices regarding GUIs, icons, typeface/type fonts and Users detailed experiences with GUIs, icons, typeface/type font designs.
5. At the conclusion of the thirty-eighth session, 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.
6. At the thirty-ninth session, after an exchange of views, the Committee decided further work was desirable on certain existing issues identified in documents SCT/39/2 and SCT/39/3, in particular on proposals 1, 3, 9 and 10 in document SCT/39/3, while issues related to novel technological designs could be undertaken in a subsequent phase. The Secretariat was instructed to invite, and did so invite, Members, Intergovernmental Intellectual Property Organizations with observer status and accredited Non-Governmental

Building on these common themes, on existing regional and national experiences and utilizing the resident technical and legal expertise on industrial design and these new technological designs, the WIPO SCT is well-poised to establish recommendations for the protection of GUI designs. Further identification and support for proven practice will aid interested jurisdictions in providing protection for designs in new technologies, fostering the conditions for new and creative design and supporting designers across the globe working to develop this rapidly evolving designs field.

We invite Standing Committee Members and Observers to share comments and consider the draft proposed joint recommendation on industrial design protection of graphical user interface designs.

II. Draft Recommendations

The text of an initial draft joint recommendation follows for consideration by the WIPO Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications.

Organizations (NGOs) to submit further inputs, including detailed questions which they would like to see answered, 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. The Secretariat prepared a draft questionnaire on the basis of the received inputs and questions, for consideration of the SCT at the fortieth session.

7. At the fortieth session, the Committee consider SCT/40/2 and SCT/40/2 Rev., Graphical User Interface (GUI), Icon, Typeface/Type Font Designs: Draft Questionnaire. The Secretariat was instructed to circulate the questionnaire as contained in SCT/40/2 Rev. to members and the Intergovernmental Intellectual Property Organizations with observer status. The Secretariat was also instructed to compile returns for the questionnaire to be considered at the forty-first session of the SCT.

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Joint Recommendation

Preamble

Recognizing the rapid development of technology and the Internet and the similarly rapid development of environments and platforms enabling the creation of new industrial designs;

Recognizing the benefits to creators resulting from development of common principles so as to provide for a simplified and reliable framework to protect industrial designs implemented in newly developed technologies;

The following recommendations are intended to facilitate the protection of graphical user interface (GUI) designs and to be considered when developing, amending and/or implementing legal, regulatory, and/or practice frameworks concerning the acquisition, maintenance and enforcement of registered industrial design rights, particularly industrial design rights for GUI designs.

GENERAL

Abbreviated Expressions

For the purposes of these Provisions:

- (i) “Graphical User Interface (GUI)” broadly refers to any visual interface which allows users to interact with electronic devices through electronic/digital elements;¹
- (ii) “Hague Agreement” is *The Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs*;
- (iii) “TRIPS Agreement” is the *Agreement on Trade Related Aspects of Intellectual Property*;
- (iv) “Paris Convention” is the *Paris Convention for the Protection of Industrial Property*.

PROTECTION AS AN INDUSTRIAL DESIGN

Recommendation 1

GUI Designs Protected as Industrial Designs

A Party shall provide industrial design protection in relation to new or original graphical user interface (GUI) designs, consistent with Articles 25 and 26 of the TRIPS Agreement.

Recommendation 2

Industrial Design Protection is Independent of Operational/Temporal Limitations

A GUI design shall be afforded industrial design protection in a Party without consideration or limitation to the operating status of the underlying electronic device, the amount of time the design is visually available, or how the GUI was installed on a product.

APPLICATION FOR INDUSTRIAL DESIGN PROTECTION

Recommendation 3

Applicant discretion with regard to representations; Format of representation

Provided the representation sufficiently discloses the industrial design claimed, Parties shall permit GUI designs to be represented using black and white photographs, color photographs, drawings², or other electronic or digital means.

Recommendation 4

*Entire Product Need Not Be Claimed; Protection in Multiple Screen Display Environments*³

A Party shall not require as a prerequisite an industrial design application for a GUI design to claim an entire underlying or separately saleable product. Parties shall ensure protection is available for a GUI design against use of the GUI design in multiple screen display environments without requiring the applicant to file an application for the same design in each environment.

Recommendation 5
Enabling Accurate and Effective Registration of GUI Designs

A Party shall provide procedures for filing industrial design applications that facilitate effective and accurate registration of GUI designs, including the filing of applications for GUI designs that possess transitional or moving image features or that include a number of views visually related and numbered to give a clear idea of the progression.

EXAMINATION OF THE APPLICATION

Recommendation 6
Formal and Substantive Examination of GUI Designs

Industrial design applications for GUI designs shall be examined under the same criteria as to form, and substance where applicable, as other types of industrial design applications.

Recommendation 7
Electronic Priority Document Exchange

A Party shall provide for electronic priority document exchange for industrial design applications including GUI design applications, such as via the WIPO Digital Access Service (DAS), to more efficiently enable satisfaction of the requirements for claiming benefit of a foreign priority application under the Paris Convention.

SCOPE AND DURATION OF PROTECTION

Recommendation 8
Rights granted as industrial designs

The industrial design rights granted by a Party to GUI designs shall not differ from the industrial design rights granted to designs for other products.

Recommendation 9
Infringement

The acts considered by a Party to infringe industrial designs rights for GUIs shall be the same⁴ as those considered to infringe industrial design rights for other products.

Recommendation 10
Duration of Protection

The duration of industrial design protection for GUI designs in a Party shall be the same as for industrial design rights for other designs, and no shorter than the time period(s) set forth in the Hague Agreement.⁵

ENDNOTES

¹ The definition of “Graphical User Interface (GUI)” is based upon the definition set forth in the *AIPPI Summary Report, 2017 - Study Question – General, Protection of graphical user interface*, pg. 1. The term Graphical User Interface (GUI) is intended to be a broad term including but not limited to icons, menus, scroll bars, windows, transitional animations, dialog boxes, etc.

² “Drawings” broadly includes drawings composed on or using a computer and/or other tools.

³ While industrial designs may be considered to be designs for a product, it is recommended that the applicant be able to claim the design without having to claim the product itself as part of the design. In considering GUI designs, issues can arise when applicants are required as a prerequisite for protection to claim the specific or entire product. For example, the scope of the protection can be significantly limited and proper creatorship/inventorship can become an issue if the applicant has not invented/created the underlying device the GUI is claimed with. Additionally, applicants may also be forced to file multiple applications for the exact same GUI design in order to acquire effective protection if the GUI design is utilized in a variety of products or environments.

⁴ In considering the same acts, the characteristics of GUI designs referred to in Recommendation 2 should be taken into account.

⁵ See Article 17 of the Hague Agreement.

[End of Annex and of document]