



Future SCT work on design protection of graphical user interfaces

Submission to WIPO Standing Committee on Law of Trademarks, Industrial Designs and Geographical Indications

The International Chamber of Commerce (ICC) is the world's largest business organisation with a network of over 6 million organisations in more than 100 countries.

Its members include many companies for which new forms of design - such as graphical user interfaces (GUIs) - represent an important economic asset.

ICC has been actively participating in SCT discussions on GUIs design protection and has recently released a [report on design protection for GUIs around the world](#), which suggests issues for policy makers to consider in reviewing their design systems to make design protection for GUIs more effective and efficient.

In response to WIPO Circular C. 8776, ICC is pleased to submit below inputs on the selected topics for future SCT work, based on feedback from businesses around the world.

1. THE REQUIREMENT FOR A LINK BETWEEN GUIs AND THE ARTICLE OR PRODUCT

Practical issues encountered by users:

More flexible approach desirable - Given that the same GUI usually can, and will, be used in different physical products, many users would find it useful to obtain protection for GUIs *per se* without the need for them to be connected to a specific physical product¹, which can unduly limit the scope of protection of a GUI design right.

It is also useful for users to have the possibility of depicting a physical product in dotted lines to make clearer the features of the GUI on a given product, without restricting the scope of protection. When protection is sought for a GUI associated to a single product, the product can be depicted in solid lines. This approach, which allows applicants to choose the scope of protection of their designs, should be extended to more jurisdictions.

REAL-LIFE EXAMPLES – GUI not qualified as a design

Refusal of protection for Amazon's GUI design application 240305 in India ("Graphic user interface for providing supplemental information of a digital work to a display screen", class 14-02).

Objection: Applied-for GUI design was considered not to be a design as per sections 2(a) and 2(d) of the Designs Act (2000), which define an "article" and a "design" respectively.

Grounds for Refusal (Controller's decision):

- The GUI, i.e. display screen of a hand-held computing device, is a function of a computer screen which is an application based on a computer program used for the operation of the hand-held computing device, which will show on the display screen only when the device is switched on.
- The design failed to satisfy the requirements of sections 2(a) and 2(d), which require the design applied on the article in the finished form to be judged solely by eye.
- The design is not an integral part of the article but is purely functional/application based.
- A GUI does not fit into this category and also does not qualify as an article of manufacture.
- A GUI cannot be sold separately as a commodity item in the market. Hence it fails to meet the provision of section 2(d) of the Act.

Insufficient harmonisation of requirements on granting GUI designs - Because of different formality requirements between jurisdictions (e.g. in some countries the physical product must be described in addition to its graphical representation, whose requirements also vary), it is difficult to obtain consistent cross-border design protection for GUIs. In particular, when the Hague System's international filing route is used to protect GUI designs in different countries at once, it is challenging to have a single international application complying with all the national or

¹ Clearly acknowledging that GUIs meet the definition of "product" (currently defined as an industrial or handicraft item by most design laws) would help make it clear that GUIs not connected to any depicted physical products are still eligible for design protection.

regional requirements.

If the requirements are harmonised – e.g. by allowing filings for GUIs themselves, without being attached to a product – this would facilitate the adoption of common standards in different jurisdictions, hence improving access to cross-border design protection of GUIs and increasing its consistency and reliability. In the case of users utilising the Hague System, this would facilitate the filing of a single international application in accordance with the requirements of all the selected jurisdictions.

REAL-LIFE EXAMPLES – lack of harmonisation leading to different decisions depending on country

The design patent D674,810 granted in the US corresponds to the rejected Indian design application 240305 (see above).

2. METHODS ALLOWED BY OFFICES FOR THE REPRESENTATION OF ANIMATED DESIGNS

Practical issues encountered by users:

The requirements for the filing of GUI design applications do not usually consider the unique characteristics of animations - Animated GUIs bring important challenges in terms of graphical representation, as the animation itself cannot usually be depicted in the application or in most design databases - instead, applications must contain static graphical representations of the animation.

Users would find it helpful to be allowed to file video or moving images in applications, and databases should be updated to allow the display and search of animations by the public. EU trade marks can be filed as motion marks in video (JPEG MP4 format) since October 2017, and a similar approach for animated designs would be desirable.

In the current situation, given the significant technical changes this would entail for most offices, the number of views allowed in a single application should not be limited or should be more generous for GUIs; this is especially important in the case of complex animations. Additionally, systems (such as tagging) to indicate the relationship between multiple views/applications representing the same animation could be introduced to make it easier to search for animations in databases.

Insufficient harmonisation of requirements on granting GUI animations - Because of the different formality requirements between jurisdictions (e.g. in some countries animations can be protected in a single application through the inclusion of a sequence of drawings reflecting the changing trend of the animation, while others only allow protection indirectly through the filing of multiple applications, each with a static graphical representation of a different position of the animation), it is difficult to obtain consistent cross-border design protection for GUIs, and in particular, when the Hague System's international filing route is used to protect GUI designs in different countries at once, to have one international application complying with all the national

or regional requirements.

If the requirements on graphical representations are harmonised - for example, by allowing for videos or an unlimited number of graphical representations in the case of animations – this would facilitate the adoption of common standards in different jurisdictions, hence improving access to cross-border design protection of GUIs and increasing its consistency and reliability. In the case of users utilizing the Hague System, this would facilitate the filing of a single international application which would respect the requirements of all the selected jurisdictions.

Before the necessary technical changes to allow the filing of video or moving images are implemented by offices worldwide, the creation of a repository for animated designs (managed by e.g. WIPO) which can be referenced by national filings could be envisaged, as a way to allow users to adequately represent animations through offices not (yet) technically able to support video representations.