

Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT)
World Intellectual Property Organization (WIPO)

United States of America Response to C.8775 (Invitation Letter for Input June 11, 2018)

Background:

At the 39th Session of the SCT held from April 23-26, 2018, the Committee decided that further work is desirable on certain issues identified in documents SCT/39/2 and SCT39/3, particularly proposals 1, 3, 9, and 10 in SCT 39/3. As noted in the invitation letter C.8775, the proposals break down into two categories:

- (1) Analysis of the requirement (or lack thereof) between designs and the article (product) to which they apply; and
- (2) Analysis of the manner in which applicants can represent animated designs.

Please find inputs from the United States in relation to the aforementioned topics.

A. *Analysis of requirement (or lack thereof) between designs and the article (product) to which they apply.*

The relationship between the design and the relevant article¹ with regard to the designs rights is one area that has not received significant study in the context of industrial design protection – particularly at the WIPO SCT. This relationship² between the design and an article arises in two interrelated contexts: (1) the design application and/or (2) the enforcement by the owner of the granted/protected design rights. Based upon previous questionnaire(s) by the SCT, there appears to be variance as to what relationship exists or is required between the design and the article or product or more broadly between the design itself and the type of good(s) identified in an application. These considerations arise in the context of graphical user interface (GUI) and icon type designs, however this topic is of importance and interest across the spectrum of designs. Whether dealing with designs in the context of electronics, housewares, vehicles, crafts,

¹ The term “article” should be read throughout this document broadly to encompass article, article of manufacture, product or other relevant terminology as appropriate.

² For simplicity throughout the paper any reference to relationship or connection between the design and an article should also be read as also including no relationship or connection.

apparel and footwear, or jewelry, the relationship between the design and an article identified in an application is of critical importance as it can affect the scope of the design rights granted.

1. Design Application

In the context of the application process, applicants submit their design including primarily a visual depiction along with any accompanying description, disclaimers and other relevant information. These visual depictions may often include the design amongst what the applicant considers to be environmental or illustrative subject matter which the applicant may not intend to assert as being within the scope of the claimed subject matter. In preparing the design application to ensure effective protection, it is important to understand how a jurisdiction interprets the drawings and disclosure. For example, some jurisdictions protect designs without strict associations to a classification of goods or a particular article if properly identified as illustrative or environmental (and not claimed subject matter). These jurisdictions may still impose additional requirements to satisfy an eligibility threshold, however the design is not considered limited to a single article. In contrast, other jurisdictions may limit the protection to only a single article or classes of articles such that an applicant would need to file an additional application on the same design identifying other articles or classes of articles to provide the additional protection in these other contexts.³

2. Enforcement of the design registration

Relatedly, when design right owners seek to enforce their rights, a critical issue that often arises when determining the scope of protection of their rights is if the design registration⁴ covers use on [X] type of product or in [X] context. In some jurisdictions, the analysis may focus primarily on the similarity in appearance between the registered design and the accused design without strict limitations as to what type of article (or classification of article) are associated with the registration. Other jurisdictions have more rigid restrictions tying the design to a certain article (or classes of articles) and the use of the design outside of those articles would not be considered infringement of that particular design right. This scenario is regularly realized in the context of screen displays and related design environments as it is common for the same

³ This practice seems analogous to practice in the area of trademarks where an applicant identifies classes of goods or services for protection and may need to select more goods or goods or services if they wish to broaden the scope of articles (or services) protected.

⁴ Registration broadly used to include design patent or various other design registration systems utilized by jurisdictions.

design to be applied on cell phones, tablets, laptops, in vehicles, on household products and appliances, etc.

It would be beneficial to applicants and to fellow IP Offices to have a more detailed understanding of the current practices across jurisdictions. While we support questions on this topic that are framed to address GUI, icon and related designs in particular, we recommend questions on these topics also be posed with regard to the wider design practice as well as the GUI/icon examples. In many instances, the handling of the design–article relationship for GUI/icon designs track the general practice of the jurisdiction, while in others it may not. Accordingly, information regarding the general practice of jurisdictions on the design-article relationship as it applies broadly to so called “conventional designs” in complement with information regarding GUI/icon designs would allow for a richer understanding of any nuances specific to GUI/icon designs. Therefore we encourage the Secretariat to structure the Questionnaire so as to obtain both types of information where possible.

B. Analysis of the manner in which applicants can represent animated designs.

The representation of animated designs can be challenging for applicants for a variety of reasons and further study at the SCT is beneficial. Jurisdictions may limit the manner or format which design reproductions are provided. A widely accepted format is in single page representations either in paper form or in electronic form as .jpeg, .pdf or .tiff pages. These static page “flipbook” type representation of designs with dynamic features inherently forces omission of potentially important aspects of the design. While these representational methods may continue to satisfy the requirements for static designs, they fail to contemplate fully the designs in new environments such as electronic screen display. Additionally, some IP Offices do not yet have the systems capable of accepting the current dynamic file types or forms of representation that would allow applicants to accurately capture their designs. Other offices however, have modernized their capabilities in recent years and accept files that do accurately capture animation, movement and transitional imagery. These developments allow applicants more options for depicting these dynamic filings.

Questions on this topic should explore both the legal and procedural requirements and office practices in relation to applications that contain animated, transitional or moving imagery. Additionally, the questions should consider the technical aspects including and particularly what

forms or file types Offices are currently accepting. Given some Offices have already been working with new approaches and technologies in this area, sharing of this information will be of value and benefit to both applicants and IP Offices.

In conclusion, we believe both topics are of importance to designers and to IP Offices. These topics will only increase in relevance to the design community and the SCT is well served to explore these topics. We also believe the categorization of topics proposed by the Secretariat in footnote 3 of C.8775 – one aimed at the relationship or connection between the design and an article or class of articles and a second aimed at practices in relation to representation of designs with animated, transitional or moving images – is the most logical approach to structuring the work and questions proposed. Finally, having provided the general inputs and views above, we respectfully provide the following proposed questions in relation to the two topics identified by the Secretariat for potential inclusion in any Study/Questionnaire.

Proposed Questions

(1) Relationship or connection between the design and an article or class of articles

1. Assuming a design registration in which an article is generally disclaimed (e.g., broken lines) but for a certain portion which contains the design sought to be protected, would the design registration be considered to be limited in scope of coverage to **only** that specific type of article that was disclaimed?
2. Assuming the same design registration and scenario as #1, would the design registration be considered limited in scope to articles that fall within the same classification(s) which the application is identified as falling within?

If yes, is that limiting classification provided by the applicant or assigned by the IP Office? If the IP Office assigns the limiting classification can the applicant challenge or appeal the classification? Also, which classification system is that which is limiting, the Locarno classification or your domestic classification?

3. Do your answers to #1 and #2 change with respect to a GUI/icon designs and if so how is treatment different? (For example, if a desktop computer screen is shown in broken lines and the icon design claimed is shown in solid lines on that screen, would the design coverage be limited to computers or would the same design be covered if it occurred on a cell phone, display of an automobile, and/or display of a refrigerator?)
4. Assuming a design registration in which the shape of an article is disclaimed (e.g., broken lines), and a portion is shown in solid lines to represent the design sought to be protected, what is the role of the identification of the product or products in relation to which the industrial design is to be used (see, for example, Hague Agreement Rule 7(3)(iv))?
5. Is the infringement criteria the same for GUI/icon designs as other types of designs? If it is not the same, how are they different?
6. Is there a distinction in your law or practice depending on the particular virtual specific electronic environment – computer game, virtual reality world, internet application, etc. - the design is utilized? If yes, how are they delineated? Would a single design registration be capable of protecting the design in each of these varied environments?
7. Is it possible for an applicant obtain a **single design registration** that would cover use of the design in a physical product environment **and** use in a virtual or

computer environment⁵ such as those listed in the question above? (For example, could an applicant obtain a single design right that could effectively protect both the design for an automobile on the street and the automobile as used in a computer game or other virtual environment?)

If not, what prevents the applicant from being able to protect the same design in two different environments – i.e., brick and mortar and virtual world? (e.g., requirement for application to be tied to a certain product classification, requirement for tie to a physical product rather than virtual reality etc.)

8. Can a design registration be obtained to a GUI/icon *per se* by filing an application with representations that are completely absent inclusion of any other imagery (claimed or disclaimed) such as a screen or a device? If yes, please provide an example. Also, if yes, does the design registration then cover use of the claimed GUI/icon in any environment?
9. Does your jurisdictions provide protection to designs that are directed to embodiments that are not embodied in “permanent” articles? Illustrative examples to consider would be:
 - a. Water design in a fountain⁶
 - b. Laser Keyboard
 - c. Projection of a speedometer or radio control panel onto a windshield of a car?

If yes, is the design considered to be embodied in or tied to an article and what is the article?

(2) Practices in relation to representation of designs with animated, transitional or moving images

1. Which among the following is a manner in which applicants can provide reproductions to your IP Office to claim animated, transitional or moving image designs:
 - a. A moving image file format such as .wav, .mov, etc which captures the animated, transitional, and moving image presentation as the applicant purports it appear in practice such that the Office can replay the animated, transitional or moving image aspects of the file;
 - b. Electronic format but only in static format (e.g., .pdf) such that a series of images when scrolled through represent the animated, transitional or moving imagery;
 - c. Paper format

⁵ Illustrative examples of environments of interest are virtual world environments such as Second Life® (<http://secondlife.com/>), 3D models for the electronic world such as Turbosquid (<https://www.turbosquid.com/>) and other related virtual and electronic environments.

⁶ See e.g., In re Hruby, 373 F.2d 997, 153 USPQ 61 (CCPA 1967) (design of water fountain patentable design for an article of manufacture)

- d. All 3 formats
- e. Only (b) static electronic form and (c) paper format
- f. Only (c) paper format

Please elaborate.

- 2. What various file formats are available for representations? (i.e., moving picture files, pdf, tif, wav, etc?) Is there a max size limit for files? If so what?
- 3. What formats are representations typically submitted by applicants with respect to animated, transitional or moving images? (e.g., (a) static.pdf files, (b) moving image files such .wav .mov files, (c) paper representation, etc.)
- 4. Are there any additional requirements or special requirements regarding the contents of the application that is particular to design applications directed to animated, transitional or moving image designs?
- 5. Are there specific restrictions or additional options relating to the file format for animated, transitional or moving images? For example, do you only except applications that contain animated, transitional or moving images in one particular format or is there one file format or filing procedure that utilized only for designs with animated, transitional or moving images?
- 6. What is the format in which design rights are granted and published by your Office? (e.g., paper registration/patent; e-grant)? Are there any special publication procedures for designs containing animated, transitional or moving imagery?
- 7. What types of documents/copies are **provided** by your Office for priority claim purposes in another Office? (Please explain how both paper and electronic format are provided as applicable.) Can the documents be certified and how are they certified? Are there any distinctions with respect to the handling or procedures for designs containing animated, transitional or moving imagery?
- 8. What types of documents/copies are **required** by your Office for priority claim purposes from another Office? (Please explain both paper and electronic format as applicable) Do you require a certified copy of priority documents? Are there any distinctions with respect to the handling or procedures for designs containing animated, transitional or moving imagery?