

QUESTIONS CONCERNING THE REQUIREMENT FOR A LINK BETWEEN GUI, ICON, TYPEFACE/TYPE FONT DESIGNS AND THE ARTICLE OR PRODUCT¹

1. Does your jurisdiction provide protection for:
GUI designs <input type="checkbox"/> YES <input type="checkbox"/> NO
Icon designs <input type="checkbox"/> YES <input type="checkbox"/> NO
Typeface/type font designs <input type="checkbox"/> YES <input type="checkbox"/> NO
Comments, if any:

2. In your jurisdiction, is a link ² between a GUI/icon design and an article required as a prerequisite for registration?
<input type="checkbox"/> YES <input type="checkbox"/> NO
If NO , please proceed to question 13 and the subsequent questions
Comments, if any:

(a) Requirement for a link

3. In your jurisdiction, for which type of designs is a link with an article required?
<input type="checkbox"/> computer-generated animated designs
<input type="checkbox"/> GUI designs
<input type="checkbox"/> icon designs
<input type="checkbox"/> typeface/type font designs
<input type="checkbox"/> other – Please specify
Comments, if any:

¹ For the sake of simplicity, only the term “article” will be used hereafter in the present questionnaire, it being understood that it covers also the term “product”, where applicable.

² For the purpose of this questionnaire, the term “link” refers to the fact that a GUI or icon design should be associated with an article.

4. For which reason is such a link required in your jurisdiction?³

- facilitating searches by examining Offices
- facilitating Freedom to Operate (FTO) searches by users
- facilitating searches by applicants
- limiting the scope of design rights
- other - Please specify

Comments, if any:

5. In your jurisdiction, a GUI design:

a) must be embodied in a physical article to be protected

YES NO

b) can apply to a virtual article?

YES NO

Comments, if any:

6. In your jurisdiction, do functional aspects⁴ of the article displaying the GUI/icon design play a role in assessing the link between such design and the article?

YES NO

If YES, what role?

Comments, if any:

³ See the contributions of Chile, INTA (p. 1-3), IPO (p. 4) and JTA.

⁴ For the purpose of this questionnaire, the terms "functional aspects" refer to the manner in which the article works.

7. In your jurisdiction, if a link between a GUI, icon, typeface/type font design and an article is required, but not provided in the design application, can it still be provided during prosecution?

YES NO

If YES, who is empowered to provide it?

the applicant

the Office

Comments, if any:

8. In your jurisdiction, if a link between a GUI/icon design and an article is required, how can/must the GUI/icon design be represented in the application?

representation of the GUI or icon design alone + an indication in words of the article

representation of the GUI or icon design + the article in dotted or broken lines

representation of the GUI or icon design + the article in dotted or broken lines + an indication in words of the article

representation of the GUI or icon design + the article in solid lines

representation of the GUI or icon design + the article in solid lines + an indication in words of the article

other – Please specify

Comments, if any:

9. If a link between a GUI/icon design and an article is required in your jurisdiction and your Office is an examining Office, does your Office search for any design with a similar or identical appearance, regardless of the articles to which it applies?

YES NO

Please explain

Comments, if any:

10. If a design is represented within an article which is disclaimed (e.g., broken lines), what is the effect of the article on the scope of protection of the design?

The scope of protection is limited:

- only to the specific type of article that was disclaimed
- to articles that fall within the same classification
- other – Please specify

Is there an exception for GUI/icon designs?

- YES NO

Comments, if any:

11. If a design is represented within an article which appears in solid lines, the scope of the design patent/design registration would be considered to cover:⁵

- only the design
- both the design and the article
- other – Please specify

Comments, if any:

12. If a design is represented within an article which is disclaimed (e.g., broken lines) and the identification of the article(s) in relation to which the industrial design is to be used is required, what is the purpose of that identification?

Comments, if any:

⁵ See the contributions of INTA (p. 1-2) and IPO (p. 3-4).

(b) No requirement for a link

13. In your jurisdiction, why is no link between a GUI/ icon design and an article required?⁶

- because of the nature of new technological designs, which may be used in different articles/environments
 other - Please specify

Comments, if any:

14. If no link is required in your jurisdiction and your Office is an examining Office, does your Office search for any design with a similar or identical appearance, regardless of the articles to which it applies?⁷

YES NO

Please explain

Comments, if any:

15. If no link is required in your jurisdiction, how do users conduct Freedom to Operate (FTO) searches?⁸

Comments, if any:

16. If no link is required in your jurisdiction, is the indication of an article:

- optional?
 mandatory?

What is the effect of such indication? Please specify

⁶ See the contributions of Hungary, ICC (p. 2), INTA (p. 3) and IPO (p. 4).

⁷ See the contribution of JTA (p. 7).

⁸ *Idem.*

Comments, if any:

17. Can a patent design/design registration be obtained for a GUI/icon design *per se* if it is represented alone (without any article such as a screen or a device)?

YES NO

If **YES**, does the patent design/design registration cover use of the claimed GUI/icon design in any article/environment?

YES NO

Comments, if any:

QUESTIONS CONCERNING THE METHODS ALLOWED BY OFFICES FOR THE REPRESENTATION OF ANIMATED DESIGNS

18. In your jurisdiction, which methods of representation can applicants use to claim protection for animated designs?

Moving images⁹

Please specify the file format (e.g., avi, flv, wmv, wav, mov, mp4):
Please specify the maximum size, if any:

Static images in electronic format

Please specify the file format (e.g., pdf):
Please specify the maximum size, if any:

Static images in paper format

Please specify any additional requirements:

Comments, if any:

⁹ The term "images" is used as a synonym of the term "views".

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19. Where a choice of different methods of representation is available in your jurisdiction, what method is used the most by applicants?

- Moving images
- Static images in electronic format
- Static images in paper format

Comments, if any:

20. Are there any additional/special requirements regarding the contents of the application for animated designs?
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- YES NO

If YES, please specify

Comments, if any:

21. Where video files can be used by applicants to represent animated designs in your jurisdiction:
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- video files *only* are accepted
- video files + series of static images are mandatory
- video files are mandatory + series of static images are optional
- video files are optional + series of static images are mandatory
- other - Please specify

Comments, if any:

22. Where both series of static images and video files are contained in the application, which format determines the scope of protection?
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- both formats, treated equally
- video files prevail and static images are treated just as a reference information - Please specify

static images prevail and video files are treated just as reference information – Please specify

Comments, if any:

23. If animated designs are represented by series of static images or a sequence of drawings or photographs, are there additional requirements regarding the images?¹⁰

YES NO

If **YES**, is it required that:

- all images relate to the same function of the article
- all images be visually related
- all images give a clear perception of the movement/change/progression
- the number of images does not exceed a maximum number – Please specify
- other – Please specify

Comments, if any:

24. In which format are animated designs granted?

- paper registration/patent
- electronic (e-grant)
- other

Comments, if any:

25. In which format are animated designs published?

- paper publication
- electronic publication
- other

¹⁰ See the contributions of United States of America (p. 3-4), EUIPO (p. 3-5), ICC (p. 3-4), INTA (p. 4), JPAA (p. 4-7), and JTA (p. 9).

Comments, if any:

26. Are there any special publication procedures for animated designs?

YES NO

Comments, if any:

ADDITIONAL QUESTIONS

27. In your jurisdiction, are some graphic images excluded from protection under design law?¹¹

YES NO

If YES, which of the following types of images are excluded from protection:

- graphic images representing “contents” that are independent from the function of the article (e.g., a scene of a film or images from a computer/TV game)
- graphic images provided only for decorative purposes (such as a desktop wallpaper)
- graphic images provided only for conveying information
- other – Please specify

If YES, how is the exclusion justified? Please specify

If YES, how are the graphic images subject to protection defined? Please specify

Comments, if any:

28. In your jurisdiction, are certain kinds of GUI/icon designs excluded from design protection?¹²

YES NO

¹¹ See the contribution of JTA (p. 5).

¹² See the contribution of JTA (p. 6).

If **YES**, please specify

Comments, if any:

29. In your jurisdiction, can a part of a GUI design (i.e., some elements only of the GUI design) be protected?

YES NO

If **YES**, how?

If **YES**, can a part of a GUI design be protected if it appears only under certain circumstances¹³

YES NO

Comments, if any:

30. In your jurisdiction, is protection provided to non-permanent designs?¹⁴

YES NO

If **YES**, is the non-permanent design deemed to be embodied in, or tied, to an article?

YES NO

If **YES**, what is the article?

Comments, if any:

¹³ e.g., in a navigation application: "icons alert" popping up in case of traffic jam, accident, etc.

¹⁴ The following are examples of non-permanent designs: the design of a lampshade which is not apparent unless the lamp is lighted, the design of a woman's hosiery which is not apparent unless it is in place on her legs, the design of inflated articles, such as toy balloons, water toys, air mattresses, which are not apparent in the absence of the compressed air which gives them form, a water design in a fountain, a laser keyboard and a projection of a speedometer or radio control panel onto a windshield of a car. See the contribution of the United States of America referring to Hruby, 373 F.2d 997, 153 USPQ 61 (CCPA 1967) (p. 6).

31. In your jurisdiction, is an indication of the class required in a design application?

YES NO

If YES, which classification system is applied in your Office?

- the Locarno classification
- the domestic classification

If YES, the class is:

- indicated by the applicant
- assigned by the Office

If the Office assigns the class, can the applicant challenge or appeal the classification?

YES NO

Is there an exception for GUI/icon designs?

YES NO

Comments, if any:

32. Where GUIs are applied to an article, how are they examined in terms of weight given to the visual features where:

- the GUI is the same or similar but applied to different articles in the prior art base
- the article is the same but shown in active/resting state¹⁵ in the prior art base vs. active/resting state in the application
- the article and GUI in the prior art base is the same or similar to one or more but not all of the representations provided showing different stages of the GUI

Comments, if any:

33. Does your legislation allow for GUIs to be considered in their active state?

¹⁵ For the purpose of this questionnaire, the terms “resting state” refer to the appearance of the article before interaction with the user e.g., the user turning on, waking, or otherwise interacting with the device that contains the GUI design. The terms “active state” refer to the design as it appears after interaction or during use with the user.

YES NO

If **NO**, is the Office practice to consider them in their active state?

YES NO

Comments, if any:

34. In your jurisdiction, are the infringement criteria the same for GUI/icon designs as for other types of designs?

YES NO

If **NO**, how are they different?

Comments, if any:

35. In your jurisdiction, which of the following acts constitute infringement of design rights?

- creation of software for displaying a protected GUI
- reproduction of software for displaying a protected GUI
- transfer of software for displaying a protected GUI
- upload of software for displaying a protected GUI
- installation of a protected GUI or icon design¹⁶ – In such case, under what circumstances?
- use of a protected GUI or icon design¹⁷ – In such case, under what circumstances?
- placement of a protected GUI or icon design on a physical article or *vice-versa* – In such case, under what circumstances?¹⁸

Comments, if any:

¹⁶ See the contribution of IPO referring to indirect infringement doctrines, such as induced infringement (p. 3), and the contribution of JTA (p. 8).

¹⁷ See the contribution of IPO referring to indirect infringement doctrines, such as induced infringement (p. 3), and the contribution of JTA (p. 8).

¹⁸ For example, if a GUI/icon design, protected in the context of an electronic device, is placed on a table top as surface ornamentation and sold as contemporary furniture, would that constitute infringement? What about the reverse, *i.e.*, if a design on the top of an end table is used as a GUI/icon design for a furniture store app, would that constitute infringement?

36. In your jurisdiction, can a *single design registration* cover use of the design in a physical environment *and* in a virtual or computer environment?¹⁹

YES NO

Comments, if any:

37. In your jurisdiction, is there a distinction in the infringement criteria, depending on the particular virtual/electronic environment²⁰ in which the design is used?

YES NO

If YES, how are the environments delineated?

If YES, would a single design registration be capable of protecting the design in each of these varied environments?

YES NO

Comments, if any:

38. In what format does your Office provide documents for priority claim purposes?

- paper format
- electronic format
- both

Can the documents be certified?

YES NO

If YES, how are they certified?

Are there any particulars for priority claims concerning animated designs?

YES NO

Please specify

¹⁹ See the examples mentioned in the contribution of the United States of America (p. 6).
²⁰ e.g., computer game, virtual reality world, Internet application.

Comments, if any:

39. What format of documents does your Office accept for priority claim purposes?

- paper format
- electronic format
- both

Does your Office require certification of priority documents?

- YES NO

Are there any particulars for priority claims concerning animated designs?

- YES NO

If YES, please specify

Comments, if any:

[End of Questionnaire]