



FÉDÉRATION INTERNATIONALE DES CONSEILS EN PROPRIÉTÉ INDUSTRIELLE
COMMISSION D'ÉTUDE ET DE TRAVAIL (CET)

CET WORKING DOCUMENT

SUBJECT:	Design Protection of Icons, Graphical User Interfaces and Fonts	DATE:	12 January 2010
PURPOSE:	Workshop Report	REFERENCE:	EXCO/AR10/WOR/0001
AUTHOR:	Stephen Perry, Workshop Reporter	MEETING:	ExCo Buenos Aires, Argentina
		MEETING DATE:	January 10-14, 2010
		DISTRIBUTION:	All attendees

WORKSHOP REPORT

Workshop #1 - Design and Trademark Protection for Computer Generated Designs

MINUTES

Presenters: Robert Katz (US) & Coleen Morrison (CA)
Reporter: Stephen Perry (CA)
Attendance: 25

Presentation: Robert Katz made a comprehensive and informative presentation on design protection for computer generated designs (GUIs, icons, typefaces). Coleen Morrison contributed a trademark component to the presentation.

The presentation began with a broad definition of protectable subject matter: Graphical User Interfaces (GUIs), icons, screen displays (e.g., wallpapers), fonts/typefaces, and followed with a description of the evolution of mobile phone displays from the small informational displays of the 1990s to the rich graphic animated displays of today. A compelling representation was shown of 10 different Personal Digital Assistants (PDAs) manufactured by different well-known companies, all of which have very similar shapes but whose visual appearance is distinguished by the computer generated designs appearing on their respective displays.

Illustrative examples of actual design registrations were presented for GUIs, icons and sets of icons, screen displays (desktop wallpaper) and screen animations.

Consideration was given to the factors that must be considered when deciding on what form of protection to pursue and what filing strategy to use (e.g. whether the design is content based or not, distinctiveness, prominence of design features, whether the design comprises portions/groups, whether the design is static, transitional or animated, and functionality).

Some consideration was given to the case of trademark protection (e.g. the design must be distinctive of the owner). Requirements concerning the appearance of the mark at the time of commercial transaction was identified as a possible problem for trademark protection. It was noted that trademark issues will be different depending on the nature of the design (e.g. motion mark, design mark etc.) It was also noted that a WIPO study revealed several countries already protect motion or multimedia signs as trademarks.

Differences were set out between US and European design protection of typefaces and fonts (e.g. portions (subsets) permitted in the US but not in the EU, the requirement for complete Roman character sets in EU and non-Roman and non-alphanumeric fonts being excluded in EU). It was noted that a full font set would be unlikely to constitute a trademark but that it is generally accepted that trademark rights in the design of a letter/word can exist.

By identifying actual cases of computer generated design knock-offs, a strong case was made for pursuing design and/or trademark protection for such designs.

It was noted that a questionnaire has been prepared and will be distributed to the national groups to collect information on whether protection for computer generated designs is available in different countries and what limitations are imposed by the national offices on the extent of such protection (e.g. limited to black and white representations, limited to a specific device, entire article must be represented, etc.).

Questions & Answers: Several themes emerged from the discussion that followed the presentation.

Issue #1- Representations: David Merrylees (BR) commented that there is a challenge in adequately representing an animated design using drawings and being able to effectively search such designs. It was agreed that design and trademark offices would need to be encouraged to permit filing animated representations and would need to offer on-line searching capabilities of such animated representations. Grahame Marshall (UK) noted that it would be possible to file a series of designs to overcome the limitation to 7 figures in a single community design application. Robert Katz advised that OHIM accepts colour representations of designs and that the USPTO will accept colour drawings upon payment of a fee, but that design patents print in black and white only. Jon Heggstad (NO) noted that in Norway, a sequence of representations to represent an animated design would be deemed to be separate designs. Robert Katz commented that this problem is addressed in US design applications by indicating in the application that the drawings show a single animated design represented by the sequence of drawings. Noel Brett (AU) noted the analogy in protecting designs of toys whose appearances transform in use, which is permitted in many countries. Andrew Parkes (IE) noted that there had been success in having the German patent office increase the maximum number of representations from 7 to 10, and that it might make sense to approach OHIM with a similar request. Grahame Marshall (GB) noted the risk that priority for a community design may be refused if the priority application contains more than 7 representations. Andrew Parkes (IE) raised the issue of filing strategy where a priority design application includes representations with dotted lines. Robert Katz recommended the strategies of either not claiming priority or filing simultaneously.

Issue #2 – Mutual exclusion/overlap of protection: Rajeshkumar Acharya (IN) noted that some countries, such as India, do not permit co-extensive design and copyright protection for a design. Miguel O'Farrell (AR) confirmed that in Argentina, a plaintiff must choose one or the other at the onset of litigation. It was suggested that copyright protection would be more effective for static, non-functional designs whereas design registration would be appropriate for functional designs where the article is identified.

Issue #3 – Untested by Courts: Dieter Laufhütte (DE) and several other delegates and the presenters noted that enforceability of design registrations for animated designs remains to be tested in court for most jurisdictions.

Other Issues: David Merrylees (BR) asked whether the Patent Reform bill before Congress directly addresses the foregoing issues in any way. Robert Katz advised that, it did not.

WORKSHOP 1
LIST OF ATTENDEES:

Chair :	Robert Katz	(US)
Reporter :	Stephen Perry	(CA)
	Miguel O'Farrell	(AR)
	Noel Brett	(AU)
	David Merrylees	(BR)
	Gustavo Barbosa	(BR)
	Luiz Leonardos	(BR)
	Coleen Morrison	(CA)
	Bernardo Serrano	(CL)
	Ximena Castellanos	(CO)
	Frantisek Kania	(CZ)
	Dieter Laufhütte	(DE)
	Antonio Tavira	(ES)
	Didier Intès	(FR)
	Grahame Marshall	(GB)
	Sharad Vadehra	(IN)
	Rajeshkumar Acharya	(IN)
	Andrew Parkes	(IE)
	Francesco Paolo Vatti	(IT)
	Paolo Stucovitz	(IT)
	Mariano Soní	(MX)
	Hendrik Jan Brookhuis	(NL)
	Jon Heggstad	(NO)
	Barry Graham	(US)
	Mark Wilson	(US)

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