Comments to the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) of the World Intellectual Property Organisation (WIPO) on the topic of Graphical User Interface (GUI), Icon and Typeface/Type Font Designs
By INTA Designs Committee
January 2017

Further to the letter of 14 November 2016 from Deputy Director General Wang Binying, the Designs Committee of the International Trademark Association (INTA) welcomes the opportunity to provide comments and observations to the SCT of WIPO on the topic of GUIs, icon and typeface/type font (for ease, "font") designs.

INTA is a global association of trademark owners and professionals dedicated to supporting trademarks and related intellectual property in order to protect consumers and to promote fair and effective commerce. INTA's members are more than 6,700 organizations from 190 countries. See more information about INTA below.

Overall, INTA Designs Committee wishes to make the following general comments in support of the SCT's work in relation to GUIs, icons and fonts:

1. In the last 10 years, there has been an obvious and acknowledged surge in use of GUIs, icons and fonts in many industries around the world.

2. From a design perspective, many of these GUIs, icons and fonts demonstrate high levels of design innovation.

3. From a consumer perspective, consumers now know, immediately, to associate particular GUIs, icons and fonts with particular producers of goods and providers of services.

4. Since the commercial success of a product or service often depends on these creative and innovative design choices, protecting GUIs, icons and fonts is important to differentiating one product from another in the marketplace.

5. In many instances, GUIs, icons and fonts have become a key aspect of a company's overall brand. They should therefore be considered a part of the overall IP portfolio, and design protection is needed to assure the legal framework for their protection.

6. Providing protection for GUIs, icons and fonts also encourages technological and economic development, in many sectors.

7. In many instances, the lifespan of this kind of technology is very short. The granting of design protection is therefore fitting. Of course, GUIs, icons and fonts may be eligible for overlapping protection via multiple intellectual property rights (such as copyright and/or trademarks).

8. INTA Designs Committee therefore supports design protection for GUIs, icons and fonts.

Regarding the Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs, it seems that it is directed at member states to elicit the position of the law currently in their jurisdiction.

Rather than commenting on the existing laws in each member state, INTA Designs Committee would like to provide comments to some of the questionnaire questions to suggest, on behalf of designers and other users of the design registration system, what optimally a harmonised position on GUIs, icons and fonts might look like.

Question 1 – Does your jurisdiction provide protection for GUIs, Icons, and Fonts?

INTA Designs Committee advocates for the reasons set out above that intellectual property protection should be provided for GUIs, icons and fonts.

INTA Designs Committee notes footnote 2 to the Questionnaire – in saying that protection should be provided, INTA Designs Committee supports protection for the GUI, icon or font, independently from any protection available to the computer program or other technical means of creating it.

INTA Designs Committee considers that protection should be available for GUIs, icons and fonts even if they are projected onto a screen or otherwise only appear when technology is activated.

Question 3 – To the extent that GUIs, icons and fonts may be eligible for overlapping protection…what is the extent of such overlapping rights?

INTA Designs Committee considers that design law is a good tool to provide short term protection for GUIs, icons and fonts. INTA Designs Committee advocates for the availability of registered design law to protect GUIs, icons and fonts.

As noted above, the provision of design law protection for GUIs, icons and fonts should be without prejudice to protection appropriately provided under other laws, such as copyright law, trademark law, or the law of unfair competition/passing off.

Question 4 – How may a GUI, icon, font be represented in an application for registration in your jurisdiction?

INTA Designs Committee's view is that users are best placed to determine how to disclose an innovative design for the purposes of applying for its protection. INTA Designs Committee therefore advocates for user choice, and for as few restrictions as possible on what a designer may file when seeking protection for GUIs, icons and fonts.

Importantly, for users of the design system, rights may be lost, including irrevocably, if an application is rejected on a technical matter such as the nature of the representation. A designer, especially an individual designer or SME, can therefore be disadvantaged if a design application outside the designer's home jurisdiction rejects the application because the "wrong" representation has been used, even though that representation was accepted in the home jurisdiction.

INTA Designs Committee therefore advocates that colour photographs, black and white photographs, drawings (including technical drawings) and other graphic representations, including CAD and video or moving files all be acceptable forms of representations of GUIs, icons and fonts, so long as the representation accurately represents the design.

Question 6 – What are the additional or special requirements applicable to a GUI and/or icon which is animated?

INTA Designs Committee advocates that no additional requirements be applicable for GUIs, icons (or indeed fonts) that are animated. Again, so long as the design is accurately represented, that should be sufficient to obtain a design registration.

Technical developments are such that Offices should be able to accept video files within appropriate guidelines.

Question 8 – If a GUI and/or icon can be registered as such in your jurisdiction, how must it be represented in an application for registration?

The very real transference in practice of GUIs, icons and fonts across technology means that it is essential, if protection for GUIs, icons and fonts is to be real, that it is NOT dependent on the product that incorporates it.

INTA Designs Committee therefore advocates, as above, that the designer be given the choice as to how best to represent the design. If the designer wishes to apply to register the GUI or icon in relation to a specific product, she/he should be able to do so. If the designer wishes to register the GUI or icon in the abstract, she/he should be able to do so.

Question 9 – Must letters, numerals, words and symbols contained in a GUI and/or icon be disclaimed?

This question seeks an answer on a difficult issue at the heart of protection of GUIs (more so than icons). A GUI for a read-out for, for example, a fitness monitor, will include a digital read-out showing the number of steps taken in a day, heart-rate etc. In seeking protection, the designer is most likely seeking to protect the design of the read-out, rather than any specific read-out of number of steps etc.

Again, INTA Designs Committee advocates that the designer seeking protection should be given the option to protect her/his design as she/he thinks best.

Design law protects innovative designs – designs have to be novel in order to be protected (albeit that the level of novelty is set at different levels in different jurisdictions). A GUI which incorporates a not-novel image of a telephone may still be novel, but its novelty will not lie in the telephone image. Similarly, a design registered for a GUI which shows a digital read-out for a number will not be novel so far as that number is concerned – but may be for the innovative way in which the number is presented.

Question 10 – Is a GUI and/or icon excluded from protection if it appears only temporarily when a program is loaded?

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As set out above, INTA Designs Committee advocates that protection for GUIs and icons should NOT be excluded if the GUI/icon appears only temporarily when a program is loaded. To do so would be to exclude from protection the vast majority of GUIs/icons, and would stymie innovation.

Question 12 – With respect to fonts, are there any requirements to provide representation for the entire series of characters (such as the whole alphabet) or an illustrative group of the entire series of characters in the font?

Question 11 is difficult to answer without a single understanding of what is meant by a "set".

In our view, the registration of fonts doesrequire additional specifications to ensure that the design is fully disclosed, and that users of the system are able to understand, without undue difficulty, what is protected (and as importantly, what is not). Therefore, INTA Designs Committee understands that various member states have introduced additional requirements for fonts, such as, for example, including all the letters of the relevant alphabet in the font (in upper and lower case if relevant), as well as numbers. Some require that a designated number of lines of text be included to show the use of the font as an example.

So long as the requirements are clear and not overly onerous, INTA Designs Committee supports such requirements as an aide to clarity.

Question 18 – Is the duration of protection of GUI, icon and font designs the same as the duration of protection of other industrial designs?

INTA Designs Committee advocates that the examination criteria for GUIs and icons be no different to those for other forms of industrial design. INTA Designs Committee accepts that for fonts, the additional elements discussed above may also be examined.

Similarly, INTA Designs Committee advocates that the duration of protection for GUI, icon and font designs ought to be the same as for other industrial designs.

Should you have any questions on the above, please contact Hélène Nicora, Representative Officer –Europe and staff liaison of INTA Designs Committee at hnicora@inta.org.

About INTA

The International Trademark Association (INTA) is a global association of trademark owners and professionals dedicated to supporting trademarks and related intellectual property in order to protect consumers and to promote fair and effective commerce. INTA's members are more than 6,700 organizations from 190 countries. INTA members collectively contribute almost US $12 trillion / €8.8 trillion / ¥73 trillion to global GDP annually. For comparison, the 2013 annual GDP of the top three markets was $9.2 trillion (China), $17.9 trillion (European Union) and $16.7 trillion (United States).

The Association's member organizations represent some 30,000 trademark professionals and include brand owners from major corporations as well as small- and medium-sized enterprises,

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law firms and nonprofits. There are also government agency members as well as individual professor and student members. INTA has almost 60 member organizations in Singapore.

INTA undertakes advocacy work throughout the world to advance trademarks and related rights, and offers educational programs and informational and legal resources of global interest. Headquartered in New York City, INTA also has offices in Brussels, Shanghai and Washington D.C. and representatives in Geneva, New Delhi and Singapore.

Further information about our Association can be found at www.inta.org.