ARISE+
ASEAN Intellectual Property Rights

Promoting Intellectual Property Rights in the ASEAN Region

Experience Sharing: Examination of new types of designs

Gerardo Penas | OEPM | 21/07/2020

Funded by the European Union

EUIPO
EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE

This Project is funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

Why is it so relevant?

Sector with fast growth level:

.

- ✓ 50% of designs will be digitised designs.
- ✓ More and more products have displays.
- ✓ More and more sectors use ICT: shopping, news, sports, maps, food, dates, tourism, health, taxis, music,…
- ✓ More designs in the icon field: virtual migration.
- ✓ IoT, smart cities, smart energy, industry 4.0, digital twins…

Legal design definition

Design: “means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation”.

(11) Whereas protection is conferred by way of registration upon the right holder for those design features of a product, in whole or in part, which are shown visibly in an application and made available to the public by way of publication or consultation of the relevant file;

Legal product definition

Product: means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

Why does design protection fit well?

- ✓ Companies invest millions of dollars to develop GUIs linked to functionalities (cool, intuitive and user-friendly).
- ✓ Protection is essential to avoid copy.
- ✓ Other ways of protection may be not so fit for purpose –TMs, patents, copyrights, secret.
- ✓ Designs not only prevent from the copy. General impression also counts.
- ✓ Fast granting process for products with short technological time life.

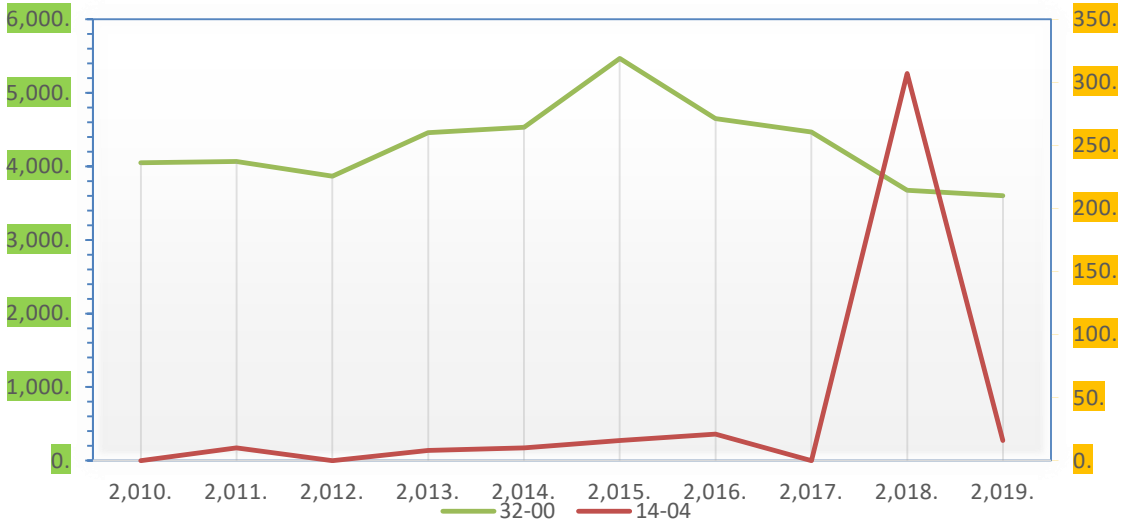
Why does design protection fit well?

Under European legislation, we consider that new types of designs fit under “product” legal definition:

- Grahical User Interfaces (GUI)
- Displays
- Icons
- Sequences of images
- Videogames (parts of)
- Videogames (characters)
- Typefonts
- Virtual Reality (?)

Statistics

Evolution classes 14-04 and 32-00



Example: Graphical user interface

Specific examination problems:

- Is the text included in the design?
- One design or several designs? Scrolling, drop-down buttons, radio buttons,…
- Classification: is it posible ornamentation for mobile app?

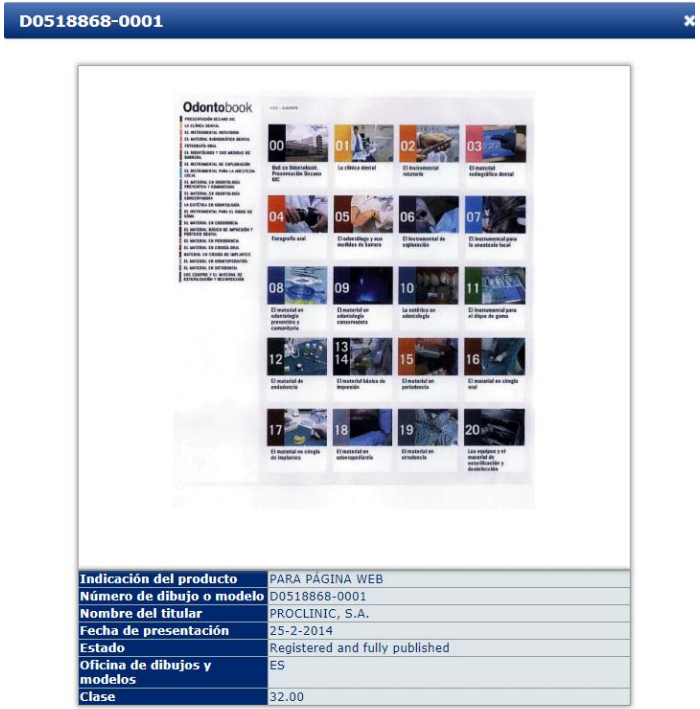
D0529655-0004

Indicación del producto	Ornamentación para página web y aplicación móvil
Número de dibujo o modelo	D0529655-0004
Nombre del titular	Pablo Sánchez Planelles
Fecha de presentación	6-3-2019
Estado	Registered and fully published
Oficina de dibujos y modelos	ES
Clase	32.00

Example: Graphical user interface

Specific examination problems:

- Complex GUIs with multiple designs.



Indicación del producto	PARA PÁGINA WEB
Número de dibujo o modelo	D0518868-0001
Nombre del titular	PROCLINIC, S.A.
Fecha de presentación	25-2-2014
Estado	Registered and fully published
Oficina de dibujos y modelos	ES
Clase	32.00

Example: Displays

Specific examination problems:

Not neccessary although convenient to show in dotted lines the product on which the display is mounted.

D0028396-0001

Indicación del producto	ORNAMENTACION DE ICONOS PARA PANTALLAS DE VISUALIZACION DE DATOS.
Número de dibujo o modelo	D0028396-0001
Nombre del titular	BAYER CORPORATION
Fecha de presentación	13-11-2002
Estado	Registered and fully published
Oficina de dibujos y modelos	ES
Clase	14.03

Example: Icons

Example: Sequence of images

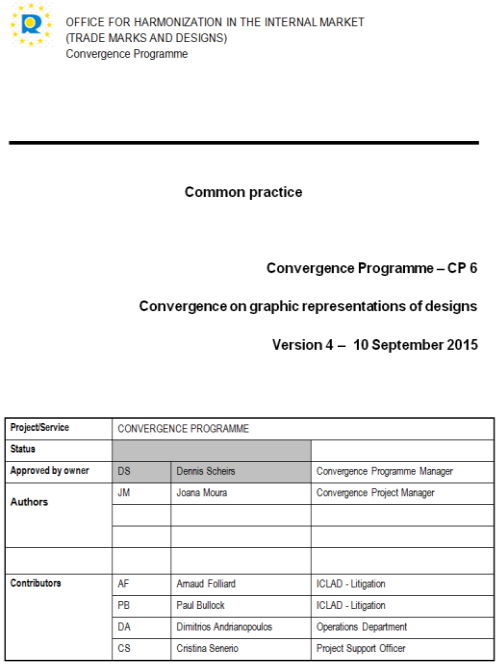
Specific examination problems:

Absence of legal tools to avoid misrepresentation.
Limited number of views.

Example: Sequence of images

CP6: Common practice agreed:

BG, BOIP, CY, CZ, DE, DK, EE, ES, FR, GR, HR, HU, IE, IS, IT, LT, LV, NO, EUIPO, PL, PT, RO, SI, SK, SE, TR y UK



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)
Convergence Programme

Common practice

Convergence Programme – CP 6

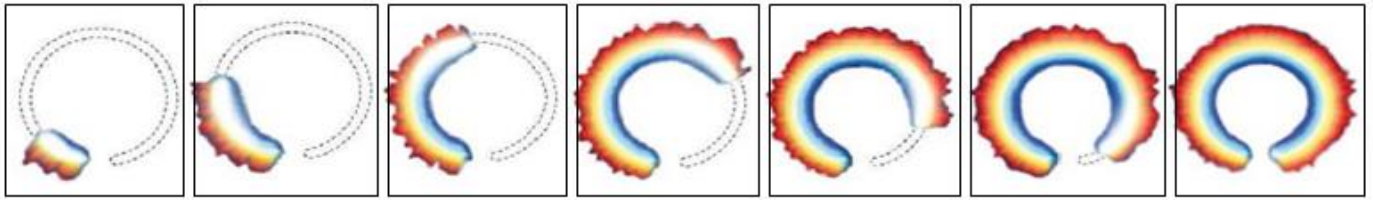
Convergence on graphic representations of designs

Version 4 – 10 September 2015

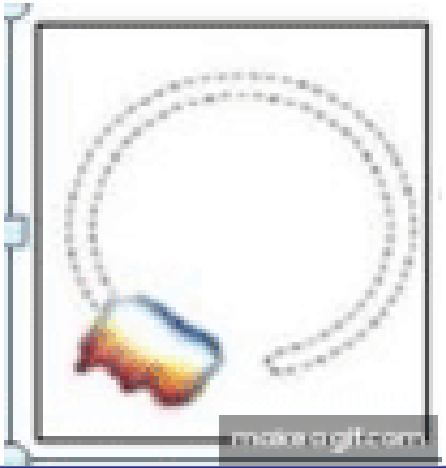
Project/Service	CONVERGENCE PROGRAMME		
Status			
Approved by owner	DS	Dennis Scheirs	Convergence Programme Manager
Authors	JM	Joana Moura	Convergence Project Manager
Contributors	AF	Arnaud Folliard	ICLAD - Litigation
	PB	Paul Bullock	ICLAD - Litigation
	DA	Dimitrios Andrianopoulos	Operations Department
	CS	Cristina Senerio	Project Support Officer

Example: Sequence of images

Representation of the 7 views in the dossier



How should they be interpreted?



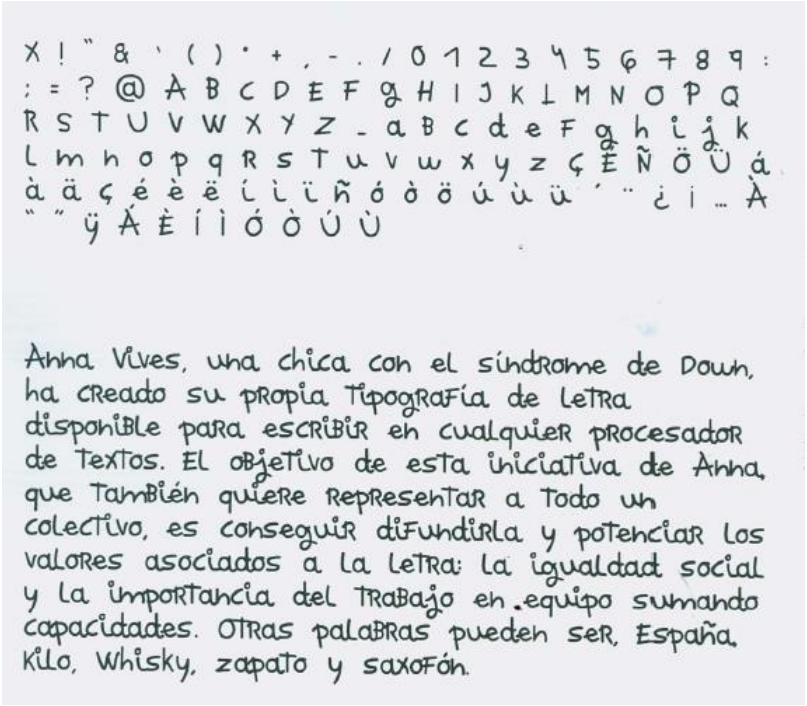
Example: Videogames characters

Example: Videogames parts

Example: Typefonts

Specific examination problems:

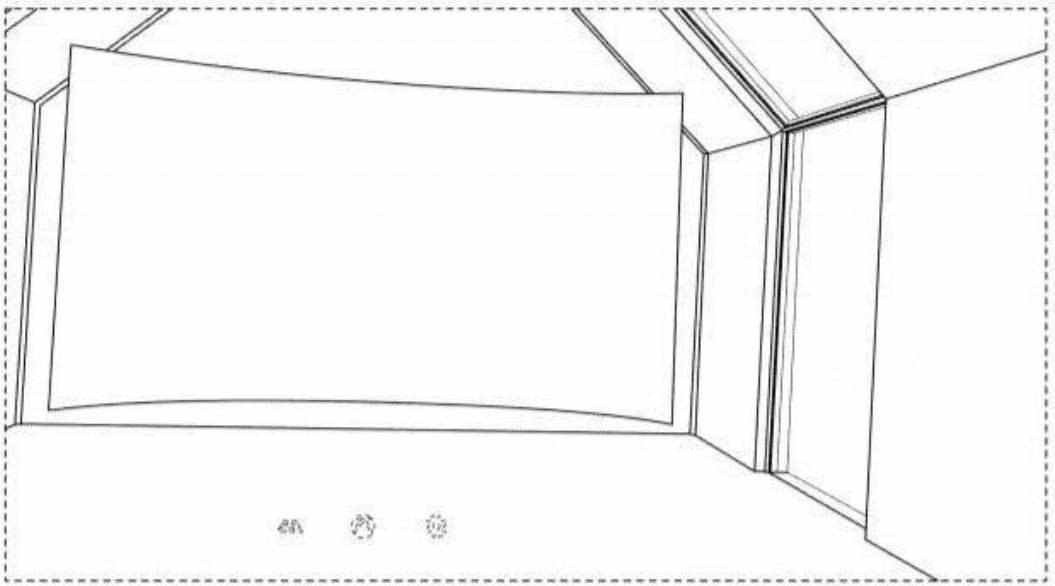
Difficulty in the representation.
Locarno classification: 18-3



Example: Virtual reality

Specific examination problems:

Is it a design in the sense of the law?



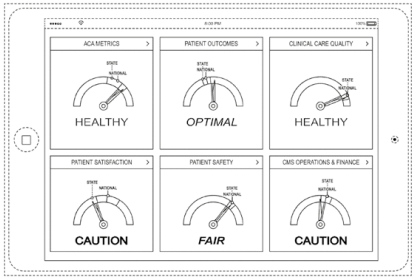
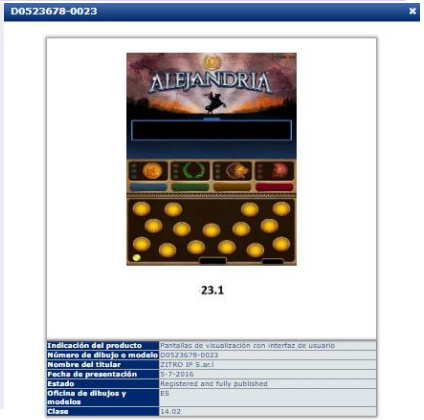
ABCDEFGHIJKLM
NOPQRSTUVWXYZ
ABCDEFGHIJKLM
NOPQRSTUVWXYZ
1234567890

Main harmonisation problem

Product: means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs.

In some countries, “product” legal interpretation is:
“physical product”

Main harmonisation problem

USPTO	SIPO	EUIPO	OEPM
YES	YES	NO	NO
			

EU 004695260-0072 (Euro Games Technology Ltd.)

Conclusions: Challenges

- Improve the representation without affecting legal certainty.
- Protection in virtual environments and rule of visibility.
- International harmonisation (priority rights)
- Limited Case Law

Conclusions: Good news

- Institutional concern (SCT-OMPI).
- Users' interest.
- European Directive should bring clarification on these topics.

ARISE+
ASEAN Intellectual Property Rights

Promoting Intellectual Property Rights in the ASEAN Region

THANK YOU

www.ariseplusipr.eu

Twitter: @IPR_Dev

Facebook: IPR Development

LinkedIn: IPR Development

YouTube: IPR Development

Funded by the European Union

EUIPO
EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE

This Project is funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)