

## **Design Patent for GUI: Challenges and Hope**

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The protection of industrial designs in China is provided by the patent law and the industrial designs are called design patents, like in the US. The design practice in China has been evolving in many aspects ever since the first Chinese patent law came into effect on April 1, 1985. However, some aspects of the design practice in China have been challenging for applicants and patentees to obtain meaningful protection scope of their design patents. Proposed changes to the Chinese patent law will bring positive changes in the not-too-distant future.

### **Power-On State**

For a very long time, any pattern on a product which is only shown when the product is powered on, such as the pattern on an electronic watch dial, the pattern on the screen of a mobile phone, software interface, and so on, is not considered as subject matter that can be protected by a Chinese design patent. In practice, applicants must remove such patterns from the drawings or pictures of the application documents. Otherwise, the application will be rejected. The design patent application No.201030255255.5 filed by Apple Inc. for a portable display device with a graphic user interface (GUI) was rejected by SIPO. Apple Inc. appealed to the Patent Re-examination Board (PRB) but the appeal was subsequently denied. Then Apple Inc. further appealed to Beijing No. 1 Intermediate People's Court which overturned the PRB's decision. The PRB then appealed to the Beijing High People's Court which in its decision (2014) Gao Xin (Zhi) Zhong Zi No. 2815, maintained the lower court's decision. Both courts were of the opinion that the application should not be rejected merely because it has a GUI which can only be shown when the device is powered on. This case was chosen by the Supreme People's Court as one of the ten "innovative" IP cases in 2014.

On May 1, 2014, the Guidelines for Patent Examination were revised to allow patterns shown in power-on state to be protected by design patents. This revision actually aimed to protect GUIs with design patents. Hence, some of such patterns are excluded from being protected by design patents in the Guidelines for Patent Examination. Specifically, they are game interface and patterns displayed by the displaying device of a product, which patterns are not relevant to human computer interaction or to the realization of the function of this product, such as wallpaper on an electronic screen, pictures shown during the start or shutdown of the device, or layout of drawings and texts on web pages of websites.

In addition, there is another significant limitation of design protection for GUIs or other patterns shown only in power-on state. According to Chinese design practice, a design patent can only protect a complete product but not a portion of the product that cannot be sold or used independently. Therefore, it is not possible to protect a GUI itself or a pattern shown only in power-on state itself. The applicant has to limit the scope of the design patent to a specific complete product with the GUI or the pattern shown only in power-on state, which product apparently has specific shape, pattern or color. This

practice significantly reduces the value of a design patent for protecting GUIs, as the scope of such a design patent is quite narrow.

The Guidelines for Patent Examination provide that in invalidation proceedings, for the purpose of evaluating whether a design patent for a product with a GUI is significantly different from prior designs, if the other parts of the product are common designs, the GUI has a notable influence on the overall visual effects of the product. In addition, a judicial interpretation issued by the Supreme People's Court provides that in infringement proceedings, the portion of a product which is easily to be directly observed in normal use of the product, which may be the GUI itself for a product with a GUI, has more influence on the overall visual effects of the product. Despite of these provisions, the scope of a design patent for a product with GUI or pattern shown only in power-on state is still significantly limited due to the absence of partial design practice in China.

### **Partial Design**

On April 1, 2015, the State Intellectual Property Office (SIPO) published a latest draft of the fourth amendment to the Chinese patent law which proposed to allow partial designs. According to this draft, the definition of "design" is changed to any new design of the shape or pattern, or their combination or the combination of the color with shape or pattern, of a product as a whole or a portion thereof, which design creates an aesthetic feeling and is fit for industrial application. This change includes design for a portion of a product as patentable subject matter, which has not been possible up to now. As mentioned, applicants currently must limit the scope of protection of a design patent to a specific complete product. For example, even if a design is only for a handle of a cup and the handle could be used for cup bodies of any shape, an applicant has to incorporate the design of the handle into a specific cup body or a limited number of cup bodies in a design application or design patent, as a design patent in China only protects a complete product but not a portion of a product that cannot be sold or used independently. The allowance of partial design protection is of significance as it gives broader protection of design patents so that copying the design of a portion of a product or combining designs of portions of various products may be determined as infringing acts.

This proposal also makes it possible to protect a GUI itself or a pattern shown only in power-on state itself, e.g. an icon for human computer interaction, without the limitation of protecting such a GUI or pattern as a portion of a complete product. Under the current practice, in the case where another portion of such a product, e.g., the shape of the complete product, is determined to have influence on the overall visual effect, even if a competing product has the same or similar GUI as the patented GUI, it is still possible that no infringement can be found if the complete competing product has a different shape. If partial designs are allowed, such unfavourable results may be avoided.

However, it is to be noted that it may still be impossible to assert partial designs against products in very different categories. First of all, a design patent application, whether for a partial design or a design of a complete product, must designate one Locarno class. Moreover, according to a judicial interpretation issued by the Supreme People's Court, in judging whether a product infringes a design patent, the following practice should be adopted: where a product of the category same as or

proximate to that of the product incorporating the design patent uses a design identical or similar to the patented design, the courts shall determine that the design alleged for infringement falls within the scope of protection of design patent. Category may be determined by various factors including Locarno classification, the actual use of the product, the function of the product, and so on. For example, if an icon for human computer interaction shown on a computer screen when the computer is powered on is the subject matter of a design patent and the same icon is used on a chair, it is very hard for infringement of the design patent to be found. The icon may be protected by other types of IP rights, such as copyright or trademark.

All in all, design patent protection for GUIs have been evolving and it is reasonable to believe more positive changes will be brought to Chinese design practice which will make Chinese design patents more effective for protecting GUIs.

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