

## **Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications**

**Forty-Sixth Session**  
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**PROPOSAL BY THE AFRICAN GROUP FOR A STUDY ON THE IMPACT OF DESIGN  
PROTECTION FOR GRAPHICAL USER INTERFACE (GUI) DESIGNS ON  
INNOVATION**

*Document prepared by the Secretariat*

In a communication dated November 4, 2022, the Delegation of Algeria on behalf of the African Group transmitted to the International Bureau of the World Intellectual Property Organization the proposal contained in the Annex to the present document.

[Annex follows]

## **PROPOSAL BY THE AFRICAN GROUP FOR A STUDY ON THE IMPACT OF DESIGN PROTECTION FOR GRAPHICAL USER INTERFACE (GUI) DESIGNS ON INNOVATION**

The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) has undertaken exploratory discussions on industrial design protection for new design technological designs, including Graphical User interfaces, Typefaces, type fonts/icons since its Thirty-fifth session in 2016.

The discussions have largely explored country practices regarding industrial design protection for the new technological designs. At the request of the SCT (35th session) a questionnaire survey and information sessions were conducted exploring the laws and practices of Member States relating to protection of designs on GUIs, icons, typeface/ type font. Discussions have endeavored to elaborate on the formality requirements for protection, the scope, means and extent of protection of, and the implications of the same for IP Offices, utilization of artificial intelligence (AI) in design examination as well as legal protection for designs created by AI.

Member States' responses comments and observations on the questionnaire by the Secretariat suggest a certain degree of convergence of national laws of the respondent countries with regard to recognition of GUIs and typefaces or type fonts for design protection and the formalities requirements for the same. Discussions have also explored questions relating to a proposed departure from the long-established requirement of design right for a link between the GUIs/icons/typeface/type font and the product concerned. Member States' responses to the Second Questionnaire conducted on Graphical User Interface (GUI), Icon and Typeface/Type font Designs, showed that in almost a third of responding jurisdictions a link between a GUI/icon design and an article is required as a prerequisite for registration.

At the 42<sup>nd</sup> session of the SCT, some Member States submitted a proposal for the adoption by the SCT of soft law norms for protection of GUI designs in the form of Joint Recommendation (document SCT/42/6), which could be considered by WIPO Member States when developing, amending or implementing legal and regulatory frameworks or practices for acquisition, maintenance or enforcement of industrial designs.

The Joint Recommendation requires all Parties to provide design protection to GUIs to the same extent as other industrial designs, without any requirement for the GUI to be visible for a period of time or the operating status of the underlying device - making GUIs protectable as designs in themselves rather than as part of a product in which it is placed as an ornamental or aesthetic aspect. It is also proposed to make the GUI design eligible for protection independent of the device in which it is placed and that protection of the design is available against unauthorised use of the GUI design in multiple display environments. It also requires Parties to protect GUI designs for a minimum term under art.17 of the Hague Agreement i.e., for a minimum period of 5 years of initial registration with the possibility of renewal of the protection for another 2 terms of 5 years in contracting Parties to the Hague Agreement. An updated proposal for Joint Recommendation on Industrial Design Protection for Designs for Graphical User Interfaces was presented at the 44<sup>th</sup> session of the SCT (SCT/44/6 REV.4).

These tasks facing the SCT involve balancing a complex set of interests that include safeguarding the interests of industry and responding to industry's concerns over the infringement of design rights over GUIs, while allowing active and sufficient space for innovation.

Over the past years, a number of WIPO Members have introduced provisions into their national laws to protect GUIs. The SCT would benefit from a better understanding of the scope of these laws, the nature and effectiveness of their implementation, and their quantifiable impacts.

Given the lack of sufficient analysis of the implications of extending design protection to GUIs for developing countries and LDCs, the SCT should thoroughly consider the implications of the same for their emerging software and information technology industries. It is a requirement of the WIPO Development Agenda Recommendation 15 that any norm setting initiative in WIPO be informed by a cost-benefit analysis of its implications for all member States, taking into account the differences in their levels of development.

Innovation by local firms through using or adapting existing technologies can have a significant impact in improving the firms' technological capabilities or other forms of learning by doing, or broader spill-overs in the economy. This is critical to the "catching up" process of developing countries with developed economies.

This proposal aims to build upon the body of work developed in the WIPO (in particular the SCT) and gather further information that will provide the SCT with a better understanding of existing systems for protecting GUIs. The proposal includes questions relating to the nature of these systems, the extent to which countries have implemented and enforced such laws and regulations, examples of how such laws and regulations have been applied, any quantifiable or other benefits that have been derived from these laws and any exceptions and limitations that may apply.

With this in mind, we propose that the WIPO secretariat should undertake a study on the impact of GUI design protection in the development of GUI design innovation in countries that extend such protection, considering the various legal means for GUI design protection, factoring in other policy measures that support the development of this sector, and whether GUI design protection can have a similar impact in developing countries and LDCs where such other factors may be absent. The study should address the following issues:

- 1) What are the various legal means for GUI design protection, in accordance with the TRIPS Agreement?
- 2) What are the trends in GUI design protection among WIPO Member States especially developing countries and LDCs? What data is available and what is missing?
- 3) To what extent has design protection for GUIs facilitated GUI design innovation? What's would be the impact of protection on access to and diffusion of technological products in developing countries and LDCs?
- 4) Whether such innovation had and would have happened regardless of design protection? Are there unintended impacts?
- 5) What is the value addition of design protection for GUIs for established technology firms vis a vis startups from developing countries and LMICs, in the context of other cost effective forms of IP protection such as copyright protection of GUI?
- 6) What are the flexibilities contained in Member States legal framework applied to GUI design including those set forth in the TRIPS Agreement?
- 7) The criteria for the determination of infringement of GUI designs and the determination of damages due to infringement. It would be important to receive concrete examples of cases to see how judiciaries in selected countries determine cases of infringement of these rights.

[End of Annex and of document]