



Graphical User Interface & Get-up protection with the EUIPO

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Studio Torta was founded in 1879.

For almost a century and a half the firm has supported its national and overseas clients in protecting their intellectual property across Europe and the world, with a total of nearly 200 professionals and staff and 6 offices.

We are registered as an observing member of the Japan Intellectual Property Association (JIPA) more than 15 years and have long relationship with the Japanese clients.

Our services cover patent, trademark, design and other IP related matters, from filing to registration. We also handle enforcement of rights and IP disputes.



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The Graphical User Interface protection (GUI)

Trademarks?



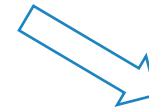
Design?



Copyright?



Patents?



I. The legal framework - DESIGN



Designs of **display screens and icons, graphic user interfaces and other kinds of visible elements of a computer program** are eligible for registration (see Class 14-04 of the Locarno Classification).

Classification

► 14 Recording, telecommunication or data processing equipment



Class ▲	Subclass ◆	My List	Term
14	04	<input type="checkbox"/>	icons
14	04	<input type="checkbox"/>	icons [for computers]
14	04	<input type="checkbox"/>	icons for display screens
14	04	<input type="checkbox"/>	Mobile phone icons
14	04	<input type="checkbox"/>	Screen displays and icons



It must be **new**, and



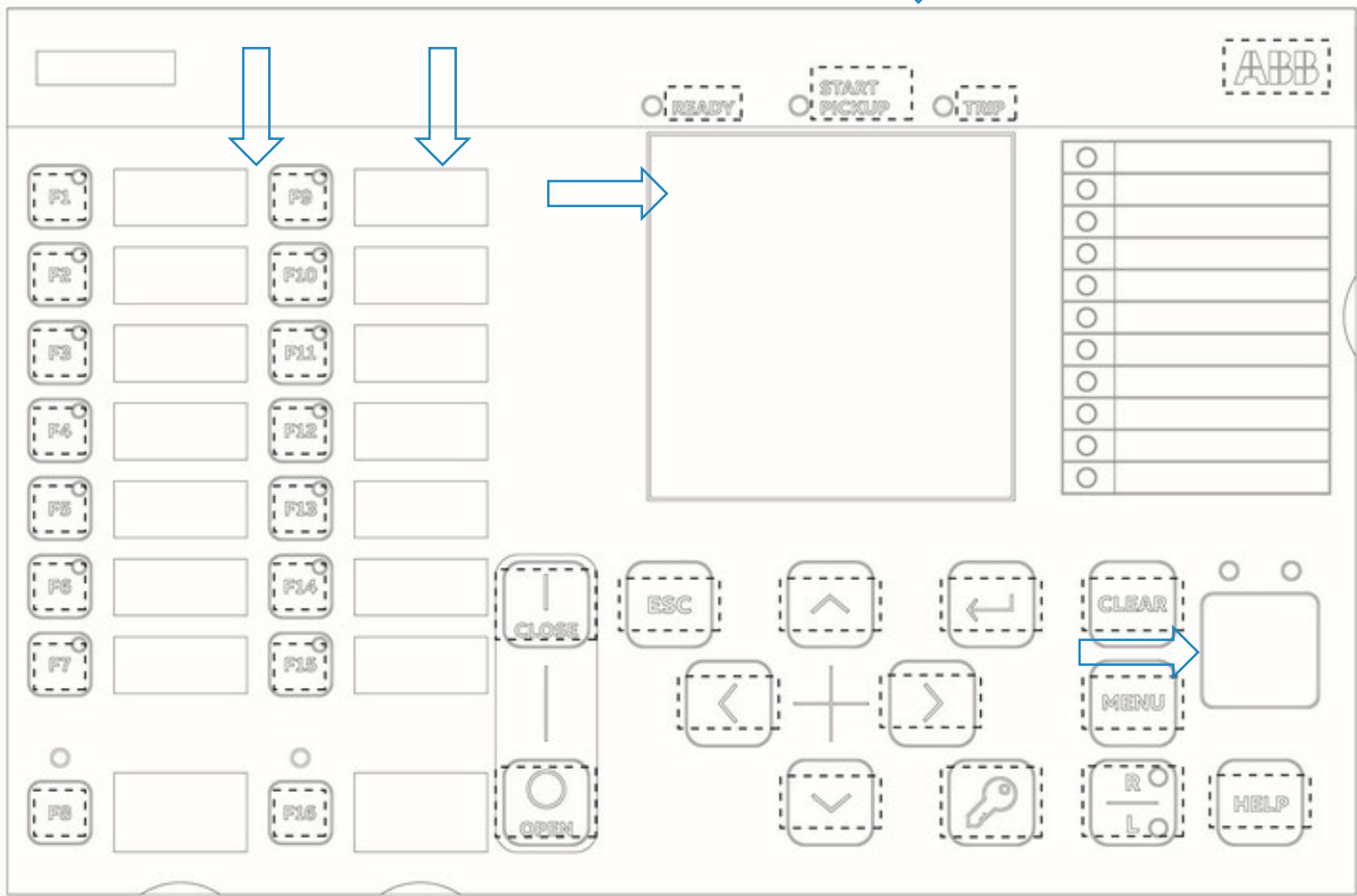
It must be provided with **individual character**

II. Acceptable representation 1/3



a) Static GUI: dotted lined

Example: RCD n. 005800406-0004 (ABB Schweiz AG) – 2018



The scope of protection is defined by the overall appearance of the GUI layout without any specific protection on the appearance or position of each icon

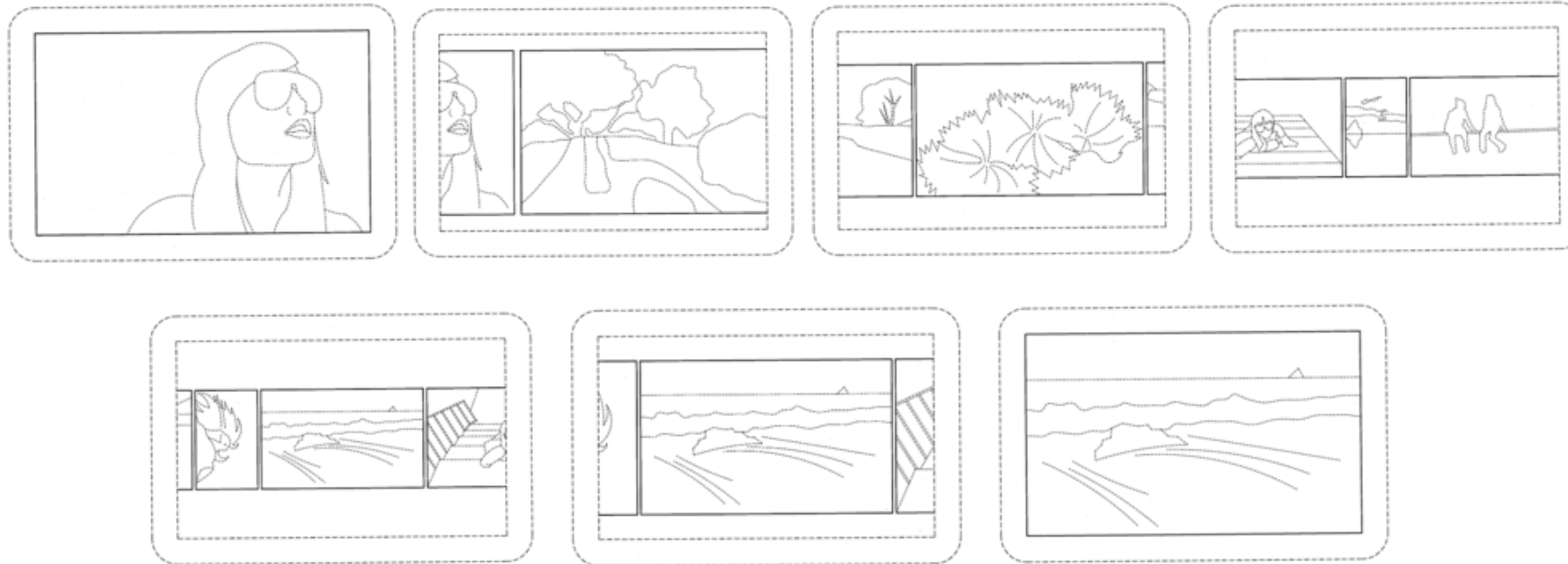
Arrows have been added for explanation purposes

II. Acceptable representation 2/3



b) Moving GUI: sequence of snapshots – All views need to be **visually related**, they must have at least one feature in common and be ordered to give a clear perception of the movement/progression.

Example: RCD n. 1840737-0001 (HTC) – 24.03.2011



II. Acceptable representation 3/3



b) Animated icon: sequence of snapshots – All views need to be visually related, they must have at least one feature in common.

Example: RCD 000589346-0001 (The Lil' Panda Company) – 03.04.2007

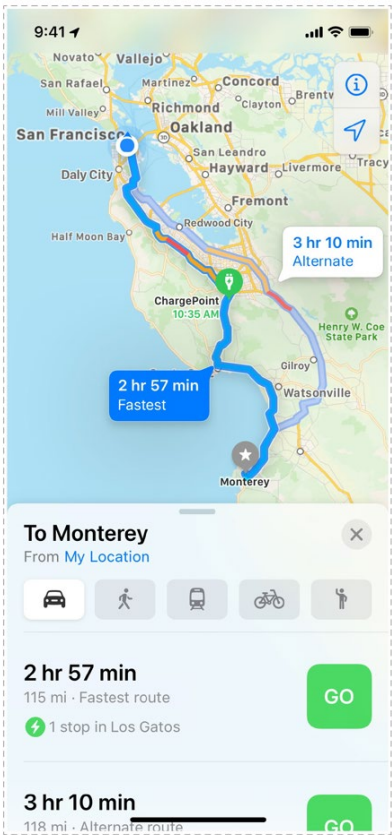


Example

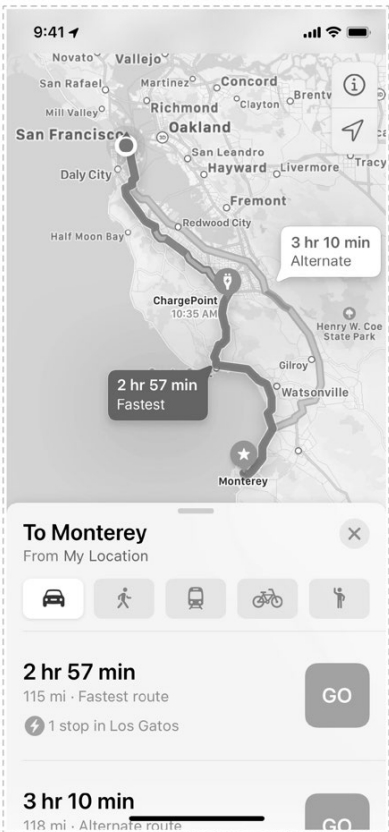


RCD 008354245 (APPLE) – 21.12.2020 Title: Graphical user interfaces (part of –)

DESIGN 1



DESIGN 2



DESIGN 3



DESIGN 4



III. The representation matters

BOA R-1948/2015-3 against RCD n. 2216416-0049



Design Holder: King



Contested RCD

Invalidity Applicant: TeamLava LLC

Prior art



D1

D2

D3

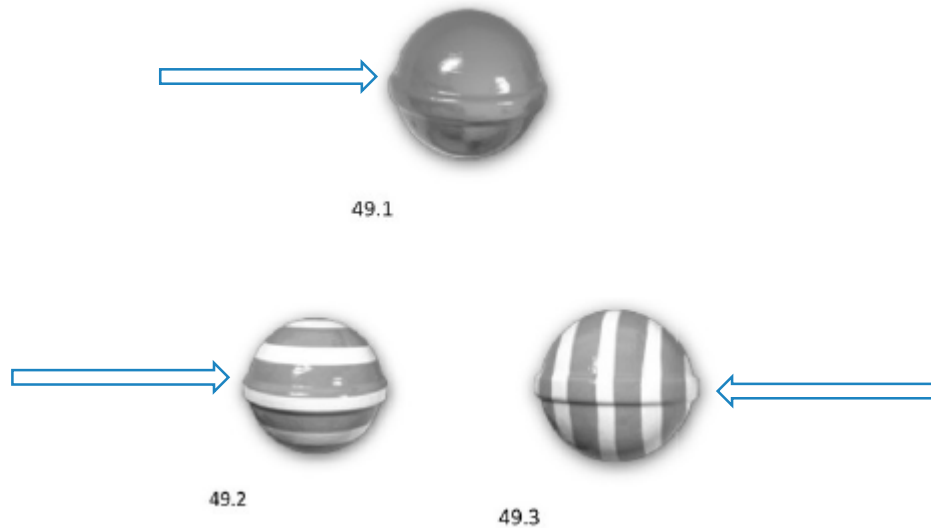
The assessment - INDIVIDUAL CHARACTER in the GUI sector



- **The product:** computer icons in the form of items of confectionery in the RCD and prior designs consisting of real individual items of confectionery.
- **Informed user:** person who uses computer icons when playing computer games or running other types of computer programs on his computer, smartphone or tablet.
- **Freedom of the designer** (i.e. analysis of constraints) design freedom with regard to computer icons is limited to the extent that such icons must be able to be represented on a computer screen and that icons are generally of limited sizes – i.e. wide freedom of the designer for shape pattern and colouring.



The BOA decision:



D3



D2

The representation does not reveal any animation in a clearly understandable progression. Design assessment is based on three views, each showing a different appearance of the same ball shape, seen in succession and not with the progression.

The representation is paramount.



Common features:

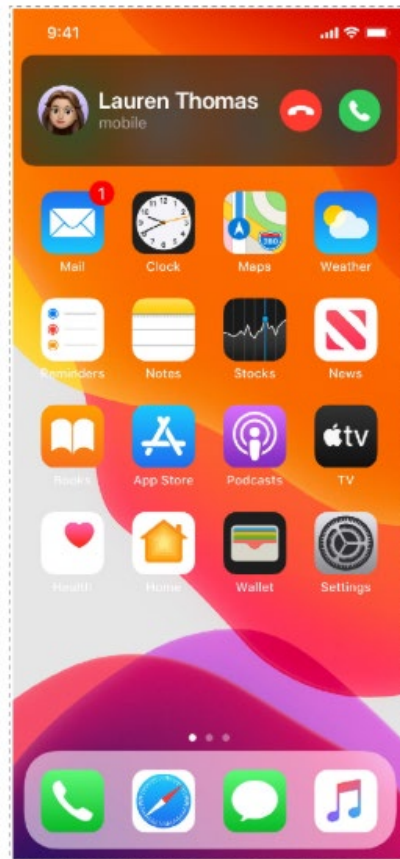
- the balls coincide in the shape,
- they coincide in stripes,
- the feature of the circumferential ring, which is moreover not very pronounced, is not sufficient to produce a different overall impression

IV. A tricky question – RCD 008329353 (APPLE) – 17.12.2020

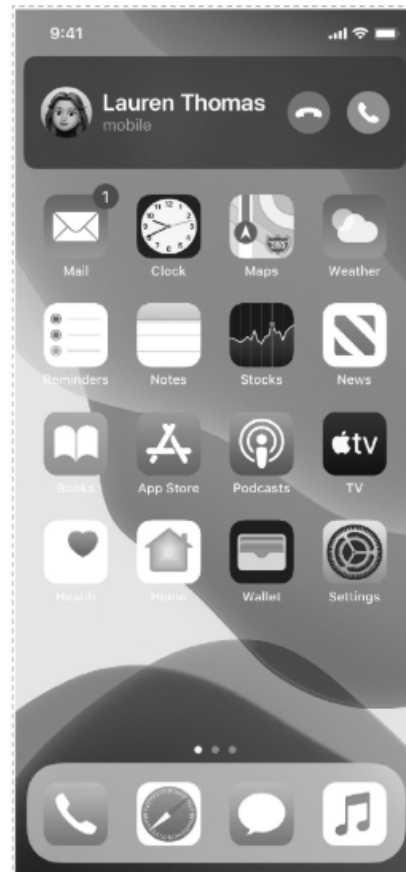


Title: Graphical user interfaces (part of –)

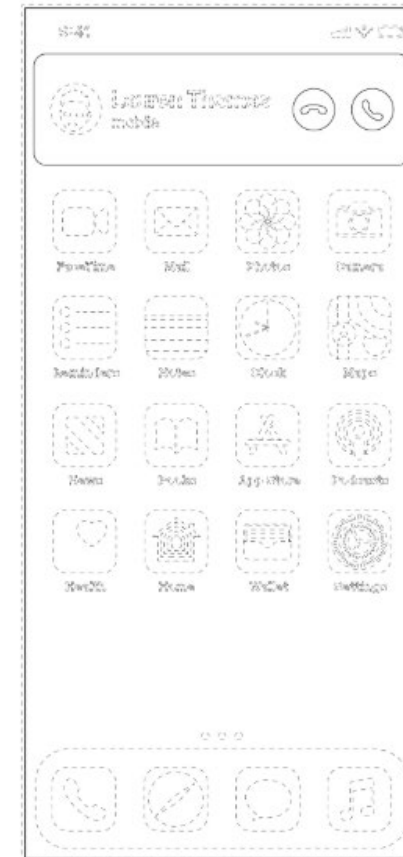
DESIGN 1



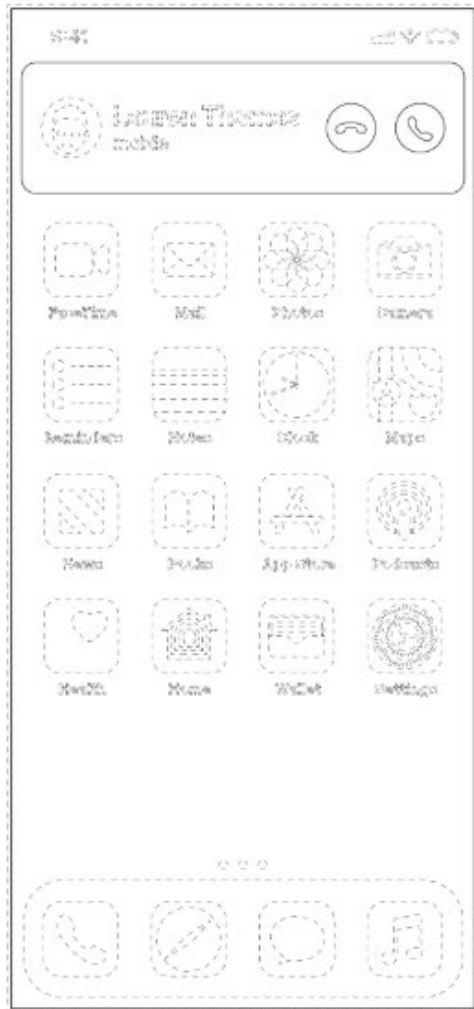
DESIGN 2



DESIGN 3



IV. A tricky question... 1/3

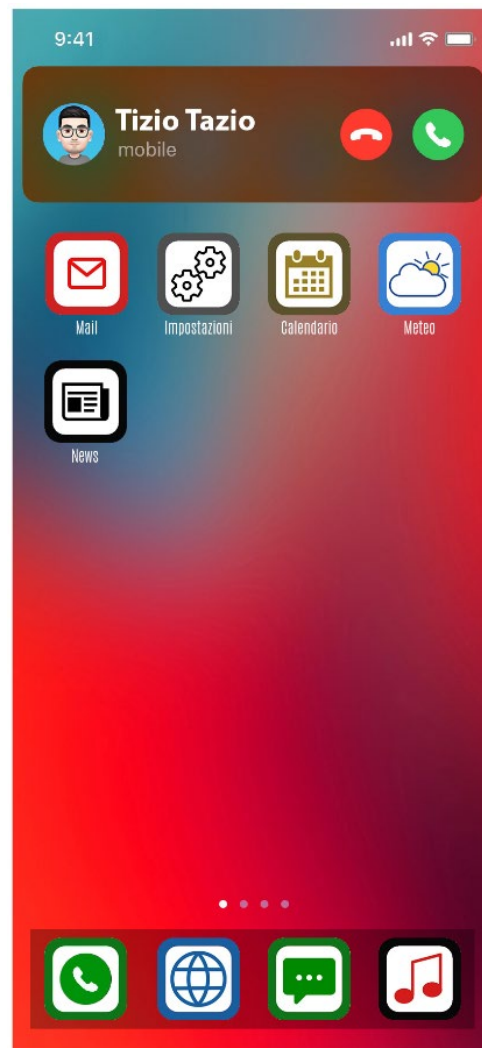
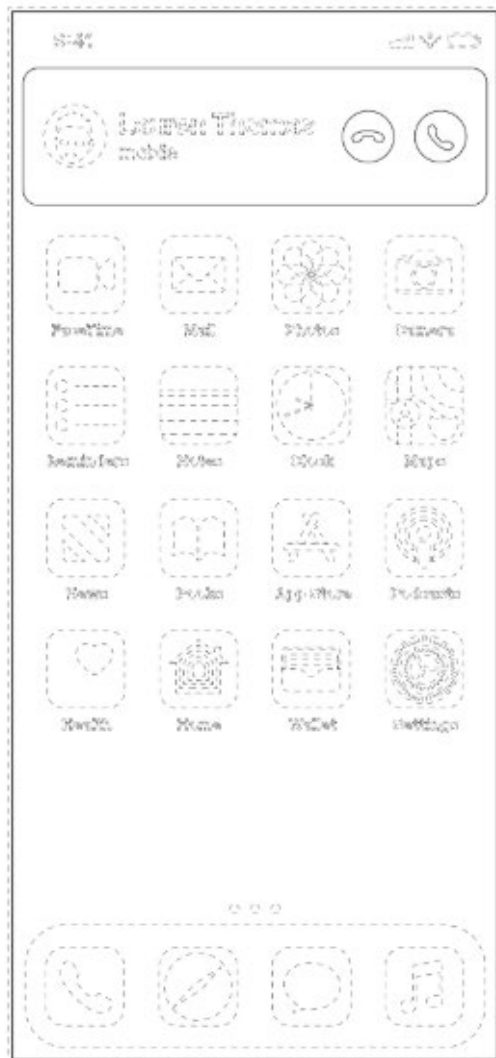


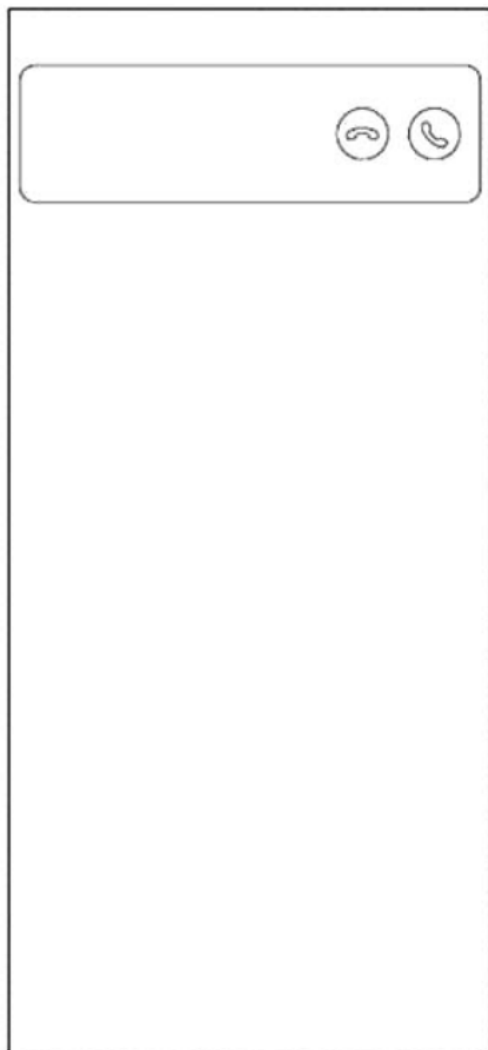
If the dotted lines should not be taken into consideration for the assessment of the infringement



IS the design on the left **EQUIVALENT** to the design on the right in which all the dotted parts have been cancelled?



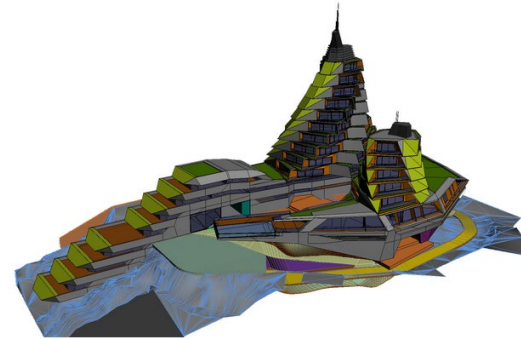






The get-ups protection

Trademarks?



Design ?



Copyright?



Patents?

I. The legal framework – DESIGN



A ‘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 (Article 3(b) CDR).

Get-ups

Class ^	Subclass ^	My List	Term
32	00	<input type="checkbox"/>	Get-up [arrangement of boat interiors]
32	00	<input type="checkbox"/>	Get-up [arrangement of restaurant interiors]
32	00	<input type="checkbox"/>	Get-up [arrangement of shop interiors]
32	00	<input type="checkbox"/>	Get-up [arrangement of the interior of a room]
32	00	<input type="checkbox"/>	Get-up [arrangement of train interiors]
32	00	<input type="checkbox"/>	Get-up [arrangement of window displays]

Building units and construction elements

Classification

25 Building units and construction elements



It must be **new**, and



It must be provided with **individual character**

II. The Apple store example – iconic buildings

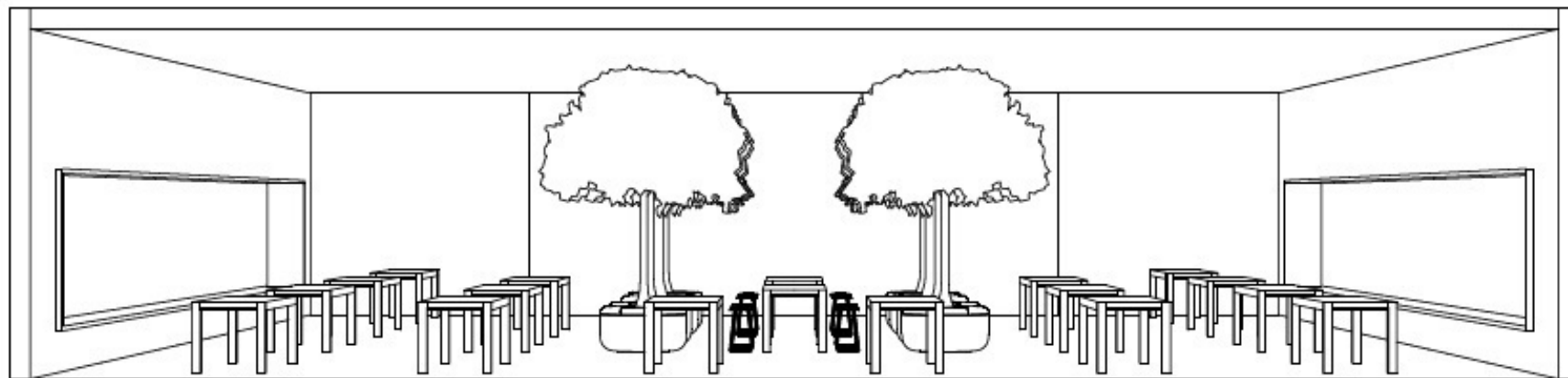


II. The Apple store example



The flagship store

DESIGN 1

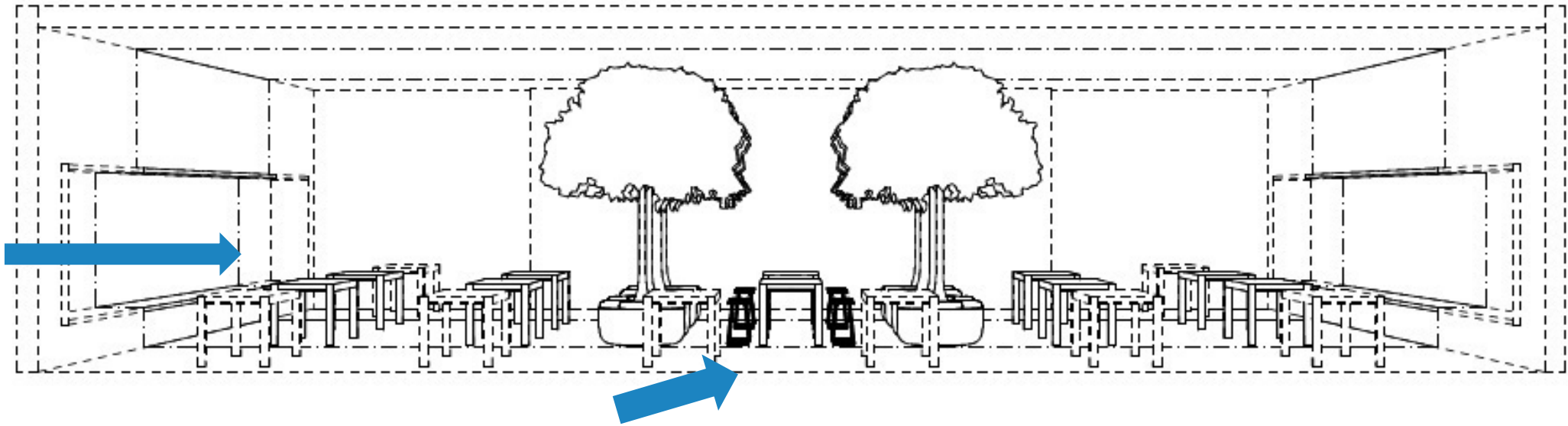


RCD n. 002997007-0001 up to 10 design

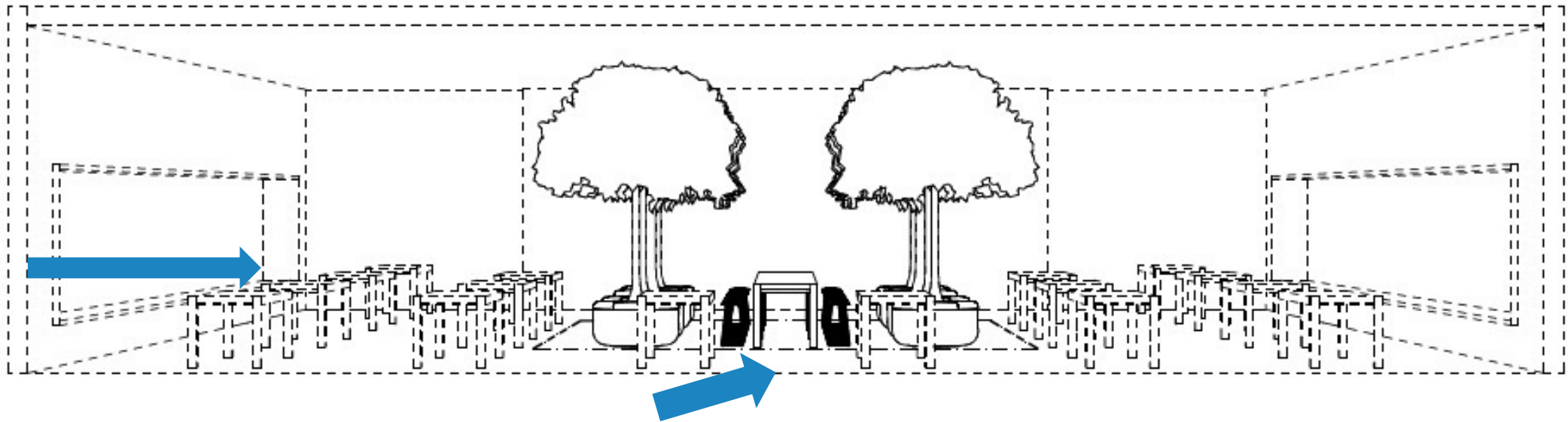
32 – Get-up [arrangement of the interior of a room] (part of –)

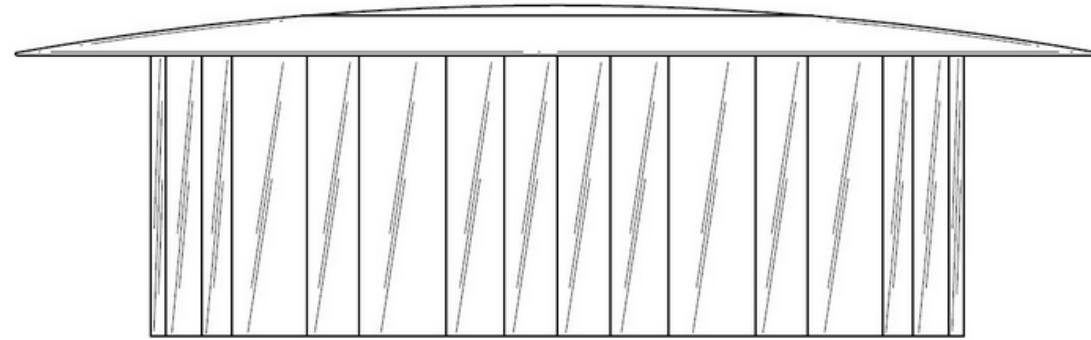


DESIGN 2

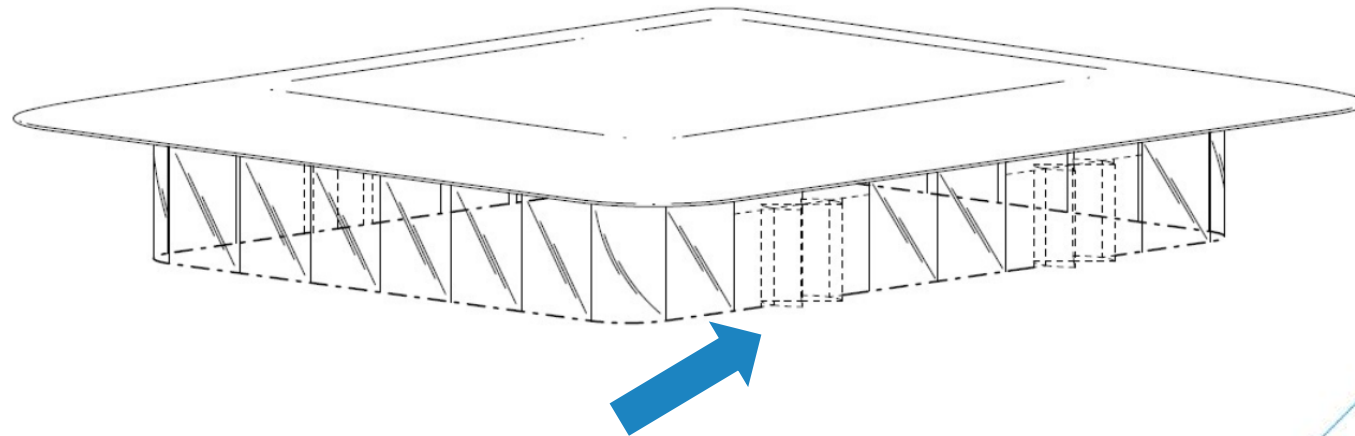


DESIGN 3





RCD 003327295-0001 – Eurolocarno 25.03 Buildings



RCD 003327295-0002 – Eurolocarno 25.03 Building (part of –)

III. The assessment of validity – EUIPO BOA R 2746/2017-3



Design holder: PARFOIS



Contested RCD – 003023381-0002

Class 32 – ornamentation and decorating of shops [shops]

Invalidity Applicant: FABULOUS CIPHER
Prior Art

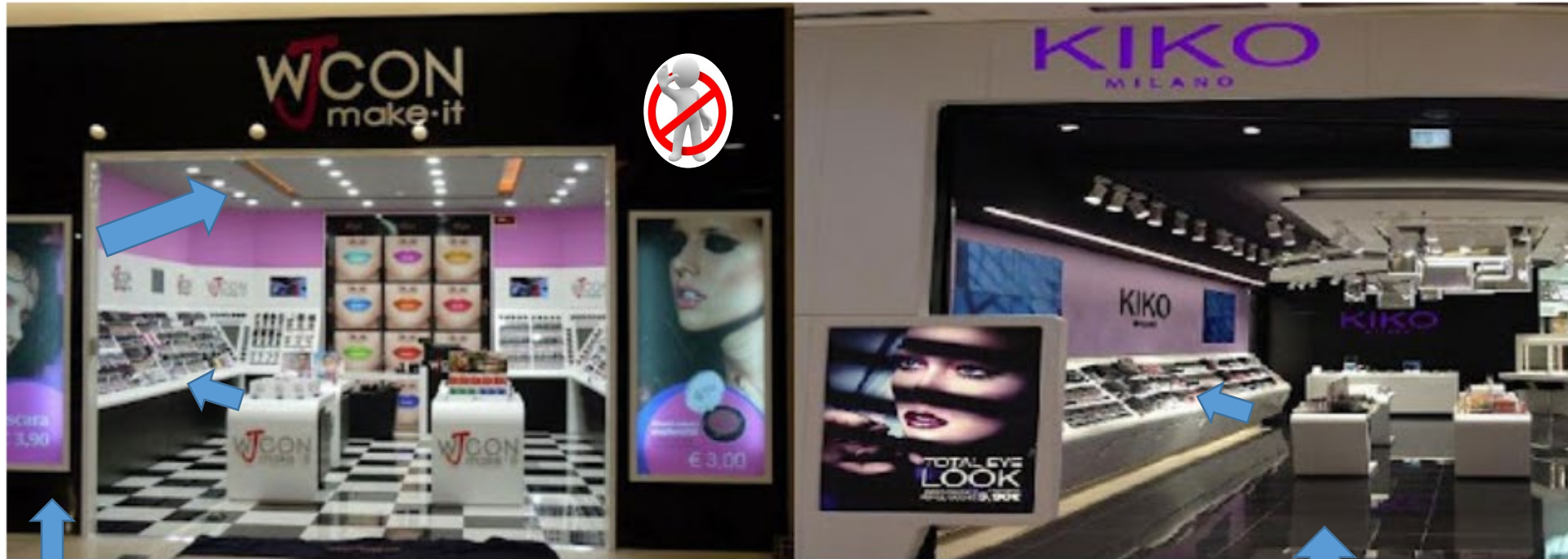


Bottega Veneta

Dissimilar overall impression (and individual character)

- Occupation of space: 3 vs 2 walls shelves on facing walls, different distance, central table size
- Lighting system: Prominent vs smaller

IV. Other available protection – COPYRIGHT ©



The interior furnishing of the two shops at a glance

Italy – Corte di Cassazione, 2020

Work of interior design is eligible for copyright protection provided that the requirements are met -

Sufficient creativity overall due to the choice, combination, coordination and overall conformation of the elements used for furnishing the Kiko shops (in particular colour of the walls, particular lighting effects, constant repetition of decorative elements, use of certain materials, dimensions and proportions)

IV. Other available protection – TRADEMARK



DE application in class 35 for “retail store services featuring computers, computer software, computer peripherals, mobile phones, consumer electronics and related accessories and demonstrations of products relating thereto” based on US registration.

Can the design alone of the layout of the retail store be registered as trademark for services aimed at inducing the consumer to purchase the products (class 35)?

ECJ (2014) ruled that the kind of trademark at issue can be registered not only for the goods themselves but also for the services, where those services do not form an integral part of the offer for sale of the goods. Thus, certain services such as «demonstrations by means of seminars of the products that are displayed» are acceptable.



KIKO shop layout

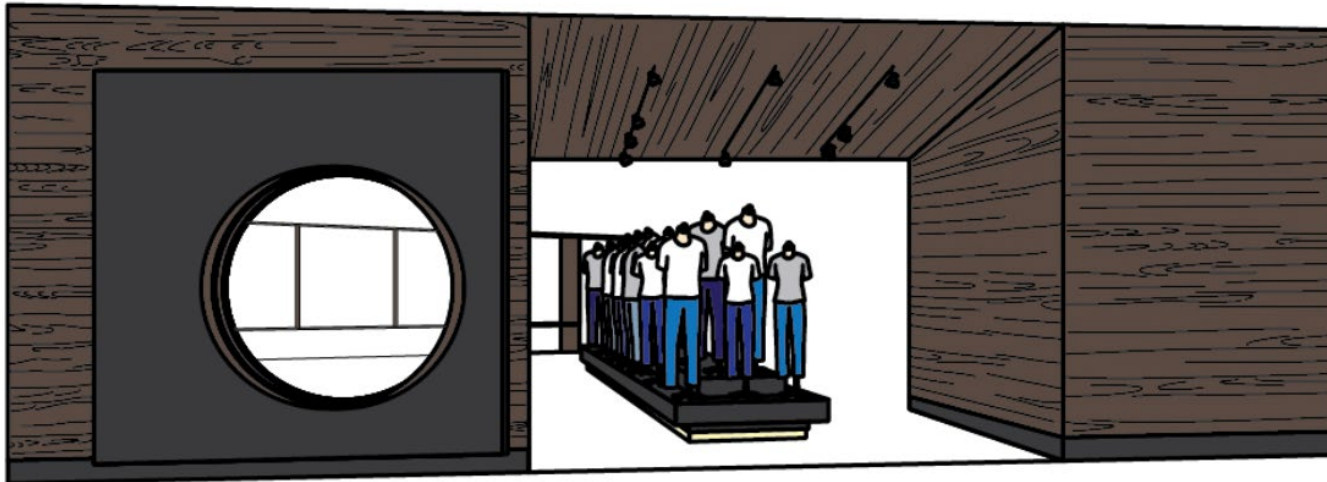
3D EUTM rejected application classes 3, 35, 41, 44 – EUIPO BOA R-1135/2015, 2016

BOA rejected due to common and technical shapes. E.g.:

- all the dominant shapes are squared and rectangular, which are simple geometric shapes and do not fulfil any distinctive feature. Circular lighting are also common in stores.
- The diagonal design of the display allows the consumer to see the products on a plane, offering a compromise to the need of waste of space and allowing the consumer to view the goods.



Some additional examples



Abercrombie & Fitch



Original – A&F prototype

3D EUTM registration n. 017984650, 2019

Class 35 : «Advertising; business management; business administration; office functions; retail store services connected with clothing, footwear.... marketing and promoting goods and brand identity through the use of brand ambassadors and social media»



To be recalled

- The design offer a good opportunity to protect the GUI and the get-ups. Its protection can also be combined with trademarks or copyright to be even stronger. It is an affordable, effective tool offering several possibilities in terms of scope of protection (partial and multiple design);
- A registered design is an IP right **that enjoys presumption of validity** to enforce against counterfeiters, thanks to the EU system, and
- it is an **asset** that add value to the bussiness.



Protect company's investments against third parties

- Exclusive right
- Fixed date
- Presumption of validity
- Fight against counterfeiting (loss of income)



Become a strong player in the market

- Paramount for negotiations, licensing, M&A, merchandising
- Promotion of the brand image



Contribute to obtain market share

Designs can transform a mere product into a brand desired by customers and increase and consolidate market share
A reputed design contribute to your business value



The entrepreneur checklist before the launch of a new product:

- Is this product, or at least a part of it, eligible for design protection?
- Which are the essential features of this new design that differ from the other already existing products?
- Is my company investing in affirming the brand through other signs rather than products design or trademarks (flagship store, furniture etc.)? Is it worth to protect also this kind of commercial tools to have a right easily to be enforced?

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Patents | Trademarks | Designs

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