Graphic User Interfaces (GUIs) Now Eligible for Design Patent Protection in China

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On March 17, 2014, China’s State Intellectual Property Office announced an amendment to its current Guidelines for Patent Examination for design patent protection for graphic user interfaces (GUIs). The amendment includes regulations for both patent prosecution and invalidation and will take effect on May 1, 2014.¹

**Prosecution**

1. **Eligible Subject Matter for GUI-Related Design**

The amendment explicitly states that a product including a GUI or a dynamic GUI (e.g., the graphics shown in the GUI that are animated) can be protected by design patent in China as of May 1, 2014.² By contrast, the current Guidelines for Patent Examination that have been in effect since February 1, 2010 do not protect “the pattern shown when the product is powered on, such as the pattern on the electronic watch display, the pattern on the screen of the mobile phone, software interface, and so on.”³

To be clear, GUIs themselves are not patentable. GUIs may only be patented when incorporated into a product such as a monitor or mobile phone display. But it is unclear how to interpret “product including GUI”; for example, how much of a screen frame of the product should be shown in the design? Would a simple rectangle or a boundary surrounding the GUI be sufficient or would the screen frame need to show additional details such as buttons? Do all sides of the product including the GUI need to be shown?

Applicants may want to submit multiple design embodiments illustrating screen frames in various thicknesses in dashed lines (in line with U.S. practice to show the environmental structure in dashed lines). Further, it may be helpful to include some embodiments with buttons in dashed lines to show a person’s interaction with the product. Although dashed lines are not allowed by Chinese patent law, they can be either deleted or solidified during prosecution. Finally, different views (e.g., sides, back, perspective) of the device should be shown in at least one embodiment.

2. **Ineligible Subject Matter for GUI-Related Design**

Note, though, that there are limitations on what types of GUIs may be registered as designs. Chinese law does not permit design patents on game interfaces, a graphic and text layout of a webpage, and patterns on a display device that are irrelevant to interaction between human and machine or irrelevant to implementing the function of the product, such as a wallpaper of an electronic display or a startup/power-off picture.⁴


Note that if the patentee has a design patent only for a tablet screen with a GUI, a mobile phone with the same GUI may not be infringing since they are different products. Therefore, for different products—for example, a computer, a tablet and a mobile phone which include the same or similar GUIs—the applicants may need to file separate design applications or file a design application that includes embodiments for each of the products, although they may be required to split the embodiments into different design applications if a unity rejection is received.

4. **Views and Brief Description of the Product**

Further, there are specific regulations for prosecution that address the drawing or picture that shows the GUI and the brief description that must be included of the product incorporating the design application. The applicants should submit views of the entire product clearly showing the GUI. And when a GUI includes a dynamic pattern, the applicants should at least submit the overall product design drawing of the GUI in one state. For other states, the applicants may submit views of key frames from which a changing trend of an animation of the GUI can be determined.⁵ The amendment further provides that, when necessary, the brief description for the product including a GUI should describe the usage of the GUI, the region where the GUI is located within the product, the way a human and the GUI interact and/or different animated states of the GUI.

**Invalidation Proceeding**

As for invalidation proceedings, when determining non-obviousness of a design for a product including a GUI (“the design patent at issue”) with respect to a prior design, if all other parts of the design patent at issue belong to common designs,⁶ then the GUI will have a more notable influence on the overall visual effect. In other words, the patentee should focus on the novelty and non-obviousness of the GUI part if other parts of the design patent are not novel or are obvious.⁷

**Infringement**
Further, as the brief description can be used to interpret the design of the product including the GUI,[8] the applicants should be careful in preparing the brief description because the accused infringer may use it against the patentee in an infringement suit. For example, if the patentee specified in the brief description that a human can interact with the product by only clicking buttons or icons, then a product including a GUI using only sliders may be noninfringing. Further, if the patentee specified in the brief description that the GUI is only used on a camera, then a car navigation system including a similar GUI design may not infringe.[9]....

Priority Claim

It is unclear if the applicants can claim priority in a Chinese design to a foreign GUI design filed before May 1, 2014—the revised Guidelines are silent on this point. Nevertheless, according to a State Intellectual Property Office examiner in a design unit, the applicants may claim priority to a foreign application if the prior application shows an embodiment of the entire product (e.g., a frame) either in dashed or solid lines in addition to the GUI. By contrast, if the prior application only shows the GUI and does not show an embodiment of the entire product incorporating the GUI, then the prior application will likely be ineligible for priority.[10]....

Conclusion

The new amendment ushers in a new era for the protection for products including GUIs in China. As a result, many companies will file GUI designs, especially in the field of smartphones, tablets and car navigation systems, that will potentially lead to an increase in patent litigation for previously unprotectable designs. Because China’s courts may issue injunctions in design patent infringement suits, it is possible that the smartphone patent wars featuring GUIs will expand to China as companies seek to prevent the manufacture and sale of competitors’ products in China. As most smartphones are manufactured in China, an injunction against manufacture would have worldwide impact. Further, since China is one of the largest markets by volume for smartphones, an injunction against sale would also have a significant impact on the sellers.

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[6] “Common designs” mean designs that are known to the public before the filing date in China or abroad, Article 23.4 of the Chinese Patent Law.
[9] See Interpretations of the Supreme People’s Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases effective as of 01/01/2010, Article 9: The people’s court shall determine whether or not design products belong to same or similar categories according to the functions of such products. To determine the functions of a product, the international classification of designs, the name and functions of such product as stated in the brief description, and the sales, actual usage, and other factors of the product can be taken into consideration.
[10]Summarized from the author’s discussions with a State Intellectual Property Office examiner in a design unit and with local patent practitioners.

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