Need to Know: Update on Design Protection of GUIs, Icons and Motion Designs

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Overview

- Brief evolution of screen designs
- Why they should not be overlooked
- Dynamics screen designs
- Emerging technology protection
- Update on damages
- Countries differ widely

How Did GUIs Become Patentable in the U.S.?

- Icon design rejected under 35 U.S.C. §171 alleging that it is mere surface ornamentation rather than a design applied to an "article of manufacture"

FIG. 6

- On appeal: Upheld but provided a roadmap for protection: had the original application disclosed a display, the design would be patentable subject matter

- *Ex Parte Strijland*, 26 U.S.P.Q.2d 1259 (USPTO 1992)
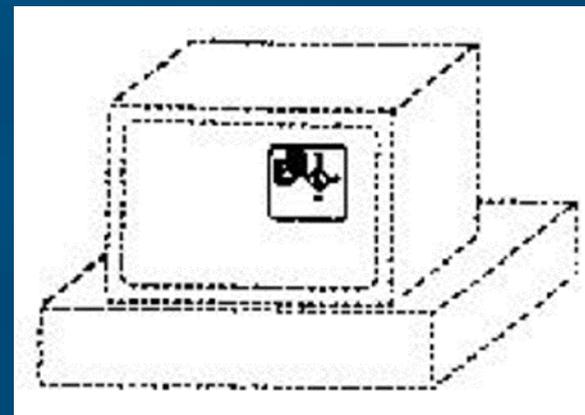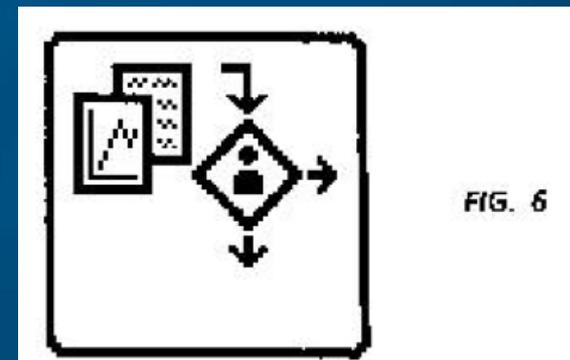
USPTO GUI Design Guidelines

- To be directed to statutory subject matter, design applications for computer-generated icons must comply with the "article of manufacture" requirement of 35 U.S.C. §171

- Because a patentable design is inseparable from the object to which it is applied and cannot exist alone as mere surface ornamentation, an icon must be embodied on a computer screen, monitor or other display panel or portion thereof

- The article of manufacture on which the design is displayed may be shown in broken lines

- MPEP §1504.01(a) Computer-Generated Icons

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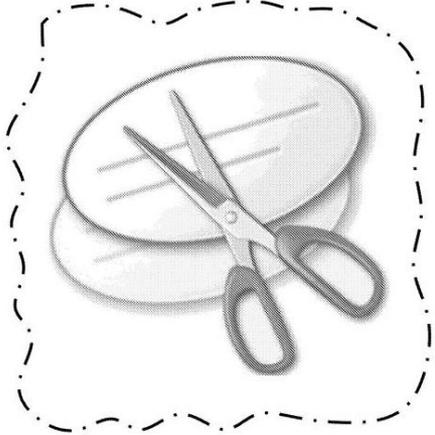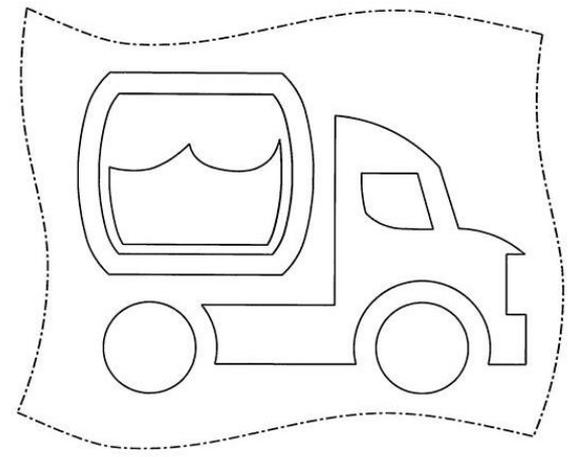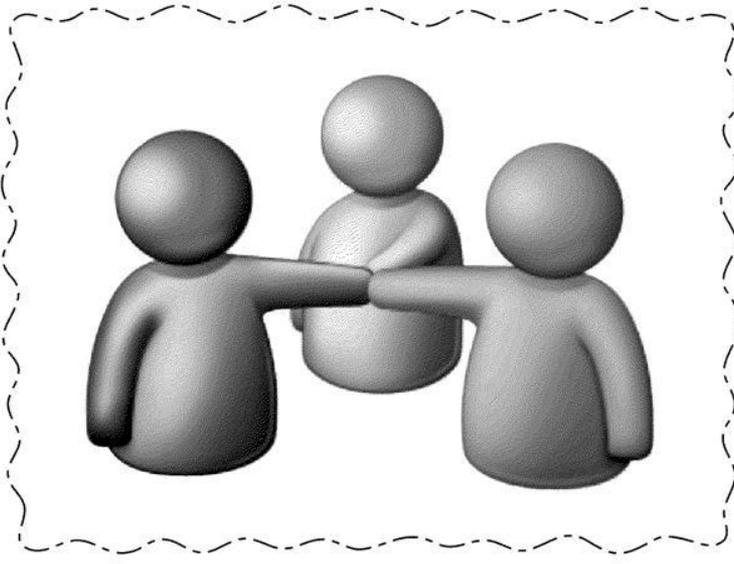
Icon Examples
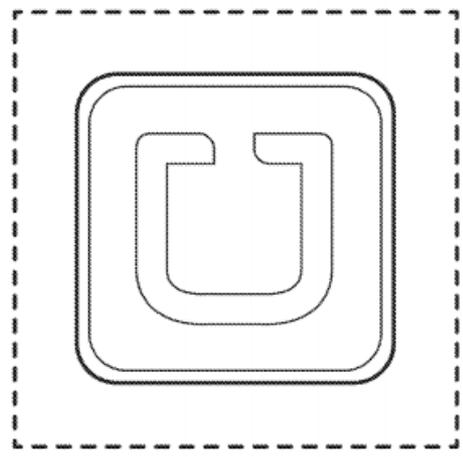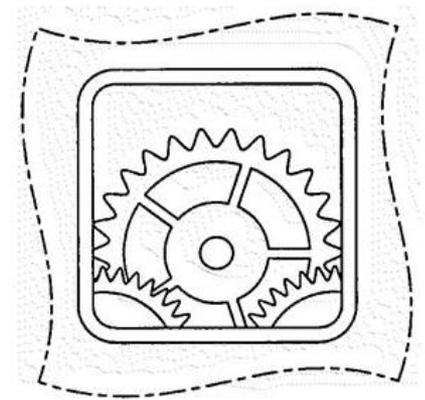
User Interface Example – D704,212 (Apple)

User Interface Example – D738,901 (Uber)
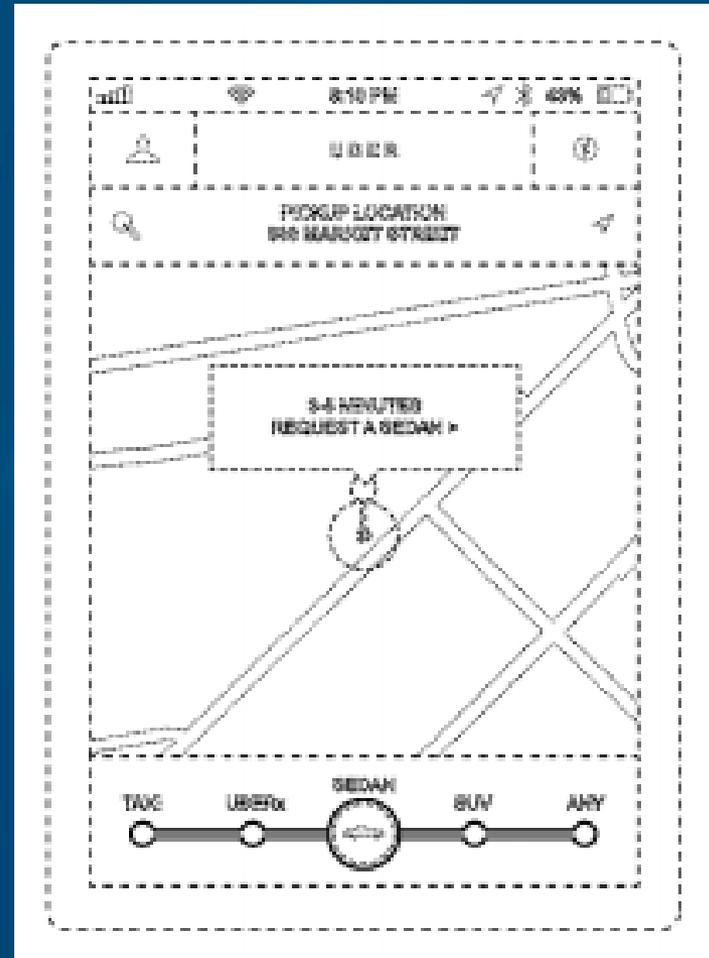
User Interface
Example – D699,259
(Sony)

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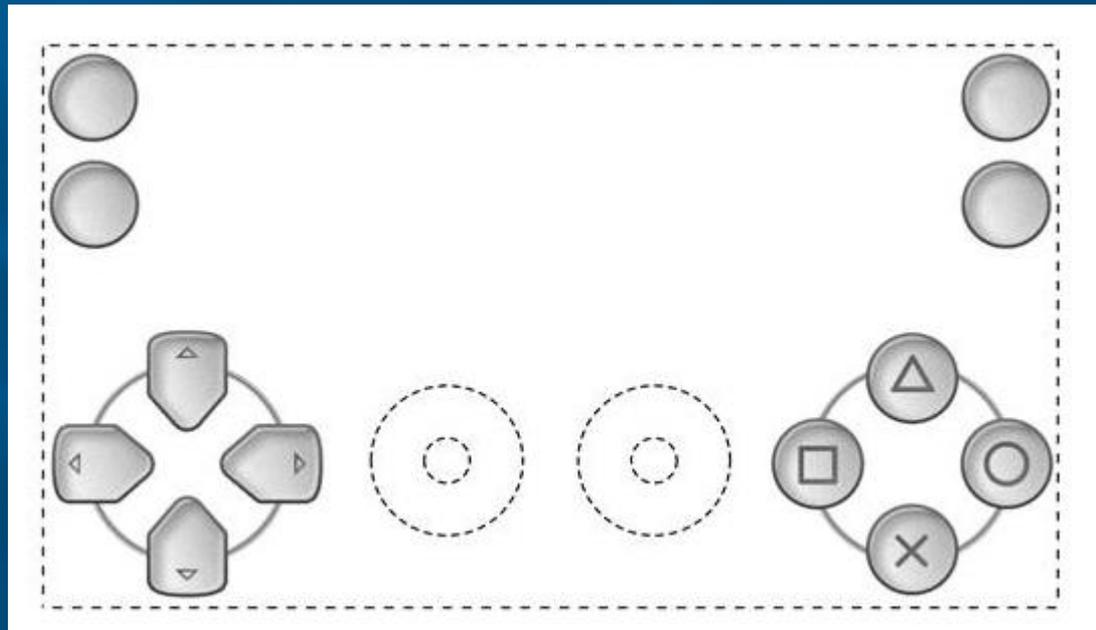
User Interface Example – D725,662 (Samsung)
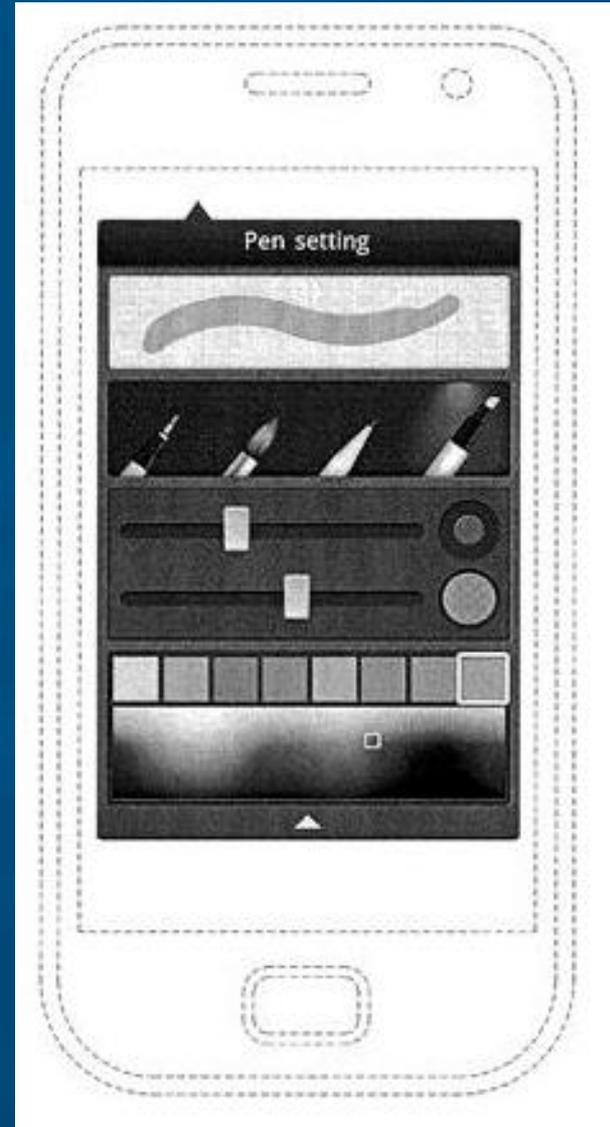
User Interface Example – D714,313 (Microsoft)

FIGURE

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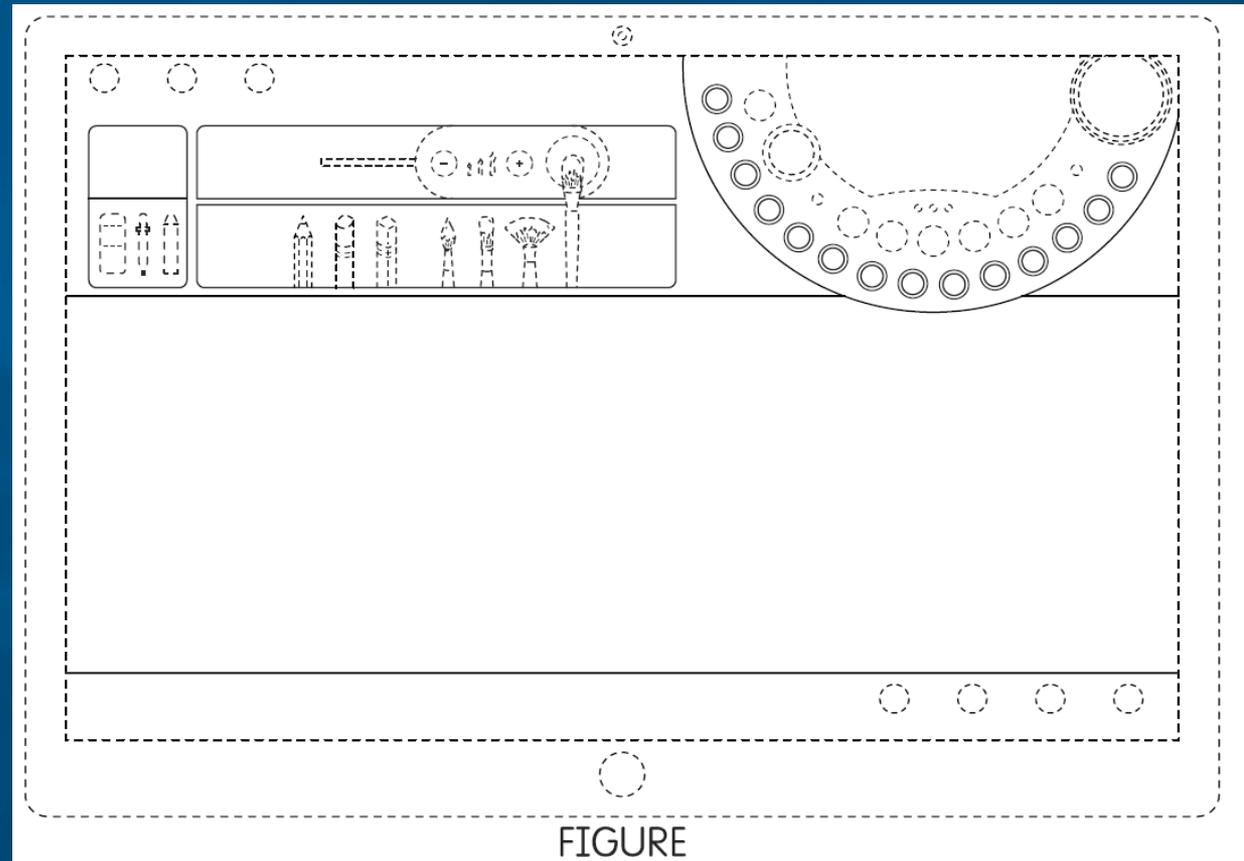
User Interface Example – D723,054 (Nissan)
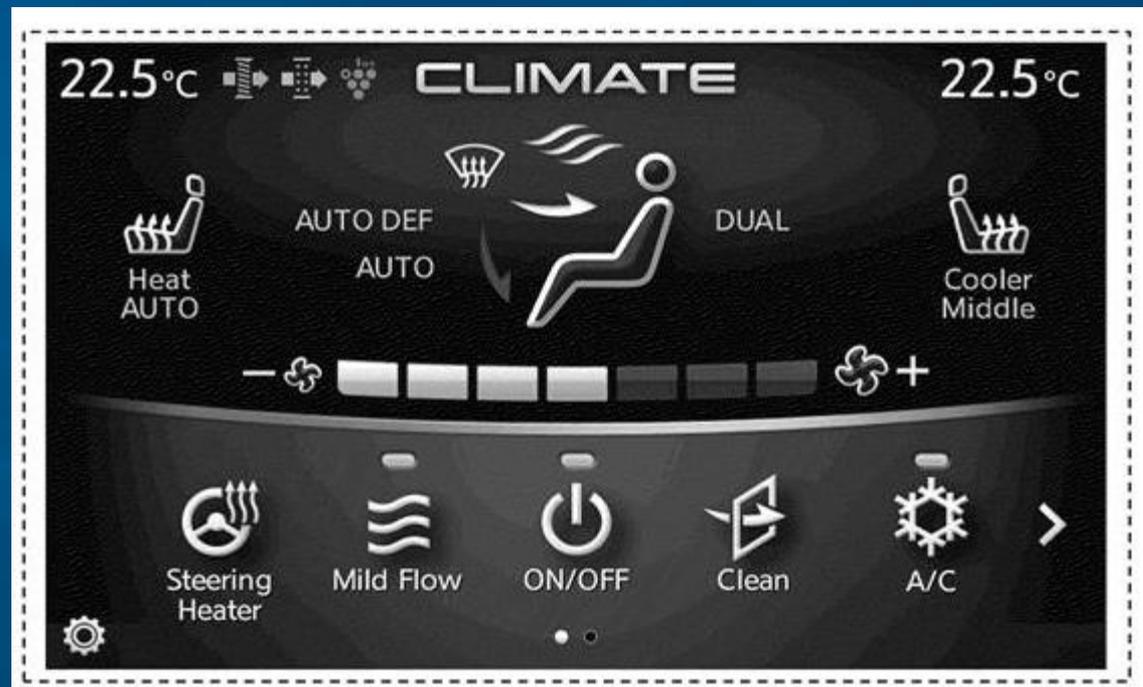
User Interface
Example – D686,222 (Microsoft)
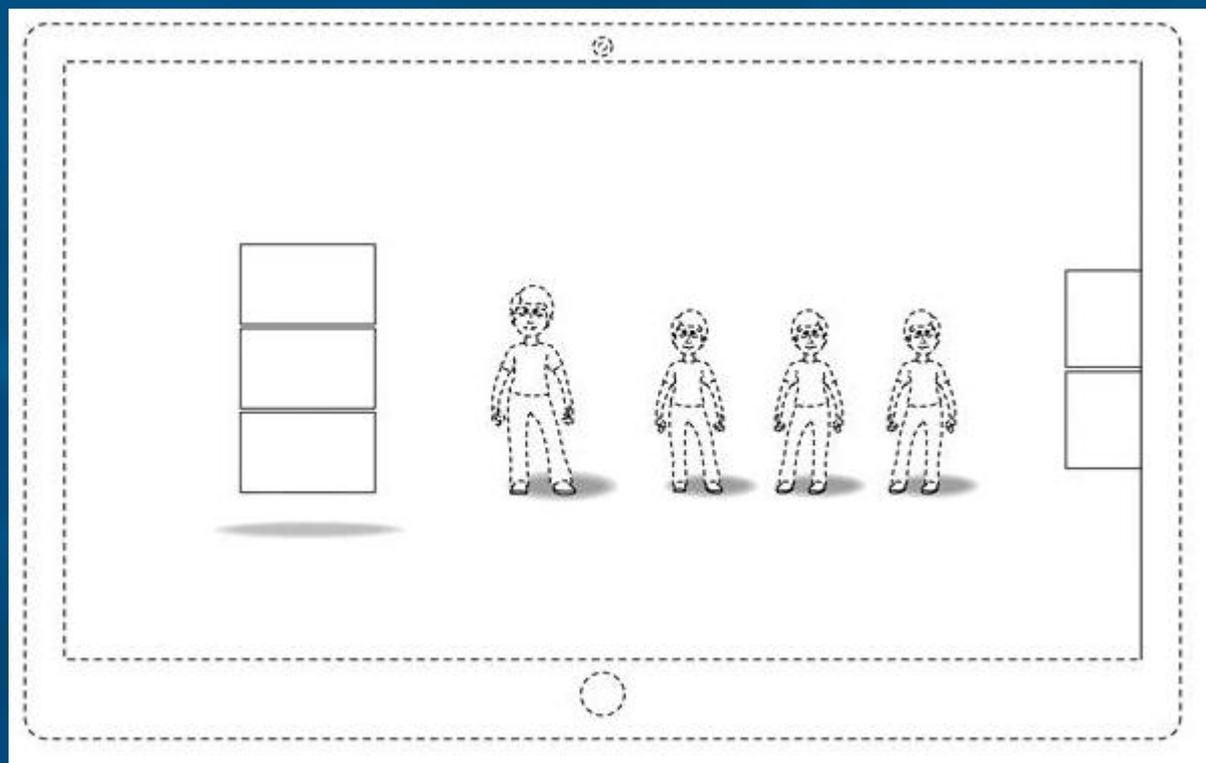
Example GUI – D457,164 (Apple)
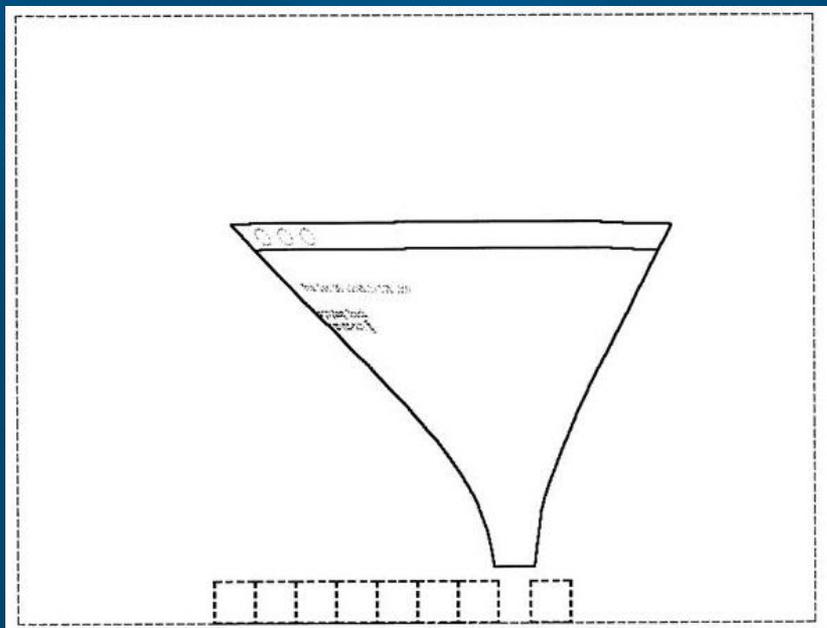
WHY: Display-Based Design Patents

- Reflects the "now" and the "future"
- More things via computers and mobile devices
    - shopping and buying platforms, news, sports, mapping, dining, dating, critiquing, gaming, museums, reality touring, drawing, video/photo editing, watching/listening content, messaging, taxis, social media, financial exchanges, etc.
    - Idea is to provide a great user experience (protecting APPs)
- Connection with source/branding and training
- Virtual Migration
- Internet of Things (more things interconnected)
- May be the only way to protect
- They get copied/simulated

Tinder, Snapchat, and Urbanspoon

Virtual Migration
Part 1

16

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Virtual Migration
Part 2

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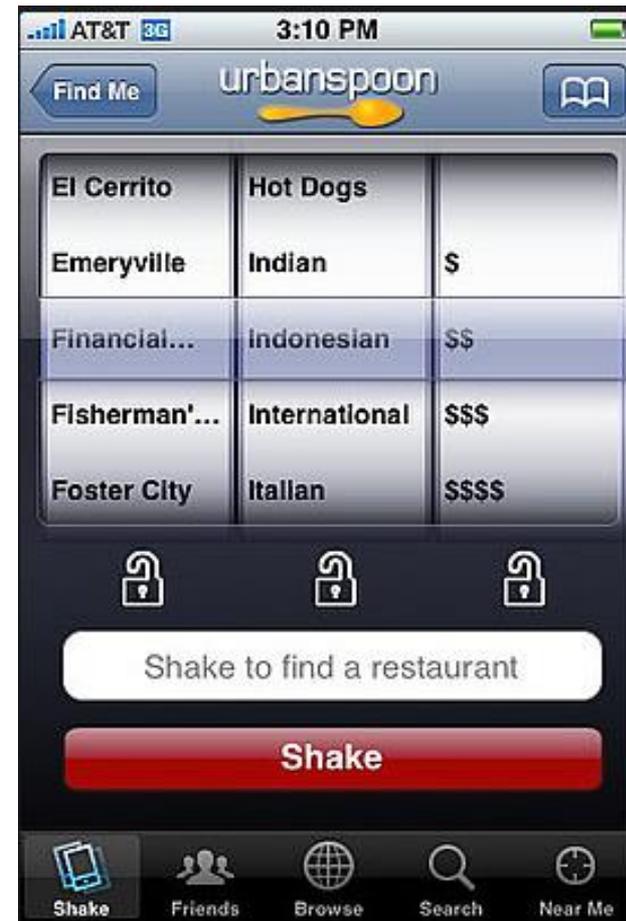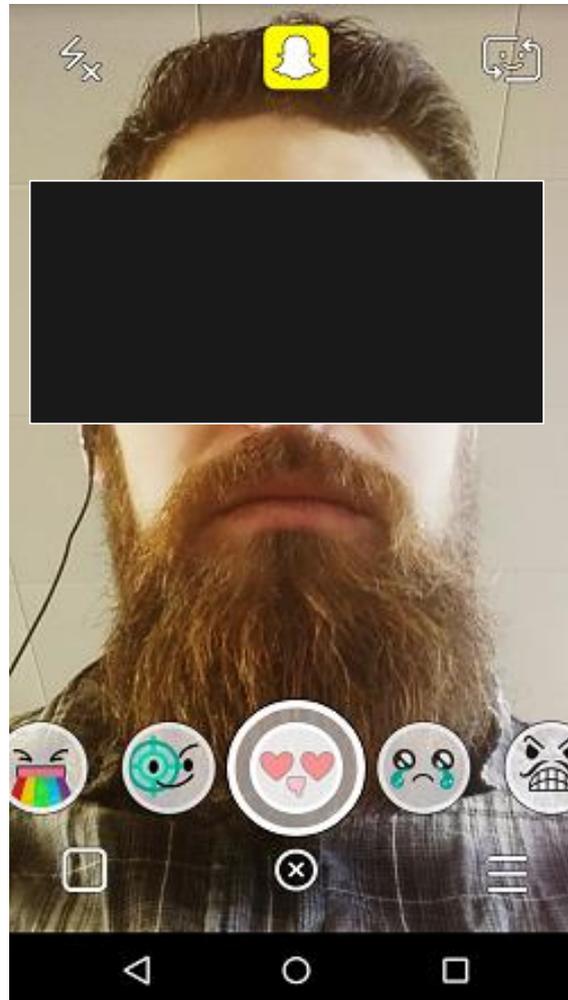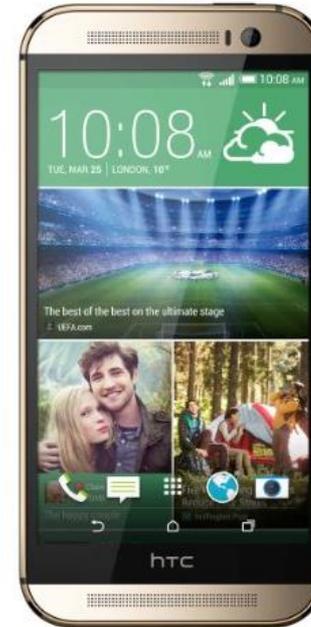
More Categories of Home Controls

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Example of Evolving Design Experiences
Nest Thermostat

Match Group, LLC (Tinder) v. Bumble Trading

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

MATCH GROUP, LLC

    Plaintiff,

v.   Civil Action No. 6:18-cv-00080

BUMBLE TRADING INC.

    Defendant.   **JURY TRIAL DEMANDED**

Lawsuit filed 3/16/2018

United States Patent No. D798,314

Display Screen or Portion Thereof With a Graphical
User Interface of a Mobile Device

FIG. 1

FIG. 2

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Dynamic Screen Designs

- An important part of portfolio if experience includes movement.

- Animations and transitions

- Different scopes/impressions from single static image designs

- Moving screen designs have made up about 20% of total number of screen designs over the last 3 years

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Icons – Static and Animated
Pat. No. D662,945 and D663,317 (NIKE)

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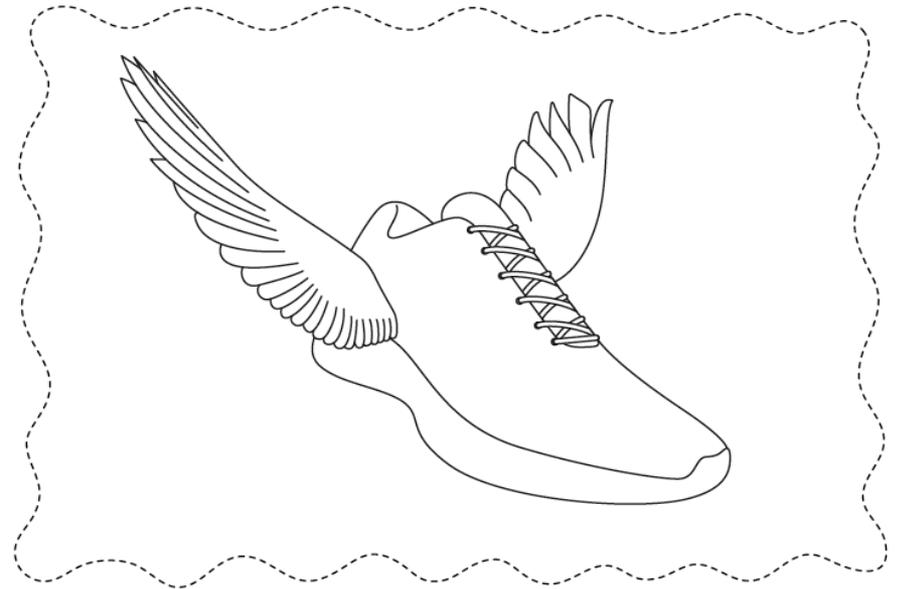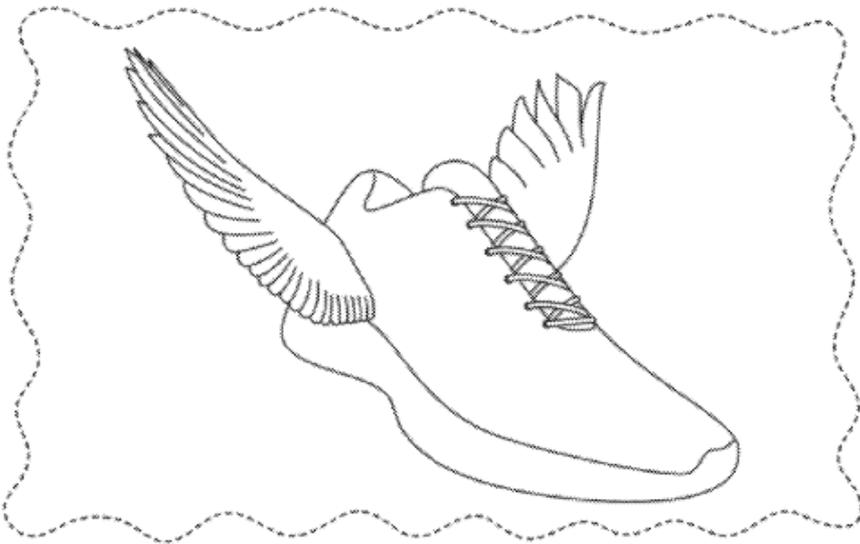
Example Animated GUI D643,850 (Microsoft)
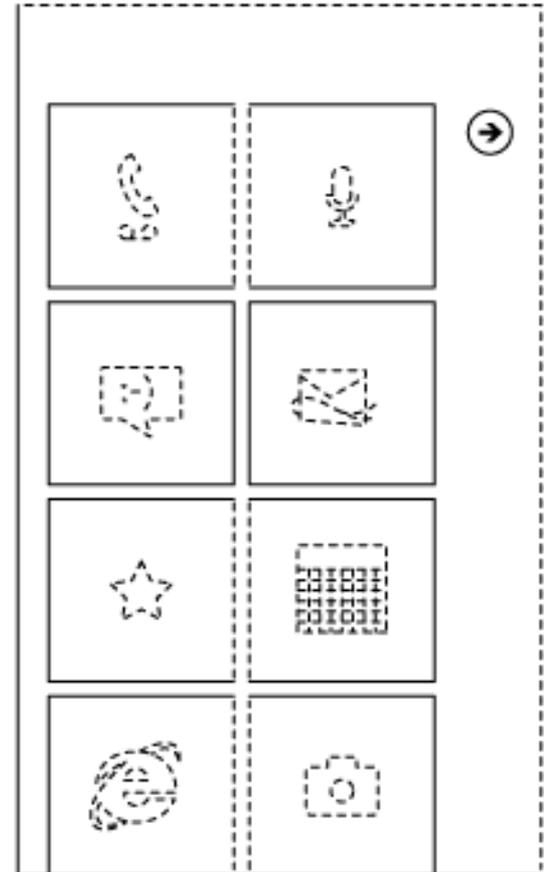
Example Animated GUI
D687,047 (Nest Labs)

FIG. 1

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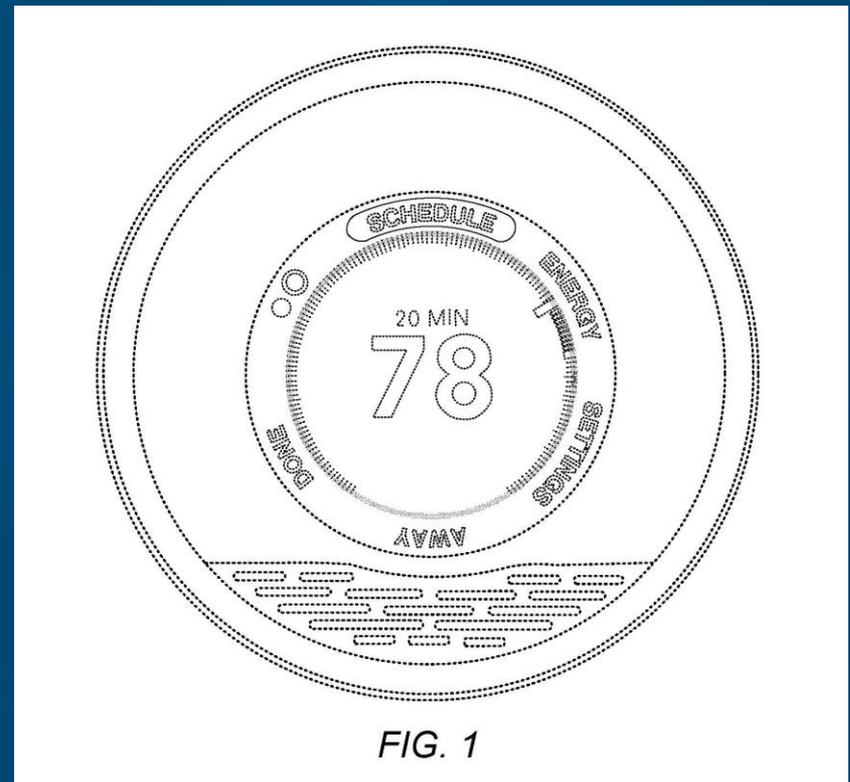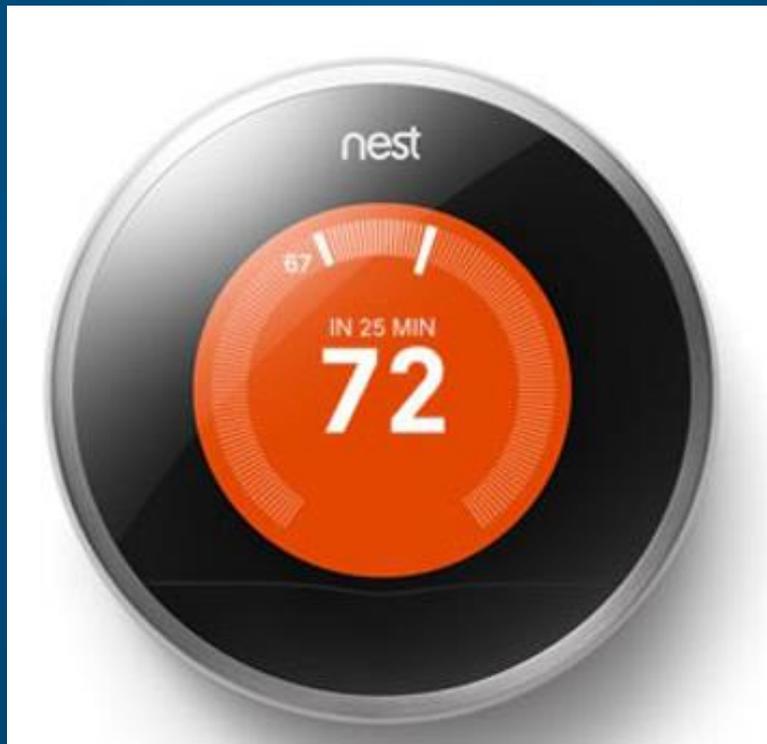
Wait Cursors/Loading Routines/Selectors D656954 and D644,661 (Microsoft)
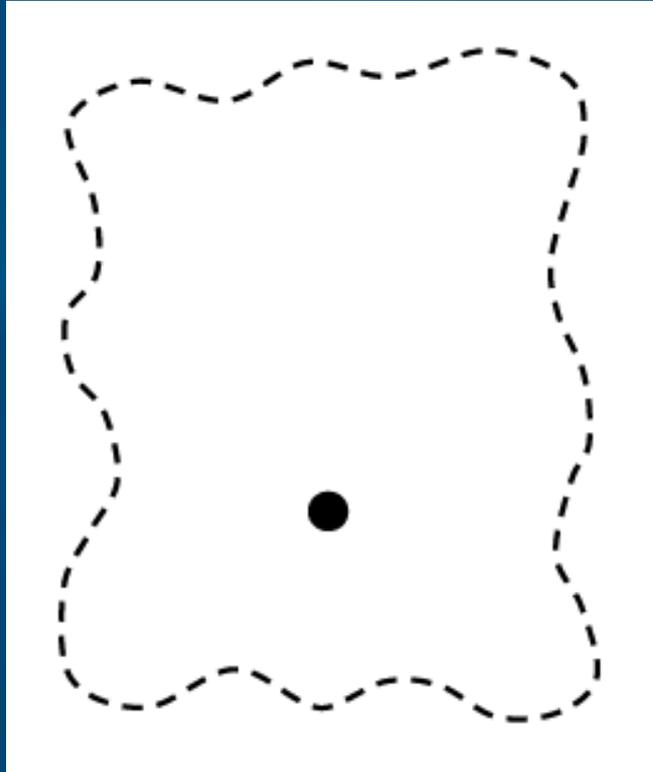
Protecting Future Designs

- What kinds of designs are we starting to see and what will we see in the future?
  - Display surfaces are changing
  - GUIs for virtual and augmented reality
  - Two and three dimensional
  - Projected designs
- "Article of manufacture" requirement in Section 171
- Make new law → tips

AR and VR Become More Mainstream

- VR: is an artificial, computer-generated simulation or recreation of a real life environment or situation. It immerses the user by making them feel like they are experiencing the simulated reality firsthand.

- Replaces your reality with a new one.

- AR: layers computer-generated enhancements atop an existing reality in order to make it more meaningful through the ability to interact with it.

- Takes your current reality and adds to it.

Virtual 3D GUI – US D797,767
Microsoft Corporation
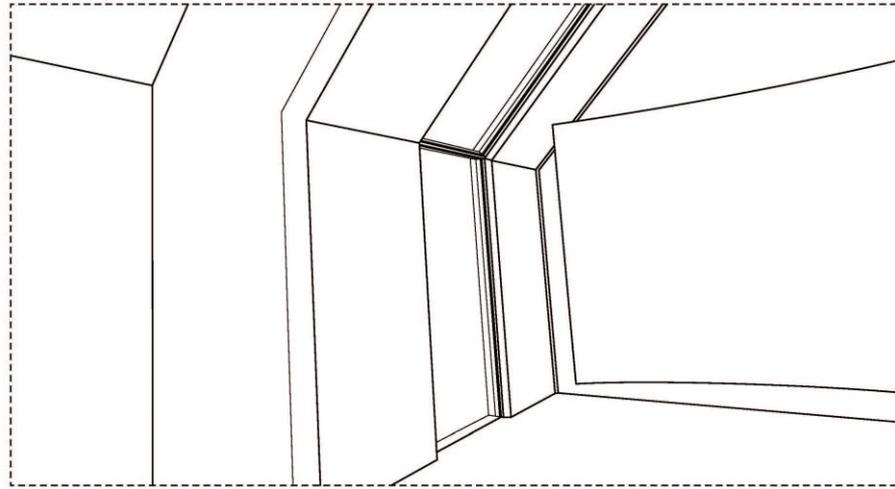
FIG. 1

Virtual 3D GUI – US D797,767
Microsoft Corporation
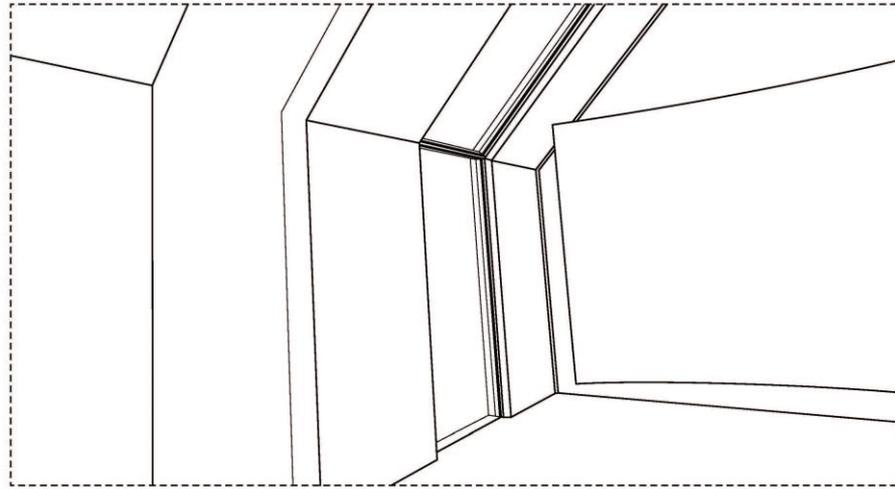
FIG. 1

Projected Designs
Seattle Museum of Pop Culture

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Projected Design– US D609947
Osram Sylvania, Inc.
Tabletop with an Applied Pattern of Projected Light
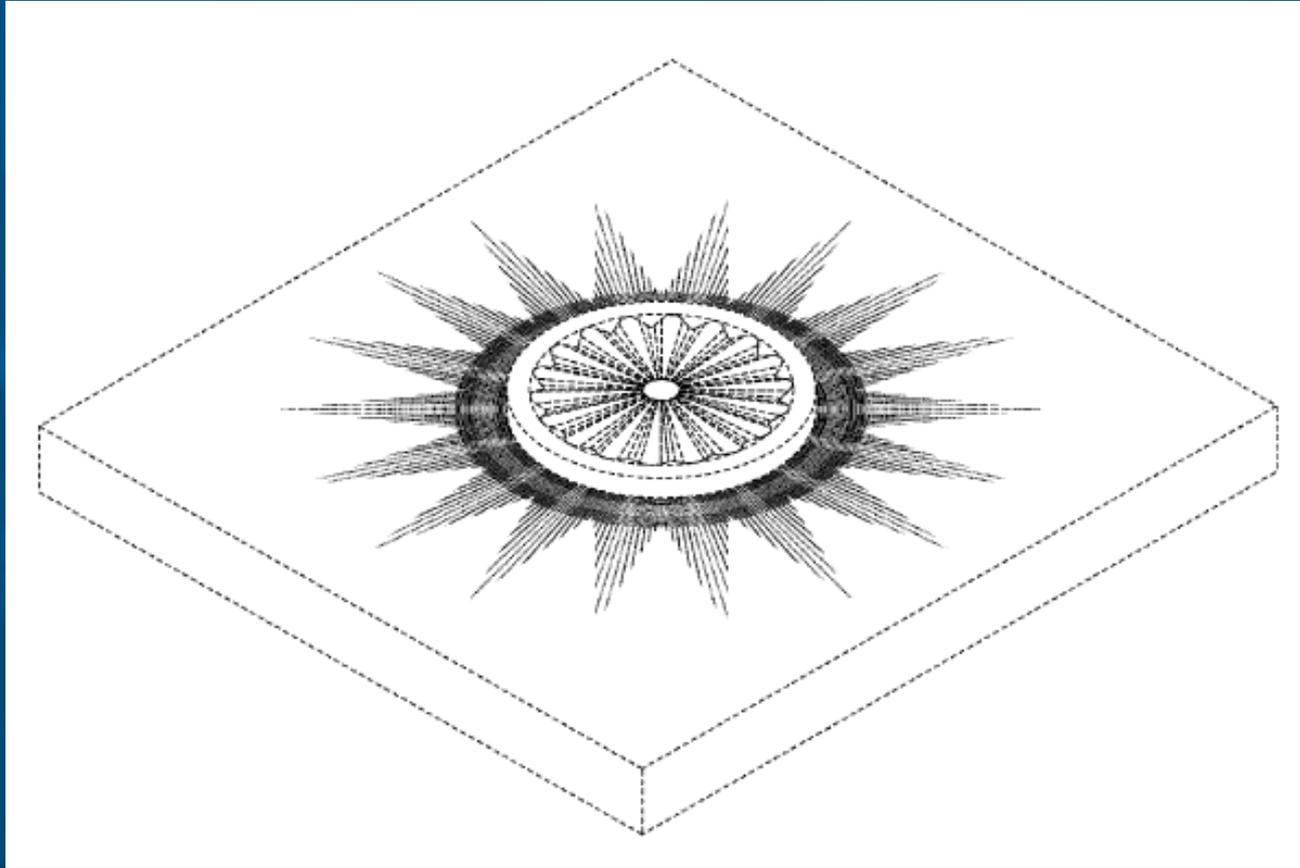
Recent Emerging Issues in Remedies

- How are screen designs doing?
  - good track record
  - 2-0 in law suits
  - 5-0 in design patents

- Both cases include Section 289 damages issues

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Apple v. Samsung

D604,305

Galaxy S

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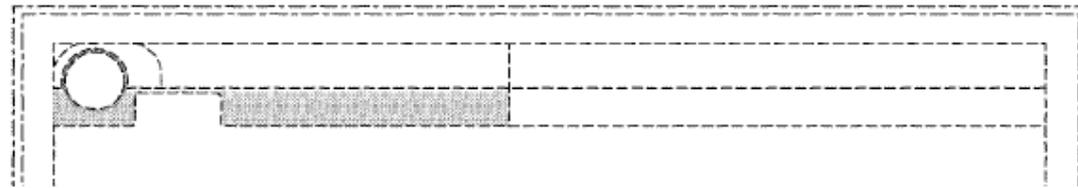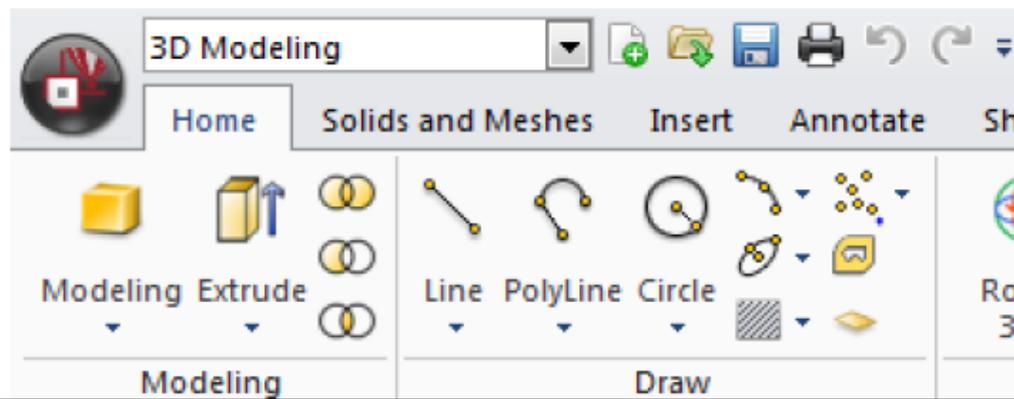
Microsoft v. Corel

Microsoft v. Corel

D554,140
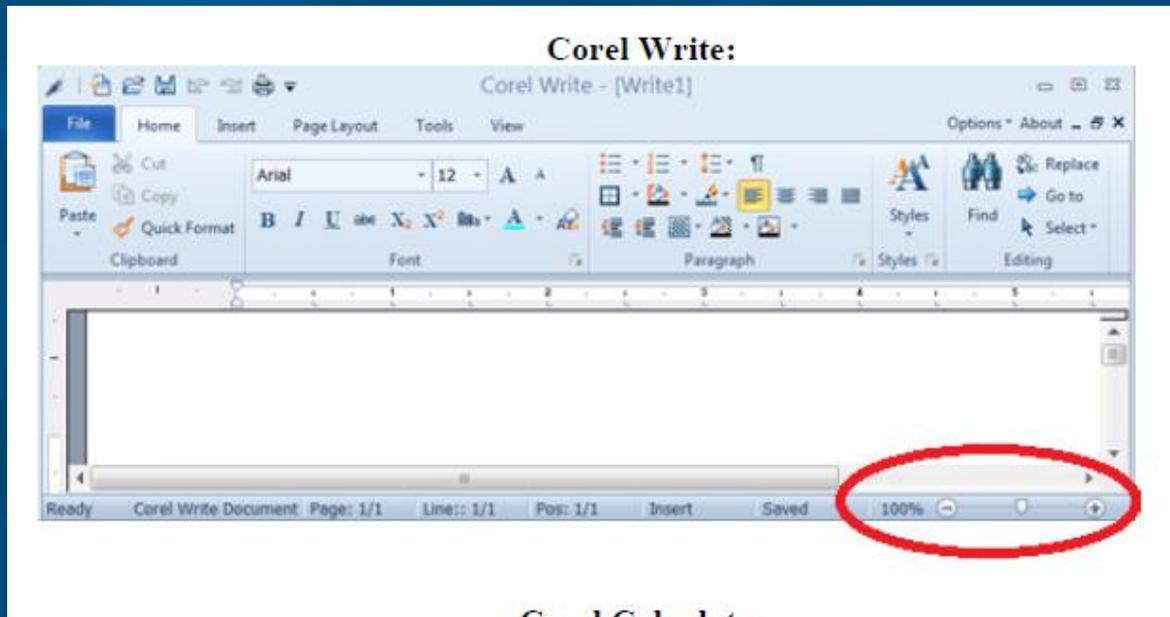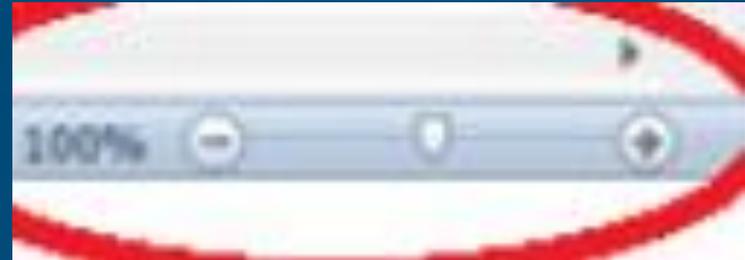
Monetary Remedies

- For an infringement patentee can choose

  - Damages (no less than a reasonable royalty) 35 U.S.C. § 284 (1st ¶) OR

  - Infringer's Profits — 35 U.S.C. § 289

- Can only increase damages
- Can't collect both

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Monetary Remdies - Section 289

- ***Section 289***

Whoever …(1) applies the patented design, or any colorable imitation thereof, *to any article of manufacture* for the purpose of sale, or (2) sells or exposes for sale any *article of manufacture* to which such design or colorable imitation has been applied, shall be liable to the owner ***to the extent of his total profit***, …

- Alternative to Section 284 which provides for damages but no less than a reasonable royalty

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Recent Section 289 Issues

- In *Apple v. Samsung*
  - Article of manufacture can potentially be smaller than the article as sold

- In *Microsoft v. Corel*
  - Can software be an article of manufacture?

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Countries Differ

- Some do not permit screen design protection
- Some require it as part of hardware
  - Some claimed; some disclaimable
- Some require a detailed operational description
- Some only permit static designs
- Some allow dynamic designs but limit number of figures
- Hague applications cannot cure these issues
- *Practitioners need to know the laws and rules for strategies and to avoid pitfalls*

Thank you!

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