First Decision on GUI Validity
Design Patent Protection for GUIs in China

On April 18, 2017, the Patent Reexamination Board (the "PRB") delivered its first decision on the validity of a graphical user interface ("GUI") design patent since GUIs were acknowledged as patentable under the Chinese Patent Law effective May 1, 2014.

By way of background, Guangzhou Dongjing ("Dongjing") first filed a patent infringement suit against Beijing Cheetah Lab ("Cheetah Lab") on June 21, 2016 before Beijing Intellectual Property Office ("BJIPO") claiming Cheetah Lab manufacturing, offering for sale and selling products containing patented designs for mobile phone application. In defense, Cheetah Lab initiated an invalidation proceeding before the PRB asserting the patent invalid on the grounds of unpatentable subject matter and lack of inventiveness.

Since GUI design practice in China is relatively young and still developing, many points of uncertainty must be considered in both patent prosecution and enforcement. In addition, the Guidelines for Patent Examination (the "Guidelines") are limited in scope and may thus be insufficient to foster understanding of GUI design protection. This short article briefs the decision, addresses uncertainty in GUI enforcement, and discusses key points on effective design patent protection of GUIs in China.

First decision on GUI validity

The patent in dispute (CN201530383753.0) includes two similar GUI designs (Design I and Design II), both directed to dynamic interfaces which are identical in main views but different in animation.

Design I

Main view

Design I

Design II

Design II

1. Designs are eligible for patenting

Cheetah Lab, the invalidation requester, asserted that the patented GUIs are graphic layouts on a mobile phone display, which, unrelated to the function of the mobile phone, shall belong to the graphic layout that is prohibited from patenting in the Guidelines, Part I, Chapter 3, §7.4, ¶1 (11).

The afore-cited section of the Guidelines specifies that designs which are unrelated to human-machine interaction or product functions, such as video game interfaces, wallpaper, start-up and shut-down screens or graphic compositions in a web page, are excluded from design patent protection.

The PRB disagreed with Cheetah Lab stating that Designs I and II are directed to different dynamics and changing patterns which corresponds to an interaction process by user's sliding the screen up and down, touching and browsing, and therefore, are not just a simple graphic layout but rather related to a mobile phone function. Accordingly, the PRB concluded Designs I and II are eligible for design patent protection under the Chinese Patent Law.

2. Design II is non-obvious over the prior designs

Cheetah Lab also asserted that the GUIs are unpatentable over prior art reference 1 (AndroidU3 version 10.6.2.626) and 2 (CN201430128675.5). While the patentee gave up Design I, the center of arguments laid on whether Design II possesses a significant visual difference from a combination of prior designs.

The PRB answered yes and reasoned that due to different dynamic changes in process, Design II differs from prior designs in middle-state interfaces and the ultimate animation to consumers. Accordingly, the PRB held Design I is invalid and Design II is non-obvious over the prior designs and thus is valid.

Interestingly, the PRB construed the protection scope of Design II to include (i) the appearance of the product, (ii) the main view, and (iii) the dynamic changes of interfaces from the beginning to the end, and opined in its decision

18th Floor, Tower B, Grand Place, No 5, Huizhong Road, Chaoyang District, Beijing 100101,P.R. China
Tel: 0086-10-84891188 Fax: 0086-10-84891189
LTBJ@lungtin.com www.lungtin.com

that it is important to consider the dynamic changes of interfaces (not just the beginning and end frames) on the impact of overall impression of a GUI design as they contribute greatly to consumers' experience.

Uncertainty on GUI infringement

While Design II stands valid, the questions on patent infringement are uncertain as Dongjing has to prove that (i) Cheetah Lab has engaged in patent infringement activities, and (ii) the accused design is substantially similar to the patented GUI.

Firstly, according to Article 11.2 of the Chinese Patent Law, design patent proprietors have a right to prevent any entity or individual from manufacturing, offering for sale, selling, or importing a product incorporating a patented design without their consent. In this case, it appears that Cheetah Lab is an APP developer who only uses a GUI, asserted in litigation, similar to that shown in the patent in its software provided to end users, and does not provide a mobile phone incorporating the patented design to the end users. In other words, Cheetah Lab may use the patented GUI, but it does not manufacture, sell, offer for sale or import the mobile phones incorporating the patented design, which are the actions that the patentee has a right to prevent others from doing. It is indeed arguable whether Cheetah Lab had infringed the design patent at all.

Secondly, in a case where an animated or dynamic GUI is protected, the Judicial Interpretations (reproduced below) with respect to a design patent for a product with variable states may apply:

Where the allegedly infringing design is identical or similar to the designs in every usage state shown in the figures of variable states, the courts shall find that the allegedly infringing design falls within the scope of protection of the patent right; and

Where the allegedly infringing design lacks the design in one of the usage states, or is neither identical nor similar thereto, the courts shall find that the allegedly infringing design does not fall within the scope of protection of the patent right.

For this case, Design II in the patent is depicted in one main view and five static usage frames for an animated GUI. To find infringement according to the above Judicial Interpretations, identical or similar usage state or frame of each and every depicted view and usage frames of Design II shall be found on the accused infringing mobile phone. The burden is quite high to satisfy.

Thirdly, in a so-called "first GUI case in China" Qihoo 360 v. Beijing Jiangmin New Science & Technology which is also pending before Beijing IP Court, a damage award of RMB 15 million has been demanded for infringing GUI design patents. Given the fact that both the plaintiff and the defendant supply free software to end users, it would be very interesting to see, if the infringement is established, how the damages would be calculated in view of Article 65.1 of the Chinese Patent Law, which stipulates the damages shall be assessed on the basis of the actual losses suffered by the proprietor because of the infringement, the resulting profits earned by the infringer, or by reference to the appropriate multiple of the royalties under a contractual license.

For the concerns set forth above, the community is watching how Beijing IP Court would decide on GUI infringement cases.

Key points for Chinese GUI design patents

GUIs, the "look and feel" of a software program, is the program's front door to the world. Therefore, companies have a great incentive to protect them from being copied or imitated. In addition to copyrights, design patents become a valuable means of protecting a company's GUI. How to effectively prosecute a GUI design application in China?

1. Current law requires a GUI design application to include a physical hardware

While the amendments to the Chinese Patent Law (where a partial design protection will be introduced) is still under discussions, a GUI design application currently must be filed together with a physical hardware. This practice differs from that in many other jurisdictions. For example, the US Patent and Trademark Office generally allows a GUI design application to show merely the GUI design, without including specific devices. In a situation where a single GUI can be applied to various devices, one approach is to incorporate the designs of a device with different hardware designs and identical or similar GUI designs into one application. If the examiner allows this incorporation, the applicant will benefit from significant cost savings and a broad scope of protection for the GUI design; and if the examiner refuses, the applicant can file divisional applications later.

In view of the above, the protection scope of a GUI design is a combination of a product appearance and a graphical interface design. Nevertheless, as the innovation resides in the latter, the Guidelines specify that the impact of the interface design on overall visual effects is more dramatic if the rest of the patent (a device) involves a usual design. In other words, the examiners and judges may focus more on the graphical interface design than on the product

18th Floor, Tower B, Grand Place, No 5, Huizhong Road, Chaoyang District, Beijing 100101,P.R. China
Tel: 0086-10-84891188 Fax: 0086-10-84891189
LTBJ@lungtin.com www.lungtin.com

appearance, which has been illustrated by the first decision on GUI validity.

2. An animated or dynamic GUI should include a series of key frames

According to the Guidelines, if a GUI includes different dynamics and changing patterns, the applicant must submit drawings showing at least one status of the GUI and key frame for other usage states, which shall be able to unambiguously determine the change trend of the animation in the dynamic image. Thus, an animated or dynamic GUI can be filed as a series of static representations in consecutive order, each showing a freeze-frame of the GUI in action. In view of the Judicial Interpretations discussed above, it is important to incorporate only key usage states into the design application, rather than every usage state or every frame. Otherwise, competitors may easily circumvent design patent protection by eliminating certain trivial usage states. If the applicant feels that one or more usage states or frames are very important and novel to the related software GUI, one or more independent applications may be filed on this basis.

3. A brief explanation for a GUI design must be drafted with special attention

A brief explanation must be provided in a Chinese design application. According to Article 59.2 of the Chinese Patent Law, the protection scope for a design patent is determined by the drawings or photographs and a brief explanation may be used to interpret the design of the product as shown. However, many practitioners pay insufficient attention to the brief explanation.

A brief explanation is especially important for a GUI design, due to a common deletion of information (which is replaced with grey blocks) that leaves to the brief explanation to provide an understanding of interfaces functions and usages. The PRB emphasized on the impacts of dynamic changes of interfaces (in functions and usages) in its first decision on GUI validity, which demonstrates the importance of the brief explanation in helping the examiners and judges to understand the essence of the design and focus on the similarities of this essence during invalidation and infringement proceedings. For a GUI design application, we suggest including a clear and comprehensive brief explanation to indicate, for example, (i) the location of the GUI on a product, (ii) the function of the GUI, (iii) how the user interacts with the GUI, and (iv) how GUI changes arising from user interaction.

Conclusion

Patent protection for GUI designs is relatively new in China. It is crucial for applicants to understand how to successfully protect their GUIs. The first decision on GUI validity shed some lights on how to construe the protection scope of GUI designs. More we are awaiting how the courts will determine on infringement. Understanding the differences between requirements in China and those in other jurisdictions is important for applicants who would also consider how each decision will affect the outcome of their applications. We further emphasize here to make full and rational use of the brief explanation in the applications to guide the examiner and judge's interpretation of a GUI design.

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LTBJ@lungtin.com www.lungtin.com

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For further information, please contact the attorney listed below. General e-mail messages may be sent using LTBJ@lungtin.com which also can be found at www.lungtin.com

Dr. Qinghong XU, Ph.D., Partner, U.S. Attorney at Law : xqh@mailbox.lungtin.com

Yan HUANG, Partner, Senior Patent Attorney: LTBJ@lungtin.com

Dr. Qinghong XU

(Ph.D., Partner, Attorney at Law)

Dr. Qinghong XU (Ph.D., J.D.) is a partner at Lung Tin focusing on all aspects of IP matters, ranging from patent application preparation and prosecution, patent invalidation and litigation, to technology transfers, licenses, strategic alliances, R&D and commercialization collaborations. She also has advised clients on regulatory matters especially those before the Chinese State Food and Drug Administration.

Prior to joining Lung Tin in 2009, Dr. Xu was a patent attorney with a New York general practice firm and a patent agent with an IP boutique since 2000.

Dr. Xu is admitted to practice before the District of New Jersey; and the New York and New Jersey State courts, and registered to practice before the United States Patent and Trademark Office.

Yan HUANG

(Partner, Senior Patent Attorney)

Ms. Huang has been helping clients secure and protect their patent rights. This experience includes international patent portfolio management, patent application preparation and prosecution before the Chinese Patent Office, patent appeals and invalidations before the Patent Reexamination Board and Beijing courts. Ms. Huang has successfully secured patent protection on behalf of individual inventors, large international corporations and companies of various sizes in between. In addition, as a Supreme People's Court appointed patent litigation attorney, she has been representing clients in enforcing their patent rights. Ms. Huang's practice focuses on mechanical and electro-mechanical systems and devices in the fields of home appliances, engineering mechanics, automation manufacture, semiconductors, printing facilities, medical devices, and computers. Ms. Huang has extensive experience counseling clients with respect to industrial design protection.

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