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”

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

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
Icon Examples
User Interface Example – D704,212 (Apple)
User Interface Example – D738,901 (Uber)
User Interface Example – D699,259 (Sony)
User Interface Example – D725,662 (Samsung)
User Interface Example – D714,313 (Microsoft)
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
Virtual Migration

Part 2
More Categories of Home Controls
Example of Evolving Design Experiences
Nest Thermostat
Match Group, LLC (Tinder) v. Bumble Trading

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
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
Icons – Static and Animated
Pat. No. D662,945 and D663,317 (NIKE)
Example Animated GUI D643,850 (Microsoft)
Example Animated GUI
D687,047 (Nest Labs)
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
  – GUls 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
Virtual 3D GUI – US D797,767
Microsoft Corporation
Projected Designs
Seattle Museum of Pop Culture
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
Apple v. Samsung

D604,305
Galaxy S
Microsoft v. Corel

The D’532 patent

CorelCAD:
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
Monetary Remedies - 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
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?
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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