



Bob Zhang



Eric Su

The protection of graphical user interface (GUI) design in China

Bob Zhang and Eric Su, HFL, discuss of the case of *QIHU 360 vs. Jiangmin*, looking closely into GUIs and design patents.

With the development of technology and new online media, Graphical User Interface (GUI) acts as a very important role for man-machine interaction, affecting not only the extent of friendship of human-computer interface, but also the selection of products of users. For GUI design, the disputes between Apple and Samsung in 2012 are still a hot topic among the IP community, even though it did not actually have much effect on the Chinese GUI market that time. In 2014, before the amendment of Patent Examination Guideline (“Guideline”), the IP community in China had not yet reached a consensus on the protection of GUI. However, since May 1 2014, when the State IP Office amended the guideline, GUI has become a design-patentable object. Notably, on August 14 2014, QIHU 360, the biggest internet security company in China, obtained the first GUI design patent, named as “A kind of mobile phone with GUI”, and marked the icebreaker of patent protection of GUI in China.

From our research on the current design patents of GUI, we believe there are still several issues existing for the design application of GUI, outlined here:

Résumés

Bob Zhang

Bob Zhang (Zhao Long) is an associate in HongFangLaw based in its Shanghai Office. Bob has a solid theoretical foundation in the field of intellectual property and focuses on intellectual property litigation and counseling, including trademark administrative litigation, trademark civil litigation, trademark enforcement, copyright infringement litigation, domain name disputes and other intellectual property related contentious and non-contentious matters. His email address: bob.zhang@hongfanglaw.com

Eric Su

Eric Su (Su JianFei) is founding partner at HongFangLaw. Eric has studied law at the East China University of Politics and Law and chemical engineering at the North University of China. He is a member of the China Bar Association and the International Trademark Association (INTA), and was named IP Star by *Managing Intellectual Property* in 2014 and is a recommended lawyer by *Legal500*. He has written articles for the *MIP China IP Focus* (2013 and 2014), the *World Intellectual Property Review* (2013), and *China Business Law Journal* (2012) and others. Eric has profound experience in the complete intellectual property practice in both Trademark and Patent law. His email address: eric.su@hongfanglaw.com

1. Different products required separate application

As we know, it is not only the TV or PC has the electronic screen, but also cell phone, tablet computer, and even now the watch. We could say, if there’s an electronic screen, there is a GUI.

According to the new guideline, the design application shall be a whole product consisting of GUI, together with the physical product. Interestingly, if the patentee wants to protect his GUI in all these products, they shall file the patent application separately: this increases the cost of both the applicant and the administrative resources.

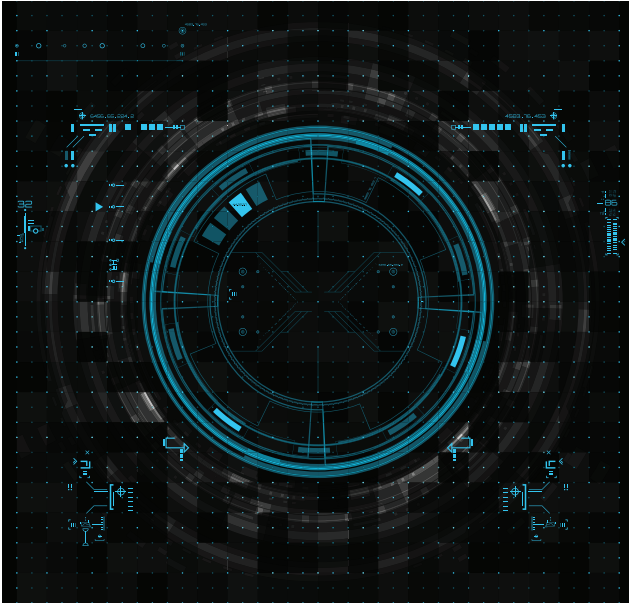
2. The value of GUI could not be well embodied

As mentioned above, the application shall be combined with the special product; the photos and pictures of the design are more focused on the products rather than the GUI itself. This, usually, does not well reflect the value of the GUI design. As to GUI, fancy layout, delicate icon, humanized arrangement, and friendly feeling of operation are the keys to the value of the GUI. But the patent as approved are more focused on the products, e.g. the stereograms of the cell phone is the essential part of the design patent.

Furthermore, sometimes the product as designated by the GUI (and shown on the patent certificate) is not designed by the applicant of the GUI - this brings some hidden troubles to the protection of the GUI. The applicant uses other parties prior products to use the GUI and applies the product with its GUI as a whole design; this may cause an invalidation of the patent.

3. The lack of Partial Design

Another problem arises through the lack of a “Partial Design” system in China. Generally speaking, “Partial Design” means any new design of the shape, pattern, color, or their combination, of a local shape of a product, which creates an aesthetic feeling and is fit for industrial application. But now there’s no such regulation in Chinese patent law system, the law is still only providing protection to the whole product’s design. Recently, QIHU 360 filed a civil lawsuit against Beijing Jiangmin New S&T Co., Ltd with Beijing IP Court for patent infringement of its GUI design patent, claiming for £1.5 million compensation. However, before the legislation of Partial Design, the court is encountered with the problem on the infringement



determination and compensation calculation of such partial design, which is also the key issue will be discussed.

In the past, and even right now, the GUI design could be protected by Anti-unfair Competition Law. If the plaintiff could prove that the GUI is special - rather than a generic interface - and the plaintiff's product with this GUI is famous in local territory or around China, then the law provides the following:

"Using, without authorization, the names, packaging or decoration peculiar to well-known goods/services or using names, packaging or decoration similar to those of well-known goods/services so that their goods are confused with the well-known goods of others, causing buyers to mistake them for the well-known goods of others" shall be held as unfair competition. As far as the QIHU 360 case is concerned, if QIHU 360 has put the GUI into use on the identical/similar product of the defendant with high revenues, large scale advertisement, large scale of users, and have nice comments from the users, it can then ask the court to recognize its GUI as specific design of a famous goods and get the protection.

Infringement claims

However, since the case in question is based on patent infringement, it is more complicated. In practice, the determination of design infringement usually complies with the 3 rules:

- 1) the similarity of the product and the design,
- 2) criteria of ordinary consumer, and
- 3) overall observation of the product.

Among them, the court usually applies the "overall observation" to determine the infringement. But considering that the GUI is only part of the design of the product, the overall observation shall be affected to some extent and the comparison has to also focus on the product itself. The identical/similar GUI maybe used on different product by the defendant that the infringement may not be constituted.

Luckily, the amended guideline provides that if the other part of the design is generic design that the GUI shall have more prominent effect on the overall visual effect of the design. Such provision can be a rational reference for infringement determination of a similar design (i.e. there's no problem of identical design). Therefore, the court shall not simply apply the "overall observation" on a case of GUI design dispute, but pull out the GUI part from the original product for comparison and analysis. According to the Judicial Interpretation of Patent Infringement issued by the Supreme Court, parts that are easily observed in the ordinary use state of the product

versus other parts of the product usually have more impact on the overall visual effects of a design. For a product with GUI design, the GUI shall be the part that is easily observed by the consumers in the ordinary use. Thus, when the accused product is different from the patented product, the GUI part shall be given priority in the comparison procedure of the infringing product and the design patent.

In the meantime, for such visualization designs, the extent of reputation of the GUI and the bad faith of imitation or copy, shall be considered when the court determines the infringement. The higher reputation, the more possibility to be imitated or copied by the infringers, and it is easy for the direct competitor to be aware. There is direct competition relationship between the two parties that they both engage in the security software development; they should know each other's GUI especially when the GUI is actually used. Thus, if QIHU 360 could prove the high reputation and distinctiveness of its GUI design, the court shall lower its criteria on the comparison between the defendant's product and the design.

Infringement compensation

As to the infringement compensation of a GUI patent, although the Patent Law provides the amount of compensation for the damage caused by the infringement of the patent right shall be assessed on the basis of the losses suffered by the patentee or the profits which the infringer has earned through the infringement, or if it is difficult to determine the losses or the profits, the amount may be assessed by reference to the appropriate multiple of the amount of the exploitation fee of that patent under contractual license. For normal product, the value or price is traceable and easily assessed, but for GUI, the value, price and the contribution proportion is difficult to be determined.

In this case, the design patent involved is "A Computer with GUI" owned by QIHU 360, a company that provides free security software products to the public; it may not really produce such computer but uses the GUI as an interface of its software products. The defendant, Jiangmin, is also a free security software provider; it does not make profit directly from the software. However, we view that GUI sometimes works like a trademark that can distinguish the source of the products, the infringer's use of such GUI will mislead the public or cause confusion among the consumers, then the infringer can attract more potential consumers and increase its advertising revenue through the software. Thus, we think the court will take into consideration of several factors when it decides the amount of compensation, e.g. the creativity of the GUI design patent, the expiration date of the design, the similarity extent of the both GUI design, the reputation/real use of the GUI, the contribution proportion of the GUI to the whole product and the bad faith of the defendant.

Overall, we think GUI can be pulled out from the product to be registered as an independent design patent so that it can save the cost of both registration and protection, and reflect the value of GUI design. Of course, the judicial system will sum up experience from the real cases; we look forward to seeing the outcome of this case which shall be a high-value reference for the future cases.

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