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IP UPDATE



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The First Invalidation Hearing of a GUI Design Patent in China

The Patent Re-examination Board ("PRB") of the State Intellectual Property Office ("SIPO") held a public hearing on 28 October 2016 for the first invalidation case involving disputes on graphical user interface ("GUI") designs.

The battle began when the anti-virus software developer Qihoo 360 Technology Co. ("Qihoo") brought a GUI design infringement case to the Beijing Intellectual Property Court in April 2016, claiming unauthorized use of its GUI design patents by its competitor, Beijing Jiangmin New Science and Technology Co. ("Jiangmin"). Jiangmin filed requests with the PRB in May and August 2016 to invalidate all the three GUI design patents.

Jiangmin further requested the Beijing IP Court to suspend the proceeding of the GUI design infringement case. The Beijing IP Court, however, after reviewing the patentability evaluation reports, declined the suspension report.

The GUI design infringement case was heard on 21 September 2016. Jiangmin argued that the products protected under Qihoo's GUI design patents

were hardware (computers) while Jiangmin's products are software programs. As a software developer, Jiangmin does not manufacture nor sell hardware products and thus did not infringe on Qihoo's GUI design patents. On the other hand, Qihoo argued that the GUI of the anti-virus software products produced by both Qihoo and Jiangmin are highly similar with ten identical features found after comparing the two.

In practice, a single GUI can be applied to various devices. As the current Chinese Patent Law does not offer protection for partial product designs, the device which the GUI design will be used on must be specified when filing an application for the GUI design patent. This requirement may weaken the protection of the GUI design patent to a certain extent as it may become difficult to establish infringement when competitors copy the GUI design and apply it on a different device.

One cost-effective approach is to obtain a protection scope as wide as possible in order to incorporate different devices with identical GUI designs into one application. In the application, the applicant may present in the brief description that the devices are similar because they include the same GUI design which is the key design

element that requires protection under the design patent. GUIs have been protected as design patents in China since 2014. However, it is still unclear how important the role of the designated device is in determining the protection scope of the patent. In December 2015, SIPO proposed in the Draft Revision of Chinese Patent Laws for Public Comments, an amendment to Article 2 to state that part of the design may be eligible for protection under a design patent. If this amendment is adopted eventually, GUI design patents will have a stronger protection as it is no longer limited to a specific device.

The current Qihoo versus Jianmin battle is still pending. The results are expected to have profound influence over the standards of determining the protection scope of GUI design patents in China.