



Study Question

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Protection of graphical user interfaces

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I. Current law and practice

Patents

1 Can GUIs generally be protected by patents?

If no, please answer questions 1.1, if yes, please go to question 2

Yes

Please Explain

Theoretically, the Italian Industrial Property Code does not explicitly forbid to protect GUIs *per se* by way of patents. As in the case of inventions it is mandatory to recognise an improvement over the prior art that has to be non-obvious.

We believe that GUIs may be indirectly protected by patents as methods for displaying objects/information on a screen, as well as computer programs implementing these methods.

1.1 If GUIs cannot be protected by patents *per se*, are any types or aspects of GUIs protectable by patents?

2 If any type or aspect of GUIs are protectable by patents, under what conditions and to what extent are those types or aspects of GUIs considered to be within the scope of patentable subject matter?

According to Articles 46 and 48 of the Italian Industrial Property Code, patent protection is available provided that a solution to a technical problem in a technical field may be identified. The solution must be new and non-obvious, i.e. provided with an inventive step over the relevant prior art.

3 If yes, do the statutory provisions, case law or judicial or administrative practice require specific claim formats for any patent protection? If yes, what claim formats are available for protecting GUIs?

No

Please Explain

In Italy, up to date, we have not found any case law that could be cited in this matter. The Industrial Property Law does not define any specific claim format.

However, according to Article 45 of the Italian Industrial Property Code it is not possible to claim a computer program *per se*.

4 Is any physical feature required in a claim as a pre-requisite for patentability of a GUI?

No

Please Explain

According to the Italian Industrial Property Code, no physical device is generally required. It is nevertheless advisable to include a physical feature in an independent claim in order to make it clear that the requirement of industrial applicability established by Article 49 of the Italian Industrial Property Code is met.

5 To what extent does involvement of the user's mental activities in a GUI process affect the patentability of the GUI?

This point is not relevant in order to protect GUIs and does not affect the patentability of GUIs.

Design rights

6 Can GUIs generally be protected by design rights?

If no, please answer questions 6.1, if yes, please go to question 7

Yes

Please Explain

Pursuant to articles 3(a) of the Community Design Regulation (hereinafter CDR) and 31 of Italian Industrial Property Code implementing the EC Directive No. 98/71 "the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product itself or its ornamentation" can be registered as design. This definition includes also the design of GUIs as they appear on a screen. This is suggested by a literal interpretation of the relevant provisions and by the aim of the EU and national legislators when drafting them. The EU system of protection of design aims at granting to valuable designs an effective

protection, irrespectively of the industrial field in which the designs are developed. This interpretation is also confirmed by the preparatory works of the EU legislation (see Explanatory memorandum to proposed Design Regulation, January 31, 1994, [1994] OJ C29/1) according to which computer software cannot be protected *per se* by the means of design law, while icons and graphic interfaces which appear on electronic devices can be protected as design in the European Union. Therefore, a GUI can be registered if it meets the requirements set forth by the CDR and the Italian Industrial Property Code and notably novelty and individual character. Furthermore, a GUI can be registered as long as its protected features do not represent the only way to achieve a particular technical effect.

6.1 If not, are any types or aspects of GUIs protectable by design rights?

7 If any type or aspect of GUIs are protectable by design rights, under what conditions and to what extent are those types or aspects of GUIs protectable?

7.a In particular is a GUI that temporarily appears on a screen of an electronic device considered a "design" that is protectable by design rights?

Yes

Please Explain

Yes, it is (see question 6 above).

7.b In particular is a GUI protectable by design rights independently from the design of the electronic device itself?

Yes

Please Explain

Yes, provided the GUI shows *per se* the requirements of protection of novelty and individual character (see question 6 above).

7.c In particular are smaller elements included in a GUI (e.g. icons, slide buttons) protectable by design rights independently from the GUI as a whole?

Yes

Please Explain

Yes, if the relevant elements meet *per se* the requirements of protection of novelty and individual character (see question 6 above).

7.d In particular are movements or screen transitions in a GUI protectable by design rights?

Yes

Please Explain

In principle yes but limited to the graphical appeal of the transition. However, under a practical point of view, the registration of transitions is difficult (if not impossible) to be carried out considering the current practices of Italian Trademark and Patent Office and EUIPO.

7.e In particular are there any other types or aspects of GUIs protectable by design rights? If so, under what conditions and to what extent?

No

Please Explain

N/A.

Copyright

8 Can GUIs generally be protected by copyright?

If no, please answer questions 8.1, if yes, please go to question 9

Yes

Please Explain

According to the case law of the European Court of Justice, graphical user interfaces can be protected as such by copyright if they are original, i.e. if they constitute their authors' own intellectual creation (EUCJ, 22 December 2010, C-393/09, BSA, §§ 44 ff.). Although Italian copyright law does not mention GUIs, the notion of protected «works» implied by the relevant provisions is flexible enough to include GUIs as well.

8.1 If not, are any types or aspects of GUIs protectable by copyright?

9 Does the fact that GUIs shown on screens are computer-generated affect the eligibility of GUIs for copyright protection?

No

Please Explain

The fact that GUIs shown on screens are computer generated does not seem to exclude *per se* their eligibility for copyright protection. If a material human intervention in the creative process occurs, whether by the programmer or by the user, computer generated GUIs should probably attract copyright protection. On the contrary, should GUIs be generated by computer in circumstances when there is no material human intervention, this could affect the eligibility of GUIs to copyright protection. This distinction is suggested by several EUCJ decisions, which limit copyright protection to works that are original in the sense that they are their authors' own intellectual creations (see, *inter alia*, EUCJ 16 July 2009, C-5/08, Infopaq International).

10 If any type or aspect of GUIs can be protected by copyright, under what conditions and to what extent are those types or aspects of GUIs protectable?

Copyright protection applies in Italy to GUIs, and elements thereof, which are original and non-functional.

According to the decision of the EUCJ in the BSA case (EUCJ, 22 December 2010, C-323/09), a clear distinction must be drawn between GUIs and computer programs which implement them. The protection of a computer program does not extend to its GUI, since the GUI is not – according to the EUCJ – a form of expression of the computer program. However, a GUI can be protected *per se* under the «ordinary law of copyright» by virtue of Directive 2001/29/EC, if it is original, i.e. if it is the result of its author's own intellectual creation. In particular, the Court

held that, when making the assessment of originality, national courts should consider, *inter alia*, the specific arrangement or configuration of all the components which form part of the GUI. In this perspective, the originality cannot be met by components of the GUI which are dictated only by their technical function, since in this respect «the different methods of implementing an idea are so limited that the idea and the expression become indissociable». For an implicit application of such criterion in domestic case law see Court of Milan, judgement of February 5, 2016.

11 Can the overall "look and feel" of GUIs be protected by copyright?

If no, please answer questions 11.1, if yes, please go to question 12

Yes

Please Explain

A GUI is a combination of elements – such as icons, menus, transitions etc. – which may be individually protected.

If the specific arrangement or configuration of the elements, which is responsible of the overall "look and feel" of the GUI, is original and not imposed by functional considerations, then it may attract copyright protection. Such protection would in principle extend to GUIs which combine identical or similar elements in the same way or with minimal variations meant to disguise the infringement. Additionally, it may extend its effects to the individual elements comprised in the GUI, if they participate of the originality expressed by their arrangement or configuration. Conversely, the protection of the individual elements of the GUI would not prevent third parties from adopting the same arrangement or configuration, if the latter is not protectable as such.

11.1 If not, can individual elements included in a GUI be protected?

Trademarks

12 Can GUIs generally be protected as trademarks?

If no, please answer questions 12.1, if yes, please go to question 13

Yes

Please Explain

Generally, anything that is distinctive can be protected as a trademark, provided that the trademark protection does not imply anti-competitive effects. Therefore, a graphic interface can be protected as a trademark if it has a distinctive value, it is not necessary to obtain a technical result and does not give substantial value to the product.

12.1 If not, are any types or aspects of GUIs protectable by trademarks?

13 If any type or aspect of GUIs are protectable as trademarks, under what conditions and to what extent can those types or aspects of GUIs protectable?

A GUI is protectable as a trademark if it owns sufficient distinctiveness to the eyes of the public, namely, if the relevant public could identify the connection between the GUI and its owner. See also the answer to the previous question.

3.1 For example, is a screen movement or transition in a GUI protectable as a trademark?

Yes

Please Explain

14 Does a GUI need to acquire secondary meaning through use in order to be protected as a trademark?

No

Please Explain

Secondary meaning should be proven if the GUI does not possess inherent distinctiveness, as for any other trademark.

Other forms of protection

15 Does your Group's current law provide any other means for protecting GUIs that are similar in nature to traditional IP rights?

Yes

Please Explain

Italian law does not provide other means for specifically protecting GUIs. However, in a few cases dealing with the reproduction of graphic and functional elements of websites and computer programs, Italian courts applied the law of unfair competition (art. 2598 of the Italian civil code) and granted relief to the plaintiff on this ground. In this regard, it should be mentioned that art. 102 of Italian Copyright Law prohibits as an act of unfair competition that of copying the general outlook of third parties' works (including signs, fonts and other features of shapes and colour) in such a way as to create confusion as to the work or the author thereof.

16 If yes, what forms of protection are available, and under what conditions, and to what extent, are such other forms of protection available?

Article 2598 n. 1 of the Italian civil code prohibits all acts that may cause confusion on the market as to the goods or the business of a competitor. This provision would likely apply when (i) a GUIs' original and arbitrary features are copied and (ii) such acts are capable of creating confusion with goods and/or services of a competitor.

Additionally, Art. 2598 n. 3 of the Italian civil code prohibits all (other) acts contrary to honest business practices. This provision has been interpreted by some courts as covering mere free-riding (i.e., non-confusing imitation) in cases dealing with GUIs and websites (*MediaShopping S.p.A. v. Foxprice S.r.l.*, Court of Milan 22 November 2010; *DriveK Italia S.r.l. v. Webbdone S.r.l.*, Court of Milan, 21 March 2016, *interim* injunction).

II. Policy considerations and proposals for improvements of your Group's current law

17 Does your law provide sufficient IP rights protection for GUIs? If yes, is that by means of any one or more types of IP rights protection (and if so, which), or by means of combination of those types of IP rights protection?

If no, please answer questions 18, if yes, please go to question 19

Yes

Please Explain

Yes. It seems that GUIs obtain sufficient protection under current Italian law. This result is achieved through a combination of IP rights: original and non-functional aspects of a GUI can get copyright protection; graphic symbols can attract industrial design rights; distinctive features can get trademark protection or be shielded by unfair competition law against confusingly similar copies; functional aspects of the GUI can be patented. Additionally, protection against free-riding may be granted by courts under the general prohibition of acts contrary to honest business practices.

18 If no, how is your law deficient?

19 Is your law sufficiently clear on whether and to what extent GUIs are protected by various IP rights?

If no, please answer questions 20, if yes, please go to question 21

Yes

Please Explain

Our current law does not deal with GUIs specifically. However, GUIs, or individual elements thereof, seem to fit into the definitions of protectable subject-matter provided for by existing IP laws.

20 If no, how is your law deficient in this regard?

21 Are there any aspects of your law that could be improved (for example, by strengthening or reducing the extent to which GUIs may be protected)?

No

Please Explain

No. We believe that Italian copyright law protects adequately GUIs *per se*, while other IP rights might provide additional protection for individual elements or characteristics of GUIs (see above answer 17).

III. Proposals for harmonisation

22 Does your Group consider that harmonisation in this area is desirable?
*If yes, please respond to the following questions without regard to your Group's current law.
Even if no, please address the following questions to the extent your Group considers your Group's laws could be improved.*

No

Please Explain

Apparently, there seems to be a considerable degree of consistency in the case law relating to the protection of GUIs around the world. This may well depend on the fact that substantial harmonization has already been achieved worldwide as to the subject-matter, requirements and extent of protection of all IP rights which may be invoked to protect GUIs or specific aspects thereof. Therefore, we do not believe that further harmonisation is necessary as far as GUIs are concerned.

Patents

23 Should GUIs generally be capable of protection by patents?

If no, please answer questions 23.1, if yes, please go to question 23.2

Yes

Please Explain

Yes. We believe that GUIs should be capable of patent protection provided that a non-obvious improvement may be recognized over the prior art. Such improvement must also be capable of an industrial application and not a mere mental activity or a computer program as such.

23.1 If not, should at least some types or aspects of GUIs be protectable by patents?

23.2 Please explain your reasons.

We believe that GUIs should be capable of patent protection provided that a non-obvious improvement may be recognized over the prior art. Such improvement must also be capable of an industrial application and not a mere mental activity or a computer program as such.

24 Under what conditions, and to what extent, should GUIs fall within the scope of patentable subject matter?

It is opinion of the Italian group that harmonisation has not to consider involvement of user's mental activities, because it seems really difficult to recognize the involvement degree of a human being, due to the undefined borders of the human brain and also considering the discretion of an examiner when evaluating this aspect.

24.1 For example, should involvement of user's mental activities in a GUI process affect the patentability of the GUI?

No

Please Explain

24.2 Please explain your reasons.

25 Should a physical feature be required in a claim as a pre-requisite for patentability of GUIs?

No

Please explain your reasons

There should not be any pre-requisite for the patentability of GUIs.

26 What claim formats should be available for protecting GUIs?

There should not be any specific claim format to use for protecting GUIs.

Design rights

27 Should GUIs generally be capable of protection by design rights?

If no, please answer questions 27.1, if yes, please go to question 27.2

Yes

Please Explain

Yes. The GUI is often a design work which adds value to the relevant product. There is no reason to prevent GUIs to access design protection if relevant requirements are met.

27.1 If not, should at least some types or aspects of GUIs be protectable by design rights?

27.2 Please explain your reasons.

28 Under what conditions, and to what extent, should GUIs be protectable by design rights?

GUIs shall be protected if general requirements for design protection are met. Notably, Article 25 of TRIPs agreement currently provides that "Members shall provide for the protection of independently created industrial designs that are new or original". Irrespectively from how they are called, two requirements should be met by a design to be protected: (a) independent creation or novelty (as a preliminary requirement); and (b) originality (individual character in an EU perspective) in the sense required by TRIPs (currently as a non binding provision) "Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features". Furthermore, features of a GUIs which are necessary to achieve a technical effect should be protected only if some alternative features to achieve the same effect is available. Therefore, for instance, screen movements or transitions should not be protected if they represent the only way to achieve a particular technical effect (also considering the features and aims of the relevant software).

28.1 For example, should screen movements or transitions in a GUI be protectable by design rights?

Yes

Please explain your reasons.

Yes. The GUIs represent independent works/products under an economic point of view.

29 Should a GUI be protectable by design rights independently from the design of the electronic device itself?

Yes

Please explain your reasons.

Yes. The GUIs represent independent works/products under an economic point of view.

Copyright

30 Should GUIs generally be capable of protection by copyright?

If no, please answer questions 30.1, if yes, please go to question 30.2

Yes

Please Explain

GUIs, *per se*, should (and indeed they are) protected by copyright if they are original, i.e. consist in the result of a creative intellectual effort. The originality could be found in the specific arrangement or configuration of all components of the GUI. In this perspective, GUIs should not be considered original if the arrangement or the configuration of their components are characterized exclusively by their technical functions.

30.1 If not, should at least some types or aspects of GUIs be protectable by copyright?

30.2 Please explain your reasons.

31 Should the fact that GUIs shown on screens are computer-generated affect the eligibility of GUIs for copyright protection?

Yes

Please explain your reasons.

As already mentioned, the fact the GUIs are computer-generated would probably not affect their eligibility for copyright protection under current Italian law, as far as a material human intervention occurs (whether by the programmer or by the user). On the contrary, if no material human intervention occurs the eligibility for protection should be denied for lack of originality, which has been defined as an author's own intellectual creation. In the latter case, there seems to be no compelling reason to depart from the solution currently provided by our law. If a GUI is automatically and autonomously produced by a software there is neither an author nor a specific investment in need of protection, considering that the software producing the GUI would probably incorporate a great deal of creativity and would likely attract protection under copyright or even patent law.

32 Under what conditions, and to what extent, should GUIs protectable by copyright?

32.1 For example, should the overall "look and feel" of a GUI be protectable by copyright?

Yes

Please explain your reasons.

Yes, but the protection should be limited to original and non-functional features of GUIs. The protection afforded by current Italian Copyright Law seems reasonable and consistent with the needs of the industries of the specific sector.

Trademarks

33 Should GUIs generally be capable of protection as trademarks?

If no, please answer questions 33.1, if yes, please go to question 33.2

Yes

Please Explain

It seems to us that GUI could generally be capable of protection, provided that it owns distinctiveness, because it could be recognized as a trademark from the relevant public, and the trademark protection thereof does not imply anti-competitive effects.

33.1 If not, should at least some types or aspects of GUIs be protectable as trademarks?

33.2 Please explain your reasons

34 Under what conditions, and to what extent, should GUIs be protectable as trademarks?

In the view of harmonization, our position points to recognise that every sign – lato sensu – could become a trademark, provided that it owns sufficient distinctiveness and its protection as a trademark does not imply anti-competitive effects.

Therefore, it seems to us that also for screen movements or transitions in a GUI the main condition to be considered should be sufficient distinctiveness in the eye of the relevant public. Furthermore, in the case the screen movements or transitions at issue do not own a sufficient distinctiveness per se, they could be protected as a trademark, if it could be demonstrated they acquired a secondary meaning.

34.a For example should screen movements or transitions in a GUI be protectable as trademarks?

Yes

Please Explain

34.b For example should a GUI be required to acquire secondary meaning through use, in order to be protected as a trademark?

Yes

Please Explain

Other forms of protection

35 Should there be other forms of protection for GUIs? If so, what forms of protection should there be?

Yes

Please explain your reasons

Unfair competition law seems to be particularly useful to protect GUIs against slavish imitation and parasitism on a case-by-case basis.

36 Should there be a *sui generis* right for protection of GUIs? If so, what aspects of GUIs should be protected by such a right, to what extent, and under what conditions?

If yes, please answer questions 37, if no, please go to question 38

No

Please Explain

It seems that existing laws have adequately sustained great innovation and thriving competition in the observed field. Therefore, we do believe that there are compelling reasons to introduce a new, *sui generis* right specifically designed for GUIs.

37 Should there be any exceptions or limitations to a *sui generis* right in order to ensure an innovative and competitive market? If so, what exceptions and limitations should there be and why?

38 Please comment on any additional issues concerning protection of GUIs that your Group considers relevant to this Study Question

No comment.

Please indicate which industry sector views are included in part "III. Proposals of harmonization" on this form:

N/A

Please enter the name of your nominee for Study Committee representative for this Question (see Rule 12.8, Regulations of AIPPI). Study Committee leadership is chosen from amongst the nominated Study Committee representatives. Thus, persons not nominated as a Study Committee representative cannot be in the Study Committee leadership.
Silvia Grazioli