

# Digital directions

How have design rights kept pace with the demands of digital designers?  
Asks **Potter Clarkson's** Deborah Maxwell

When you think of intellectual property (IP) rights, you probably think about protecting drugs, devices or logos which means IP rights aren't for cutting edge creatives like digital designers, right?

Wrong!

As the world becomes more digitally driven, it also becomes more innovative, more competitive and more challenging. Unfortunately, this means our ideas are more open than ever to misappropriation and misuse.

As such, IP rights – and, by extension, IP strategy - has been forced to keep pace with the times, constantly evolving to meet the demands of the growing digital economy and maximise the value at the heart of our businesses.

For the sake of illustrating just how hard IP has worked to keep pace with the way we do business, let's look at apps.

Apps are now one of the world's most used products and Statista estimates the global app industry will generate \$808bn during 2022, an increase of \$115bn in only twelve months.

It is also an area in which innovation must be ridden hard if developers are going to hold the interest of their current users, attract new users and fend off the new offerings from their competitors.

And these external pressures are only half the story.

As more developers start up, funding will be harder to find and investors, VCs and

private equity are all looking for the strongest businesses. They want plans that promise solid growth potential, profitability and a lucrative exit because the crown jewels - the ideas that make the app different - are fully owned and fully protected by those they are about to invest in.

## Are design rights the best form of protection for digital designers?

In essence, designs are all about protecting the appearance of a product. Designs can be protected by registered and unregistered design rights or by copyrights.

The reason many designers turn to registered designs first is while they offer a powerful additional layer of protection to complement the business' patents or trademarks, when it comes to product design the appearance of the product is likely to be its key differentiating factor.

That said, the fact designs are easier, quicker and less expensive to register also makes them an attractive option!

## Protecting GUIs and animated designs

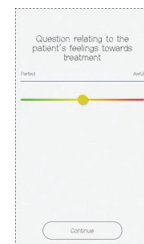
But what do design rights offer designers when it comes to protecting digital designs?

2D designs - such as those you'd use when producing an app - fall under registered design protection, most specifically when graphical user interfaces (GUIs) and/or animated sequences are involved.

You can use screenshot images to protect

the appearance of a still GUI on a screen if the particular layout and combination of images on the screen are unique.

For example, below is a screenshot from a drug treatment app protected by a registered design, where the key feature is the colour gradient scale that the slider is moved across by the user - which was found to glean accurate results from the patient in terms of how a drug treatment is going.



Most GUIs will include and arguably rely on some form of animation, and so protecting this animation is key to preventing competitors incorporating it into their versions. The good news is UK and EU design law allows you to file a series of images to illustrate the way your GUI moves through its animated sequence.

Using the same drug treatment app example, the images below show how the movement of the slider through the colour gradient scale was protected by an animated registered design:



## What is the multiple application system and how can it benefit digital designers?

The multiple application system allows you to

file a bundle of design applications at once. It is an option that is unique to the UK and the EU. Better still, it's an option that will afford you significant cost savings while you protect different versions of your design and different aspects of the same design.

In this way, you can file your designs in a similar manner to how you would use patents – that is protecting different combinations of the key features and disclaiming the other components to provide layers of protection. As such, the protection should be much stronger than filing a single design application.

If we use the treatment app example again, several overlapping animations of the app were protected, as well different colour combinations and text combinations, as the images below show:



## How much protection can existing case law provide for designers?

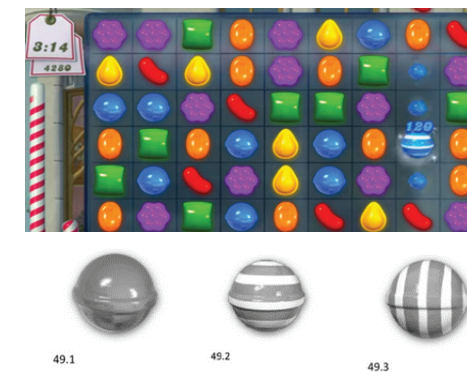
While GUIs are registrable, are they enforceable? Admittedly at the moment there isn't a lot of case law but several high profile cases have predictably hit the headlines.

Probably the best known case led to Samsung paying Apple \$539m for design infringement (while a mere \$5.3m was awarded for the associated patent infringements). The court decided that 14 Samsung devices did infringe Apple's GUI design and set the damages to reflect the profits Samsung had generated from sales of the offending smart phones.

We can argue just how hard \$539m would actually hit Apple or Samsung but the case illustrates just how serious a part a cleverly executed design strategy can play in protecting a product-led business' brand, revenue and market share.

While the Apple/Samsung case was directly linked to the appearance of the GUIs both manufacturers were using, the case of Team Lava LLC v King.com related to the use of the animation - or lack of - within the functionality of an app.

Team Lava claimed that despite being protected by registered designs, the individual images being used in King.com's 'Candy Crush Saga' lacked novelty and individual character in their portrayal of confectionary. King.com's response was to argue their designs related to one animation rather than 3 different views of the same image.



The Board of Appeal disagreed. They felt the representation of the candy in Candy Crush did not reveal any animation in a clearly understandable progression.

As 'Candy Crush' was King.com's marquee product, could they have done anything different to protect their most valuable designs?

When it comes to protecting animated

designs, the start point is to understand what an animated design is and what demonstrates a clear progression of that animation.

Once this has been established, all views of an animated icon and the graphical user interface need to be visually related; they must have features in common and the applicant needs to order the views to provide a clear perception of the progression.

As the above cases show, protecting GUI designs (especially animations) is not a straightforward task! It's always best to seek professional advice from an IP attorney who specialises in designs.

## In summary ...

- Registered designs are not just for 3D products. It's important to consider them when developing digital designs, especially where patent protection is unsuitable.
- The UK and EU design registration system is geared up for digital designers to build layers of protection of their animated GUIs by using the multiple application system ... and all without breaking the bank!
- It's always best to ask for (professional) help. Don't be fooled into thinking design protection is as simple as uploading some images onto the EU and UK design register. There needs to be a carefully thought out strategy put in place to obtain useful and effective design protection, especially for non-conventional designs such as animated apps.



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Opposite page | EUIPO 7981998  
Below | EUIPO 7981998  
| Candy Crush Saga app by King.com  
| EUIPO 2216416-0049