# Study Question

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Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

## Protection of graphical user interfaces

**Responsible Reporter: Yusuke INUI**

<table>
<thead>
<tr>
<th>National/Regional Group</th>
<th>Mexico</th>
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<tbody>
<tr>
<td>Contributers name(s)</td>
<td>ALMA ALVAREZ, HECTOR CHAGOYA, OCTAVIO ESPEJO</td>
</tr>
<tr>
<td>e-Mail contact</td>
<td><a href="mailto:alma@breakthroughip.com">alma@breakthroughip.com</a></td>
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## I. Current law and practice

### Patents

<table>
<thead>
<tr>
<th>Question</th>
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<tr>
<td>1</td>
<td>Can GUIs generally be protected by patents?</td>
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<tr>
<td></td>
<td><em>If no, please answer questions 1.1, if yes, please go to question 2</em></td>
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<tr>
<td></td>
<td>No</td>
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<td></td>
<td>Please Explain</td>
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<tr>
<td></td>
<td>GUIs per se can not be protected by patent since Article 19, fracción V establishes that the &quot;methods of presenting information&quot; are not eligible for patent.</td>
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<tr>
<th>Question</th>
<th>Answer</th>
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<td>2</td>
<td>If GUIs cannot be protected by patents per se, are any types or aspects of GUIs protectable by patents?</td>
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<td>Yes</td>
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<td></td>
<td>If so, which?</td>
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<td>Functionality aspects of the GUI's can be protected via patents by complying with patentability criteria.</td>
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<th>Question</th>
<th>Answer</th>
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<td>3</td>
<td>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?</td>
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The functionality aspects (features) of GUI's are protectable by patents provided they comply with novelty, inventive step and industrial applicability as per Articles 12 and 16 of Mexican IP Law. Such technical features are claimed in an allowabe claim category such as method, system, apparatus as per (Article 45 of MIPL) and must be clear, concise, drafted as a function of the technical characteristics of the invention (Article 47 of MIPL). Scope is given by the claims.

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 GUls?

Yes

Please Explain

According to the Industrial Property Law and practice they can be claimed as a system or computer implemented invention (method) where well defined tangible elements are described.

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

Yes

Please Explain

A physical feature is required to claim a system or a computer implemented invention, usually in the form of a computer system.

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

Mental activity per se or as part of the method/system can not be involved to have patent eligibility as per Article 19, fraction III of Mexican IP Law thus, claims must be directed to the functionalities provided by the technical/physical means.

Design rights

6. Can GUls generally be protected by design rights?

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

Yes

Please Explain

GUls can be protected by design rights. Mexican IP Law contemplates two Industrial Design categories: Drawings for two dimensional designs and Models for three-dimensional designs (objects). GUls are included within the definition of Industrial Drawings and, therefore, they are subject to registration.

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


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?

According to Article 32 of MIPL an Industrial Drawing must be constituted by a combination of shapes, lines or colors incorporated in an industrial product (e.g. article, device). The scope of protection is given by the elements shown in the drawings.

<table>
<thead>
<tr>
<th>7a</th>
<th>In particular is a GUI that temporarily appears on a screen of an electronic device considered a “design” that is protectable by design rights?</th>
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</table>
| Yes | Please Explain

As an Industrial Drawing

<table>
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<tr>
<th>7b</th>
<th>In particular is a GUI protectable by design rights independently from the design of the electronic device itself?</th>
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</table>
| Yes | Please Explain

GUI's design is protected as an Industrial Drawing while the electronic device is protected separately through an Industrial Model.

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<tr>
<th>7c</th>
<th>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?</th>
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</table>
| Yes | Please Explain

Separate elements can be protected in separate Industrial Drawing registrations

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<tr>
<th>7d</th>
<th>In particular are movements or screen transitions in a GUI protectable by design rights?</th>
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</table>
| No  | Please Explain

Animated designs of GUIs are not protectable as such.

The sequence of the screens showing the different movements or screen transitions can be protected as embodiments by illustrating all of them in the drawings. However, unity of invention may be compromised, depending on the variation of the design across the transitions so, eventually separate applications may be required.

<table>
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<tr>
<th>7e</th>
<th>In particular are there any other types or aspects of GUIs protectable by design rights? If so, under what conditions and to what extent?</th>
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<tr>
<td>Yes</td>
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</table>
**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 Article 13 of the Mexican Federal Copyright Law, the graphic aspects can be protected as a Drawing work; animation aspects can be protected as an Audiovisual work and; the software that provies the functionality can be protected as a Computer program, but not the functionality itself.

3. **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 affect eligibility; the graphic elements shown on the screen are considered artworks, despite of being computer generated, as they are previously designed or its design is programed by an author.

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?**

   Graphic aspects and dynamic aspects of GUIs are protectable under copyrights. The originality aspect and the author’s expesion is protected. The work has to be fixed on any material medium (Articles 3, 4, 5 and 6). The FCL establishes moral and patrimonial rights, which are available to the same extent as any other copyrightable work.

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
Overall (look and feel) protection of GUIs is available since FCL provides protection to works fixed in any material media, that includes: the incorporation of letters, numbers, signs, sounds, images and other elements by means of which the work has been expressed (Articles 5 and 6).

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

**Trademarks**

Can GUIs generally be protected as trademarks?

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

No

Please Explain

Article 90 fraction I of MIPL establishes that three-dimensional, animated or changing names, figures or shapes that are exposed in motion, even when visible, are not eligible as trademarks.

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

Yes

If so, which?

Distinctive graphic and phonetic elements are protectable, provided they are used to distinguish goods or services from a source (Articles 88 and 89).

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?

GUIs are protectable provided they refer to distinctive names or designs but animated representations are not eligible under Article 90, fraction I of MIPL.

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

No

Please Explain

Article 90 fraction I of MIPL establishes that three-dimensional, animated or changing names, figures or shapes that are exposed in motion, even when visible, are not eligible as trademarks.

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

MIPL in article 213 fraction XXVI of MIPL provides protection against unfair competition

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 213 fraction XXVI establishes as unfair competition the use of combination of trademarks and other operativee and branding elements with the intention to cause confusion in consumers about the true source of products or services but it depends upon the products or services related therewith

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

No

Please Explain

It is not sufficient since IPL does not provide protection for the functionality of the GUI’s nor for the animated aspects.

18 If no, how is your law deficient?

The protection provided by Industrial Property Law is limited to visual aspects in a static form (not dynamic) and for ornamental purposes but not for a function or operation of the article bearing the GUI; while Copyright Law provides protection on various aspects such as graphic, asthetic, sounds, animation, programs, etc. but limited to the recognition of authoral rights.

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

No
Please Explain

It is not clear since the protection is given to the visual static elements/aspects and it is subject to the interpretation of the examiners and practitioners either for prosecution and enforcement.

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

The MIPL does not provide any type of protection considering all aspects of GUI's such as design, functionality and animation.

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)?

Yes

Please Explain

Protection provided by MIPL to GUIs could be improved by extending design protection to the associated animation (dynamic design) and the function or operation related therewith.

III. Proposals for harmonisation

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.

Yes

Please Explain

IP Laws should be updated to respond to current needs and the experience in different jurisdictions should be considered to produce legal instruments that provide legal certainty to all IP system users.

Patents

Should GUIs generally be capable of protection by patents?

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

No

Please Explain

Article 19, fracción V establishes that the "methods of presenting information" are not eligible for patent since they are not considered as inventions.

If not, should at least some types or aspects of GUIs be protectable by patents?
Functionality aspects of GUIs are protectable by current IPL by complying with patentability requirements (novelty, inventive step and industrial applicability) and should remain the same.

Please explain your reasons.

Functionality aspects of GUIs may involve patentable subject matter and inventor's rights should be recognized.

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

By complying with patentability criteria as a method, system or computer implemented invention avoiding claiming non-eligible subject matter per Article 19, such as mental activity, computer program per se, method of presenting information, etc.

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

Yes

If so, to what extent?

The steps involving a mental activity in a GUI process should not be claimed as part of the invention.

Please explain your reasons.

Involvement of user’s mental activities in a GUI process should affect the patentability since mental activity is not an invention and the result may be unpredictable and cannot be replicable.

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

Yes

Please explain your reasons.

Because under Mexican practice a claim for a system or computer implemented invention (method) requires a well defined tangible elements to be described.

What claim formats should be available for protecting GUIs?

As in the present, the claim should be a system or method claim.
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

Design rights provide protection to aesthetic aspects related to industrial products.

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

Please explain your reasons.

The aesthetic/ornamental aspects should be protectable under Design rights, including the static and animated graphic aspects in reference to a function or operation of the article bearing the GUI.

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

GUI’s designs must meet the standards of novelty or originality. Protection should be available either for static elements and dynamic elements that may be shown in motion or transformed in any manner in a screen and also to screen transitions associated to a function.

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

Yes

Please explain your reasons.

Dynamic elements shown in motion or transformed in any manner in a screen and also to screen transitions associated to a function should be protectable as such to provide legal certainty.

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

Yes

Please explain your reasons.

GUIs should be protectable by design rights and they should be tied to an industrial product it is meant to be used in. The design of the electronic device should be protected separately from the GUI design, since the GUI may be used in a number of different electronic devices.

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

Available protection provided by FCL for various aspects such as graphic, asthetic, sounds, animation, computer programs should remain the same as artworks.

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

Please explain your reasons.

GUIs involve a number of artworks and copyrights of the designers, programmers and creators should be recognized.

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

No

Please explain your reasons.

Available protection for various aspects such as graphic, aesthetic, sounds, animation, computer programs should remain the same as artworks.

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

In the same conditions and extent as current available protection.

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

Yes

Please explain your reasons.

Overall (look and feel) protection is available by copyright and it should remain the same, no matter the different aspects may require separate registrations.

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

No

Please Explain

GUI's per se should not be protectable as trademarks since MIPL requires for a trademark to be visible signs that distinguish goods or services from a source.

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

No

Please Explain

Only graphic and phonetic elements/aspects of the GUI's should be allowable for trademark protection.

33.2. Please explain your reasons

Trademark protection should be available when graphic or phonetic elements of a GUI are not only meant to provide the function or operation of an article but also is used to distinguish goods or services from a source.

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

Under the same conditions and extent as any distinctive sign protected under a trademark registration.

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

Yes

Please Explain

Protection for dynamic or animated graphic elements should be available since current electronic media allow the use of dynamic designs that provide originality to distinctive signs.

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

No

Please Explain

GUI's designs should not be required to acquire secondary meaning nor other requirement different to those established for any trademark.
### Other forms of protection

<table>
<thead>
<tr>
<th>35</th>
<th>Should there by other forms of protection for GUIs? If so, what forms of protection should there be?</th>
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<tr>
<td>Yes</td>
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<td>Please explain your reasons</td>
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</table>

A sui generis form of protection for GUI's designs should be available to provide legal certainty and that the extent of the protection is clearly defined.

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<thead>
<tr>
<th>36</th>
<th>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?</th>
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<tbody>
<tr>
<td>If yes, please answer questions 37, if no, please go to question 38</td>
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<td>Please Explain</td>
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Protection should be available either for static elements and dynamic elements that may be shown in motion or in any manner transformed in a screen as well as for screen transitions and associated to a function or operation of an article or device.

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<tr>
<th>37</th>
<th>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?</th>
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<tbody>
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Limitation should be set by the graphic either static and dinamic elements associated to a function and a kind of device or group of devices. Thus, the method, system, program or any other element providing the functionality should be excluded.

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<th>38</th>
<th>Please comment on any additional issues concerning protection of GUIs that your Group considers relevant to this Study Question</th>
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<tbody>
<tr>
<td>If a sui generis right for protection of GUIs is available, it should provide protection not only to graphic elements either static, in motion or transitions but also to other elements that may be part of the dynamics such as sound or variations precived by touch.</td>
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Please indicate which industry sector views are included in part "Ill. Proposals of harmonization" on this form:

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.