

## Victorious Samsung “not as cool” as Apple, rules Birss

Over the past year, the business and technology pages of newspapers and websites across the globe have been awash with stories of the so-called “**smartphone wars**”, which have thrust intellectual property issues to the forefront of the world’s media.

### Background

With so much attention on the legal battles between the world’s major smartphone players, it would have been easy to overlook the importance of the recent case of *Samsung Electronics (UK) Limited v Apple Inc.* heard by the High Court of England and Wales, the significance being that this was the first substantive hearing in the European Union between the two parties of the issue of infringement of Apple’s Registered Community Design No. 000181607-0001 (“the RCD”).

Samsung, the claimant, sought a declaration that three of its Galaxy tablet computers (the Tab 10.1, Tab 8.9 and Tab 7.7) do not infringe the RCD, with Apple counterclaiming for infringement. The validity of the RCD was not at issue in this case, but is presently being disputed before OHIM.

An initial consideration for Judge Birss QC was whether the counterclaim for infringement should be stayed in view of the pending invalidity proceedings before OHIM. Before the Court of Appeal of England and Wales, Apple had applied for the whole proceedings to be stayed pending the outcome of the invalidity action. However, the Court of Appeal ruled that the declaration of

non-infringement must not be stayed, and that the decision as to whether the counterclaim for infringement should be stayed rested on the trial court’s interpretation of Art. 91(1) of the Community Design Regulation 6/2002. Article 91(1) has the effect that, in view of the pending OHIM proceedings, Samsung’s claim for a declaration of non-infringement should not be stayed, but requires that Apple’s counterclaim for infringement be stayed unless there are “special grounds” allowing the claim to proceed.

The judge indicated that any “special grounds” would need to be sufficient to justify the risk that parallel proceedings on the same issue could result in inconsistent judgements between a Community design court and OHIM. He concluded that because the proceedings before him did not include validity, and taking into account that there existed a need for a speedy determination of the claim and that the parties agreed that the counterclaim should not be stayed, the “special grounds” criterion was satisfied and the counterclaim for infringement need not be stayed. Hence, neither the claim for a declaration of non-infringement nor the counterclaim for infringement was stayed as a result of the pending OHIM invalidity proceedings.

Turning to the RCD itself, the judge pointed out that none of Apple’s existing commercial products could be said to be a concrete example of the RCD, with neither the iPad nor the iPad 2 being identical to the RCD. In considering the potential infringement of the RCD, the judge reminded himself that the decision must be based on whether any of the Samsung tablets creates the same overall impression on the informed user as the RCD.

Apple submitted that the similarities between the RCD and the Samsung tablets are as follows, and these were considered by the judge:

1. A rectangular, biaxially symmetrical slab with four evenly, slightly rounded corners;
2. A flat transparent surface without any ornamentation covering the entire front of the device up to the rim;
3. A very thin rim of constant width, surrounding and flush with the front transparent surface;
4. A rectangular display screen surrounded by a plain border of generally constant width centred beneath the transparent surface;

5. A substantially flat rear surface which curves upwards at the sides and comes to meet the front surface at a crisp outer edge;
6. A thin profile, the impression of which is emphasised by (5) above;
7. Overall, a design of extreme simplicity without features which specify orientation.

The judge assessed both the existing design corpus (taken to include a number of handheld computers and computer monitors) and the degree of design freedom involved in creating each feature of the allegedly infringing articles. In each case, he weighed up whether the design constraint involved was sufficient to account for a particular similarity between the Samsung tablets and the Apple design, and also assessed the significance of each similarity based on whether a similar feature appears in other designs within the corpus. He noted that a design should receive a broader scope of protection where the registered design is markedly different to the design corpus and a narrower scope of protection where it differs only slightly from the design corpus. Judge Birss also pointed out that the informed user in this case is someone who is interested in aesthetics and, therefore, that how a product looks matters to the informed user. The products making up the design corpus are not purely functional designs.

Whilst acknowledging that the RCD in question is a European Community wide right and therefore that harmony between courts of different member states is desirable, the judge disagreed with the Dutch and German Courts of Appeal on interpretation of two important designs within the corpus. He therefore placed no reliance on earlier decisions of those courts and, in so doing, highlighted their "preliminary character".

Both Apple and Samsung employed the use of an expert witness to give an opinion on the design freedom afforded to the designer of the Samsung tablets. Mr Sherman, called by Samsung, explained technical or functional reasoning for each of the seven features identified by Apple, indicating that the designer of the Samsung tablets would have had very limited design freedom. Conversely, Mr

Ball, called by Apple, offered the view that, for each of the features in issue, a wide range of options existed which were available to the designer.

In reaching his decision, Judge Birss identified the most important similarities between the Samsung tablets and the RCD as being the similarity between their respective front views (described as being "really very striking"), the lack of lights or buttons on the front surface and of obvious switches or fittings on other surfaces, and the curved sides which have a "thinness enhancing effect". However, major differences were identified as being the relative thinness of the Samsung tablets compared with that of the Apple design, and the inclusion of detailing on the back surface of the Samsung tablets although the fact that the ornamentation was on the back surface as opposed to the front was said to reduce its significance somewhat.

Apple had argued that advances in technology would mean that the informed user would not attribute much significance to the fact that the Galaxy tablets are so much thinner; they are thinner because technology has advanced. However, the judge disagreed, stating that the informed user would notice the significant difference in thickness, and rejecting on principle the argument that technological advances could reduce the significance of some differences to the informed user, which could result in registered designs increasing in scope as technology moves forward.

The judge's view was that, although the similarities between the Samsung tablets and the RCD are striking in the first instance, they would not be so striking on the informed user (which the judge acknowledged he was not, initially). He highlighted the importance of taking into account the informed user's knowledge of the design corpus in weighing up the similarities between the designs' front views and the differences between their thicknesses and back surfaces. Based on the design corpus, the judge felt that the informed user would observantly recognise the front view of the Apple design as being familiar within the design corpus and therefore the significance of the similarities between the front views of the Samsung tablets and that of the RCD

would be reduced, such that the informed user's attention to the differences between the back surfaces would be enhanced.

Judge Birss then held that the informed user's overall impression of each of the Samsung tablets is different to the Apple design, commenting that "From the front they belong to the family which includes the Apple design; but the Samsung products are very thin, almost insubstantial members of that family with unusual details on the back." In a final statement which will no doubt draw additional attention to this already important case, Judge Birss concluded that the Samsung tablets "do not have the same understated and extreme simplicity which is possessed by the Apple design. They are not as cool."

## Conclusion

This decision, and its likely effect on future decisions throughout the Community, will no doubt be debated in the months to come. It is probable though that the outcome will reinforce the view already held by many that registered design protection can afford its owner a distinctly narrow scope of protection, particularly in fields as saturated as the current smartphone climate, owing to an extensive design corpus.

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## Need advice?

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