Apple loses appeal on "cool" design

Back in July 2012, we **reported** on the much-publicised dispute between Samsung Electronics (UK) Limited and Apple Inc., heard by the High Court of England and Wales on the issue of infringement of Apple's Registered Community Design (RCD) 000181607-0001.

Background

In that case, Judge Colin Birss concluded that three of Samsung's Galaxy tablet computers (the Tab 10.1, Tab 8. and Tab 7.7) did not infringe the RCD and were "not as cool" as the Apple design. On 28th September 2012, the Court of Appeal of England and Wales heard appeals against this decision and a second decision given by Judge Birss to the effect that Apple should be compelled to publicise the fact that it had lost in specified trade magazines and newspapers, and on its own website.

The Court of Appeal, constituted by Sir Robin Jacob with Lord Justice Longmore and Lord Justice Kitchin, commenced proceedings by clarifying what this case is and isn't about.

> "It is not about whether Samsung copied Apple's iPad. Infringement of a registered design does not involve any question of whether there was copying: the issue is simply whether the accused design is too close to the registered design according to the tests laid down in the law".

The Court also noted that the RCD is not the same design as the iPad, and the case must be assessed as if the iPad never existed.

On the subject of infringement, the appeal judges came to the conclusion that Judge Birss was correct in his assertion that the Samsung tablets do not infringe because they create a different overall impression on the informed user. They indicated that they could not see "any material error" in Judge Birss's judgement.

One interesting discussion centred on Apple's submission that the informed user would know and expect that advances in technology would make thinner tablets possible, meaning that he would attribute little significance to changes in thickness (the Samsung tablets are considerably thinner than the RCD). Sir Robin disagreed, stating "if the informed user could foresee thinner tablets ere long so could Apple whom the informed user would take to have the same prevision. Thus the informed user would take the thickness to be a deliberate design choice by Apple".

The appeal judges also endorsed Judge Birss's approach in paying considerable attention to Apple's own contention that a key feature of the RCD was a lack of ornamentation on both the front and back of the device. Given this information, the appeal judges agreed with Judge Birss that any ornamentation, even the addition of a Samsung trade mark, represents a noticeable departure from the RCD which would be taken into account by the informed user. Sir Robin contrasted this with the position taken in a related German decision which held, erroneously in the view of the Court of Appeal, that how the trade mark affected the appearance should be ignored altogether.

Apple also argued that Judge Birss had approached the design corpus wrongly and failed to consider the overall impression of the RCD, choosing instead to carry out the comparison feature by feature. As Mr. Silverleaf acting on behalf of Apple put it, you cannot pick out features from the prior art and say "those articles have that feature, these articles have this feature, those articles have a third feature and, therefore, those features do not really count". The appeal judges accepted this submission as a point of law, but indicated that Judge Birss did not remotely do that and "was entirely aware of the need to consider the overall impression of the design as it would strike the informed user bearing in mind both the design corpus and the extent of design freedom". Sir Robin expressed his opinion that Judge Birss had assessed the significance between the RCD and the design corpus in a manner which could not be bettered.

The decision of the Court of Appeal also reviewed parallel proceedings in other jurisdictions (The Netherlands, Spain, Germany (as already mentioned) and The USA), noting that no injunction now exists anywhere in the world based on the RCD or an equivalent. On the German case, Sir Robin was further critical of the Oberlandesgericht for granting a pan-European injunction after Judge Birss's Community-wide declaration of non-infringement (Judge Birss was sitting as a Community design court, not a national court, and the

Court of Appeal believed that a national court had no place interfering with the Community-wide jurisdiction of Judge Birss's Court, or its Community-wide declaration). It was acknowledged, however, that Apple undertook to apply forthwith to the German court for that injunction to be completely withdrawn so far as it related to infringement of the registered design.

The Court of Appeal then turned to the question of whether a publicity order should be enforced, emphasising that "the grant of such an order is not to punish the party concerned for its behaviour. Nor is it to make it grovel – simply to lose face. The test is whether there is a need to dispel commercial uncertainty". Sir Robin explained that Judge Birss's original "not as cool" decision received such widespread publicity that a publicity order would not have been necessary had there been nothing else. However, in view of the publicity received by the decision of the Oberlandesgericht, which Apple attempted to enforce, "real commercial uncertainty" was created. Sir Robin commented:

> "Apple itself must (having created the confusion) make the position clear: that it acknowledges that the court has decided that these Samsung products do not infringe its registered design. The acknowledgement must come from the horse's mouth. Nothing short of that will be sure to do the job completely".

This view was endorsed by the accompanying appeal judges. Apple is therefore obliged to publicise in specified trade magazines and newspapers and on its own website (for a period of one month and via a link), that the Samsung tablets do not infringe the RCD.

This decision will certainly not be the last we hear in the intellectual property "war" between Samsung and Apple, but it provides welcome relief for Samsung just months after a US jury awarded Apple $1.05bn (£644m) damages after finding Samsung had infringed several of Apple's design and software patents.

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