

**NALSAR PROXIMATE EDUCATION
NALSAR UNIVERSITY OF LAW, HYDERABAD
P.G.DIPLOMA IN PATENTS LAW**

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Paper IV - Abuse of Patents (Practical)

Time: 2 ½ hours.

Total Marks: 90

INSTRUCTIONS TO CANDIDATES

1. The questions to be interpreted as given and no clarification can be sought from the invigilator.
2. All questions carry equal marks (30 marks each)

You are required to answer the questions – the crucial issues involved in this analysis of the suit of Apple against Samsung and bring out your theoretical understanding of Infringement on the background of this blog. NALSAR Proximate acknowledges Nialy Patel and This is My Next web source for helping us to expand our efforts on creative effort of imparting Patent Jurisprudence examination.

Apple sues Samsung: a complete lawsuit analysis

Background

The background section of Apple's complaint has a couple interesting nuggets in it: Apple's sold "over 60 million" iPod touches as of March 2011, which is the first time a specific number has ever been broken out for that device, and we're also told that 108m iPhones and 19m iPads have been sold. What's more, Apple spent more than \$2 billion advertising the iPhone, iPod touch, and iPad during its fiscal years 2007 to 2010.

It's in this section that Apple also lays out what it considers to be its protectable intellectual property: seven utility patents, three design patents, trademarks on several iOS system app icons, and a host of trade dress registrations on the iPhone, iPod touch, iPad, and the packaging that each comes in. (Yes, the packaging — companies spend millions designing gadget boxes, after all.)

We're also told that Apple views the Samsung Captivate, Continuum, Vibrant, Galaxy S 4G, Epic 4G, Indulge, Mesmerize, Showcase, Fascinate, Nexus S, Gem, Transform, Intercept, and Acclaim phones as infringing its various IP, as well as the Galaxy Tab. It's also clear Apple has particular scorn for TouchWiz'd Galaxy S devices, saying "The copying is so pervasive, that [they] appear to be actual Apple products." The rest of the background section is really just the foundation for Apple's actual claims, so let's take a look at them in order and talk about what they mean, shall we?

The claims

We're going to take the claims one-by-one, but structurally it's notable that trade dress is the first listed claim, as claims are traditionally ordered by some combination of perceived strength and importance. Apple was forced to focus on deeply-technical underlying Android system patents when it sued HTC and Motorola because Sense and Blur are highly differentiated from iOS and the actual products have unique hardware and packaging designs, but Samsung all but invited these additional and somewhat more subjective claims by hewing so closely to Apple's conventions. And at this stage of the game, more claims generally means more liability.

First claim: Trade dress infringement under 15 U.S.C. § 1125

You're probably familiar with patents, copyrights, and trademarks, the three main types of intellectual property. Trade dress is the wonky red-headed step-cousin of the family that fills the gaps between the three; you might think of it as a trademark on design elements that trigger consumer recognition. (That's a vastly simplified explanation, but it's good enough for our purposes.) Trademarks and trade dress are all about protecting consumers from being deceived in the marketplace — the idea is to clearly indicate the source of a product or service.

Think of it this way: the trademark "iPhone" is a made up word that consumers recognize, so Samsung can't call its phones the "Galaxy iPhone" because that would confuse consumers about the source of the product. Similarly, Apple's claim is that the iPhone's box and design scream "Apple" to consumers just as strongly as the word "iPhone." Simple, right?

Oh, and don't conflate trade dress with Apple's doomed copyright-based "look and feel" lawsuit against Microsoft in the 90s — it's totally different. Trade dress law is well-established, and Apple itself has a history of successfully pursuing trade dress claims in the Northern District of California. In 2000 the company sued both eMachines and a company called Future Power for knocking off the iMac's trade dress, winning injunctions in both cases and eventually getting extremely restrictive settlements that effectively removed the infringing products from the marketplace.

So with all that background, here's Apple's list of trade dress elements it thinks Samsung is infringing:

Hardware and software trade dress claims

- a rectangular product shape with all four corners uniformly rounded;
- the front surface of the product dominated by a screen surface with black borders;
- as to the iPhone and iPod touch products, substantial black borders above and below the screen having roughly equal width and narrower black borders on either side of the screen having roughly equal width;
- as to the iPad product, substantial black borders on all sides being roughly equal in width;
- a metallic surround framing the perimeter of the top surface;
- a display of a grid of colorful square icons with uniformly rounded corners; and
- a bottom row of square icons (the "Springboard") set off from the other icons and that do not change as the other pages of the user interface are viewed.

Packaging trade dress claims

- a rectangular box with minimal metallic silver lettering and a large front-view picture of the product prominently on the top surface of the box;
- a two-piece box wherein the bottom piece is completely nested in the top piece; and
- use of a tray that cradles products to make them immediately visible upon opening the box.

Now, some of these are a little ridiculous when taken individually — is Apple going to sue every digital photo frame maker that puts equal size black borders around the screen as well? — but in the end, the main question for the court will be whether or not Samsung has used all of these elements in a way that's likely to confuse consumers about what they're buying. Does the overall impression of Samsung's hardware and software lead people to think it's actually from Apple? Does the box? (We're simplifying again, but that's the crux of the issue.) In response, Samsung's best bet is to argue that its products and packaging aren't confusingly similar, and if that doesn't work, to somehow prove that consumers aren't actually being confused. It sounds simple, but, well, that's only because we're

simplifying it. In reality this one claim alone will cost both parties millions of dollars to litigate. And there are 15 more to go — so let's get to it.

Second claim: Federal trade dress infringement under 15 U.S.C. § 1114



This second trade dress claim is the more simple and direct of the two, because it deals with three specific iPhone trade dress elements Apple's registered with the US Patent and Trademark office. That means Apple's already convinced the USPTO these elements are distinctive and protectable; with the first claim Apple will have to start from scratch.

U.S. Registration No. 3,470,983 is for the overall design of the product, including the rectangular shape, the rounded corners, the silver edges, the black face, and the display of sixteen colorful icons.

U.S. Registration No. 3,457,218 is for the configuration of a rectangular handheld mobile digital electronic device with rounded corners.

U.S. Registration No. 3,475,327 is for a rectangular handheld mobile digital electronic device with a gray rectangular portion in the center, a black band above and below the gray rectangle and on the curved corners, and a silver outer border and side.

For Samsung, it's the same story: the best strategy is to deny any similarities, and back that up with data that shows consumers aren't actually being confused.

Third claim: Federal trademark infringement under 15 U.S.C. § 1114

This one's pretty simple, and on its face it looks like the strongest claim of them all: Apple's registered trademarks on several iOS system icons, and TouchWiz includes six icons that look almost exactly the same. The facts here literally line right up — we'll put the iOS icon on the left and the TouchWiz icon on the right.



No. 3,886,196 is the iOS phone app icon.

No. 3,889,642 is the iOS messaging app icon.

No. 3,886,200 is the iOS photos app icon.

No. 3,889,685 is the iOS settings app icon.

No. 3,886,169 is the iOS notes app icon.

No. 3,886,197 is the iOS contacts icon.

Pending No. 85/041,463 is the iTunes icon, which is a riff on U.S. Registration No. 2,935,038, the desktop iTunes logo.

It's going to be far harder for Samsung to argue out of some of these — in some cases, like the phone icon, the similarities are impossible to ignore. You might argue that the design of the phone icon is ridiculously trivial and obvious, but consider the flipside: Apple can argue just as persuasively that Samsung had a million options for a phone icon and instead chose a white handset resting at an angle on a green gradient background. Samsung's lawyers are going to have get creative with this one.

Fourth claim: common law trademark infringement

This one's a catch-all — it's there to pick up the pieces from the federal trademark claims and to strengthen the claim on the iTunes icon, which is still pending registration.

Fifth claim: Unfair business practices under the California Business and Professions Code

This is a state-level version of the trade dress and trademark claims — it's there to pick up the pieces in case the federal claims somehow don't pass muster. I'm not a California lawyer, so I'm not too familiar with these statutes — let me know if I missed something important here.

Sixth claim: Unjust enrichment

Yet another state-level claim that feels like a catch-all in case everything else fails — Apple's arguing that whether or not Samsung's conduct rose to actual infringement its trade dress, trademarks, and patents, Samsung still unfairly profited by copying Apple's work.

Let's skip ahead here and deal with the design patents now as well, since they're of the same theme — you might as well call this bundle the Galaxy / TouchWiz claims, since they're all to do with Samsung-specific hardware and software.

The rule for design patent infringement is relatively simple: if the two designs are substantially similar enough to trick an ordinary person into thinking they're the same, it's probably an infringement. Got it? So let's look at Apple's three iPhone design patents.



FIG. 1

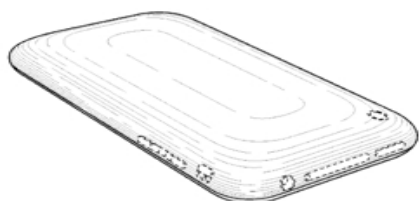


FIG. 2

Patent #D627,790: Graphical User Interface For a Display Screen or Portion Thereof. This is the iOS homescreen — the grid of icons.

Patent #D602,016: Electronic Device. This is the iPhone 3G / 3GS design, as seen to the left. The broken lines that form the screen and the button aren't part of the patent, just the device's shell, so any button or screen size differences on Samsung's devices don't matter.

Patent #D618,677: Electronic Device. This is the opposite of '677 — it's the screen and button design of the iPhone. The broken lines that form the case aren't part of the patent.

Okay, so that's all the Samsung-specific stuff. At nine claims out of sixteen, it's actually the bulk of the lawsuit — making this case much different than Apple's other lawsuits against Android phone manufacturers. But that doesn't mean there isn't some Android-related stuff in here. Far from it, in fact — in addition to asserting some of the same patents against Android that it's using in other lawsuits, Apple's picked out several new ones that we haven't seen litigated yet. Let's burn through them.

Seventh claim: Infringement of the '002 patent

Patent #6,493,002, delightfully titled **Method and Apparatus for Displaying and Accessing Control and Status Information in a Computer System**, is new to the Apple / Android litigation party. It was filed in 1997 and granted in 2002, so the connection to iOS and Android is a little harder to see — it covers a system that pops open a window to show multiple interactive control widgets. The drawings are of the old OS 9 control bar, but one could see how this applies to the Android control widgets. We'll have to see what Apple specifically argues with this one.

Eighth claim: Infringement of the '381 patent

You remember Patent #7,469,381, don't you? **List Scrolling and Document Translation, Scaling and Rotation on a Touch-Screen Display**? No, of course you don't. You are busy having a real life, and possibly interacting with other humans. '381 is one of Apple's first iOS-related patents — it covers the “bounce” effect you get on iOS when you scroll top the top or bottom of a list. We talked about it way back in January 2009 when everyone thought Apple cared enough about Palm's impact on the market to do anything except patiently wait for a six-month Sprint exclusive to slowly and inevitably choke the company to death. Those, friends — those were the days.

Ninth claim: Infringement of the '134 patent

Patent #7,669,134 is titled **Method and Apparatus For Displaying Information During An Instant Messaging Session**, and that's no lie — it covers arranging incoming messages in a communications session in a timeline that's horizontally spaced. In simple terms? It covers the iChat and iOS cartoon-bubble chat interface. That's pretty much exactly what Samsung's TouchWiz chat interface looks like.

Tenth claim: Infringement of the '828 patent

Patent #7,812,828 is a wonky technical patent related to touchscreen input — titled **Ellipse Fitting For Multi-Touch Surfaces**, it covers taking touch impressions mapping them to ellipses. Apple's also asserting this one against Motorola, so Cupertino's lawyers probably feel pretty good about it — and when a patent lawyer friend of mine read it, he actually said “whoa, nice claim.” This is a true story.

Eleventh claim: Infringement of the '915 patent

Patent #7,844,915 is titled **Application programming interfaces for scrolling operations**, and it covers deciding when a user is using one finger to scroll a view versus two or more fingers to scale that same view. At first read, this seems like a pretty fundamental multitouch patent, so we'll see how successfully Samsung challenges it — if it holds up, Apple will have a very potent arrow in its quiver.

Twelfth claim: Infringement of the '891 patent

Patent #7,853,891, titled **Method and apparatus for displaying a window for a user interface**, covers displaying an overlay window over the standard UI in response to a keystroke and having it disappear automatically after some predefined amount of time. In other words, it covers things like the iOS volume display, which automatically fades out after you've adjusted the volume. This is a relatively new patent, just granted on December 14, 2010, so we'll see what the courts do with it — there are plenty of elements in Android that exhibit this behavior.

Thirteenth claim: Infringement of the '533 patent

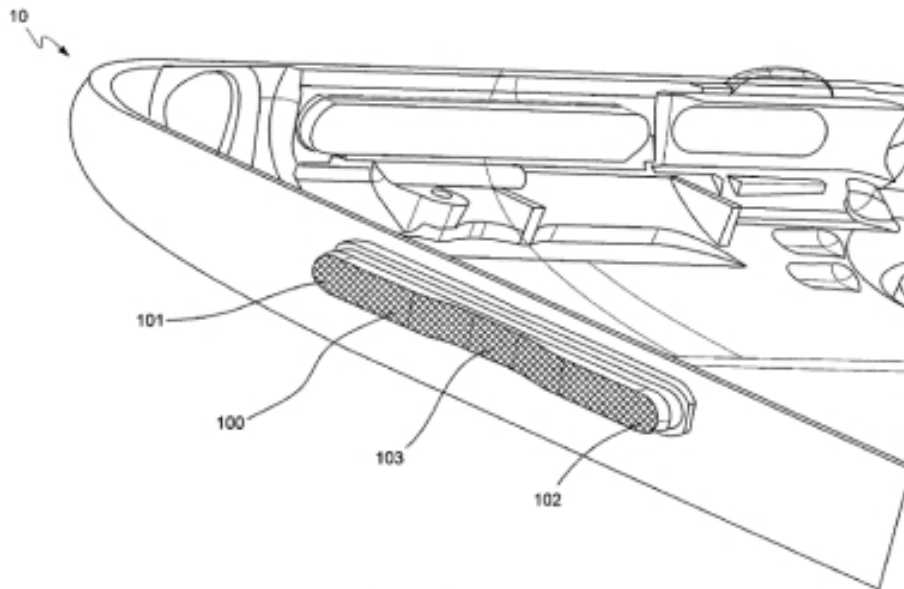


FIG. 1

Claims fourteen, fifteen, and sixteen: infringement of design patents

Just when you were getting your head around trade dress, we're throwing design patents into the mix. There's actually a pretty simple relationship between the two — if trade dress is all about the product design's relationship to the consumer, a design patent is all about the design of the product itself. Think about it like this: if you designed a new phone with a novel design, you could get a design patent. Once you started selling it and your customers started associating that design with your products, you'd be protected by trade dress. (Again, a gross simplification, but we're aiming for broad contours here.) Oh, and design patents expire just like every other patent, while trade dress lasts as long as the item is in commerce. The classic example is the Coke bottle, which carries a distinctive decorative shape — it was given a design patent that eventually expired, but it's still protected under trade dress because consumers associate that shape with Coca-Cola.

ANSWER THE FOLLOWING QUESTIONS

1. Enumerate the patent infringement claims from the above analysis and analyse whether it is direct infringement or indirect infringement by Samsung.
2. According to the blog what are the criticisms leveled against Apple on its suit?
3. Discuss the concept of 'Doctrine of Equivalents' and analyse whether any of the alleged infringing acts of Samsung falls under the same.

Source: Reproduced above is the web posting of Nilay Patel –

<http://web.archive.org/web/20110421044348/http://thisismynext.com/2011/04/19/apple-sues-samsung-analysis/>