

# Apple and Samsung: What's behind the patent fight

At issue: Just how far a person or company can go to patent a design

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Samsung took a step toward finding a kind of "pax tabletica" with arch-foe Apple in an Australian court last week, offering to remove features from its Galaxy Tab to avoid a court ban on sales of the device in that country. But what's really interesting about the case isn't the technical litigation, but the underlying attempt to define how much of a product's design is actually protected under existing, fragmented international laws.

The fight began in April, when [Apple sued Samsung](#) for allegedly copying Apple's tablet and smartphone designs. Shortly thereafter, [Samsung countersued](#), and the battle was on.

In some ways, the various legal cases now pending between the two companies -- just today [Samsung went after planned sales the iPhone 4S](#) in Italy and France -- seem likely to force courts worldwide to make decisive judgments on just how far a person can patent a design.

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## Defining design protection

"Apple's complaint is notable because it also cites the overall product design and onscreen interface," said Ilya Kazi, Chartered Patent Attorney and partner at leading intellectual property advisors [Mathys & Squire](#) in London. These are sometimes called 'trade dress' issues as well as involving aesthetic designs.

"The original suit claims that Samsung's products infringe Apple's technical ('utility') patents relating to user interaction, specifically pinching, zooming, scrolling, and selecting," Kazi said. "Apple also accuses Samsung of breaching design patents, most notably the flat black face of the iPhone and iPad."

Samsung's unusual response to Apple's original U.S. lawsuit included citing as 'prior art' -- information already public before Apple's patent was filed -- a video device depicted in the film *2001: A Space Odyssey*.

Samsung refers to a scene in the 1968 Stanley Kubrick classic where actors watch a TV news broadcast from what appears to be a digital newspaper and describes the scene as astronauts "using personal tablet computers." This is an attempt to limit what Apple can claim

is unique to the iPad and is part of a global search for antecedents, according to patent law experts.

"I think it's fair to say this is the most high-profile design case we've ever had and this is really testing the system in these different countries, forcing them to make decisions on difficult issues about design," said Chris Carani, chairman of the American Bar Association's Industrial Designs Committee for 2011-13. He is also a patent attorney at Chicago-based IP law firm McAndrews, Held & Malloy.

## **The 1871 precedent**

In the U.S., Apple must only satisfy a single requirement to prove its claim. This dates back to an 1871 decision in the *Gorham v. Company v. White* case. To show U.S. courts that a design patent has been abused, Apple must show that:

"If, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same -- if the resemblance is such as to deceive such an observer and sufficient to induce him to purchase one supposing it to be the other -- the one first patented is infringed by the other."

Apple's culture of industrial design, which has won high marks for everything from the original iMac to the Cube to peripherals like the Apple mouse -- has helped the company achieve its high levels of success; purity of design is part of the Apple allure.

The challenge for judges is huge: "Countries will need to grapple with the question of how should scope be declared when you have such limited choices," said Carani.

Given the stripped-down simplicity of Apple product design, Samsung may try to argue that when you have a limited number of design choices, infringement can be avoided by changing the smallest detail. Apple could counter that no one ever claimed a tablet needs to be rectangular, and no one demanded that all tablets have straight edges.

Adding to the difficulty of making all-encompassing rulings on design is a bigger problem; every jurisdiction in which the legal fights are now taking place operates under different rules. It's theoretically possible for Apple to win a specific point in some countries, which could make it hard to take a product and turn it into an icon by ensuring it is consistent.

## **Why consistency matters**

In the U.S. -- the world's biggest consumer electronics market -- Apple and Samsung appear to have been headed for a showdown for years. In 2001, Apple secured just 10 design patents; in 2008, 64. Last year, the company achieved 154 such patents. But Samsung became the "top dog in the U.S. for issued design patents" in 2010, Carani said.

But because U.S. design patent protection demands only that items look "substantially" the same in the "eyes of a preliminary observer," Apple's best shot at winning the fight may be there. That may be what prompted Samsung to offer Apple a secret deal under which it would strip features from its Galaxy Tab in Australia. (These were technical features, not design-related.) Terms of the deal have not been revealed, and Apple has since rejected that overture.

The Korean firm had already begun to remove features from its tablet. (The original Apple filing noted 13 such patents; that number is now down to just three.)

## The technical war

The Korean firm has plenty of its own intellectual property with which to fight back. In the Netherlands, Samsung says Apple is using some of its own UMTS technical patents without permission, telling the Dutch court, "Apple is consciously, structurally infringing the 3G patents."

Apple's response? To assert that these patents are for widely-deployed technologies. It argues that Samsung is demanding an "excessive" (2.4%) royalty on 3G chips used in Apple devices, and says it is "abusively" asserting UMTS patents to get away with "illicit" copying.

Because licensing talks are ongoing, an injunction on this basis is unlikely. The Dutch judge is expected to declare whether Samsung has a case on Oct. 14. Ironically, that's also the date on which [the new iPhone 4S](#), unveiled just yesterday, actually goes on sale.

"The key thing to know about wireless standards is that if someone managed to shut down all adopters of such a standard, users of one phone could no longer connect with others," said Florian Mueller, a patent activist and analyst who writes the FOSS Patents blog. "They wouldn't even be able to connect with their mobile network."

## A patchwork of decisions

There have already been several developments in the various legal fights.

- In Europe, Apple got a preliminary injunction against Samsung's Galaxy Tab. That decision, which originally stopped sales of the device across the European Union, was later scaled back to cover only Germany.
- Also in Europe, Apple won an injunction against selected Samsung smartphones running Android 2.2; that decision takes effect on Oct. 15.
- The aforementioned offer from Samsung -- eventually rejected by Apple -- to remove features from the Galaxy Tab in order to avoid a ban on the tablet's sale in Australia.

## The outcome ahead?

"The German court's weighing up of the factors in deciding to grant a preliminary injunction in this case may not be followed by courts in other European countries," warned Kazi.

Legal experts expect that the legal dramas now playing out in nine separate jurisdictions across the globe could drag on for years, but they think both parties will eventually broker a peace deal.

"The likely outcome is that Apple and Samsung will eventually settle with a cross-license one way or the other for an undisclosed amount [of money] after a succession of press releases and sideshow battles, and after the lawyers have assessed the overall picture and commercial teams have weighed up the costs and benefits of the continuing battle," Kazi said.

That Samsung's heavyweight legal teams have been unable to prevail against Apple's litigation is most telling, said Carani: "In my opinion, design patents can have teeth if they are prosecuted in a learned and strategic fashion."

*Jonny Evans is a [Computerworld blogger](#) who writes extensively about Apple. You can follow him on [Google+](#) and on Twitter at [@jonnyevans\\_cw](#).*