Apple v. Samsung Design Patents Take Center Stage

By Christopher V. Carani

After operating in the intellectual property backwaters for years, design patents took center stage in the epic battle in *Apple Inc. v. Samsung Electronics Co.*[1] What ensued was a dispute, centered on design rights, between two consumer tech titans that captured the nation's attention—indeed the world's. The case's grip was felt not only in legal circles, but also in the mainstream press and media. After all, the case regarded symbols of our time—devices such as smartphones and tablets that impact our everyday lives. Indeed, the *Wall Street Journal* touted the case as "The Patent Trial of the Century."[2] Even the evening talk show circuit chimed in with both Conan O'Brien and *The Colbert Report* putting on skits that riffed on the case. Never has a patent infringement case, let alone one centered on *design* patents, received so much attention.

On August 24, 2012, before a packed courtroom, the most exciting words in legal theater were uttered: "The jury has reached its verdict." The future of the smartphone and tablet market weighed in the balance. As the world tuned in, the jury's findings were read aloud. Feverish tweeting and blogging abound, the verdict was bold and decisive: a $1.05 billion dollar verdict in favor of Apple, which if sustained will represent the largest patent infringement jury award of all time.[3] All 28 accused Samsung products were found to infringe; all of Apple's patents were found to be valid. Even recognizing that scores of judgments as a matter of law (JMOLs) are pending and inevitable appeals surely will follow, the verdict itself represents a coming out party for design rights in general. By taking the heavyweight boxing match into the 10th round, and prevailing, the strength of design patents surprised many, most assuredly Samsung.

In short, this article seeks to: (1) provide the facts and background necessary to understand the blockbuster dispute, (2) extract the critical implications of the jury's verdict, and (3) offer insights into potential outcomes and impacts as the case proceeds. The thrust of this article will focus on design patents,[4] which comprised the lion's share of the billion dollar damages award.[5]

Brief Background and Procedural History

In April 2011, Apple filed its lawsuit against Samsung in the U.S. District Court for the Northern District of California in San Jose, California, a mere 10 miles from Apple's headquarters in nearby Cupertino. From the get-go, Apple consistently pushed the pace of the case, moving simultaneously for a preliminary injunction *and* an expedited trial. Presiding Judge Koh granted (in part) Apple's request for a preliminary injunction, and also entered Apple's motion for an expedited trial. The jury trial commenced a mere 16 months after the initial complaint was filed, thereby halving the district's 32-month average pendency from filing to trial.

Apple's complaint (once amended) alleged that Samsung infringed eight utility patents, seven design patents, and six trade dress rights.[6] Before sending its case to the jury, however, and at the urging of Judge Koh, Apple trimmed down its allegations to just three utility patents, four design patents, and four trade dress rights.[7] Apple claimed that its intellectual property rights were infringed by 26 Samsung smartphones and two Samsung tablets.

Apple's narrative at trial was concise and consistent: Samsung's newfound success was the result of its "slavish copying" of Apple's world famous product designs. Indeed, Apple repeatedly used the following demonstrative at trial to illustrate this point. Notice the differences in appearances of the commercialized Samsung smartphones before and after the 2007 release of Apple's iPhone.[8]

Apple's Asserted Design Patents

The four Apple design patents presented to the jury were U.S. Patent Nos. D593,087; D618,677; D504,889; and D604,305.[9] The D'087 and D'677 patents both are directed to the ornamental appearance of a front face for smartphones, while the D'889 patent is directed to the overall appearance of a tablet. These three patents regard what is conventionally known as "industrial design." The D'305 patent, in contrast, is directed to "graphic design," implicating the digital graphic user interface that appears when a device is turned on. Representative images of the four asserted design patents are set forth below.

Samsung phones BEFORE iPhone	Apple's iPhone (announced Jan. 2007)	Samsung phones AFTER iPhone
		

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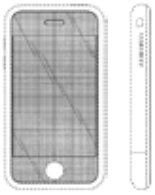


D'677 Patent

The D'677 patent, which claims an earliest priority date of January 5, 2007, discloses a single embodiment directed to the appearance of a front face of a device.

Samsung argued that the claim consisted of nothing but "a rectangle with rounded corners." Apple countered that the claimed design was more limited than that, noting that the drawings depict a vertically centered black flat front screen with edge-to-edge glass and further include a specifically shaped and placed speaker slot. The overall appearance of these features, Apple contended, created a visual impression that was novel and nonobvious in view of the prior art.

Apple claimed a black front face by using a cross-hatch in the drawings along with the statement in specification that the cross-hatching denotes the "designation for the color black." In addition to the black front face, the D'677 patent also specifically claims edge-to-edge glass on the front face of the smartphone. This surface treatment was affirmatively claimed in the D'677 patent by using "oblique" (i.e., diagonal) surface shading lines over the entire front face of the device. According to United States Patent and Trademark Office (USPTO) practice, oblique lines are required to depict transparent, translucent, highly polished, or reflective surfaces.[10]

While only the front face of the device is claimed, the D'677 patent does include perspective and side elevation views, which are important because they disclose the (lack of) contour on the front face. (A simple top plan view often does not provide enough information so that the contour of the surface can be discerned. By way of example, a single top plan view showing two concentric circles does not provide sufficient information to discern whether the inner circle is coplanar with the outer circle.) Here, the perspective view shows that that the front face is flat, and not angled, convex, concave, or otherwise contoured.

D'087 Patent

Unlike the D'677 patent, which discloses only a single embodiment, the D'087 patent, which claims an earliest priority date of January 5, 2007, discloses six different embodiments. All embodiments are directed at a front face with an outer bezel for an electronic device. None of the embodiments claim a specific color or surface treatment. As shown below, the differences between the D'087 patent's six various embodiments reside in various combinations of dotted and solid lines to depict (1) the upper speaker, (2) the screen border, and (3) the home button.

For example, and as shown above, in Embodiment 1 the speaker and screen border are depicted in dotted lines (i.e., "unclaimed"), while the home button is depicted in solid lines (i.e., "claimed"). Conversely, in Embodiment 6 the speaker and screen border are depicted in solid lines, while the home button is depicted in dotted lines. Thus, while multiple embodiments are most often used to depict variations in shape and form, here Apple used multiple embodiments to claim variations in claim scope. It should be remembered that while multiple embodiments may be included in the figures, design patents are permitted to have only a single claim. While only one embodiment need be infringed for there to be infringement, similarly, if one embodiment is found to be invalid, all embodiments fail.

Below is a chart summarizing the various combinations of claimed and unclaimed subject matter set forth in the six embodiments of the D'087 patent.

Embodiment	Speaker	Screen Border	Home Button
1	Unclaimed	Unclaimed	**Claimed**
2	Unclaimed	**Claimed**	Unclaimed
3	**Claimed**	Unclaimed	Unclaimed
4	Unclaimed	**Claimed**	**Claimed**
5	**Claimed**	Unclaimed	**Claimed**
6	**Claimed**	**Claimed**	Unclaimed

Here, Apple's strategic use of multiple embodiments and dotted lines was used to increase the scope of the single claimed design, providing it with much flexibility when it came to enforcement. It was ultimately Embodiment 6, which disclaimed the circular home button, that ensnared Samsung. Samsung's accused smartphones do not incorporate a circular home button.

The D'889 Patent

The asserted D'889 patent, which claims an earliest priority date of March 17, 2004, is directed to the appearance of a tablet, specifically, Apple's iPad. The D'889 patent discloses a single embodiment directed to the entire appearance of the tablet device. No portion of the tablet is disclaimed in the specification, and all six sides of the tablet are claimed (i.e., top, bottom, front, rear, right side, left side).[11] Significantly, and similar to the D'677 patent, some figures of the D'889 include "oblique" (i.e., diagonal) surface shading lines. For example, figures 1 and 3 depict a design having edge-to-edge glass over the entire front face of the device.

The inclusion of the oblique lines in the drawings is effectively a claim limitation, which, of course, limits the scope of the claim when deciding both infringement and validity. In other words, just as the cross-hatching in the D'677 patent limits the claim to a front face that is colored black, the oblique surface shading lines of the D'889 patent limit the claim to a device having a front face that has a transparent, translucent, highly polished, or reflective surface.

With respect to the rear side of the device, there was some confusion in interpreting the claim due to an apparent drafting

error in the figures. Specifically, in figure 2 (a rear perspective view) oblique surface shading appears, whereas in figure 4 (a rear bottom plan view) no such surface shading appears.

While the oblique line shading was clearly intended on figures 1 and 3 (the front side), inclusion of oblique line shading on figure 2 (the back side) would appear to be in error. After all, the rear of Apple's iPad has a matted brushed finish, not a polished or reflective surface. The litigants vigorously debated the meaning of the drafting conventions during claim construction and the apparent inconsistency between figures 2 and 4.

Ultimately, while Judge Koh largely took a hands-off approach to claim construction,[12] she did add, however, that for figures 1–3, the oblique line shading denoted a "transparent, translucent and highly polished or reflective surface."[13] Despite Apple's arguments to the contrary, Judge Koh concluded that the drawings as depicted, including the oblique surface shading on the rear of the tablet, would govern—no exceptions.

Significantly, the Samsung accused tablets do not incorporate a back side having a "transparent, translucent and highly polished or reflective surface." Rather, they have a brushed aluminum finish—just like the iPad. While this is one of many features, the jury, which found that the Samsung tablets did not infringe the D'889 patent, may well have placed heightened importance on this difference given that it was specifically pointed out by Judge Koh in her jury instructions.

The D'305 Patent

The D'305 patent, which claims an earliest priority date of June 23, 2007, is directed to the appearance of a graphic user interface (GUI).

In a conventional sense, the Apple D'305 patent is "narrow"; it does not include any dotted lines (except on the perimeter, which is typical for a GUI) and it claims a particular colorway (rather than the noncolor-specific black and white line drawing typically used in design patents).

The "Functional" Element Argument

Samsung argued at trial, and again argues on JMOL, that all of the asserted Apple design patents are "invalid" because each claimed *element* of the designs is "functional," and not "ornamental." For example, Samsung's counsel argued: "We're going to say that all of the elements are functional, so when you add them all up, you get a functional totality of the circumstance. But let's go through them one by one."[14]

Specifically, Samsung contends that the devices' front surfaces are flat because it is easier to clean them, the corners are rounded to prevent snagging, the shape is rectangular to be compatible with modern media, the speaker slot is positioned and shaped to allow the user to listen, etc. Samsung's counsel concluded that because each element is "functional," the entire design is functional, and thus invalid. While this "divide-and-conquer" functionality-invalidity argument may have some initial shelf appeal, the Federal Circuit long ago made clear that this approach is not the appropriate inquiry.

> [T]he utility of each of the various elements that comprise the design is not the relevant inquiry with respect to a design patent. In determining whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.[15]

To date, Judge Koh has not taken the bait, and hopefully she will continue to reject this legally and logically erroneous argument.

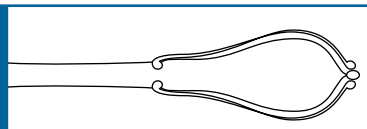
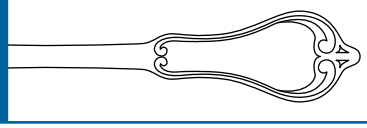
Samsung also weaved its functionality arguments into claim construction, arguing that "functional" features should be eliminated from the claim, citing *Richardson v. Stanley Works, Inc.*[16] Samsung is reading *Richardson* as endorsing a "masking tape" approach, whereby any aspects of the claimed design that serve a function are "taped over" and ignored—effectively read out of the claim.[17] In short, like the now defunct "point of novelty" approach (which sought to separate out new and old elements), Samsung's approach (which seeks to separate out ornamental and functional elements) conflicts with the tenet that a design patent protects the overall appearance of the claimed design.[18]

Samsung's argument is akin to contending that because each part of a Ferrari has a "function" (i.e., door for ingress/egress, headlights for night driving, windows for viewing, etc.), Ferrari cannot protect the overall appearance of its car design with a design patent. Samsung's argument misses the point that a product and its parts can have "function" but still be designed in many different ways. Indeed, the sheer wealth of prior art (with a multitude of different looking designs) produced by Samsung in this case belies any argument that the designs-in-suit (or any of their constituent elements) are somehow dictated by their function.

Primer on the Law of Design Patent Infringement

The current design patent infringement test (colloquially known as the "ordinary observer test") first was laid down by the United States Supreme Court in 1871 in *Gorham Co. v. White*.[19] In *Gorham*, where the design patent at issue regarded an ornamental design for a handle on flatware, the court declared that there was infringement if "in the eye of an *ordinary observer*, giving such attention as a purchaser usually gives, two designs are *substantially* the same."[20] Significantly, the court (1) rejected the notion that design patent infringement should be decided through the eyes of an expert, and rather left the decision to the "ordinary observer"; (2) rejected a design patent infringement test that required exactitude, instead opting for a test only requiring "substantial" identity in appearance; and (3) affirmed that design patents, as set forth in the acts of Congress, provide a "meritorious service to the public."[21]

Applying the "ordinary observer test," the *Gorham* court ultimately concluded that White's accused flatware infringed Gorham's design patent. Representative images are set forth below for the patented design on the left, and the accused/infringing design on the right.

U.S. Patent No. D1,440	
Infringing Flatware Handle Design	

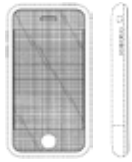
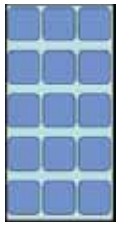
As is seen from the visual comparison, there were noticeable differences between (1) the handle silhouettes, and (2) the engraving, including the ribbing, curls, points, etc. Nevertheless, and despite these differences, the court found that the accused White products incorporated a design that was "substantially the same" as the patented design. Thus, from the outset, the court has made clear that the design patent infringement test is not a minute analysis of detail but rather a test that asks whether the *overall appearance* of the patent and accused designs are *substantially* the same in the eyes of an ordinary observer.[22]

In 2008, the en banc Federal Circuit in *Egyptian Goddess, Inc. v. Swisa, Inc.*, affirmed that the ordinary observer was the "sole test" for determining design patent infringement, but added the twist that it should be conducted "in light of the prior art."[23]

Before jumping into the visual comparisons from *Apple v. Samsung*, it is important to note that a proper design patent infringement analysis requires inspection of the accused product from all perspectives set forth in the design patent.[24] In the interest of space, however, only representative images of the patent and accused designs (along with any relevant prior art) have been depicted.

Apple v. Samsung: A Visual Study

After the dust from *Apple v. Samsung* has settled, design patent infringement comparisons from the case, along with the jury's verdict, will continue to serve as meaningful data points that practitioners can reference when assessing and advising on the issue of design patent infringement. To facilitate this process, arranged chronologically from left to right, below, are representative images of the relevant prior art, the asserted Apple design patents, and the accused Samsung products.[25]

Prior Art	Apple's U.S. Patent	Samsung Product	Jury Decision
			**Non-Infringement**
	 No. D504,889	 Galaxy 10.1 Tab	
	 No. D593,087	 Galaxy S 4G	***Infringed***
		 Galaxy Infuse 4G	**Non-Infringement**
	 D618,677	 Galaxy Infuse 4G	***Infringed***
			***Infringed***
	 D604,305	 All Phones	***Infringed***

Observations and Insights Regarding Jury's Verdict

Although the jury took but a few days to answer the 773 discreet questions set forth on the monstrous jury verdict form, it does not appear that it acted like the brash high school student who answers "True" to ever question on a True/False exam. Instead, it appears that, in some instances, the jury made nuanced findings hinging on differences between the various design patents and accused products. For example, for the Galaxy S 4G, the jury found that it infringed both the D'087 and the D'677 patents. However, for the Infuse 4G, the jury found that the D'087 patent was not infringed, while the D'677 patent was infringed. Apparently, the jury felt that while the curvature of the corners and geometry of the bezel on the Infuse were too different from the D'087 patent to find infringement, those differences were not as important in the D'677 patent infringement analysis because there were other areas of similarity, namely, the black front face with edge-to-edge glass.

However, when it came to the finding of infringement with respect to the D'305 patent, the jury did not seem to paint with the same fine brush. An ocular inspection of the patented and accused GUIs shows that, other than the green telephone icon in the lower left-hand corner, no two icons are remotely the same. Indeed, for any given location, the icons are not even the same color. Apparently, the jury looked past all of these differences in detail and took a more impressionistic view of the claimed GUI.

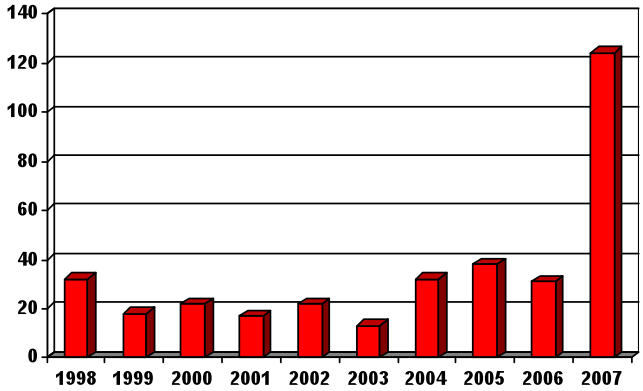
It must be remembered that the "all-elements rule," the bedrock of the (literal) infringement analysis for utility patents, does not apply to design patents. All aspects of the claimed design need not be present in an accused product for there to be design patent infringement. Under *Gorham*, as long as the overall appearance is substantially the same (in view of the prior art and in the eyes of an ordinary observer), there is infringement. Thus, sometimes when less is claimed, differences between the asserted design and accused product can take on heightened significance; in short, there is less potential for commonality to outweigh any differences. Conversely, when more is claimed, differences can take on less importance; there is more potential for commonality to outweigh the differences. This finding challenges the conventional wisdom that, when it comes to infringement, claiming less is best.

The Seeds of Apple's Success

Apple filed its complaint in April 2011, but the seeds of success were planted back in 2007 during the buildup and release of Apple's iPhone. At the 2007 Macworld Expo, Steve Jobs, taking the stage to a recording of James Brown singing "I Feel Good" and amidst thundering applause, declared:

> [T]oday, we're introducing three revolutionary products of this class. The first one is a widescreen iPod with touch controls. The second is a revolutionary mobile phone. And the third is a breakthrough Internet communications device. . . . These are not three separate devices, this is one device, and we are calling it iPhone. Today, Apple is going to reinvent the phone, and here it is. . . . Now, we're going to start with a revolutionary user interface. . . . And boy, have we patented it.[26]

The fact that Apple and Jobs pursued an aggressive patent procurement program for their iPhone release is well known. However, what may not be so well known is that a large portion of that assault is attributable to an energized design patent procurement program, many filed just days before the 2007 Macworld Expo. How aggressive was Apple in 2007 with its design patent filings? The numbers tell the story. The following chart plots Apple's design patent application filings in 2007, and the 10 years prior.



Apple's U.S. Design Patent Application Filings

Prior to 2007, Apple, in its storied history, never had filed more than 38 U.S. design patent applications in a single calendar year. In 2007, however, Apple filed 124 design patent applications—a 400 percent increase from 2006. (Interestingly, Steve Jobs himself was a named coinventor on over half.) By way of comparison, from 2006 to 2007, Apple's *utility* patent output increased *only* 23 percent. As history would have it, Apple's 2007 design patent offensive served as the foundation for Apple's design patent success in 2012. Indeed, three of the four design patents that Apple prevailed upon yield from applications filed in 2007.

Upon close inspection, one of the key attributes of Apple's design patent acquisition program was that Apple, which has a limited product offering, secured multiple design patents (of varying scope and on varying aspects) for any given product. In contrast, Samsung, which offers many more product models than Apple, has typically secured only a single design patent for any given product. In other words, Apple has more design patents per product offering than most companies, including Samsung.

Apple's "more is more" approach was instrumental when it came to enforcement. Apple could pick and choose design patents in its cupboard that claimed the common elements with Samsung's products, but conveniently and largely disclaimed any differing elements (i.e., circular home button, contour of back side, etc.).

$1.05 Billion Damages: The Result of a Patent Act Chestnut

How did we get to that number? It is because of a little chestnut in the Patent Act that provides the unique remedy for design patent infringement of disgorgement of the infringer's "*total* profits," in other words, without apportionment.[27]

The no apportionment language (i.e., disgorgement of the infringer's "total profits") was placed in the Patent Act in 1887

in response to an 1886 U.S. Supreme Court case regarding infringement of a design patent on a carpet design, whereby the court said the design patentee was only entitled to six cents in damages—the portion of the damages attributable to the design.[28] In response to that holding, a holding that members of Congress felt was a miscarriage of justice, the 1887 Patent Act was enacted and provided a remedy for "total profit" without apportionment for design patent infringement. The provision has largely been a sleeper for 125 years. Now, it has surfaced and done so in a big, big, way—to the tune of $1.05 billion.

Apple's JMOL Regarding Tablet Infringement—Stay Tuned

Both Samsung and Apple have filed postverdict motions asking Judge Koh to trump portions of the jury verdict. The standard for granting a motion for a directed verdict (in the Ninth Circuit where Judge Koh sits) is high, specifically the standard is whether the evidence permits only one reasonable conclusion, and that conclusion is contrary to the jury's verdict.[29] Directed verdicts are relatively uncommon because judges are reluctant to second guess a jury. While these motions are filed as a matter of course, they are typically denied.

That said, with respect to the jury's finding of noninfringement on the Samsung tablet vis-à-vis the Apple design patent, Apple's arguments may have some traction; Judge Koh may well exercise this supercharged trump card in Apple's favor. The reason for this prediction is nested in Judge Koh's order granting Apple's motion for preliminary injunction.[30] There, in expressing her views that Samsung's tablets infringe, she repeatedly opined that the Samsung Galaxy 10.1 Tab is "virtually indistinguishable" from Apple's iPad.[31] Indeed, Judge Koh stated at the preliminary injunction hearing that the accused Galaxy 10.1 Tab "looks almost identical" to, and "looks virtually identical" to, Apple's iPad.[32] Further yet, in pronouncing her conclusion that the test for design patent infringement was satisfied for purposes of granting a preliminary injunction, Judge Koh stated that "Samsung appears to have created a [tablet] design that is likely to deceive an ordinary observer, 'inducing him to purchase one supposing it to be the other.'"[33]

These findings of extreme similarity far exceed the needed similarity for design patent infringement, namely, that the accused design need be at least "substantially the same" as the patented design.[34] By using stronger words such as "virtually indistinguishable," "looks almost identical," and "looks virtually identical," Judge Koh appears to be of the mindset that the accused Samsung tablet easily meets the "substantially the same" infringement standard, so much so that the facts lead to one and only one conclusion—infringement. Thus, Apple has a greater chance than usual to succeed in convincing Judge Koh to play this extraordinary trump card.

While, yes, one could argue that her articulations of infringement must be placed in context and thus limited to the preliminary injunction stage, keep in mind that at that stage, the burdens of proof and persuasion are stacked heavily against the moving party, here, Apple. At trial, the burdens to show infringement are much lower, requiring only a showing by the preponderance of the evidence. In short, since the preliminary injunction stage, as for hurdles to clear, matters have not become harder for Apple, they have become easier. What is worse for Samsung, Judge Koh's finding of infringement already was up on appeal, and it was ultimately undisturbed by a three-judge panel of the Federal Circuit.[35] Indeed, Judge O'Malley, affirming Judge Koh's finding, wrote that its "review leads to one firm conclusion—that an injunction as to the D'889 Patent should be entered, and should be entered now."[36]

To be clear, it is certainly possible that new facts emerged since Judge Koh last weighed in on infringement, and that those new facts dislodged her from her previously stated position, but in view of the (publicly available) record to date, it would appear unlikely. After all, since her findings on infringement, Apple's D'889 design patent hasn't changed, nor has Samsung's accused product. There is little room for Judge Koh to abandon her previously stated positions. To move Judge Koh off her previous finding of "virtually indistinguishable" to a finding of not even "substantially the same," Judge Koh will need to explain herself, perhaps pointing to some extremely close prior art that she did not previously consider. However, a close review of the record reveals that such close prior art was not proffered. In any event, resolution of Apple's Rule 50 motion for a directed verdict on the jury's finding of noninfringement on the tablet design patent will be interesting to follow. She just might grant it.

Conclusion

In *Apple v. Samsung*, design patents took center stage and grabbed the headlines. They assuredly will be coming back for an encore. As practitioners increasingly are called upon to render advice on design patent infringement, the visual facts of past cases, including *Apple v. Samsung*, should serve as helpful gauges for assessing the difficult question of "how close is too close" when it comes to design patent infringement. The battle royale is a result of two things: (1) the size and potential of the smartphone and tablet market, and (2) how important product design and appearance have become to consumers. If a company has not incorporated design rights into its intellectual property portfolio, it will need too. Even apart from the ultimate outcome, design patents no longer can be overlooked if a company, particularly a consumer tech company, wants to have a strong intellectual property portfolio. Simply put, looks matter. Once a company reaches that conclusion, and then invests in good design, it is a natural conclusion that it will want to protect, and if need be enforce, its designs. Nobody wants to be the design team for the competitors. ■

Endnotes

1. No. 11-CV-01846 (N.D. Cal.).

2. Ashby Jones & Jessica E. Vascellaro, Apple v. Samsung*: The Patent Trial of the Century*, Wall St. J., July 24, 2012, http://online.wsj.com/article/SB10000872396390443295404577543221814648592.html.

3. In 2009, in *Centocor Ortho Biotech, Inc. v. Abbott Laboratories*, the jury awarded the patentee Centocor $1.67 billion; however, the award was overturned on appeal. 636 F.3d 1341 (Fed. Cir. 2011). In 2007, in *Lucent Technologies, Inc. v. Microsoft Corp.*, the jury awarded $1.53 billion, however, here again, the verdict was overturned on appeal. Lucent Techs., Inc. v. Gateway, Inc., 543 F.3d 710 (Fed. Cir.

2008). Thus, currently, the $1.05 billion award in *Apple v. Samsung* represents the largest jury verdict in a patent infringement case.

4. Roughly speaking, design patents protect appearance; utility patents protect function. (For example, a design patent could be used to protect a smartphone's aesthetic appearance, while a utility patent could be used to protect the smartphone's internal circuitry.)

5. I make my observations based upon the available *public record*, which contains over 1,700 docket entries. There are several documents in the case that remain under seal.

6. Samsung added to the mix by counterclaiming that Apple infringed five of Samsung's utility patents. Ultimately, the jury found that none of the asserted Samsung patents were infringed.

7. The asserted Apple utility patents regarded user interface features, namely "(un)pinch-to-zoom," "swipe bounce-back," and "double-click to zoom." The asserted trade dress rights, both registered and unregistered, regarded the "look and feel" of Apple's iPhone 3 and iPad devices.

8. While these types of arguments have no place in the conventional design patent infringement analysis (which compare patents to products, not products to products), they certainly told a nice story, something the jury could easily grasp. Because Apple also asserted trade dress claims, it was able to deftly interweave principles of trade dress law and design patent law whenever it saw fit.

9. The late Steve Jobs was among the 14 inventors listed on the face of Apple's asserted design patents.

10. *See* U.S. Patent & Trademark Office, Manual of Patent Examining Procedure (MPEP) § 1503.02 (8th ed. Rev. 9, Aug. 2012) ("Oblique line shading must be used to show transparent, translucent and highly polished or reflective surfaces . . . .").

11. It is notable that the D'889 patent (which was filed in 2004) does not employ the same aggressive and sophisticated claiming strategy used in the prosecution of the D'677 and D'087 patents (which related to a parent application filed in 2007). It appears from a study of Apple's design patent portfolio that the progressive claiming techniques (i.e., dotted lines, multiple embodiments, multiple applications, color, surface treatment) did not blossom until the 2007–08 timeframe.

12. *See* Apple, Inc. v. Samsung Elecs. Co., No. 11-CV-01846, 2012 U.S. Dist. LEXIS 105125, *32–33 (N.D. Cal. July 27, 2012).

13. *Id.*

14. Transcript of Hearing on Apple's Motion for Preliminary Injunction 44–45, *Apple v. Samsung*, No. 11-CV-01846 (N.D. Cal. Oct. 11, 2011).

15. L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993).

16. Richardson v. Stanley Works, Inc., 597 F.3d 1288 (Fed. Cir. 2010).

17. *See* Good Sportsman Mktg. LLC v. Li & Fung Ltd., No. 6:07-cv-395, 2010 U.S. Dist. LEXIS 65458 (E.D. Tex. June 29, 2010) (discussing *Richardson* and rejecting "masking tape" approach).

18. Further, the "masking tape" approach, which seeks to eliminate functional elements of a claimed design, risks undermining both the validity and enforceability of design patents. After USPTO examination, an issued design patent enjoys a presumption of validity, just like any other patent. *See* 35 U.S.C. § 282. At the USPTO, the patentability determination for a claimed design is premised solely on the *overall appearance* of the depicted design. MPEP, *supra* note 10, § 1503.01(c). Yet, the presumption of validity and its underpinnings easily fall apart when portions of the claimed design are eliminated and thus fundamentally different from the claim examined and issued by the USPTO.

19. 81 U.S. 511 (1871).

20. *Id.* at 528 (emphasis added).

21. *Id.* at 525; *see also id.* at 524 ("The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts.").

22. *Id.* at 528 ("The purpose of the law must be effected if possible; but, plainly, it cannot be if, while the general appearance of the design is preserved, minor differences of detail in the manner in which the appearance is produced, observable by experts, but not noticed by ordinary observers, by those who buy and use, are sufficient to relieve an imitating design from condemnation as an infringement.").

23. 543 F.3d 665, 678 (Fed. Cir. 2008) ("[W]e hold that the 'ordinary observer' test should be the sole test for determining whether a design patent has been infringed. . . . [W]e believe that the preferable way to achieve that purpose is to do so directly, by relying on the ordinary observer test, conducted in light of the prior art.").

24. *See* Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1370, 1381 (Fed. Cir. 2002). ("The overall features of . . . the accused products must be compared with the patented design as a whole as depicted in all of the drawing figures to determine infringement.").

25. While there were 26 Samsung smartphones accused of infringement, I have endeavored to set forth two Samsung smartphones that fairly bookend the range of designs.

26. Vincent Nguyen, *Complete Transcript of Steve Jobs, Macworld Conference and Expo on January 9, 2007*, iPhone Buzz (Feb. 23, 2007), http://www.iphonebuzz.com/complete-transcript-of-steve-jobs-macworld-conference-and-expo-january-9-2007-23447.php.

27. 35 U.S.C. § 289.

28. *See* Dobson v. Dornan, 118 U.S. 10 (1886).

29. *See* EEOC v. Go Daddy Software, Inc., 581 F.3d 951 (9th Cir. 2009).

30. *See* Apple, Inc. v. Samsung Elecs. Co., No. 11-CV-01846, 2012 U.S. Dist. LEXIS 88436, *17–19 (N.D. Cal. June 26, 2012).

31. *Id.*

32. Transcript of Hearing on Apple's Motion for Preliminary Injunction, *supra* note 14, at 61–64.

33. Apple, Inc. v. Samsung Elecs. Co., No. 11-CV-01846, 2011 U.S. Dist. LEXIS 139049 (N.D. Cal. Dec. 2, 2011).

34. *See* Gorham v. White, 81 U.S. 511 (1871) (setting forth the test for design patent infringement, which requires substantial similarity, not exactitude).

35. Apple, Inc. v. Samsung Elecs. Co., 678 F.3d 1314 (Fed. Cir. 2012).

36. *Id.* at 1336.