



# Apple loses appeal on “cool” design

**On 28th September 2012, the Court of Appeal of England and Wales heard appeals against two High Court decisions given by Judge Colin Birss in connection with the much-publicised dispute between Samsung Electronics (UK) Limited and Apple Inc**

In the first of these cases, Birss had concluded that three of Samsung’s Galaxy tablet computers (the Tab 10.1, Tab 8. and Tab 7.7) did not infringe one of Apple’s registered Community designs (RCD). An RCD is a right which protects the outward appearance of a product or a part of it, resulting from the features of the product itself and/or its ornamentation. Birss had held that the Samsung tablets were not sufficiently similar to the RCD to constitute an infringement, and stated that the Samsung models were “not as cool” as the Apple design.

The second appealed decision compelled Apple to publicise the fact that Samsung did not infringe the RCD to provide commercial certainty for third parties.

The Court of Appeal, constituted by Sir Robin Jacob with Lord Justice Longmore and Lord Justice Kitchin, commenced proceedings by clarifying what this case was and was not 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 was not the same design as the iPad (the RCD was not identical to any Apple product), and the case must be assessed as if the iPad never existed.

While upholding Birss’s decision of non-infringement, the appeal court provided a number of useful insights for IP owners on how the courts in England and Wales treat infringement of RCDs.

Firstly, Birss had given significant weighting to the fact that the Samsung tablets are considerably thinner than the RCD. In the appeal, Apple submitted that it would be expected that advances in

technology would make thinner tablets possible, meaning that little significance should be attributed to changes in thickness. Jacob disagreed with Apple and agreed with Birss, arguing that if thinner devices could be foreseen, Apple would have had the benefit of this provision, making the thickness of the RCD a deliberate design choice. Consequently, arguing that a difference arises naturally, as a result of advances in technology, is unlikely to be tenable henceforth.

Apple had also contended that an important common feature of the RCD and the Samsung tablets was a lack of ornamentation on both the faces of the device. Given that simplicity was acknowledged by Apple as being an important feature of the RCD, the appeal judges agreed with Birss’s statement that any ornamentation – even the mere addition of a Samsung trademark – represented a noticeable departure from the RCD. Therefore, Apple’s own emphasis on simplicity being integral to the RCD led the court to conclude that even minor decoration on Samsung’s devices was enough to place the Samsung tablets outside the scope of the RCD.

Apple also drew on the fact that the scope of RCD protection is dependent on how much the RCD differs from earlier designs, while taking into account the degree of design freedom available to the designer. An RCD which is similar to existing designs has a narrower scope than one which is radically different to previous designs, and similarities between designs are given less attention if the designer would have been restricted to using the similar feature. For example, a designer of tablets is somewhat restricted to using a rectangular screen, so the fact that both the RCD and the Samsung tablets had a rectangular screen was not given undue attention.

Apple argued that Birss had selected odd features from existing designs instead of considering their “overall impression”. As Mr Silverleaf acting on behalf of Apple put it, you cannot pick out features from the known designs and say, “These 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 Birss did not remotely do that. Thus, in fields such as the smartphone market, where there are a huge number of existing products, it can be difficult to make an RCD sufficiently distinct from existing designs to obtain a broad scope of protection.

The Court of Appeal then considered whether a publicity order should be enforced. Jacob explained that Birss’s original 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 a later contrasting decision of a German court, which Apple subsequently attempted to enforce, “real commercial uncertainty” was created. Apple was therefore obliged to publicise in specified trade magazines and newspapers, and on its own website, that the Samsung tablets do not infringe the RCD.

Since the appeal decision, Apple has been rebuked for breaching this order, because it drew attention in the notice to other decisions (eg, the German decision) which had been decided in its favour. Consequently, the Court of Appeal has enforced a further order requiring Apple to revise the notice to provide commercial certainty.

The outcome of this case is likely to reinforce the view already held by many that RCD protection can provide a distinctly narrow scope of protection, particularly in fields as saturated as the smartphone market, owing to an extensive catalogue of earlier designs. Many people would consider the Samsung tablets to be very similar to the RCD (as did Birss at first sight), but the existence of numerous other similar designs, and a significant restriction in the design freedom of a tablet designer, meant that the Samsung tablets were found to be sufficiently different to place them outside the scope of the RCD.

**Gary Small** is a partner and **Matthew Birch** is a technical assistant with Carpmals & Ransford in London