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**Samsung v Apple saga: Invalidation Division rules on validity of Apple's tablet RCD
European Union - EIP**

Design

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In *Samsung Electronics Co Limited v Apple Inc* (July 5 2013), in a decision that lacks the headline-grabbing 'cool' language of its UK cousin on the associated infringement issues, the Invalidation Division of the Office for Harmonisation in the Internal Market (OHIM) has ruled on the validity of Apple Inc's registered Community design (RCD) No 000181607-001.

Following an application by various Samsung companies for invalidity of the design, Apple's design survived Samsung's numerous attacks based upon no less than 50 cited pieces of prior art, including an Etch-a-Sketch device and a tablet computer from Stanley Kubrick's film *2001 a Space Odyssey*.

Much of the decision concerns the description of the cited prior art and what of this art was available for the purposes of assessing novelty and/or individual character, and as a result, in places it reads like a tablet encyclopaedia. However, after one has made it through the summary of designs D1 to D50, there are a number of points that merit further consideration.

First, with 50 pieces of prior art, Samsung had clearly left no stones unturned in its search for relevant material. In the face of this, Apple sought to argue that certain of the prior art designs disclosed on the Internet did not fulfil the requirements of Article 7 of the Council Regulation on Community Designs (6/2002) in that they "could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community."

While one can have some sympathy with Apple's position and can only imagine the numerous hours of paralegal and lawyer time that went into locating these numerous designs, the Invalidation Division found against Apple on this issue and ruled that the disclosures were not unsearchable, and that these disclosures were not obscure within the meaning that was intended according to the *travaux préparatoires*.

There is certainly a practicality in this approach. Finding otherwise would likely involve a great deal of court time and effort being spent determining which of any designs located on the Internet would reasonably be located, and which would be considered obscure. The answer to this question could turn upon the search strategy, the number of different search terms that had to be tried first, the number of search engine hits that had to be looked at first, the number of webpages that had to be looked at first, etc. One can only imagine the issues of privilege that this would also raise.

Furthermore, it would be almost impossible to relate a search undertaken today for the purpose of finding prior art designs, to the availability of a particular design to a searcher prior to the relevant date for Article 7. This is not only due to changes in websites, but additionally due to the differences in search engine algorithms and keywords/AdWords associated with any search that would all cause different results to be displayed to a user at different time periods.

All things considered, this would therefore appear to be an inevitable outcome.

Second, the reader may recall from the decision of HHJ Birss QC (as he then was) in the infringement action between Apple and Samsung over Samsung's Galaxy Tablet 10.1, 8.9 and 7.7 ([2012] EWHC 1882 (Pat)) that a question arose over the meaning to be attributed to the dotted lines in RCD No 000181607-001 (in particular drawings 0001.1 and 0001.3). In the infringement action, Samsung took the position that:

"the dotted lines visible in images 0001.1 and 0001.3 also do not form a protected feature in the registration. Part of this submission relied on paragraph 11.4 of the OHIM Examination Guidelines which indicates that dotted lines may be used to indicate elements for which no protection is sought or elements which are not visible in a particular view."

Apple took a contrary view:

"Apple submitted that the Guidelines were permissive and not mandatory and that, in this case, the dotted lines around the screen would be understood to indicate the presence of a visible border on the screen. The border will be created by a difference in appearance between what lies under the glass on either side of the dotted line."

The judge found for Apple on this issue:

"On the facts of this case I accept Apple's submission. Looking at the two images, the dotted lines

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would be understood as showing that there is an edge visible under the glass. It is obviously a border around the screen.”

When the same issue came to be decided by the Invalidity Division, the opposite view was taken:

“The RCD, as registered, contains several parts shown in broken lines: the rectangular area in front views 1.1 and 1.3, a round element in side view 1.6 and a rectangular element in side view 1.7. The office adopts the meaning of broken/dotted lines established by the cited case-law and common practice. The office is also of the opinion that the interpretation of broken/dotted lines in the representations of the design should be consistent. Furthermore, the holder provides instructions on how to read the representation of the design in the description (see paragraph 1 above). For these reasons, it should be considered that protection is not claimed for any of the three elements indicated in dotted lines and the representation of the design should be considered to be a featureless, transparent front screen, framed by a smooth, featureless casing.”

While in both cases, the decision did not ultimately assist the party in whose favour the issue was decided, one can see how this difference *could* have been significant in both cases, and is a yet another indicator of the discrepancies that bifurcation can potentially give rise to, and which in related IP spheres have recently caused so much debate (namely rules of procedure for the Unified Patent Court).

Third, another strand to Samsung's case was that RCD No 000181607-001 was dictated by technical function, and thus was not a design in the context of the regulation. In rejecting this submission, the Invalidity Division considered a number of points in relation to this argument, including the fact that numerous prior art designs had been cited by Samsung and that these products clearly differed in appearance.

One key point to note is the overall impact of the decision. While Apple has succeeded in upholding the validity of the design, Samsung remain free to sell its tablets due to the earlier infringement action. This decision is not quite the victory it initially may seem.

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