

World Trademark Review Daily

Samsung v Apple - how similar does an alleged infringement have to be?
United Kingdom - EIP

Design

July 19 2012

In *Samsung Electronics UK v Apple Inc* ([2012] EWHC 1882 (Pat), July 9 2012), his Honour Judge Colin Birss QC, sitting in the High Court (specifically, the Patents Court designated as a Community Design Court), has decided that three tablet computers marketed by [Samsung Electronics UK](#) - the Galaxy Tab 10.1, Tab 8.9 and Tab 7.7 - did not infringe [Apple Inc's](#) registered Community design No 000181607-0001 (the RCD).

This conclusion was reached after detailed comparison of seven features of the RCD that were alleged by Apple to have been reproduced in the Samsung designs, namely:

1. a rectangular, biaxially symmetrical slab with four evenly, slightly rounded corners;
2. a flat transparent surface without any ornamentation covering the entire front of the device up to the rim;
3. a very thin rim of constant width, surrounding and flush with the front transparent surface;
4. a rectangular display screen surrounded by a plain border of generally constant width centred beneath the transparent surface;
5. a substantially flat rear surface which curves upwards at the sides and comes to meet the front surface at a crisp outer edge;
6. a thin profile, the impression of which is emphasised by (5) above; and
7. overall, a design of extreme simplicity without features which specify orientation.

The first four features were accepted by the judge to be present in the Samsung products, but the features were considered to be of reduced significance because of their presence in the "design corpus" of prior designs.

Feature (5) was present in the Samsung products, but this was considered to be a feature of a class of products that would be familiar to the informed user. Feature (6) was considered to represent a point of difference, because the Samsung products were significantly thinner than the RCD. Feature (7) was also considered to be a point of difference, in particular in respect to the backs of the designs. The Samsung products had ornamentation on the back which was absent from the RCD. On the other hand, the fact that the difference was on the back of the product and not the front was considered to reduce its significance.

In the final assessment, the judge considered that, despite the similarities of the view from the front, the differences in thinness and the design of the back, and, in particular, the extreme simplicity of the RCD contrasting with the less simple Samsung products, created a different overall impression on the informed user. Therefore, he ruled that the Samsung products did not infringe the RCD.

Interestingly, the judge observed that he had reached this conclusion despite the fact that, "when I first saw the Samsung products in this case, I was struck by how similar they look to the Apple design when they are resting on a table". He changed his view after having educated himself into the position of the informed user.

The judge noted the characteristics of the informed user from the UK and EU case law, in particular *Pepsico v Grupo Promer* (C-281/10P), which establishes that the informed user is particularly observant. Therefore, when considering how similar the alleged infringement has to be in order to infringe, although he observed that the 'different overall impression' test of the Community design system was intended to give broader protection than simply anti-counterfeiting, the judge stated that "the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection".

Arguably, in relation to the scope of protection afforded by a Community design, this decision can be seen to fit in line with a series of UK decisions on the scope of Community designs, starting from when the Court of Appeal led by Jacob LJ overturned the first instance decision of Lewison J in *Procter & Gamble v Reckitt Benckiser* ([2007] EWCA Civ 936) - although the approach of Judge Birss differed from that advocated by Jacob LJ by relying to a greater degree on the expert evidence, the design corpus and analysis by individual features. According to this line of reasoning, the alleged infringement can reproduce quite a number of features of the registered design, and escape infringement by having some notable differences. Therefore, although, in principle, the scope of protection of a Community design extends beyond counterfeit products, it is legitimate to wonder how often in practice it will arise that there is an infringement that is not a slavish imitation. Many readers will take from this judgment the lesson that Community design rights are easy to

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design around.

The judge pointed out that the RCD was not that “of the iPad”, as it differed from the commercial products. Nevertheless, even in cases where the registered design has related to award-winning products, as was accepted to be the case in *Procter & Gamble v Reckitt Benckiser* and in *Dyson v Vax* ([2010] EWHC 1923 (Pat)), UK courts have declined to find infringement.

Even if the scope of the registered right is in the end narrow, registration offers the advantages - compared with relying on unregistered Community design rights - of a very much longer term, and release from evidential burdens of proof of subsistence, ownership and copying. Therefore, it is not expected that the popularity of the registration system will diminish.

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