Apple v. Samsung: The War of Roses

AIPPI Forum & ExCo
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Helsinki, Finland

By Christopher V. Carani
Chicago, USA
“The Patent Trial of The Century”
Largest Patent Infringement Jury Verdict (Standing)

Verdict: $1,049,343,540.00
U.S. Intellectual Property

1. Patents
   - Utility Patents
   - Design Patents**

2. Trademarks
   - Trade Dress

3. Copyrights
Apple, Inc. v. Samsung Elecs. Co.,
11-cv-1846 (N.D. Cal 2012)

“I am going to destroy Android…I’m willing to go thermonuclear war,” and, “I will spend my last dying breath if I need to, and I will spend every penny of Apple’s $40 billion in the bank, to right this wrong.”

~ Steve Jobs (1955-2011)
Set the way back machine…
January 7, 2007
“Today, Apple is going to reinvent the phone, and here it is…

We are calling it iPhone. … Now, we’re going to start with a revolutionary user interface…. And boy, have we patented it.”
Apple’s Design Patent Offensive (Filings)

Apple’s U.S. Design Patent Application Filings

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Samsung’s Meteoric Rise

Global Smartphone Vendor Shipments: Samsung, Apple, Nokia

Source: Strategy Analytics (Oct 2011)
Apple, Inc. v. Samsung Elecs. Co.,
11-cv-1846 (N.D. Cal 2011)
Apple, Inc. v. Samsung Elecs. Co.,
11-cv-1846 (N.D. Cal. 2012)

Amended Complaint
• 8 utility patents
• 7 design patents
• 6 trade dress rights

Sent to Jury
• 3 utility patents
• 4 design patents
• 4 trade dress rights
Apple, Inc. v. Samsung Elecs. Co.,
11-cv-1846 (N.D. Cal 2012)

Apple Design Patents-in-Suit

Device Designs

GUI Design
Usher in the “The Accused”...

Samsung Galaxy 10.1 Tab

Samsung Galaxy S 4G

Samsung Infuse 4G

Samsung GUI
Side-by-side, ‘889 and Galaxy Tab in view of prior art

Prior Art

US D504,889

Samsung Galaxy 10.1 Tab
Side-by-side, ‘087 and Galaxy S 4G in view of prior art
Side-by-side, ‘087 and Infuse 4G in view of prior art

Prior Art

US D6593,087

Samsung Infuse 4G
Side-by-side, ‘677 and Galaxy S 4G in view of prior art
Side-by-side, ‘677 and Infuse 4G in view of prior art

Prior Art

US D618,677

Samsung Infuse 4G
Side-by-side, ‘305 and Samsung smart phones

US D604,305

Samsung GUI
Case goes to the jury...

The Jury
by John Morgan (1861)
Apple’s Argument in a Nutshell (Smart Phones)

<table>
<thead>
<tr>
<th>Samsung Smartphones BEFORE iPhone</th>
<th>Apple’s iPhone (announced Jan. 2007)</th>
<th>Samsung Smartphones AFTER iPhone</th>
</tr>
</thead>
</table>
Apple’s Argument in a Nutshell (Tablets)

<table>
<thead>
<tr>
<th>Samsung Touchscreen Tablet BEFORE iPad</th>
<th>Apple’s iPad 2 (announced March 2011)</th>
<th>Samsung Touchscreen Tablet AFTER iPad 2</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image1.jpg" alt="Samsung Touchscreen Tablet BEFORE iPad" /></td>
<td><img src="image2.jpg" alt="Apple’s iPad 2 (announced March 2011)" /></td>
<td><img src="image3.jpg" alt="Samsung Touchscreen Tablet AFTER iPad 2" /></td>
</tr>
</tbody>
</table>
Design Patent Remedies

- Lost Profits
- Reasonable Royalty
- Infringer’s “Total Profits”
- Injunction (Preliminary, Permanent)
### Side-by-side, ‘087 and ‘677 versus Galaxy/Infuse smart phones

<table>
<thead>
<tr>
<th>Patent Number</th>
<th>Device 1</th>
<th>Device 2</th>
</tr>
</thead>
<tbody>
<tr>
<td>US D593,087</td>
<td>Galaxy S 4G</td>
<td>Infuse 4G</td>
</tr>
<tr>
<td></td>
<td><strong>INFRINGING</strong></td>
<td><strong>NON-INFRINGING</strong></td>
</tr>
<tr>
<td>US D618,677</td>
<td><strong>INFRINGING</strong></td>
<td><strong>INFRINGING</strong></td>
</tr>
</tbody>
</table>
4 Topics to Discuss

1. Dotted Lines

2. Design Corpus and Infringement

3. Nature of the Product

4. Features Dictated by Technical Function
1. General Rule on Dotted Lines

“Solid lines” are part of claim design.

“Dotted lines” are NOT part of claimed design.
Dotted Lines

Mount is not part of claimed design

Microsoft Webcam, US Patent D647,937
Dashed Lines

Microsoft Webcam, US Patent D647,937
Multiple Applications

US D647,946
“SUPPORT FOR ELECTRONIC CAMERA”

US D647,933
“ELECTRONIC CAMERA”
Dotted Lines and Continuation Practice

Filing 8/24/05
Filing 3/22/07
Filing 05/08/07
Filing 2/13/09
Filing 08/10/11
Issuance D548,744
Issuance D573,606
Issuance D650,355
Abandoned

Etc.
Apple’s US D593,087
6 “Embodiments”

<table>
<thead>
<tr>
<th>Embodiment</th>
<th>Speaker</th>
<th>Screen Border</th>
<th>Home Button</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>Unclaimed</td>
<td>Unclaimed</td>
<td>Claimed</td>
</tr>
<tr>
<td>2</td>
<td>Unclaimed</td>
<td>Claimed</td>
<td>Unclaimed</td>
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<tr>
<td>3</td>
<td>Claimed</td>
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<tr>
<td>6</td>
<td>Claimed</td>
<td>Claimed</td>
<td>Unclaimed</td>
</tr>
</tbody>
</table>
Importance of Dotted Lines

Apple’s ‘087 Design

Samsung’s Accused Galaxy 4 S

Claimed

Not present
Apple’s US D593,087
Apple's US D593,087
(annotated)
Importance of Dotted Lines

Apple’s ‘087 Design

Disclaimed

Samsung’s Accused Galaxy 4S
2. Design Corpus and Design Patent Infringement

Set the way back machine...

Gorham v. White (1871)
Gorham v. White (1871)

[Diagram showing Gorham’s patented design and White’s accused design]
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, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”

Gorham v. White (1871)
Gorham v. White (1871)

Gorham’s Patented Design

White’s Accused Design
Articulation of Infringement Test

Eye of an Ordinary Observer:

1. “Is the overall appearance of the claimed patented design
2. substantially the same as
3. the overall appearance of the accused design
4. in view of the prior art?”

Gorham v. White (1871)

Prior Art

Gorham’s Patented Design

White’s Accused Design
Gorham v. White (1871)

Prior Art

Gorham’s Patented Design

White’s Accused Design

INFRINGEMENT
Gorham v. White (1871)

Prior Art

Gorham’s Patented Design

White’s Accused Design
Gorham v. White (1871)

Prior Art

Gorham's Patented Design

White's Accused Design

NON-INFRINGEMENT
3. Nature of the Product

**US D513,395**
Title: Automobile Body

**Accused Product**
Automobile
3. Nature of the Product

US D513,395
Title: Automobile Body

Accused Product
Go-Cart or UTV
3. Nature of the Product

US D513,395  
Title: Automobile Body

Accused Product  
Child’s Toy
3. Nature of the Product

**US D593,087**
Title: Smartphone

**Accused Product**
Child's Toy
4. Two Distinct “Functionality” Concepts

**Concept 1**
Validity – Overall Appearance of Claimed Design

**Concept 2**
Scope of Protection – Appearance of Individual Features
Validity Question: Is Appearance of Overall Claimed Design Dictated by Function?
Concept 2: Functionality – Scope of Protection

Scope of Protection Question:
Is Appearance of Claimed Design Feature Dictated by Function?
Concept 2: Functionality – Scope of Protection

Scope of Protection Question:

Is Appearance of Claimed Design Feature Dictated by Function?

Prior Art

Accused Design

‘167 Patented Design
“Divide and Conquer”

Claim Construction – as a Matter of Law

“Richardson's multi-function tool comprises several elements that are driven purely by utility. As the district court noted, elements such as the handle, the hammer-head, the jaw, and the crowbar are dictated by their functional purpose.”

![Diagram of multi-function tool with labeled parts: 1. handle, 2. hammer-head, 3. jaw, 4. crowbar]
“Divide and Conquer”

Claim Construction

“Discount,” “Ignore,” “Factor out,” these features
“Divide and Conquer”

1. hammer-head
2. jaw
3. crow-bar
4. handle
“Divide and Conquer”

1. hammer-head
2. jaw
3. crow-bar
4. handle
“Divide and Conquer”

1. hammer-head
2. jaw
3. handle
4. crow-bar
“Divide and Conquer”

1. hammer-head
2. jaw
3. crow-bar
4. handle
Claim Construction = Claim Destruction
Functionality – Scope of Protection

Scope of Protection: Are there any features “dictated by function”?
Side-by-side, ‘305 and Samsung smart phones

US D604,305

Samsung GUI
Apple’s Design Patents-in-Suit
Graphic User Interfaces

D613,334
D627,790
D604,305

Samsung
GUI
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Christopher V. Carani, Esq. is a partner and shareholder at the intellectual property law firm of McAndrews, Held & Malloy, Ltd. based in Chicago, Illinois. He is a leading authority in the field of design law, counseling clients on a wide range of strategic design protection and enforcement issues; he is often called upon to render infringement, validity and design-around opinions and serve as a legal consultant/expert in design law cases.

Chris has worked extensively with clients to secure a wide array of design rights both in the U.S and outside of the U.S. He has published and lectured extensively on the topic and is a frequent contributor to CNN on intellectual property law issues. He is also often called upon to provide comment to other media outlets, including New York Times, Wall Street Journal, NPR, PBS TV, CNBC TV, BBC, Bloomberg TV, Reuters, InformationWeek, Fast Company, ComputerWorld, PCWorld, Washington Post, L.A. Times, Chicago Tribune, Forbes, Fortune, and FoxBusiness TV.

Mr. Carani currently chairs the American Bar Association’s Design Rights Committee, and is the past chair of the American Intellectual Property Law Association (AIPLA) Committee on Industrial Designs. In the landmark design patent case Egyptian Goddess v. Swisa, he authored amicus briefs on behalf of the AIPLA at both the petition and en banc stages. In 2009, 2011-12, and 2013 he was an invited speaker at the United States Patent & Trademark Office’s (“USPTO”) Design Day.

Prior to joining McAndrews, Mr. Carani served as a law clerk to the Honorable Rebecca R. Pallmeyer at the U.S. District Court for the Northern District of Illinois. Mr. Carani was conferred his Juris Doctorate from The Law School at The University of Chicago. He also holds a Bachelor of Science in Engineering from Marquette University. He is currently licensed to practice before the U.S. Supreme Court, the U.S. Federal Circuit Court of Appeals and other U.S. District Courts. He is a registered patent attorney licensed to practice before the USPTO.