

Apple v Samsung Decision Throws Spotlight on Design Patent Damages

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The US Court of Appeals for the Federal Circuit vacating the jury's damages awards against Samsung products that were found liable for trade dress dilution may be grabbing mainstream media headlines, but it is the affirmation of design patent damages that practitioners will find more significant.

In *Apple v Samsung Electronics*, the US District Court for the Northern District of California previously found that Samsung had infringed Apple's design and utility patents, and diluted Apple's trade dresses, making headlines when it awarded Apple more than \$1 billion in damages. Samsung appealed and this week the US Court of Appeals for the Federal Circuit affirmed the jury's verdict on the design patent infringements, the validity of two utility patent claims, and the damages awarded for the design and utility patent infringements appealed by Samsung, while reversing the jury's findings that the asserted trade dresses are protectable. It therefore vacated the jury's damages awards against the Samsung products that were found liable for trade dress dilution.

Leaving aside the utility patent aspects, it is the design patent and trade dress dimensions that are worth focusing on from a trademark practitioner's perspective.

James H Donoian, partner at McCarter & English, comments: "The reversal of the trade dress claims isn't surprising because it's so difficult to protect trade dress when it's a common geometric shape with functional characteristics. The iPhone may have suffered from a bit of both as the claimed trade dress included a rectangle with colourful icons under a flat screen. It's difficult to imagine a touch screen handheld device without a flat screen and colourful icons to identify each app. The biggest lesson is to carefully define the trade dress."

Considering the design patent and trade dress dimensions in tandem, Donoian suggests: "The reason for the court's seemingly odd split between the design patent and the trade dress claims is due to the slight differences in the design patent drawings and the defined trade dress, and the difference between the Federal Circuit standard for the former and the Ninth Circuit standard for the latter (which doesn't require a lot for functionality). So, strategy in framing claims needs to account for those possible differences and perhaps choice of venue where the claims include both types of IP rights and functionality may be an issue."