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I. OVERVIEW

Apple, Inc., (Apple) is a telecommunication and electronics company that considers itself a forerunner in “mobile communication devices, personal computers and portable digital media players.”

Samsung Electronics Co. (Samsung) is a technology company and mobile device provider that competes with Apple and has been the top volume seller of cellphones in the United States and the second largest mobile device seller in the world. As a leader and innovator in the tech industry, Apple owns several design and utility patents that are used in its

2. Id.
smartphones and tablet-style computers. In the instant case, three of its design patents are being considered, all generally concerning its famous “minimalist design”; “large rectangular display[s]” with “rounded corners”; and “black, highly polished, reflective surface[s].” However, a major standout in the case is Apple’s utility patent called the “List Scrolling and Document Translation, Scaling and Rotation on a Touch-Screen Display” or, more commonly, the “bounce-back” (or “snap-back”) patent. The bounce-back software feature is used in Apple’s products and entails touch interface scrolling that causes the page image to recoil back when reaching a document’s end.

In its patent infringement suit against Samsung, Apple claims that Samsung has developed cellular telephones and tablet computers that “blatantly imitate” Apple’s mobile devices in an attempt to “capitalize on Apple’s success.” Strong questions have been raised concerning the validity of Apple’s bounce-back patent based on allegedly anticipatory prior art references. First, Samsung stated that the independent claims in the ’381 patent are anticipated by the preexisting Lira patent application and the related dependent claims are thus rendered obvious. Alternatively, Samsung argued that the LaunchTile and XNA V computer software programs anticipate all claims within the ’381 patent. The Lira application was published in 2003 and disclosed software to reconfigure and scroll online documents on a portable electronic device. Like the ’381 patent, the Lira claims disclosed a method of display bounce-back where “after a user lifts the stylus or his finger, the column ‘snap[s] into alignment with the display window.’” The purportedly anticipated independent claim of the ’381 patent is claim 1: a computer program comprising “a touch screen display . . . displaying a first portion of an electronic document” that, in response to detecting a

4. Id.
5. Id. at 1318-19 (citing U.S. Patent No. 7,469,381 (filed Dec. 14, 2007)).
6. Id.
8. Id. at *34.
9. Id.
movement, moves the first image to a second portion of the document.\textsuperscript{12} Once the end of the electronic document is met, or if the edge of the page is met, the software displays “an area beyond the edge of the document” and then displays the third portion of the electronic document.\textsuperscript{13} Scrolling over the document portions cause the portion to move back either to the document or to the next portion depending on whether the threshold of movement is detected.\textsuperscript{14} Dependent claims 2-18 involve the disclosure of additional limitations, and claims 19 and 20 disclose “independent apparatus claims.”\textsuperscript{15} The software programs Samsung claimed anticipate all of the claims in the ’381 patent were LaunchTile and XNAV.\textsuperscript{16} The software, referred to in the case collectively as LaunchTile for simplicity, involves a one-handed interaction method on a touch-screen mobile device.\textsuperscript{17} Samsung listed two elements of the software that anticipate the ’381 patent. The first is the “world view” element, in which the display image on the screen snaps back to the image or the next corresponding image based on how far the user’s finger swipes.\textsuperscript{18} The second is an e-mail feature that also contains an “auto-align” or bounce-back feature where “the program will move forward or backwards to align the edge of the e-mail box with the edge of the screen,” much like the Apple ’381 patent.\textsuperscript{19} The court determined that none of the claimed prior art adequately invalidated the ’381 patent via anticipation or obviousness arguments.\textsuperscript{20} The court found that because the bounce-back function that is required by the ’381 patent is not always performed in the Lira and LaunchTile references (but instead performed based on user input decisions), those references are not anticipatory.\textsuperscript{21} Due to the fact that the independent claims in the ’381 patent were not invalidated and the dependent claims hinged on the prior art’s anticipating the independent claim in the patent, the court determined that the dependent ’381 patent claims were thus nonobvious.\textsuperscript{22} The United States District Court for the Northern District of California held that the ’381 patent was valid; however, it denied

\begin{thebibliography}{9}
\bibitem{13} \textit{Id.} at il. 43-51
\bibitem{14} \textit{Id.} at il. 53-58.
\bibitem{15} \textit{Id.} at cols. 35-38.
\bibitem{17} \textit{Id.}
\bibitem{18} \textit{Id.}
\bibitem{19} \textit{Id.}
\bibitem{20} \textit{Id.} at *37.
\bibitem{21} \textit{Id.}
\bibitem{22} \textit{Id.}
\end{thebibliography}

II. BACKGROUND

A. Anticipation

According to 35 U.S.C. § 102, a patent claim will be anticipated if a prior art reference describes “each and every claim limitation and enable[s] one of skill in the art to practice an embodiment of the claimed invention without undue experimentation.” In order to anticipate, the reference must “disclose all elements of the claim within the four corners of the document [and] ‘arranged as in the claim.’” Even if prior art encompasses an aspect that is capable of being turned off and on, or is only present in particular situations, it can still be anticipatory with respect to a similar aspect that is always on. However, the United States Court of Appeals for the Federal Circuit has also said that if a method patent necessitates that an action occur every time, then prior art that only sometimes executes the act cannot read on the patent.

B. Obviousness

Patents may also be invalidated if they are deemed obvious in reference to combinations of prior art. The United States Supreme Court in *Graham v. John Deere Co. of Kansas City* stated that inventions and breakthroughs are only patentable if the new concept required more ingenuity and skill than a mechanic or technician ordinarily acquainted with the concept could muster. In an obviousness inquiry, the court will consider differences between the prior art and the claims at issue in the patent, the level of ordinary skill in the art involved, and the scope of the prior art. The court will also look at secondary considerations like

29. *Id.* at 17.
“commercial success, long felt but unsolved needs, [and] failure of others.” The Federal Circuit has also developed an accompanying test referred to as the “teaching, suggestion, or motivation” test (TSM test). Under the TSM test, a patent is found obvious if “some motivation or suggestion to combine the prior art teachings can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art” (PHOSITA).

III. THE COURT’S RULING: ISSUES AND MISSES IN APPLE I

The court had two questions to consider: first, whether the Lira patent anticipated the independent claims making the related dependent claims obvious and second, whether the LT/XNAV prior art anticipated every claim of the patent. The district court’s logic for anticipation of the ’381 patent in both questions hinged on “whether an auto-correct function that allows for a snap back feature on some, but not all, user inputs anticipates the ’381 patent.” The court concluded, “[W]hen a method patent requires some action to always occur, then a method which only sometimes performs this action cannot read on the patent.” The court determined that the Lira claims did not read on the ’381 patent because the bounce-back action is required to occur in the ’381 method patent, whereas it is not required by the Lira patent. Therefore, the Lira art does not anticipate the independent claims and cannot render the dependent claims in ’381 obvious.

Furthermore, while the LT/XNAV prior art and the ’381 patent may both include a bounce-back feature, not every action in the LT/XNAV prior art causes the bounce-back action to occur as required by the ’381 patent claims. Therefore the LT/XNAV world view and e-mail application prior art do not read on the ’381 patent and do not anticipate the independent claim of the ’381 patent. Accordingly, the court held

30. Id.
32. Id. (citation omitted) (internal quotation marks omitted).
34. Id. at *36.
35. Id. at *37 (citing Ferguson Beauregard/Logic Controls, Div. of Dover Res., Inc. v. Mega Sys., LLC, 350 F.3d 1327, 1346 (Fed. Cir. 2003)).
36. Id. at *36.
37. Id. at *37.
38. Id.
39. Id. at *36-37.
that the claims of the '381 patent that were dependent on the independent claim for the bounce-back feature were not obvious in light of the prior art.

Apple appealed to the Federal Circuit after its preliminary injunctions of infringement on its design and utility patents were denied. The court subsequently remanded the case to trial and affirmed the denial of a preliminary injunction of infringement on the '381 patent. After the remand, Samsung brought forth additional prior art references. For instance, Samsung referenced a program called DiamondTouch—a software based “table” that uses touch scrolling pinch-to-zoom movements and a bounce-back feature for displaying onscreen images. Although Samsung claimed that a PHOSITA could develop a software program similar to Apple’s bounce-back technology, the jury found the prior art to be noninvalidating and held for Apple.

A. Jury Confusion

These validity complications cause more problems than just in the Apple rulings, for if the likelihood of convincing just a single judge is a gargantuan task, convincing a jury of laymen is nearly impossible. The jury in the remanded Apple case disregarded prior art not because they believed the references failed obviousness or anticipation tests, but because at least some of the jurors were confused. One member of the jury admitted that they had a hard time believing there was no prior art involved in many of Apple’s patents, so they decided to “skip that one . . . so [they] could go on faster”; it was “bogging [them] down.”

40. Id. at *37.
41. Apple II, 678 F.3d 1314, 1333 (Fed. Cir. 2012).
43. Samsung used the extra time given by the remanding of the trial by the Federal Circuit to include additional prior art into its infringement defense claim to invalidate the '381 patent. See Josh Lowensohn, Samsung Keeps Prior Art Parade Marching Against Apple, CNET (Aug. 14, 2012, 4:54 PM PDT), http://news.cnet.com/8301-13579_3-57493333-37/samsung-keeps-prior-art-parade-marching-against-apple.
44. Id.
Even after a jury instruction that stated that anticipation (from a single prior art source) and obviousness (from multiple combined sources) should be found if all of the claims in Apple’s patents could be found and written on a piece of paper, the jury was still unclear on how to apply the law.\footnote{See Pamela Jones, The Foreman’s Aha Moment in Apple v. Samsung Was Based on Misunderstanding Prior Art, GROKLAW (Aug. 29, 2012, 9:23 AM EDT), http://www.groklaw.net/articlebasic.php?story=20120828225612963.}

Jurors admitted after the trial that they ignored prior art and chose not to invalidate the ’381 patent because they believed that the bounce-back feature could not work on an Apple product.\footnote{See id.} After a presentation of the DiamondTouch prior art, which implanted a bounce-back utility on a physical table structure, Apple’s counsel made the comment, “It’s hard to imagine holding the Diamond Touch in your hand and making a phone call.”\footnote{Id.} The statement clouded the determination of prior art by comparing Apple’s sleek phone with a table within the jury’s mind.\footnote{See Jones, supra note 48.} The Apple utility patent claims do not limit themselves to only Apple devices like the prior art; they claim functionality on all “multifunction devices.”\footnote{Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272, 1282 (Fed. Cir. 2000); see also Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1371 (Fed. Cir. 2008).} For utility patent validity determinations, what matters is whether the claims are congruous between the patent and the prior art, not whether the patented software could run on other patented machines or whether the products looked similar.\footnote{See, e.g., Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 18 (1966) (explaining that the high number of improperly granted patents may be due to liberal review standards of the Patent Office).}

\textbf{B. Patent Office Confusion}

Courts in the past have described the difference in standards for patent validity between the courts and the United States Patent and Trademark Office as “notorious,” lamenting patent examiners’ liberal discretion in granting patents.\footnote{See, e.g., Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 18 (1966) (explaining that the high number of improperly granted patents may be due to liberal review standards of the Patent Office).} This notorious nature is shown in the Apple cases: less than two months after the most recent jury trial, the bounce-back patent was deemed “tentatively invalidated” after
reconsideration by the USPTO. The USPTO rejected the patent on prior art considerations, claiming “no inventive step” was found between the prior art and Apple’s patent. Still, to save face, the USPTO made sure to explain the difference between patent rejection and invalidation. The ’381 patent is still technically “alive,” and a determination of its validity will only occur after a reexamination process that may take up to two years. For now at least, the bounce-back patent’s invalidity ruling has been placed on the sidelines.

Another showing of the confusing nature of invalidity determinations occurred when another of Apple’s utility patents at issue in the case was invalidated by the USPTO. Apple’s U.S. Patent No. 7,884,915 “pinch-to-zoom” patent (‘915 patent) was invalidated by the Patent Office, which brings the latest Apple ruling into question. This utility patent involves “application programming interfaces for scrolling operations.” The jury cited it and the ’381 patent as “property key to the trial” and a large factor in the $1.05 billion in damages awarded to Apple. The ’915 patent was invalidated due to obviousness by some of the same prior art implicated in considering the ’381 patent.

The district court, in an attempt to cover their blunder and embarrassment, proceeded to slash the $1.05 billion damages payout by over forty percent to $600 million and admitted that “the damages awarded for a handful of products in the case must be recalculated in a new trial.” While the district court initially denied any jury

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56. Id.


59. Id.


61. Campbell, supra note 58.

62. Id.

miscalculations aside from those related to the '915 utility patent, Samsung has requested a new trial in light of such an error.64

IV. Conclusion

Regardless of whether Apple’s ’381 utility patent was invalidated by prior art, the U.S. Patent Office has seen the need to reexamine the patent’s validity. Furthermore, the jury in the newest trial has made grievous errors in their mishandling of prior art. The only silver lining in the patent war between Apple and Samsung is that with so many irregularities in the jury’s verdict for patent infringement, there are plenty of issues to be raised on appeal to the Federal Circuit.†

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64. Id.
† Since the writing of this note, the case of Apple v. Samsung was once again heard by the United States Court of Appeals for the Federal Circuit. Despite acknowledging that the USPTO has largely invalidated the ’381 patent, the Court refused to consider that fact as evidence as the patent’s reexamination was not yet finalized. Apple, Inc. v. Samsung Elecs., Co. LTD., 735 F.3d 1352 (2013). The Court upheld the lower court’s decision, but admonished the district court judge’s many errors in the trial. Id. at 1370. The ’381 patent is still being reviewed by the USPTO, and other countries such as Germany and Japan have produced drastically different findings concerning the patent. Michael Filtz, Apple ‘bounce-back’ patent declared invalid in Germany thanks to Steve Jobs video, ZD NET, (September 30, 2013, 1:54PM), http://www.zdnet.com/apple-bounce-back-patent-declared-invalid-in-germany-thanks-to-steve-jobs-video-7000021332/. The Apple v. Samsung drama continues with a second jury trial slated to occur in April 2014. Staff, Apple sues Samsung for $2bn as tech rivals head back to court, THE GUARDIAN, (March 30, 2014, 9:06PM), http://www.theguardian.com/technology/2014/mar/31/apple-sues-samsung-for-2bn?INTCMP=ILCNETTXT3487.

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