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13 Counterclaim-Defendant APPLE INC.

14
15 UNITED STATES DISTRICT COURT
16 NORTHERN DISTRICT OF CALIFORNIA
17 SAN JOSE DIVISION

18 APPLE INC., a California corporation,

19 Plaintiff,

20 v.

21 SAMSUNG ELECTRONICS CO., LTD., a
22 Korean corporation; SAMSUNG
23 ELECTRONICS AMERICA, INC., a New
24 York corporation; and SAMSUNG
TELECOMMUNICATIONS AMERICA,
LLC, a Delaware limited liability company,

25 Defendants.

Case No. 11-cv-01846-LHK

**APPLE'S RENEWED OBJECTION
TO PRELIMINARY INSTRUCTION
NO. 21**

1 The Court yesterday overruled Apple's objections to the fourth paragraph of Instruction
 2 No. 21 ("Summary of Trade Dress Contentions") in the Court's July 23, 2012 Tentative
 3 Preliminary Jury Instructions. Because the issues Apple raised will come up again in final jury
 4 instructions, and because the paragraph departs so clearly from applicable precedent, we submit
 5 this brief paper in the form of a renewed objection to the instruction.

6 The preliminary instruction suggests that in assessing trade dress dilution and
 7 infringement the jury should consider something less than "the overall visual impression created
 8 in the consumer's mind" by the product. It says that trade dress concerns only "the non-
 9 functional aspects of the product, and not . . . the utilitarian or useful aspects of the product."
 10 This language comes from Ninth Circuit Model Jury Instruction Number 15.2, but it is
 11 contradicted by the cases the manual purports to rely on and by other Ninth Circuit law.

12 The law is clear: functionality should be assessed on the basis of the trade dress as a
 13 whole. "[F]unctional elements that are separately unprotectable can be protected together as part
 14 of a trade dress." *Clicks Billiards, Inc. v. Sixshooters Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001)
 15 (internal citation omitted). This principle is repeated in *Taco Cabana, Int'l Inc. v. Two Pesos,*
 16 *Inc.*, 932 F.2d 1113, 1119 (5th Cir. 1991), *aff'd*, 505 U.S. 763, 770-73 (1992) ("combination of
 17 functional features . . . which is not itself functional, properly enjoys protection"), one of the
 18 cases on which the Ninth Circuit Model Jury Instruction Manual relies.

19 Thus, once a trade dress is found to be non-functional, and hence worthy of protection,
 20 the jury should consider the trade dress as a whole rather than only the non-functional aspects of
 21 it. The Ninth Circuit is explicit on this point in *Clicks Billiards*: "Courts have repeatedly
 22 cautioned that, in trademark—and especially trade dress—cases, the mark must be examined as a
 23 whole, not by its individual constituent parts." 251 F.3d at 1259. The courts' infringement
 24 analyses in *Clicks Billiards* and in *Taco Cabana* confirm this principle. In both cases, the court,
 25 after concluding the trade dress may have functional elements but is not functional as a whole,
 26 goes on to analyze infringement without subtracting out the allegedly functional elements.
 27 *Clicks Billiards*, 251 F.3d at 1264-66 (discussing likelihood of confusion); *Taco Cabana*, 932
 28 F.2d at 1122-23 (same).

1 *Vision Sports, Inc. v. Melville Corp.*, the other case on which the Ninth Circuit Model
 2 Jury Instruction Manual relies, stands for the same proposition: “trade dress involves the total
 3 image of a product and . . . requires the court to focus on the plaintiff’s entire selling image.”
 4 888 F.2d 609, 613 (9th Cir. 1989). In *Vision Sports*, the infringer sought to prevent trade dress
 5 protection for a logo configuration on clothing on the grounds that it conferred a monopoly on
 6 the functional color combination of red, black, and white. *Id.* at 614. The court refused to
 7 separate out this ostensibly functional aspect of the trade dress, explaining that the infringer was
 8 “not enjoined from using the colors red, black, or white on its clothing labels or screen print,” but
 9 was “enjoined from using these colors in a particular graphic display which may be confusingly
 10 similar to the” protected trade dress. *Id.*

11 Samsung’s rejoinder yesterday was to cite *Wal-Mart Stores, Inc. v. Samara Brothers,*
 12 *Inc.*, 529 U.S. 205 (2000), for the proposition that product configuration cases are different, but
 13 the *Wal-Mart* case is inapposite. *Wal-Mart* held that, absent registration, a product configuration
 14 is entitled to trade dress protection only if it has acquired secondary meaning. *Id.* at 216. That
 15 is, product design “is not inherently distinctive.” *Id.* at 212. But Apple does not dispute the need
 16 to establish that its unregistered trade dress has acquired secondary meaning. That has no
 17 bearing on whether the trade dress, once its distinctiveness is established, is protected as a whole
 18 or only in its non-functional aspects. In product configuration cases, the courts of this circuit
 19 have long held that it is “the *total effect* of the defendant’s product and package on the eye and
 20 mind of an ordinary purchaser” that counts, even where “each feature independently furthers the
 21 [product’s] function.” *STX, Inc. v. Trik Stik, Inc.*, 708 F. Supp. 1551, 1559 (N.D. Cal. 1988)
 22 (skateboard kneepads) (emphasis added); *see also, White Swan, Ltd. v. Clyde Robin Seed Co.*,
 23 729 F. Supp. 1257, 1259-60 (N.D. Cal. 1989) (shaker-top can). There is no precedent for
 24 departing from that rule.

25 Apple also renews its objection to the sentence in the preliminary instruction defining
 26 trade dress as “the form in which a person presents a product or service to the market, its manner
 27 of display.” We see considerable potential for jury confusion in this sentence. Apple’s trade
 28 dress claim goes to product configuration, not to the manner in which Samsung’s products are

1 “display[ed]” or “present[ed].” The first two sentences of the instruction accurately and
2 completely define trade dress and have Supreme Court imprimatur. *See Two Pesos, Inc. v. Taco*
3 *Cabana, Int’l Inc.*, 505 U.S. 763, 764 n.1 (1992) (quoting without disagreement an instruction
4 almost identical to the first two sentences of the proposed instruction). We can find no case
5 authority for the third sentence of the proposed instruction, whether in the decisions cited in the
6 Model Instruction or elsewhere.

7 Apple thus respectfully renews its objection to Preliminary Instruction No. 21.
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