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Public Awareness through Private Law Remedies: The Struggle for Information in the *Samsung/Apple* Case[*]

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Abstract

Compelling a party to disseminate judicial orders through her Homepage implies a relevant discretionary power. The work discusses the extension of such a judicial power, pointing out some questions and raising some concerns.

What is the real function of such prominent advertising? Is it possible to repair a damage beared by a private plaintiff by restablishing a correct information of the public at large? Can injunctive reliefs transcend the immediate interests of the litigants in order to further social objectives? This paper does not provide definitive answers, rather it is a starting point for a discussion.

The survey recalls other questions like: the increasing use of moral arguments in Courts' reasoning in order to prevent violations or breach of duties, public information and commercial certainty as legal goals, the controversial shaming effect of the remedy at issue and the threats to personality rights and freedom of expression.

1. Introduction

Although the core of the Samsung/Apple litigation is enforcement of Intellectual Property as well as industrial design infringements, the recent UK case addresses concerns that go beyond such boundaries. Indeed, the Court issued a publicity order whose aim was essentially to disperse the fog of commercial uncertainty created by Apple's negative commercial speech about Samsung.

Moving from the comment of such a case, the article introduces some hyphotesis and questions about the role of private law remedies. In particular, injunctive reliefs could be investigated in their ability to transcend the immediate interests of the litigants in order to further social objectives. In this respect, the paper encompasses a comprehensive view of corrective advertising as a remedy with a main characteristic: taking advantage of the potential of Internet based commercial speech to provide adequate information to the public.

Does such prominent advertising amount to a shaming sanction or a judge ordered apology? In light of a comparative law analysis, the article suggests that the Law may consider, under certain circumstances, public awareness as a relevant goal to achieve,

[*] I would like to thank Prof. Prue Vines for her insightful comments and encouragement. Any errors that remain are entirely my own.

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to protect both private and public interests, allowing a judicial restriction of freedom of speech and communication. In the case of Samsung/Apple, it could reflect the emerging need for new regulatory tools aimed at preventing unfair competition as well as providing proper incentives for innovation.

2. "Smartphone War": Some Background

The recent Samsung/Apple case[1] fixes the paradigm of a global litigation between Hi-tech Corporations, contending against each other for dominance on the "mobile media" market. Such litigation is part of the so called "smartphone war"; meanwhile it is essentially based on patents rights claims.

The worldwide litigation between the two giants, Samsung and Apple has been characterized by a reiterated assertion by Apple that Samsung went on infringing and copying its smartphone patents and designs. Since the beginning, Apple has traditionally sought to stop Samsung from selling some of its devices accusing it of stealing its patents and iPad design.

Netherlands at a preliminary stage held in Samsung's favour. There are judgments of the Dutch and German courts saying that the Samsung products do not infringe the Registered Community Design.[2] In Germany, the courts of Düsseldorf were called to decide on these issues.[3] In particular, the Higher Court of Düsseldorf found that the Galaxy 10.1 tablet computer did not infringe a registered Community design held by Apple but was exploiting the iPad's reputation, which violates rules of unfair competition law.[4] Samsung then modified the design and intended to market this 10.1N version of the Galaxy tablet. Apple again took action but neither the Regional Court nor the appeal to the Higher Regional Court found the redesigned version to violate unfair competition rules.[5]

In the US in the Northern District of California,[6] the Court granted a preliminary injunction in Apple's favour, enjoining the Samsung Galaxy Nexus on the basis of four patents infringed by the smartphone's operating system, Google's Android. Judgment – as observed – may yield serious consequences for the manufacturer of Android-based devices. In fact, Judge Koh highlighted the necessity of identifying

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[1] See Birrs J in *Samsung Electronics (UK) Ltd v. Apple Inc* [2012] EWHC 2049 (Pat) (18 July 2012).

[2] See TC Vinje and A van Rooijen, *The Relationship between Intellectual Property Rights and Competition Laws*, in N Wilkof, S Basheer, *Overlapping Intellectual Property Rights*, 365–385 (Oxford, 2012); also A Nordemann and T Mooney Aron, *The Relationship between Trademark Rights and Unfair Competition Law*, in *Id.*, at 342–364.

[3] MD Mimler, *The Aspects of Unfair Competition within the Apple v. Samsung litigation in Germany*, *Oberlandesgericht Düsseldorf*, *Urteil vom 31.01.2012*, *I-20 U 175/11*, *Landgericht Düsseldorf*, *Urteil vom 09.02.2012*, *14c O 292/11 and Oberlandesgericht Düsseldorf*, *Urteil vom 24.07.2012*, *20 U 35/12* 3 Queen Mary Journ. Of Intellectual Property176–184 (2013).

[4] *Ibid.*

[5] *Ibid.*

[6] *Apple Inc v. Samsung Electronics Co Ltd*, District Court, 12-CV-0030 (29 June 2012).

the effects of patent infringement on consumers, considering loss of brand distinctiveness as a loss of goodwill.[7]

3. The UK Samsung/Apple Litigation

Recent judgments in the UK deal with a particular perspective on such a "war" as it is concerned with Community registered design. In this case, unusually, Samsung sued Apple to obtain a declaratory judgment and publicity injunction in order to stop Apple from falsely accusing the claimant of Community designs infringements. In particular, Samsung Electronics (UK) Ltd decided to sue Apple Inc in UK for a declaration that three of Samsung's Galaxy tablet computers (the Tab 10.1, Tab 8.9 and Tab 7.7) did not infringe a specific Apple's Community registered design.[8]

After a complex and highly technical inquiry, Judge Birss found that "The informed user's overall impression of each of the Samsung Galaxy Tablets is the following. From the front they belong to the family which includes the Apple design; but the Samsung products are very thin, almost insubstantial members of that family with unusual details on the back. They do not have the same understated and extreme simplicity which is possessed by the Apple design. They are not as cool. The overall impression produced is different." As a result, J. Birrs concluded that the Samsung tablets do not infringe Apple's registered design.[9]

4. Prior Restraining Order

Moreover, Samsung sought a prior restraining injunction in the following terms: "The Defendant, by its directors, officers, servants or agents or otherwise howsoever, is restrained from representing to any person that the making and/or offering and/or putting on the market and/or importing and/or exporting and/or using the Claimant's Galaxy Tab 10.1 and Galaxy Tab 8.9 and Galaxy Tab 7.7 tablet computers and/or stocking the Claimant's Galaxy Tab 10.1 and Galaxy Tab 8.9 and Galaxy Tab 7.7 tablet computers for those purposes by the Claimant in the European Union infringes Registered Community Design 000181,607-0001."[10]

However, the Court declined to restrain Apple from repeating allegations of infringement, stating that Apple 'are entitled to their opinion that the judgment is not

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[7] See S Barazza, *Apple v. Samsung: A Preliminary Injunction Against the Galaxy Nexus Smartphone* 8 Journal of Intellectual Property Law and Practice 6–8 (2013).

[8] Which number is No 000181607–0001. See D Smyth, *Publicity Orders in Intellectual Property Cases – When are They Granted and How Must a Party Comply? Samsung Electronics (UK) Ltd v. Apple Inc [2012] EWCA Civ 1430*, *Court of Appeal for England and Wales*, *9 November 2012*, 8 Journal of Intellectual Property Law & Practice 272 (2013).

[9] In particular, it was the registration No. 000181607–0001.

[10] Birrs J, 18.07.2012, Ch. 3.

correct'.[11] Moreover, Birrs J. outlined that the Defendant's right to appeal its ruling as well as its freedom of speech would be at risk by such an order: "I also bear in mind the question of what would be the position pending appeal. Apple wish to appeal this ruling and I have given them permission to do that. To do that they need to assert that the Samsung tablet infringes. I suppose a proviso could be put into the injunction. Nevertheless they are entitled to their opinion that the judgment is not correct"[12]. Birrs J. went on, stating that "Finally, and most importantly in my judgment, Article 10 and freedom of speech would be engaged. An injunction of this kind, it seems to me, risks engaging the right to free speech. No development of these principles was made before me. All I will say is that I foresee serious difficulties in relation to freedom of speech arising from an injunction of this kind."[13]

It was acknowledged that there is a very serious question whether the court should go around granting injunctions purporting to restrain people from saying that they disagree with a judgment.[14] A statement attributed to Jeremy Bentham asserts "publicity is the soul of justice" and Birrs J. remarked that it is very important that the courts can be held up to public scrutiny and what happens in them can be discussed in public.[15] The Court assumed that it is one very powerful factor and is quite sufficient to establish that there should be no injunction[16]. So, according to the overwhelming value of freedom of information, it refused to issue a prior restraining order against Apple.

5. Publicity Order

Otherwise, as claimed by Samsung, the Court issued an injunctive relief requiring Apple to give publicity to the decisions in two ways.

First, he ordered Apple to publish a notice in The Financial Times; the Daily Mail; The Guardian; Mobile Magazine; and T3 magazine on its UK website. The notice reads as follow:[17]

> *On 9th July 2012 the High Court of Justice of England and Wales ruled that Samsung Electronics (UK) Limited's Galaxy Tablet computers*, *namely the Galaxy Tab 10.1*, *Tab 8.9 and Tab 7.7 do not infringe Apple's registered design 000181607-0001. A copy of the full judgment of the High Court is available via the following link [insert hyperlink].*
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[11] *Id*., Ch. 28.

[12] *Id*., Ch. 26.

[13] *Id*., Ch. 27.

[14] *Ibid*.; see also E Volokh, *Freedom of Speech*, *Information Privacy*, *and the Troubling Implications of a Right to Stop People from Speaking about You* 52 Stanford Law Rev 1–60 (2000).

[15] *Ibid*., Ch. 28.

[16] *Ibid*., Ch. 29.

[17] *Ibid*.

It directed also that the above mentioned notice should appear on the home page of Apple's UK website in a font size no smaller than Arial 11pt together with a hyperlink to the judgment and that the notice and the hyperlink should remain displayed for a period of six months.[18] Further, the notice in the newspaper and trade magazines should be published in a font size no smaller than Arial 14pt and appear on a page earlier than page 6[19].

What is the legal basis to issue such an order? What is the goal pursued by Court? Is the publicity order aimed to undo a past wrong to the counterpart reputation? Or is it at best aimed to inform the public and to prevent deceptive consequences?

Normally an injunctive relief could take the form of an interim injunction that is an injunction granted at the pre-trial of the action, while final injunctions are granted at the trial of the action or at another hearing in which final judgment is given.[20]

Mandatory injunctions, which are less common than prohibitory injunctions, require the defendant to do something: they enforce primary duties or, in the form of a mandatory "restorative" injunction, they require the defendant to "undo" a wrong.[21]

Does the Directive 48/2004/EC on Enforcement of Intellectual Property apply to the case? As stated by recital 27 of the preamble to Directive 48/2004: "to act as a supplementary deterrent to future infringers and to contribute to the awareness of the public at large, it is useful to publicise decisions in intellectual property infringement cases".

The same Directive addresses at Article 15 the issue of "Publication of judicial decisions", ruling that**: "**Member States shall ensure that, in legal proceedings instituted for infringement of an intellectual property right, the judicial authorities may order, at the request of the applicant and at the expense of the infringer, appropriate measures for the dissemination of the information concerning the decision, including displaying the decision and publishing it in full or in part. Member States may provide for other additional publicity measures which are appropriate to the particular circumstances, including prominent advertising."

But the same Art. 15 of Directive 2004/48/EC makes clear that the remedy is basically available only against IP infringers and not to the detriment of the unsuccessful rights holder. So there is no legislative basis in the Community Design Regulation or in the IP Enforcement Directive (Council Directive 2004/48) for such an order.

Does the absence from the Community legislation of such an order necessarily go as far as to mean that Courts should be "extremely" cautious in adopting an injunction?[22]

The UK Court of Appeal does not share this view and expresses concerns about the order's effect on trade between Member States. The directive, in fact, does not prevent Member states from allowing a protection of the non-infringing party by other legal means[23].

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[18] *Samsung Electronics (UK) Limited v. Apple Inc*. [2012] EWCA Civ 1223, Ch. 8.

[19] *Ibid*.

[20] A Burrows (Ed.), *English Private Law*, 1691 (2nd, Oxford, 2007).

[21] *Id*., 1691.

[22] *Samsung Electronics (UK) Limited v. Apple Inc*. [2012] EWCA Civ 1223, Ch. 17.

[23] *Ibid*.

In UK law, an order could be made by Court pursuant to section 37(1) of the Senior Courts Act 1981, that is essentially a provision which says that the court may grant injunctions when it is just and convenient to do so.[24]

Unlike *Samsung v. Apple*, in the *Brigade* case[25] the order was in an action for infringement and was therefore within Article 15 of the Enforcement Directive and recital 27. Nevertheless, the availability in principle of a publicity order was acknowledged in both cases. But in *Brigade*, it was stated that in order to have a proper basis for making such an order:

– some material would need to be placed before the court in support (evidence);
– when a judgment is in default of defence, the considerations applicable to declaratory orders in similar circumstances (see e.g. *Wallersteiner v. Moir* [1974] 1 WLR 991) seem to be potentially relevant here too.[26]

There is no presumption that an advertisement should follow as a matter of routine, but in some cases there is a clear underlying policy which shows that a discretionary power should ordinarily be exercised in a particular way. A certain amount of underlying policy can be discerned from recital 27 and summarised in four reasons:

– such orders ought to become standard practice;
– such an order would remind the defendant to be more careful about the nature of the products which it sold;
– the publication by the defendant of the result of the decision against it would be a deterrent to other infringers and counterfeiters;
– whenever infringement is established there ought to be a policy of granting a full range of remedies, given the difficulties which owners of IP rights face in identifying and successfully pursuing infringers.[27]

However, all of these matters are to some extent beside the point. Article 15 and *32Red* concern a case in which the person seeking the order is a victorious rights holder vindicated in a claim for infringement. The *Samsung/Apple* case is different from the case specifically considered by Article 15.[28] In fact, in this case the victorious person is the one who has been found not to infringe. What is the legal base for the dissemination of such a judgment?[29] Samsung submitted that the jurisdiction to make this order lays on section 37 of the Senior Courts Act and that the court has jurisdiction to make this order. But the real question, as always, is whether it should be exercised.[30]

Quoting Mann J, Birrs J. remarked that: "*The dispute in this case needs resolution while the designs of the product are still current*, *and in the context of a Europe-wide*

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[24] J Birrs, in *Samsung v. Apple*, 18.07.2012, Ch. 15.
[25] *Ibid*.
[26] *Ibid*.
[27] Henderson J in *32Red PLC v. WHG (International) Limited* [2011] EWHC 665 (Ch) 37.
[28] *Be*, Ch. 41.
[29] Birrs J., Ch. 39.
[30] *Id*., Ch. 40.

dispute about these tablet computers it is necessary to start to get some (or some more) final decisions in place to produce certainty and remove public and litigation posturing."[31] Birrs J. referred also that Lloyd LJ said: *"The need for urgency arises because of the intense competition between the rival parties and their products in the market, and because of Samsung's position that Apple's contention that the Galaxy infringes the registered design is putting Samsung wrongly and unfairly at a disadvantage in the market."*[32]

In conclusion, the policy comes down to two points: to deter future infringers and to publicise and disseminate the outcomes of these sorts of proceedings. As pointed out by Birrs J: "clearly the first question of deterrents of future infringers does not apply, but as for the policy of contributing to awareness, it seems to me, and I accept Miss Pickard's submission, that this applies both ways, both to infringements and to non-infringements."[33]

But, as underlined by Sir Robin Jacob, publicity orders of this sort should not be the norm.[34] He expressed concerns on the proliferation of disputes about publicity orders as ancillary satellite disputes, concluding: "They should normally only be made, in the case of a successful intellectual property owner where they serve one of the two purposes set out in Art. 27 of the Enforcement Directive and in the case of a successful non-infringer where there is a real need to dispel commercial uncertainty in the marketplace (either with the non-infringer's customers or the public in general)."

6. The Publication *Ad Usum Delphini* by Apple

What did happen with the homepage notice?

The home page[35] of the Apple website[36] is the first port of call for Internet users and the most critical page from a marketing perspective. The order sought would compel Apple to place the statement on its homepage for a period of six months and do something utterly out of character and at odds with everything it has previously chosen to say. It will also disrupt Apple's ability to control its image, publicity and content and worse still, completely change the appearance of that website. All of this would distract consumers and inevitably cause unquantifiable and irreparable harm.[37] This brought Apple to subsequently disobey the order.

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[31] *Id.*, Ch. 43.

[32] *Id.*, Ch. 44.

[33] *Id.*, Ch. 42.

[34] See *Samsung v. Apple* [2012] EWCA Civ 1339, Ch. 69 recently quoted in *Brigade (BBS-TEK) Limited v. Back Tek Worldwide LTD*, *Jamie Martin Macsween* [2012] EWPCC 52, Ch.8.

[35] An Home page consists in the part of a web site that is seen first an that usually contains links to the other pages of site. See Merriam-Webster Dictionary, www.merriam-webster.com.

[36] Web site: a place in the world wide web that contains information about a person, organization etc., and that usually consists of many Web pages joined by hyperlinks. See *Ibidem*.

[37] *Samsung Electronics (UK) Limited v. Apple Inc*. [2012] EWCA Civ 1223, Ch. 32.

Trying to avoid dangers to its reputation,[38] Apple embellished the notice in a tendentious way, suggesting a different version of the litigation outcomes[39]. In particular, the additions consisted in some assertions by Birrs J. about the Apple's cool style as opposed to the Samsung style. Moreover, referring to further judgments released around the world, it reported that contrasting rulings were issued on the same case. Although the contested notice conveyed a displaced, contradictory and, somehow, ridiculous image of justice, this is a real critical point.

So Apple blatantly violated the order and provoked a strong reaction of the Court of Appeal that stated "The false innuendo is that the UK court came to a different conclusion about copying, which is not true for the UK court did not form any view about copying. There is a further false innuendo that the UK court's decision is at odds with decisions in other countries whereas that is simply not true. The reality is that wherever Apple has sued on this registered design or its counterpart, it has ultimately failed. It may or may not have other intellectual property rights which are infringed. Indeed the same may be true the other way round for in some countries Samsung are suing Apple. But none of that has got anything to do with the registered

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[38] A notice of this sort could be seen as a prejudice in the light of future litigation outcomes. See about the resistance to admit past wrongdoings in mediation, T Bingham, *Re D (Minors) (Conciliation: Disclosure of Information)* [1993] 2 WLR 721, 724.

[39] Here is the text disseminated by Apple.

Samsung / Apple UK judgment

On 9th July 2012 the High Court of Justice of England and Wales ruled that Samsung Electronic (UK) Limited's Galaxy Tablet Computer, namely the Galaxy Tab 10.1, Tab 8.9 and Tab 7.7 do not infringe Apple's registered design No. 0000181607–0001. A copy of the full judgment of the High court is available on the following link www.bailii.org/ew/cases/EWHC/Patents/2012/1882.html.

In the ruling, the judge made several important points comparing the designs of the Apple and Samsung products:

"The extreme simplicity of the Apple design is striking. Overall it has undecorated flat surfaces with a plate of glass on the front all the way out to a very thin rim and a blank back. There is a crisp edge around the rim and a combination of curves, both at the corners and the sides. The design looks like an object the informed user would want to pick up and hold. It is an understated, smooth and simple product. It is a cool design."

"The informed user's overall impression of each of the Samsung Galaxy Tablets is the following. From the front they belong to the family which includes the Apple design; but the Samsung products are very thin, almost insubstantial members of that family with unusual details on the back. They do not have the same understated and extreme simplicity which is possessed by the Apple design. They are not as cool."

That Judgment has effect throughout the European Union and was upheld by the Court of Appeal on 18 October 2012. A copy of the Court of Appeal's judgment is available on the following link www.bailii.org/ew/cases/EWCA/Civ/2012/1339.html. There is no injunction in respect of the registered design in force anywhere in Europe.

However, in a case tried in Germany regarding the same patent, the court found that Samsung engaged in unfair competition by copying the iPad design. A U.S. jury also found Samsung guilty of infringing on Apple's design and utility patents, awarding over one billion U.S. dollars in damages to Apple Inc. So while the U.K. court did not find Samsung guilty of infringement, other courts have recognized that in the course of creating its Galaxy tablet, Samsung wilfully copied Apple's far more popular iPad.

design asserted by Apple in Europe. Apple's additions to the ordered notice clearly muddied the water and the message obviously intended to be conveyed by it."[40]

According to the doctrine of inherent jurisdiction, the Court granted a further injunction to correct the Apple's previous breach of order,[41] expressly prohibiting any further comment. As observed by Sir Robin Jacob:"All we required is that the notice we ordered should appear unvarnished or unembellished in any way."[42] Of course, the Court made clear that did not preclude a compelled party from making statements elsewhere – even untrue ones which might amount to a libel or malicious falsehood.[43]

In cases involving such opposite versions of facts the court's inherent jurisdiction could be invoked by the party potentially endangered by adverse assertions. As recently underlined by Lord Chadwick in *Point v. Focus*[44]: "I can see some attraction in a "put up or shut up" order in circumstances where one party seeks to spread it around the market by innuendo that another party (a competitor) is infringing its copyright, with the obvious purpose of putting that other party at a commercial disadvantage." Another point I would like to stress is the moral regret that encompassed the Apple decision to rewrite the notice *ad usum delphini.* As a consequence, the costs (lawyers' fees) have been awarded on an indemnity basis, higher than the normal "standard" basis. The Court ruled that "Such a basis can be awarded as a mark of the court's disapproval of a party's conduct, particularly in relation to its respect for an order of the court. Apple's conduct warranted such an order".[45]

Finally the Court mentioned the time for compliance which "for technical reasons" Apple delayed for fourteen days. Sir Robin found that very disturbing: "that it was beyond the technical abilities of Apple to make the minor changes required to own website in less time beggared belief. In end we gave it 48 hours which in itself I consider generous." Moreover the Court had given Apple the opportunity to extend the term by an application supported by an affidavit from a senior executive explaining the reasons why more was needed, but in the event no such application was made. In the last part (par. 32) of the Appeal judgment Sir Robin Jacob affirmed: "I hope that the lack of integrity involved in this incident is entirely atypical of Apple."[46]

But why did Apple add to the notice and waste time? I think Apple was well aware to go beyond the boundaries of its freedom of speech. Probably, and so the Court implied, it decided to take extra time according to a specific legal strategy aimed at weakening the negative effects of dissemination. Nevertheless, the argument used by Apple against the order was that by putting a reference to Samsung on Apple's website, that risked diverting sales to Samsung so that Samsung essentially were getting

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[40] CA, 09.11.2012, Ch. 24–25.

[41] *Id.*, Ch. 27. See also I H Jacob, *The Inherent Jurisdiction of the Court* 23 Current Legal Problems 44 (1970).

[42] See *Samsung v. Apple* [2012], EWCA, 1430, Ch. 30.

[43] See *Samsung v. Apple* [2012], EWCA, 1430, Ch. 30.

[44] *Point Solutions Limited v. Focus Business Solutions Limited* [2007] EWCA Civ 14, Ch. 34.

[45] *Samsung v. Apple* [2012] EWCA Civ 1430, Ch. 31.

[46] *Id.*, Ch. 32.

free advertising from Apple.[47] According to it, an advertising (in favour of Samsung – as Apple viewed the contested notice) had to be punctual to produce a valuable effect. We have to bear in mind that "This is a very fast moving industry", as pointed out by Birrs J.[48] as well as "this is a commercial battle between the largest sorts of corporations one could ever imagine who are in many ways people who can look after themselves."[49]

7. Forum Shopping Concerns: Community Design and Overlapping Rights

The case at issue raises some concerns about Apple's litigation strategy or forum shopping argument.

The UK Court of Appeal appropriately underlined the different ground of its jurisdiction from the German one. UK Court sits as Community Design Court while German judges only took part as preliminary hearing or patent-unfair competition law.

But the Court called also for a defect of the German Court as well as the latter had ruled against Samsung under unfair competition law.[50] In fact, the Court openly complained also of the uncertainties created by German jurisdiction holding or to have fallen into the Apple's litigation (forum) shopping strategy.

Does a Community design registration of a certain product own any *vis attractiva*, or preemptive effect, on intellectual property or competition law issues? Infringement disputes concerning Community trademarks and designs (including unregistered Community designs) are dealt with by nominated courts in each EU member state.[51] Both the CDR and the CMTR contain rules which determine which court or courts have jurisdiction in any particular case, dependent on such factors as the domicile of the defendant, the domicile of the claimant, and the country in which the alleged infringement is taking place.[52]

In most cases, the court concerned has jurisdiction to grant a pan-EU injunction. In any particular case, there may be more than one country in which this would be possible, and so there is some scope for forum shopping or abusive litigation when an action is being contemplated for Community trademark or design infringement (or both) particularly where the alleged infringements are taking place in multiple EU member states.[53] Otherwise, identification of litigation brought entirely without merit is a difficult analysis to undertake. For example, the firm could be required to show not only that it initiated the litigation in a genuine attempt to assert what it reasonably

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[47] Birrs J, 18.07.2012, Ch. 49.

[48] Birrs J, 18.07. 2012, Ch. 57.

[49] See *Samsung Electronics (UK) Limited v. Apple Inc.* Justice Birrs QB [2012] EWHC 2049.

[50] CA, 09.11.2012, Ch. 22, b).

[51] AS Nemes, H Blackwell, A Carboni, *Overlapping Rights in Designs*, *Trademarks*, *and Trade Dress*, in Wilkof and Basheer, at 373.

[52] *Ibid*.

[53] *Ibid.*

considered to be its rights, but also that it believed it had good prospects of success in that litigation.[54]

In general, limitation to only one form of protection cannot operate without clear selection rules, which neither Europe nor the US have enacted.[55] Under the EU law regime, the Office of Harmonization in the Internal Market affirmed that "if any entity possesses the required conditions, it may be protected simoultaneously by a number of intellectual property rights".[56] Parallel protection by design and patent is permitted by the Council Regulation which, at recital 31, reads: " This Regulation does not preclude the application to designs protected by Community designs of the industrial property laws...such as those relating to...patents."[57]

The primary purpose of designs protection is to deal with product shape (its overall impression) not function. Indeed, the two ways may co-exist and Apple IPad could join a double protection in principle. As a result, it encompasses the hypothesis of infringement in a very comprehensive way. Moreover, the regulation at stake in EU is specifically crafted for the Community design, implying a technical analysis by Courts assuming the point of view of an informed user. As both patents and designs involve some kind of intellectual creativity, the difference is not in the nature of the right but in the person of the reader.[58] Whereas a patent is directed to an expert who may be able to extract a principle of operation from an exemplary drawing, a design is directed to a lay observer (the "informed user" in Europe, the "ordinary observer" in US).[59]

The observer has to take into account the material implementation of designs to compare them. As recently underlined, "In infringement proceedings a direct comparison will be to the disadvantage of the design owner: the differences in the allegedly infringing product that has to be compared with the design registration will be easily observable in a direct comparison, which increases the chance that the allegedly infringing product will produce a different overall impression on the informed user".[60]

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[54] S Priddis, S Constantine, *The Pharmaceutical Sector*, *Intellectual Property Rights*, *and Competition Law in Europe*, in S Anderman, A Ezrachi (eds), *Intellectual Property and Competition Law*, 267 (Oxford, 2011).

[55] See literally, D Musker, *The Overlap between Patent and Design Protection*, in N Wilkof, S Basheer, *Overlapping Intellectual Property Rights*, 26 (Oxford, 2012) (outlining the lack of uniformity, also in the application of the "election theory" in US case law).

[56] See *Lego Juris A/S v. Mega Brands Inc* (R 856/2004-G) [2007].

[57] See Council Regulation 6/2002 on Community Designs [2001} OJ L3/1 ('CDR').

[58] D Musker, at 43.

[59] *Ibid*.

[60] See Geerts, *The Informed User in Design Law: What Should He Compare and How Should He Make the Comparison?* 36(3) E.I.P.R. 184 (2014), citing *Samsung v. Apple* [2012] EWHC 1882 (Pat); [2013] E.C.D.R. 1at [58] where the following is held, among other things: "On the other hand 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." See also *Apple v. Samsung*, Court of Appeal of The Hague, January 24, 2012(2012) 36 BIE 169, annotated by Huydecoper at para. 9.2.

Although the UK proposed an exclusion of Designs or Arrangements in which the novelty resides in appeal to the eye, explicitly to eliminate overlap, this was rejected.[61] So, the positive requirements for ornamentality (for designs) and utility or technical character (for patents) do not produce a clear and unmistakeble separation.[62]

Once more, the different fields and competences of Community design on one side, and unfair competition and intellectual property issues, on the other, seem to be a crucial but controversial aspect.

Unfair competition is a relatively unsignificant concept in UK Law.[63] Its function is better acknowledged in Civil Law contexts (like German law) whose aim is to regulate "business to business" unfair commercial practices that do not affect directly the consumers.[64]

Indeed, the primary concern of unfair competition law in civil law systems is that the consumers' decisions should not be influenced by unfair practices of marketing.[65] If the form of the good is slavishly copied, for instance, the registered design owner can assert claims of unfair competition even in addition to his community registered design.[66] Similar conclusions could be reached if the original product is imitated or recalled by false or misleading advertising, parodied or made to look ridiculous.

8. Publicity Orders and Corrective Advertising: A Comparative Overview

In Civil Law countries, it's quite common that Courts may order adverse publication on websites, under the circumstances, absent any specific statutory provision allowing them to do so.[67] In the last years, there was considerable interest in alternative remedies to damages and negative injunctions. From a comparative perspective, a major change in private law remedies stems from ICT powerful dissemination of ideas and behaviors.[68]

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[61] D Musker, at 30–31.

[62] *Ibid*.; G Zimmerman, *Extending the Monopoly? Risks and benefits of multiple forms of Intellectual Property protection* 17 Canadian Intellectual Property Rev., 363 (2000).

[63] See C Wadlow, *The Emergent European Law of Unfair Competition and its Consumer Law Origins*, 1 Intellect. Prop. Quart. 1–5 (2012), describing "unfair competition" as "terra incognita" in UK law.

[64] *Id*., 20–22 (arguing that the division between unfair business-to-consumer practices and unfair business to business practices is impossible to maintain).

[65] See also A Nordemann and T Mooney Aron, *The Relationship between Trademark Rights and Unfair Competition Law*, at 342; G Alpa, *New Perspectives in the Protection of Consumers: a General Overview and Some Criticism on Financial Services* 16 Eur. Bus. L. Rev. 719–735 (2005).

[66] See *Id*., 342–343, showing the intersection between unfair competitive practices and registered form of the good (as registered trademark), although the reasoning shares common characters with registered design.

[67] Such a provision is now part of art. 120 of the Italian Civil Procedure Code (as modified by art. 45, 16, of law 18.6.2009, n 69). See F Ferrari, *Art. 120*, in Comoglio, Consolo, Sassani, Vaccarella (eds), *Commentario del codice di procedura civile*, II, 502 ss (Torino, Utet Giuridica, 2012).

[68] The World Wide Web as a multimedia interface that allows for the transmission of text, pictures, audio, and video together, known as web pages. http://legal-dictionary.thefreedictionary.com/Internet.

Intellectual Property Laws generally provides a wide range of remedies for the infliction of wrongs on private individuals and entities.[69] Also in US Patent Act, the injunction is commonly intended as a preventive measure, while in other areas of law it can achieve further functions (reparation, sanction).[70] In the Circuit's words, "An injunction is only proper to prevent future infringement of a patent, not to remedy past infringement".[71] Otherwise, scholars have identified only one injunction that contained a purely reparative function. It was a consented-to order commanding an infringer to "provide a written letter of apology … that recognizes [the] infringement of the patents-in-suit, and apologizes for it."[72]

Actually, publicity orders and corrective advertising are gaining momentum.[73] The AIPPI[74] recently carried out a survey on reliefs in IP proceedings with reference to various countries. In France, the publicity order is very common as additional relief and it is granted at the Court's discretion when it could prevent further damages. The Courts can consider that a publication is justified by the nature of the acts of infringement at issue.[75] With specific regard to Designs Law it was pointed out that measures like corrective advertising or dissemination of the judgment stem from the need to protect the health or safety of consumers (e.g. in product's liability).[76]

The possibility of granting publication on the Internet was introduced by the law of 29 October 2007. It entails a form of corrective advertising, in particular when it is ordered on the defendant's website.[77] The Courts may refuse to order the publication of the judgment by the length of time elapsed since the acts occurred or the cessation of the marketing of infringing goods, so that awarding damages constitutes adequate and sufficient relief.[78]

In determining the proportionality and justified nature of the measures the Court may take into account the following situations:

See also, for a critical survey, R Peters, *Marketplace of Ideas' or Anarchy: What Will Cyberspace Become?* 51 Mercer Law Review 909 (2000).

[69] TM Sichelman, *Purging Patent Law of "Private Law" Remedies* 92 Texas Law Rev. 518 (2014); EJ Weinrib, *The Idea of Private Law* 143 (1995); G Calabresi, AD Melamed, *Property Rules*, *Liability Rules and Inalienability: One View of the Cathedral* 85 Harv. L. Rev.1089 (1972).

[70] Golden, *Injunctions as More (or Less) than "Off Switches": Patent-Infringement Injunctions' Scope* 90 Tex. L. Rev. 1399, 1424–25 (2012).

[71] *Spine Solutions*, *Inc. v. Medtronic Sofamor Danek USA*, *Inc.*, 620 F.3d 1305, 1320 (Fed. Cir. 2010)].

[72] Golden (n 72), quoting *Batesville Servs.*, *Inc. v. S. Rain Casket & Funeral Supply*, No. 2:09-CV-257-PPS-APR, slip op. at 5 (N.D. Ind. July 15, 2010). About apologies, see Ch. 8.

[73] A Burrows (Ed.), *English Private Law*, 1691 (2nd, Oxford, 2007).

[74] AIPPI (*Association pour la Protection de la Proprieté Industrielle*), Working Group France, *Relief In IP Proceedings Other Than Injunctions or Damages*, Report on 24 April 2013, pp 7–9.

[75] See French Supreme Court, 12 July 2012.

[76] *Ibid*.

[77] See Paris first level civil court, 19 March 2008. For an order authorizing a right holder to display a publication on the defendant's stand during trade fairs (Paris first level civil court, 3rd chamber – 3rd section, 16 September 2011).

[78] Paris Court of Appeal, 17 September 2009; Paris Court of Appeal, 27 February 2013.

– where the patent has expired;
– where the infringement has ceased;
– where the defendant is undergoing court ordered liquidation;
– where the defendant is in default;
– where the infringing product was presented on a single occasion, during a trade fair.[79]

We can find useful indications about the goals and limits concerning corrective advertising in the case *United States of America v. Philip Morris*.[80] Here a federal judge ordered tobacco companies to publish corrective advertising statements that (i) say a federal court found that they lied about the dangers of smoking and (ii) disclose negative facts about smoking, including about smoking's negative health effects; the addictiveness of smoking; the lack of significant health benefits from cigarettes marked "low tar," "light" and similar words; the cigarette companies' manipulation of cigarette design and composition to ensure optimum nicotine delivery; and the adverse health effects of secondhand smoke. The court also found that the corrective advertising did not violate the First Amendment because the statements ordered are purely factual and uncontroversial, and are directed at preventing and restraining the defendants from deceiving the American public in the future.

Another relevant case of a publicity order attached to a prohibitory injunction is *Copiepresse v. Google Inc*, in which Google was ordered by *Tribunal de Premiere Instance de Bruxelles*:[81]

– to withdraw from all its sites all the articles, photograph and graphic representations from the Belgian publisher of the daily French-and German – speaking press, repesented by the plaintiffs within 10 days of the present notification under penalty of a daily fineof 1,000,000.00 Euros per day of delay;
– to publish in a visible and clear manner and without any commentary from her part, the entire intervening judgment, on the home pages of "google.be" and "news.google.be" for a continuous period of 5 days, within 10 days of the present notification under penalty of incurring a daily fine of 500.000,00 Euro per day of delay.

To prevent breaches of order, like critical speaches, by the injuncted party, the Belgian Tribunal accurately specified that any comment by the injuncted party was banned from the same homepage. Similarly, it dealt with huge fines (*astreintes*) as an incentive to comply.

Absent a similar provision in the Samsung/Apple case, the notice appeared with Apple's modifications and additions requiring a further statement by the Court that Apple should not be allowed to do the same or something similar again.[82]

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[79] See Paris Court of Appeal, Division 5, ch. 1, 14 November 2012 and Paris Court of Appeal, Division 5, ch. 1, 19 December 2012.

[80] *Id*., 27/11/2012 (District Court of Columbia).

[81] Courts of First Instance of Bruxelles, No 2006/9099/4 (5th September 2006).

[82] See *Samsung v. Apple* [2012], EWCA, 1430, Ch. 30.

According to this precedent, the High Court stated recently in 2013 that**:** "For the period of six months from 7th October 2013 the parties shall publish in the press release of their respective websites at … statement that the outcome of this litigation has been embodied in a Court Order, and provide the text of or a link to a copy of this Order *and avoid any further comment or discussion on their respective websites when providing the text of or the link to the copy of this Order*."[83] (italics added).

9. Public Awareness Through Private Law Remedies

Although it could sound like a shaming sanction[84] or a judicial apology, the publication of the judgment on Apple's homepage seems to pursue different goals than moral redress or symbolic humiliation. As underlined by the Appeal Court: "The grant of such an order is not to punish the party concerned for its behaviour. Nor is it to make it grovel – simply to lose face. The test is whether there is a need to dispel commercial uncertainty."[85]

The pursuing of public awareness by injunctive relief of this kind can provide an impressive indication about the nature of legal systems or legal cultures. Particularly, it shows that law can take an active role in the public debate about IP rights. A similar goal can be achieved shaping remedies in different ways. Due to its primary compensatory function, civil liability normally turns itself into an obligation to pay the equivalent of a loss, rarely to perform something or, even less, to a sanction (deterrence, punition, rieducation).[86]

While in most cases involving defamation or reputation threats, awarding damages can miss the objectives of reparation and prevention, an interesting solution is represented by a mix (or a sequence) of different remedies left, to a certain degree, to the judicial discretion.[87]

Usually Courts have been very cautious in issuing injunctive reliefs to require specific performance out of a contractual relationship. Samsung/Apple reliefs deal with Internet statements and public awareness in a specific marketplace. Is it similar to an ordered apology?

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[83] *ITV Broadcasting Limited et al. v. TVCatchup-Limited*, Chancery Div., I.P., 7/10/2013, at Ch. 12.

[84] See *Samsung Electronics (UK) Ltd v. Apple Inc* [2012] EWHC 2049 (Pat) (18 July 2012) Ch. 24–25 (on the Apple's argument that the publicity order is like a shaming sanction).

[85] CA, 18.10.2012, Ch. 81.

[86] "Money is the common measure of valuable things" (H Grotius, *De Iure Belli Ac Pacis: Libri Tres (*1625, English trans. by Francis Kelsey, 1949): book II, chap XVII, sect. XXII). The same principle is applied to non pecuniary damages (see the venerable precedent *Livingstone v. Rawyards Coal Co.* (1880), 5 App. Cas. 25 at 39, Lord Blackburn). See also D Kahneman, D A Schkade, C R Sunstein (1998). *Shared Outrage and Erratic Awards: The Psychology of Punitive Damages* 16 Journal of Risk and Uncertainty 49–86. About an expressive function of Tort Law, see S Hershovitz, *Tort as a Substitute for Revenge* (August 11, 2013). *Philosophical Foundations of the Law of Torts*, John Oberdiek (ed.) (OUP, 2014 Forthcoming).

[87] *Ex multiis*, see AS Gold, *Expressive Remedies in Private Law*, in F Lichere, R Weaver (eds), *Remedies and Property* (Presses Universitaires d'Aix Marseille, 2013).

Apology can reach a plurality of legal meanings and goals. For example, apology can work as an initial step toward bridge-building between offender and his victim[88] but also as a proper legal remedy. Looking at a large part of the western legal tradition, judicial orders to apologise are quite unknown, although some scholars advocate for their increasing importance.[89] The High Court of South Africa has recently acknowledged the renaissance of the ancient remedy of *amende honorable* as a form of apology in a defamation case.[90] Beyond publication orders or corrective advertising, we can find an heavier approach to restrict freedom of information as testified by censorship, shaming sanctions, judge ordered apologies that can imply a significant threat to freedom of expression, freedom of thought and due process.[91] A further criticism is that shame penalties, and so judicial ordered apologies, inappropriately impose humiliation rather than confront individuals with the prices for wrongdoing.[92] As a consequence, they divert private litigation from its main compensatory goal, introducing moral correction issues which are totally atypical for private law remedies, if not for the rule of law at large.

Do corporations have feelings or do they experience blame?

Assuming that the category of emotional corporation cannot stand, the Samsung/Apple publicity order was essentially directed, as long as Community design is concerned, to prevent false accusations of plagiarism and to inform the public that Samsung products are not illegal.[93] So, such remedies are concerned essentially with strengthening, as far as possible, a correct and fair competition throughout the, also digital, communication environment. The moral function of remedies is out of sight here, although some references to the emotional corporation are traceable and fascinating. As reported by the Appeal judgment, a witness statement in favour of Apple acknowledged that: "at the heart of *Apple's ethos* is its ability to distinguish and dif-

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[88] See Aristotle: *Nicomachean Ethics*, translated by WD Ross (World Library Classics, New York, NY, 2005); J Derrida, *On Cosmopolitanism and Forgiveness*, Trans. by M Dooley and M Hughes, 28–29 (Routledge, 2001); P Vines, *The Power of Apology: Mercy*, *Forgiveness or Corrective Justice in the Civil Liability Arena?* 1 The Journal of Law and Social Justice 1–51.

[89] For the hypotesis of a reparative function of apology, see R Carroll, *Apologies as a Legal Remedy* 35 Sydney Law Rev. 319 (2013). For a critical approach, see L Taft, *Apology Subverted: the Commodification of Apology* 109 Yale L. J. 1135 (2000); N Brutti, *Compensation Trends in Tort Law. The Case of Public Apology*, EBLR 128–148 (2013). In far eastern countries apologies are rooted in customary law and they are also enforced by Courts. With specific reference to IP rights: XT Nguyen, *Apology as Intellectual Property Remedy. Lessons from China* 44 Connecticut Law Rev 88 (2012).

[90] *Id*., *Mineworkers Investment Company (PTY) Limited v. Mobidane*, *Joe*, Case N. 2001/20548, 2001/21162, date: 18/06/2002, Ch. 18–25. See also JR Midgley, *Retraction*, *Apology and the Right to Reply* 58 *Tydskrif vir Hedendaagse Romeins-Hollandse Reg* 288 (1995). See also A Zwart-Hink, AJ Akkermans, K van Wees, *Compelled Apologies as a Legal Remedy: Some Thoughts from a Civil Law Jurisdiction* (October 1, 2014*). University of Western Australia Law Review*, Vol. 38, No. 1, 2014.

[91] H Stoll, *Consequences of Liability: Remedies*, in *Intern. Enc. Comp. Law*, XI, 8, 9 (1983).

[92] See RA Posner, *Social Norms*, *Social Meaning*, *and Economic Analysis of Law: A Comment* 27 J. Legal Stud. 553, 557–58 (1998). Further critical suggestions in R Cooter, A Porat, *Should Courts Deduct Nonlegal Sanctions from Damages?* 30 J. Legal. Stud. 401 (2001).

[93] See in general, R Tushnet, *Fighting Freestyle: The First Amendment*, *Fairness*, *and Corporate Reputation*, 50 B.C. L. Rev. 1457 (2009).

ferentiate itself, its brand and products from those of its competitors"[94] (italics added). But, in our case the claim concerns the commercial reputation of Samsung posed at risk by prominent Apple's statements.

An increasing dissemination of data, opinions and speeches across all over the world is one of the main effects of ICT society and its twin, the global economy. Otherwise, a real improvement in public knowledge is often overwhelmed by low quality news, gossip, information overloading and restrictions imposed on the access to reliable sources.[95] As soon as quality of information depends widely on the identity of the speaker, commercial speech and advertising have reached a prominent role in Internet communication. At the same time, fundamental rights, privacy and reputation can be endangered.

The Law[96] deals with this challenge with a proverbial delay which market makers take advantage of. In such circumstances, Law's goals can be viewed also as confused and misplaced in a globalized world dominated by a fast-developing economy and technology absent any Internet global authority, whose effectiveness goes beyond local boundaries. But there is also good news that Law can take advantage of its own artificiality,[97] for instance spreading someone's liabilities across the Internet arena.

In this respect, rights can be protected by other kinds of preventive measures, like publicity orders, retractions, replies[98] whose aim is to disseminate an "incontrovertible" version of facts at the initiative of public institutions (not only Courts but sometimes administrative bodies as well).[99]

Paraphrasing the title of a Jhering's masterpiece, one of the most challenging law objectives nowaday involves a struggle for information and awareness of the public in the global marketplace.[100] In Italy, the recent Consumers' Code Reform allowed the Antitrust Authority to compel the professionals to publish corrective statements about unfair terms in consumer contracts.[101] Nevertheless, environmental protection or consumer safety can be achieved by publicity orders or corrective advertising issued by administrative agencies or Courts in class actions lawsuits.[102] Moreover, a

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[94] CA, 26.07.2012, Ch. 26.

[95] See W Cornish, *Intellectual Property. Omnipresent, Distracting, Irrelevant?* (Oxford: Clarendon Law Lectures, 2004); N Elkin Koren, NM Netanel (eds.), *The Commodification of Information* (London, New York, 2002).

[96] See the classic survey of J Stone, *The Province and Function of Law: Law As Logic Justice and Social Control: A Study in Jurisprudence* (London: Stevens and Sons Limited, 1947).

[97] See N Irti, *Il diritto nell'età della tecnica*, 19–20 (Napoli, 2007).

[98] See JG Fleming, *Retraction and Reply: Alternative Remedies for Defamation* 12 University of British Columbia Law Review 15–16 (1987).

[99] See, in general, DA Farber, S Sherry, *Beyond All Reason: The Radical Assault on Truth in American Law* 38 (Oxford U. Press 1997); see also H Whalen-Bridge, *The Lost Narrative. The Connection Between Legal Narrative and Legal Ethics* 7 J. Leg. Writ. Dir. 233 (2010); CA Mackinnon, *Law's Stories as Reality and Politics*, *in Law's Stories: Narrative and Rhetoric in the Law* 237 (Peter Brooks & Paul Gewirtz eds., Yale U. Press 1996).

[100] R von Jhering, *Der Kampf um's Recht* (Wien, 1872); *The Struggle for Law*, Translated from the fifth german edition by John J Lalor (Chicago, 1915).

[101] Art. 37-bis, Consumer Code (D.lgs. n 206 of 06.09.2005, as modified by L. n 27 of 24.03.2012).

[102] See E Gellhorn, *Adverse Publicity by Administrative Agencies*, 86 Harv. L. Rev 1380 (1973)

restorative function of public awareness can be found in apologies and reconciliation proceedings on past wrongdoings.[103]

An order to publish a judgment on the homepage of the injuncted party can obviously produce many effects. Although it could be perceived as a shaming sanction by the injuncted party and its followers, it can properly operate as a preventive measure other than a scarlet letter.[104]

In the specific context of the patent system, remedies are strongly linked to the societal goal to pursue innovation incentives.[105] Although the primary target here is the protection of private interests and their costs are borne by private litigants, public objectives can be involved in private law remedies.[106] As demonstrated by the case at issue, Courts are also engaging through enforcement of private law litigation a regulatory role that transcends the immediate interests of the litigants.[107] So – as recently underlined – the patent system and its remedies should be viewed as part of a "public law" regulatory regime designed to further the social objective of optimizing innovation incentives.[108] In the Samsung/Apple case a publicity order was issued to prevent private economic losses and harms to reputation, following the public goal to dispel commercial uncertainty. So the Samsung reputation complaint about Apple's innuendos introduced a public concern in a private litigation that required a proper remedy. As observed by an influential scholarship, the substantive reference of law "imports both a minimal justness of rules, and a dynamic responsiveness of substantive law to the needs of social and economic development."[109] The heart of the doctrine of the rule of law lies in the recognition by those in power "that their power is wielded and tolerated only subject to the restraints of shared socio-ethical convictions".[110]

10. Conclusions

To a more effective enforcement of IP rights, an harmonized legal framework has entered into force throughout Europe according to the EC Directive 48/2004. It repro-

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(recommending clear standards for issuing such publicity); S Jasanoff, *Science at the Bar: Law, Science and Technology in America* (Cambridge MA, Harvard University Press, 1995); N Cortez, *Adverse Publicity by Administrative Agengies in the Internet Era* 2011 BYU L. Rev. 1371 (2011).

[103] See for example, M Galanter, *Righting Old Wrongs*, in M Minow (ed), *Breaking the Cycles of Hatred*, 107–125 (Princeton and Oxford, 2002).

[104] For a literary example of shaming sanction, see the novel by Nathaniel Hawthorne, *The Scarlet Letter* 48 (Stanley Appelbaum ed., Dover Publications 1994) (1850).

[105] TM Sichelman, *Purging Patent Law of "Private Law" Remedies* 92 Texas Law Rev. 518 (2014).

[106] See above: G Calabresi, AD Melamed (n 71).

[107] For a classical criticism to the extension of the boundaries of Law to morality or ethical fields, see A Ravà, *I diritti sulla propria persona. Nella Scienza e nella Filosofia del Diritto*, 174 (Città di Castello, 1901).

[108] TM Sichelman, *Purging Patent Law of "Private Law" Remedies* 92 Texas Law Rev. 518 (2014).

[109] J Stone, *Social Dimensions of Law and Justice*, 620 (London: Stevens, 1966). See also, H L A Hart, *The Concept of Law* (2nd ed, 1994); N Mc Cormick, *Legal Reasoning and Legal Theory* (1978).

[110] J Stone, at 619.

duces in part the legal remedies existing in various Member states, but there are new aspects, like a call for judge ordered dissemination and "prominent advertising", which requires (and grounds) a systematic and comparative survey.

In order to protect its commercial reputation and promote a safe coexistence of different consumer choices, Samsung suggested an original interpretation of the Directive about how to enforce its right. Absent any IP infringement by Apple, Samsung sought remedies against it, as declaratory judgment, prior restraint to speak against its name and prominent publicity order, far from damages or traditional injunctions. The Court of Appeal provided original insights and technical solutions to the problems at issue, confirming and enforcing the publicity order adopted by the Court of first instance.[111]

The need for a preventive and dissuasive function of Law suggests to focus not only on victim's compensation, but also on replacing public certainty and correctness of the marketplace (e.g. public awareness). Judge ordered dissemination can achieve this objective, imposing to issue a notice through the defendant's home page.

Indeed, compensation culture and monetary remedies show some limits and lack of effectiveness.[112] For example, major doubts stem from: the intangible nature of some kind of losses and how to quantify them, business self-interested behavior based on economic convenience of wrongdoings, damages lotteries and random deterrence (punitive damages excess).

But compelling a party to disseminate informations about judicial decision implies a relevant discretionary power. The paper discussed the extension of a judicial power to bind over a litigant party in such a way, pointing out some questions and raising some concerns. A further critical point is the problems that can arise along the concrete execution of such a remedy and how to prevent them.

The homepage dissemination of the judgment greatly differs from publication on traditional media like press. In fact, the first can be performed solely by the injuncted party while the second can be normally carried out also by the claimant at expense of the other party. Indeed, Apple's order binds the injuncted party – e.g. the website owner – to adapt his homepage to the prescriptions contained in the judgment. Thus such imposition can involve a clear restraint of website owner's freedom of expression. As well as the injuncted party decides to affirm his eventual dissense in the same homepage diluting the sense of the notice (or the same structure of it), this could amount to a violation of the order.

Apple and Samsung have developed products of different aesthetic fashions linked to also divergent technical standards (like interoperability). In doing so, their peculiar lifestyle and creativity gave rise to opposing customers communities (e.g. androidians

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[111] About the cultural background of Judges as an influential factor in framing and deciding the case, J Esser., *Vorverstandnis und Methodenwahl in der Rechtsfindung: Rationalitatsgrundlagen richterlicher Entscheidungspraxis* (Kronberg/Ts.: Scriptor Verlag, 1975); G Zaccaria, *Ermeneutica e giurisprudenza. Saggio sulla metodologia di Josef Esser* (Milano, 1984).

[112] About the "litigation explosion", see L Friedmann, *Claims*, *Disputes*, *Conflicts and the Modern Welfare State*, in M Cappelletti, *Access to Justice and the Welfare State*, 265 (European University Institute, Firenze, 1981).

v. Apple community).[113] The harshness of litigation carried out by Apple against Samsung, independently from its substantial merits, raises also social and economic concerns like consumers' awareness and innovation incentives. But the findings, coming out of a comparative view on corrective advertising, suggest further questions like: the use of public goals and moral incentives to prevent further violations or breaches of duties, the eventually shaming nature of judicial ordered disseminations and the potential harm to identity, image and freedom of speech.

This case makes clear that such homepage restrictions can directly affect freedom of expression and communication as a price to incentivate the coexistence between two market competitors and prevent litigation abuses.[114] In this respect, injunctive reliefs are here intended to achieve a complex regulatory goal that is, a balance between defendant's freedom of expression and public awareness. In light of its challenging objective, the case represents a leading precedent, impressive for its innovative attitude.

[113] For further details see http://androidforums.com, and http://en.m.wikipedia.org/wiki/Apple_community that reads: "In recent years, a more specific subculture within the Apple community has developed, where some websites will focus almost exclusively on rumors about new Apple products and services."

[114] As critically observed by J Stone on declaratory judgment theory: "counsel often still tend to assume that even in cases of first impression they will fare better before appellate courts by citing inadequately reasoned, tenuous dicta, remote or even merely verbal analogies and abstract syllogistic deductions, than by a straightforward argument as to what the rule ought to be, based on the social facts to be regulated and the policies to be applied in." J Stone, *The Province and Function of Law: Law as Logic Justice and Social Control: A Study in Jurisprudence*, 166–168 (London: Stevens and Sons Limited, 1947). There is no reason to think that anything is changed.