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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91199897
Party	Plaintiff Samsung Electronics, Ltd.
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Date	02/27/2017
Attachments	Opposers Status Update - re 2-27-17 Board Order.pdf(42721 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No.: 85041463



Filed: May 18, 2010
Date Published: April 19, 2011

SAMSUNG ELECTRONICS CO. LTD.,

Opposer,

v.

APPLE INC.

Applicant.

Opposition No. 91199897

OPPOSER'S STATUS UPDATE AS TO THE CIVIL ACTION

Opposer Samsung Electronics Co. Ltd. ("Samsung") respectfully submits this status update as to the civil action that occasioned the suspension of this proceeding, as directed by the Board's Order dated February 23, 2017.

Proceedings in this matter were stayed pending the resolution of *Apple, Inc. v. Samsung Electronics Co., Ltd. et al.*, Case No. 11-cv-1846, in the United States District Court for the Northern District of California (the "Civil Action"). On March 6, 2014, the District Court in the Civil Action issued a final judgment, from which both parties appealed. These appeals were heard by the United States Court of Appeals for the Federal Circuit under docket numbers 14-1335 and 14-1368. On May 18, 2015, after briefing and oral argument, the Federal Circuit

issued its decision. *Apple Inc. v. Samsung Electronics Co., Ltd.*, 786 F.3d 983 (2015). The Federal Circuit held, among other things, that Apple's asserted registered and unregistered iPhone trade dresses, which included square icons with rounded edges, were functional and therefore unprotectable. *Id.* at 990-96. This ruling of unprotectability on functionality grounds extended specifically to Apple's icons (*id.* at 993-96) — the same element at issue in this Opposition proceeding.

Although neither Apple nor Samsung has sought further review of the Federal Circuit's relevant trade dress rulings, Samsung filed a petition for a writ of certiorari in the U.S. Supreme Court seeking review of the Federal Circuit's judgment regarding design patent infringement and damages. The U.S. Supreme Court granted Samsung's petition with respect to design patent damages. *See Samsung Elecs. Co. v. Apple Inc.*, 136 S. Ct. 1453 (Mar. 21, 2016). The district court subsequently stayed all proceedings in the Civil Action pending resolution of matters by the Supreme Court. *See Civil Action*, ECF No. 3472 (March 22, 2016 Order).

On December 6, 2016, the Supreme Court issued its opinion, reversing the judgment of the Federal Circuit and remanding for further proceedings. *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016). On February 7, 2017, the Federal Circuit in turn remanded the case to the District Court for further proceedings. *See Civil Action*, ECF No. 3483 (Opinion and Judgment of Federal Circuit). At present, the Civil Action is pending in the District Court.

Samsung therefore respectfully suggests that the instant Opposition proceedings remain suspended until all matters associated with the Civil Action are finally and fully concluded.

Dated: February 27, 2017 Los Angeles, California

Quinn Emanuel Urquhart & Sullivan, LLP

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Certificate of Service

I hereby certify that a true and correct copy of the foregoing Opposer's Status Update As To The Civil Action has been duly served by mailing such a copy first class, postage paid to Glenn A. Gunderson, Dechert LLP, Cira Centre, 2929 Arch Street, Philadelphia, PA 19104-2808 on February 27, 2017.