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11 Attorneys for Plaintiff and  
 12 Counterclaim-Defendant APPLE INC.

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

17 APPLE INC., a California corporation,  
 18 Plaintiff,  
 19 v.  
 20 SAMSUNG ELECTRONICS CO., LTD., a  
 21 Korean business entity; SAMSUNG  
 22 ELECTRONICS AMERICA, INC., a New York  
 23 corporation; SAMSUNG  
 24 TELECOMMUNICATIONS AMERICA, LLC, a  
 Delaware limited liability company,  
 Defendants.

Case No. 11-cv-01846-LHK (PSG)  
**APPLE'S REPLY REGARDING  
 DESIGN PATENT CLAIM  
 CONSTRUCTION**

1 Apple urges the Court to follow the Federal Circuit’s directive that figures are the best  
2 description of a patented design. Apple’s proposed guidance on the meaning of the patents is  
3 consistent with this guidance and legally correct; Samsung’s proposals are not. Samsung also  
4 fails to support its claims of inefficiency if functionality findings are not made before trial. But  
5 even if the Court were inclined to rule now, it is Apple, not Samsung, that has put forth probative  
6 evidence showing that no element of the patented designs is functional.

7 **I. SAMSUNG OFFERS NO GOOD REASON WHY ITS LENGTHY AND**  
8 **INACCURATE VERBAL DESCRIPTIONS SHOULD BE ADOPTED**

9 Samsung fails to address the key point in Apple’s opening brief—the Federal Circuit’s  
10 admonition that verbal claim constructions are inappropriate in design patent cases. *See Egyptian*  
11 *Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (“Given the recognized  
12 difficulties entailed in trying to describe a design in words, *the preferable course ordinarily will*  
13 *be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed*  
14 *verbal description of the claimed design.*”) (emphasis added). Samsung’s opposition rests on the  
15 false premise that claim construction is required in *every* patent case. For reasons stated in  
16 Apple’s opening brief, there is no justification for a verbal claim construction of Apple’s design  
17 patents, and certainly not the detailed claim constructions proffered by Samsung. Those claim  
18 constructions will not lead to a more efficient trial, as Samsung suggests. (Samsung Opp. at 2.)  
19 In fact, they will likely confuse the jury, for the reasons explained in Apple’s Opposition to  
20 Samsung’s Claim Construction Brief. (Dkt. No. 1136.)

21 Samsung’s concern that the jury would be left with the erroneous impression that Apple’s  
22 patents protect generalized design concepts is unfounded because the jury will be instructed that  
23 the design is what is shown in the patent figures, not “rectangles with rounded corners,” as  
24 Samsung suggests. (Samsung Opp. at 3.) Samsung’s reliance on the Federal Circuit opinion in  
25 this case is misplaced; the Federal Circuit held that it is error to look to “the general concept of a  
26 tablet” design rather than “the distinctive ‘visual appearances’ of the reference and the claimed  
27 design” for invalidity purposes. *Apple Inc. v. Samsung Elecs. Co.*, No. 11-cv-1846, 2012 U.S.  
28 App. LEXIS 9720, \*37-38 (Fed. Cir. May 14, 2012). Apple is advocating precisely what the

1 Federal Circuit approved—the jury should look to the visual appearance of the claimed designs,  
2 which will avoid the error of considering “general concepts.”

3 Samsung’s citation to *Egyptian Goddess* as sanctioning a narrow construction in light of  
4 prior art is unavailing. Samsung quotes only from *Egyptian Goddess*’s discussion of the “point of  
5 novelty” test (which limited the infringement analysis to design elements that were “novel” in  
6 light of the prior art), as applied in *Litton Systems*. (Samsung Opp. at 4.) That “point of novelty  
7 test” was explicitly (and famously) rejected by the *en banc* panel in *Egyptian Goddess*. 543 F.3d  
8 at 678 (“[W]e hold that the “point of novelty” test should no longer be used in the analysis of a  
9 claim of design patent infringement.”). Neither *Egyptian Goddess* nor subsequent Federal Circuit  
10 decisions condone narrow verbal constructions of design patents in light of prior art. (Dkt. No.  
11 1136 at 2-3.)

12 Samsung’s use of prosecution history is also incorrect because, as discussed in Apple’s  
13 opposition, Samsung uses a mischaracterized statement from the unrelated *D’677* patent to argue  
14 for a limitation to the *D’889* patent. (Dkt. No. 1136 at 4.) Samsung offers no legal support for its  
15 approach, which is contrary to law. *See Pfizer Inc. v. Ranbaxy Labs.*, 457 F.3d 1284, 1290 (Fed.  
16 Cir. 2006) (“statements made during prosecution of the later, unrelated ’995 patent cannot be  
17 used to interpret claims of the ’893 patent.”) And Samsung’s attempt to use subsequent Apple  
18 patents to narrow the construction of the patents at issue has already—and properly—been  
19 rejected by the Court. (Dkt. No. 1157 at 5.)

20 Finally, Samsung cannot claim to be disadvantaged without an early verbal claim  
21 construction (Samsung Opp. at 1-2) because its experts did not rely on one. None of Samsung’s  
22 four design patent experts relied on anything other than the patent drawings to determine the  
23 scope of the claims, whether for obviousness, anticipation, or non-infringement. (Dkt. Nos. 940-  
24 3, 940-7, 940-8, 971, and 940-9.) In fact, the two noninfringement experts, Robert Anders and  
25 Sam Lucente, did not factor out a single “functional” element in their non-infringement opinions.  
26 (Dkt. No. 1089-3 at 5; Dkt. No. 941.)

1 **II. THE FUNCTIONALITY FINDING IS BETTER MADE AT THE CONCLUSION**  
2 **OF EVIDENCE; BUT ON THIS RECORD, APPLE IS ENTITLED TO A FINDING**  
3 **THAT NO FUNCTIONAL ELEMENTS EXIST IN ITS DESIGN PATENTS**

4 Samsung also fails to address the good reasons courts have found for reserving the  
5 functionality finding: the need for a full factual record in light of disputed issues of fact and the  
6 danger of undue emphasis on identified elements while the jury hears evidence. (Dkt. No. 1089-3  
7 at 3-4.) Instead, it cites to the functionality arguments that it offered in its own opening brief,  
8 which are incorrect for the reasons explained in Apple's opposition (Dkt. No. 1136), and  
9 continues to ignore altogether the significance of Apple's proffered alternative designs. Ignoring  
10 this evidence will not make it go away; its importance will become even more glaring after  
11 Samsung's experts testify at trial.

12 Apple offered strong legal support for its position that functionality determinations should  
13 be made based upon a full trial record. Samsung's efforts to distinguish those cases are  
14 unavailing. Contrary to Samsung's assertion, the court in *ADC Telecommunication* did consider  
15 claim construction, and deferred findings on functionality for trial in light of disputed facts. *ADC*  
16 *Telecomms., Inc. v. Panduit Corp.*, 200 F. Supp. 2d 1022, 1033 (D. Minn. 2002). In *Dexas Int'l,*  
17 *Ltd. v. Tung Yung Int'l, Inc.*, No. 6:07-cv-334, 2008 U.S. Dist. LEXIS 48324, at \*36 (E.D. Tex.  
18 Jun. 24, 2008), the court also decided to wait until trial to decide functionality, in light of the  
19 disputed factual issues. The court in *Soffpool, LLC v. Intex Rec. Corp.*, No. 2:07-CV-097, 2007  
20 U.S. Dist. LEXIS 93057 (E.D. Tex. Dec. 19, 2007), made the same decision, deferring  
21 consideration of functionality until trial. Other cases cited in Apple's opening brief reached the  
22 same conclusion. See *Colgate-Palmolive Co. v. Ranir, L.L.C.*, No. 06-417 GMS, 2007 U.S. Dist.  
23 LEXIS 55258, at \*7-8 (D. Del. July 31, 2007) ("the court may further limit the current  
24 construction at trial by factual determinations regarding functionality and ornamentality of the  
25 included features"); *180s, Inc. v. Gordini U.S.A., Inc.*, 699 F. Supp. 2d 714 (D. Md. 2010)  
26 (finding discretion to reserve functionality finding, if ultimately rendered before comparing claim  
27 and accused article).

28 If the Court is nonetheless inclined to make its determination now, it is Apple that has  
advanced ample evidence in support of its proposed finding that no elements are functional. (Dkt.

1 No. 1089-3 at 5-9; Dkt. No. 1136 at 9-14.) Samsung, which is the proponent for findings of  
2 functional elements, fails to rebut *any* of Apple’s proffered evidence of non-functionality.  
3 (Samsung Opp. at 7-8.) In particular, while Samsung mentions the factors for evaluating  
4 alternative designs in *PHG Techs., Inc. v. St. John Cos., Inc.*, 469 F.3d 1361, 1366 (Fed. Cir.  
5 2006), it never explains why Apple’s identified alternatives are insufficient. Rather, Samsung  
6 appears to retreat from its earlier claim that many elements are functional, including that any  
7 element of the D’305 patent is functional. Samsung’s rehashing of its prior arguments regarding  
8 the iPhone and iPad design patents fail for the reasons set forth in Apple’s opening and opposition  
9 briefs. (Dkt. No. 1089-3 at 5-8; Dkt. No. 1136 at 11-13.) The myriad alternative designs in the  
10 art further confirm that no elements of Apple’s “electronic device” designs are purely functional.  
11 (Dkt. No. 1140-31.) *Cf. Richardson v. Stanley Works, Inc.*, 610 F. Supp. 2d 1046, 1050 (D. Ariz.  
12 2009).

### 13 **III. APPLE’S GUIDANCE ON ITS DESIGN PATENT DRAWINGS IS CORRECT**

14 Use of “light lines”: Samsung misleadingly refers to “the PTO’s requirement” that  
15 elements visible behind transparent surfaces be shown in “light lines.” There is no such  
16 “requirement.” Samsung’s only cite is to an informal PTO guide—which does not establish a  
17 “requirement.” *HR US LLC v. Mizco Int’l, Inc.*, No. CV-07-2394 (DGT) (JO), 2009 U.S. Dist.  
18 LEXIS 27056, \*11-12 (E.D.N.Y. Mar. 31, 2009) (“This conclusion is not altered by defendants’  
19 citation to the [Guide, which] appears to simply be an informal resource . . . [and nothing suggests  
20 it] is entitled to the force of law or even to any level of deference.”). Therefore, nothing prevents  
21 the Court from reading the dotted line rectangular element in the D’889 patent as claimed subject  
22 matter. For the same reason, the Court should reject Samsung’s assertion that the rectangular  
23 element in the front face of the D’677 patent cannot be read as something visible behind a  
24 transparent surface (because it is not rendered in light lines).

25 Back of D’889 design: Samsung’s assertion that the back of the D’889 patent should be  
26 read as a transparent, translucent, or highly polished surface is contrary to the figures and should  
27 be rejected. The lines appearing in Figure 2 show only the flatness of the back surface in a  
28 perspective view. (Bartlett Decl. Ex. 1 at 185:7-186:4; Ex. 2 at 50:23-51:12.) The fact that

1 similar lines do not appear in Figure 4 (showing the plan view of the back) or in any of the profile  
2 views in Figures 5-8 of the D'889 patent (where a portion of the back of the device is visible)  
3 confirms that an ordinary designer would not understand the lines in Figure 2 to claim a  
4 transparent, translucent, or mirror-like surface.

5 Front of D'087 design: Samsung is wrong that the absence of oblique lines in the D'087  
6 design means the patent claims an opaque surface. Because the MPEP requires the use of oblique  
7 lines to claim a transparent, translucent, or highly polished surface (MPEP § 1503.02), the  
8 absence of oblique lines means a design is not claiming such a surface. It does not follow,  
9 however, that if a transparent or reflective surface is *not* claimed, an opaque surface necessarily is  
10 claimed. Instead, the lack of lines on the surface means that a flat surface (i.e., the configuration  
11 or shape of an article) is being claimed regardless of its color and regardless of whether it is  
12 transparent or opaque. The use of color, transparency, or reflectivity lines is a narrowing  
13 limitation. If Apple wanted to claim a flat black surface, it could have done so with the addition  
14 of lines claiming the color black. MPEP § 1503.02. If Apple wanted to claim a flat transparent  
15 surface, it could have done so with the addition of lines claiming transparency. *Id.* It did not. It  
16 elected to claim only flatness as a distinguishing feature of the front surface of the D'087 patent.  
17 Samsung's attempt to limit that surface to an opaque surface should be rejected.

## 18 CONCLUSION

19 The Court should not make detailed verbal claim constructions and should instruct the  
20 jury initially only regarding limited points of technical guidance. The Court should make  
21 functionality determinations at the conclusion of evidence based on a full record and instruct the  
22 jury accordingly at that time.

23 Dated: July 3, 2012

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24  
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27 Attorneys for Plaintiff  
28 APPLE INC.