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 TELECOMMUNICATIONS AMERICA, LLC  
 15

16 UNITED STATES DISTRICT COURT

17 NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

18 APPLE INC., a California corporation,

19 Plaintiff,

20 vs.

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

24 Defendants.  
 25

CASE NO. 11-cv-01846-LHK

**SAMSUNG'S OPPOSITION TO APPLE'S  
 OPENING CLAIM CONSTRUCTION  
 BRIEF**

Date: July 18, 2012  
 Time: 2:00 pm  
 Place: Courtroom 8, 4th Floor  
 Judge: Hon. Lucy H. Koh

**SUBMITTED UNDER SEAL**

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1 **INTRODUCTION**

2 Apple argues that the Court should refrain from construing the patents until after trial,  
3 except to the limited extent required to provide the jury with technical guidance regarding design  
4 patent drawing conventions. But patent construction is an issue of law, and these patents are far  
5 more limited than Apple hopes to insinuate to a jury. In addition, a clear construction of the  
6 patents is required to streamline the evidence, avoid irrelevant and prejudicial arguments, and  
7 prevent jury confusion. Delaying claim construction until after trial serves no purpose other than  
8 to invite legal and factual error.

9 Apple also seeks a ruling that no element of its designs is functional. Apple’s argument  
10 contradicts not only common sense and the law of claim construction (as reflected in the Court’s  
11 previous rulings that elements of Apple’s designs are dictated by function). It also contradicts  
12 the admissions of Apple’s own expert witness, who has conceded that elements such as a display  
13 screen located beneath a transparent front cover are “essential” to the use of a smartphone device.

14 **ARGUMENT**

15 **I. THE COURT SHOULD CONSTRUE THE DESIGN PATENTS BEFORE TRIAL**

16 **A. The Court Should Construe the Design Patents Prior to Trial**

17 As a legal matter, there is no reason to further delay construing the asserted design patents.  
18 Claim construction is a matter of law for the Court. *Egyptian Goddess Inc. v. Swisa, Inc.*, 543  
19 F.3d 665, 679 (Fed. Cir. 2008); *see also Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979  
20 (Fed. Cir. 1995) (en banc); *Sun-Mate Corp. v. Koolatron Corp.*, 2011 WL 3322597 at \*3 (C.D.  
21 Cal. Aug. 1, 2011) (“claim construction is a question of law for the court”); *180s Inc. v. Gordini*  
22 *Inc.*, 699 F. Supp. 2d 714, 717 n. 2 (D. Md. 2010) (same); *Moose Mountain Toymakers Inc. v.*  
23 *Majik, Ltd.*, 2011 WL 3626067, at \*2 (D.N.J. Aug 12, 2011) (“First, the design patent must be  
24 properly construed, as a matter of law.”).

25 This case in particular warrants construction prior to trial. The Court has ordered the  
26 parties to streamline their disputes and limited both the time each party has to put on its evidence  
27 and the number of exhibits it may introduce. Dedicating valuable trial time and exhibits to claim  
28 construction creates a risk that the jury will be asked to decide the case based on a

1 misunderstanding of the patents and an incomplete record and will cause undue prejudice to  
2 Samsung. That is because Samsung’s non-infringement positions must necessarily be tied to the  
3 scope of the asserted design patents. Deferring claim construction until after trial would  
4 therefore force Samsung not only to use its scarce trial time and limited exhibits to support its  
5 claim construction, but also to prove its invalidity and non-infringement defenses as to any  
6 number of potential constructions that could ultimately be adopted. Forcing Samsung to do so  
7 would not only mean that the jury will be presented with evidence and argument that will likely be  
8 irrelevant ultimately, but, given the constraints on the parties’ trial presentations, would also  
9 deprive Samsung of its ability to present a full and fair defense to Apple’s claims.

10 Efficiency also strongly militates in favor of construing the patents prior to trial. As the  
11 Court has noted, the jury in this case will be asked to absorb a substantial amount of information  
12 and make infringement determinations about a number of accused products in a relatively short  
13 period of time. *See, e.g.*, June 26, 2012 Declaration of Adam Cashman (“June 26 Cashman  
14 Decl.”), Ex. 1 (May 2, 2012 Tr. at 3:22-4:3, 5:3-12). Absent further narrowing, Apple’s current  
15 design-related case alone involves four different design patents, alleged dilution of an iPhone trade  
16 dress and alleged dilution and infringement of an iPad trade dress against numerous products.  
17 The parties have designated a combined ten expert witnesses to testify regarding such issues as  
18 validity, infringement, indefiniteness and scope of the design patents at issue. If Apple is sincere  
19 in its representation that it “will do whatever [it] need[s]” to ensure that its case can properly be  
20 tried within the parameters set by the Court, *see id.* Ex. 1 (May 2, 2012 Tr. at 8:25), then Apple  
21 should be in favor of obtaining a definitive construction of the design patents prior to trial.

22 Rather than using the claim construction process as a means to comply with the Court’s  
23 directive to further streamline the case, however, Apple paradoxically takes the opposite tack. It  
24 urges that claim construction should not be done until after the close of evidence, if at all.  
25 Although Apple apparently plans to offer all manner of evidence to support its arguments  
26 regarding the purportedly sweeping scope of its design rights, such evidence and argument would  
27 be largely unnecessary once the Court establishes the proper scope of the design patents in suit.  
28 *See* Dkt. 1090-1.

1 Further, as discussed below, the design patents should be construed prior to trial so that the  
2 parties may focus their presentations on the elements of Apple’s design rights that are actually  
3 protected under design patent law and that may properly be the subject of an infringement claim.  
4 Allowing Apple unbridled reign on the scope and construction of the asserted design patents will  
5 only serve to confuse the jury and prejudice Samsung.

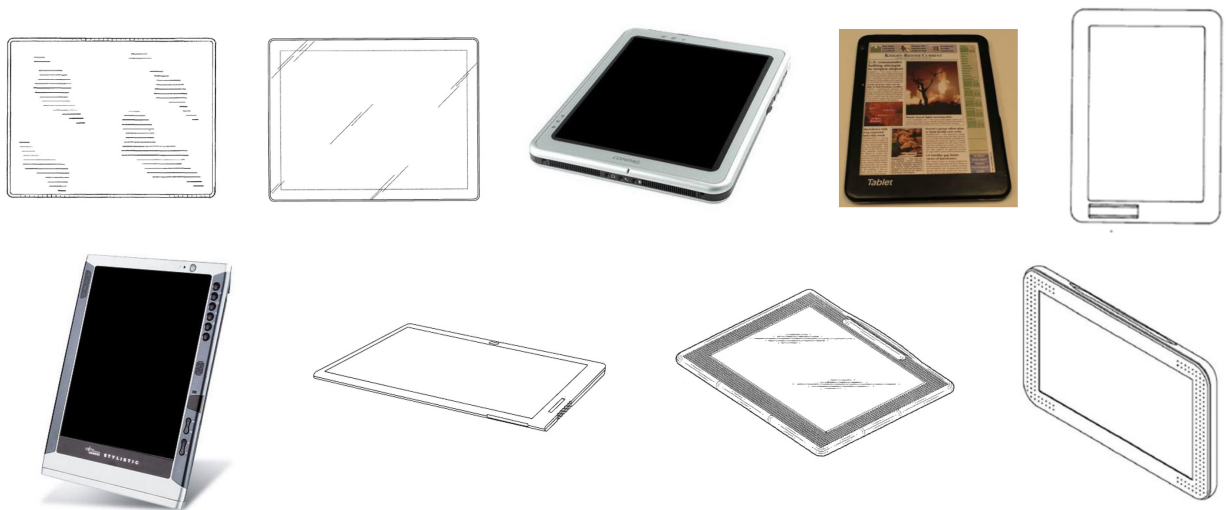
6 **B. Apple’s Design Patents Warrant And Require Construction**

7 After unsuccessfully opposing Samsung's request to file a claim construction brief, and  
8 having failed in its earlier attempts to suppress discussion of claim construction entirely, Apple  
9 now has filed an opening claim construction brief that merely seeks the same result by advocating  
10 a “construction” that is nothing more than the images of the patent figures and generic descriptions  
11 of patent drawing conventions. Dkt. 1089-3, at 1-2; *see also* Dkt. 893, at 2; June 26 Cashman  
12 Decl. Ex. 1 (May 2, 2012 Tr. at 21:16-24). That is no construction at all, and would leave the  
13 jury with the erroneous impression that Apple’s patents protect such “generalized design  
14 concepts” as rectangles with rounded corners or, as discussed further below, such concededly  
15 functional aspects as a display screen covered by a transparent material. *See OddzOn Prods.,*  
16 *Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (“We agree with the district court’s  
17 claim construction, which properly limits the scope of the patent to its overall ornamental visual  
18 impression, rather than to the broader general design concept of a rocket-like tossing ball.”); Dkt.  
19 449, at 15. The Federal Circuit already has rejected such a broad construction in the invalidity  
20 context, finding that it was error to “view[] the various designs from too high a level of  
21 abstraction.” *Apple, Inc. v. Samsung Electronics Co., Ltd.*, No. 2012-1105, 2012 WL 1662048,  
22 at \*13 (Fed. Cir. May 14, 2012) (quoting *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100,  
23 104 (Fed. Cir. 1996)). Because the infringement analysis of design patents is the same as the  
24 invalidity analysis,<sup>1</sup> Apple’s proposed approach invites the same error. The jury therefore

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27 <sup>1</sup> *See International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239 (Fed.  
28 Cir. 2009) (“That which infringes, if later, would anticipate, if earlier.”) (quoting *Peters v. Active*  
*Mfg. Co.*, 129 U.S. 530, 537 (1889)); *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d  
(footnote continued)

1 should be properly instructed regarding the claimed designs to avoid erroneously construing the  
2 patents “from too high a level of abstraction.” *Id.*

3 Apple’s mistaken suggestion that the design patents protect all visual elements shown in  
4 the claimed designs fails to account for the fact that when “a field is crowded with many  
5 references” relating to the design of the same type of article, a design patent’s “scope of  
6 protection” is limited to a more “narrow range.” *Egyptian Goddess Inc. v. Swisa, Inc.*, 543 F.3d  
7 665, 676 (Fed. Cir. 2008) (quoting *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444  
8 (Fed. Cir. 1984)). As set forth in Samsung’s opening claim construction brief, and as depicted in  
9 the graphic below, the “field” of prior art at issue for mobile electronic devices is extremely  
10 “crowded,” which necessitates a claim construction that is sufficiently narrow to avoid reading on  
11 the prior art. See Dkt. 1090-01, at 10, 13; see also *In re Mann*, 861 F.2d 1581 (Fed. Cir. 1988)  
12 (“Design patents have almost no scope”); *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577  
13 (Fed. Cir. 1995) (quoting *In re Mann*).



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Top: D’037; D’889; Compaq TC1000; Fidler Knight Rider; JPD0887388  
Bottom: Fujitsu Stylistic ST4120; JPD0921403; D’802; JPD1142127

See June 26 Cashman Decl. Exs. 2-4; Dkt. 1091, Exs. 1, 2, 7-9, 12.

1343, 1351 (Fed. Cir. 2001) (“A patent may not, like a “nose of wax,” be twisted one way to avoid anticipation and another to find infringement.”) (internal citation omitted).



1           Additionally, Apple’s erroneous suggestion that the design patents protect all visual  
2 elements shown in the claimed designs is contrary to the numerous representations it has made to  
3 the USPTO in the course of obtaining dozens of design patents for its iPhone and iPad products.  
4 As the Federal Circuit has made clear, one of the “useful[.]” purposes of design patent claim  
5 construction is to “guide the finder of fact by addressing . . . issues that bear on the scope of the  
6 claim[,] . . . includ[ing] . . . assessing and describing the effect of any representations that may  
7 have been made in the course of the prosecution history.” *Egyptian Goddess Inc.*, 543 F.3d at  
8 680. Apple has made several such representations that bear on the scope of its asserted design  
9 patents. For example, in seeking to avoid an obviousness rejection under 35 U.S.C. § 103(a),  
10 Apple swore that the D’677 was patentably distinct from the prior art cited by the examiner  
11 because it claimed “a substantially continuous transparent surface on an electronic device and the  
12 substantially smooth or flush transition between the display screen and the rest of the front face of  
13 the device[.]” Dkt. 1091, Ex. 21 at APLPROS0000011936. Yet, Apple has elsewhere argued  
14 that the D’889 design, which was also cited as prior art during prosecution of D’677, already  
15 disclosed that very same characteristic of a continuous flat front surface that runs from edge to  
16 edge. *See, e.g.*, Dkt. 997-02, at 10-11 (distinguishing the D’037 prior art reference because it  
17 purportedly “does not disclose an edge-to-edge transparent front surface” or a “uniform mask”  
18 underneath the front surface, and distinguishing the “Brain box” reference as purportedly lacking a  
19 flat front surface.). By its own admissions, Apple’s patents must be construed in a limited  
20 fashion to be patentable as “new” and “original” ornamental designs, without reading on the prior  
21 art. *See* 35 U.S.C. § 171. Here, that requires a construction of D’677 that does not include a  
22 continuous, flat, transparent front surface. Construction of the design patents is therefore  
23 necessary to determine the effect of Apple’s prior representations on the scope of its designs.

24           **C.       The Functional Elements Of Apple's Patents Need To Be Factored Out**

25           Apple’s argument that the Court should defer its determination of whether the patents  
26 contain any functional elements is unsupported. Dkt. 1089-3, at 3-4. Although courts retain  
27 significant discretion in the way they conduct design patent claim construction, the Federal Circuit  
28 has made clear that one of the “useful” purposes of claim construction is to “distinguish[.] between

1 those features of the claimed design that are ornamental and those that are purely functional.”  
2 *Egyptian Goddess*, 543 F.3d at 680. “Where a design contains both functional and non-  
3 functional elements, the scope of the claim *must* be construed in order to identify the non-  
4 functional aspects of the design shown in the patent.” *OddzOn*, 122 F.3d at 1405 (emphasis  
5 added); *see also Richardson v. Stanley Works, Inc.*, 597 F. 3d 1288, 1294 (Fed. Cir. 2010). That  
6 is particularly warranted where, as here, the Court has specifically granted Samsung’s request to  
7 construe the design patents and trial is set to begin in approximately one month. *See OddzOn*,  
8 122 F.3d at 1405 (affirming, on *de novo* review, District Court’s construction of patent to factor  
9 out functional elements).

10 The factual circumstances also weigh in favor of factoring out certain functional elements  
11 of the design patents now as part of claim construction, as opposed to waiting until after trial.  
12 Apple concedes that this functionality determination is a question for the Court, not the jury, yet  
13 urges the Court to defer it until it has a “full factual record.” Dkt. 1089-3, at 4. But discovery is  
14 complete and the factual record is indisputably “full.” And, as Apple is aware, the Court  
15 previously identified elements of the D’889, D’087 and D’677 patents that it found were “dictated  
16 by” function and that, accordingly, could not be considered part of the claimed ornamental design  
17 for infringement comparison purposes. *See* Dkt. 449, at 15, 39-40. There is no reason to delay  
18 the determination of which elements of the claimed designs are functional.

19 The authorities Apple relies on do not compel the result Apple seeks here. To the  
20 contrary, as the court noted in *Depaoli v. Daisy Mfg. Co., Inc.* (Dkt. 1089-03, at 4), courts have  
21 “considerable discretion” in determining how to address and factor out functional elements in  
22 connection with construing the scope of design patents. No. 07-cv-11778, 2009 WL 2145721 at  
23 \*3 (D. Mass. July 14, 2009) (citing *Egyptian Goddess*, 543 F.3d at 680); *see also Mag Instrument,*  
24 *Inc. v. JS Products, Inc.*, 595 F. Supp. 2d 1102, 1108 (C.D. Cal. 2008) (deferring functionality  
25 determination from motion to strike to claim construction hearing). Further, in *ADC*  
26 *Telecommunications, Inc. v. Panduit Corp.*, 200 F. Supp. 2d 1022 (D. Minn. 2002), the Court  
27 denied summary judgment as to the defendant’s invalidity defense based on overall functionality  
28 of the designs, and did not consider whether any aspect of the claimed design must be “factored

1 out” as part of claim construction. 200 F. Supp at 1035 (“[Defendant] has not met its burden of  
2 proving that ADC’s design patents are invalid because they are primarily functional.”); *see also*  
3 *Egyptian Goddess*, 543 F.3d at 680.<sup>2</sup> The Court should construe, as part of the claim  
4 construction process, Apple’s design patents to factor out functional aspects of Apple’s designs  
5 because doing so will promote efficiency, streamline the parties’ presentations at trial, and reduce  
6 the probability of jury confusion.

7 As set forth in Samsung’s opening brief, the Court’s functionality determination should not  
8 be a difficult one. Dkt. 1090-1 at 5, 11-12, 14-15. Apple’s expert witness has conceded, as he  
9 must, that elements of the claimed designs are “critically important” to the use of the devices,  
10 including (i) having a display screen that is (ii) covered by a transparent material; and for the  
11 phone patents, (iii) locating a speaker opening on the upper portion of the device. *Id.* The  
12 Court previously held that these elements and others were “dictated by” the use or purpose of the  
13 article claimed. Dkt. 449, at 15, 39-40. The Court should do so again here.

14 Apple nevertheless argues, implausibly, that *none* of the features of its design patents are  
15 functional, including the elements its expert admitted are “essential” to the use and purpose of the  
16 devices. Dkt. 1089-3, at 5. Because there are examples of other devices that have “a variety of  
17 screen sizes,” speaker locations, and front border size and proportions, Apple claims that these  
18 elements of its designs reflect ornamental design choices that were determined by “aesthetic  
19 considerations,” not practical ones. *Id.* at 5. But the mere existence of alternatives does not  
20 render a design ornamental and non-functional. *See PHG Tech., Inc. v. St. John Co., Inc.*, 469  
21 F.3d 1361, 1366 (Fed Cir. 2006) (listing several factors courts consider in determining whether a  
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23 <sup>2</sup> The two additional authorities cited by Apple are inapposite. In *Dexas Int., Ltd. v. Tung*  
24 *Yung Int., Inc.*, the court deferred claim construction until trial because the defendant’s  
25 representation that functionality was undisputed was not accurate, leaving the court without an  
26 adequate record on which to determine which elements of the claimed designs were functional.  
27 2008 WL 4831348 at \*12 (E.D. Tex. June 24, 2008). In *Soffpool, LLC v. Intex Recreation Corp.*,  
28 although the court noted in *dicta* that other courts have deferred the functionality analysis until  
trial, *Soffpool* did not appear to involve any argument that any aspect of the claimed designs were  
functional, and the court proceeded to construe the design patents in that case at the claim  
construction stage. 2007 WL 4522331 at \*4 (E.D. Tex. Dec. 19, 2007).

1 design is functional, including whether (1) the protected design represents the best design; (2)  
2 alternative designs would adversely affect the utility of the specified article; (3) there are any  
3 concomitant utility patents; (4) advertising touts particular features of the design as having specific  
4 utility; (5) there are any elements in the design or an overall appearance clearly not dictated by  
5 function.); *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed Cir. 1997)  
6 (“The presence of alternative designs may or may not assist in determining whether the challenged  
7 design can overcome a functionality challenge.”). The existence of alternative designs that do  
8 not affect the utility of the article is therefore merely one of several factors that may be relevant to  
9 determining the functionality of a design. *See id.*

10 The Court therefore should hold that at least the elements previously found to be functional  
11 and those that Apple’s expert has admitted were functional form no part of the claimed ornamental  
12 designs for purposes of an infringement comparison. Dkt. 1090-01, at 5, 11-12, 14-15.

13 **II. ANY INSTRUCTION REGARDING DESIGN PATENT DRAFTING**  
14 **CONVENTIONS SHOULD APPLY CONSISTENTLY TO APPLE’S PATENTS**

15 Apple argues that the Court should instruct the jury, consistent with the patents and the  
16 MPEP, that the broken lines in the D’677, D’087, and D’305 patents form no part of the claimed  
17 designs, even though D’677 makes no broken line disclaimer whatsoever. Dkt. 1089-3, at 2;  
18 MPEP § 1503.02. Such definitive and out of context instructions would only serve to further  
19 confuse the jury because the patents at issue and Apple’s proposed constructions of them are  
20 inconsistent and self-contradictory.

21 With respect to the D’889 design, Apple argues that the Court should instruct the jury that  
22 the broken lines of the human figure in figure 9 form no part of the claimed design, but that the  
23 same broken lines forming a rectangular shape on the front of the device in Figures 1, 3 and 9 *are*  
24 part of the claimed design. Dkt. 1089-3, at 3. To justify its inconsistent construction, Apple  
25 asserts that the broken lines were never disclaimed, except with respect to the human figure visible  
26 in Figure 9. *Id.* Apple’s argument ignores the plain language of the disclaimer: “Fig. 9 is an  
27 exemplary diagram of the use of the electronic device thereof the broken lines being shown for  
28 illustrative purposes only and form no part of the claimed design.” *See* Dkt. 1091, Ex. 1 at 2.

1 Thus, the D'889 patent is ambiguous on its face by claiming the interior rectangle in Figures 1 and  
2 3 while expressly disclaiming it in Figure 9.

3 Moreover, Apple's argument that the broken line rectangle on the front surface of the  
4 device in Figures 1, 3 and 9 "marks an area visible beneath the transparent surface and is claimed  
5 subject matter" (Dkt 1089-3, at 3) is in direct contravention of the PTO's requirement that  
6 "elements visible behind transparent surfaces should be shown in light, full lines, not broken  
7 lines." United States Patent and Trademark Office, A Guide to Filing a Design Patent  
8 Application, at 14 (available at [http://www.uspto.gov/web/offices/com/iip/pdf/brochure\\_05.pdf](http://www.uspto.gov/web/offices/com/iip/pdf/brochure_05.pdf)).  
9 This argument cannot clarify or explain away the use of broken lines in Figure 9.



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24 Dkt. 1091, Ex. 1 at 6.

25 For the same reason, the rectangular element shown on the face of D'677 cannot be  
26 construed as claiming a feature behind a transparent front surface, because that element is not  
27 rendered in "light, full lines" as required by the PTO. In addition, although the D'677 design  
28 uses broken line structure, the patent does not disclaim broken lines as forming no part of the

1 claimed design or of a specified embodiment thereof, as required by the MPEP. *See* MPEP §  
2 1503.02 (III) (“Unclaimed subject matter may be shown in broken lines for the purpose of  
3 illustrating the environment in which the article embodying the design is used. Unclaimed  
4 subject matter **must** be described as forming no part of the claimed design or of a specified  
5 embodiment thereof.”) (emphasis added). Apple’s claims regarding the scope of the D’677 are  
6 therefore contradicted by the rules governing design patent drawing.

7         Apple also argues that the jury should be instructed that the “oblique lines appearing in the  
8 D’677 patent indicate a transparent, translucent, or highly polished or reflective surface.” Dkt.  
9 1089-3, at 3. In support, Apple relies on MPEP section 1530.02, which provides that “oblique  
10 line shading **must** be used to show transparent, translucent and highly polished or reflective  
11 surfaces, such as a mirror.” (Emphasis added). Although Apple misleadingly alters the MPEP’s  
12 **mandatory** language “must be” by bracketing it and changing it to the permissive “is,” there can  
13 be no dispute that the use of oblique line shading is required to indicate a transparent, translucent,  
14 or reflective surface. *See* Dkt. 1091, Ex. 15 at 751:15-22; *id.*, Ex. 14, at ¶ 124 (Apple’s expert  
15 opining that lack of oblique lines in border disclosed by prior art signifies lack of transparent  
16 material); *see also* June 26 Cashman Decl. Ex. 5 at 798:11-24, 811:6-812:7.

17         This same rule must be applied to D’087, which does not include any oblique line shading  
18 and therefore does not claim, and cannot claim, a transparent, reflective or highly polished front  
19 surface. Indeed, the lack of oblique shading means that the front surface of D’087 must be  
20 construed as opaque and non-transparent. *See* MPEP § 1530.02; Dkt. 1091, Ex. 15 at 751:15-22;  
21 *id.*, Ex. 14, at ¶ 124; June 26 Cashman Decl. Ex. 5 at 798:11-24, 811:6-812:7. The jury should  
22 be so instructed at the beginning of trial to clarify the applicable rules of design patents and to  
23 avoid confusion. And, to state the obvious, if the jury is instructed on patent drawing  
24 conventions generally, the actual, correct language from the MPEP should be used, rather than  
25 Apple’s altered version of it.

26         For these same reasons, the jury should be instructed that the back of D’889 depicts “a  
27 transparent, translucent, or highly polished or reflective surface” when shown in an angled  
28 perspective, but not when in a plan or direct view. This instruction is needed because Figure 2 of

1 the D'889 design patent shows oblique line shading on the back of the design in perspective view,  
2 while Figure 4 of the back in plan view does not. See Dkt. 1091, Ex. 1 at 3, 4.

3 The indefiniteness and the various drawing inconsistencies in the asserted patents, as well  
4 as Apple's inconsistent and incompatible positions regarding their construction, further illustrate  
5 precisely why these patents must be construed prior to trial. The parties need clear guidance  
6 regarding the elements that are claimed and the scope of those designs in order to focus their  
7 presentations, and the jury will require instruction to avoid significant and prejudicial confusion.  
8 See also Dkt. 930-01, at 15 n. 5.

9 **CONCLUSION**

10 For the foregoing reasons, and for the reasons set forth in Samsung's Opening  
11 Memorandum Regarding Claim Construction, Apple's proposed construction should be rejected.

12  
13 DATED: June 26, 2012

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