



1 opposed this motion, ECF No. 2027 (“Opp’n”), and Samsung filed a reply. ECF No. 2042  
2 (“Reply”). This Court will first address the ’163 Patent, and will then address the design patents.

3 **I. ’163 INDEFINITENESS**

4 As an initial matter, this claim is not waived. Apple asserts that this argument is waived  
5 because Samsung did not seek claim construction of the term “substantially centered” or include  
6 the indefiniteness issue in its pretrial statement. However, failure to seek construction of a term  
7 during claim construction does not constitute waiver of an indefiniteness argument. For one thing,  
8 under this District’s Patent Local Rules, the parties were limited in the number of terms for which  
9 they could seek construction.<sup>2</sup> See Pat. Loc. R. 4-1 (limiting parties to a total of 10 terms). Thus,  
10 failure to include a term at that stage cannot reasonably constitute a waiver. Further, Samsung has  
11 continued to raise the issue, first in invalidity contentions and in later in arguing for a jury  
12 instruction. See Pierce Reply Decl. Exh. 2 at 53 (invalidity contentions); ECF No. 1809 (proposed  
13 jury instruction). During trial, Apple agreed that Samsung could “make a JMOL on that” and “let  
14 the Court determine it.” See Tr. at 3336:18-25. Finally, this Court specifically included  
15 indefiniteness of the ’163 Patent as a topic Samsung could address in a non-jury brief. ECF No.  
16 1965. There is no question that Apple has been on notice of Samsung’s assertion of this claim.  
17 Accordingly, the Court finds that it is appropriate for Samsung to raise the issue now.

18 In order to be valid, a patent claim must “particularly point [] out and distinctly claim[] the  
19 subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2. The purpose of  
20 this definiteness requirement is “to ensure that the claims delineate the scope of the invention using  
21 language that adequately notifies the public of the patentee’s right to exclude.” *Datamize, LLC v.*  
22 *Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005). Patent claims are invalid for  
23 indefiniteness when they are not “amenable to construction,” or are “insolubly ambiguous.” *Exxon*  
24 *Research and Engineering Co. v. U.S.*, 265 F.3d 1371, 1375 (Fed. Cir. 2001).

25 Samsung contends that the term “substantially centered” in the ’163 Patent is an indefinite  
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27 <sup>2</sup> Although the parties originally identified 10 claim terms for construction, by the time of the  
28 *Markman* hearing, the parties stipulated to the construction of two terms and asked the Court to  
construe only eight terms. See Order Construing Disputed Claim Terms, ECF No. 849, at 1.

1 term of degree, which cannot be construed because no objective anchor is provided in the  
2 specification. Claim 50, the only claim at issue in this litigation, reads:

3 A portable electronic device, comprising:  
4 a touch screen display;  
5 one or more processors;  
6 memory; and  
7 one or more programs, wherein the one or more programs are stored in the memory  
8 and configured to be executed by the one or more processors, the one or more  
9 programs including:  
10 instructions for displaying at least a portion of a structured electronic document on  
11 the touch screen display, wherein the structured electronic document comprises a  
12 plurality of boxes of content;  
13 instructions for detecting a first gesture at a location on the displayed portion of the  
14 structured electronic document;  
15 instructions for determining a first box in the plurality of boxes at the location of the  
16 first gesture;  
17 instructions for enlarging and translating the structured electronic document so that  
18 the first box is **substantially centered** on the touch screen display;  
19 instruction for, while the first box is enlarged, a second gesture is detected on a  
20 second box other than the first box; and  
21 instructions for, in response to detecting the second gesture, the structured electronic  
22 document is translated so that the second box is **substantially centered** on the touch  
23 screen display.

24 U.S. Patent No. 7,864,163 B2 (emphasis added).

25 The imprecise claim term at issue here, “substantially,” is a word of degree. *See, e.g., LNP*  
26 *Engineering Plastics, Inc. v. Miller Waste Mills, Inc.*, 275 F.3d 1347, 1359 (Fed. Cir. 2001)  
27 (considering the term “substantially completely wetted”); *Exxon*, 265 F.3d at 1377 (considering the  
28 phrase “to increase substantially”). “When a word of degree is used the district court must  
determine whether the patent’s specification provides some standard for measuring that degree.”  
*Seattle Box Co. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984). If the  
specification does not provide a standard for imposing a more precise construction of the term, the  
Federal Circuit has ruled that imposing a more precise construction would be error. *See Playtex*  
*Products, Inc. v. Procter & Gamble Co.*, 400 F.3d 901, 907 (Fed. Cir. 2005); *Cordis Corp. v.*  
*Medtronic AVE, Inc.*, 339 F.3d 1352, 1360 (Fed. Cir. 2003).

For example, in *Playtex*, the Federal Circuit, quoting *Liquid Dynamics Corp. v. Vaughan*  
*Co., Inc.*, 355 F.3d 1361, 1368 (Fed. Cir. 2004), stated that “substantial” implies “approximate”  
rather than “perfect.” 400 F.3d at 907. The *Playtex* Court further stated that, “the definition of  
‘substantially flattened surfaces’ adopted by the district court introduces a numerical tolerance to

1 the flatness of the gripping area surfaces of the claimed applicator. That reading contradicts the  
2 recent precedent of this court, interpreting such terms of degree.” *Id.* The *Playtex* Court then  
3 discussed *Cordis*, 339 F.3d at 1360. In *Cordis*, the Federal Circuit held that: “The patents do not  
4 set out any numerical standard by which to determine whether the thickness of the wall surface is  
5 ‘substantially uniform.’ The term ‘substantially,’ as used in this context, denotes approximation.”  
6 In refusing “to impose a precise numeric constraint on the term ‘substantially uniform thickness,’”  
7 the *Cordis* Court held that “the proper interpretation of this term was ‘of largely or approximately  
8 uniform thickness’ unless something in the prosecution history imposed the ‘clear and  
9 unmistakable disclaimer’ needed for narrowing beyond this plain-language interpretation.”  
10 *Playtex*, 400 F.3d at 907 (quoting *Cordis*, 339 F.3d at 1361).

11 Similarly, in *Anchor Wall Systems, Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298,  
12 1311 (Fed. Cir. 2003), the Federal Circuit held that the phrase “generally parallel” envisions “some  
13 amount of deviation from exactly parallel.” The *Anchor Wall* Court also noted that “words of  
14 approximation, such as ‘generally’ and ‘substantially,’ are descriptive terms ‘commonly used in  
15 patent claims ‘to avoid a strict numerical boundary to the specified parameter.’”” *Id.* at 1310-11  
16 (internal citations omitted). Furthermore, the Court noted that “nothing in the prosecution history  
17 of the #015 patent family clearly limits the scope of ‘generally parallel’ such that the adverb  
18 ‘generally’ does not broaden the meaning of parallel.” *Id.* at 1311.

19 In *Liquid Dynamics Corp.*, 355 F.3d at 1369, the Federal Circuit construed a claim with the  
20 phrases a “substantial helical flow” and a “substantially volume filling flow” as “all flow patterns  
21 that are generally, though not necessarily perfectly, spiral, and that fill much, though not  
22 necessarily all, of the tank’s volume.” The Court held that, “Because the plain language of the  
23 claim was clear and uncontradicted by anything in the written description of the figures, the district  
24 court should not have relied upon the written description, the figures, or the prosecution history to  
25 add limitations to the claim.” *Id.* at 1368.

26 Other Federal Circuit cases have also held that the term “substantially” does not require a  
27 strict numerical boundary. “We note that like the term ‘about,’ the term ‘substantially’ is a  
28 descriptive term commonly used in patent claims to ‘avoid a strict numerical boundary to the

1 specified parameter.”” *Ecolab, Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367 (Fed. Cir. 2001)  
2 (quoting *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211 (Fed. Cir. 1995)). “Expressions  
3 such as ‘substantially’ are used in patent documents when warranted by the nature of the invention,  
4 in order to accommodate the minor variations that may be appropriate to secure the invention.”  
5 *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120 (Fed. Cir. 2002). Thus, the law is clear that  
6 a court need not, and indeed may not, construe terms of degree to give them greater precision,  
7 absent a standard for imposing a more precise construction in the specification.

8 In the instant case, the Court finds no standard for measuring the precise boundaries of  
9 “substantially centered” in the specification. Accordingly, under Federal Circuit precedent, it  
10 would be inappropriate for this Court to issue a construction of “substantially centered” that gives  
11 it greater precision.

12 The Federal Circuit has never suggested, however, that this lack of precision constitutes a  
13 lack of construability, so as to render a term of degree indefinite. Indeed, the Federal Circuit has  
14 construed such terms of degree. In so doing, the Federal Circuit has taken one of two approaches.  
15 In some cases, the Federal Circuit relies on the commonly understood meaning of other terms of  
16 degree. *See, e.g., Cordis*, 339 F.3d at 1360 (“substantially uniform thickness” construed as “of  
17 largely or approximately uniform thickness”); *Anchor Wall*, 340 F.3d at 1311 (“generally parallel”  
18 construed as “some amount of deviation from exactly parallel”). In other cases, the Federal Circuit  
19 points to some contrasting example to provide an indication of what is *not* meant by the term. *See,*  
20 *e.g., Playtex*, 400 F.3d at 909 (“substantially flattened surfaces” construed as “surfaces, including  
21 flat surfaces, materially flatter than the cylindrical front portion of the applicator”). In none of  
22 these cases has the Federal Circuit found that the term of degree was not amenable to construction  
23 or insolubly ambiguous.

24 Samsung has not attempted to argue that a court would be unable to issue such a plain  
25 meaning-based construction of the term “substantially centered.”<sup>3</sup> Instead, Samsung has argued

26 <sup>3</sup> Neither party requested construction of the term “substantially centered.” Moreover, Samsung  
27 did not make any noninfringement, anticipation, or obviousness argument that depended on a  
28 disputed interpretation of the term “substantially centered.” *Cf. O2 Micro Int'l Ltd. v. Beyond  
Innovation Tech. Co., Ltd.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008) (noting that claim construction

1 that the fact that the Court cannot issue a more *precise* construction, based on the lack of an  
2 objective standard in the specification, makes it impossible to construe the term *at all*, thus  
3 rendering the term indefinite. However, as the cases cited above demonstrate, this is simply not the  
4 law. The Federal Circuit has explained that “[e]xpressions such as ‘substantially’ are used in  
5 patent documents when warranted by the nature of the invention, in order to accommodate the  
6 minor variations that may be appropriate to secure the invention.” *Verve*, 311 F.3d at 1120.  
7 Samsung has not contended, and this Court does not find, that the term “substantially centered” as  
8 used in this patent is not amenable to construction consistent with the Federal Circuit’s  
9 constructions of terms of degree.

10 The parties have also presented extrinsic evidence that the term “substantially centered” can  
11 be understood by persons of ordinary skill in the art. The Federal Circuit has explained that  
12 although courts “have emphasized the importance of intrinsic evidence in claim construction, we  
13 have also authorized district courts to rely on extrinsic evidence, such as expert testimony.”  
14 *Datamize*, 417 F.3d at 1348 (internal quotation marks and citation omitted). The opinion of an  
15 expert can illuminate the meaning of an ambiguous term of degree. *See Datamize*, 417 F.3d at  
16 1353-54; *Amgen, Inc. v. Chugai Pharm. Co., Ltd.*, 927 F.2d 1200, 1218 (Fed. Cir. 1991). The  
17 testimony of an inventor can also shed light on the meaning of a term insofar as the inventor is a  
18 person of ordinary skill in the art, but testimony about the inventor’s subjective state of mind  
19 cannot bear on definiteness. *See CBT Flint Partners, LLC v. Return Path, Inc.*, 654 F.3d 1353,  
20 1360 (Fed. Cir. 2011) (considering an inventor’s testimony as testimony of one of skill in the art);  
21 *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1370 (Fed. Cir. 2004) (noting a  
22 district court’s proper rejection of inventor testimony concerning subjective intent).

23 Regarding “substantially centered,” Apple’s expert, Dr. Karan Singh, testified that “a  
24 person of ordinary skill in the art, or actually even a -- a person, a layman, would tell you that  
25 visually it’s by and large centered.” Declaration of John Pierce in support of Samsung’s Reply

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26 was required where the parties had an actual dispute about whether or not the term “only if”  
27 permitted any exceptions).

1 (“Pierce Decl.”), Exh. 1, Singh 4/26/12 Depo. Tr. 119:11-21. Dr. Singh also explained that “by  
2 and large, it’s something that a person of ordinary skill in the art will have no problem  
3 understanding.” Singh 8/10/12 Trial Tr. 1901:17-19.

4 Similarly, Samsung’s expert, Mr. Gray, testified during his deposition that he had  
5 determined that some of Samsung’s accused products were capable of substantial centering as  
6 contemplated in the ’163 Patent:

7 So of the products that I -- that I have tested, except for -- except for the tab -- I  
8 think the tab 10.1. Then at least on one occasion in the boxes that I tested, my best  
9 recollection today is that there were none of the products which were incapable of  
10 centering in at least one direction under some circumstances when that first gesture  
11 selected a box. My recollection -- or “substantially centered” is the language. But  
12 not in all cases, there’s cases where they don’t. But there are some -- some cases  
13 where at least they did center it at some -- as best I can recollect, or at least  
14 approximate a centering of it.

15 And, in fact, let me rephrase. I think that my recollection is that even in the tab  
16 10.1, there is occasions when -- when it when it enlarged and substantially centered.

17 Declaration of Nathan Sabri in support of Apple’s Opposition (“Sabri Decl.”), Exh. 3, Gray 5/4/12  
18 Depo. Tr. 181:24-182:14. Mr. Gray further testified that a second box in some of the Samsung  
19 accused products was “substantially centered” on the touch screen display:

20 I believe that I have observed on at least some of the accused devices the ability to,  
21 while a first box is enlarged, select a -- select a second box. And then in response to  
22 detecting the second gesture, that that second box is substantially centered --  
23 translated so that the second box is substantially centered on the touch screen  
24 display.

25 Sabri Decl., Exh. 3, Gray 5/4/12 Depo. Tr. 185:16-22. However, at trial, Mr. Gray testified that “I  
26 don’t know when something is substantially center [sic]. I know when something is fully centered  
27 or not centered, but ‘substantially centered’ is ambiguous. How would a patent – how would an  
28 engineer understand how to make something substantially centered or not?” Gray 8/15/12 Trial Tr.  
29 2922:19-25.

30 The Court recognizes that “[t]he test for indefiniteness does not depend on a potential  
31 infringer’s ability to ascertain the nature of its own accused product to determine infringement, but  
32 instead on whether the claim delineates to a skilled artisan the bounds of the invention.” *Star*  
33 *Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1373 (Fed. Cir. 2008) (quoting  
34 *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1384 (Fed. Cir. 2005) (quoting *SmithKline*

1 *Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1341 (Fed. Cir. 2005). Nonetheless, Mr. Gray’s  
2 ability during his deposition to determine whether parts of the accused Samsung products were  
3 substantially centered or not supports the conclusion that “substantially centered” is not insolubly  
4 ambiguous.

5 In sum, the Federal Circuit’s cases establish that precise construction is not required, or  
6 even permissible, when a patent uses a term of degree such as “substantially,” and the  
7 specification does not provide a standard for measuring the precise boundaries of that term of  
8 degree. Moreover, the evidence suggests that persons of ordinary skill in the art can understand the  
9 meaning of the term “substantially centered.” Accordingly, the Court finds that the term  
10 “substantially centered” is not indefinite.

## 11 **II. DESIGN PATENT INDEFINITENESS**

12 Apple claims that Samsung’s design patent indefiniteness defense, like the utility patent  
13 indefiniteness defense, is waived. Apple asserts that Samsung cannot argue design patent  
14 indefiniteness now, because Samsung submitted an interrogatory response to a question about  
15 invalidity defenses that did not provide any details about the defense. Opp’n at 3. Apple further  
16 explains that Judge Grewal then struck expert testimony that included material beyond what was  
17 disclosed in that interrogatory response. ECF No. 1144.

18 This failure to disclose relevant evidence does not constitute waiver of the claim. Indeed,  
19 Samsung has continued to raise this issue, from its answer, ECF No. 80 at ¶ 278, through summary  
20 judgment briefing, ECF No. 931-1 at 15, and at trial, in its proposed jury instructions, ECF No.  
21 1694 at 123-24. Thus, Apple has been on notice of this defense throughout the litigation.  
22 Accordingly, the Court properly entertains Samsung’s motion at this time.

23 Samsung argues that all four of the design patents at issue in this case – the D’889, D’305,  
24 D’677, and D’087 Patents – are indefinite, for a variety of reasons.

### 25 **A. LEGAL STANDARD**

26 The standard for indefiniteness is explained above. The definiteness requirement applies to  
27 design patents as well as utility patents. *See Litton Systems, Inc. v. Whirlpool Corp*, 728 F.2d  
28 1423,1440-41 (Fed. Cir. 1984) (overruled on other grounds by *Egyptian Goddess, Inc. v. Swisa*,



1 *Inc.*, 543 F.3d 665 (Fed. Cir. 2008)). Thus, even in design patents, “[c]laims are considered  
2 indefinite when they are not amenable to construction or are insolubly ambiguous . . .  
3 Indefiniteness requires a determination whether those skilled in the art would understand what is  
4 claimed.” *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1346 (Fed. Cir. 2007).

5         There is little clear precedent on the question of how this standard is to be applied to design  
6 patents. Courts considering the question have analyzed whether “a person of skill in the art” would  
7 get “an overall understanding of the total substance of the designs.” *Antonious v. Spalding &*  
8 *Evenflo Companies, Inc.*, 217 F.3d 849 (Fed. Cir. 1999) (unpublished); *see also Seed Lighting*  
9 *Design Co., Ltd. v. Home Depot*, C 04-2291, 2005 WL 1868152 (N.D. Cal., Aug. 3, 2005)  
10 (considering whether a person skilled in the art would understand the bounds of a design patent  
11 claim from inconsistent drawings); *HR U.S. LLC v. Mizco Int'l, Inc.*, CV-07-2394, 2009 WL  
12 890550 (E.D.N.Y., Mar. 31, 2009) (design patent would be indefinite where “the overall  
13 appearance of the design is unclear”).

14         As indefiniteness is intimately linked to claim construction, the cases discussing claim  
15 construction in design patents bear on the indefiniteness analysis. Further, the test for infringement  
16 certainly bears on the test for indefiniteness, since the ultimate inquiry for indefiniteness is whether  
17 a person having ordinary skill in the art could tell what is claimed – and therefore, what infringes.  
18 *See LNP Engineering*, 275 F.3d at 1360. Design patents protect “overall designs” rather than  
19 individual specific features. *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239-  
20 41 (Fed. Cir. 2009); *see also Egyptian Goddess*, 543 F.3d at 665 (noting the risk that a verbal  
21 description will lead a jury to “plac[e] undue emphasis on particular features of the design and. . .  
22 focus on each individual described feature in the verbal description rather than on the design as a  
23 whole”). Design patents are infringed when “an ordinary observer, familiar with the prior art  
24 designs, would be deceived into believing that the accused product is the same as the patented  
25 design.” *Crocs, Inc. v. Int'l Trade Com'n*, 598 F.3d 1294, 1303 (Fed. Cir. 2010). Further, the  
26 Federal Circuit has explained that in construing design patent claims, a district court “[i]s not  
27 obligated to issue a detailed verbal description of the design,” *Egyptian Goddess*, 543 F.3d at 680,  
28 but “can usefully guide the finder of fact by addressing a number of other issues that bear on the

1 scope of the claim. Those include such matters as describing the role of particular conventions in  
2 design patent drafting, such as the role of broken lines; assessing and describing the effect of any  
3 representations that may have been made in the course of the prosecution history; and  
4 distinguishing between those features of the claimed design that are ornamental and those that are  
5 purely functional.” *Id.* (internal citations omitted). It is with these parameters in mind that the  
6 Court considers whether the design patents now at issue allow “those skilled in the art [to]  
7 understand what is claimed.” *Young*, 492 F.3d at 1346.

8 To prevail on its indefiniteness defense, Samsung must show by clear and convincing  
9 evidence that a designer of ordinary skill in the art would not understand what is claimed. *See*  
10 *Datamize*, 417 F.3d at 1348. This is a high standard, necessary to give effect to the statutory  
11 presumption of validity afforded to issued patents. *See* 35 U.S.C. § 282.

## 12 B. DISCUSSION

13 Samsung has made a range of arguments about why the various design patents are  
14 indefinite. Specifically, Samsung argues that the D’889 Patent is indefinite for four reasons: (1)  
15 drawings showing the design oriented in different directions make it impossible to know which  
16 way the design is supposed to be oriented or where features actually appear; (2) the use of broken  
17 lines is inconsistent, making it difficult to tell which elements are claimed and which are not; (3)  
18 the use of surface shading is different in different pictures, making it unclear what type of surface  
19 is being represented; and (4) the 035 Mockup<sup>4</sup> and iPad 2 are both said to embody the design,  
20 while the original iPad is not. Samsung then presents a single argument for indefiniteness of the  
21 D’305 Patent: that the use of color in one drawing but not another makes it impossible to tell  
22 whether color is necessary for the claim. Finally, Samsung presents two arguments for  
23 indefiniteness of the related D’677 and D’087 Patents: (1) that the drawing does not make clear  
24 whether the “lozenge” shape and rectangular shape are beneath the surface, a break in the surface,  
25 or resting on top of the surface; and (2) that the lack of shading on the D’087 drawing makes it  
26 impossible to see that there is, in fact, a display area below a transparent surface.

27 <sup>4</sup> The 035 Mockup is a model Apple produced of one of its designs. It was admitted at trial as  
28 DX741.

1           Several of Samsung’s arguments concern use of drafting techniques (broken lines and  
2 shading). In support of its argument that inconsistent use of broken lines is per se indefinite,  
3 Samsung cites *In re Blum*, 374 F.2d 904 (C.C.P.A. 1967). The court in *Blum* noted that “[d]otted  
4 and broken lines may mean different things in different circumstances” and that “in each case it  
5 must be made entirely clear what they do mean” to avoid indefiniteness. *Id.* at 907. This case,  
6 however, precedes *Young*, *Datamize*, *Exxon*, and other cases explaining that a claim need only be  
7 amenable to construction to be definite, and precedes *Egyptian Goddess*, which explains the  
8 responsibilities of district courts in construing design patent claims, including construing the use of  
9 drafting techniques. Further, it makes clear that it “is the examiner’s responsibility to obtain such  
10 definiteness.” *Blum*, 374 F.2d at 907. Here, when the patent has already issued, the patent comes  
11 with a strong presumption of validity. Thus, there is no per se rule that inconsistent use of dotted  
12 lines renders a patent invalid.

13           Indeed, the Court’s claim construction of the design patents shows that these features *are*  
14 amenable to construction. ECF No. 1425 (construing the use of broken lines, oblique lines, and  
15 shading in all four of the design patents). Similarly, the Federal Circuit found no difficulty in  
16 interpreting the claimed designs in the D’677, D’087, and D’889 Patents. *See Apple, Inc. v.*  
17 *Samsung Electronics Co., Ltd.*, 678 F.3d 1314 (Fed. Cir. 2012) (preliminary injunction opinion).  
18 Given that this Court and the Federal Circuit have construed the claims in these patents, they are  
19 not “insolubly ambiguous” or “not amenable to construction.” *Young*, 492 F.3d at 1346.

20           Moreover, the Federal Circuit has explicitly recognized that it is appropriate for district  
21 courts to issue interpretations of drafting conventions, *see Egyptian Goddess*, 543 F.3d at 680. If  
22 the use of drafting conventions had to be facially obvious for the patent to be valid, no such  
23 interpretations would ever be necessary. Further, the law is clear that the fact that claim  
24 construction is necessary does not render the patent indefinite. *See, e.g., Exxon*, 265 F. 3d at 1375  
25 (patent is not indefinite even if claim construction is quite difficult). Accordingly, the patents are  
26 not per se indefinite due to their inconsistent use of drafting techniques including shading and  
27 broken lines.  
28

1           Regarding the differently oriented drawings in the D’889 Patent, the Court sees nothing  
2 inconsistent about these drawings. They show a device facing different directions, but there is no  
3 place in which an identifiable feature of the design appears in two different places in two different  
4 figures, taking into account the rotation of the object depicted. The fact that a feature may be  
5 invisible in one of the figures due to the resolution and orientation of the drawing does not make it  
6 impossible to determine whether or not the feature is part of the design. Samsung argues that the  
7 “environmental features” in Figures 1-4 are “switched to different sides” in Figures 5-8. Mot. at 6.  
8 Without any further specifics in Samsung’s argument, the Court cannot be certain as to what  
9 features Samsung intends to refer, but having examined the drawings, the Court sees no  
10 inconsistency. There is a circular hole on one edge and a rectangular opening on another edge  
11 visible in Figure 2; the same features are visible in the same relative places in Figures 6 and 8,  
12 though the entire object is rotated. Further, contrary to Samsung’s assertion, there is simply no  
13 requirement that a claimed design must have a particular preferred orientation; indeed, Samsung  
14 cites no law even suggesting that there is. The fact that the D’889 Patent shows a design in  
15 different orientations merely shows that the particular orientation – landscape or portrait, head-on  
16 or perspective – is not part of what is claimed.

17           Samsung also argues that the fact that the iPad 2 and the 035 Mockup both embody the  
18 D’889 Patent necessarily renders the patent indefinite. But the law is clear that the same design  
19 patent can have multiple embodiments. *See Antonious*, 217 F.3d at 7; *In re Rubinfeld*, 270 F.2d  
20 391, 391 (C.C.P.A. 1959). Thus, the fact that both of these objects are said to embody the design  
21 does not necessarily propose a definiteness problem. Samsung seems to suggest that if two objects  
22 as different as the iPad 2 and the 035 Mockup can both embody the patented design, where the  
23 original iPad does not, the patent simply must be indefinite. But Samsung presents no evidence to  
24 support its assertion that the 035 Mockup and iPad2 are less similar in relevant ways than the  
25 original iPad and iPad2, and a mere assertion in a brief that objects are similar or dissimilar cannot  
26 serve as a basis for invalidating a patent. Given the strong presumption of validity accompanying  
27 issued patents, this Court cannot find, based on Samsung’s bald assertion, that the similarities and  
28 differences between these three articles and the patent itself warrant a finding of indefiniteness.

1           Next, Samsung claims that because only one of the figures in the D’305 Patent is in color,  
2 there is no possible way to know whether color is part of the claimed design. As Samsung  
3 acknowledges, the Model of Patent Examining Procedure explains that color drawings are allowed  
4 where “color is an integral part of the claimed design.” MPEP 1503.02(V). Thus, by including a  
5 color drawing, Apple has made clear that color *is* necessary to the design. The regulations  
6 governing color drawings make clear that they are to be used only rarely and only where necessary  
7 to convey what is claimed. *See* 37 C.F.R. § 1.84(a)(2). Nowhere do the regulations say that if one  
8 drawing is in color, all drawings must be in color, and Samsung cites no authority for that  
9 proposition. Given the presumption of validity afforded to issued patents, *see Datamize*, 417 F.3d  
10 at 1347, the Court declines to adopt a rule requiring all depictions of the design to be in color in  
11 order for color to be part of the claimed design.

12           Samsung next argues that the D’677 and D’087 Patents are indefinite because it is unclear  
13 whether the lozenge and rectangle shapes are below, in, or on top of the surface. But it does not  
14 matter “whether the lozenge and rectangle features on the front faces are *below* a surface, material  
15 breaks *on* the surface, or features drawn on *top* of a continuous surface,” Mot. at 8, as long as any  
16 of those could produce interchangeable visual effects that would appear “substantially the same to  
17 the ordinary observer.” *Egyptian Goddess*, 543 F.3d at 678. As this Court explained in its Claim  
18 Construction Order, a design patent protects an overall visual impression, and “it will be for the  
19 jury to decide whether the accused device’s ‘lozenge-shaped element would appear as it does in the  
20 figures.’” ECF No. 1425 at 7. In other words, the design patent need not specify how the lozenge  
21 shape is created. It need only provide the visual standard for comparison. It may be possible to  
22 produce the same overall visual impression with the lozenge in any one of those three positions,  
23 relative to the smooth surface. This fact does not render the design patent indefinite; it simply  
24 means that there may be more than one way to manufacture an article that embodies the claimed  
25 design.

26           Finally, Samsung argues that Apple’s “named inventors and other witnesses” testified “that  
27 they could not understand the designs reflected in Apple’s patents.” Reply at 3 n.1 (citing exhibits  
28 to Pierce Reply Decl.). Generally, the witnesses to whom Samsung points express a lack of

1 familiarity with the conventions used in the drawings, or a lack of understanding about what design  
2 patents are. However, the witnesses' reluctance to verbally interpret the drawings presented in  
3 depositions as parts of patents subject to intense litigation does not, in and of itself, establish  
4 indefiniteness. Rather, the testimony Samsung cites consistently indicates a lack of familiarity  
5 with design patent conventions. *See, e.g.*, Pierce Reply Decl. Exh. 10 ("Q: And why is it you can't  
6 ascertain that? Is there not enough information in the drawings here to tell you? A: I don't  
7 understand the language of the patent drawing."); *id.* Ex. 12 ("Q: And in some instances you said  
8 you couldn't make that judgment based on the drawings. Do you recall that? A: Yes. Q: Why is  
9 that, sir? A: I—I can't – I can't interpret patent drawing.") Witnesses' ignorance of drafting  
10 conventions, which are detailed in the Manual of Patent Examining Procedure (*see* Mot. at 7;  
11 Opp'n at 7), does not establish that the patents cannot be construed so as to clearly delineate what  
12 design is claimed. Further, definiteness does not require that persons of skill in the art be able to  
13 clearly describe the designs in words; they must simply be able to replicate the patented design and  
14 understand what is claimed. Here, the testimony to which Samsung points demonstrates a general  
15 unease among some witnesses with the concept of design patents – not an inability to understand or  
16 replicate the claimed designs.

17 Further, Apple presents some trial testimony of witnesses who *were* able to interpret the  
18 drawings. Most notably, Samsung's design expert, Itay Sherman, testified that the designs were  
19 obvious and functional (*see, e.g.*, Tr. 2578:10-21; 2579:8-20; 2581:22-25). As Apple points out, it  
20 would be difficult to have an opinion that a given design was obvious without understanding what  
21 the design actually was.

22 Taken together, Samsung's arguments, which all concern the quality and specificity of the  
23 drawings, are in contrast to the types of defects that courts have found constituted design patent  
24 indefiniteness. For example, in *Seed Lighting*, the lamp was depicted with a base that had one  
25 shape in one drawing and a completely different shape in another drawing. 2005 WL 1868152 at  
26 \*9. The difference could not be attributed to the way in which the design was represented; there  
27 were unambiguously two different shapes in the two different pictures. The Federal Circuit in  
28 *Antonious* confirms that where the ambiguities concern representation, and not the actual article, a

1 court need not find indefiniteness. 217 F.3d at 7-8 (no indefiniteness where discrepancies between  
2 drawings may be due to differing use of perspective). The distinction between drafting  
3 inconsistencies and actual ambiguity is especially relevant here, where the Court has been able to  
4 construe the drafting techniques, as the Federal Circuit has stated that district courts may do. *See*  
5 *Egyptian Goddess*, 543 F.3d at 680. In sum, all of Samsung's alleged sources of indefiniteness  
6 concern how the design is represented, rather than the nature of the design itself. These  
7 ambiguities are not fatal to patents that this Court must view with a strong presumption of validity.  
8 Accordingly, Samsung has not established indefiniteness by clear and convincing evidence, and  
9 Apple's design patents remain valid.

10 **III. CONCLUSION**

11 For the reasons stated above, the Court finds that neither the '163 Patent nor Apple's  
12 design patents are invalid for indefiniteness.

13 **IT IS SO ORDERED.**

14 Dated: January 29, 2013

15   
16 LUCY H. KOH  
17 United States District Judge