

1 QUINN EMANUEL URQUHART & SULLIVAN, LLP
 Charles K. Verhoeven (Cal. Bar No. 170151)
 2 charlesverhoeven@quinnemanuel.com
 50 California Street, 22nd Floor
 3 San Francisco, California 94111
 Telephone: (415) 875-6600
 4 Facsimile: (415) 875-6700

5 Kevin P.B. Johnson (Cal. Bar No. 177129)
 kevinjohnson@quinnemanuel.com
 6 Victoria F. Maroulis (Cal. Bar No. 202603)
 victoriamaroulis@quinnemanuel.com
 7 555 Twin Dolphin Drive 5th Floor
 Redwood Shores, California 94065
 8 Telephone: (650) 801-5000
 Facsimile: (650) 801-5100

9 Michael T. Zeller (Cal. Bar No. 196417)
 10 michaelzeller@quinnemanuel.com
 865 S. Figueroa St., 10th Floor
 11 Los Angeles, California 90017
 Telephone: (213) 443-3000
 12 Facsimile: (213) 443-3100

13 Attorneys for SAMSUNG ELECTRONICS
 CO., LTD., SAMSUNG ELECTRONICS
 14 AMERICA, INC. and SAMSUNG
 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

**REPLY IN SUPPORT OF SAMSUNG'S
 NOTICE OF MOTION AND MOTION TO
 EXCLUDE ORDINARY OBSERVER
 OPINIONS OF APPLE EXPERT COOPER
 WOODRING; AND**

**MEMORANDUM OF POINTS AND
 AUTHORITIES IN SUPPORT**

Date: October 13, 2011

Time: 1:30 pm

Place: Courtroom 8, 4th Floor

Judge: Hon. Lucy H. Koh

PUBLIC REDACTED VERSION

TABLE OF CONTENTS

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Page

MEMORANDUM OF POINTS AND AUTHORITIES 1

INTRODUCTION..... 1

ARGUMENT 2

I. THERE IS NO SUFFICIENT “CONNECTION BETWEEN” THE FACTS AND MR. WOODRING’S OPINIONS REGARDING THE ORDINARY OBSERVER 2

II. MR. WOODRING’S OPINIONS IGNORE KEY FACTS WHICH MAKE HIS OPINIONS UNRELIABLE 4

 A. Samsung Accurately Described the Prior Art and Mr. Woodring’s Crucial Testimony That it is Substantially Similar to Apple’s ’087 and ’677 Designs 4

 B. Apple Misrepresents Mr. Woodring’s Purported Functionality Analysis..... 8

 C. Mr. Woodring Is Silent as to the Sophistication of the Ordinary Purchaser 11

 D. Apple Improperly Dismisses Significant Differences Between the Samsung Products and Apple’s Patented Designs 12

III. APPLE POINTS TO NO EVIDENCE THAT QUALIFIES MR. WOODRING AS AN EXPERT ON THE ORDINARY OBSERVER OF SMARTPHONES AND COMPUTER TABLETS..... 13

CONCLUSION 15

TABLE OF AUTHORITIES

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Page(s)

Cases

Applied Arts Corp. v. Grand Rapids Metalcraft Corp.,
67 F.2d 428 (6th Cir. 1933).....8

Avia Group Int'l, Inc., v. L.A. Gear California, Inc.,
853 F.2d 1557 (Fed. Cir. 1988).....10

Best Lock Corp. v. Ilco Unican Corp.,
94 F.3d 1563 (Fed. Cir. 1996).....10

In re Bextra and Celebrex Mktg. Sales Practices and Prod. Liab. Litig.,
524 F. Supp. 2d 1166 (N.D. Cal. 2007)4, 11

Contessa Food Products, Inc. v. Conagra, Inc.,
282 F.3d 1370 (Fed. Cir. 2002).....7

Crocs, Inc. v. ITC,
598 F.3d 1294 (Fed. Cir. 2010).....10

Door-Master Corp. v. Yorktowne, Inc.,
256 F.3d 1308 (Fed. Cir. 2001).....7

Durling v. Spectrum Furniture Co., Inc.,
101 F.3d 100 (Fed. Cir. 1996).....7

Egyptian Goddess, Inc. v. Swisa, Inc.,
543 F.3d 665 (Fed. Cir. 2008).....6, 9

Gorham Mfg. Co. v. White,
81 U.S. 511 (1871)6, 14

Hupp v. Siroflex of Am., Inc.,
122 F.3d 1456 (Fed. Cir. 1997).....10

Int'l Seaway Trading Corp. v. Walgreens Corp.,
589 F.3d 1233 (Fed. Cir. 2009).....7

KeyStone Retaining Wall Systems, Inc. v. Westrock, Inc.,
997 F.2d 1444 (Fed. Cir. 1993).....8

L.A. Gear v. Thom McAn Shoe Co.,
988 F.2d 1117 (Fed. Cir. 1993).....12

Lee v. Dayton-Hudson Corp.,
838 F.2d 1186 (Fed. Cir. 1988).....9

OddzOn Prods., Inc. v. Just Toys, Inc.,
122 F.3d 1396 (Fed. Cir. 1997).....8, 9

1	<i>Richardson v. Stanley Works, Inc.</i> , 597 F.3d 1288 (Fed. Cir. 2010).....	9
2		
3	<i>Richardson v. Stanley Works, Inc.</i> , 610 F. Supp. 2d 1046 (D. Ariz. 2009).....	9
4	<i>Robinson v. G.D. Searle & Co.</i> , 286 F. Supp. 2d 1216 (N.D. Cal. 2003)	2
5		
6	<i>Spotless Enterprises, Inc. v. A & E Products Group LP</i> , 294 F. Supp. 2d 322 (E.D.N.Y. 2003).....	10
7	<i>Sun Hill Indus. v. Easter Unlimited</i> , 48 F.3d 1193 (Fed. Cir. 1995).....	13
8		
9	<i>Sun-Mate Corp. v. Koolatron Corp.</i> , <i>No. CV10-4735-JST (JCEX)</i> , 2011 U.S. Dist. LEXIS 84726 (C.D. Cal. Aug. 1, 2011)	10
10		
11	<i>U.S. v. Laurienti</i> , 611 F.3d 530 (9th Cir. 2010).....	14
12	<i>U.S. v. Lopez-Martinez</i> , 543 F.3d 509 (9th Cir. 2008).....	14
13		

Statutes

14		
15	37 C.F.R. sec. 1.56(a).....	6
16	Fed. R. Evid. 702.....	2
17		
18		
19		
20		
21		
22		
23		
24		
25		
26		
27		
28		

1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 **Introduction**

3 It is undisputed, and Apple’s Opposition cannot prove otherwise, that Apple’s proffered
4 expert, Cooper Woodring, based his ordinary observer opinion on facts that are inapplicable to
5 consumer behavior for the accused products here -- smartphones and tablet computers -- and his
6 opinion therefore should be excluded. Apple does not dispute that Mr. Woodring, in rendering
7 his opinions, did not receive (or even ask for) Apple’s available internal research or data on why
8 consumers buy products or how they perceive and evaluate designs. [REDACTED]

9 [REDACTED] Apple undoubtedly chose to keep Mr. Woodring
10 in the dark because [REDACTED]

11 [REDACTED]
12 [REDACTED] Instead, Mr. Woodring merely relied on his
13 experience at J.C. Penney over 25 years ago where no smartphones or tablet computers were sold
14 and where Mr. Woodring admits the retail environment was quite different. His reliance on
15 irrelevant market research from decades ago, especially when coupled with his failure to consider
16 research from today’s market about smartphones and tablet computers that flatly contradicts his
17 analysis, renders his ordinary observer opinions impermissibly speculative, unreliable and
18 divorced from the facts. They should be excluded.

19 Mr. Woodring’s flawed ordinary observer analysis also overlooks core facts like prior art
20 and functionality, which likewise renders his opinion irrelevant, unreliable and inadmissible.
21 Contrary to Apple’s hyperbole, Samsung properly showed Mr. Woodring at his deposition the
22 front surface of the Japanese design patent prior art from Sharp. Apple ignores that the two
23 Apple phone design patents at issue cover *only* the front surface of those phones – the exact same
24 portions that Mr. Woodring conceded was taught by the front surface of the Sharp prior art that he
25 was examined on. Not only is Apple wrong on the facts, but it is wrong on the law. In
26 demonstrating that a patent is invalid due to obviousness, it is appropriate under Federal Circuit
27 law for Samsung to rely on a portion of the Sharp prior art. Apple also misrepresents Mr.
28 Woodring’s purported functionality opinion. Mr. Woodring conceded he did no such analysis,

1 and his declaration says nothing on functionality. Apple's assertion that Mr. Woodring had no
2 duty to filter out the functional elements of the design patents, including the elements that he
3 conceded at deposition were functional, is contrary to law and only serves to confirm that Mr.
4 Woodring's opinions relied on an impermissible construction of the design patents at issue.

5 Despite all of these glaring flaws, Apple offers Mr. Woodring's opinions to advance its
6 extreme positions in this litigation that competitors such as Samsung should be barred from using
7 generalized design features that have long been common in smartphones and tablet computers,
8 such as rounded corners and the color black. Apple may well have selected Mr. Woodring
9 because of his own past advocacy that design patents be used as a "competitive weapon,"¹ just as
10 Apple seeks to do in this litigation. Whatever the case, however, Mr. Woodring is not qualified to
11 act as an expert with respect to the ordinary observer of smartphones and computer tablets, and
12 Apple provides no evidence that he is. Indeed, he has never designed a smartphone or tablet
13 computer (or even a phone for that matter) and has not worked with or at any retailer that sells
14 them. As Mr. Woodring admitted, he is not an expert on the reasons why consumers purchase
15 iPhones and iPads in particular or smartphones and tablets in general. Mr. Woodring's opinions
16 are unreliable and irrelevant, and the Court should exclude them.

17 **Argument**

18 **I. THERE IS NO SUFFICIENT "CONNECTION BETWEEN" THE FACTS AND**
19 **MR. WOODRING'S OPINIONS REGARDING THE ORDINARY OBSERVER**

20 Apple concedes that to be admissible, there must be "a 'sufficient connection' between the
21 facts and the proffered opinion" of Mr. Woodring. Opp. at 2:6-8. See also Fed. R. Evid. 702;
22 *Robinson v. G.D. Searle & Co.*, 286 F. Supp. 2d 1216, 1221 (N.D. Cal. 2003) (Rule 702 "requires,
23 for expert testimony to be admissible, that the testimony be 'based on sufficient facts or data'").

24 _____
25 ¹ Deposition Transcript of Cooper Woodring, dated August 5, 2011 ("Woodring Depo. Tr.")
26 at 256:5-257:9, Supplemental Zeller Declaration In Support Of Samsung's Motion to Exclude
27 Ordinary Observer Opinions of Apple Expert Cooper Woodring, dated September 20, 2011,
28 ("Supp. Zeller Dec."), Exh. 1; see also Declaration of Cooper Woodring In Support of Apple's
Motion For A Preliminary Injunction ("Woodring Dec."), Ex. 6 at 6, Zeller Dec. Exh. 4.

1 There is no such connection here, and Apple presents no evidence otherwise. Mr. Woodring
2 relies on amorphous, conclusory claims about unproduced market and consumer research from his
3 experience at J.C. Penney over 25 years ago.² Nowhere does Mr. Woodring, or even Apple, offer
4 any empirical data or reliable basis to support his extrapolation of that experience to purchasers of
5 smartphones and tablet computers today. Neither of them provide any plausible explanation as to
6 why that experience is applicable to the facts of this case. It is not. As Mr. Woodring testified,
7 that retail environment in 1986 is "quite different" than the retail environment for Apple products.³
8 Apple tellingly does not dispute this proposition, let alone provide contrary proof. Opp. at 14.

9 Apple also concedes that even though Mr. Woodring's ordinary observer opinions rely on
10 his claims about consumer behavior in a different retail environment involving different products
11 during the 1980s, he did not receive — or even ask for — any of Apple's internal research or data
12 on why consumers buy Apple products or how they perceive and evaluate Apple's designs. [REDACTED]

13 [REDACTED]
14 [REDACTED] and did not attempt to obtain current market research information about
15 smartphones and tablet computers.⁴ Without support, Apple dismisses such key data and
16 information as irrelevant. Opp. at 10. Fatal to Apple's *ipse dixit* position, however, Mr.
17 Woodring himself admitted that, as far as his opinion is concerned, this type of "updated specific
18 market research information about the purchasing behavior of Apple's consumers *is relevant* to
19 determining how an ordinary observer would perceive and evaluate the smartphone and tablet
20 computer designs at issue in this case."⁵ [REDACTED]

21 [REDACTED]
22 [REDACTED] is also relevant because it flatly refutes Mr. Woodring's opinion
23 that ordinary observers overwhelmingly believe otherwise. And Apple's research defeats any

24
25 ² Woodring Depo. Tr. at 190:17-24, 191:13-19, Zeller Dec. Exh. 1.

26 ³ Woodring Depo. Tr. at 183:1-12, Zeller Dec. Exh. 1.

27 ⁴ [REDACTED]
⁵ Woodring Depo. Tr. at 192:6-13 (emphasis added), Zeller Dec. Exh. 1.

28 ⁶ [REDACTED]
[REDACTED]

1 argument that Apple could be suffering irreparable harm because it shows that the accused design
2 infringement could have no meaningful effect on Apple's market share.

3 In a last ditch attempt to salvage Mr. Woodring, Apple posits that because the parties
4 merely dispute Mr. Woodring's ultimate conclusions, those disagreements should only affect the
5 weight afforded to Mr. Woodring's opinions. Opp. at 3. Apple is wrong. Samsung does not
6 simply dispute Mr. Woodring's ultimate conclusions. Though Samsung believes they are also
7 inaccurate, those opinions are based on key premises and methodologies that are unconnected to
8 the facts of this case and ignore other, more relevant data. His opinions regarding the ordinary
9 observer are therefore inadmissible under *Daubert*.

10 **II. MR. WOODRING'S OPINIONS IGNORE KEY FACTS WHICH MAKE HIS**
11 **OPINIONS UNRELIABLE**

12 Apple concedes that Mr. Woodring failed to consider certain facts in rendering his
13 opinions. Yet, it also claims that Mr. Woodring actually did consider other facts — facts that Mr.
14 Woodring himself admitted he failed to consider — but that they do not alter his analysis. Apple
15 quibbles that the facts Mr. Woodring ignored were irrelevant or misconstrued by Samsung. Opp.
16 at 2-12. Apple's arguments are unavailing. Each of the facts Mr. Woodring ignored — such as
17 highly relevant prior art, functionality, sophistication of the purchasers, and the differences
18 between the Apple patents and Samsung's products — requires the exclusion of his analysis. *See,*
19 *e.g., In re Bextra and Celebrex Mktg. Sales Practices and Prod. Liab. Litig.*, 524 F. Supp. 2d
20 1166, 1176-77, 1179-81 (N.D. Cal. 2007).

21 **A. Samsung Accurately Described the Prior Art and Mr. Woodring's Crucial**
22 **Testimony That it is Substantially Similar to Apple's '087 and '677 Designs**

23 Mr. Woodring testified at deposition that the front face of the device shown in Japanese
24 design registration 1241638⁷ is “substantially the same” as the designs in Apple's asserted D'677
25

26 _____
27 ⁷ Deposition Exhibit 67, Zeller Dec. Exh. 2; *see also* Japanese design registration 1241638,
28 Supp. Zeller Dec. Exh. 2.

1 and D'087 phone patents.⁸ Unfortunately for Apple, this registration was filed by Sharp and
2 issued by the Japanese Patent Office well before Apple's claimed invention dates for its iPhone
3 design. Seeking to evade the admissions of its own expert, Apple nevertheless tries to spin his
4 testimony. Opp. at 4-6. That attempt fails. In reality, during his deposition, Mr. Woodring
5 repeatedly admitted that the front face of the device covered by Japanese design registration
6 1241638⁹ is "substantially the same" as the designs in Apple's D'677 and D'087 patents.¹⁰
7 Apple merely cites to a portion of Mr. Woodring's testimony where, only *after* he made his
8 unambiguous admissions and only *after* the repeated, improper speaking objections by Apple's
9 counsel that coached him to change his answers,¹¹ he *later* tried to vaguely claim (consistent with
10 Apple's counsel's speaking objections)¹² that it would be "impossible to make [the]
11 determination."¹³ Contrary to Apple's attempts to portray this additional testimony as salvaging
12 Mr. Woodring's admissions, these efforts by Apple's counsel and Mr. Woodring to back-peddle
13 after Mr. Woodring's repeated admissions that the prior art was indeed "substantially the same" as
14 Apple's claimed designed patents¹⁴ only further show the impropriety of Mr. Woodring's
15 opinions.

16 Moreover, Apple does not dispute that Mr. Woodring failed to consider Japanese design
17 registration 1241638.¹⁵ Apple complains that Samsung should have identified this prior art
18 earlier in this case (Opp. at 3), but that assertion is baseless and indeed is backward. Apple was
19 obligated to identify that prior art not only to Samsung, but also to the Patent Office when it
20 sought the design patents at issue. Japanese design registration 1241638 was issued to Sharp on
21

22 ⁸ Woodring Depo. Tr. at 207:10-208:21, 216:10-22, Zeller Dec. Exh. 1.

23 ⁹ Deposition Exhibit 67, Zeller Dec. Exh. 2.

24 ¹⁰ Woodring Depo. Tr. at 207:10-208:21, 216:10-22, Zeller Dec. Exh. 1.

25 ¹¹ Woodring Depo. Tr. at 217:5-224:19 (Woodring agreeing that Exhibit 67 shares the major
design elements of the Apple D'087 design, as described in his declaration at paragraph 31,
subparagraphs A through E, interspersed by counsel's objections), Supp. Zeller Dec. Exh. 1.

26 ¹² Woodring Depo. Tr. at 217:9-14, 223:10-14 and 224:13-19, Supp. Zeller Dec. Exh. 1.

27 ¹³ Woodring Depo. Tr. at 224:20-225:9, Supp. Zeller Dec. Exh. 1.

28 ¹⁴ Woodring Depo. Tr. at 207:10-18, 208:8-21, 216:24-217:20, Zeller Dec. Exh. 1.

¹⁵ Deposition Exhibit 67, Zeller Dec. Exh. 2.

1 June 6, 2005. That was ten months before the purported invention of the iPhone design patents.
2 Yet, Apple did not disclose it during the prosecution of the D’677 and D’087 patents. 37 C.F.R.
3 sec. 1.56(a) (patent applicant has “a duty to disclose to the Office all information known . . . to be
4 material to patentability.”).¹⁶

5 In any event, it is immaterial to this *Daubert* motion whose burden it is to identify relevant
6 prior art, because Mr. Woodring’s failure to consider it makes his opinion unreliable. The
7 “ordinary observer” is assumed to have familiarity with all relevant prior art (*Egyptian Goddess,*
8 *Inc. v. Swisa, Inc.*, 543 F.3d 665, 676-77 (Fed. Cir. 2008)), and is one who considers the accused
9 design “giving such attention as a purchaser usually gives.” *Gorham Mfg. Co. v. White*, 81 U.S.
10 511, 528 (1871). Given the Japanese prior art that Mr. Woodring failed to consider but admitted
11 was “substantially the same” as the D’087 and D’677 patents, Mr. Woodring’s opinion is not that
12 of an ordinary observer conversant with the relevant prior art. Simply because Apple believes it
13 does not have the burden to produce evidence does not mean that its experts’ opinions are
14 immunized from being challenged as unreliable when evidence comes along that proves those
15 opinions failed to address highly relevant art. Otherwise, an expert could rely on the smallest
16 amount of prior art possible and then state that any new invalidating prior art cannot affect the
17 reliability of his opinion. Either Apple chose not to investigate relevant prior art in prosecuting
18 its design patents and preparing Mr. Woodring to testify, or it knew about this patent and kept
19 quiet about it. Either way, Apple cannot now cry foul. Mr. Woodring’s opinions did not
20 properly consider key prior art and thus his testimony is not that of someone conversant in the
21 relevant prior art.

22 _____
23 ¹⁶ Apple’s reliance on the few prior art examples that Samsung cited during a hearing less
24 than a month after Apple filed its lawsuit is misplaced for additional reasons. These examples are
25 not and were not the only prior art that Samsung would be relying on — Samsung never said they
26 were — and Apple’s surmise otherwise is unsupported. Indeed, Samsung uncovered the key
27 Japanese design registration 1241638 only as a result of its own investigation after this suit began
28 because Apple never disclosed it. Apple’s apparent suggestion that the prior art should be
deemed “frozen” as of some hearing date unilaterally picked by Apple is not only inconsistent
with the deadlines set by this Court, but asks the Court to reward *Apple* for concealing key prior
art to both the Patent Office during patent prosecution and to Samsung in this litigation.

1 Apple contends that Samsung acted inappropriately by showing Mr. Woodring the front
2 face design of the device as disclosed by Japanese design registration 1241638 and should have
3 shown Mr. Woodring all views of that art so that he would have seen alleged differences between
4 it and the Apple designs. Opp. at 4-6. Apple misstates the facts and the law. Critically, Apple
5 ignores that the D'677 and D'087 patents which Apple has asserted on the preliminary injunction
6 motion claim *only the front face of the phone design*. Thus, that front face was and remains the
7 only material part of the Japanese prior art for comparison purposes as part of patent invalidity
8 analysis. Apple's legal contention that Federal Circuit law requires a comparison of all available
9 views for the substantial similarity analysis is demonstrably wrong as well. The obviousness test
10 for invalidity still allows comparisons between individual aspects of prior art designs, and even
11 individual aspects of multiple prior art designs, as the Federal Circuit affirmed in *Int'l Seaway*
12 *Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009). Thus, the prevailing
13 Federal Circuit precedent for obviousness remains *Durling v. Spectrum Furniture Co., Inc.*, 101
14 F.3d 100, 103 (Fed. Cir. 1996). The *Durling* test requires as an initial matter that a primary
15 reference be found that has “basically the same” visual impression as the claimed design. *Id.*
16 Then, the inquiry turns to combining prior art designs, if need be. Specifically, if “one of
17 ordinary skill would have combined teachings of the prior art to create the same overall visual
18 appearance as the claimed design,” the challenged design is invalid as obvious. *Id.*¹⁷

19 Thus, in showing that the Apple design patents at issue are invalid due to obviousness,
20 Samsung properly has relied on the front surface portion of the prior art because that is what
21 corresponds to the Apple design patents that likewise claim only the front surface portion. As is
22 seen from the front view of the Sharp prior art design, Apple's design phone patents at issue are
23 obvious in light of that art because they include all of the main features that Apple claims: (1) the

24
25 ¹⁷ Apple's citations do not hold otherwise (see Opp. at 6). Instead they require a
26 comparison with the entire design patent only in assessing infringement and anticipation, not when
27 comparing prior art for invalidity due to obviousness. See *Contessa Food Products, Inc. v.*
28 *Conagra, Inc.*, 282 F.3d 1370, 1381 (Fed. Cir. 2002) (requiring comparison of all views of a
design in assessing infringement); *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1313-14
(Fed. Cir. 2001) (looking to all views in assessing infringement and anticipation).

1 speaker shape; (2) the rectangular design; (3) the rounded corners; and (4) the screen with thin
2 borders on the side and wide borders on top and bottom. Apple’s further assertion that the Sharp
3 art “is no different than the prior art Mr. Woodring already considered” is unsupported by Mr.
4 Woodring’s testimony and is belied by the evidence. Opp. at 7. The Sharp prior art discloses all
5 material features claimed by Apple in its D’677 and D’087 patents.¹⁸ Mr. Woodring’s failure to
6 consider that art renders his opinions unreliable.

7 **B. Apple Misrepresents Mr. Woodring’s Purported Functionality Analysis**

8 Mr. Woodring conceded at deposition that claimed elements of the Apple patented designs
9 were functional. Opp. at 9. Apple acknowledges that he so testified, but it urges that Mr.
10 Woodring had no duty to filter out those admittedly functional elements out of the infringement
11 analysis. That is contrary to law. A design patent does not protect functional design. *See, e.g.,*
12 *KeyStone Retaining Wall Systems, Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993)
13 (“A design patent protects the non-functional aspects of an ornamental design as shown in a
14 patent.”). If it were otherwise, it would subvert the purpose of design patent law. *Applied Arts*
15 *Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933) (“To hold that general
16 configuration made necessary by function must give to a patented design such breadth as to
17 include everything of similar configuration, would be to subvert the purpose of the law, which is
18 to promote the decorative arts. . . .”) (internal citations omitted).¹⁹ Significantly here, “[a] design
19 patent only protects the novel, ornamental features of the patented design.” *OddzOn Prods., Inc.*
20 *v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997). Thus, even if the presence of functional

21 _____
22 ¹⁸ [REDACTED]
23 [REDACTED]
24 [REDACTED]

25 ¹⁹ Apple does not dispute that Mr. Woodring is well aware that design patents do not protect
26 functional design since he unsuccessfully lobbied the Congress and Senate to change that. Tr. of
27 Hearing on SB 791 (100th Congress) before Senate Judiciary Subcomm. on Patents, Copyrights
28 and Trademarks dated March 26, 1987, at 31-33, Zeller Dec. Exh. 6. Transcript of Hearing on
HR 1790 (102nd Congress) before House Judiciary Subcomm. on Intellectual Property and Judicial
Administration dated January 29, 1992, at 79-80, Zeller Dec. Exh. 7.

1 elements in a design patent do not operate to invalidate it in its entirety, they still limit the scope of
2 protection that the patent provides against alleged infringement. Mot. at 16. As the Federal
3 Circuit has mandated, “[w]here a design contains both functional and non-functional elements, the
4 scope of the claim must be construed in order to identify the non-functional aspects of the design
5 as shown in the patent” because “the patentee must show that the perceived similarity is based on
6 the ornamental features of the design.” *Id.* Indeed, cases cited by Apple to the contrary actually
7 agree with Samsung on this score.²⁰

8 Apple’s confusion on the case law also accounts for its erroneous claim that Samsung has
9 to prove that there are “no alternative smartphone or tablet computer designs” in order to show
10 functionality. Opp. at 8.²¹ The pertinent issue on this *Daubert* motion is not patent invalidity
11 due to functionality, but rather Mr. Woodring’s legally impermissible claim construction. It is the
12 patentee’s burden to prove infringement based solely on the ornamental elements of the design
13 patent. *See OddzOn Prods.*, 122 F.3d at 1405 (“[Where] a design contains both functional and
14 ornamental features, the patentee must show that the perceived similarity is based on the
15 ornamental features of the design”). As both Samsung’s and Apple’s authorities hold as shown
16 above, it is also black letter law that design patents can protect against infringement only insofar

17
18 ²⁰ *See, e.g., Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1190 (Fed. Cir. 1988) (for
19 infringement to occur, claimed patents and accused designs “must be equivalent in their
20 ornamental, not functional, aspects.”) (emphasis added); *Egyptian Goddess*, 543 F.3d at 680 (trial
21 courts can aid fact finder in design patent infringement cases by “distinguishing between those
22 features of the claimed design that are ornamental and those that are purely functional.”) (citing
OddzOn Prods, 122 F.3d at 1405 (“Where a design contains both functional and non-functional
elements, the scope of the claim must be construed in order to identify the non-functional aspects
of the design as shown in the patent.”)).

23 ²¹ *Richardson v. Stanley Works, Inc.*, 610 F. Supp. 2d 1046, 1050 (D. Ariz. 2009), cited by
24 Apple purportedly to the contrary, actually supports Samsung. There, certain elements were
25 considered “functional and therefore not protected by the ’167 patent” even though many alternate
26 designs were possible. *Id.* (“[T]he jaw or claw element of the tool can take many different
27 forms.”) On appeal, the plaintiff contested this ruling, asserting exactly the same thing Apple has
28 stated here, that “a design element is purely functional only when the function encompassed by
that element cannot be performed by any other design.” *Richardson v. Stanley Works, Inc.*, 597
F.3d 1288, 1293 (Fed. Cir. 2010). The Federal Circuit disagreed, holding that the district court
had “properly factored out the functional aspects of Richardson’s design as part of its claim
construction.” *Id.*

1 as the individual elements claimed in the patent are primarily ornamental, and not primarily
2 functional, and that similarity of functional elements must be filtered out from the infringement
3 analysis.²² Because functionality is an essential element of the claim construction and
4 infringement inquiries, the law required Mr. Woodring to exclude from his analysis (at the very
5 least) the aspects of the claimed designs that he admitted are functional (Mot. at 18) as well as
6 those product features that Apple likewise has admitted “may enhance the utility” of the product.
7 Opp. at 9. Mr. Woodring's refusal to do so renders his opinions inadmissible under *Daubert*.

8 Contrary to Apple’s assertions (Opp. at 7), Mr. Woodring himself testified at deposition
9 that he was not asked to opine on functionality and for that reason did not include any
10 functionality analysis in his declaration.²³ He simply *assumed* the designs were ornamental
11 because the Patent Office had granted Apple patents.²⁴ Later in the deposition, after his counsel’s
12 repeated objections in an effort to coach him,²⁵ Mr. Woodring realized his error and did an about-

14 ²² Apple additionally fails to furnish any on-point precedent requiring Samsung to prove that
15 no alternative designs exist when conducting an infringement analysis (as opposed to an invalidity
16 one). This is not surprising. Courts recognize that “even elements that are not solely dictated by
17 function are not included in the comparison to the extent they are functional.” *See, e.g., Spotless*
18 *Enterprises, Inc. v. A & E Products Group LP*, 294 F. Supp. 2d 322, 344 (E.D.N.Y. 2003). Thus,
19 “the process of distinguishing the ornamental features is merely a form of claim construction and
20 is distinct from the functionality analysis of invalidity.” *Id.* The cases cited by Apple
21 purportedly to the contrary are inapposite. Opp. at 9 n.2. In *Best Lock Corp. v. Ilco Unican*
22 *Corp.*, 94 F.3d 1563, 1566 (Fed. Cir. 1996), *Avia Group Int’l, Inc., v. L.A. Gear California, Inc.*,
23 853 F.2d 1557, 1563 (Fed. Cir. 1988), and *Hupp v. Siroflec of Am., Inc.*, 122 F.3d 1456, 1460-61
24 (Fed. Cir 1997) — the Federal Circuit dealt with the issue of whether a design patent was invalid
because it was purely functional, not whether and to what extent individual elements were
functional or ornamental. The remaining cases cited by Apple — *Crocs, Inc. v. ITC*, 598 F.3d
1294, 1303 (Fed. Cir. 2010); and *Sun-Mate Corp. v. Koolatron Corp.*, No. CV10-4735-JST
(JCEX), 2011 U.S. Dist. LEXIS 84726, at *8-10 (C.D. Cal. Aug. 1, 2011) — are irrelevant because
they have nothing to do with determining functionality in the infringement context and merely
warn against excessive verbal claim constructions in design patent cases, which is not at issue
here.

25 ²³ Woodring Depo. Tr. at 47:18-49:14, Zeller Dec. Exh. 1.

26 ²⁴ Woodring Depo. Tr. at 46:14-47:14, Zeller Dec. Exh. 1. He later contradicted his earlier
27 testimony claiming he did not just assume that the designs were ornamental because of the Patent
Office. *Id.* at 49:3-5, Zeller Dec. Exh. 1. Rather, he summarily decided it was his opinion that
they were. *Id.*

28 ²⁵ Woodring Depo Tr. at 46:14-49:5, Supp. Zeller Dec. Exh. 1

1 face by claiming he did assess functionality.²⁶ However, no such analysis was in fact done.
2 And, in any event, Mr. Woodring conceded he did not do any investigation or analysis sufficient
3 to conduct a proper functionality analysis.²⁷ Mr. Woodring’s failure to account for functionality
4 — or to undertake a proper functionality analysis — renders his opinion irrelevant to the legal
5 question of substantial similarity of the non-functional design and unreliable by failing to account
6 for the relevant facts. *In re Bextra*, 524 F. Supp. 2d at 1181.

7 **C. Mr. Woodring Is Silent as to the Sophistication of the Ordinary Purchaser**

8 Upon specific examination by Samsung, Mr. Woodring admitted that customers pay more
9 attention and exercise more care when purchasing expensive items²⁸ and that purchasers of
10 smartphones pay attention to differences in designs because they are on the more costly side.²⁹
11 Although he conceded these facts, Mr. Woodring did not factor them in his analysis. Despite the
12 record that Mr. Woodring ignored the sophistication of the purchaser of smartphones and tablet
13 computers in making his proffered ordinary observer opinions, Apple claims that he in fact did.
14 Opp. at 10. Yet, Mr. Woodring’s declaration is conspicuously silent as to the impact the
15 sophistication of the purchaser of smartphones and tablet computers has on the ordinary observer
16 analysis. Moreover, Mr. Woodring had ample opportunity at deposition to assert that he
17 considered the sophistication of the consumer in his analysis — but he did not.³⁰ As a fall-back,
18 Apple argues that Mr. Woodring’s failure to consider these “arguably relevant fact[s]” should
19 merely go to his testimony’s weight. Opp. at 10. In reality, Mr. Woodring’s failure to consider
20 these plainly relevant facts, despite his knowledge of them, makes his opinions regarding ordinary
21 observers unreliable. They should be excluded.

22
23
24
25 ²⁶ Woodring Depo. Tr. at 49:16-50:10, Zeller Dec. Exh. 1.
26 ²⁷ Woodring Depo. Tr. at 49:16-51:5, 51:6-22, 49:16-50:19, 51:6-22, Zeller Dec. Exh. 1.
27 ²⁸ Woodring Depo. Tr. at 188:16-23, Zeller Dec. Exh. 1.
28 ²⁹ Woodring Depo. Tr. at 74:21-75:3, Zeller Dec. Exh. 1.
29 ³⁰ See, e.g., Woodring Depo Tr. at 185:1-186:4, 181:5-182:6, 149:17-151:6, Supp. Zeller
30 Dec. Exh. 1.

1 **D. Apple Improperly Dismisses Significant Differences Between the Samsung**
2 **Products and Apple’s Patented Designs**

3 Contrary to Apple’s assertion, the differences between the accused Samsung products and
4 Apple’s patented designs are not minute, but significant. Mot. at 18-22. Among others, Mr.
5 Woodring wholly ignored obvious differences such as the actual proportions and aspect ratios of
6 the Samsung products as compared to the Apple designs; the multiple navigational icons on the
7 Samsung smartphones; and the placement of ornamentation³¹ on the accused products. These
8 critical differences change the overall impression on the ordinary observer. [REDACTED]

9 [REDACTED]
10 [REDACTED]
11 [REDACTED] Mr. Woodring nevertheless did not account for this in his
12 opinions, but instead simply chose, improperly, to close his eyes to differences that did not
13 advance Apple's cause.

14 Apple also cannot escape the fact that by manipulating the images of the accused Samsung
15 products, Mr. Woodring makes them deceptively appear more similar than they appear to the
16 ordinary observer. As Mr. Woodring admitted, these alterations “mak[e] the comparison an
17 easier one to make.”³³ That, by definition, is not what the ordinary observer encounters. Apple
18

19 _____
20 ³¹ Apple claims, in a throw-away footnote, that logos and trade names do not avoid
21 infringement. Opp. 11, n. 4. That misses the point. Apple has construed its own patents as
22 covering designs that are "substantially free from ornamentation." Woodring Dec. at 5, 6, 8, 10,
23 Zeller Dec. Exh. 4. The presence of surface ornamentation on Samsung's products – including in
24 the form of Samsung logos and trade names – is an obvious difference that would be recognized
25 by the ordinary observer under even Apple's view of its patents. The single authority that Apple
26 cites, *L.A. Gear v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1126 (Fed. Cir. 1993), says nothing to
27 the contrary and involved a significantly different context since the lack of ornamentation was not
28 claimed to be a feature of the asserted designs.

25 ³² Woodring Depo. Tr. at 29:13-31:4, Zeller Dec. Exh. 1; [REDACTED]
26 [REDACTED]
27 [REDACTED]

27 ³³ Woodring Depo. Tr. at 123:23-124:18 (“So to scale the drawings in a design patent to the
28 same scale or size as an accused product simply *makes the comparison an easier one to make.*”) (footnote continued)

1 also did not merely scale the images – but in fact skewed them, changing the proportions of the
2 Samsung phone.³⁴ An ordinary observer comparing the actual product to the patented design
3 would notice the differences, and recognize they clearly differentiate the Samsung products from
4 the claimed patented designs. Mr. Woodring’s analysis must be excluded because he ignores data
5 that makes his analysis both unreliable and inapposite to the facts.

6 Unable to actually defend its conduct, Apple accuses Samsung of submitting inaccurate
7 images. Unlike Apple, Samsung did not manipulate the images in its Opposition to the
8 preliminary injunction motion to create artificial differences, as Apple alleges. Samsung's images
9 were proportionate to the actual size and proportions of the products. And, further refuting
10 Apple's false suggestions, Samsung provided the actual devices at issue to the Court to ensure that
11 the Court could see for itself how the relevant products could look. In contrast, Apple submitted
12 no actual products, but instead merely touted its images of demonstrably altered products, without
13 even disclosing that they were altered.

14 **III. APPLE POINTS TO NO EVIDENCE THAT QUALIFIES MR. WOODRING AS AN**
15 **EXPERT ON THE ORDINARY OBSERVER OF SMARTPHONES AND**
16 **COMPUTER TABLETS**

17 Mr. Woodring has no credentials or experience that qualifies him as an expert on the
18 ordinary observations of the purchasers of smartphones and tablet computers, as his only
19 “experience” is the time he spent working at J.C. Penney 25 years ago. J.C. Penney did not sell
20 any smartphones or tablet computers during the time that Mr. Woodring worked there.³⁵ It did
21 not even sell anything similar to such products, such as flat screen T.V.’s or monitor screens. Mr.

22 _____
23 (emphasis added), Zeller Dec. Exh. 1; *see, e.g.*, Woodring Dec., Ex. 9, 12, 15, 18, Zeller Dec. Exh.
24 4.

25 ³⁴ *Sun Hill Indus. v. Easter Unlimited*, 48 F.3d 1193, 1196-1197 (Fed. Cir. 1995), cited by
26 Apple, did not involve manipulating images to change the proportions of the accused product.
27 There the court was merely faulted for comparing an accused product to the commercial
embodiment of the plaintiff’s patent and finding non-infringement because the former was smaller
than the latter, even though it looked the same. In *Sun Hill*, there was no skewing of an image to
make the comparison easier – as is the case here.

28 ³⁵ *See, e.g.*, Woodring Depo. Tr. at 108:3-5, 185:1-7, Zeller Dec. Exh. 1.

1 Woodring has never designed any phones, let alone smart phones or computer tablets, or any
2 analogous products. Moreover, while Apple claims he studied the behavior of consumers when
3 they shopped for the vague category of “electronics” and conducted interviews and surveys of
4 those shoppers, that was over 25 years ago when no smartphones or tablet computers existed and
5 when Mr. Woodring conceded the retail environment was quite different.³⁶ His observations
6 decades ago are inapplicable to current smartphones and tablet computers. Nor has Apple met its
7 burden of showing, with evidence, that such outdated, inapposite consumer information can be
8 properly extrapolated to today’s consumers of the products at issue in this case. In fact, Mr.
9 Woodring admitted he is not an expert on the reasons why consumers buy iPhones and iPads in
10 particular or smartphones and tablets in general.³⁷ Apple argues that an expert may be qualified
11 to testify based on knowledge and experience alone. Opp. at 13. However, that experience and
12 knowledge must be relevant to the facts at issue.³⁸ Apple touts Mr. Woodring as a great industrial
13 designer. Opp. at 12. However, Mr. Woodring is not offering an opinion on industrial design.
14 He is opining on the ordinary observations of purchasers of smartphones and computer tablets and
15 basing his opinion on experience that is inapplicable. That Mr. Woodring’s testimony has been
16 admitted in other cases on other products does not make his opinions reliable or relevant here.

17
18

19 ³⁶ Woodring Depo. Tr. at 183:1-12, Zeller Dec. Exh. 1.
20 ³⁷ Woodring Depo. Tr. at 81:2-17, 83:1-4, Zeller Dec. Exh. 1. Moreover, Apple does not
21 dispute that Mr. Woodring’s personal experience purchasing electronics is hopelessly limited and
22 insufficient to distinguish him from millions of other consumers. Tellingly, Mr. Woodring’s only
23 experience purchasing smartphones or tablet computers is confined to the products sold by the
24 company paying him for his opinions in this case. Nor does Apple even attempt to defend Mr.
25 Woodring’s incorrect assertion that the mere fact that he is an expert is enough for him to opine on
26 the observations of differences by the ordinary observer of Apple and Samsung’s products. *See,*
27 *e.g.,* Woodring Depo. Tr. at 264:6-21, Zeller Dec. Exh. 1.
28 ³⁸ Apple’s cited cases do not hold otherwise. *Gorham*, 81 U.S. at 531 (crediting testimony
from *non-expert* ordinary observers); *U.S. v. Lopez-Martinez*, 543 F.3d 509, 514-15 (9th Cir.
2008) (expert was qualified to testify in border smuggling case due to 14 years experience as
border patrol agent, 5 of which were in the same area involved in the case); *U.S. v. Laurienti*, 611
F.3d 530, 547-48 (9th Cir. 2010) (expert’s 26 years experience in securities industry with NASD
rules qualified him to testify about those rules).

1 Apple has presented no evidence that qualifies Mr. Woodring as an expert with respect to the
2 ordinary observer of smartphones and computer tablets. His opinions must be excluded.

3 **Conclusion**

4 For the foregoing reasons, Samsung respectfully requests that this Court grant its motion.

5 DATED: September 20, 2011

QUINN EMANUEL URQUHART &
SULLIVAN, LLP

6
7
8 By /s/ Kevin Johnson

Charles K. Verhoeven

Kevin P.B. Johnson

Victoria F. Maroulis

Michael T. Zeller

Attorneys for SAMSUNG ELECTRONICS

CO., LTD., SAMSUNG ELECTRONICS

AMERICA, INC., and SAMSUNG

TELECOMMUNICATIONS AMERICA, LLC