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 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,

CASE NO. 11-cv-01846-LHK

19 Plaintiff,

**SAMSUNG'S NOTICE OF MOTION AND  
 MOTION FOR SUMMARY JUDGMENT**

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,

**Date: June 21, 2012**  
**Time: 1:30 p.m.**  
**Place: Courtroom 8, 4th Floor**  
**Judge: Hon. Lucy H. Koh**

24 Defendants.

PROPOSED PUBLIC REDACTED  
 VERSION

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1 **NOTICE OF MOTION AND MOTION**

2 PLEASE TAKE NOTICE that on June 21, 2012, at 1:30 p.m., or as soon as the matter may  
3 be heard by the Honorable Lucy H. Koh in Courtroom 8, United States District Court for the  
4 Northern District of California, Robert F. Peckham Federal Building, 280 South 1st Street, San  
5 Jose, CA 95113, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung  
6 Telecommunications America, LLC (collectively “Samsung”) shall and hereby do move the Court  
7 pursuant to Federal Rule of Civil Procedure 56 for summary judgment. This motion is based on  
8 the following Memorandum, supporting declarations, the record, and such other matters that may  
9 be presented at or before the hearing on the motion, as well as this Court’s claim construction of  
10 Apple’s design patents, which is expected to leave no material dispute of non-infringement.

11 **MEMORANDUM OF POINTS AND AUTHORITIES**

12 **I. INTRODUCTION**

13 Hundreds of hours of depositions, millions of pages of document production, and dozens  
14 of motions in this action have yielded one unifying fact: Apple’s case fails as a matter of law.  
15 Apple lacks evidence that could create a genuine dispute as to any material fact regarding  
16 Samsung’s entitlement to judgment as a matter of law on Apple’s remaining claims.

17 **II. APPLE’S TRADE DRESS IS INVALID BECAUSE IT IS FUNCTIONAL**

18 The Ninth Circuit long ago rejected Apple’s bid to protect its graphic user interface  
19 elements on the grounds of functionality. *Apple Computer, Inc. v. Microsoft Corp.*, 35 F. 3d  
20 1435, 1444 (9th Cir. 1994) (“[I]conic representation of familiar objects from the office  
21 environment are not protectable ... [GUIs] are a tool to facilitate communication between the user  
22 and the computer ....”). Apple brought that case against its then-leading competitor under  
23 copyright law; this time, it has chosen to rehash those claims and others under the guise of trade  
24 dress. But the same functionality concerns apply with at least equal force in trade dress law and  
25 likewise render Apple’s asserted intellectual property rights invalid. *See, e.g., Tie Tech, Inc., v.*  
26 *Kinedyne Corp.*, 296 F.3d 778, 785 (9th Cir. 2002).

1 Under binding Supreme Court precedent, “trade dress protection may not be claimed for  
2 product features that are functional.”<sup>1</sup> *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532  
3 U.S. 23, 29 (2001) (citations omitted). In trade dress law, functionality is not limited to what is  
4 “dictated by function”; it is defined expansively. It includes utilitarian functionality, which  
5 inquires whether the claimed feature is “essential to the use or purpose of the device or when it  
6 affects the cost or quality of the device.”<sup>2</sup> *Id.* at 33. If the feature is essential to the use or  
7 purpose of the article *or* affects its cost or quality, “the inquiry is over—the feature is functional  
8 and not protected.” *Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d 1062,  
9 1072 (9th Cir. 2006) (citations omitted). There is no need to “proceed further to consider if there  
10 is a competitive necessity for the feature” or “engage ... in speculation about other design  
11 possibilities.” *TrafFix*, 532 U.S. at 33-34. Functionality also includes aesthetic functionality,  
12 which inquires “whether protection of the feature as a trademark would impose a significant non-  
13 reputational-related competitive disadvantage.” *Au-Tomotive Gold*, 457 F.3d at 1072. A design  
14 feature “which, *in itself and apart from its identification of source*, improves the usefulness or  
15 appeal of the object it adorns” is aesthetically functional. *Id.* at 1073. Thus, if a design feature  
16 has “intrinsic aesthetic appeal,” it cannot be monopolized as trade dress. *Id.* Apple’s asserted  
17 trade dresses serve unquestionably utilitarian purposes. Even if not, however, Apple itself has  
18 strenuously argued that they are aesthetically appealing. *E.g.*, Amended Compl. ¶¶ 1, 3, 4; Ex.

19  
20

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21 <sup>1</sup> The rule broadly prohibiting the appropriation of functional features as trade dress stems  
22 from “a fundamental right to compete.” *Tie Tech*, 296 F.3d at 785. “The functionality doctrine  
23 prevents trademark law, which seeks to promote competition by protecting a firm’s reputation,  
24 from instead inhibiting legitimate competition by allowing a producer to control a useful product  
25 feature.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164-65 (1995). This is because  
26 “copying is not always discouraged or disfavored by the laws which preserve our competitive  
economy. . . . Allowing competitors to copy will have salutary effects in many instances.”  
*TrafFix Devices*, 532 U.S. at 29. Accordingly, the Court has cautioned “against misuse or over  
extension of trade dress.” *Id.*

27 <sup>2</sup> A product feature or combination of features “need only have *some* utilitarian advantage  
28 to be considered functional,” not necessarily “*superior* utilitarian advantages.” *Disc Golf Ass’n,  
Inc. v. Champion Discs, Inc.*, 158 F. 3d 1002, 1007 (9th Cir. 1998).

1 48<sup>3</sup> (Urbach Report ¶¶ 21, 28, 33; 44,45); Ex. 49 (Winer Report ¶ 82-86)).

2 **A. The iPad and iPhone Trade Dresses Are Indisputably Functional Under The**  
3 **Doctrine Of Utilitarian Functionality**

4 Apple carefully defined its asserted trade dresses to sound similar to the Samsung's  
5 products, so it excluded such features as the Apple logo, the Apple name, or the "home" button.  
6 Apple bears the burden of proving non-functionality of its limited trade dresses,<sup>4</sup> but it has  
7 proffered no evidence that any of the features of its claimed trade dresses do not "affect the cost or  
8 quality" of the iPhone and iPad.<sup>5</sup> *TrafFix*, 532 U.S. at 33-34. [REDACTED]

9 [REDACTED]  
10 [REDACTED]  
11 [REDACTED]  
12 [REDACTED] For trade dress purposes, this confirms functionality. *See Disc Golf Ass'n*, 158 F. 3d at  
13 1007. As shown below, everything that Apple claims is part of its trade dresses is functional.

14 **Trade Dress Element Identified In Amended Complaint - iPhone (Original)**<sup>6</sup>

15 *Rectangle with evenly rounded corners:*

16 <sup>3</sup> All cites to "Ex." are cites to the Declaration of Brett Arnold, submitted herewith, and the  
17 paragraphs of that declaration that contain the reference to the exhibit.

18 <sup>4</sup> Apple bears the burden of proving that its unregistered trade dress is not functional. 15  
19 U.S.C. §1125(a)(3). For claims under 15 U.S.C. §1114, Samsung may rebut the evidentiary  
20 presumption afforded the registration by a preponderance of the evidence, which eliminates the  
21 evidentiary significance of Apple's registrations and shift the burden back to Apple to prove that  
22 its trade dress is not functional. *See Talking Rain Beverage Co. v. South Beach Beverage Co.*,  
23 349 F.3d 601, 603 (9th Cir. 2003).

24 <sup>5</sup> Apple's sole proffered "evidence" of non-functionality, as articulated by its experts, is that  
25 Samsung could have employed alternate designs. However, for utilitarian functionality, the  
26 existence of alternatives does nothing to undermine the functionality identified by Samsung; it is  
27 legally irrelevant. *E.g., TrafFix*, 532 U.S. at 33-34. In any event, the proposed "alternatives"  
28 identified by Apple are functionally different from the iPhone and/or iPad and accordingly are not  
true alternatives. *See Leatherman*, 199 F. 3d at 1013-14 (noting that claimed alternative designs  
must offer "exactly the same features" as the plaintiff's product). Rather, each has one or more  
attributes that makes it less useful to consumers and/or more difficult or costly to manufacture  
than the iPhone and/or iPad, such as a smaller screen, a physical keyboard, less rounded corners, a  
bulkier form factor, buttons on the front surface, and/or a visually cluttered front face, which  
distracts from the display screen. Ex. 66 (Bressler Report ¶¶ 331-341); [REDACTED]).

<sup>6</sup> *See Amended Compl. ¶¶ 32, 49, 57.*



1 • Rounded corners make a device more comfortable to hold and easier to pick up when it is  
2 lying on a flat surface. Ex. 51 (APLND0003040119-124); Ex. 74 (Sherman Rpt. pp. 89,  
97); Ex. 75 (Lehto Rpt. p. 8); [REDACTED]

3 [REDACTED]  
4 [REDACTED]

4 • Rounded corners are mechanically stronger than sharp ones. Ex. 74 (Sherman Rpt. p. 90)

5 • It is easier, more reliable, and less expensive to manufacture clean and accurate corners  
6 that are rounded versus sharp. Ex. 74 (Sherman Rpt. p. 90).

7 *Flat clear surface covering front:*

8 • A flat front surface enables the user's fingers to slide easily over the active area of the  
9 display and efficiently execute actions such as scrolling and selecting text. In contrast, if  
10 the display area was surrounded by a raised edge or abutted by physical buttons, the user's  
11 fingers would be more likely to bump against those elements, reducing the ease of  
12 operating the touch screen. Ex. 74 (Sherman Rpt. p. 90); Ex. 75 (Lehto Rpt. p. 8).

12 • The absence of other physical design elements, such as physical buttons, contrasting  
13 surfaces, and even other surface ornamentation, eliminates visual distractions and clutter  
14 that can detract from the user's access to the touch screen and experience of using it. Ex.  
15 53 (Apple Utility Patent No. 7,768,462, col. 4, line 53); Ex. 3 ([REDACTED])  
16 [REDACTED] Ex.75 (Lehto Rpt. p. 8); Ex. 74(Sherman Rpt. p. 91).

15 • A smooth front surface allows the user to wipe the screen clean without bumping into, or  
16 lodging dust or dirt into, crevices and gaps created by physical buttons and keyboards and  
17 the contact area between two different surfaces. Ex. 75 (Lehto Rpt. p. 8); Ex. 74 (Sherman  
18 p. 90); [REDACTED]  
19 [REDACTED]

18 • Flat glass is less costly and less difficult to manufacture and is more scratch resistant than  
19 plastic. Ex. 11 ([REDACTED])  
20 [REDACTED]  
21 [REDACTED]

22 • A flat glass surface affects the performance of touch sensors to work well. Ex. 74  
23 (Sherman Rpt. p. 94); [REDACTED]

24 *Large display screen under clear surface:*

25 • A proportionally large screen enhances media viewing and facilitates the input of touch  
26 commands by providing more room for error in making touch commands. [REDACTED]  
27 [REDACTED]  
28 [REDACTED]

28 • A clear front surface protects the screen and allows it to be visible. Ex. 74 (Sherman Rpt.

1 pp. 91, 94).

2 *Black color:*

- 3 • It is less costly to manufacture smartphones with black surfaces. [REDACTED]  
4 [REDACTED]  
5 [REDACTED]

6 *Substantial black borders above/below display:*

- 7 • The wide, opaque borders at the top and bottom of the screen, [REDACTED]  
8 [REDACTED] hide components necessary to the operation of the touch screen sensors, as well as  
9 the antennae, speaker and receiver and accommodate the iPhone home button. Ex. 54  
10 [REDACTED]  
11 [REDACTED]
- 12 • The receiver and speaker components are most effective if aligned with the receiver hole,  
13 which is most logically placed near the top of the device, leaving the lower portion for the  
14 antennae components. [REDACTED]
- 15 • Opaque borders provide an area where users' fingers and thumbs can safely hold and touch  
16 the device without triggering the active display area of the screen. [REDACTED]  
17 [REDACTED]

18 *Narrower black borders on either side of display [in addition to reasons above]:*

- 19 • The side borders protect the fragile display screen from damage in the event the phone is  
20 dropped or hit. [REDACTED] Ex. 74 (Sherman p. 98).
- 21 • The side borders cannot be eliminated because components that enable the touch  
22 technology to work must surround the display screen. [REDACTED]  
23 [REDACTED] Ex. 74 (Sherman pp. 91, 98).

24 *Metallic bezel around flat clear surface:*

- 25 • The bezel provides structural support, joins and holds the front and back pieces of the  
26 device, and protects the display screen and cover from side impacts and drops. Ex. 62  
27 (SAMNDCA00366492-366517, Apple's US Patent Nos. 7,688,574, column 7, lines 53-  
28 64); Ex. 74 (Sherman Rpt. p 102); [REDACTED]  
[REDACTED]  
[REDACTED]

29 *Matrix of colorful square icons with evenly rounded corners:*

- 30 • Icon matrixes provide an organizing structure for quickly and easily locating icons. [REDACTED]  
31 [REDACTED]; Ex. 75 (Lehto Rpt. p. 22-23); Ex. 76 (Lucente Rpt. p. 16-17).
- 32 • The rounded rectangular shape of the icons evoke the shape of buttons or keys on a

1 physical keypad and signal to the user that the icons should be pressed. [REDACTED]  
2 [REDACTED] Ex. 76 (Lucente Rpt. p. 18); Ex. 75 (Lehto Rpt. p. 24).

- 3 • Each individual icon, including its graphical elements and colors, serves as a “a visual  
4 shorthand to communicate an idea or some kind of information that in an application is  
5 represented with a visual to identify it at a glance.” [REDACTED]  
6 [REDACTED] Ex. 76 (Lucente Rpt.pp. 25-30); Ex. 75 (Lehto pp. 25-26);

7 *Bottom row (“dock”) of colorful square set off from other icons which does not change as other  
8 pages are viewed:*

- 9 • The dock enables users to easily access the most frequently used icons from each page. [REDACTED]  
10 [REDACTED]; Ex. 76 (Lucente Rpt. p. 17).
- 11 • The placement of the dock at the bottom of the screen makes one-handed use more  
12 convenient. [REDACTED] Ex. 76 (Lucente Rpt. p. 17-18).

13 **Trade Dress Element Identified In Amended Complaint - iPhone 3G** (in addition to all  
14 elements asserted for iPhone trade dress) (*See* Amended Compl. ¶¶ 35, 59.)

15 *A row of small dots on the display screen when the device is turned on:*

- 16 • This row of dots informs the user which page of the multi-page interface they are viewing.  
17 [REDACTED]; Ex. 76 (Lucente Rpt. p. 25); Ex. 75 (Lehto Rpt. p. 30).

18 **Trade Dress Element Identified In Amended Complaint – iPad/iPad2** (in addition to  
19 overlapping elements asserted for iPhone trade dress) (*See* Amended Compl. ¶¶ 44, 65, 67.)

20 *Metallic rim around flat clear surface:*

- 21 • The metallic rim around provides structural integrity. Ex. 75 (Lehto Rpt p. 37).

22 Although trade dress must be viewed as a whole, “where the whole is nothing other than  
23 the assemblage of functional parts, and where even the arrangement and combination of the parts  
24 is designed to result in superior performance, it is semantic trickery to say that there is still some  
25 sort of separate ‘overall appearance’ which is non-functional.” *Leatherman Tool Group, Inc. v.*  
26 *Cooper Indus., Inc.*, 199 F. 3d 1009, 1013 (9th Cir. 1999). The record reveals that the elements  
27 are configured as they are to *optimize the functionality* of the devices. The use of most or all of  
28 the claimed design features in the same or similar configuration by numerous smart phones and  
tablets on the market today further confirms functionality. *See* Ex. 74 (Sherman Rpt., Ex. C)).

Moreover, when viewed together, the individual functional elements identified by Apple  
cannot give rise to protectable trade dress. The entirety of the iPhone and iPad trade dresses

1 defer to their display screens by putting the primary emphasis on them and not doing anything to  
2 distract attention from the display. [REDACTED]  
3 [REDACTED]; Ex. 65 (*Objectified* (2009)). Because the display screen is the  
4 primary means by which users interact with these devices—i.e., the *raison d’etre* for the  
5 products—these overall configurations indisputably affect the quality of the articles.

6 **B. The iPad and iPhone Trade Dresses Are Indisputably Functional Under The**  
7 **Doctrine Of Aesthetic Functionality**

8 The aesthetic functionality doctrine prohibits monopolization of aesthetic features that in  
9 and of themselves contribute to consumer sales, as compared to features that have a pure source  
10 identifying function and do not otherwise cause consumers to purchase the product. *See Tie*  
11 *Tech*, 296 F.3d at 785; *Au-Tomotive Gold*, 457 F.3d at 1072. Thus, to the extent that the  
12 appearance of Apple’s claimed trade dresses contribute to consumer sales as Apple maintains, they  
13 are not protectable as trade dress as a matter of law. *E.g., Pagliero v. Wallace China Co*, 198  
14 F.2d 339 (9th Cir. 1952) (china pattern was functional because “the attractiveness and eye appeal”  
15 were “at the heart of basic consumer demand for the product”).

16 Apple has claimed repeatedly that the design-related attributes of the iPhone and iPad  
17 contribute to their market success. Amended Compl. ¶ 1, 3, 4; Ex. 48 (Urbach Report ¶¶ 21, 28,  
18 33; 44,45); Ex. 49 (Winer Report ¶ 82-86). [REDACTED]

19 [REDACTED]  
20 [REDACTED]  
21 [REDACTED]  
22 [REDACTED]  
23 [REDACTED] Apple’s  
24 position that the otherwise functional elements of its trade dress are somehow transformed into  
25 source identifiers because they are aesthetically pleasing is at odds with the law. To the contrary,  
26 if the “elegant design” of Apple’s products makes them more appealing to consumers, than it *may*  
27 *not* be exclusively appropriated under trademark law. *See Tie Tech*, 296 F.3d 778, 785 (“features  
28 which constitute the actual benefit that the consumer wishes to purchase” were not protectable);

1 *Aurora World Inc. v. Ty, Inc.*, 719 F. Supp.2d 1115, 1149, (C.D. Ca. 2009) (holding that aesthetic  
2 features of plush toys were functional because they are “essential selling features of the toys”).

3 **III. APPLE’S DILUTION CLAIM SHOULD BE DENIED BECAUSE IT CANNOT**  
4 **PROVE THAT THE ASSERTED TRADE DRESSES ARE FAMOUS**

5 Because protection from dilution comes close to being a “right [] in gross,” it is a cause of  
6 action “reserved for a select class of marks—those marks with such powerful consumer  
7 associations that even non-competing uses can impinge on their value.” *Avery Dennison Corp. v.*  
8 *Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999). To prevail on its dilution claims, Apple must prove  
9 that the trade dresses it claims here—which do not include the Apple logo, the Apple name, or the  
10 “home” button—are “widely recognized by the general consuming public of the United States as a  
11 designation of source of the goods or services of the mark’s owner.” 15 U.S.C. § 1125(c)(2)(A).  
12 The level of recognition required is exceptionally high: the trade dress must be so famous that it is  
13 a “household name.” *See Thane Int., Inc., v. Trek Bicycle Corp.*, 305 F.3d 894, 911 (9th Cir.  
14 2002). The Ninth Circuit has rejected evidence of awareness of even 65% of the general U.S.  
15 consuming public as sufficient to show fame and rejected that “Nissan” and “Avery Dennison” are  
16 famous marks. *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1014 (9th Cir.  
17 2004); *Avery Dennison*, 189 F.3d 868. Although it bears the burden of doing so, Apple failed to  
18 produce evidence sufficient to support a finding of the required fame in its limited trade dresses.

19 **Survey evidence.** Apple’s own survey evidence, proffered by Hal Poret, proves that the  
20 recognition levels for the limited trade dresses Apple is claiming, without the Apple logo or name  
21 or home button, are too low to prevail on its claims. Samsung disputes that Mr. Poret’s numbers  
22 are valid, reliable, or derived from an appropriate survey universe, which would have been the  
23 general U.S. consuming population instead of the more tech-savvy subset actually surveyed.<sup>7</sup>

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24  
25 <sup>7</sup> Ex. 69 (Poret Tr. at 133:8-19.) Consumers surveyed for the iPhone study had purchased  
26 a mobile phone in the past 12 months or were likely to do so in the next 12 months, or own a  
27 mobile phone that they purchased more than a year ago or that was purchased for them. Ex. 70  
28 (Poret Rpt. p. 35). Consumers surveyed for the iPad study had purchased a tablet in the past 12  
months or were likely to in the next 12 months or had purchased a mobile phone or  
(footnote continued)

1 However, Poret’s numbers represent the absolute high-water mark of Apple’s evidence of fame,  
2 and they fall short, revealing that not even 60% of those surveyed were aware of the limited iPad  
3 or iPhone trade dress Apple is claiming. *Id.* Even if this were a survey of the general public,  
4 Apple’s results are too low to establish fame. *E.g., Nissan Motor*, 378 F.3d at 1014; 4 MCCARTHY  
5 ON TRADEMARK at § 24:106, 24-310 (2008 ed.) (“[M]inimum threshold survey response should be  
6 in the range of 75% of the general consuming public of the United States.”).

7 **Advertising.** Nor can Apple’s advertising carry its burden because it does not promote  
8 the *as-claimed* trade dresses. To be probative of fame, a plaintiff’s advertising must not merely  
9 depict the product, but “must *feature* in some way the [claimed] trade dress itself.” *First Brands*  
10 *Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1383 (9th Cir. 1987) (finding that plaintiff’s advertising  
11 did not *stress* the color and shape of the bottle); *see also Autodesk, Inc., v. Dassault Systems*  
12 *Solidworks Corp.*, 685 F. Supp. 2d 1001, 1014 (N.D. Cal. 2009) (advertising that showed the  
13 claimed trade dress was not probative because it did not stress it “in a manner that would support  
14 an inference of secondary meaning”). Apple cannot point to any advertising that promotes its *as-*  
15 *claimed* trade dresses as source identifiers, or urges consumers to “look for” specific elements of  
16 those trade dresses. *See First Brands*, 809 F.2d at 1383. Rather, Apple’s ads focus on product  
17 functionality, and many do not even show the entire asserted trade dress.<sup>8</sup> In addition, Apple  
18 does not market the iPhone and iPad to the general U.S. public, but targets a narrow subset of  
19 consumers who are not only tech-savvy, but are able to afford the substantial cost of these devices.  
20 Ex. 73 (Winer Rpt. ¶¶ 95-97). This subset of consumers was likely even more select at the time  
21 the first accused Samsung product was first released—i.e., the only time relevant to the issue of  
22 fame. *See Horphag Research Ltd. v. Garcia*, 475 F. 3d 1029, 1036 (9th Cir. 2007).

23  
24 notebook/laptop computer in the past 12 months or were likely to do so in the next 12 months.  
25 Ex. 70 (Poret Rpt. p. 36).

26 <sup>8</sup> *See, e.g.,* iPhone 3G “Touching is Believing” print advertisements featuring a hand  
27 scrolling through various apps not claimed by Apple’s asserted trade dress. *See Ex. 71*  
28 (APLNDC00000114 – 118 (Album covers from “Music” app), APLNDC00000119 (“Maps” app),  
APLNDC00000120 (NYT from “Safari” app), APLNDC00000121 (Email message from “Mail”  
app), APLNDC00000122 (chat conversation from “Messages” app)) (APLNDC00000114-22);  
*see also Ex. 72a-i* (“There’s an app for that” campaign, focusing on applications not pre-installed).

1 Because Apple lacks sufficient evidence that would support a finding of fame under the  
2 dilution law, Samsung is entitled to summary judgment in its favor on Apple’s dilution claim.

3 **IV. APPLE’S DESIGN PATENTS ARE INVALID**

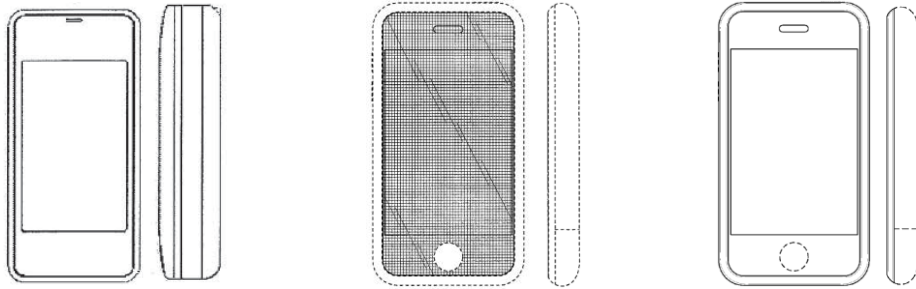
4 Apple’s design patents are invalid in light of prior art. The record has now been  
5 developed far more than the preliminary injunction record to which the Federal Circuit limited its  
6 opinion. *Apple v. Samsung*, 2012-1105, at 31 n.6 (Fed. Cir. May 14, 2012); *see also Glaxo*  
7 *Group Ltd. v. Apotex, Inc.*, 376 F.3d 1339, 1346 (Fed. Cir. 2004) (“An appellate court’s  
8 preliminary injunction opinion has no conclusive bearing at the trial ...”). Hundreds of hours of  
9 deposition testimony and new prior art references leave no material dispute that Apple’s remaining  
10 design patents were obvious at their alleged conception. *See, e.g., Ex. 74* (Sherman Decl. Ex. B).

11 Obviousness is a less stringent standard than anticipation and infringement, which are  
12 mirror images. *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003)  
13 (“[T]hat which would literally infringe if later in time anticipates if earlier.”) If several  
14 references would have been combined by a designer of ordinary skill in the art to disclose the  
15 design, the patent is invalid as obvious. 35 U.S.C. § 103(a); *Durling v. Spectrum Furniture Co.*,  
16 101 F.3d 100, 103 (Fed. Cir. 1996); *LA Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 117, 1124  
17 (Fed. Cir. 1993) ( person skilled in the art is “presumed to have perfect knowledge of all pertinent  
18 prior art”). The obviousness analysis begins with a primary reference that has “basically the  
19 same” design characteristics as the claimed design. *Durling*, 101 F.3d at 103. Secondary  
20 references may “be used to modify it to create a design that has the same overall visual appearance  
21 as the claimed design” if the references are sufficiently related that “the appearance of certain  
22 ornamental features in one would suggest the application of those features to the other.” *Id.*

23 **A. The D618,677 and D593,087 Patents Are Obvious.**

24 Both D’677 and D’087 are obvious in light of prior art. Apple’s inventors and expert  
25 testified that [REDACTED]

1 [REDACTED] Although the Federal Circuit’s opinion said JP’638 alone  
 2 did not *anticipate* D’087 due to the contour in the side view, *see* No. 2012-1105 at 23, the design  
 3 properly serves as a primary reference for obviousness because it creates basically the same visual  
 4 impression but for that one difference. *See In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996).



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10 **JP 1241638** (Ex. \_4, Issued June 2005)    **D618,677** (Ex. 5)    **D593,087** (Ex. 6)

11 Numerous secondary references that Apple did not disclose to the PTO teach both a flat,  
 12 flush, continuous surface and a black front face, showing that it would have been obvious to a  
 13 designer skilled in the art at the alleged invention date to modify the JP’638 design with these  
 14 features. *See Durling*, 101 F.3d at 103. Shown below are few of those references (of which  
 15 only the LG Chocolate was part of the preliminary injunction record):



16  
17  
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21  
22 **JP 1204221**    **iRiver U10 MP3 Player**    **LG Chocolate**    **Nokia Fingerprint Concept**  
 (Issued May 2004)    (Released late 2005)<sup>10</sup>    (Released March 2006)    (Public in 2004)<sup>11</sup>  
 23 Ex. 7.    Arnold Decl. ¶ 12    | Arnold Decl. ¶ 13    Ex. 10

24 As these references show, using black on the front of an electronic device was common at the time

25 \_\_\_\_\_  
 26 <sup>9</sup> [REDACTED]  
 27 [REDACTED]  
 28 [REDACTED]



1 D'087 and D'677 were allegedly conceived on April 20, 2006. [REDACTED]  
2 [REDACTED]  
3 [REDACTED]  
4 [REDACTED]  
5 [REDACTED]

6 [REDACTED]. The file history for D504,889, which became public in  
7 2005, also included photos Apple submitted of a mockup that used black on the front surface:<sup>10</sup>

8 Many combinations of prior art render the D'677 obvious, including using the iRiver or  
9 Nokia Fingerprint Concept as a primary reference and the JP 1204221 or LG Chocolate, which  
10 both disclose oblong shapes and less rounded edges than the Nokia Fingerprint Concept, as a  
11 secondary reference. Likewise, the JP 1204221, which discloses all the elements of the D'677,  
12 but has slightly less narrow side borders and a barely perceptible circular element to the left of the  
13 oblong shape (as does the iPhone 4), properly serves as a primary reference, combined with  
14 JP'638, which is very similar to D'677 on those two elements. Given the sparse "design  
15 elements" in each of these minimalist prior art designs, slight variations on each of those elements  
16 were obvious to those of ordinary skill in the art. *See Durling*, 101 F.3d at 103 (noting that  
17 where obviousness references are similar, they suggest application of features one to another).

18 Further, to overcome an obviousness rejection, Apple claimed that the D'677 design was  
19 distinct from the prior art solely because it disclosed "a substantially continuous transparent  
20 surface on an electronic device and the substantially smooth or flush transition between the display  
21 screen and the rest of the front face of the device" (*see* Ex. 16 at APLPROS0000011936)—one of  
22 the very features Apple has asserted the D'889 patent, filed in 2004 and published in 2005,  
23 disclosed.<sup>11</sup> The D'889 is unquestionably a proper secondary reference. Like the D'087 and  
24

25 \_\_\_\_\_  
26 <sup>10</sup> Ex. 13 (photos from file history); [REDACTED]  
[REDACTED]; Ex. 15 (photos of the actual mockup pictured in the D'889 file history).

27 <sup>11</sup> *See* Ex. 2, 2/15/12 Stringer Tr. at 365:21-366:6; Ex. 1, 8/5/2011 Woodring Tr. at 280:8-14.  
28 Samsung does not believe this is what the D'889 discloses, but if its claim construction is not  
(footnote continued)

1 D'677, it is for an “electronic device,” and Apple cited it to the PTO as prior art for both patents.<sup>12</sup>  
2 The same fourteen people named as inventors on D'889 are also named inventors of D'087 and  
3 D'677 and were thus aware of their own earlier design. And Apple's expert, Peter Bressler,  
4 testified that [REDACTED]

5 [REDACTED].<sup>13</sup>

6 The D'087 design is similarly obvious. It differs from the D'677 primarily in the  
7 presence of a bezel and the lack of the color black, which the KR 30-0398307 (issued November  
8 15, 2005) and the Bluebird Pidion BM-200 (released 2005) show. Ex. \_\_, \_\_.



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13  
14 **KR 30-0398307** (Ex.19)      **Bluebird Pidion BM-200**<sup>14</sup> (Arnold Decl. ¶ 24)

15 The bezel of either of these references combined with JP'638, JP'221, or iRiver yields an  
16 invalidating design with the “same overall visual appearance” as D'087. See *Durling*, 101 F.3d  
17 at 103.<sup>15</sup> As a matter of law, this renders the D'087 obvious.

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24 accepted, Apple is estopped from disputing that the D'889 discloses a flat, continuous surface  
25 from edge to edge.

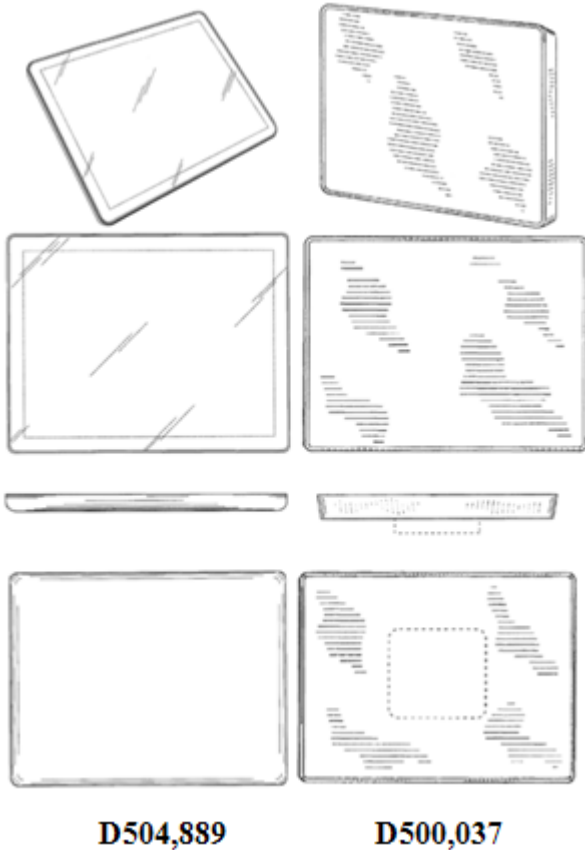
26 <sup>12</sup> See Ex. 17 at APLPROS0000010467 (D'087); Ex. 16 at APLPROS0000011784 (D'677).

27 <sup>13</sup> Ex. 18, 4/23/2012 Dep. of Peter Bressler at 180:20-181:16, 182:11-20, 184:3-8.

28 <sup>14</sup> Ex. 20, 3/8/2012 Dep. of Sungyub Lee at 8:24-27:25 and Dep. Exs.

<sup>15</sup> D'087 is invalid if any of its embodiments is obvious. See *In re Klein*, 987 F.2d 1569,  
1570 (Fed. Cir. 1993). Embodiment 2 claims only the internal rectangle, like the iRiver U10.

1 **B. The D504,889 Patent Is Obvious.**



D’889 is also invalid in view of prior art that was not in the preliminary injunction record. (Ex. 21 (D’889).) U.S. patent D500,037 shows the design for a “bezel-less flat panel display” that was filed a year before D’889’s alleged conception.<sup>16</sup> (Ex. 22.) D’037 has nearly the same rectangular shape with a transparent and/or reflective surface running from edge to edge on the front of the device with no interruptions, giving the same “unframed” impression as D’889.<sup>17</sup> D’037 is also symmetrical and smooth in all views and has a relatively thin profile. Because it creates the same basic visual

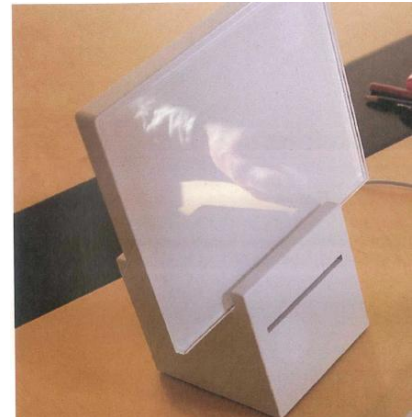
appearance as D’889, it is a proper primary reference.

In addition, the “Brain Box” display shown to the right is an Apple design made public at least as early as 1997.<sup>18</sup>

As Apple witnesses acknowledged, [REDACTED]

[REDACTED]<sup>19</sup>

The Brain Box display shows a profile more similar in



22  
23 <sup>16</sup> Apple alleges a conception date of Sept. 3, 2003. Ex. 23, at 7.

24 <sup>17</sup> The optional mask region on the front of D’889 is also shown in D’037. Figure 3 of the patent shows the mask underneath the continuous, transparent cover piece, and the accompanying utility patent confirms a mask under the top transparent layer surrounding the active display area. See Ex. 24, U.S. Patent 6,919,678 at column 5, line 53 to column 6, line 31.

25 <sup>18</sup> The image is from *AppleDesign* by Paul Kunkel (1997). (Ex. 25 at 144.)

26 <sup>19</sup> Ex. 11, Feb. 9, 2012 Dep. of Douglas Satzger at 153:5-156:21 and Dep. Ex. 8. A named  
27 inventor of D’889 testified [REDACTED]  
28 [REDACTED] in which the design was published. *Id.*

1 proportion to the D'889 in terms of thickness and shape than D'037, and in combination, they  
2 create the same overall visual appearance as D'889, with either serving as the primary or  
3 secondary reference to the other.<sup>20</sup> “[T]he scope and content of the prior art” thus demonstrate  
4 that “the level of ordinary skill in the art” was sufficient, and likely, to result in the design of  
5 D'889 at the time of its alleged invention.<sup>21</sup> *Crocs, Inc. v. ITC*, 598 F.3d 1294, 1308 (Fed. Cir.  
6 2010); *see also KSR*, 550 U.S. at 417.

7 **C. D604,305 and D617,334 Are Anticipated And Obvious**

8 A design is unpatentable if it was known or described in a printed publication before its  
9 invention by the applicant. 35 U.S.C. § 102(a). Apple allegedly conceived of D'305 and D'334  
10 no earlier than April 26, 2007. (Ex. 23 at 9.) Images of the iPhone shown to the public on  
11 January 9, 2007, and that were immediately published, anticipate these patents, or at least renders  
12

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13  
14 <sup>20</sup> Both of these display devices are appropriate obviousness references because D'889 claims  
15 broadly it is an “electronic device” and the file history shows that the design corresponded to both  
16 a tablet device and a display or screen that could be coupled to a computing device. Ex. 26 at  
17 APLPROS0000010190, File Wrapper for D504,889. But these are not the only prior art  
18 references that taught flat, uninterrupted front and back surfaces on a rectangular shape with  
19 rounded corners and a thin profile. *See* Ex. 27 (JP1178470); Ex. 28 (KR 30-0304213); Ex. 24.  
20 In addition, among his other designs, inventor Roger Fidler testified that in 1981 he created a  
21 tablet design that was rectangular with four evenly rounded corners, a flat clear surface running  
22 from edge to edge, no physical buttons, and a thin form factor. (Ex. 29, 9/23/2011 Dep. of Roger  
23 Fidler at 290:22-299:10 and Dep. Ex.). These additional references confirm that these features  
24 were obvious prior to the alleged conception of D'889.

25 <sup>21</sup> The D'889 patent is also invalid due to indefiniteness because its figures are ambiguous  
26 and leave the scope of the design open to conjecture. 35 U.S.C. § 112; *see also Seed Lighting*  
27 *Design Co., Ltd. v. Home Depot*, 2005 WL 1868152, \*8 (N.D. Cal. Aug. 3, 2005); *Ultimax*  
28 *Cement Mfg. Corp. v. CTS Cement Mfg. Corp.*, 587 F.3d 1339, 1352 (Fed. Cir. 2009) (“Claims are  
considered indefinite when they are not amenable to construction or are insolubly ambiguous.”).  
Ex. 38 (11/21/11 De Iuliis Tr. 188:24-190:10); Ex. 39 10/31/11 (Howarth Tr. 100:9-13; 104:13-  
105:10); Ex. 40 (11/27/11 Coster Tr. 29:3-30:21); Ex. 43 (10/24/2011 Rohrbach Tr. at 99:6-  
102:25), Ex. 39 (10/31/11 Howath at 92:18-96:7), Ex. 41 (11/27/11 Kerr Tr. 27:19-28:25); Ex. 42  
(10/31/11 Zorkendorfer Tr. at 44:18-65:11; Ex. 43, 10/24/11 Rohrbach Tr. at 95:11-109:20;  
115:25-116:13; Ex. 44, 10/27/11 Whang Tr. at 72:21-78:25; Ex. 40, Coster Tr. at 12:4-6; 31:9-  
32:4; 36:5-37:6; Ex. 41, Kerr Tr. at 26:24-28:25; Ex. 39, Howarth Tr. at 92:19-113:6; 270:19-  
284:16; Ex. 45, 11/8/11 Satzger Tr. at 31:20-23; 37:5-38:1; Ex. 3, 12/1/11 Ive Tr. at 155:7-10;  
160:7-162:19; Ex. 46, 2/8/12 (ITC) Howarth Tr. at 162:7-166:4; Ex. 47, 2/23/12 (ITC) Rohrbach  
Tr. at 111:12-116:14). Samsung will address this further at claim construction.

1 them obvious.<sup>22</sup>



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7 **Jan. 9, 2007 Press Release**



8 **D'305**



9 **D'334**

10 The January 9, 2007 design differs slightly from D'305 and D'334, with different numbers  
11 and placements of icons, for example. [REDACTED]

[REDACTED]

[REDACTED] This anticipates the D'305 and D'334.

12 **D. The D'334 Patent Is Invalid Due To The On-Sale Bar**

13 The on-sale bar applies when two conditions are satisfied: (i) the product is offered for sale  
14 more than a year prior to the filing date; and (ii) the invention is ready for patenting before its  
15 filing date. *Pfaff v. Wells Elecs*, 525 U.S. 55, 67 (1998). By June 29, 2007, Apple had not only  
16 announced the iPhone, it was offering it for sale in the U.S.<sup>23</sup> These sales occurred more than a  
17 year before July 15, 2008, when Apple filed the application for D'334. Because, [REDACTED]  
18 [REDACTED] an ordinary observer would find the design in the D'334 patent substantially  
19 the same as the design in the D'305 patent,<sup>24</sup> which Apple claims was embodied in the original  
20 iPhone,<sup>25</sup> these sales trigger the on-sale bar and invalidate the D'334 patent. *See* 35 U.S.C.  
21 § 102(b); *Pfaff v. Wells Elecs*, 525 U.S. at 67.

22  
23 \_\_\_\_\_

24 <sup>22</sup> *See* Ex. 31 (www.apple.com/iphone/, as visited Jan. 11, 2007 by web.archive.org); Ex. 17 at  
25 APLPROS0000010469, APLPROS0000010479-481 (printout from www.gsmarena.com on  
26 March 12, 2007, included in Apple's application for D'087).

27 <sup>23</sup> *See* Ex. 37, at 2, [REDACTED]

28 <sup>25</sup> *See* Ex. 37, at 2.

1 **V. APPLE’S UTILITY PATENTS ARE INVALID OR NOT INFRINGED**

2 Apple asserts four claims from the following touch screen patents: U.S. Patent Nos.  
3 7,844,915 (claim 8), 7,864,163 (claim 50), 7,469,381 (claim 19), and 7,663,607 (claim 8). As  
4 explained below, the undisputed evidence shows that these claims are not infringed or invalid.

5 **A. Claim 8 Of The '915 Patent Is Not Infringed**

6 Claim 8 of the '915 patent describes a computer-based method for distinguishing between  
7 scroll and gesture operations. Ex. 85 ('915 patent). The claim requires a particular operation:  
8 “determining whether the *event object invokes* a scroll or gesture operation.” Thus, the “event  
9 object” (not some other object) must “invoke” the scroll or gesture operation.

10 In claim 8, “object invokes” means “the object calls a method or function.” Gray Decl.

11 ¶ 21. The [REDACTED]  
12 [REDACTED]  
13 [REDACTED]  
14 [REDACTED]  
15 [REDACTED]  
16 [REDACTED]

17 [REDACTED] Technical dictionaries concur. Gray Ex. 16 (Microsoft Computer  
18 Dictionary at 287 (5th ed. 2002)).

19 Apple identifies Android’s MotionEvent object as the “event object” in the accused  
20 products. Gray Exs. 13 & 14 (Singh Infringement Report, ¶ 322–23 & Ex. 17 at 16). [REDACTED]

21 [REDACTED]  
22 [REDACTED]  
23 [REDACTED]  
24 [REDACTED]

25  
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1 [REDACTED]  
2 [REDACTED] Consequently, Samsung’s accused devices cannot infringe claim 8.<sup>26</sup>

3 Apple attempts to salvage infringement by rewriting the claim. In particular, Apple  
4 argues that the “event object” need not “invoke” a scroll or gesture operation; it need only be used  
5 by *another* object – [REDACTED] – that invokes a method or function.<sup>27</sup> This is not what  
6 the claim says. The claim is clear: “*the event object* invokes” the scroll or gesture operation  
7 itself. By contrast, Apple’s litigation driven interpretation ignores the well-known meaning of  
8 “invokes” in the field as confirmed by the inventors, technical dictionaries, and Apple’s own  
9 expert. Indeed, before this case, Apple’s expert had *never* used the phrase “object invokes” in  
10 the way he (and Apple) are now using it in claim 8.<sup>28</sup> Apple’s claim construction argument  
11 should be rejected and summary judgment should be entered.

12 **B. Claim 50 Of The ‘163 Patent Is Invalid**

13 Claim 50 of the '163 patent relates to a technique for enlarging and translating a “structured  
14 electronic document” on a touch screen. Ex. 86 (‘163 patent). Claim 50 generally requires: (1)  
15 enlarging and translating a structured electronic document to substantially center a first box of  
16 content in response to a first gesture; and (2) translating the structured electronic document to  
17 substantially center a second box of content in response to a second gesture.

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19  
20 <sup>26</sup> Because Apple failed to assert a doctrine of equivalents theory in its infringement  
21 contentions, it is precluded from doing so now. *MEMC Elec. Materials v. Mitsubishi Materials*  
22 *Silicon Corp.*, 2004 WL 5363616, at \*4 (N.D. Cal. 2004) (precluding reliance of doctrine of  
23 equivalents theory not disclosed in infringement contentions); *Rambus, Inc. v. Hynix*  
24 *Semiconductor Inc.*, 2008 WL 5411564, at \*3 (N.D. Cal. 2008) (same); *Genentech, Inc. v. Amgen*,  
25 289 F.3d 761, 773–74 (Fed. Cir. 2002).

26 <sup>27</sup> [REDACTED]  
27 [REDACTED]  
28 [REDACTED]

1           Years before the ‘163 patent application was filed, this very technique was invented and  
2 publicly disclosed by Dr. Benjamin Bederson. In 2004, Dr. Bederson developed a prototype  
3 “LaunchTile System” – the LaunchTile program running on a Compaq Pocket PC. The  
4 LaunchTile System was publicly disclosed through demonstrations, videos, and power point slides  
5 at the April 2005 ACM Conference on Human Factors in Computing Systems. Bederson Decl., ¶  
6 8, Exs. D, E, & F. Indeed, Dr. Bederson presented a video demonstration (the “LaunchTile  
7 Video”) specifically depicting one of two invalidating behaviors that are the basis for this motion  
8 at the conference. *Id.* Ex. D. Additionally, at the conference, Dr. Bederson presented the paper  
9 *AppLens and LaunchTile: Two Designs for One-Handed Thumb Use on Small Devices*, CHI 2005,  
10 ACM, Apr. 2-7, 2005, (“LaunchTile Publication”). Bederson Ex. A. Thus, the LaunchTile  
11 System, the LaunchTile Video, and the LaunchTile Publication each independently qualify as  
12 prior art under 35 U.S.C. §§ 102(a), (b), and (g)(2).

13           LaunchTile consists of a single interactive zoomspace with 36 tiles (6x6 matrix) embedded  
14 within. Gray Decl. at ¶ 65; Bederson Decl. at ¶ 10. This zoomspace is a “structured electronic  
15 document” comprising a plurality of boxes of content.<sup>29</sup> Gray Decl. at ¶¶ 76-82. While at the  
16 outermost level of zoom (World view), a user can select a 4-tile Zone within the 36 tiles. In  
17 response to this first gesture, LaunchTile enlarges and translates the zoomspace so that the 4-tile  
18 Zone is centered on the display. Gray Decl. at ¶¶ 84-90, Exs. 4 & 5 (videos). While in the  
19 Zone view, a user can then select any one of the 4 tiles. In response to this second gesture,  
20 LaunchTile again translates the zoomspace so that the selected tile is centered on the display.  
21 Gray Decl. at ¶¶ 92-97, Exs. 4 & 5. These steps meet every limitation of claim 50 and therefore  
22 anticipate. Gray Decl. ¶ 97, Ex. 3 (claim chart).<sup>30</sup>

23

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25           <sup>29</sup> A “structured electronic document” is a “two dimensional information space containing  
26 embedded coding that provides some meaning or ‘structure’ to the document.” Gray Decl. at ¶  
27 60. Dr. Singh does not dispute this construction. Gray Ex. 6 (Singh Dep. at 80:25-81:1).

28           <sup>30</sup> Additionally, from Zone view, a user can drag the zoomspace to an adjacent 4-tile Zone  
and select a single tile. Gray Decl. at 95 & Ex. 5. This is an alternative, invalidating operation.



1 Apple contends that LaunchTile does not anticipate because the zoomspace is not  
2 “enlarg[ed]” and “translat[ed]” when a user selects a 4-tile zone. Gray Ex. 15 (Singh Rebuttal  
3 Report, ¶ 33). Instead, Apple claims that selected portion of the zoomspace is replaced by  
4 “entirely different content with a different visual appearance.” *Id.* Apple’s argument is based  
5 on a flawed and unsupported construction of “structured electronic document.”

6 Under Apple’s construction, the visual appearance of content within a structured electronic  
7 document cannot change when enlarged. However, nothing in the claim language, specification  
8 or prosecution history precludes the changing or substitution of content in a structured electronic  
9 document when enlarged. Certainly, one of ordinary skill in the art would not believe such a  
10 change or substitution of content *within* a structured electronic document renders the document a  
11 “different” document when enlarged. Furthermore, a webpage – an example of a structured  
12 electronic document offered in the ‘163 specification (Col. 18 ll. 50-52) – often contains  
13 embedded content which is replaced when the webpage refreshes. Gray Decl., ¶ 89. This  
14 replacement does not render the webpage a “different” webpage. *Id.* Likewise, any change or  
15 replacement of content when enlarging the zoomspace in LaunchTile does not somehow transform  
16 the zoomspace into an “entirely different” structured electronic document.<sup>31</sup> For the foregoing  
17 reasons, Claim 50 is invalid as anticipated.

18 **C. Claim 19 Of The ‘381 Patent Is Invalid**

19 Claim 19 of the ‘381 patent relates to a snap-back feature. The feature operates as  
20 follows: when a user places a finger on a screen and drags an electronic document past its edge  
21 and then releases the finger, the document bounces back to fill the screen. Ex. 83 (‘381 patent).  
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25 <sup>31</sup> Although not relevant under the proper construction of “structured electronic document,”  
26 Apple’s assertion that LaunchTile presents entirely different content when the zoomspace is  
27 enlarged is not correct. The change in appearance results from further rendering of the tile based  
28 on content existing within the single, hierarchical data structure of LaunchTile; it does not result  
from “replacement” of tile content. *See* Gray Decl., ¶¶ 43, 50-53; Bederson Decl., ¶ 15-17.

1 The snap-back feature was not new when Apple filed its '381 patent application in  
2 December 2007.<sup>32</sup> Years earlier, in 2001, Mitsubishi Electric Research Laboratory ("MERL")  
3 developed a touch screen device called DiamondTouch. Bogue Decl., ¶ 4. By early 2005,  
4 MERL developed a program in the United States that ran on DiamondTouch called Tablecloth.  
5 *Id.*, ¶¶ 4-13. Tablecloth includes the same snap-back feature claimed in the '381 patent. van  
6 Dam Decl., ¶¶50-55, Exs. 3 and 4. In fact, the Tablecloth source code includes a function named  
7 "snapBack." Forlines Decl., ¶ 9. In early 2005, Tablecloth was installed on a DiamondTouch  
8 device located in the MERL visitor lobby in Cambridge, MA, was available for visitors to freely  
9 use without a nondisclosure agreement, and was used to publicly demonstrate the snap-back  
10 feature. Bogue Decl., ¶ 9, 12, Exs. 4 and 5 (videos). Furthermore, Tablecloth's snap-back  
11 feature was shown to potential customers at a conference in San Jose, CA in March 2006. *Id.*,  
12 ¶12. Thus, Tablecloth qualifies as prior art under 35 U.S.C. §§ 102(a), (b), and (g)(2).

13 As described in the declaration of Dr. van Dam and the supporting claim chart and videos,  
14 Tablecloth discloses each limitation of claim 19 of the '381 patent. Tablecloth displays a first  
15 portion of an electronic document. Van Dam Decl., ¶ 71-73, 97-99. In response to movement  
16 of a finger on the screen, Tablecloth displays a second portion of the document. *Id.*, ¶ 74-75,  
17 100-101. In response to the edge of the document being reached, Tablecloth displays a third  
18 portion and an area beyond the edge of the document. *Id.*, ¶ 76-78, 102-104. Finally, in  
19 response to detecting that the finger is no longer on the touch screen display, Tablecloth displays a  
20 fourth portion of the document such that the area beyond the edge is no longer displayed. *Id.*, ¶  
21 79-81, 105-107. Thus, Tablecloth anticipates claim 19.

22 Apple argues that Samsung has not identified an "electronic document" in Tablecloth.  
23 That argument, however, is based on a non-existent claim construction dispute. Samsung has  
24 identified "electronic documents" under both Apple's and Samsung's definitions. Whether  
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26 <sup>32</sup> The cited provisional patent applications do not disclose the subject matter of asserted  
27 claim 19; thus this claim is not entitled to an earlier priority date. *PowerOasis, Inc. v. T-Mobile*  
28 *USA, Inc.*, 22 F. 3d 1299, 1305-06 (Fed. Cir. 2008) (plaintiff has burden of proving earlier date).

1 electronic document is construed as Apple has proposed: “some visual representation on the  
2 screen that has a ... defined set of boundaries” (Van Dam Ex. 2 (Balakrishnan Dep. at 27:19-25))  
3 or as Samsung has proposed: “information that is visually represented on a screen that has a  
4 defined set of boundaries,” Van Dam Decl. ¶ 32, both of which are consistent with the phrase’s  
5 plain and ordinary meaning and the intrinsic evidence, there is no dispute that claim 19 is  
6 anticipated by Tablecloth and invalid.

7 **D. Claim 8 Of The ‘607 Patent Is Invalid**

8 The ‘607 patent relates to a touch panel configured to detect multiple touches. Ex. 84  
9 (‘607 patent). Earlier this year, the International Trade Commission (“ITC”) issued a final  
10 decision finding independent claim 1 and dependent claim 7 of the ‘607 patent invalid. Von  
11 Herzen Decl., ¶¶ 22-27 and Exs. 2, 5, 6. In that proceeding, an Administrative Law Judge and  
12 the Commission both concluded that U.S. Patent No. 7,372,455 (“Perski”) and the Smartskin  
13 paper (“Smartskin”) independently invalidate claims 1 and 7.<sup>33</sup> *Id.*

14 Apple has dropped claims 1 and 7 in this case (presumably because of the ITC decision)  
15 and now only asserts claim 8. However, claim 8 depends from claims 1 and 7 and adds nothing  
16 more than a trivial circuit component that was very well known to one of ordinary skill in the art  
17 for over a *decade* prior to the filing of the ‘607 Patent. *Id.*, ¶¶ 28-57. Consequently, claim 8 is  
18 also invalid in view of Perski and Smartskin.<sup>34</sup>

19 Apple argues that Perski does not disclose the “multitouch” limitation of claims 1 and 7.  
20 But as Dr. Von Herzen explains, there is “absolutely no difference” between the multitouch  
21 algorithm disclosed in Perski and the algorithm of the ‘607 patent. *Id.*, ¶¶ 60-73. The ITC also  
22 rejected this argument, holding that the “method disclosed in Perski [] for detecting multiple  
23 touches is *virtually identical* to the disclosure in the ‘607 Patent.” *Id.*, ¶ 23.

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26 <sup>34</sup> For the Court’s convenience, Dr. von Herzen has prepared claim charts comparing the  
27 limitations of claim 8 to each of the Perski and Smarksin references. Von Herzen Decl., Ex. 17.  
28 These claim charts prove by clear and convincing evidence that all the limitations of claim 8 are  
disclosed or rendered obvious by each of Perski and Smartskin.

1 Apple claims that Smartskin does not disclose the “transparent capacitive sensing medium”  
2 limitation of claims 1 and 7. However, Smartskin expressly discloses that “a transparent  
3 SmartSkin sensor can be obtained . . . .” *Id.*, ¶¶ 81-93. Even if Smartskin had not expressly  
4 disclosed a transparent sensor, converting either one of the described opaque embodiments into  
5 transparent form would be an “obvious design choice” yielding extremely predictable results.  
6 *Id.*, ¶ 82. The ITC, while describing anticipation “an extremely close call,” also found this  
7 limitation to be obvious in view of Smartskin. *Id.*, ¶¶ 24-27.

8 Claim 8 merely adds a common and trivial limitation to claims 1 and 7: a “virtual ground  
9 charge amplifier.” This well-known circuit element adds nothing inventive. *Id.*, ¶¶ 28-57, 74-  
10 77, 94. Indeed, the charge amplifier configuration covered by claim 8 was well known as an  
11 “integrator” for more than a decade. For example, a popular 1989 textbook offers dozens of  
12 examples of an *identical* charge amplifier configuration. *Id.*, ¶¶ 34-39. In addition, a 1977  
13 IEEE paper and a university physics experiment detail the exact same circuit. *Id.*, ¶¶ 40, 43-44.  
14 The charge amplifier configuration was also extremely well known in the capacitive touch sensor  
15 field for use as a “capacitive measuring element” more than a decade before the ‘607 patent was  
16 filed. *Id.*, ¶¶ 45-57. Blonder, Gerpheide ’658, and Gerpheide ’017 all describe capacitive touch  
17 sensors with identical charge amplifiers used to detect touches. *Id.* Thus, one of ordinary skill  
18 in the art would find the addition of a “virtual ground charge amplifier” to be a trivial modification  
19 to Perski or Smartskin that would have yielded predictable results—namely the filtering of noise  
20 and unwanted charge coupling. *Id.*, ¶¶ 54, 76, 77, 94. Consequently, claim 8 would be obvious  
21 to one of ordinary skill in the art in view of Perski or Smartskin and is invalid. *Id.*, ¶¶ 77, 94.

## 22 VI. APPLE’S ANTITRUST CLAIMS FAIL FOR LACK OF DAMAGES

23 Apple’s antitrust counterclaim for damages should be dismissed because Apple has not  
24 adduced any evidence of damages. Summary judgment is proper when there is “no competent or  
25 relevant evidence from which a jury could fairly estimate damages.” *Rickards v. Canine Eye*  
26 *Registration Found., Inc.*, 704 F.2d 1449, 1452-53 (9th Cir. 1983). In *Rickards*, the Court  
27 granted summary judgment on the asserted antitrust damages claims where the plaintiff had not  
28 “identified their expert witnesses nor designated documents supporting their damages claims.” *Id.*;

1 *see also Toscano v. PGA Tour, Inc.*, 201 F. Supp. 2d 1106, 1124 (E.D. Cal. 2002) (finding  
2 summary judgment appropriate when there is no admissible evidence of damages).

3 In response to interrogatories, Apple failed to identify any facts supporting its claim to  
4 damages. In response to Samsung’s Interrogatory No. 79, which required Apple to “IDENTIFY  
5 all facts supporting APPLE’s Twenty-Eight Counterclaim (Violation of Section 2 of the Sherman  
6 Act, 15 U.S.C. § 2),” Apple identified no documents supporting its claim for damages and no  
7 witnesses that would testify regarding such damages. Ex. 81 (Apple’s Obj. and Resp. to  
8 Samsung’s Fourth Set of Interrogatories (Mar. 10, 2012))). Instead, [REDACTED]

9 [REDACTED] Similarly, in response to Samsung’s  
10 Interrogatory No. 8, which required Apple to “fully describe any and all damages that APPLE is  
11 claiming . . . and the detailed basis for any such damages claims,” [REDACTED]  
12 [REDACTED] made no attempt to substantiate  
13 those claims. Ex. 80 (Apple’s Supp. Obj. and Resp. to Samsung’s First Set of Interrogatories (Mar.  
14 7, 2011))).

15 Apple’s sole expert on antitrust issues, Dr. Janusz Ordover, admitted during deposition that  
16 he had no evidence of the amount of damages that Apple suffered. [REDACTED]

17 [REDACTED]  
18 [REDACTED]  
19 [REDACTED]  
20 [REDACTED]  
21 [REDACTED]  
22 [REDACTED]  
23 [REDACTED]  
24 [REDACTED]  
25 [REDACTED]

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1 Merely demonstrating that a party has incurred litigation costs is insufficient to sustain a  
2 claim for antitrust damages,<sup>35</sup> but, even if evidence of such costs were sufficient, Apple has failed  
3 to offer any evidence of the costs it has incurred here. Apple has not produced any documents,  
4 such as invoices, establishing legal fees incurred and Dr. Ordover admitted he did not know the  
5 amount of such expenses. Ex. 82 at 253:15-17. Because Apple has not offered “competent or  
6 relevant evidence from which a jury could fairly estimate damages,” this Court should grant  
7 summary judgment denying its antitrust damages claims. *Rickards*, 704 F.2d at 1452-53.

8 **VII. CONCLUSION**

9 For the foregoing reasons, Samsung respectfully asks the Court to grant its Motion for  
10 Summary Judgment on all claims described above.

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26 <sup>35</sup> See *Chip-Mender, Inc. v. Sherwin-Williams Co*, 2006-1 Trade Cas. ¶ 75,148 (N.D. Cal.  
27 2006). Litigation costs have only been recognized as antitrust damages in the context of *sham*  
28 *litigation*, which Apple has not alleged. *Handgards v. Ethicon*, 601 F.2d 986, 997 (9th Cir.  
1979).