

PUBLIC VERSION

UNITED STATES INTERNATIONAL TRADE COMMISSION  
Washington, D.C.

In the Matter of

CERTAIN ELECTRONIC DIGITAL MEDIA DEVICES  
AND COMPONENTS THEREOF

Inv. No. 337-TA-796

INITIAL DETERMINATION ON VIOLATION OF SECTION 337 AND  
RECOMMENDED DETERMINATION ON REMEDY AND BOND

Administrative Law Judge Thomas B. Pender  
(October 24, 2012)

**Appearances**

**For Complainant Apple, Inc.:**

Alexander J. Hadjis, Esq., G. Brian Busey, Esq., and Kristin L. Yohannan, Esq. of Morrison & Foerster LLP of Washington, DC

Harold J. McElhinny, Esq., Michael A. Jacobs, Esq., Rachel Krevans, Esq. of Morrison & Foerster LLP of San Francisco, California

**For Respondents Samsung Electronics. Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC:**

Charles K. Verhoeven, Esq. of Quinn Emanuel Urquhart & Sullivan, LLP of San Francisco, CA

Kevin P.B. Johnson, Esq., Victoria F. Maroulis, Esq. of Quinn Emanuel Urquhart & Sullivan, LLP of Redwood Shores, CA

Eric Huang, Esq. of Quinn Emanuel Urquhart & Sullivan, LLP of New York, NY

William Price, Esq., Robert J. Becher, Esq. of Quinn Emanuel Urquhart & Sullivan, LLP of Los Angeles, CA

Paul F. Brinkman, Esq., Alan L. Whitehurst, Esq., S. Alex Lasher, Esq. of Quinn Emanuel Urquhart & Sullivan, LLP of Washington, DC

Charles F. Schill, Esq. of Steptoe & Johnson LLP of Washington, DC

**For The Office of Unfair Import Investigations:**

Lynn I. Levine, Esq., Director; David O. Lloyd, Esq., Supervisory Attorney; Reginald D. Lucas, Esq., Investigative Attorney of Washington, DC

PUBLIC VERSION

Table of Contents

I.	Introduction.....	2
A.	Procedural History .....	2
B.	Parties.....	3
1.	Complainant .....	3
2.	Respondents.....	3
C.	Patents at Issue.....	4
D.	Products at Issue .....	4
1.	Accused Products .....	4
2.	Design Around Products .....	8
II.	Importation or Sale .....	12
III.	Jurisdiction.....	14
A.	Subject Matter Jurisdiction .....	14
B.	Personal Jurisdiction .....	15
C.	In Rem Jurisdiction .....	15
IV.	Standards of Law .....	15
A.	Claim Construction .....	15
B.	Infringement.....	18
1.	Direct Infringement .....	18
2.	Indirect Infringement.....	20
C.	Validity .....	21
1.	Anticipation .....	22
2.	Obviousness.....	23
3.	Written Description (35 U.S.C. §112).....	24
4.	Enablement.....	25
D.	Domestic Industry .....	25
1.	Economic Prong .....	26
2.	Technical Prong.....	29
V.	U.S. Patent No. D558,757.....	30
A.	Introduction.....	30
B.	Asserted Claims .....	30
C.	Level of Ordinary Skill in the Art.....	31
D.	Claim Construction .....	32
E.	Infringement.....	37

PUBLIC VERSION

1.	Galaxy S 4G SGH-T959V and Vibrant SGH-T959 .....	50
2.	Mesmerize SCH-I500, Fascinate SCH-I500 and Showcase SCH-I500 .....	55
3.	Galaxy Player 4.0 YP-G1CWY.....	60
4.	Galaxy Player 5.0 YP-G70/NAW .....	66
5.	Transform SPH-M920 .....	71
F.	Validity of the D’757 Patent - Obviousness Under 35 U.S.C. § 103(a) .....	75
1.	Japanese Design Patent JP D1250487 .....	76
2.	Korean Design Registration 30-0304213 .....	80
G.	Technical Prong of the Domestic Industry Requirement.....	81
VI.	U.S Patent No. D618,678.....	88
A.	Introduction.....	88
B.	Asserted Claims .....	89
C.	Level of Ordinary Skill in the Art.....	89
D.	Claim Construction .....	90
E.	Infringement of the D’678 Patent .....	95
1.	The Galaxy S II (SGH-T989).....	110
2.	The Galaxy S 4G and Vibrant .....	114
3.	The Galaxy SII (SGH-I777) .....	117
4.	The Galaxy SII Epic 4G Touch.....	121
5.	The Galaxy SII Skyrocket .....	124
6.	The Mesmerize/Showcase/Fascinate.....	127
7.	The Infuse 4G .....	130
8.	The Focus S .....	133
9.	The Galaxy Player 4.0 .....	136
F.	Validity of the D’678 Patent .....	139
1.	Obviousness under 35 U.S.C. § 103.....	139
2.	D’678 Patent Invalid – New Matter .....	146
G.	Domestic Industry - “Technical Prong” .....	148
VII.	U.S. Patent No. 7,479,949.....	154
A.	Introduction.....	154
B.	Asserted Claims .....	155
C.	Level of Ordinary Skill in the Art.....	161
D.	Claim Construction .....	161
1.	“heuristics” .....	161

PUBLIC VERSION

2.	“one or more heuristics” .....	161
3.	other claim terms .....	161
E.	Infringement.....	162
1.	Direct Infringement .....	162
2.	Indirect Infringement.....	181
F.	Technical Prong of the Domestic Industry Requirement.....	191
1.	Do the domestic industry products determine a vertical screen scrolling command based on “initial movement”? .....	192
2.	Do the domestic industry products employ heuristics for scrolling and a next item command? .....	193
G.	Validity .....	194
1.	Anticipation .....	194
2.	Obviousness.....	206
3.	Written Description .....	224
4.	Enablement .....	227
VIII.	U.S. Patent No. RE41,922 .....	230
A.	Introduction.....	230
B.	Asserted Claims .....	230
C.	Level of Ordinary Skill in the Art.....	232
D.	Claim Construction .....	232
1.	“image operation” .....	232
2.	Other claim terms .....	232
E.	Infringement.....	233
1.	Direct Infringement .....	233
2.	Indirect Infringement.....	262
F.	Technical Prong of the Domestic Industry Requirement.....	272
G.	Validity .....	274
1.	Anticipation .....	274
2.	Obviousness.....	303
IX.	U.S. Patent No. 7,912,501.....	306
A.	Introduction.....	306
B.	Asserted Claims .....	307
C.	Level of Ordinary Skill in the Art.....	308
D.	Claim Construction .....	309



PUBLIC VERSION

E.	Infringement.....	309
1.	Products employing GND-detection scheme and a comparator for microphone detection and switch activation events.....	311
2.	Products employing a receptacle switch for plug detection, comparator for microphone detection, and dedicated comparator for switch activation event .....	319
3.	Products employing a switch for plug detection, data converter for microphone detection, and dedicated comparator for switch activation events .....	330
4.	Products employing L-detection, a data converter for microphone detection, and dedicated comparator for switch activation events .....	341
F.	Technical Prong of the Domestic Industry Requirement.....	343
G.	Validity .....	344
1.	Anticipation .....	344
2.	Obviousness.....	360
X.	U.S. Patent No. 7,789,697.....	379
A.	Introduction.....	379
B.	Asserted Claims .....	380
C.	Level of Ordinary Skill in the Art.....	381
D.	Claim Construction .....	382
E.	Infringement.....	382
1.	Products employing GND-detection circuitry to detect the presence of a plug .....	384
2.	Products employing L-detection circuitry to detect the presence of a plug .....	398
F.	Technical Prong of the Domestic Industry Requirement.....	402
1.	Do the iPhone 4 and iPad 2 “detect that the signal path is ... a high impedance path”? . .....	405
2.	Do the iPhone 4 and iPad 2 include “detection circuitry coupled to the detect contact and the first receptacle contact”? .....	406
G.	Validity .....	409
1.	Anticipation .....	409
2.	Obviousness.....	427
3.	35 U.S.C. § 112 .....	443
XI.	Economic Prong of the Domestic Industry Requirement .....	447
XII.	Conclusions of Law .....	459
XIII.	Initial Determination and Order.....	464

**PUBLIC VERSION**

**List of Abbreviations**

CDX	Complainant's Demonstrative Exhibit
CIB	Complainant's Initial Post-Hearing Brief
CRB	Complainant's Reply Post-Hearing Brief
CX	Complainant's Exhibit
Depo.	Deposition
JX	Joint Exhibit
RDX	Respondent's Demonstrative Exhibit
RIB	Respondent's Initial Post-Hearing Brief
RRB	Respondent's Reply Post-Hearing Brief
RX	Respondent's Exhibit
Tr.	Transcript
DWS	Direct Witness Statement (Including Revised Direct Witness Statements)
RWS	Rebuttal Witness Statement

**PUBLIC VERSION**

UNITED STATES INTERNATIONAL TRADE COMMISSION  
Washington, D.C.

In the Matter of

CERTAIN ELECTRONIC DIGITAL MEDIA  
DEVICES AND COMPONENTS THEREOF

Inv. No. 337-TA-796

INITIAL DETERMINATION ON VIOLATION OF SECTION 337

Administrative Law Judge Thomas B. Pender

(October 24, 2012)

Pursuant to the Notice of Investigation and Rule 210.42(a) of the Rules of Practice and Procedure of the United States International Trade Commission, this is my Initial Determination in the matter of Certain Electronic Digital Media Devices and Components Thereof, Investigation No. 337-TA-796.

The Administrative Law Judge hereby determines that a violation of Section 337 of the Tariff Act of 1930, as amended, has been found in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain electronic digital media devices and components thereof, in connection the claim of U.S. Patent No. D618,678; claims 1, 4-6, and 10-20 of U.S. Patent No. 7,479,949; claims 29, 30, and 33-35 of U.S. Patent No. RE41,922; and claims 1-4 and 8 of U.S. Patent No. 7,912,501.

The Administrative Law Judge hereby determines that no violation of Section 337 of the Tariff Act of 1930, as amended, has been found in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain electronic digital media devices and components thereof, in connection with the claim of U.S. Patent No. D558,757; and claims 13 and 14 of U.S. Patent No. 7,789,697.

**PUBLIC VERSION**

Furthermore, the Administrative Law Judge hereby determines that a domestic industry in the United States does exist that practices or exploits U.S. Patent Nos. D558,757; D618,678; 7,479,949; RE41,922; and 7,912,501, but that a domestic industry in the United States does not exist that practices or exploits U.S. Patent Nos. 7,789,697.

**I. Introduction**

**A. Procedural History**

On July 5, 2011, complainant Apple, Inc. (“Apple”) filed a complaint with the Commission pursuant to Section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337. The complaint named Samsung Electronics Co., Ltd. (“SEC”), Samsung Electronics America, Inc. (“SEA”), and Samsung Telecommunications America, LLC (“STA”) (collectively, “Samsung”) as Respondents.

By publication of notice in the Federal Register on August 5, 2011, the Commission instituted this investigation to determine whether there is a violation of Section 337(a)(1)(B) in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain electronic digital media devices and components thereof that infringe one or more of claims 1, 3-6, and 9-20 of U.S. Patent No. 7,479,949 (“the ‘949 patent”); claims 29-35 of U.S. Patent No. RE41,922 (“the ‘922 patent”); claims 1, 4, 7, 9, 11, 12, 15-17, 19, and 20 of U.S. Patent No. 7,863,533 (“the ‘533 patent”); claims 1-3, 11-16, and 21-27 of U.S. Patent No. 7,789,697 (“the ‘697 patent”); claims 1-4 and 8 of U.S. Patent No. 7,912,501 (“the ‘501 patent”); the claim of U.S. Patent No. D558,757 (“the D’757 patent”); and the claim of U.S. Patent No. D618,678 (“the D’678 patent”), and whether an industry in the United States exists as required by Section 337(a)(2). *See* 76 Fed. Reg. 47610-11 (Aug. 5, 2011).

## **PUBLIC VERSION**

This investigation was originally assigned to Administrative Law Judge Bullock. *See* Aug. 2, 2011 Notice to the Parties. On October 24, 2011, this investigation was reassigned to me. (*See* Oct. 24, 2011, Notice to the Parties.)

A Markman hearing was held in this investigation from November 21-22, 2011. On March 6, 2012, Order No. 16 issued construing claim terms. *See* Order No. 16.

On May 3, 2012, Order No. 17 issued as an initial determination partially terminating this investigation with respect to all claims of the '533 patent, claims 1-3, 11, 12, 15, 16, and 21-27 of the '697 patent, and claim 3 of the '949 patent. The Commission determined not to review Order No. 17. *See* Comm'n Notice (May 3, 2012).

An evidentiary hearing was held in this investigation from May 31 – June 7, 2012.

### **B. Parties**

#### **1. Complainant**

The Complainant named in this investigation is Apple, Inc. (*See* NOI.) Apple is a California corporation headquartered in Cupertino, California. Apple designs, manufactures, and markets personal computers, tablet devices, mobile communication device, and portable digital music and video players, and sells related software, services, peripherals, and networking solutions.

#### **2. Respondents**

The Respondents named in this investigation are Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC. (*See* NOI.) Respondent Samsung Electronics Company, Ltd. is based in Suwon, Korea. Samsung Electronics America, Inc. is a wholly owned subsidiary of SEC. SEC is one of the largest

manufacturers of wireless communication devices in the world. SEC's subsidiary, Samsung Telecommunications America, LLC, was established in 1996 to perform activities in the United States relating to wireless communication services. STA is a Delaware limited liability company with a principal place of business in Richardson, Texas.

**C. Patents at Issue**

This investigation was instituted to determine whether there was a violation of Section 337 based on infringement of the '949, '922, '533, '697, '501, D'757, and D'678 patents. (*See* NOI.) Subsequent to the institution of this investigation, the '533 patent was terminated from this investigation. Thus, there remain at issue in this investigation the '949, '922, '697, '501, D'757, and D'678 patents.

**D. Products at Issue**

At issue in this investigation are certain electronic digital media devices and components thereof. 76 Fed. Reg. 47610-11.

**1. Accused Products**

Apple contends that the following Samsung products, which include mobile telephones, tablet computers, and media devices, infringe at least one claim of the asserted patents. The parties have entered into a stipulation regarding representative accused products. (Joint Stipulation Regarding Representative Accused Products, EDIS Document No. 480341(May 15, 2012).)

PUBLIC VERSION

U.S. Patent No.	Accused Apple Products
7,479,949	<p><u>Products Running Android Version 2.2, 2.3, or 3.x</u></p> <p>Acclaim SCH-R880, Admire SCH-R720, Captivate SGH-I897, Conquer 4G SPH-D600, Continuum SCH-I400, Dart SGH-T499, DoubleTime SGH-I857, Exhibit II 4G SGHT679, Exhibit SGH-T759, Fascinate SCHI500, Galaxy Ace S5830L, Galaxy Player 4 YP-G1CWY, Galaxy Player 5 YPG70C/NAW, Galaxy Prevail SPH-M820, Galaxy S 4G SGH-T959V, Galaxy S II SGHT989, Galaxy Tab 10.1 GT-P7510, Galaxy Tab 10.1 SGH-T859, Galaxy Tab 7 GT-P1010, Galaxy Tab 7 Plus GT-P6210, Galaxy Tab 7, SCH-I800, Galaxy Tab 7 SGH-I987, Galaxy Tab 7 SGH-T849, Galaxy Tab 7 SGH-T869, Galaxy Tab 7 SPH-P100, Galaxy Tab 8.9 GTP7310/M16, Galaxy Tab 8.9 SGH-I957, Gem SCH-I100, Gravity SGH-T589, Illusion SCHI110, Indulge SCH-R910, Infuse 4G SGHI997, Intercept SPH-M910, Mesmerize SCHI500, Nexus S GT-I9020, Nexus S GT-I9020A, Nexus S GT-I9020T, Nexus S SPH-D720, Precedent SCH-M828C, Repp SCH-R680, Showcase SCH-I500, Sidekick SGH-T839, Stratosphere SCH-I405, Transfix SCH-R730, Transform SPH-M920, Transform Ultra SPHM930, Vibrant SGH-T959, Vitality SCH-720</p> <p><u>Products Running Android Version 4.0</u></p> <p>Galaxy Nexus GTI9250, Galaxy Nexus SCH-I515</p>

PUBLIC VERSION

U.S. Patent No.	Accused Apple Products
RE 41,922	<p>Acclaim SCH-R880, Admire SCH-R720, Attain SCH-R920, Captivate Glide SGH-I927, Captivate SGH-I897, Conquer 4G SPH-D600, Continuum SCH-I400, Dart SGH-T499, DoubleTime SGH-I857, Droid Charge SCH-I510, Epic 4G SPH-D700, Exhibit II 4G SGHT679, Exhibit SGH-T759, Fascinate SCH-I500, Galaxy Ace S5830L, Galaxy Nexus GTI9250, Galaxy Nexus SCH-I515, Galaxy Player 4 YP-G1CWY, Galaxy Player 5 YPG70C/NAW, Galaxy Prevail SPH-M820, Galaxy S 4G SGH-T959V, Galaxy S II Epic 4G Touch SPH-D710, Galaxy S II SGH-I777, Galaxy S II SGH-T989, Galaxy S II Skyrocket SGH-I727, Galaxy Tab 10.1 GT-P7510, Galaxy Tab 10.1 SCH-I905, Galaxy Tab 10.1 SGH-T859, Galaxy Tab 7 GT-P1010, Galaxy Tab 7 Plus GT-P6210, Galaxy Tab 7 SCH-I800, Galaxy Tab 7 SGH-I987, Galaxy Tab 7 SGH-T849, Galaxy Tab 7 SGH-T869, Galaxy Tab 7 SPH-P100, Galaxy Tab 8.9 GTP7310/ M16, Galaxy Tab 8.9 SGH-I957, Gem SCH-I100, Gravity SGH-T589, Illusion SCH-I110, Indulge SCH-R910, Indulge SCH-R915, Infuse 4G SGH-I997, Intercept SPH-M910, Mesmerize SCH-I500, Nexus S GT-I9020, Nexus S GT-I9020A, Nexus S GT-I9020T, Nexus S SPH-D720, Note SGH-i717, Precedent SCH-M828C, Replenish SPHM580, Repp SCH-R680, Showcase SCH-I500, Sidekick SGH-T839, Stratosphere SCH-I405, Transfix SCH-R730, Transform SPH-M920, Transform Ultra SPH-M930, Vibrant SGHT959, Vitality SCH-720, Seek SPH-M350</p>
D558,757	<p>Galaxy S 4G (SGH-T959V), Mesmerize (SCH-I500), Fascinate (SCH-I500), Showcase (SCH-I500), Vibrant (SGH-T959), Transform (SPH-M920) Galaxy Player 4.0 (YP-G1CWY), Galaxy Player 5.0 (YP-G70C/NAW)</p>
D618,678	<p>Galaxy S 4G (SGH-T959V), Galaxy S II AT&amp;T (SGH-I777), Galaxy S II TMobile (SGH-T989), Galaxy S II Epic 4G Touch (SPH-D710), Galaxy S II Skyrocket (SGH I727), Mesmerize (SCH-I500), Fascinate (SCH-I500), Showcase (SCH-I500), Vibrant (SGH-T959), Infuse 4G (SGH-I997), Focus S (SCH-I937), Galaxy Player 4.0 (YP-G1CWY)</p>



PUBLIC VERSION

U.S. Patent No.	Accused Apple Products
7,789,697	<p>Admire SCH-R720, Conquer 4G SPH-D600, Continuum SCH-I400, Craft SCH-R900, DoubleTime SGH-I857, Exhibit SGH-T759, Fascinate SCH-I500, Flight II SGH-A927, Focus SGH-I917, Focus Flash SGH-I677, Focus S SGH-I937, Galaxy Nexus SCH-I515, Galaxy Player 4.0 YPG1CWY, Galaxy Player 5.0 YP-G70C/NAW, Galaxy Prevail SPH-M820, Galaxy S 4G SGHT959V, Galaxy S II Epic 4G Touch SPHD710, Galaxy S II SGH-I777, Galaxy S II SGH-T989, Galaxy S II Skyrocket SGH-I727, Galaxy Tab 7.0 SCH-I800, Galaxy Tab 7.0 SGH-T849, Galaxy Tab 7.0 SGH-T869, Galaxy Tab 7.0 SGH-I987, Galaxy Tab 7.0 SPH-P100, Galaxy Tab 7.0 GT-P1010/W16, Galaxy Tab 7.0 Plus GT-P6210, Galaxy Tab 8.9 SGH-I957, Galaxy Tab 8.9 GTP7310/M16, Galaxy Tab 10.1 SGH-T859, Galaxy Tab 10.1 SCH-I905, Galaxy Tab 10.1 GT-P7510/M16, Gravity SGH-T589, Illusion SCH-I110, Indulge SCH-R910, Indulge SCHR915, Infuse 4G SGH-I997, Mesmerize SCHI500, Nexus Prime GT-I9250, Nexus S GTI9020, Nexus S GT-I9020A, Nexus S GTI9020T, Nexus S SPH-D720, Note GTN7000/SGH-I717, Precedent SCH-M828C, Replenish SPH-M580, Repp SCH-R680, Showcase SCH-I500, Sidekick SGH-T839, Stratosphere SCH-I405, Transfix SCH-R730, Transform SPH-M920, Vibrant SGH-T959, Vitality SCH-720</p>
7,912,501	<p>Acclaim SCH-R880, Captivate SGH-I897, Conquer 4G SPH-D600, Continuum SCHI400, Craft SCH-R900, Droid Charge SCHI510, Epic 4G SPH-D700, Exhibit II 4G SGHT679, Exhibit 4G SGH-T759, Fascinate SCHI500, Focus SGH-I917, Focus Flash SGHI677, Focus S SGH-I937, Galaxy Ace S5830L, Galaxy Nexus SCH-I515, Galaxy Player 4.0 YP-G1CWY, Galaxy Player 5.0 YPG70C/NAW, Galaxy S 4G SGH-T959V, Galaxy S II Epic 4G Touch SPH-D710, Galaxy S II SGH-I777, Galaxy S II SGH-T989, Galaxy S II Skyrocket SGH-I727, Galaxy Tab 7.0 SCH-I800, Galaxy Tab 7.0 SGH-T849, Galaxy Tab 7.0 SGH-T869, Galaxy Tab 7.0 SGH-I987, Galaxy Tab 7.0 SPH-P100, Galaxy Tab 7.0 GT-P1010/W16, Galaxy Tab 7.0 Plus GT-P6210, Galaxy Tab 8.9 SGH-I957, Galaxy Tab 8.9 GT-P7310/M16, Galaxy Tab 10.1 SGH-T859, Galaxy Tab 10.1 SCH-I905, Galaxy Tab 10.1 GT-P7510/M16, Gravity SGH-T589, Illusion SCH-I110, Indulge SCHR910, Indulge SCH-R915, Infuse 4G SGHI997, Intercept SPH-M910, Mesmerize SCHI500, Messenger SCH-R630, Messenger Touch SCH-R631, Nexus Prime GT-I9250, Nexus S GT-I9020, Nexus S GT-I9020A, Nexus S GTI9020T, Nexus S SPH-D720, Note GTN7000/SGH-I717, Repp SCH-R680, Seek SPH-M350, Showcase SCH-I500, Sidekick SGH-T839, Stratosphere SCH-I405, Suede SCH-R710, Transform SPH-M920, Transform Ultra SPH-M930, Vibrant SGH-T959, Vitality SCH-720</p>

## 2. Design Around Products

Samsung argues in its post-hearing briefs that Apple failed to prove that certain of its products, which it refers to as design around products, infringe the asserted claims of the '949, '922, '697, and '501 patents. Apple argues that it did not accuse those products of infringement and thus they are not at-issue in the investigation.

None of the parties, including Staff, adequately addressed this issue in its post-hearing briefing. Thus, on August 27, 2012, Order No. 25 issued seeking additional briefing discussing whether the design around products are at issue in this investigation and whether infringement of those products should be adjudicated as part of this investigation. (*See* Order No. 25 (August 27, 2012).)

### **Parties' Positions**

Apple argues that while the NOI might encompass the non-accused products, the complainant's infringement contentions determine which products are accused. (CSupp at 1.) Apple argues that it did not assert infringement against Samsung's alleged design around products and thus did not address them in its expert witness statements. (*Id.*) Apple also asserts that it did not address the design-around products in its pre-hearing brief or post-hearing briefs. (*Id.* at 2.) Apple argues that any adjudication of whether the design-around products infringe the asserted patents would constitute an improper advisory opinion that is not provided for under the Commission Rules. (*Id.*) Apple also argues that I should reject Samsung's argument that any exclusion order issued should exempt its alleged design around products. (*Id.*) Apple argues that the Commission in *Certain MEMS Devices and Products Containing the Same* reversed the ALJ's decision to carve out non-accused processes from the exclusion order because the

PUBLIC VERSION

complainant had not moved to terminate the investigation as to products made using such processes or to exclude them from the scope of any limited exclusion order and because the ALJ denied the respondents' summary determination motion. (*Id.*)

Samsung argues that its design around products for the '949, '697 and '501 patents are at issue and infringement by those designs should be adjudicated as part of this investigation. (RSupp at 1.) Samsung argues that the design around products are electronic devices within the scope of the investigation and that Apple had sufficient opportunity to conduct discovery in this area. (*Id.*) Samsung argues that Apple received timely discovery regarding the design around products and that its own experts analyzed them and in some cases opined on them in their expert reports. Samsung argues that simply because Apple chose to ignore the design around products in its briefing and at the hearing, after full discovery, cannot remove the design around products from the investigation. (*Id.* at 2.) Samsung argues that it expended considerable resources during the investigation and allocated valuable trial time to introduce and address these design around products. (*Id.* at 1.) Samsung argues that ignoring these products at this late stage would be prejudicial and a waste of valuable party and judicial resources should infringement of the design around products need to be re-addressed. (*Id.* at 1-2.)

The Staff argues that under Commission precedent, Samsung's design-around products are properly at issue in this investigation. (SSupp at 2.) In support, the Staff argues that in *Certain Flash Memory Circuits and Products Containing Same*, the Commission held that the ALJ should have made a determination as to whether Samsung's new designs infringe the patent-at-issue, noting that the record contained testimony by technical experts that the new designs are not infringing. (*Id.*) The Staff argues that here, Samsung witnesses provided testimony about

the ‘949, ‘697, and ‘501 design-around products. (*Id.* at 1.) The Staff also argues that Samsung expert witness Dr. van Dam testified regarding the ‘949 design around in his witness statement and that Apple expert witness Dr. Balakrishnan provided testimony regarding the ‘949 design around products at the evidentiary hearing. (*Id.* at 2.) Similarly, the Staff argues that Samsung expert Dr. Russ testified regarding the ‘697 and ‘501 design around products and that on cross-examination, Apple expert Dr. Phinney also testified about the ‘697 and ‘501 design around products. (*Id.*)

### **Analysis**

The design around products are within the scope of the investigation as set forth in the NOI. The evidence shows that there was substantial discovery taken on the design around products. Indeed, the evidence shows that Apple inspected the design-around products as well as the relevant source code and took depositions of the relevant Samsung witnesses. (*See e.g.*, Dooju Byun (CX-2457C) and Kiyung Nam (CX-2507C).) Moreover, both Apple’s and Samsung’s experts testified at the evidentiary hearing regarding said products. (*See e.g.*, RX-3636C (van Dam RWS) at Q&A 504-505, 602; RX-3637C (Russ RWS) at Q&A 702, 703, 733, 739, 749; CX-3633C (Nam RWS) at Q&A 14-18; CX-2428C (Balakrishnan DWS) at Q&A 181; Balakrishnan Tr. at 1208:14-1209:13; Phinney Tr. at 930:16-931:13, 931:17-932:6.) The evidence also shows that the design around products are fixed and have been imported or sold in the United States. (RX-3636C (van Dam RWS) at Q&A 504, 602; RX-3637C (Russ RWS) at Q&A 733, 737; J.R. Lee Tr. 1705:4-7, 1723:22-1724:19, 1726:13-1728:1; RX-3452C; RX-3453C at 3; RX-3454C; RX-3005C; RX-2112C; CX-2507C (Nam Dep.) at 49:3-11, 58:5-15.)

PUBLIC VERSION

Apple argues that because it did not accuse the design around products of infringing the asserted patents there is no need to determine whether they infringe the asserted patents. At the same time Apple argues that the design around products should not be carved out of any exclusion order that may issue in this investigation. Taken together, it would seem that Apple does not want the design patents adjudicated on the merits, but wants to still be able to argue that they fall within the scope of any exclusion order that may issue. I find Apple's position unimpressive.

The design around products are within the scope of this investigation, have been imported into the United States or sold in the United States, were the subject of extensive discovery as well as testimony during the evidentiary hearing in this investigation. Thus, I find that infringement of Samsung's design around products should be adjudicated as part of this Initial Determination. *See Certain Flash Memory Circuits and Products Containing Same*, 337-TA-382, Comm'n Op. (June 9, 1997).

A listing of Samsung's design around products, categorized by asserted patent, is shown in the chart below.

U.S. Patent No.	Design Around Products
7,479,949	Galaxy Tab 10.1 SCH-I905 (modified), Indulge SCH-R915, Epic 4G SPH-D700, Replenish SPH-M580, Galaxy Prevail SPH-M820, Galaxy Attain 4G SCH-R920, Galaxy S II Skyrocket SGH-I727, Galaxy S II SGH-I777, Captivate Glide SGH-I927, Galaxy S II Epic 4G Touch SPH-D710, Droid Charge SCH-I510, and Galaxy Note SCH-I717  Galaxy Tab GT-P7500

PUBLIC VERSION

U.S. Patent No.	Design Around Products
RE41,922	Galaxy Tab 10.1 GT-P7510, Epic 4G SPH-D700, Replenish SPH-M580, Galaxy Prevail SPH-M820, Galaxy S II Skyrocket SGH-I727, Galaxy S II Epic 4G Touch SPH-D710, Droid Charge SCH-I510, and Galaxy Note SCH-I717
7,789,697	Droid Charge SCH-I510
7,912,501	Droid Charge SCH-I510

## II. Importation or Sale

Samsung admits that it has imported or sold after importation in the United States the accused products in this investigation. (Joint Stipulation Regarding Importation, EDIS Document No. 480342 (May 15, 2012.); RIB at 14.)

On December 2, 2011, the Commission issued its opinion in *Certain Electronic Devices with Image Processing Systems, Components Thereof, and Associated Software*, Inv. No. 337-TA-724. (“*Electronic Devices with Image Processing Systems*”). The Commission stated in its opinion that “the ALJ’s importation analysis must include an evaluation of whether the type of infringement alleged will support a finding that there has been an importation of an article that infringes in violation of section 337. *Electronic Devices with Image Processing Systems*, Inv. 337-TA-724, Comm’n Op. at 13, n. 8 (December 2, 2011). In particular, the Commission held that:

[S]ection 337(a)(1)(B)(i) covers imported articles that directly or indirectly infringe when it refers to “articles that – infringe.” We also interpret the phrase “articles that – infringe” to reference the status of the articles at the time of importation. Thus, infringement, direct or indirect, must be based on the articles as imported to satisfy the requirements of section 337.

*Id.* at 13-14. The Commission further held that “[w]e analyze a violation of section 337(a)(1)(B)(i) based on method claim[s] [] under the statutory rubrics of indirect infringement.”

*Id.* at 18. In that investigation, the Commission held that the complainant failed to show importation, sale for importation, or sale after importation of articles that infringe a method claim directly or indirectly. *Id.* at 18-19.

As set forth, *supra*, the accused products in this investigation include mobile phones, tablets, and other media devices. Apple alleges that the D’757 Accused Products directly infringe the claimed ornamental design shown and described in the D’757 patent. Apple’s allegations of direct infringement of the claim of the D’757 patent would support a finding that there has been an importation of an article that infringes in violation of section 337.

Apple alleges that the D’678 Accused Products directly infringe the claimed ornamental design shown and described in the D’678 patent. Apple’s allegations of direct infringement of the claim of the D’678 patent would support a finding that there has been an importation of an article that infringes in violation of section 337.

Apple alleges that the ‘949 Accused Products directly infringe the asserted apparatus claims and both directly and indirectly infringe the asserted method claims. Apple’s allegations of direct infringement of the apparatus claims of the ‘949 patent would support a finding that there has been an importation of an article that infringes in violation of section 337. Likewise, Apple’s allegations of indirect infringement of the method claims of the ‘949 patent would support a finding that there has been an importation of an article that infringes in violation of section 337.

## PUBLIC VERSION

Apple alleges that the '922 Accused Products both directly and indirectly infringe the asserted method claims. Apple's allegations of indirect infringement of the method claims of the '922 patent would support a finding that there has been an importation of an article that infringes in violation of section 337.

Apple alleges that the '501 Accused Products directly infringe the asserted apparatus claims. Apple's allegations of direct infringement of the apparatus claims of the '501 patent would support a finding that there has been an importation of an article that infringes in violation of section 337.

Apple alleges that the '697 Accused Products directly infringe the asserted apparatus claims. Apple's allegations of direct infringement of the apparatus claims of the '697 patent would support a finding that there has been an importation of an article that infringes in violation of section 337.

### **III. Jurisdiction**

In order to have the power to decide a case, a court or agency must have both subject matter jurisdiction and jurisdiction over either the parties or the property involved. 19 U.S.C. § 1337; *Certain Steel Rod Treating Apparatus and Components Thereof*, Inv. No. 337-TA-97, Commission Memorandum Opinion, 215 U.S.P.Q. 229, 231 (1981).

#### **A. Subject Matter Jurisdiction**

Section 337 confers subject matter jurisdiction on the International Trade Commission to investigate, and if appropriate, to provide a remedy for, unfair acts and unfair methods of competition in the importation, the sale for importation, or the sale after importation of articles into the United States. (*See* 19 U.S.C. §§ 1337(a)(1)(B) and (a)(2).) Apple alleges in the



Complaint that Samsung has violated Subsection 337(a)(1)(B) in the importation and sale of products that infringe the asserted patents. (*See* Complaint.) Samsung has stipulated that it either imports or sells after importation in the United States the accused products in this investigation. (RIB at 14.) Accordingly, I find the Commission has jurisdiction over this investigation under Section 337 of the Tariff Act of 1930. *Amgen, Inc. v. U.S. Int'l Trade Comm'n*, 902 F.2d 1532, 1536 (Fed. Cir. 1990).

**B. Personal Jurisdiction**

Samsung does not dispute that the Commission has personal jurisdiction over them. (*See* RIB at 14.) Samsung has fully participated in the investigation by, among other things, participating in discovery, participating in the hearing, and filing pre-hearing and post-hearing briefs. Accordingly, I find that Samsung has submitted to the jurisdiction of the Commission. *See Certain Miniature Hacksaws*, Inv. No. 337-TA-237, Pub. No. 1948, Initial Determination at 4, 1986 WL 379287 (U.S.I.T.C., October 15, 1986) (unreviewed by Commission in relevant part).

**C. In Rem Jurisdiction**

The Commission has in rem jurisdiction over the products at issue by virtue of the above finding that the accused products have been imported into the United States. *See Sealed Air Corp. v. United States Int'l Trade Comm'n*, 645 F.2d 976, 985 (C.C.P.A. 1981).

**IV. Standards of Law**

**A. Claim Construction**

“An infringement analysis entails two steps. The first step is determining the meaning and scope of the patent claims asserted to be infringed. The second step is comparing the

PUBLIC VERSION

properly construed claims to the device accused of infringing.” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*) (internal citations omitted), *aff’d*, 517 U.S. 370 (1996). Claim construction is a “matter of law exclusively for the court.” *Id.* at 970-71. “The construction of claims is simply a way of elaborating the normally terse claim language in order to understand and explain, but not to change, the scope of the claims.” *Embrex, Inc. v. Serv. Eng’g Corp.*, 216 F.3d 1343, 1347 (Fed. Cir. 2000).

Claim construction focuses on the intrinsic evidence, which consists of the claims themselves, the specification, and the prosecution history. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (*en banc*); *see also Markman*, 52 F.3d at 979. As the Federal Circuit in *Phillips* explained, courts must analyze each of these components to determine the “ordinary and customary meaning of a claim term” as understood by a person of ordinary skill in art at the time of the invention. 415 F.3d at 1313. “Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language.” *Bell Atl. Network Servs., Inc. v. Covad Commc’ns Grp., Inc.*, 262 F.3d 1258, 1267 (Fed. Cir. 2001).

“It is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’” *Phillips*, 415 F.3d at 1312 (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)). “Quite apart from the written description and the prosecution history, the claims themselves provide substantial guidance as to the meaning of particular claims terms.” *Id.* at 1314; *see also Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1331 (Fed. Cir. 2001) (“In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to

‘particularly point [ ] out and distinctly claim [ ] the subject matter which the patentee regards as his invention.”). The context in which a term is used in an asserted claim can be “‘highly instructive.” *Phillips*, 415 F.3d at 1314. Additionally, other claims in the same patent, asserted or unasserted, may also provide guidance as to the meaning of a claim term. *Id.*

The specification “is always highly relevant to the claim construction analysis. Usually it is dispositive; it is the single best guide to the meaning of a disputed term.” *Id.* at 1315 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). “[T]he specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor’s lexicography governs.” *Id.* at 1316. “In other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor.” *Id.* As a general rule, however, the particular examples or embodiments discussed in the specification are not to be read into the claims as limitations. *Id.* at 1323. In the end, “[t]he construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be ... the correct construction.” *Id.* at 1316 (quoting *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)).

In addition to the claims and the specification, the prosecution history should be examined, if in evidence. *Id.* at 1317; *see also Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004). The prosecution history can “often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Phillips*, 415 F.3d at 1317; *see also Chimie v. PPG Indus. Inc.*, 402 F.3d

1371, 1384 (Fed. Cir. 2005) (“The purpose of consulting the prosecution history in construing a claim is to exclude any interpretation that was disclaimed during prosecution.”).

When the intrinsic evidence does not establish the meaning of a claim, then extrinsic evidence (*i.e.*, all evidence external to the patent and the prosecution history, including dictionaries, inventor testimony, expert testimony, and learned treatises) may be considered. *Phillips*, 415 F.3d at 1317. Extrinsic evidence is generally viewed as less reliable than the patent itself and its prosecution history in determining how to define claim terms. *Id.* at 1317. “The court may receive extrinsic evidence to educate itself about the invention and the relevant technology, but the court may not use extrinsic evidence to arrive at a claim construction that is clearly at odds with the construction mandated by the intrinsic evidence.” *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 977 (Fed. Cir. 1999).

If, after a review of the intrinsic and extrinsic evidence, a claim term remains ambiguous, the claim should be construed so as to maintain its validity. *Phillips*, 415 F.3d at 1327. Claims, however, cannot be judicially rewritten in order to fulfill the axiom of preserving their validity. *See Rhine v. Casio, Inc.*, 183 F.3d 1342, 1345 (Fed. Cir. 1999). Thus, “if the only claim construction that is consistent with the claim’s language and the written description renders the claim invalid, then the axiom does not apply and the claim is simply invalid.” *Id.*

## **B. Infringement**

### **1. Direct Infringement**

A complainant must prove either literal infringement or infringement under the doctrine of equivalents. Infringement must be proven by a preponderance of the evidence. *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 889 (Fed. Cir. 1988). A preponderance

of the evidence standard “requires proving that infringement was more likely than not to have occurred.” *Warner-Lambert Co. v. Teva Pharm. USA, Inc.*, 418 F.3d 1326, 1341 n.15 (Fed. Cir. 2005).

**a. Literal Infringement**

Literal infringement is a question of fact. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1332 (Fed. Cir. 2008). Literal infringement requires the patentee to prove that the accused device contains each and every limitation of the asserted claim(s). *Frank’s Casing Crew & Rental Tools, Inc. v. Weatherford Int’l, Inc.*, 389 F.3d 1370, 1378 (Fed. Cir. 2004). If any claim limitation is absent, there is no literal infringement of that claim as a matter of law. *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir. 2000.)

**b. Doctrine of Equivalents**

Where literal infringement is not found, infringement nevertheless can be found under the doctrine of equivalents. Determining infringement under the doctrine of equivalents “requires an intensely factual inquiry.” *Vehicular Techs. Corp. v. Titan Wheel Int’l, Inc.*, 212 F.3d 1377, 1381 (Fed. Cir. 2000). According to the Federal Circuit:

Infringement under the doctrine of equivalents may be found when the accused device contains an “insubstantial” change from the claimed invention. Whether equivalency exists may be determined based on the “insubstantial differences” test or based on the “triple identity” test, namely, whether the element of the accused device “performs substantially the same function in substantially the same way to obtain the same result.” The essential inquiry is whether “the accused product or process contain elements identical or equivalent to each claimed element of the patented invention[.]”

*TIP Sys., LLC v. Phillips & Brooks/Gladwin, Inc.*, 529 F.3d 1364, 1376-77 (Fed. Cir. 2008)

(citations omitted). Thus, if an element is missing or not satisfied, infringement cannot be found

under the doctrine of equivalents as a matter of law. *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538-39 (Fed. Cir. 1991).

## **2. Indirect Infringement**

### **a. Inducement**

Section 271(b) of the Patent Act prohibits inducement: “[w]hoever actively induces infringement of a patent shall be liable as an infringer.” 35 U.S.C. § 271(b). As the Federal Circuit stated:

To establish liability under section 271(b), a patent holder must prove that once the defendants knew of the patent, they “actively and knowingly aid[ed] and abett[ed] another’s direct infringement.” However, “knowledge of the acts alleged to constitute infringement” is not enough. The “mere knowledge of possible infringement by others does not amount to inducement; specific intent and action to induce infringement must be proven.”

*DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1305 (Fed. Cir. 2006) (en banc) (citations omitted); *See also Cross Medical Products, Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1312 (Fed. Cir. 2005) (“In order to succeed on a claim inducement, the patentee must show, first that there has been direct infringement, and second, that the alleged infringer knowingly induced infringement and possessed specific intent to encourage another’s infringement.”). Mere knowledge of possible infringement by others does not amount to inducement. Specific intent and action to induce infringement must be proven. *Warner-Lambert Co. v. Apotex Corp.*, 316 F.3d 1348, 1363 (Fed. Cir. 2003). In *DSU*, the Federal Circuit clarified the intent requirement necessary to prove inducement. As the court recently explained:

In *DSU Med. Corp. v. JMS Co.*, this court clarified en banc that the specific intent necessary to induce infringement “requires more than just intent to cause the acts that produce direct infringement. Beyond that threshold knowledge, the inducer must have an affirmative intent to cause direct infringement.”

*Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1354, (Fed. Cir. 2008) (citation omitted). “Proof of inducing infringement requires the establishment of a high level of specific intent.” *Lucent Techs. Inc. v. Gateway, Inc.*, 2007 WL 925510, at \*2-3 (S.D. Cal. 2007).

**b. Contributory Infringement**

Section 271(c) of the Patent Act provides:

Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

35 U.S.C. § 271(c). “Under 35 U.S.C. § 271(c), a party who sells a component with knowledge that the component is especially designed for use in a patented invention, and is not a staple article of commerce suitable for substantial noninfringing use, is liable as a contributory infringer.” *Wordtech Sys., Inc. v. Integrated Networks Solutions, Inc.*, 609 F.3d 1308, 1316 (Fed. Cir. 2010). “[N]on-infringing uses are substantial when they are not unusual, far-fetched, illusory, impractical, occasional, aberrant, or experimental.” *Vita-Mix Corp. v. Basic Holding, Inc.*, 581 F.3d 1317, 1327 (Fed. Cir. 2009). In assessing whether a use is substantial, the factfinder may consider “the use’s frequency, ... the use’s practicality, the invention’s intended purpose, and the intended market.” *i4i Ltd. P’ship v. Microsoft Corp.*, 598 F.3d 831, 851 (Fed. Cir. 2010).

**C. Validity**

It is Respondents’ burden to prove invalidity, and the burden of proof never shifts to the patentee to prove validity. *Scanner Techs. Corp. v. ICOS Vision Sys. Corp. N.V.*, 528 F.3d 1365,

1380 (Fed. Cir. 2008). “Under the patent statutes, a patent enjoys a presumption of validity, see 35 U.S.C. § 282, which can be overcome only through facts supported by clear and convincing evidence[.]” *SRAM Corp. v. AD-II Eng’g, Inc.*, 465 F.3d 1351, 1357 (Fed. Cir. 2006).

The clear and convincing evidence standard placed on the party asserting the invalidity defense requires a level of proof beyond the preponderance of the evidence. Although not susceptible to precise definition, “clear and convincing” evidence has been described as evidence which produces in the mind of the trier of fact “an abiding conviction that the truth of a factual contention is ‘highly probable.’” *Price v. Symsek*, 988 F.2d 1187, 1191 (Fed. Cir. 1993) (citing *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 1463 (Fed. Cir. 1988).)

“When no prior art other than that which was considered by the PTO examiner is relied on by the attacker, he has the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job[.]” *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir. 1984). Therefore, the challenger’s “burden is especially difficult when the prior art was before the PTO examiner during prosecution of the application.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1467 (Fed. Cir. 1990).

### **1. Anticipation**

“A patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention. Moreover, a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.” *Schering Corp. v. Geneva Pharm., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (citations omitted). “Inherency, however, may not be



established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 1269 (Fed.Cir.1991). To be considered anticipatory, a prior art reference must describe the applicant’s “claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000) (quoting *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994)). Anticipation is a question of fact. *Texas Instruments, Inc. v. U.S. Int’l Trade Comm’n*, 988 F.2d 1165, 1177 (Fed. Cir. 1993).

## **2. Obviousness**

Under 35 U.S.C. § 103(a), a patent is valid unless “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a). The ultimate question of obviousness is a question of law, but “it is well understood that there are factual issues underlying the ultimate obviousness decision.” *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1479 (Fed. Cir. 1997); *Wang Lab., Inc. v. Toshiba Corp.*, 993 F.2d 858, 863 (Fed. Cir. 1993). The underlying factual determinations include: (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the claimed invention and the prior art, and (4) objective indicia of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Although the Federal Circuit has historically required that, in order to prove obviousness, the patent challenger must demonstrate, by clear and convincing evidence, that there is a

“teaching, suggestion, or motivation to combine,” the Supreme Court has rejected this “rigid approach.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417-418 (2007). In *KSR*, the Supreme Court described a more flexible analysis:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue... As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

*Id.* Since *KSR* was decided, the Federal Circuit has announced that, where a patent challenger contends that a patent is invalid for obviousness based on a combination of prior art references, “the burden falls on the patent challenger to show by clear and convincing evidence that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, . . . and would have had a reasonable expectation of success in doing so.” *PharmaStem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007).

### **3. Written Description (35 U.S.C. §112)**

The hallmark of the written description requirement is the disclosure of the invention. *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The test for determining the sufficiency of the written description in a patent requires “an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Id.* Compliance with the written description requirement is a question of fact and “the level of detail

required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.*

#### **4. Enablement**

Thirty-five U.S.C. § 112 sets forth the enablement requirement:

[t]he specification shall contain a written description of the invention, and the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

35 U.S.C. § 112, ¶ 1. “To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365 (Fed.Cir.1997) (quoting *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993)). Enablement serves the dual function in the patent system of ensuring adequate disclosure of the claimed invention and of preventing claims broader than the disclosed invention. *MagSil Corp. v. Hitachi Global Storage Technologies, Inc.*, 687 F.3d 1377, 1380 -1381 (Fed. Cir. 2012). “The scope of the claims must be less than or equal to the scope of the enablement to ensure that the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims.” *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2008) (quoting *Nat’l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1195-96 (Fed. Cir. 1999)). The enablement determination proceeds as of the effective filing date of the patent. *Plant Genetic Sys., N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1339 (Fed. Cir. 2003).

#### **D. Domestic Industry**

In a patent-based complaint, a violation of section 337 can be found “only if an industry in the United States, relating to the articles protected by the patent ... concerned, exists or is in

the process of being established.” 19 U.S.C. § 1337(a)(2). Under Commission precedent, this “domestic industry requirement” of section 337 consists of an economic prong and a technical prong. *Certain Stringed Musical Instruments and Components Thereof*, Inv. No. 337-TA-586, Comm’n Op. at 12-14, 2009 WL 5134139 (U.S.I.T.C. Dec. 2009). The complainant bears the burden of establishing that the domestic industry requirement is satisfied. *See Certain Set-Top Boxes and Components Thereof*, Inv. No. 337-TA-454, Final Initial Determination at 294, 2002 WL 31556392 (U.S.I.T.C. June 21, 2002) (unreviewed by Commission in relevant part).

**1. Economic Prong**

The economic prong of the domestic industry requirement is defined in subsection 337(a)(3) as follows:

(3) For purposes of paragraph (2), an industry in the United States shall be considered to exist if there is in the United States, with respect to the articles protected by the patent, copyright, trademark or mask work concerned --

(A) Significant investment in plant and equipment;

(B) Significant employment of labor or capital; or

(C) Substantial investment in its exploitation, including engineering, research and development, or licensing.

19 U.S.C. § 1337(a)(3). The economic prong of the domestic industry requirement is satisfied by meeting the criteria of any one of the three factors listed above.

Section 337(a)(3)(C) provides for domestic industry based on “substantial investment” in the enumerated activities, including licensing of a patent. *See Certain Digital Processors and Digital Processing Systems, Components Thereof, and Products Containing Same*, Inv. No. 337-TA-559, Initial Determination at 88 (May 11, 2007) (“Certain Digital Processors”). Mere ownership of the patent is insufficient to satisfy the domestic industry requirement. *Certain*

*Digital Processors* at 93 (citing the Senate and House Reports on the Omnibus Trade and Competitiveness Act of 1988, S.Rep. No. 71). However, entities that are actively engaged in licensing their patents in the United States can meet the domestic industry requirement. *Certain Digital Processors* at 93. In establishing a domestic industry under Section 337(a)(3)(C), the complainant does not need to show that it or one of its licensees is practicing a patent-in-suit. *See Certain Semiconductor Chips with Minimized Chip Package Size and Products Containing Same*, Inv. No. 337-TA-432, Order No. 13, at 11, (January 24, 2001) (“Certain Semiconductor Chips”).

In *Certain Multimedia Display & Navigation Devices & Systems, Components Thereof, & Products Containing Same*, Inv. No. 337-TA-694, Comm’n Op. (Aug. 8, 2011) (“*Multimedia Display*”), the Commission stated that a complainant seeking to rely on licensing activities must satisfy three requirements: (1) the investment must be “an investment in the exploitation of the asserted patent;” (2) the investment must relate to licensing; and (3) the investment “must be domestic, *i.e.*, it must occur in the United States.” *Id.* at 7-8. The Commission stated that “[o]nly after determining the extent to which the complainant’s investments fall within these statutory parameters can we evaluate whether complainant’s qualifying investments are ‘substantial,’ as required by the statute.” *Id.* at 8.

Under the first of the three requirements, the complainant must show a nexus between the licensing activity and the asserted patent. *Id.* at 9. When the asserted patent is part of a patent portfolio, and the licensing activities relate to the portfolio as a whole, the Commission requires that the facts be examined to determine the strength of the nexus between the asserted patent and the licensing activities. *Id.* The Commission provided a non-exhaustive list of factors to

consider, such as (1) whether the licensee's efforts relate to "an article protected by" the asserted patent under Section 337 (a)(2)-(3); (2) the number of patents in the portfolio; (3) the relative value contributed by the asserted patent to the portfolio; (4) the prominence of the asserted patent in licensing discussions, negotiations, and any resulting licensing agreement; and (5) the scope of technology covered by the portfolio compared to the scope of the asserted patent. *Id.* at 9-10.

The Commission explained that the asserted patent may be shown to be particularly important or valuable within the portfolio where there is evidence that: (1) it was discussed during licensing negotiations; (2) it has been successfully litigated before by the complainant; (3) it is related to a technology industry standard; (4) it is a base patent or pioneering patent; (5) it is infringed or practiced in the United States; or (6) the market recognizes the patent's value in some other way. *Id.* at 10-11.

Once a complainant's investment in licensing the asserted patent in the United States has been assessed in the manner described above, the next inquiry is whether the investment is "substantial." 19 U.S.C. § 1337(a)(3)(C). The Commission takes "a flexible approach whereby a complainant whose showing on one or more of the three section 337(a)(3)(C) requirements is relatively weak may nevertheless establish that its investment is 'substantial' by demonstrating that its activities and/or expenses are of a large magnitude." *Multimedia Display and Navigation Devices*, Comm'n Op. at 15. The Commission has indicated that whether an investment is "substantial" may depend on:

- (1) the nature of the industry and the resources of the complainant;
- (2) the existence of other types of "exploitation" activities;
- (3) the existence of license-related "ancillary" activities;

- (4) whether complainant's licensing activities are continuing; and
- (5) whether complainant's licensing activities are the type of activities that are referenced favorably in the legislative history of section 337(a)(3)(C).

*Id.* at 15-16. The complainant's return on its licensing investment (or lack thereof) may also be circumstantial evidence of substantiality. *Id.* at 16. In addition, litigation expenses may be evidence of the complainant's investment, but "should not automatically be considered a 'substantial investment in . . . licensing,' even if the lawsuit happens to culminate in a license." See *John Mezzalingua Associates, Inc. v. U.S. Int'l Trade Comm'n*, --- F.3d ---, 2011 U.S. App. LEXIS 20128 at \*13 (Fed. Cir. Oct. 4, 2011).

## **2. Technical Prong**

The technical prong of the domestic industry requirement is satisfied when the complainant in a patent-based section 337 investigation establishes that it is practicing or exploiting the patents at issue. See 19 U.S.C. §1337 (a)(2) and (3); *Certain Microsphere Adhesives, Process for Making Same and Prods. Containing Same, Including Self-Stick Repositionable Notes*, Inv. No. 337-TA-366, Comm'n Op. at 8, 1996 WL 1056095 (U.S.I.T.C. Jan. 16, 1996). "In order to satisfy the technical prong of the domestic industry requirement, it is sufficient to show that the domestic industry practices any claim of that patent, not necessarily an asserted claim of that patent." *Certain Ammonium Octamolybdate Isomers*, Inv. No. 337-TA-477, Comm'n Op. at 55 (U.S.I.T.C., Jan. 2004).

The test for claim coverage for the purposes of the technical prong of the domestic industry requirement is the same as that for infringement. *Certain Doxorubicin and Preparations Containing Same*, Inv. No. 337-TA-300, Initial Determination at 109, 1990 WL

710463 (U.S.I.T.C., May 21, 1990), *aff'd*, Views of the Commission at 22 (October 31, 1990); *Alloc, Inc. v. Int'l Trade Comm'n*, 342 F.3d 1361, 1375 (Fed. Cir. 2003). “First, the claims of the patent are construed. Second, the complainant’s article or process is examined to determine whether it falls within the scope of the claims.” *Certain Doxorubicin and Preparations Containing Same*, Initial Determination at 109. To prevail, the patentee must establish by a preponderance of the evidence that the domestic product practices one or more claims of the patent. The technical prong of the domestic industry can be satisfied either literally or under the doctrine of equivalents. *Certain Dynamic Sequential Gradient Devices and Component Parts Thereof*, Inv. No. 337-TA-335, Initial Determination at 44, Pub. No. 2575 (U.S.I.T.C., November 1992).

**V. U.S. Patent No. D558,757**

**A. Introduction**

U.S. Patent No. D588,757 (“the D’757 patent”), titled “Electronic Device,” issued on January 1, 2008. (JX-0001 at 2.) The D’757 patent issued from U.S. Patent App. Serial No. 29/270,885, filed on January 5, 2007. (*Id.*) The inventors are Bartley K. Andre, Daniel J. Coster, Daniele De Iuliis, Richard P. Howarth, Jonathan P. Ive, Steve Jobs, Duncan Robert Kerr, Shin Nishibori, Matthew Dean Rohrbach, Douglas B. Satzger, Calvin Q. Seid, Christopher J. Stringer, Eugene Antony Whang, and Rico Zorkendorfer. (*Id.*) The D’757 patent is assigned to Apple, Inc. (*Id.*)

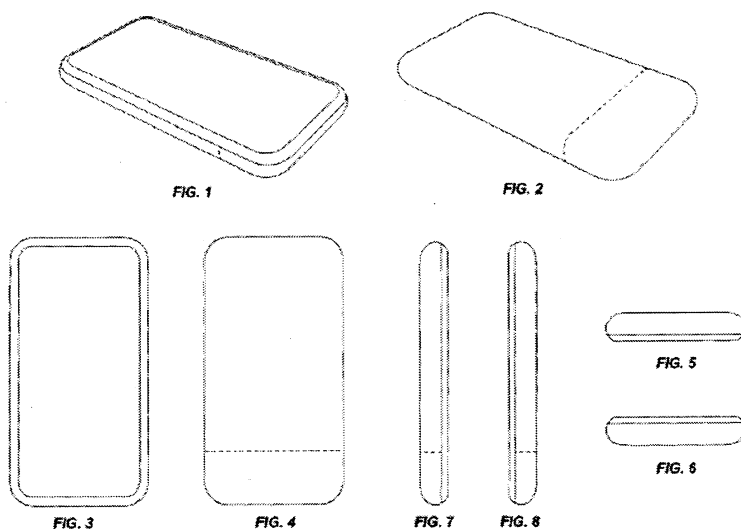
**B. Asserted Claims**

The D’757 is a design patent and as such has only one claim, which reads as follows:

We claim the ornamental design for an electronic device, substantially as shown and described.



(*Id.*) The figures from the D'757 patent are reproduced below.



[JX-0001 D'757, Figs. 1-8]

### C. Level of Ordinary Skill in the Art

Apple suggests a person of ordinary skill in the relevant art is one holding a Bachelor of Science degree or its equivalent in industrial or product design, and having at least two years of work experience as an industrial designer, including experience in the design of electronic devices. (CIB at 30.) The Staff suggests the designer of ordinary skill in the art pertaining to the D'757 patent is a person who holds a Bachelor of Science degree or its equivalent in industrial or product design and has at least two years of work experience as an industrial designer, including experience in the design of electronic devices. (SIB at 22.) Samsung suggests a person of ordinary skill in the art relevant to Apple's asserted design patents would have experience designing electronic devices including, but not limited to, mobile devices, such as cellular telephone handsets and other electronic devices, or be a designer in academia who conducted research on the interface of products to people or taught industrial design students the design of

electronic devices. (RIB at 64, 103.) Whereas Apple cites to the testimony of its expert in support of its proposed level of ordinary skill, Samsung relies only on attorney argument.

In light of the evidence, I find that a designer of ordinary skill in the art pertaining to the D’757 patent is a person who holds a Bachelor of Science degree or its equivalent in industrial or product design and has at least two years of work experience as an industrial or product designer, including experience in the design of electronic devices.

**D. Claim Construction**

The infringement analysis for a design patent begins with construing the claimed design. *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1319 (Fed. Cir. 2007).

“A design patent protects the nonfunctional aspects of an ornamental design as shown in the patent.” *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) (citing *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993)). The design patent claim scope thus “encompasses its visual appearance as a whole, and in particular the visual impression it creates.” *Arminak & Assocs.*, 501 F.3d at 1319-20 (internal quotations omitted). Design patents do not cover broad design concepts, however, and are limited by the specific ornamental features depicted in the patent. *See OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (finding that proper construction did not encompass broad design concept of “rocket-like tossing ball”); *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (finding the district court properly avoided the “broader general design concept” in construing patent).

The Court of Appeals for the Federal Circuit has cautioned trial courts to avoid excessive reliance on a detailed verbal description of the design in construing the claim. *Crocs, Inc. v. ITC*,

598 F.3d 1294, 1302 (Fed. Cir. 2010) (citing *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc)). “Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design.” *Egyptian Goddess, Inc.*, 543 F.3d at 679. A court’s decision regarding the level of detail to be used in describing the claimed design, though, “is a matter within the court’s discretion, and absent a showing of prejudice, the court’s decision to issue a relatively detailed claim construction will not be reversible error.” *Id.*

Although the Federal Circuit has repeatedly cautioned about the dangers of presenting a full description of the claimed design, the Federal Circuit has nevertheless stated that a court may find it helpful to point out various features of the claimed design in relation to the accused design and the prior art. *See Egyptian Goddess, Inc.*, 543 F.3d at 680 (“In a case such as this one, for example, there would be nothing wrong with the court pointing out to a jury that in the patented design only three sides have buffers attached, while in the accused product (and in the three-sided Nailco patent), all of the sides have buffers attached.”). The trial court may also address particular conventions in design patent drafting, such as the role of dashed lines. *Contessa Food Prods., Inc.*, 282 F.3d at 1378 (approving the district court’s explanation of the use of dashed lines in the asserted design patent).

### **Parties’ Positions**

Apple describes the D’757 design as:

[A] rectangular body with a flat front surface and evenly curved corners. The flat front surface is encircled by a thin, continuous, and uniform bezel that is flush with the front face and curves to meet the sides of the device. The back of the device is continuous and the edges are curved toward the front face. The design

PUBLIC VERSION

has a thin overall profile. One design element—a line across the lower portion of the back—is shown using broken lines and is therefore unclaimed.

From the perspective view of figure 1, it is clear that a flat front surface exists inside of the claimed bezel and is flush with the level of the bezel. This interpretation is corroborated by the front elevation of figure 3, which shows an unshaded front surface that runs all the way to, and meets with, the bezel, and by the profile elevations of Figures 5-8, which show that the front surface is flat.

(CIB at 35-36.) Apple further characterizes the overall impression of the design as an electronic device with “smooth, continuous surfaces and rounded corners [with] a strong statement of continuity and harmony by encircling the oily pond with a uniform, thin, metallic bezel [that is] delicate and unbroken by any buttons, ports, or screws.” (CIB at 42.) Apple’s expert, Mr. Stringer, summarized the overall appearance of the design as “an aesthetic impression of simplicity, calm, and quiet.” (*Id.*)

The Staff believes that Apple’s constructions should be adopted. (SIB at 18-19.)

Samsung presents a somewhat narrower interpretation of the D’757 patent. Samsung advocates construing the D’757 design as an electronic device with an opaque, non-reflective front surface, a front surface devoid of any ornamentation or detail except the bezel, a flat rear surface that is smooth and devoid of any detail, except for an optional parting line in the lower portion, no physical buttons or ports on the side or top edges, a bezel that wraps around the front of the entire device, having a uniform thickness at all points, and showing the precise width and shape from the front, sides and top, a side profile that has continuous and perfectly even curves from back to front, in the precise shape and proportions shown, creating a generally oblong shape and a front face that is co-planar with the bezel. (RIB at 27-30.) Samsung contends that Apple conceded that the D’757 does not claim a transparent or reflective front surface because its drawings lack oblique line shading. (*Id.* at 28.)

Samsung argues that Apple's broad construction would apply to the prior art as well, including JP D1250487 (RX-2750), D'889 (RX-0485), and KR-30-0304213 (RX-0371) and thus such a construction is inappropriate. (RIB at 26, 32-38.) Samsung also contends that factors such as the cost of the D'757 Accused Products warrants a greater attention to detail. (*Id.* at 31.) Samsung additionally contends that the design depicted in the D'757 patent is not the proper subject for design patent protection due to its lack of ornamentation. (*Id.* at 29-30.)

### **Analysis**

Samsung contends that Apple's construction is so broad it would apply to the prior art as well and thus such a generic construction is inappropriate. (RIB at 26 and 33-38.) Samsung failed to argue that the scope of the D'757 patent was narrowed by the prior art in its prehearing brief, and thus this argument is deemed waived. (Ground Rule 9.2.) Even if not waived, however, this argument still fails because there is no legal support for considering the prior art for purposes of limiting and defining the scope of the claims. The Federal Circuit described the prior art only as "a frame of reference" for the ordinary observer test, not as a claim construction tool:

[I]t can be difficult to answer the question whether one thing is like another without being given a frame of reference. The context in which the claimed and accused designs are compared, *i.e.*, the background prior art, provides such a frame of reference and is therefore often useful in the process of comparison.

*Egyptian Goddess*, 543 F.3d at 677. In using the prior art as a frame of reference for the comparison step of the infringement analysis, the Court compared the accused nail buffer design to the patented nail buffer design and considered whether an ordinary observer would find the accused design to be closer to the patented design than to the prior art. *Id.* at 682. Nothing in

*Egyptian Goddess*, or any other case I could find supports using, the prior art to “limit the scope” of an asserted design patent for claim construction purposes as Samsung suggests.<sup>1</sup>

I have decided not to provide a verbal construction of the claim. I find that the drawings of the D’757 patent speak for themselves and thus construe the claims of the D’757 to cover the design for an electronic device as depicted in FIGS. 1-8 of the D’757 patent. I also find that the patent does not claim a reflective or shiny front face as the drawings depicting the front surface lack oblique line shading. MPEP § 1503.02(II) (“Oblique line shading must be used to show transparent, translucent and highly polished or reflective surfaces.”). Additionally, I find, and Apple and Samsung appear to agree, that the patent covers a front face with a single plane, as the drawings depicting the front surface lack dimensional shading, particularly where the front bezel meets the front face. (*Id.*)

---

<sup>1</sup> Samsung also contends that the design depicted in the D’757 patent is not the proper subject for design patent protection due to its lack of ornamentation. (RIB at 29-30.) Samsung alleges the D’757 patent expressly claims “the ornamental design for an electronic device, substantially as shown and described” and that “the article of manufacture to which the ornamental design has been applied is an electronic device.” (JX-0001 at 1). Further, Samsung argues the current Patent Act states that a design patent issues only for a “new, original, and ornamental design for an article of manufacture.” 35 U.S.C. § 171 (emphasis added). Samsung contends that the statute does not offer protection for the configuration or shape of an article of manufacture absent the ornamental features. In interpreting what “ornamental design” includes, however, the Federal Circuit’s predecessor court made clear that “Section 171 refers, not to the design of an article, but to a design for an article, and is inclusive of ornamental designs of all kinds including surface ornamentation as well as configuration of goods.” *In re Zahn*, 617 F.2d 261, 268 (C.C.P.A. 1980) (emphasis added). The MPEP is in accord: “Since a design is manifested in appearance, the subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation.” MPEP § 1502. Accordingly, I do not find Samsung’s argument persuasive. I have addressed this issue in the claim construction section because this is the section in which Samsung raises the argument.

## E. Infringement

After the claims have been construed, the court must consider if the patented design is infringed by the accused product. *Arminak & Assocs.*, 501 F.3d at 1320. Design patent infringement is a question of fact, which a patentee must prove by a preponderance of the evidence. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993). The sole test for determining infringement of a design patent is the “ordinary observer” test. *See e.g., Egyptian Goddess, Inc.*, 543 F.3d at 678. In defining the “ordinary observer test,” the Supreme Court stated:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

*Gorham Mfg. Co. v. White*, 81 U.S. 511, 20 L. Ed. 731, 732 (1871). Thus, the “ultimate question [of whether a design patent is infringed] requires determining whether ‘the effect of the whole design [is] substantially the same’.” *L.A. Gear, Inc.*, 988 F.2d at 1125 (quoting *Gorham*, 81 U.S. at 530). The test is not a comparison of one product to another, but instead is a comparison of the patented *design* to the allegedly infringing *design*. *See Gorham Mfg. Co. v. White*, 81 U.S. at 529 (“The *Gorham design*, and the two *designs* sold by the defendant, which were patented to White, one in 1867, and the other in 1868, are alike the result of peculiarities of outline, or configuration, and of ornamentation. These make up whatever is distinctive in appearance, and of these, the outline or configuration is most impressive to the eye. Comparing the figure or outline of the plaintiffs’ *design* with that of the White *design* of 1867, it is apparent there is no substantial difference.” (*emphasis added*)).

PUBLIC VERSION

In assessing infringement, the patented and accused designs do not have to be identical in order for design patent infringement to be found. *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 820 (Fed. Cir. 1992). What is controlling is the appearance of the patented design as a whole in comparison to the accused design. *OddzOn Prods., Inc.*, 122 F.3d at 1405. To assist in determining whether the two designs would be considered “substantially the same” by an ordinary observer, a comparison of the claimed and accused designs with the prior art may be beneficial. *See Egyptian Goddess, Inc.*, 543 F.3d at 677.

Samsung argues vociferously that to prove infringement of a design patent, the patent owner must show “deceptive similarity.” (RIB at 20.) In the context of this investigation, Samsung argues that “Apple introduced no evidence that the hypothetical ordinary observer, paying as much attention as a normal smartphone purchaser would pay and considering all claimed views of the asserted designs, ‘*would be deceived*’ into thinking that any of the accused Samsung phones are the same as either asserted design patent.” (*Id.* (emphasis in original).) To support this argument Samsung relies on the following oft cited and paraphrased quote from *Gorham*:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

*Gorham Co. v. White*, 81 U.S. 511, 528 (1872). Samsung argues, citing to a number of cases, that the Federal Circuit continues to rely on a showing of deceptive similarity. See e.g., *Egyptian Goddess*, 543 F.3d at 681 (The question in a design patent case “is whether an ordinary observer, familiar with the prior art ... designs, would be deceived into believing the [accused product] is the same as the patented design.”); *Crocs, Inc. v. International Trade Comm’n*, 598 F.3d 1294,



1303 (Fed. Cir. 2010.) (“To show infringement under the proper test, an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused product is the same as the patented design.”); *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1313 (Fed. Cir. 2001) (“Two designs are substantially the same if their resemblance is deceptive to the extent it would induce an ordinary observer, giving such attention as a purchaser usually gives, to purchase an article having one design supposing it to be the other.”).

While it is true that the quotes cited by Samsung in isolation may appear to suggest that the test for design patent infringement requires an affirmative showing that an ordinary observer would be deceived into thinking the accused design is the patented design, I believe such a conclusion would be error and that Samsung misunderstands both the Supreme Court’s and Federal Circuit’s teachings. Contrary to Samsung’s argument, I do not find deceptive similarity to be a prerequisite to a finding of infringement, but merely a consequence, or result, of the designs being substantially the same.

Starting with *Gorham*, I note the Court there began its analysis by stating, “The sole question is one of fact. Has there been an infringement? Are the designs used by the defendant substantially the same as that owned by the complainants?” *Gorham*, 81 US at 524. The Court did not ask whether one was, or would have been, deceived by the defendant’s designs, only whether the accused designs were substantially the same as the patented design. The Supreme Court went on to state that “[i]f, then, identity of appearance, or (as expressed in *McCrea v. Holdsworth*) sameness of effect upon the eye, is the main test of substantial identity of design, the only remaining question upon this part of the case is, whether it is essential that the

appearance should be the same to the eye of an expert.”<sup>2</sup> *Id.* at 527. Again, the Court confirms the test for infringement is identity of appearance (*i.e.*, the sameness of the effect upon the eye), not whether one would be deceived by the accused designs. Further, the Court held that “whatever differences there may be between the plaintiffs’ design and those of the defendant in details of ornament, they are still the same in general appearance and effect, so much alike that in the market and with purchasers they would pass for the same thing—so much alike that even persons in the trade would be in danger of being deceived.” *Id.* at 531. Here the Court’s language makes clear that it is the sameness in “general appearance and effect” that leads to the “danger of being deceived.”

Next, I turn to the Federal Circuit’s opinion in *Egyptian Goddess*. Contrary to the selective quote by Samsung, the Federal Circuit specifically confirmed in *Egyptian Goddess* that the test for design patent infringement was whether the claimed design and accused design are “substantially the same” to an ordinary observer.

In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the patentee has not met its burden of proving the two designs would appear “substantially the same” to the ordinary observer, as required by *Gorham*.

*Egyptian Goddess*, 543 F.3d at 678; *see also id.* at 682 (“In light of the similarity of the prior art buffers to the accused buffer, we conclude that no reasonable fact-finder could find that EGI met its burden of showing, by a preponderance of the evidence, that an ordinary observer, taking into account the prior art, would believe the accused design to be the same as the patented design.”).

---

<sup>2</sup> I am acutely aware that the test has not involved an expert, but requires “the eye of an ordinary observer giving such attention as a purchaser usually gives” since the time of *Gorham*.

Moreover, the court made clear that the deception results from the substantial similarity between the accused design and patented design, stating that:

In the language used by the Supreme Court in *Gorham*, 81 U.S. at 528, we hold that the accused design could not reasonably be viewed as so similar to the claimed design that a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs, “inducing him to purchase one supposing it to be the other.”

*Id.* at 683. Other Federal Circuit decisions are in accord. *Crocs*, 598 F.3d at 1303 (“In other words, “the deception that arises is a result of the similarities in the overall design, not of similarities in ornamental features in isolation.”); *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir 2010.)

Accordingly, I do not find that *Gorham*, or any other of the design patent cases I have reviewed, supports the notion that there need be an affirmative showing of deceptive similarity to prove design patent infringement. In accordance with Supreme Court and Federal Circuit precedent, I find that the sole test for design patent infringement is whether the claimed design is “substantially the same” as the accused design in the eye of the ordinary observer, giving such attention as a purchaser usually gives. It is not, as the Supreme Court held in *Gorham*, the eye of the expert. Thus, I do not find Apple’s expert Dr. Bressler’s failure to consider whether an ordinary observer would be deceived by the accused designs fatal to Apple’s infringement contentions.

### **The Parties’ Positions**

Apple alleges that certain Samsung products infringe the claimed design of the D’757 patent. (CIB at 46.) Apple argues that the Galaxy S 4G is a representative product for the purposes of its infringement analysis. (*Id.* at 43.) Apple expert Mr. Bressler argues that the

PUBLIC VERSION

Galaxy S 4G and D'757 patent designs contain the same major visual elements, including: the same rectangular overall shape and proportion, a flat front face, curved corners, a thin continuous bezel that curves toward the front face, and rounded edges that contiguously connect with the bezel from the continuous back surface. (*Id.* at 46.) Apple also contends that with respect to each of the selected pieces of prior art, all of the products accused of infringing the D'757 patent “appear more similar to the D'757 design” than they do to any piece of prior art. (*Id.*) Apple argues that “Their flat faces and overall body shapes provide substantially the same overall visual impression as the design claimed in the D'757 Patent.” (*Id.*)

Apple also contends that although there are some differences between the claimed design and the design of the accused products, the differences did not alter the overall impression of the designs. (*Id.* at 47.) Apple also argues that features on the back of the accused products should be given less weight because the ordinary observer’s overall impression of the Apple designs is derived primarily from the front surface of the phone, particularly because of the striking nature of this aspect of the Apple design and its departure from the prior art. (*Id.*) According to Apple, although the back surface contributes to the overall impression, it does not have as strong of an influence as the front surface on the overall impression. (*Id.*)

The Staff argues that Apple expert Mr. Bressler applied the correct test in determining that the D'757 patent is infringed by the accused products. (SIB at 26.) The Staff argues that the D'757 Accused Products infringe the D'757 design. (*Id.*)

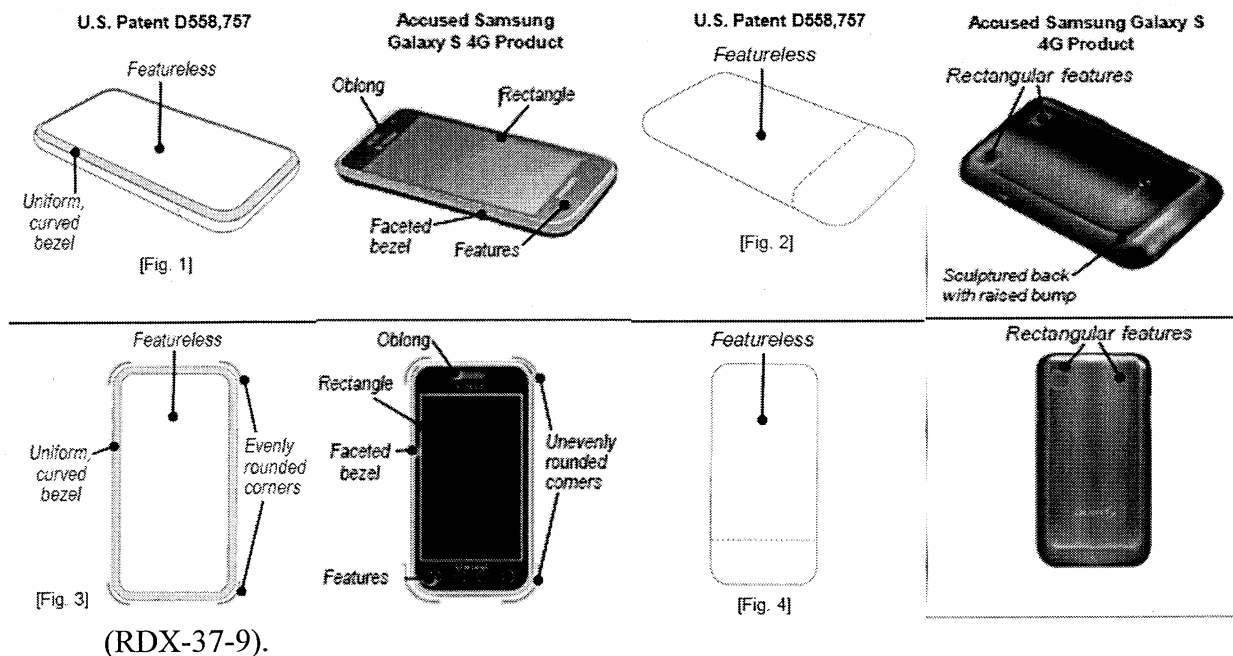
Samsung contends Apple has not met its burden of showing that an ordinary observer, giving such attention as a purchaser usually gives to the types of products at issue, looking at all

views, and familiar with the prior art, would be deceived into believing the D'757 Accused Products are the same design as that which is disclosed in Apple's D'757 patent. (RIB at 30.)

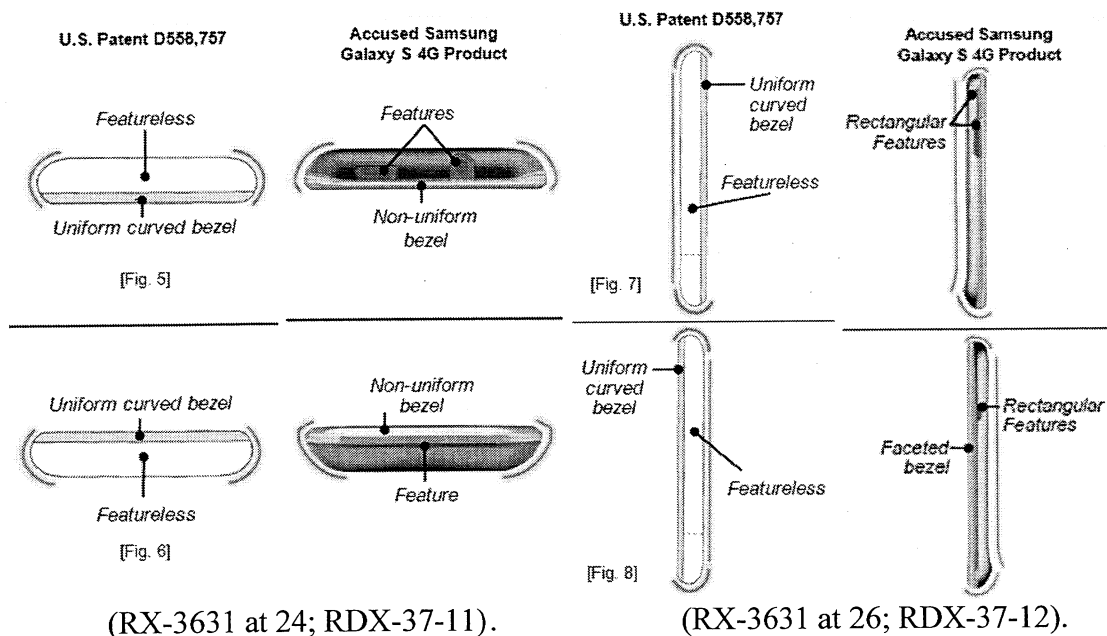
Samsung first contends the D'757 Accused Products do not infringe the claims of the D'757 patent in view of the prior art. (RIB at 32-38.) Samsung then argues the D'757 Accused Products do not infringe the claim of the D'757 patent in view of the differences between the claimed design and the D'757 accused products which are common to all products. (RIB at 38-42.) Samsung argues that the overall shape of the D'757 Accused Products differs from the patented design. (*Id.* at 40-41.) Samsung contends none of the accused devices have an even, continuous curve in their corners and edges, and they do not have oblong profiles shown in the D'757 patent. (*Id.*)

In addition, Samsung argues that additional features of the D'757 Accused Products not present in the patented design further distinguish the accused designs from the claimed design. (RIB at 38-42.) First, Samsung argues the D'757 Accused Products all have reflective front surfaces with rectangular display screens that do not take up the entirety of the front face. (RIB at 39-40.) Samsung contends Apple's expert testified both that reflectivity and transparency were the dominant characteristic of the D'757 Accused Products and that these features were not claimed by the D'757 patent. (RIB at 39-40.) In addition, Samsung contends that unlike D'757, which Apple admits is "lacking in ornamentation" aside from a bezel around the front surface, the D'757 Accused Devices have openings on the front surfaces for the receiver or earpiece, and soft key buttons near the bottom of the front face with graphical icons to denote touch sensitive areas. (*Id.* at 40.) Samsung also argues that the D'757 Accused Products have circular sensors near the receiver at the top of the front face and physical buttons and ports on the side, top and/or

bottom edges. (*Id.*) Furthermore, Samsung argues the D'757 Accused Products have features on the rear surfaces, including camera windows and other features that D'757 design lacks. (*Id.*) Samsung illustrates these differences as exemplified by the Galaxy S 4G in the figures shown below.<sup>3</sup>



<sup>3</sup> Even though I am basing this decision upon a comparison of the **physical** products with the patented design, I have included images herein for a frame of reference. In so doing, I note the images of any products (Apple or Samsung) and any prior art or alternative designs compared to the asserted design patents have been resized while maintaining their aspect ratio so that they better correspond with each other. Resizing the images so that they are on the same scale as the patent figures allows for ease of comparison between the products or prior art and Apple's claimed design. *See also Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1196-97 (Fed. Cir. 1995) (finding that trial court incorrectly considered size as part of its infringement analysis).



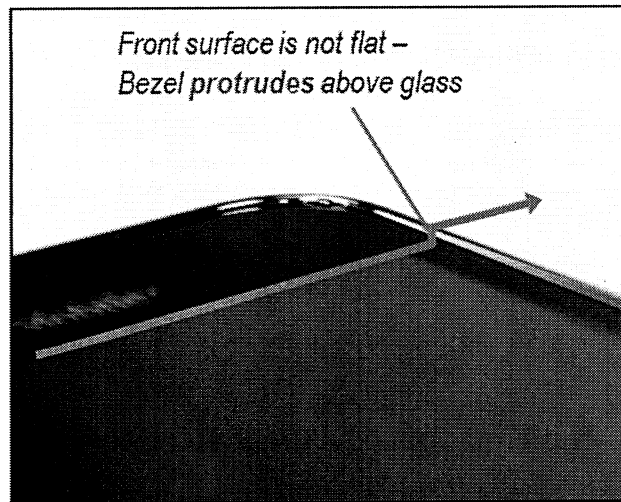
Samsung also contends that factors such as the high cost of the D’757 Accused Products warrants a greater attention to detail. (RIB at 31.)

In addition to the general arguments above, Samsung specifically addresses each of the D’757 Accused Devices.

#### Galaxy S 4G SGH-T959V and Vibrant SGH-T959

In addition to the common differences already noted and shown above such as the curvature of the corners and side faces, the reflective front surface and the additional features, Samsung contends an ordinary observer when viewing the accused products in their entirety will notice the non-flat back with a sculptured protrusion in the lower portion. (RIB at 42-43.) Unlike the rear of the D’757 patent, which is flat across the entire back and wraps in a continuous, even curve up to the bezel, Samsung argues that both the Galaxy S 4G and the Vibrant have a prominent “bump” on the back that an ordinary observer would both see and feel

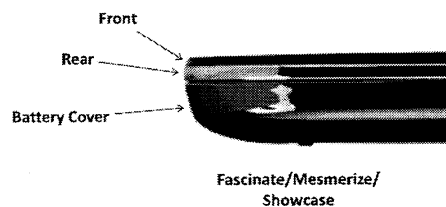
when considering the products' overall impressions. (*Id.*) In addition, Samsung argues the bezels also protrude above the surface of the glass, as admitted by Apple's expert. (*Id.*)



Samsung Galaxy S 4G (RPX-149)

Mesmerize SCH-I500, Fascinate SCH-I500 and Showcase SCH-I500

In addition to the differences common to all accused Samsung products as compared with the D'757 patent, Samsung states that the Mesmerize, Showcase and Fascinate have a "bezel," shown below, that is divided into front and rear parts, sometimes called a "double ring bezel," that does not have a curve or sloping shape, unlike the D'757 patent's single portion bezel. (RIB at 43-44.)



(RX-3444C at 29 (RDX-2-1)).

Samsung contends that the Mesmerize, Showcase and Fascinate also have a different shape in the profile view, appearing to have almost perpendicular edges that taper in slightly



toward the rear surface, with different curvature of the sides of the device than the D'757 patent. (RIB at 43-44). In addition to distinguishing the overall visual impression of these phones from the D'757, Samsung argues these changes in shape produce a different tactile impression in the hand that the ordinary observer would readily notice. (*Id.* at 44.)

Transform SPH-M920

In addition to the differences common to all accused Samsung products as compared with the D'757 patent, Samsung argues the Transform is a slider phone. Samsung argues it has a bezel that is much thicker in proportion to the device than the D'757 patent's bezel to accommodate the additional hardware required for the sliding keyboard. Samsung argues the Transform also has a contrasting band underneath the bezel—between it and the battery cover—which could be seen as a “double ring bezel.” (RIB at 44-45.) Samsung also notes the Transform has a different shape in the profile view with a much flatter curve on the sides of the device than the D'757 patent, and it has a sculptured or non-planar back, with a feature protruding from the lower portion of the back, unlike the rear of the D'757 patent. (*Id.*) Samsung contends that because each element of the designs is visibly different, the overall impression of the Transform is sufficiently different from the D'757 not to be deceiving. (*Id.*)

Galaxy Player 5.0 YP-G70/NAW

In addition to the differences common to all accused Samsung products as compared with the D'757 patent, Samsung argues the Galaxy Player 5.0, shown below, has a bezel that is thinner in proportion to the device and a different shape than the bezel of the D'757 patent. (RIB at 46-47). Samsung then argues the side profile does not have a continuous curve, but appears to have almost perpendicular side edges that taper in toward the rear surface. (*Id.*) Samsung also

argues that the Galaxy Player 5.0 has a back with sharper edges at the top and bottom portions than the D'757 patent. (*Id.*) Additionally, Samsung argues that the top edge of the Galaxy Player 5.0 is substantially flat, unlike D'757. (*Id.*) Samsung argues that because each element of the designs is visibly different, the overall impression of the Galaxy Player 5.0 is sufficiently different from the D'757 not to be deceiving. (*Id.*)

Galaxy Player 4.0 YP-G1CWY

In addition to the differences common to all accused Samsung products as compared with the D'757 patent, Samsung contends that the Galaxy Player 4.0, shown below, like the Vibrant and Galaxy S 4G, has a bezel that does not have a continuous curve like the D'757 patent. (RIB at 45-46). Rather, Samsung argues that the bezel angles outward from the front surface and then drops down, which gives the bezel a more angular profile when viewed from the top, bottom and sides. (*Id.*) Samsung further argues that the Galaxy Player 4.0 has a sculpted, non-planar back portion along the upper edge of the rear surface to accommodate the headphone jack, unlike the smooth rear of the D'757 patent. (*Id.*) Additionally, Samsung argues that the top edge of the Galaxy Player 4.0 is substantially flat, unlike D'757. (*Id.*) Samsung argues that because each element of the designs is visibly different, the overall impression of the Galaxy Player 4.0 is sufficiently different from the D'757 not to be deceiving. (*Id.*)

**Analysis**

Samsung contends that factors such as the high cost of the D'757 Accused Products warrants a greater attention to detail. (RIB at 31.) Apple's own expert admitted, purchasers of smartphones study and compare phone models even before going to the store to purchase them, as those phones often require entering into multi-year contracts. (Bressler Tr. 709:21-25.) The

PUBLIC VERSION

fact that the accused product is relatively expensive and not an “impulse purchase” is indicative of the level of attention an ordinary observer would give. *See Child Craft Industries, Inc. v. Simmons Juvenile Products Co., Inc.*, 990 F. Supp. 638, 643-44 (S.D. Ind. 1998). Courts have recognized that consumers purchasing electronics for hundreds of dollars are sophisticated, take care in making their purchases, and have knowledge of the range of products under consideration. *See Edge Wireless LLC v. U.S. Cellular Corp.*, 312 F. Supp. 2d 1325, 1333 (D. Or. 2003); *M & G Elecs. Sales Corp. v. Sony Kabushiki Kaisha*, 250 F. Supp. 2d 91, 104 (E.D.N.Y. 2003). Accordingly, I have kept it in mind that a purchaser of the kind of devices at issue in this investigation will pay significant attention to what they are buying.

Apple argues that features on the back of the accused products should be given less weight because the ordinary observer’s overall impression of the Apple designs is derived primarily from the front surface of the phone, particularly because of the striking nature of this aspect of the Apple design and its departure from the prior art. (CIB at 47.) I find Apple’s argument that features on the back of the accused products should be given less weight unpersuasive. The D’757 patent covers both front, back and side views of the design, and as such, I find that an ordinary observer will necessarily take all these views of the accused product into account when determining if the designs are substantially similar. *Arminak & Assocs.*, 501 F.3d at 1324.

Consistent with Apple’s broad construction of the patented design, Apple argues that the Galaxy S 4G is representative of the D’757 Accused Products. Likewise, consistent with Samsung’s more narrow construction, Samsung divides the D’757 Accused Products into five

groupings. I will analyze infringement according to the groupings set forth by Samsung as I find these groupings better reflect the differences between the accused products.

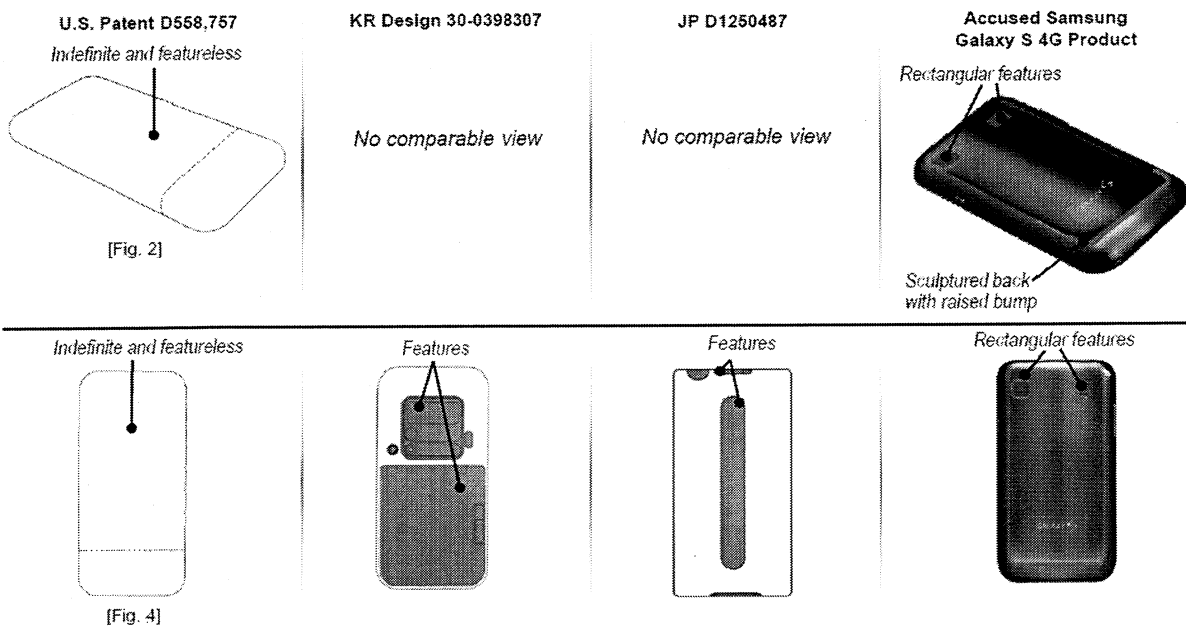
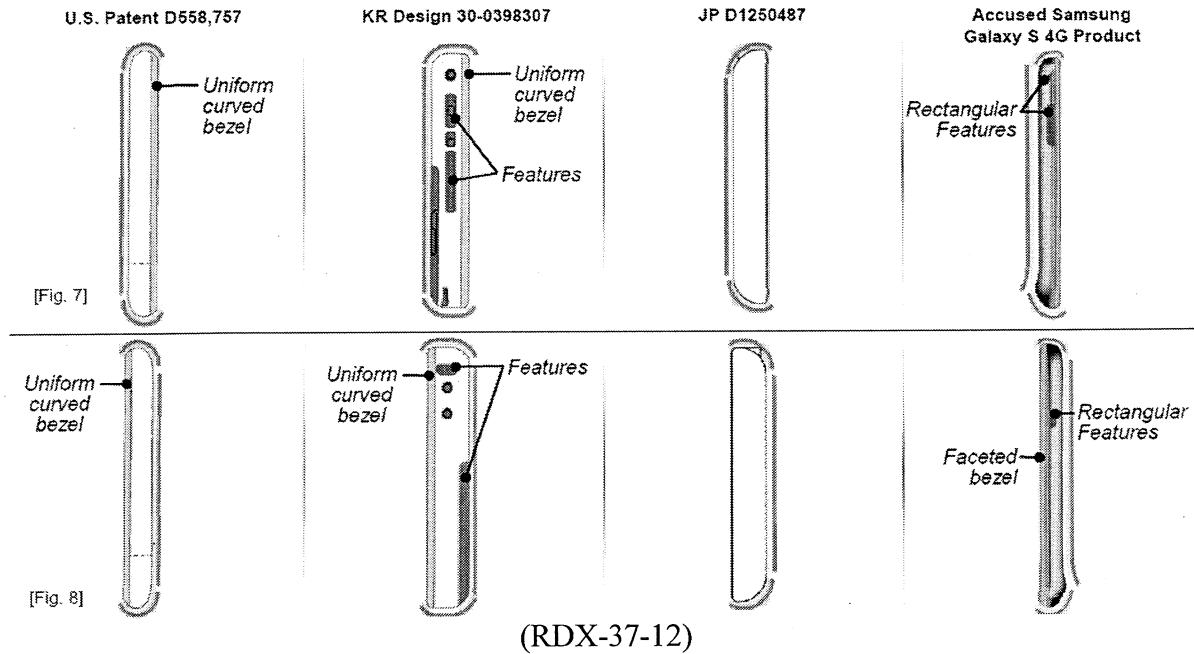
**1. Galaxy S 4G SGH-T959V and Vibrant SGH-T959**

When comparing the claimed design to the **physical** exhibits of the Galaxy S 4G (CPX-0056) and the Vibrant (CPX-0141), I find that in light of the prior art the overall impression of the design claimed in the D'757 patent is substantially different than the Galaxy S 4G and the Vibrant. The D'757 patent evinces a simplistic and minimalistic design described by Apple in their post hearing brief as:

smooth, continuous surfaces and rounded corners [with] a strong statement of continuity and harmony by encircling the oily pond with a uniform, thin, metallic bezel. The bezel is delicate and unbroken by any buttons, ports, or screws . . . These elements reflect the design principles of the iPhone, summarized by Mr. Stringer as an aesthetic impression of simplicity, calm, and quiet.

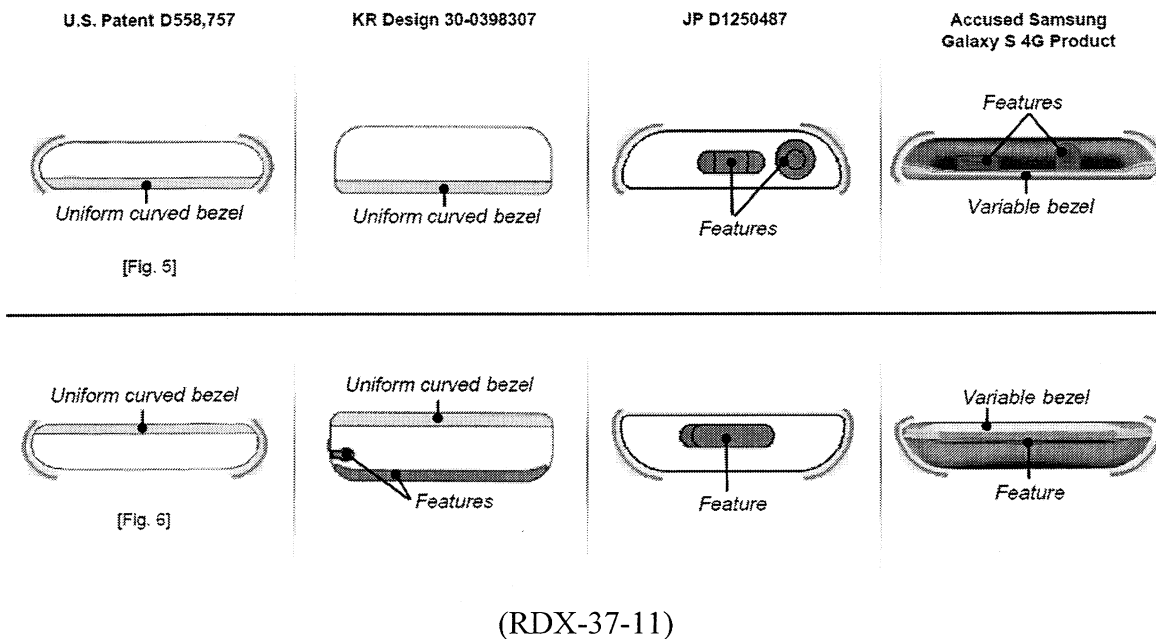
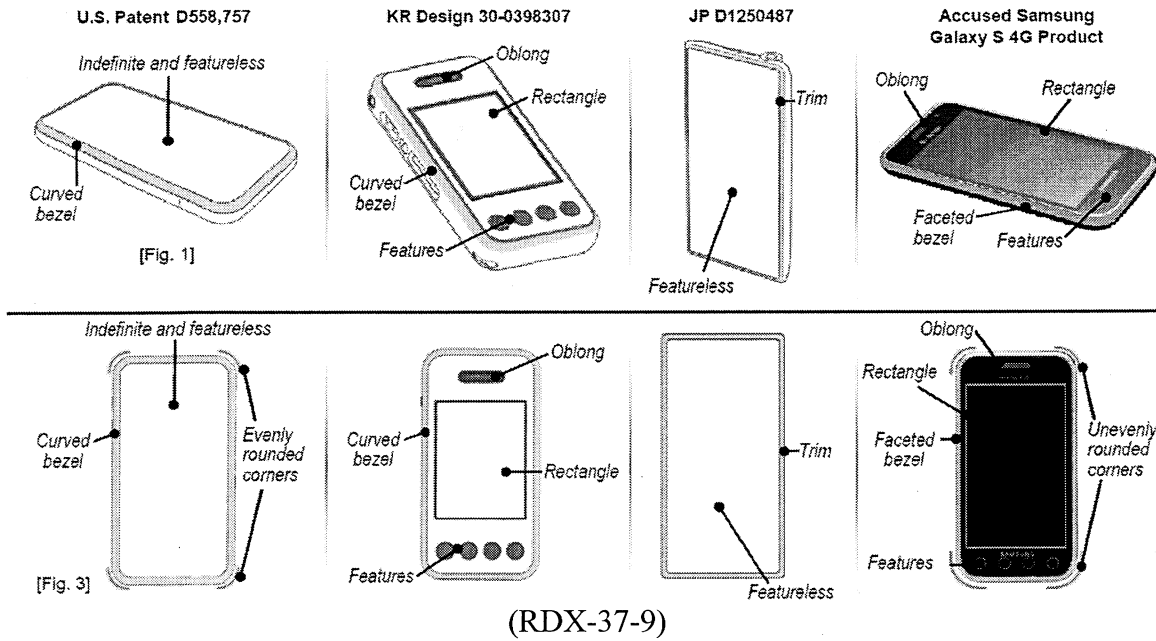
(CIB at 42.) The number and prominence of the features on the Galaxy S 4G and Vibrant, however, produce a more angular and a distinctly busier impression than the D'757 design. In each of the views of the D'757 patent and the Galaxy S 4G, I note a number of differences that contribute to the dissimilarity between the overall impression of the D'757 patent and the overall impression of the Galaxy S 4G and Vibrant. These differences are exemplified by figures RDX-37-9, RDX-37-10, RDX-37-11, and RDX-37-12. Although the following discussion addresses specific differences between the D'757 design and the Galaxy S 4G and Vibrant, I have only considered these details in the context of the overall impression created by the Galaxy S 4G and Vibrant. The drawings below of the claimed design, prior art, and accused products are included to help elucidate my infringement analysis. The drawings are for illustrative purposes only as the test for design patent infringement requires a comparison of the claimed design with

the actual accused product (which I have done numerous times for all of the accused products), not the claimed design with a drawing of the accused design. The annotations to the drawings were included by Samsung and I accord them no weight.



PUBLIC VERSION

(RDX-37-10)



In light of the prior art, the side views demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Galaxy S 4G's busier appearance. For example,

the side views of the D'757 patent show a flat back surface, rounded edges, a curved bezel which meets and joins with the rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression. (*See* JX-0001.) In contrast, the Galaxy S 4G has a non-flat back, somewhat more angular edges, an angular bezel which does not meet and join with the rounded edges, and a number of rectangular features. (*Compare* JX-0001 *with* CPX-0144; *see also* RDX-37-12.) The rectangular features are noticeable because they protrude slightly, however the overall effect is that they tend blend in with the rest of the side because of their similar coloring. (*See* CPX-0144.)

In light of the prior art, the rear and rear perspective views also demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Galaxy S 4G's busier impression. For example, the rear and rear perspective views of the D'757 patent show a flat back surface, rounded edges, and a distinct lack of detail or ornamentation—again creating an uninterrupted and sleek impression of simplicity. (*See* JX-0001.) In contrast, the Galaxy S 4G has a sculptured back and rectangular features which draw the observer's eye because of their contrasting color and prominence. (*Compare* JX-0001 *with* CPX-0144; *see also* RDX-37-10.)

In light of the prior art, the front and front perspective views also demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Galaxy S 4G's impression of detail. For example, the front and front perspective views of the D'757 patent show a flat front surface that is co-planar with the bezel, rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression of simplicity. (*See* JX-0001.) In contrast, the Galaxy S 4G has a reflective front surface with rectangular features and a

non-coplanar bezel.<sup>4</sup> (*Compare* JX-0001 *with* CPX-0144; *see also* RDX-37-9.) As with the side views, however, these rectangular features tend to disappear into the background of the front face. (*See* CPX-0144.)

In light of the prior art, the bottom and top views further exemplify the difference between the D'757 patent's impression of sleek minimalism and the Galaxy S 4G's busier impression. For example, the top and bottom views of the D'757 patent show rounded edges, a curved bezel which meets and joins with the rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression. (*See* JX-0001.) In contrast, the Galaxy S 4G has somewhat more angular edges, an angular bezel which does not meet and join with the rounded edges, and a number of rectangular features which draw the observer's eye. (*Compare* JX-0001 *with* CPX-144; *see also* RDX-37-11.)

Accordingly, I find that an ordinary observer familiar with the prior art, giving such attention as a purchaser usually gives to the types of products at issue, considering the overall appearance and impression of the claimed design and the accused design, would find the Galaxy

---

<sup>4</sup> The bezels of the Galaxy S 4G and the Vibrant protrude above the surface of the glass, as admitted by Apple's expert. I do not find this to be a prominent visual feature of the accused products. I have also found no case law in support of Samsung's argument that the tactile impression of the accused product is something an ordinary observer would take into account when considering if the design and the accused products are substantially similar. Nevertheless if an ordinary observer would consider this difference, it would only strengthen my conclusion that an ordinary observer would consider the claimed design of the D'757 patent and the Galaxy S 4G and Vibrant products to have impressions that are not substantially the same.



S 4G and Vibrant are not substantially the same design as Apple's D'757 patent and thus do not infringe the D'757 patent.

**2. Mesmerize SCH-I500, Fascinate SCH-I500 and Showcase SCH-I500**

When comparing the claimed design to the **physical** exhibits of the Mesmerize (CPX-0090), Showcase (CPX-0124) and Fascinate (CPX-0044), I find that in light of the prior art the overall impression of the D'757 patent is substantially different than the Mesmerize, Fascinate and Showcase accused products. The Fascinate is representative of this group. The D'757 evinces a simplistic and minimalistic design described by Apple in their post hearing brief as

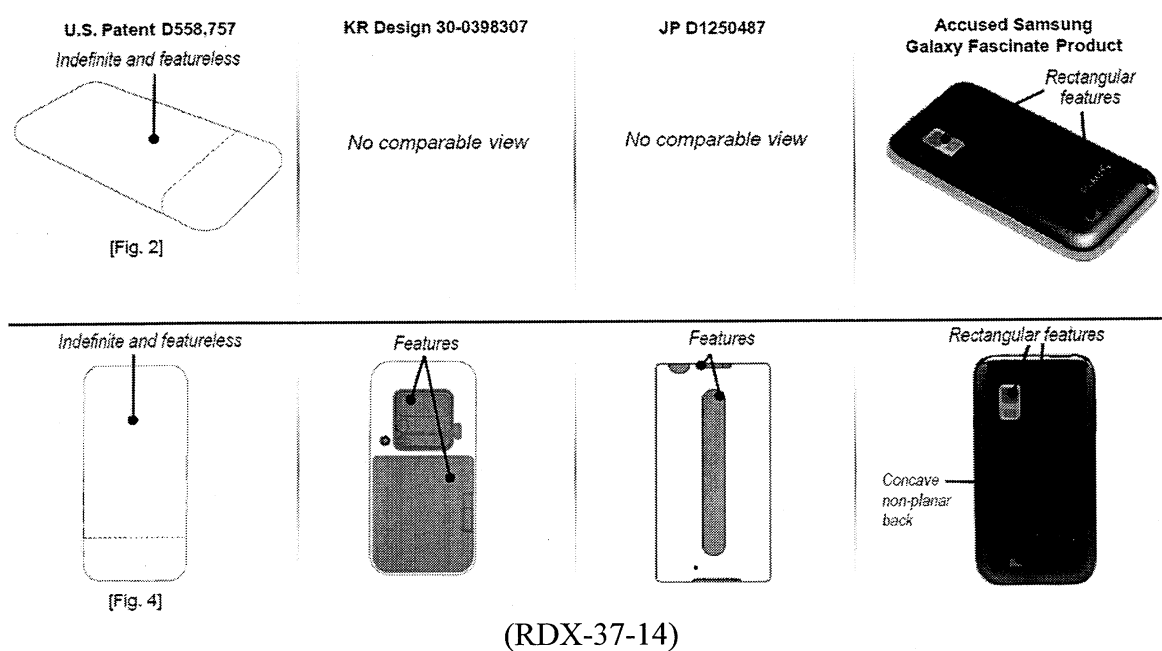
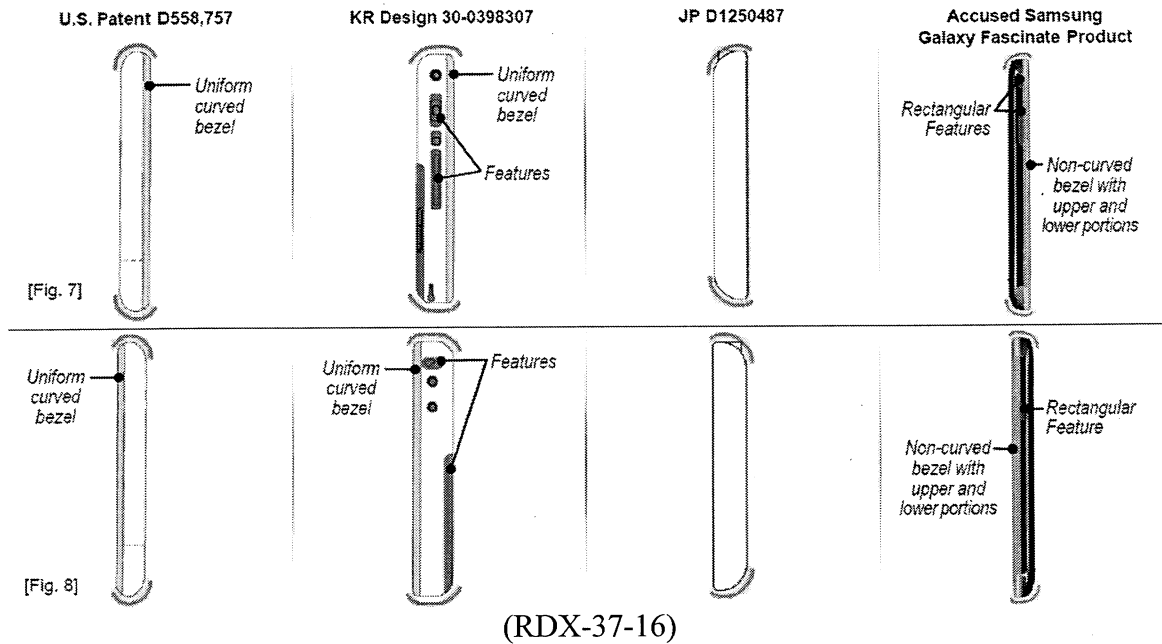
smooth, continuous surfaces and rounded corners [with] a strong statement of continuity and harmony by encircling the oily pond with a uniform, thin, metallic bezel. The bezel is delicate and unbroken by any buttons, ports, or screws . . . These elements reflect the design principles of the iPhone, summarized by Mr. Stringer as an aesthetic impression of simplicity, calm, and quiet.

(CIB at 42.) The number and prominence of the features on the Fascinate, however, produces a more angular, much busier impression than the D'757 patent. In each of the views of the D'757 patent and the Fascinate, I note a number of differences that contribute to the dissimilarity between the overall impression of the D'757 patent and the overall impression of the Fascinate. These differences are exemplified by figures RDX-37-13, RDX-37-14, RDX-37-15, and RDX-37-16. Although the following discussion addresses specific differences between the D'757 design and the Fascinate, I note that I considered these details is in the context of the overall impression created by the Fascinate.

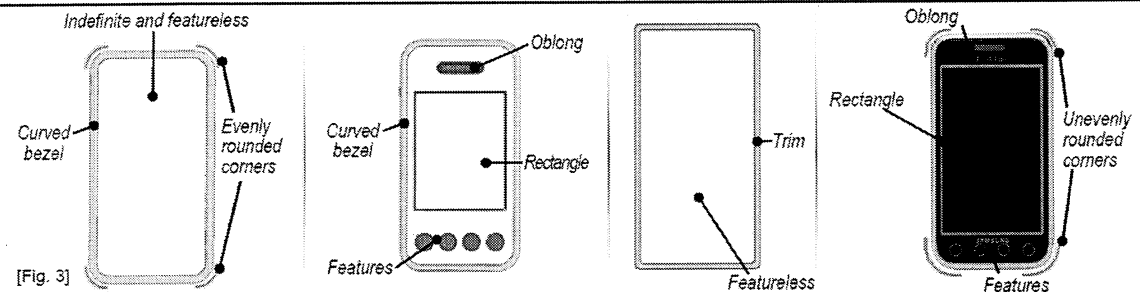
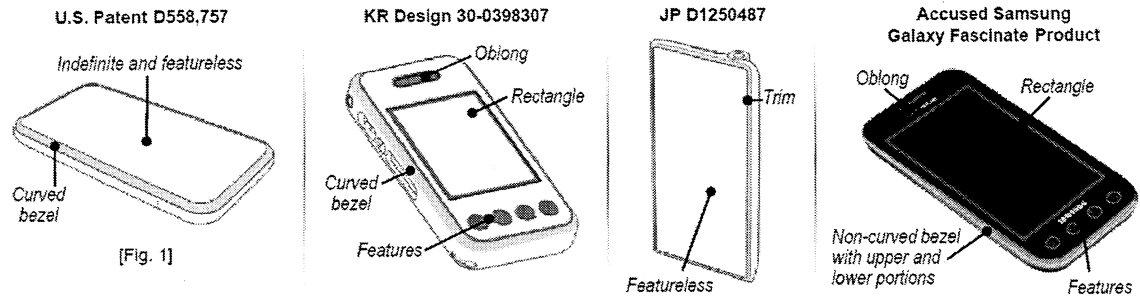
The drawings below of the claimed design, prior art, and accused products are included to help explain (or provide context for) my infringement analysis. The drawings are for illustrative purposes only as the test for design patent infringement requires a comparison of the claimed

PUBLIC VERSION

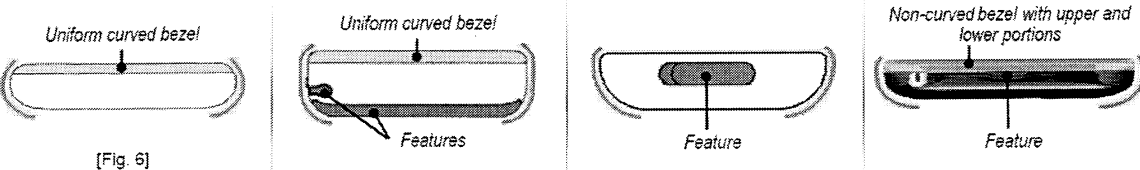
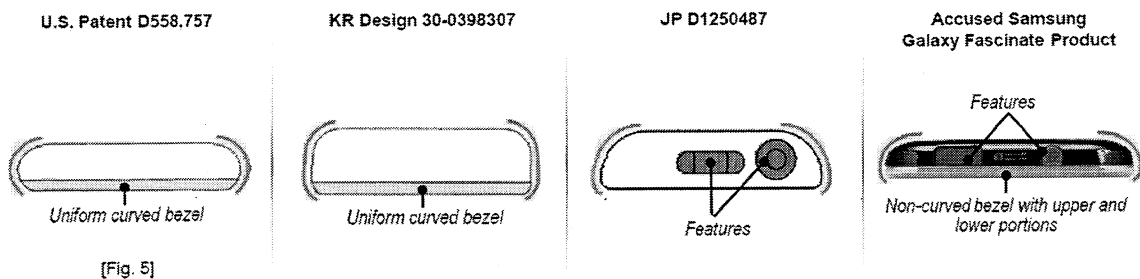
design with the actual accused product (which I have done numerous times for all of the accused products), not the claimed design with a drawing of the accused design. The annotations to the drawings were included by Samsung and I accord them no weight.



PUBLIC VERSION

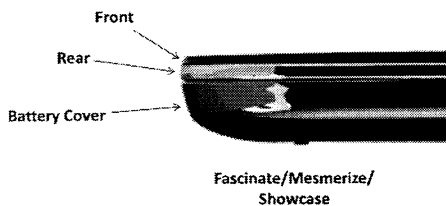


(RDX-37-13)



(RDX-37-15)

For example, the side views demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Fascinate's busier appearance. (*See* RDX-37-16.) In addition to the differences common to all accused Samsung products as compared with the D'757 patent, the Fascinate, shown below, has a "bezel" that is divided into front and rear parts, sometimes called a "double ring bezel." (CPX-0044; CPX-0090; CPX-0124; RDX-2-1). The double ring bezel of the Fascinate does not have a curve or sloping shape, unlike the D'757 patent's single bezel. (*Id.*)



(RX-3444C at 29 (RDX-2-1)).

The Fascinate also has a different shape in the side view, appearing to have almost perpendicular edges that taper in slightly toward the rear surface, with different curvature of the sides of the device than the D'757 patent. (*Compare* JX-0001 with CPX-0044, CPX-0090, CPX-0124; *see also* RDX-2-1). On the other hand, the side views of the D'757 patent show rounded edges, a curved bezel which meets and joins with the rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression. (JX-0001.) The Fascinate also has rectangular features seen in the side view that are noticeable because they protrude slightly; however, these features tend to blend in with the rest of the side because of their similar coloring.

In light of the prior art, the rear and rear perspective views also demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Fascinate's busier

impression. For example, the rear and rear perspective views of the D'757 patent show a flat back surface, rounded edges, and a distinct lack of detail or ornamentation—again creating an uninterrupted and sleek impression of simplicity. (JX-0001.) In contrast, the Fascinate has rectangular features which draw the observer's eye because of their contrasting coloring and prominence. (*Compare* JX-0001 with CPX-0044, CPX-0090, and CPX-0124; *see also* RDX-37-14.)

In light of the prior art, the front and front perspective views also demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Fascinate's busier impression. For example, the front and front perspective views of the D'757 patent show a flat front surface which is co-planar with the bezel, rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression of simplicity. (JX-0001.) In contrast, the Fascinate has a reflective front surface with more rectangular features and a non-coplanar bezel.<sup>5</sup> (*Compare* JX-0001 with CPX-0044; *see also* RDX-37-13.) As with the side views, however, these rectangular features tend to disappear into the background of the front face. (*See* CPX-0044.)

---

<sup>5</sup> The bezels of the Fascinate, Showcase and Mesmerize protrude above the surface of the glass, as admitted by Apple's expert. I do not find this to be a prominent visual feature of the accused products. I also have found no case law in support of Samsung's argument that the tactile impression of the accused product is something an ordinary observer would take into account when considering if the design and the accused products are substantially similar. Nevertheless if an ordinary observer would consider this difference, it would only strengthen my conclusion that an ordinary observer would consider the claimed design of the D'757 patent and the Fascinate, Showcase and Mesmerize products to have impressions that are not substantially the same.

PUBLIC VERSION

In light of the prior art, the bottom and top views also demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Fascinate's impression of detail. For example, the top and bottom views of the D'757 patent show rounded edges, a curved bezel which meets and joins with the rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression. (JX-0001.) In contrast, the Fascinate has somewhat more angular edges, an angular bezel which does not meet and join with the rounded edges, and a number of rectangular features which draw the observer's eye. (*Compare* JX-0001 *with* CPX-0044; *see also* RDX-37-15.)

Accordingly, I find that an ordinary observer familiar with the prior art, giving such attention as a purchaser usually gives to the types of products at issue, considering the overall appearance and impression of the claimed design and the accused design, would find the Mesmerize, Showcase and Fascinate are not substantially the same design as claimed in Apple's D'757 patent and thus do not infringe the D'757 patent.

**3. Galaxy Player 4.0 YP-G1CWY**

When comparing the claimed design to the **physical** exhibit of the Galaxy Player 4.0 (CPX-0054), I find that in light of the prior art the overall impression of the D'757 patent is substantially different than the Galaxy Player 4.0. The D'757 evinces a simplistic and minimalistic design described by Apple in their post hearing brief as

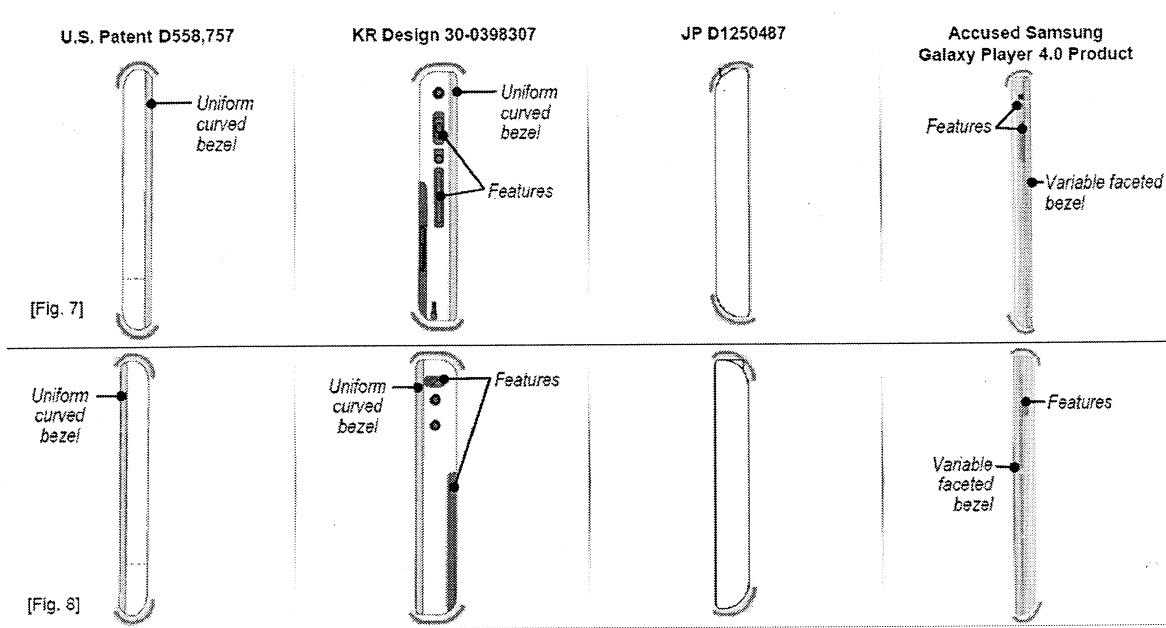
smooth, continuous surfaces and rounded corners [with] a strong statement of continuity and harmony by encircling the oily pond with a uniform, thin, metallic bezel. The bezel is delicate and unbroken by any buttons, ports, or screws . . . These elements reflect the design principles of the iPhone, summarized by Mr. Stringer as an aesthetic impression of simplicity, calm, and quiet.

**PUBLIC VERSION**

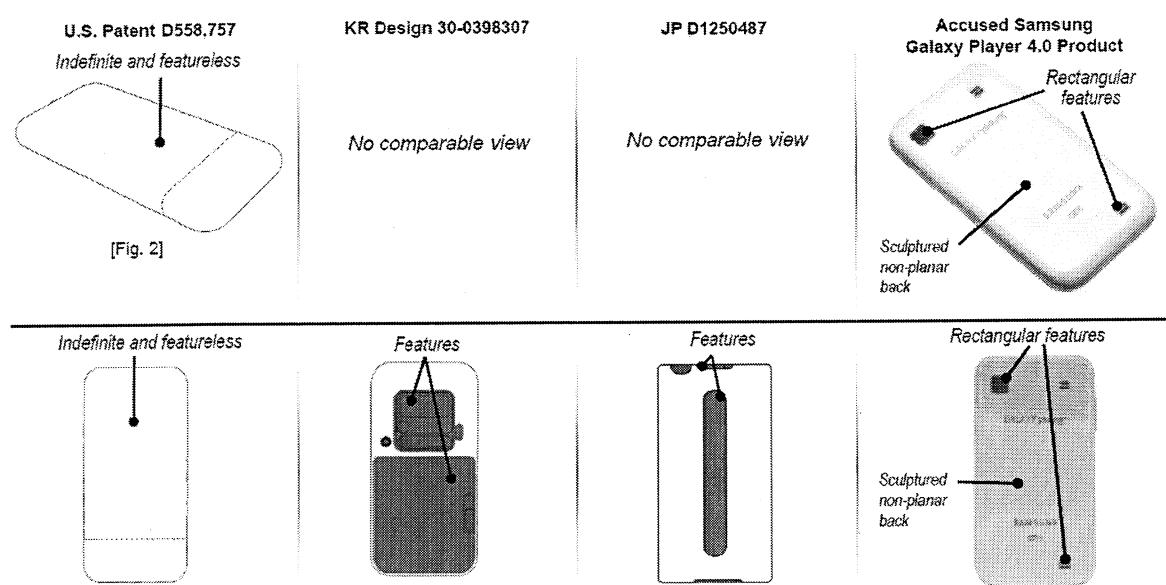
(CIB at 42.) The number and prominence of the features on the Galaxy Player 4.0, however, produce a more angular, busier impression than the D'757 patent. In each of the views of the D'757 patent and the Galaxy Player 4.0, I note a number of differences that contribute to the dissimilarity between the overall impression of the D'757 patent and the Galaxy Player 4.0. These differences are exemplified by figures RDX-37-21, RDX-37-22, RDX-37-23, and RDX-37-24. Although the following discussion addresses specific differences between the D'757 design and the Galaxy Player 4.0, I note that I considered these details in the context of the overall impression created by the Galaxy Player 4.0.

The drawings below of the claimed design, prior art, and accused products are included to help elucidate my infringement analysis. The drawings are for illustrative purposes only as the test for design patent infringement requires a comparison of the claimed design with the actual accused product ((which I have done numerous times for all of the accused products), not the claimed design with a drawing of the accused design. The annotations to the drawings were included by Samsung and I accord them no weight.

PUBLIC VERSION

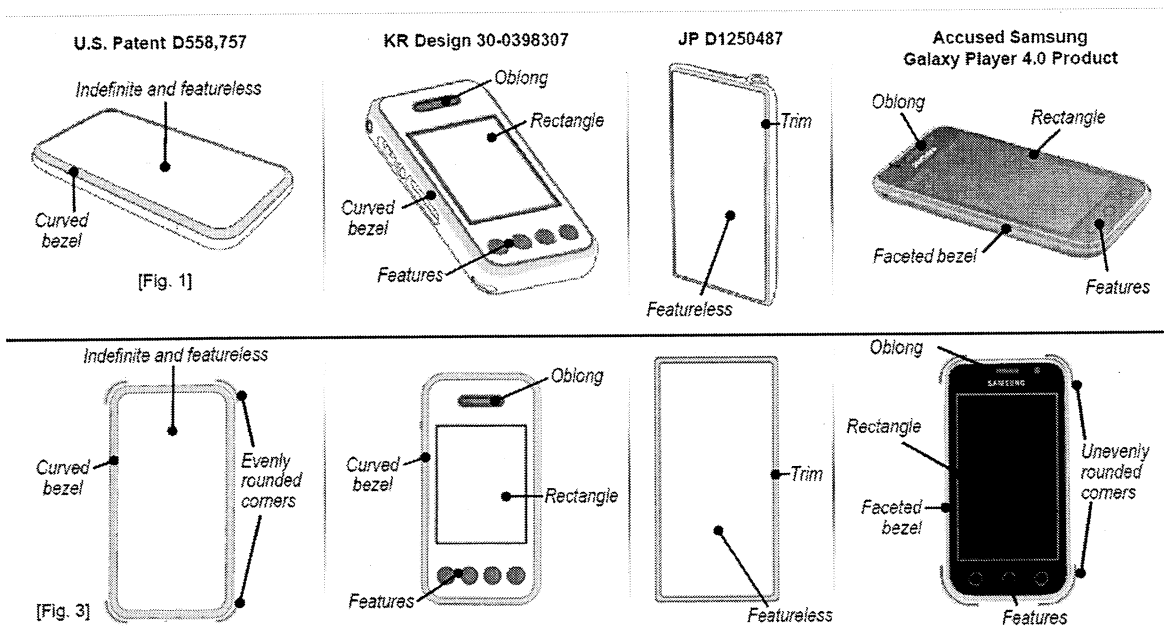


(RDX-37-24)

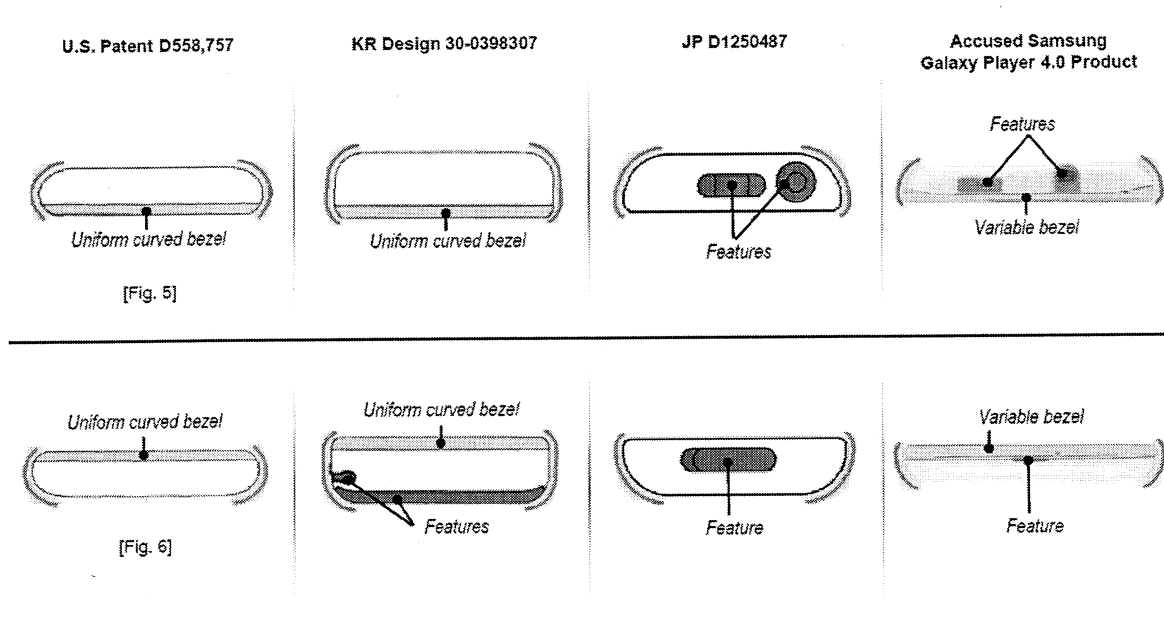


(RDX-37-22)





(RDX-37-21)



(RDX-37-23)

For example, the side views demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Galaxy Player 4.0's angular, busy appearance. (See

RDX-37-24.) The Galaxy Player 4.0 has a different shape in the side view, appearing to have angular edges that taper in slightly toward the rear surface. (*Compare JX-0001 with CPX-0053; see also RDX-37-28.*) In contrast, the side views of the D'757 patent show rounded edges, a curved bezel which meets and joins with the rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression. (Figs. 7 and 8, JX-0001.) The Galaxy Player 4.0 also has rectangular features seen in the side view that are noticeable because they protrude slightly, however, I note that these features tend to blend in with the rest of the side because of their similar coloring. (CPX-0053.)

In light of the prior art, the rear and rear perspective views also demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Galaxy Player 4.0's busier impression. For example, the rear and rear perspective views of the D'757 patent show a flat back surface, rounded edges, and a distinct lack of detail or ornamentation—again creating an uninterrupted and sleek impression of simplicity. (Figs. 2 and 4, JX-0001.) In contrast, the Galaxy Player 4.0 has rectangular features which draw the observer's eye because of their contrasting coloring and prominence. (*Compare JX-0001 with CPX-0053; see also RDX-37-22.*)

In light of the prior art, the front and front perspective views also demonstrate the difference between the D'757 patent's minimalistic impression and the Galaxy Player 4.0's busier impression. For example, the front and front perspective views of the D'757 patent show a flat front surface which is co-planar with the bezel, rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression of simplicity. In contrast, the Galaxy Player 4.0 has a reflective front surface with more rectangular features and a non-

coplanar bezel.<sup>6</sup> (*Compare* JX-0001 *with* CPX-0053; *see also* RDX-37-21.) As with the side views, however, these rectangular features tend to disappear into the background of the front face. (*See* CPX-0053.)

In light of the prior art, the bottom and top views also demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Galaxy Player 4.0's angular, busy impression. For example, the top and bottom views of the D'757 patent show rounded edges, a curved bezel which meets and joins with the rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression. (JX-0001.) In contrast, the Galaxy Player 4.0 has much more angular edges, an angular bezel which does not meet and join with the rounded edges, and a number of rectangular features including a protruding headphone port which draws the observer's eye. (*Compare* JX-0001 *with* CPX-0053; *see also* RDX-37-23.)

Accordingly, I find that an ordinary observer familiar with the prior art, giving such attention as a purchaser usually gives to the types of products at issue, considering the overall appearance and impression of the claimed design and the accused design, would find the Galaxy Player 4.0 is not substantially the same as the design of Apple's D'757 patent and thus does not infringe the D'757 patent.

---

<sup>6</sup> The bezel of the Galaxy Player 4.0 protrudes above the surface of the glass. I do not find this to be a prominent visual feature of the accused product. I have also found no case law in support of Samsung's argument that the tactile impression of the accused product is something an ordinary observer would take into account when considering if the design and the accused products are substantially similar. Nevertheless, if an ordinary observer would consider this difference, it would only strengthen my conclusion that an ordinary observer would consider the claimed design of the D'757 patent and the Galaxy Player 4.0 product to have impressions that are not substantially the same.

#### 4. Galaxy Player 5.0 YP-G70/NAW

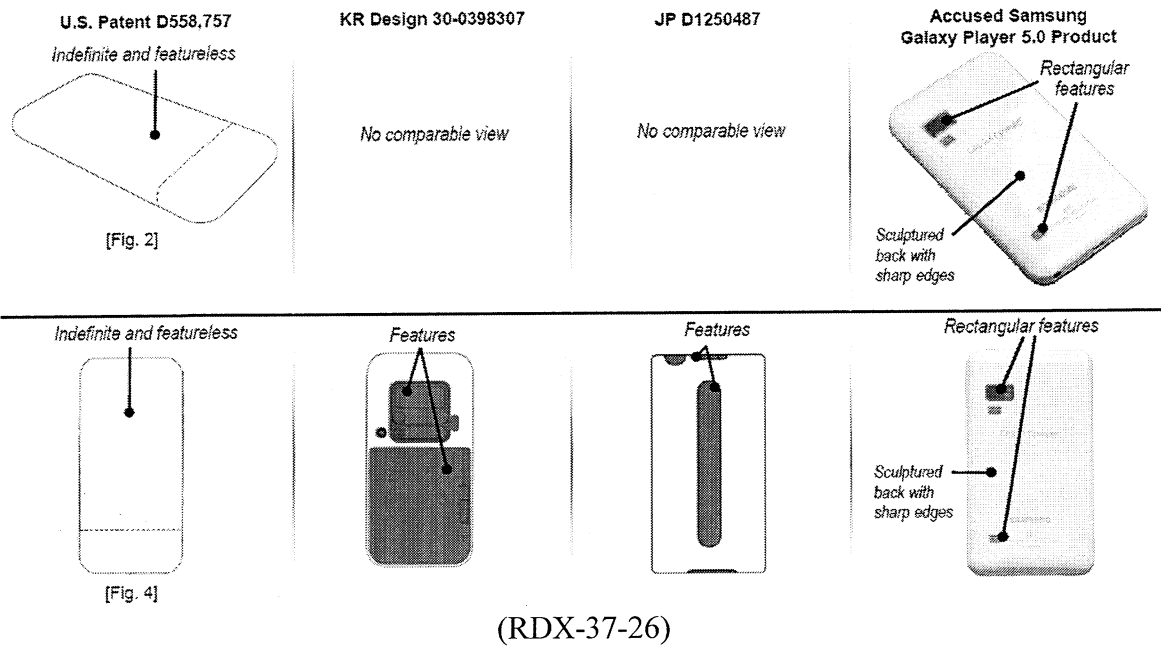
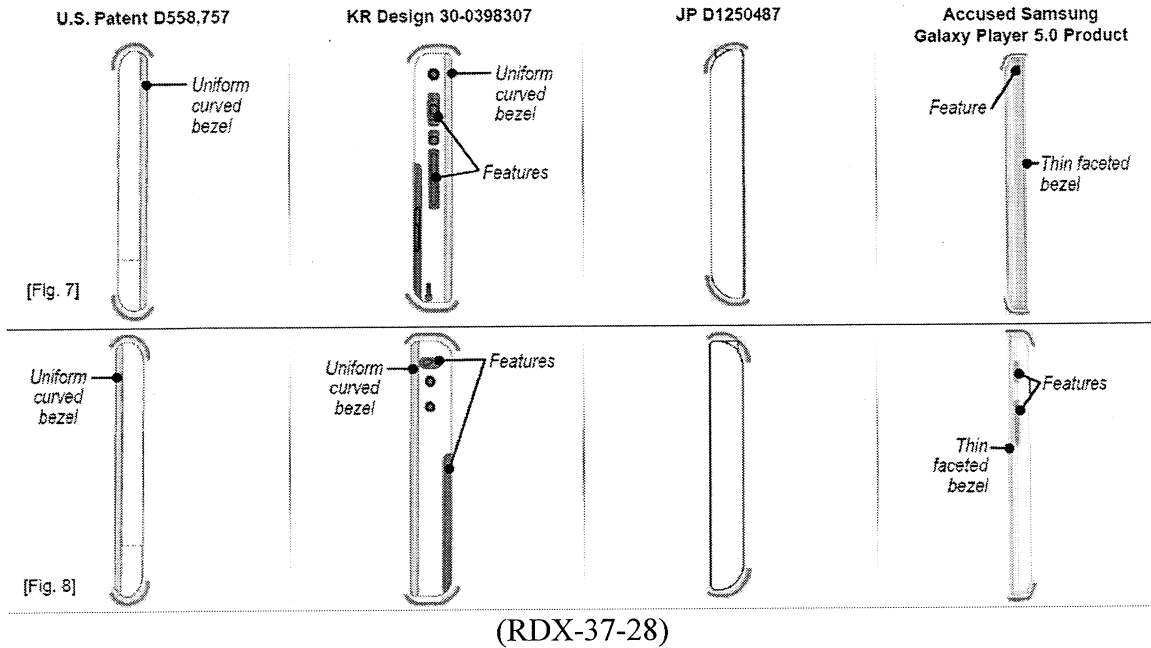
When comparing the claimed design to the **physical** exhibit of the Galaxy Player 5.0 (CPX-0054), I find that in light of the prior art the overall impression of the design claimed in the D'757 patent is substantially different than the Galaxy Player 5.0. The D'757 evinces a simplistic and minimalistic design described by Apple in their post hearing brief as

smooth, continuous surfaces and rounded corners [with] a strong statement of continuity and harmony by encircling the oily pond with a uniform, thin, metallic bezel. The bezel is delicate and unbroken by any buttons, ports, or screws . . . These elements reflect the design principles of the iPhone, summarized by Mr. Stringer as an aesthetic impression of simplicity, calm, and quiet.

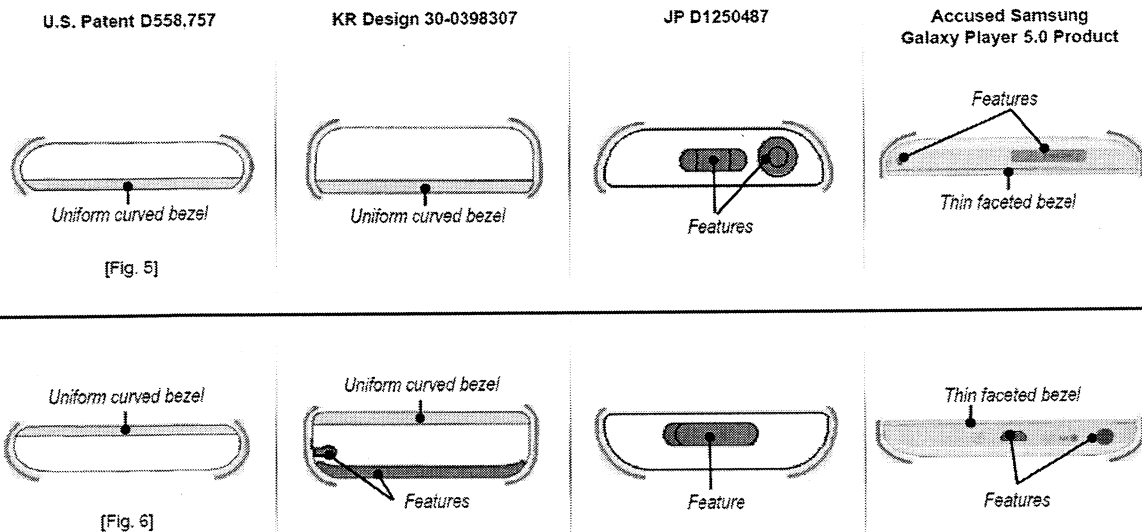
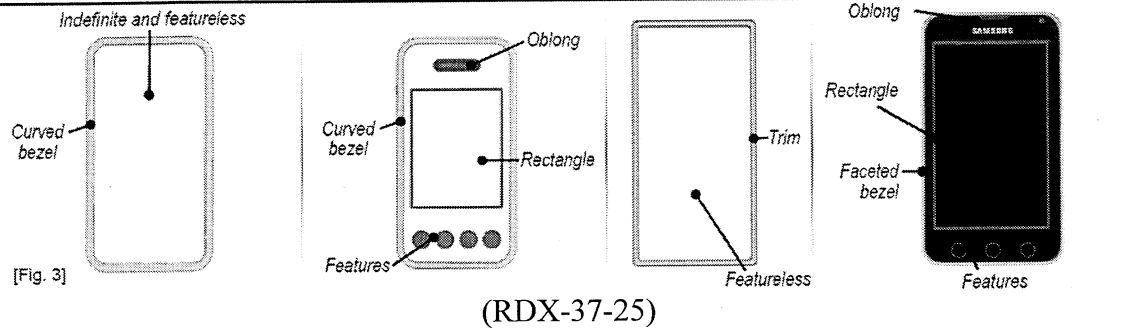
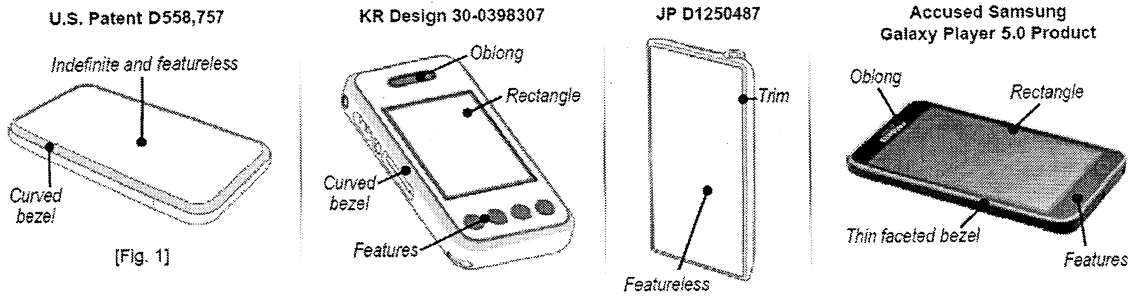
(CIB at 42.) The number and prominence of the features on the Galaxy Player 5.0, however, produce a more angular, busier impression than the D'757 patent. In each of the views of the D'757 patent and the Galaxy Player 5.0, I note a number of differences that contribute to the difference between the overall impression of the D'757 patent and the Galaxy Player 5.0. These differences are exemplified by figures RDX-37-25, RDX-37-26, RDX-37-27, and RDX-37-28. Although the following discussion addresses specific differences between the D'757 design and the Galaxy Player 5.0, the consideration of these details is in the context of the overall impression created with these details (or lack thereof).

The drawings below of the claimed design, prior art, and accused products are included to help elucidate my infringement analysis. The drawings are for illustrative purposes only as the test for design patent infringement requires a comparison of the claimed design with the actual accused product (which I have done), not the claimed design with a drawing of the accused design. The annotations to the drawings were included by Samsung and I accord them no weight.

PUBLIC VERSION



PUBLIC VERSION



(RDX-37-27)

For example, the side views demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Galaxy Player 5.0's angular, busy appearance. (See RDX-37-28.) The Galaxy Player 5.0 has a different shape in the side view, appearing to have

PUBLIC VERSION

angular edges that taper in slightly toward the rear surface. (*Compare* JX-0001 with CPX-0054; *see also* RDX-37-28.) In contrast, the side views of the D'757 patent show rounded edges, a curved bezel which meets and joins with the rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression. (Figs. 7 and 8, JX-0001.) The Galaxy Player 5.0 also has rectangular features seen in the side view that are noticeable because they protrude slightly, however, I find that these features tend to blend in with the rest of the side because of their similar coloring. (CPX-0054.)

In light of the prior art, the rear and rear perspective views also demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Galaxy Player 5.0's busier impression. For example, the rear and rear perspective views of the D'757 patent show a flat back surface, rounded edges, and a distinct lack of detail or ornamentation—again creating an uninterrupted and sleek impression of simplicity. (Figs. 2 and 4, JX-0001.) In contrast, the Galaxy Player 5.0 has rectangular features which draw the observer's eye because of their contrasting coloring and prominence. (*Compare* JX-0001 with CPX-0054; *see also* RDX-37-26.)

In light of the prior art, the front and front perspective views also demonstrate the difference between the D'757 patent's minimalistic impression and the Galaxy Player 5.0's busier impression. For example, the front and front perspective views of the D'757 patent show a flat front surface which is co-planar with the bezel, rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression of simplicity. In contrast, the Galaxy Player 5.0 has a reflective front surface with more rectangular features and a non-

coplanar bezel.<sup>7</sup> (*Compare* JX-0001 *with* CPX-0054; *see also* RDX-37-25.) As with the side views, however, these rectangular features tend to disappear into the background of the front face. (*See* CPX-0054.)

In light of the prior art, the bottom and top views also demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Galaxy Player 5.0's angular, busy impression. For example, the top and bottom views of the D'757 patent show rounded edges, a curved bezel which meets and joins with the rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression. (JX-0001.) In contrast, the Galaxy Player 5.0 has much more angular edges, an angular bezel which does not meet and join with the rounded edges, and a number of rectangular features which draw the observer's eye. (*Compare* JX-0001 *with* CPX-0054; *see also* RDX-37-27.)

Accordingly, I find that an ordinary observer familiar with the prior art, giving such attention as a purchaser usually gives to the types of products at issue, considering the overall appearance and impression of the claimed design and the accused design, would find the Galaxy Player 5.0 is not substantially the same design as claimed by Apple's D'757 patent and thus does not infringe the D'757 patent.

---

<sup>7</sup> The bezel of the Galaxy Player 5.0 protrudes above the surface of the glass. I do not find this to be a prominent visual feature of the accused product. I also have found no case law in support of Samsung's argument that the tactile impression of the accused product is something an ordinary observer would take into account when considering if the design and the accused products are substantially similar. Nevertheless, if an ordinary observer would consider this difference, it would only strengthen my conclusion that an ordinary observer would consider the claimed design of the D'757 patent and the Galaxy Player 5.0 product to have impressions that are not substantially the same.



5. Transform SPH-M920

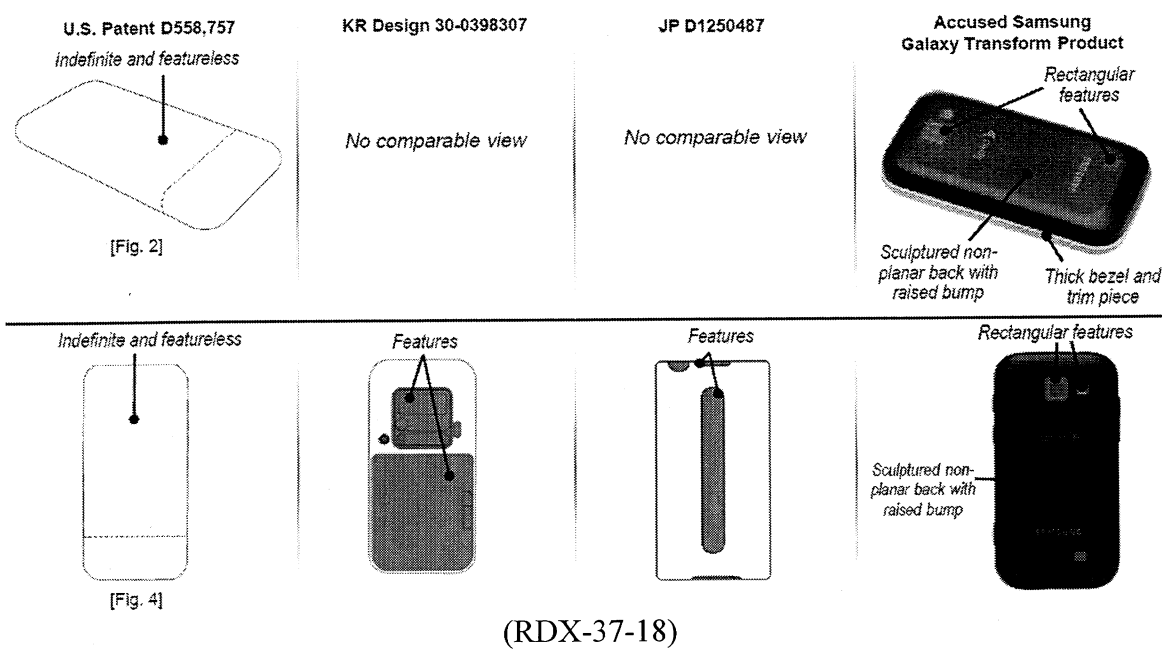
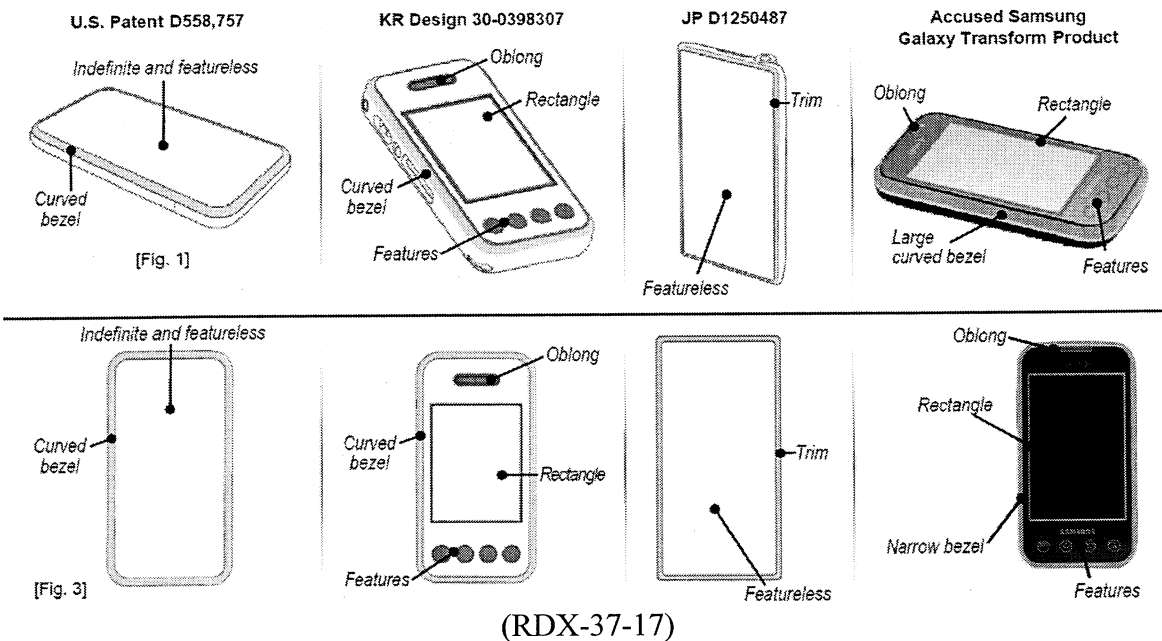
When comparing the claimed design to the **physical** exhibit of the Transform (CPX-0138), I find that in light of the prior art the overall impression of the D'757 patent is substantially different than the Transform. The D'757 evinces a simplistic and minimalistic design described by Apple in their post hearing brief as

smooth, continuous surfaces and rounded corners [with] a strong statement of continuity and harmony by encircling the oily pond with a uniform, thin, metallic bezel. The bezel is delicate and unbroken by any buttons, ports, or screws . . . These elements reflect the design principles of the iPhone, summarized by Mr. Stringer as an aesthetic impression of simplicity, calm, and quiet.

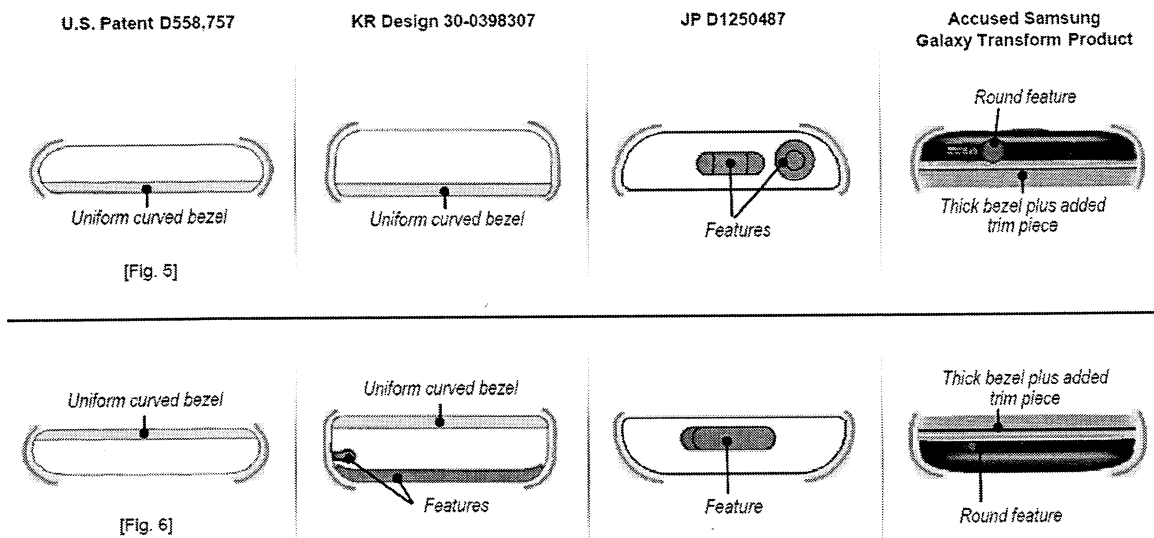
(CIB at 42.) The number and prominence of the features on the Transform, however, produces a more detailed, busier impression than the D'757 patent. Furthermore, in each of the views of the D'757 patent and the Transform, I note a number of differences that contribute to the dissimilarity between the overall impression of the design claimed by the D'757 patent and the Transform. These differences are exemplified by figures RDX-37-17, RDX-37-18, RDX-37-19, and RDX-37-20. Although the following discussion addresses specific differences between the D'757 design and the Transform, the consideration of these details is in the context of the overall impression created by the Transform.

The drawings below of the claimed design, prior art, and accused products are included to help explain my infringement analysis. The drawings are for illustrative purposes only as the test for design patent infringement requires a comparison of the claimed design with the actual accused product (which I have done), not the claimed design with a drawing of the accused design. The annotations to the drawings were included by Samsung and I accord them no weight.

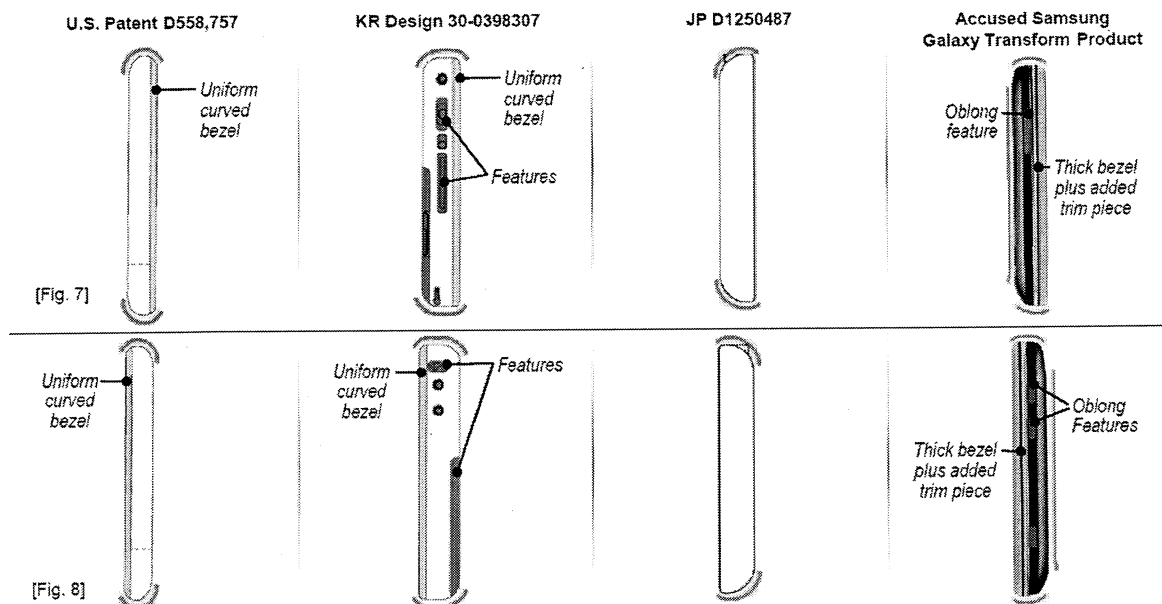
PUBLIC VERSION



PUBLIC VERSION



(RDX-37-19)



(RDX-37-20)

For example, the side views demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Transform's busier appearance. (See RDX-37-20.) The Transform has a different shape in the side view, appearing to have angular edges that taper in

slightly toward the rear surface and an additional protrusion at the top of the side view. (CPX-0138; *see also* RDX-37-20.) In addition, the Transform has a double bezel. (*Id.*) On the other hand, the side views of the D'757 patent show rounded edges, a curved bezel which meets and joins with the rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression. (Figs. 7 and 8, JX-0001.) The Transform also has rectangular features seen in the side view that are noticeable because they protrude slightly; however, I find these features tend to blend in with the rest of the side because of their similar coloring. (CPX-0138.)

In light of the prior art, the rear and rear perspective views also demonstrate the difference between the D'757 patent's impression of sleek minimalism and the Transform's busier impression. For example, the rear and rear perspective views of the D'757 patent show a flat back surface, rounded edges, and a distinct lack of detail or ornamentation—again creating an uninterrupted and sleek impression of simplicity. (Figs. 2 and 4, JX-0001.) In contrast, the Transform has a sculptured back surface and rectangular features which draw the observer's eye because of their contrasting coloring and prominence. (*Compare* JX-0001 *with* CPX-0138; *see also* RDX-37-18.)

In light of the prior art, the front and front perspective views also demonstrate the difference between the D'757 patent's minimalistic impression and Transform's busier impression. For example, the front and front perspective views of the D'757 patent show a flat front surface which is co-planar with the bezel, rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression of simplicity. In contrast, the Transform has a reflective front surface with more rectangular features and a non-coplanar bezel.

(Compare JX-0001 with CPX-0138; see also RDX-37-17.) As with the side views, however, these rectangular features tend to disappear into the background of the front face. (See CPX-0138.)

In light of the prior art, the bottom and top views also demonstrate the difference between the D’757 patent’s impression of sleek minimalism and the Transform’s impression of detail. For example, the top and bottom views of the D’757 patent show rounded edges, a curved bezel which meets and joins with the rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression. In contrast, the Transform has somewhat more angular edges, an angular bezel which does not meet and join with the rounded edges, and a number of rectangular features which draw the observer’s eye. (Compare JX-0001 with CPX-0138; see also RDX-37-19.)

Accordingly, I find that an ordinary observer familiar with the prior art, giving such attention as a purchaser usually gives to the types of products at issue, considering the overall appearance and impression of the claimed design and the accused design, would find the Transform is not substantially the same design as claimed by Apple’s D’757 patent and thus does not infringe the D’757 patent.

**F. Validity of the D’757 Patent - Obviousness Under 35 U.S.C. § 103(a)**

In addressing a claim of obviousness in a design patent, “the ultimate inquiry ... is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1375 (Fed. Cir. 2009) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996).)

## PUBLIC VERSION

To determine whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design, the finder of fact must employ a two-step process. First, one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design. Second, other references may be used to modify [the primary reference] to create a design that has the same overall visual appearance as the claimed design.

*Apple, Inc. v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012.) (internal quotations and citations omitted). However, the “secondary references may only be used to modify the primary reference if they are so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (internal quotations omitted). “[W]hether to combine earlier references to arrive at a single piece of [hypothetical] art for comparison with the potential design or to modify a single prior art reference” is also determined from the point of view of a designer of ordinary skill in the art. *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009). However, “[o]nce that piece of [hypothetical] prior art has been constructed, obviousness, like anticipation, requires application of the ordinary observer test” and a “focus on the *overall* designs.” *Id.* at 1240-41.

### 1. Japanese Design Patent JP D1250487

#### **The Parties’ Positions**

Apple argues that the JP487 does not create basically the same visual impression as the D’757 patent and thus it cannot serve as a primary reference. (CIB at 47.) Apple argues that modifying the JP487 design with an unadorned back, as Samsung suggests, would not address

the many other modifications necessary to make it look substantially the same as the D'757 design. (*Id.*)

Samsung argues that construed broadly, the front view of the JP487 discloses a design very similar to the D'757 patent and serves as a primary reference. (RIB at 64.) Samsung argues that both designs show rectangular forms with rounded corners framing the face. (*Id.*) Samsung also argues that the perspective views are also some more, showing thin rectangular forms with Truman in front and curved edges. (*Id.*) Samsung argues that although the back of the JP487 contains features not found in the D'757 patent it wouldn't obvious to modify the JP487 to remove them to enhance comfort in usability and reduce manufacturing costs and potential breakage. (*Id.* at 64-65.) Samsung argues that other references disclosed an unadorned back. (*Id.*) Thus Samsung argues because of the portable and tried devices with unadorned back for publicly disclosed prior to the D'757 patent, such prior art references indicate the obviousness of such a solution. (*Id.*)

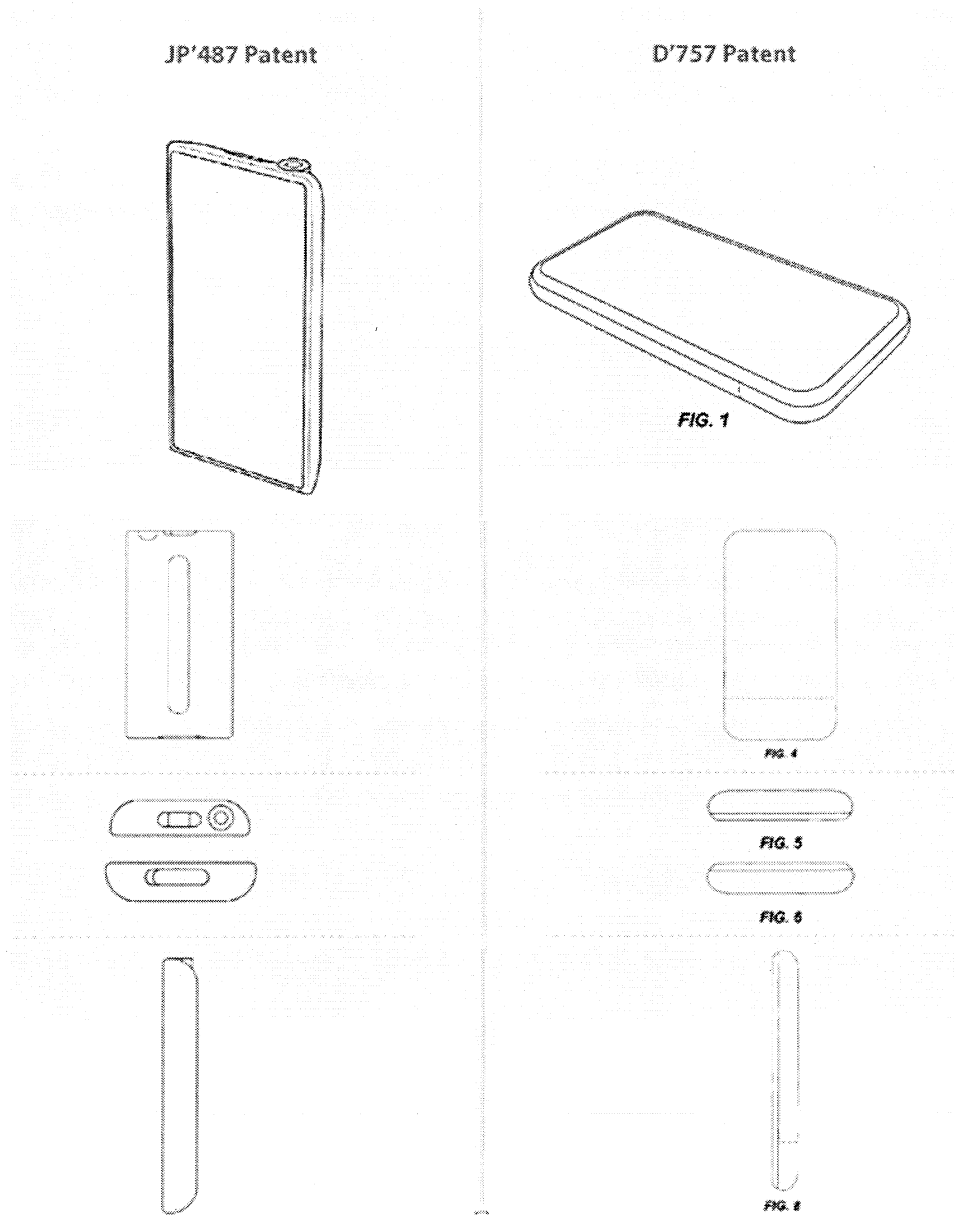
The Staff argues that the evidence has shown that the JP487 patent is not a proper primary reference and that the patent therefore does not render the claimed D'757 design obvious. (SIB at 29.) The Staff argues that in contrast to the D'757 design, which includes a rectangular body with evenly curved corners, the JP487 design includes a body having corners that are substantially sharper than the D'757 design. (*Id.* at 29-30.) Staff argues that the evidence has shown that unlike the D'757 claimed design, the JP487 design includes a prominent circular headphone jack protruding from the top of the device. (*Id.* at 30.) The Staff argues in further contrast the D'757 design, the top and bottom views of the JP487 design have significant adornments. (*Id.*)

**Analysis**

Samsung argues that the claimed D'757 design would have been obvious in light of Japanese Design Patent JP D1250487 ("JP487") in view of KR30-0304213, JP887388, and D504,889. JP487 was filed on November 25, 2004, which is more than one year before the effective filing date of the D'757 patent. (RX-2750; JX-001, cover page.) Thus, JP487 is prior art under 35 U.S.C. § 102 (b). An illustration of both the JP487 design and D'757 design is shown below.



PUBLIC VERSION



Although Samsung contends that JP487 is similar to the D'757 design, the overall visual impression of the JP487 would require major modifications to look similar to the D'757 design. For example, while the circular headphone jack protruding from the top of JP487 is a prominent feature of the device, no such analogous feature exists in the D'757 design. Also, there are

differences in the corners of JP487 and the D'757 design. The corners of JP487 are sharp in comparison to the round corners in the D'757 design, thus giving a much more angular visual impression than the soft, curved impression given by the D'757 patent. Further, the sleek minimalistic appearance of the D'757 design is contrasted by the back, top and bottom profile views of JP487, which show significant adornments, including a large lozenge-shaped feature on the back. Thus, for the reasons above, I do not find JP487 to be sufficiently the same as the claimed design to constitute a primary reference for purposes of obviousness.

Moreover, even if JP487 was found to be a primary reference, Samsung still fails to explain why the secondary references it lists qualify as prior art, why one of ordinary skill in the art would combine the primary and secondary designs, and whether the combined alleged prior art designs would have the same overall visual impression as the D'757 design. Samsung only discusses modifying JP487 design with an unadorned back, but does not address the many other modifications necessary to make JP487 look substantially the same as the D'757 design.

Accordingly, I find Samsung has failed to show by clear and convincing evidence that the claimed design in the D'757 patent is obvious in light of JP487.

## **2. Korean Design Registration 30-0304213**

Samsung argues that the design claimed in the D'757 patent is obvious in light of Korean Design Registration 30-0304213 ("KR213"). Samsung's entire argument regarding the KR213 is stated in Samsung's initial post-hearing brief as follows:

Korean design registration 30-0304213 (KR'213) (RX-0371), published in August 2002, can serve as an obviousness reference to the extent the D'757 patent is construed broadly. It also demonstrates further that rectangular devices with rounded corners and large, flat, unornamented surfaces were known in the prior art, and would be familiar to the ordinary observer.

(RIB at 65.) Samsung did not raise this argument in its pre-hearing brief and thus in accordance with Ground Rule 9.2 it is hereby struck. Regardless, the above paragraph is insufficient on its face to constitute a *prima facie* case of obviousness. Not only does Samsung fail to show that the KR213 is a primary reference, but Samsung does not even set forth any secondary references. Accordingly, even if the reference was not struck, I would find Samsung failed to prove by clear and convincing evidence that the claim of the D'757 patent was obvious in light of the KR213.

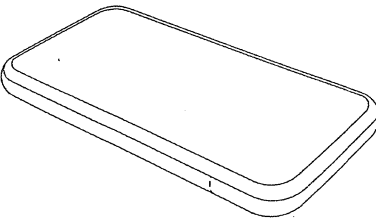
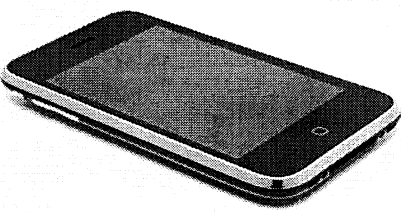
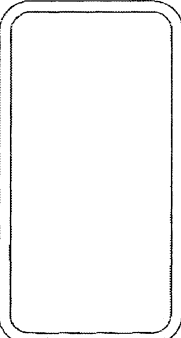
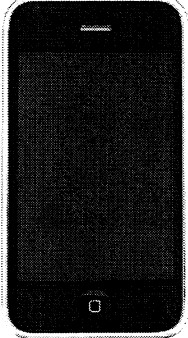
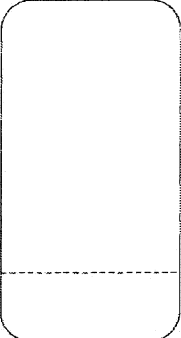
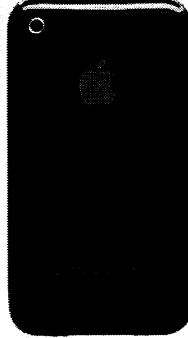
**G. Technical Prong of the Domestic Industry Requirement**

“[T]he technical prong requires proof that the patent claims cover the articles of manufacture that establish the domestic industry.” *Crocs*, 598 F.3d at 1307. With respect to design patents, this requires applying *Gorham*’s ordinary observer test to compare the overall impressions of the design of the Domestic Industry products and the asserted designs. *See id.* (finding the “overall effects of the design present in both the ‘789 patent and Crocs shoes” to be substantially the same in the eyes of the ordinary observer).

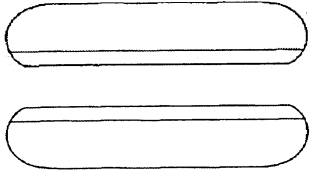
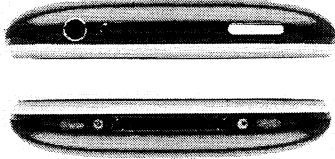
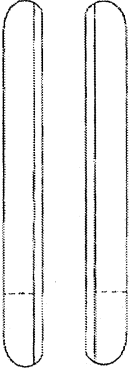
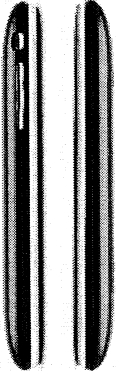
**Parties’ Positions**

Apple contends its iPhone 3G and iPhone 3GS practice the D’757 patent because the overall visual impression of their designs would be viewed by an ordinary observer as substantially the same as the D’757 design. (CIB at 68-70.)

**PUBLIC VERSION**

<b>D'757 Patent</b>	<b>iPhone 3GS (CPX-5)</b>
	
	
	

PUBLIC VERSION

D'757 Patent	iPhone 3GS (CPX-5)
	
	

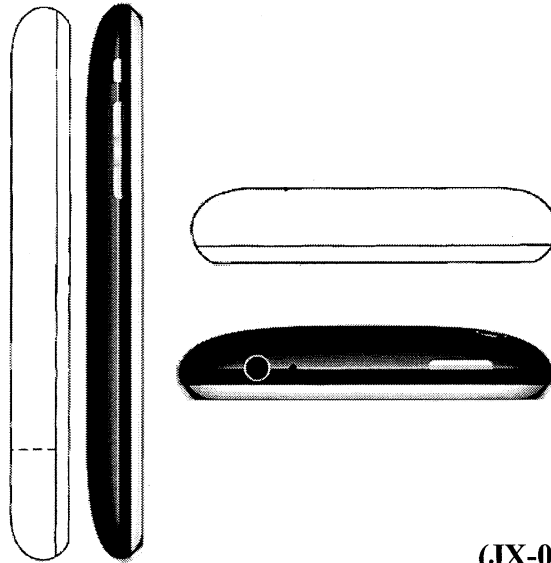
Although Apple admits a few differences between the D'757 design and the D'757 Domestic Industry products, Apple contends that the features on the front face of the iPhone 3GS either do not disrupt the ordinary observer's overall visual impression created by the flat front face, the bezel, and the body of the D'757 design or constitute a trademark that plays no part in the ordinary observer test. (CIB at 70.)

The Staff believes that the claimed design of the D'757 patent is substantially the same as at least the iPhone 3G. (SIB at 31.) Furthermore, the Staff believes that Samsung's analysis of the technical prong of domestic industry with respect to the D'757 patent is cursory and incomplete. (SIB at 31.) In addition, as previously indicated, the Staff believes that Apple's construction should be adopted over Samsung's construction. (*Id.*) As such, and in light of the foregoing analysis regarding the Domestic Industry products provided by Apple, the Staff

believes the evidence has shown that the iPhone devices practice the claimed design of the D'757 patent. (*Id.* at 31-32.)

Samsung makes a number of arguments to support its contention that the D'757 Domestic Industry products do not practice the D'757 patent. First, Samsung contends the iPhone, iPhone 3G, and iPhone 3GS all have transparent and reflective front surfaces, which makes them all fundamentally different than the D'757 design. (RIB at 58.) Samsung also contends the D'757 design has an entirely blank front face devoid of any detail such as buttons, display screen, apertures, interruptions or features, while the iPhone, iPhone 3G, and iPhone 3GS all have a large rectangular screen on the front, an oblong-shaped opening for a speaker, circular elements for sensors, border masks, and a circular button on the bottom of the front surface. (*Id.*). Along those same lines, Samsung contends that the rear surfaces of the iPhones also have details not disclosed in the D'757, such as cameras and an Apple logo image in contrasting colors and physical buttons, ports and speakers on the left side, top and bottom. (*Id.* at 61-62.)

In addition, Samsung contends the iPhone 3G and 3GS do not have the same shape as the D'757 patent because the D'757 has a flat back but the iPhone 3G/3GS design has a curved back. (RIB at 58-62).



(JX-0001; CPX-0005).

### Analysis

When comparing the D'757 patent claims to the **physical** exhibits of the D'757 Domestic Industry products, I find that in light of the prior art the overall impression of the D'757 patent is substantially the same as the D'757 Domestic Industry products. In each of the views of the D'757 patent and the D'757 Domestic Industry products, I note a number of differences that contribute to the similarity between the overall impression of the D'757 patent and the D'757 Domestic Industry products. Although the following discussion addresses specific details of the D'757 design and the D'757 Domestic Industry products, the consideration of these details is in the context of the overall impression created with these details (or lack thereof).

The side views demonstrate the similarity between the D'757 patent's impression of sleek minimalism and the D'757 Domestic Industry products' appearances. For example, the side views of the D'757 patent show a flat back surface, rounded edges, a curved bezel which meets and joins with the rounded edges, and a distinct lack of detail or ornamentation—creating an uninterrupted and sleek impression. (See JX-0001.) Although the iPhone 3GS has a non-flat

PUBLIC VERSION

back and a slightly different curvature, these differences are slight and would not demonstrate a significant difference to an ordinary observer. (*Compare* JX-0001 with CPX-0003, CPX-0004, CPX-0005.)

The rear and rear perspective views also demonstrate the similarity between the D'757 patent's impression of sleek minimalism and the D'757 Domestic Industry products' impressions. For example, the rear and rear perspective views of the D'757 patent show a flat back surface, rounded edges, and a lack of detail or ornamentation—again creating an uninterrupted and sleek impression of simplicity. (*See* JX-0001.) Similarly, the D'757 Domestic Industry products have a flat back surface with rounded edges and a lack of ornamentation. (*Compare* JX-0001 with CPX-0003, CPX-0004, CPX-0005.) Samsung contends that additional features on the back of the D'757 Domestic Industry products create an impression that is not substantially similar to the D'757 patent. While the Apple trademark is prominent on the back of the D'757 Domestic Industry products, trademarks are not considered in the ordinary observer test and thus this feature cannot contribute to a difference between the D'757 patent and the D'757 Domestic Industry products. *See, e.g., L.A. Gear*, 988 F.2d at 1126 & 1133-34 (infringer's use of trademarks, described as “well-known” and “recognized by consumers,” did not avoid finding of the design patent infringement). Furthermore, the additional details cited by Samsung are slight and would not demonstrate a significant difference to an ordinary observer. (*Compare* JX-0001 with CPX-0003, CPX-0004, CPX-0005.)

The front and front perspective views also demonstrate the similarity between the D'757 patent's impression of sleek minimalism and the D'757 Domestic Industry products' impression. For example, the front and front perspective views of the D'757 patent show a flat front surface



which is co-planar with the bezel, rounded edges, and a lack of detail or ornamentation—creating an uninterrupted and sleek impression of simplicity. (*See* JX-0001.) Likewise, the D’757 Domestic Industry products have a co-planar with the bezel, rounded edges, and a distinct lack of detail or ornamentation. (*Compare* JX-0001 with CPX-0003, CPX-0004, CPX-0005.) Although the D’757 Domestic Industry products all have a rectangular screen on the front, an oblong-shaped opening for a speaker, circular elements for sensors, border masks, and a circular button on the bottom of the front surface, these features tend to disappear into the background of the front face and do not alter the overall impression of simplicity of the D’757 Domestic Industry products. (*See* CPX-0003, CPX-0004, CPX-0005.)

The bottom and top views also demonstrate the similarity between the D’757 patent’s impression of sleek minimalism and the D’757 Domestic Industry products’ impression. For example, the top and bottom views of the D’757 patent show rounded edges, a curved bezel which meets and joins with the rounded edges, and a lack of detail or ornamentation—creating an uninterrupted and sleek impression. (*See* JX-0001.) Similarly, the D’757 Domestic Industry products have rounded edges and a curved bezel which meets and joins with the rounded edges. (*Compare* JX-0001 with CPX-0003, CPX-0004, CPX-0005.) Samsung contends that additional features on the top and bottom of the D’757 Domestic Industry products create an impression that is not substantially similar to the D’757 patent. These features tend to disappear into the background of the front face, however, and do not alter the overall impression of simplicity of the D’757 Domestic Industry products. (*See* CPX-0003, CPX-0004, CPX-0005.)

Samsung’s suggestion that the iPhone 3G or 3GS cannot practice the D’757 patent if they embody later-issued Apple patents is not supported by the law. Federal Circuit law is clear that a

product may practice multiple patents. *See Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1582 (Fed. Cir. 1996) (“[T]he fact of separate patentability presents no legal or evidentiary presumption of non-infringement.”); *see also Keystone*, 2001 U.S. Dist. LEXIS 26272, at \*12-15 (excluding evidence of subsequently-issued patents as they were not “relevant to the question of whether the accused Rockwood blocks are ‘substantially similar’ to the design disclosed in the ‘560 patent”). In *Gorham*, the Supreme Court found that defendant White’s silverware designs, which practiced White’s own patents, also infringed plaintiff Gorham’s patent. *Gorham*, 81 U.S. at 530-31.

Accordingly, I find that an ordinary observer, giving such attention as a purchaser usually gives to the types of products at issue, considering the overall appearance and impression of the claimed design and the D’757 Domestic Industry products, would find the D’757 Domestic Industry products are substantially the same design as claimed in Apple’s D’757 patent and thus practice the D’757 patent.

## **VI. U.S Patent No. D618,678**

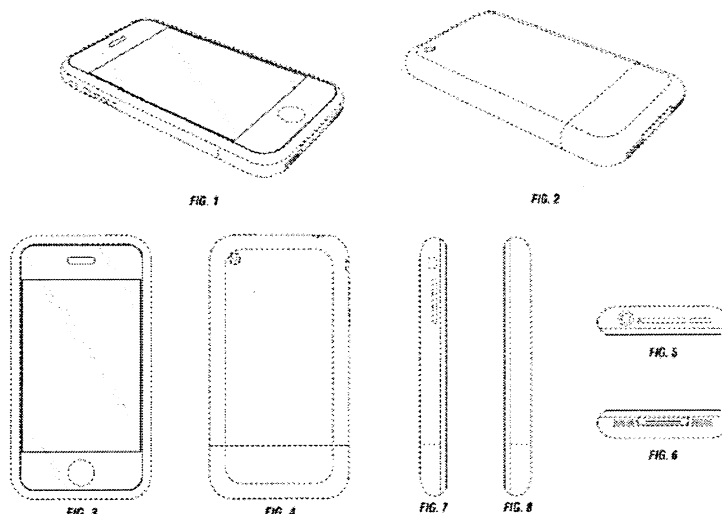
### **A. Introduction**

U.S. Patent No. D618,678 (“D’678 Patent”), titled “Electronic Device,” issued on June 29, 2010. (JX-0002, coverpage.) The D’678 patent issued from U.S. Patent App. Serial No.29/332,683, filed on February 23, 2009. (*Id.*) The inventors are Bartley K. Andre, Daniel J. Coster, Daniele De Iuliis, Richard P. Howarth, Jonathan P. Iye, Steve Jobs, Duncan Robert Kerr, Shin Nishibori, Matthew Dean Rohrbach, Douglas B. Satzger, Calvin Q. Seid, Christopher J. Stringer, Eugene Antony Whang, and Rico Zorkendorfer. (*Id.*) The D’678 patent is assigned to Apple, Inc. (*Id.*)

## B. Asserted Claims

The D'678 is a design patent and as such has only one claim, which reads as follows:

We claim the ornamental design for an electronic device, substantially as shown and described.



[JX-0002 D'678, Figs. 1-8]

## C. Level of Ordinary Skill in the Art

Apple suggests a person of ordinary skill in the relevant art is one holding a Bachelors of Science degree or its equivalent in industrial or product design, and having at least two years of work experience as an industrial designer, including experience in the design of electronic devices. (CIB at 30.) The Staff suggests the designer of ordinary skill in the art pertaining to the D'678 patent is a person who holds a Bachelors of Science degree or its equivalent in industrial or product design and has at least two years of work experience as an industrial designer, including experience in the design of electronic devices. (SIB at 22.) Samsung suggests a person of ordinary skill in the art relevant to Apple's asserted design patents would have experience designing electronic devices including, but not limited to, mobile devices, such as

cellular telephone handsets and other electronic devices, or be a designer in academia who conducted research on the interface of products to people or taught industrial design students the design of electronic devices. (RIB at 64, 103.) Whereas Apple cites to the testimony of its expert in support of its proposed level of ordinary skill, Samsung relies only on attorney argument.

Thus, in light of the evidence, I find that a designer of ordinary skill in the art pertaining to the D'678 patent is a person who holds a Bachelors of Science degree or its equivalent in industrial or product design and has at least two years of work experience as an industrial or product designer, including experience in the design of electronic devices.

**D. Claim Construction**

The infringement analysis for a design patent begins with construing the claimed design. *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1319 (Fed. Cir. 2007).

The design patent claim scope “encompasses its visual appearance as a whole, and in particular the visual impression it creates.” *Arminak & Assocs.*, 501 F.3d at 1319-20 (internal quotations omitted). Design patents do not cover broad design concepts, however, and are limited by the specific ornamental features depicted in the patent. *See OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (finding that proper construction did not encompass broad design concept of “rocket-like tossing ball”); *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (finding the district court properly avoided the “broader general design concept” in construing patent).

The Court of Appeals for the Federal Circuit has cautioned trial courts to avoid excessive reliance on a detailed verbal description of the design in construing the claim. *Crocs, Inc. v. ITC*,

598 F.3d 1294, 1302 (Fed. Cir. 2010) (citing *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc)). “Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design.” *Egyptian Goddess, Inc.*, 543 F.3d at 679. A court’s decision regarding the level of detail to be used in describing the claimed design, though, “is a matter within the court’s discretion, and absent a showing of prejudice, the court’s decision to issue a relatively detailed claim construction will not be reversible error.” *Id.*

Although the Federal Circuit has repeatedly cautioned about the dangers of presenting a full description of the claimed design, the Federal Circuit has nevertheless stated that a court may find it helpful to point out various features of the claimed design in relation to the accused design and the prior art. *See Egyptian Goddess, Inc.*, 543 F.3d at 680 (“In a case such as this one, for example, there would be nothing wrong with the court pointing out to a jury that in the patented design only three sides have buffers attached, while in the accused product (and in the three-sided Nailco patent), all of the sides have buffers attached.”). The trial court may also address particular conventions in design patent drafting, such as the role of dashed lines. *Contessa Food Prods., Inc.*, 282 F.3d at 1378 (approving the district court’s explanation of the use of dashed lines in the asserted design patent).

### **Parties’ Positions**

Apple contends the D’678 patent protects the iconic design of the iPhone’s front face, which has appeared in every generation of the iPhone to date. (CIB at 36.) Apple characterizes the design as

[A] single continuous piece of transparent material that is rectangular in overall shape with evenly curved corners. The transparent material is flat and extends edge-to-edge across the entire front surface. Visible in this transparent material is a rectangular element surrounded by narrow balanced borders on the lateral sides and wider balanced borders above and below. There is a lozenge-shaped element horizontally centered in the area above the rectangular element . . . The grouping of these features is distinctive in shape, proportion, placement, and overall visual impression.

(*Id.* at 36-37.)

The Staff cites to the testimony of Apple witness Mr. Stringer, which states:

The D'678 patent shows the transparent flat front surface of the iPhone. It reflects the fundamental idea behind the appearance of the original iPhone, as I explained previously. Figures 1 and 3 show a generally rectangular shape with four evenly radiused corners, a flat transparent front surface, and a symmetrically placed inner rectangular design element with wide borders surrounding it at the top and bottom and narrower borders on the sides. There is a lozenge-shaped design element centered above the inner rectangular design element. This lozenge shape corresponds to the receiver opening in an actual iPhone. The flat geometry of the front surface of the design is further shown by Figures 5, 6, 7, and 8. The claimed front surface is defined by a straight, solid line extending across the full front of the otherwise disclaimed electronic device in each of those figures. I believe that it is clear that the claimed design is limited to a transparent flat surface, regardless of its placement in relation to the remainder of the device, because the broken line indicating the disclaimed environmental structure and the full line indicating the claimed flat transparent surface are nearly superimposed on one another.

(SIB at 19.) The Staff argues that Apple's construction of the D'678 patent should be adopted.

(*Id.*)

Samsung alleges that the design claimed in the D'678 patent should be construed as a front surface that is entirely co-planar and continuous, borders to the left and right of the interior rectangle that are extremely narrow, an oblong feature of the shape shown in the drawings of the D'678 patent that is co-planar with the rest of the front, or ornamented on the surface of the device, and positioned symmetrically both horizontally and vertically in the upper border, no additional detail on the front surface, an external rectangular shape with four evenly rounded

corners of the shape and proportion shown in the drawings of the D'678 patent, a reflective, highly polished, or transparent surface that extends to the outside perimeter, a display screen and a clear cover over the display that cannot be claimed. (RIB at 71-73.)

Samsung also contends that the patents must be construed narrowly in view of their alleged functional elements. (*Id.* at 74.) Samsung alleges the D'678 patent must be construed to factor out functional elements because design patents protect only ornamental features. (*Id.*) Samsung alleges the display, the transparent cover over the display, and the receiver speaker located in the upper portion of the front face are functional. (*Id.* at 74-75.)

### Analysis

A design patent only protects the nonfunctional aspects of an ornamental design. *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) (citing *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993)). A claimed element is functional “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Amini*, 439 F.3d at 1371 (internal quotations omitted). To be excluded from protection based on functionality, the particular aspect of the claimed design must be *dictated* by function. See *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010) (*emphasis added*). Thus, the fact that an aspect of the claimed design has some function does not necessarily require its exclusion from protection. See *Richardson*, 597 F.3d at 1294 (factoring out certain elements of the claimed design due to the elements being driven “*purely* by utility”) (*emphasis added*).

Samsung’s argument that functional elements must be discarded is insufficient as a matter of law as it confuses elements having functionality with elements dictated by function

alone. *See Richardson*, 597 F.3d at 1293. Although as Samsung alleges, certain elements of the device to which the claimed designs pertain are functional, I find that the design characteristics of these elements and the overall claimed designs are not dictated by function.

Samsung specifically alleges the display feature and the speaker slot on a mobile telephone are functional. However, the evidence suggests that having a display or speaker slot with particular characteristics (e.g., shape, size, etc.), is not dictated by function. *L.A. Gear, Inc.*, 988 F.2d at 1123; *see also* Tr. 797:22-798:10, Tr. 799:10-25 (testimony of Mr. Bressler, discussing the functionality of the display screen and speaker slot). Moreover, the existence of alternative phone designs from both Samsung and others also indicates that the design of the display and speaker slot are not dictated solely by their respective functions. *See Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed. Cir. 1997) (“The presence of alternative designs may or may not assist in determining whether the challenged design can overcome a functionality challenge.”). Samsung also argues that a design element is functional if it “affects the cost or quality of the article.” (RIB at 74; *see Amini Innovation Corp. v. Anthony California, Inc.*, 439 F.3d 1365, 1371 (Fed. Cir. 2006)). The evidence suggests, though, that the cost and quality of the D’678 Accused Devices are not affected by the claimed design. (*See, e.g.*, Tr. 800:1-19 (testimony of Mr. Bressler discussing cost and quality of alternative designs)). In light of the foregoing, I find that none of the elements of the D’678 patent should be excluded from the infringement analysis because there is no proof that any of the elements are dictated solely by function.

I find Apple’s and the Staff’s construction overly broad and thus decline to adopt it. I find Samsung has lost sight of the factors important to design patent infringement, namely the



overall visual appearance of the prior art, patents, and accused products, and has instead improperly become mired in the minutia of individual design elements. As such, Samsung's analysis is flawed in light of *Egyptian Goddess* because it strays too far from the ordinary observer test.

I have again decided not to provide a verbal construction of the claim. I find that the drawings of the D'678 patent speak for themselves and thus construe the claims of the D'678 to cover the design for an electronic device as depicted in FIGS. 1-8 of the D'678 patent. Additionally, I find that the patent does not claim any feature depicted in dashed line, as this has been affirmatively disavowed. (JX-0002 ("The broken lines show portions of the electronic device which form no part of the claimed design.")). I further find that this patent covers a reflective or shiny front face as the drawings depicting the front surface include oblique line shading. *Apple, Inc. v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1331 n. 5 (Fed. Cir. 2012) ("By its use of oblique lines, the D'889 patent indicates that the front surface of the device is reflective and glass-like."); *see also* MPEP § 1503.02(II).

**E. Infringement of the D'678 Patent**

After the claims have been construed, the court must consider if the patented design is infringed by the accused product. *Arminak & Assocs.*, 501 F.3d at 1320. Design patent infringement is a question of fact, which a patentee must prove by a preponderance of the evidence. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993). The sole test for determining infringement of a design patent is the "ordinary observer" test. *See e.g., Egyptian Goddess, Inc.*, 543 F.3d at 678. In defining the "ordinary observer test," the Supreme Court stated:

PUBLIC VERSION

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

*Gorham Mfg. Co.*, 81 U.S. at 528. Thus, the “ultimate question [of whether a design patent is infringed] requires determining whether ‘the effect of the whole design [is] substantially the same’.” *L.A. Gear, Inc.*, 988 F.2d at 1125 (quoting *Gorham*, 81 U.S. at 530). The test is not a comparison of one product to another, but instead is a comparison of the patented *design* to the allegedly infringing *design*. See *Gorham Mfg. Co.*, 81 U.S. at 529 (“The *Gorham design*, and the two *designs* sold by the defendant, which were patented to White, one in 1867, and the other in 1868, are alike the result of peculiarities of outline, or configuration, and of ornamentation. These make up whatever is distinctive in appearance, and of these, the outline or configuration is most impressive to the eye. Comparing the figure or outline of the plaintiffs’ *design* with that of the White *design* of 1867, it is apparent there is no substantial difference.” (*emphasis added*)).

In assessing infringement, the patented and accused designs do not have to be identical in order for design patent infringement to be found. *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 820 (Fed. Cir. 1992). “[M]inor differences between a patented design and an accused article’s design cannot, and shall not, prevent a finding of infringement.” *Payless Shoesource, Inc. v. Reebok Int’l, Ltd.*, 998 F.2d 985, 991 (Fed. Cir. 1993) (quoting *Litton Sys. Inc. v. Whirlpool*, 728 F.2d 1423, 1444 (Fed. Cir. 1984)). What is controlling is the appearance of the patented design as a whole in comparison to the accused design. *OddzOn Prods., Inc.*, 122 F.3d at 1405. To assist in determining whether the two designs would be considered “substantially the same” by an ordinary observer, a comparison of the claimed and accused designs with the prior art may be beneficial. See *Egyptian Goddess, Inc.*, 543 F.3d at 677.

**The Parties' Positions**

Apple alleges that certain Samsung products infringe the claimed design of the D'678 patent. (CIB at 55-61.) Apple has applied the ordinary observer test to the infringing products in light of the prior art (e.g., Japanese Patent No. D1204221 and Japanese Patent No. D1241638) and has argued that the accused products infringe the claimed D'678 design. (*Id.*) Apple cited the Galaxy S 4G/Vibrant as representative of the D'678 Accused Products. Apple contends the Galaxy S 4G/Vibrant and D'678 designs have the same major visual elements, including a flat front surface comprised of a single piece of transparent material that extends edge-to-edge, a generally rectangular shape with rounded corners, a large display screen with narrow balanced borders on either side and wider balanced borders above and below, and a horizontal lozenge-shaped element horizontally centered in the upper portion of the front face. (*Id.* at 58-59.) Apple argues that with respect to each of the selected pieces of prior art, all of the products accused of infringing the D'678 patent “are more similar to the D'678 design” than to any piece of prior art, particularly with respect to the flat front face comprised of a single piece of transparent material that extends from edge-to-edge across the front face of the device. (*Id.* at 59.) Thus Apple concludes that an ordinary observer would conclude that the overall visual impression of the D'678 Accused Products is substantially the same as the overall visual impression of the design claimed in the D'678 Patent when considered in light of the prior art. (*Id.*) Apple also concludes that any differences between the D'678 Accused Products designs and the D'678 patent would not alter the overall impression of the designs for an ordinary observer. (*Id.*)

In the Staff's view, the Samsung Galaxy S 4G, for example, is “much closer” to the claimed design of the D'678 patent than the patented design is to the prior art. (SIB at 38.)