



IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA

ADOBE SYSTEMS INCORPORATED,  
*Plaintiff,*

v.

SOUTHERN SOFTWARE, INC., et al.,  
*Defendants,*

SOUTHERN SOFTWARE, INC.  
*Third-Party Plaintiff,*

v.

ARES SOFTWARE CORPORATION,  
*Third-Party Defendant.*

NO. C95-20710 RMW(PVT)

ORDER GRANTING IN PART PLAINTIFF ADOBE'S MOTION FOR SUMMARY JUDGMENT ON COPYRIGHT CLAIMS, DENYING DEFENDANTS' CROSS-MOTION FOR SUMMARY ADJUDICATION ON COPYRIGHT CLAIMS, DENYING ADOBE'S MOTION FOR SUMMARY JUDGMENT ON PATENT CLAIMS, DENYING DEFENDANTS' COUNTER-MOTION FOR SUMMARY JUDGMENT ON PATENT CLAIMS AND DENYING THIRD-PARTY DEFENDANT ARES' MOTION FOR SUMMARY JUDGMENT

Plaintiff Adobe Systems Incorporated's ("Adobe's") motions for summary judgment, defendants Southern Software, Inc.'s ("SSI's"), The Learning Company's ("TLC's") and Paul King's ("King's") cross-motions for summary judgment and third-party defendant Ares Software Corporation's ("Ares") motion for summary judgment were heard on June 11, 1997. The court has read the moving and responding papers and heard the oral argument of counsel. On May 30, 1997 at Adobe, the parties also presented a tutorial to assist the court. For the reasons set forth below, the court grants in part Adobe's motion for summary judgment on its copyright claims,<sup>[1]</sup> denies defendants' cross-motion for summary adjudication of issues on Adobe's copyright claims, denies Adobe's motion for summary judgment on its patent claims, denies defendants' countermotion on the patent claims and denies Ares' motion for summary judgment on the first amended third-party complaint.

## I. BACKGROUND

### A. Adobe's Complaint

In October 1995, plaintiff Adobe initiated this action for copyright infringement against defendants SSI and TLC (formerly known as Softkey International, Inc.). In its first amended complaint filed in June 1996, Adobe added patent infringement claims. In January 1997, Adobe filed its second amended complaint ("Complaint") adding defendant King. King is the sole officer, director and employee of SSI. King created software products for SSI which he then licensed to TLC. Adobe's Complaint contains three causes of action: (1) copyright infringement related to SSI's Key Fonts Pro product 1555, Key Fonts Pro product 2002 and Key Fonts Pro product 3003, (2) copyright infringement based on intermediate copying and (3) patent infringement related to six design patents.

Adobe alleges that King solicited copies of Adobe's programs from various sources, copied the programs onto his hard drive and altered the programs using commercially available font editing software tools contained in software programs known as Font/Monger and Fontographer. Adobe contends that using this process King created his Key Fonts Pro 1555 product which infringes Adobe's copyright. Adobe further contends that SSI then used Key Fonts Pro 1555 to create Key Fonts Pro 2002 and 3003.

### *1. Creation of Adobe font software programs*

The raw material for Adobe's fonts comes from various sources including the purchase of digitized font files from third parties. Adobe obtains a digital representation of the x and y coordinates for the glyphs which it then stores in computer memory. These "raw" coordinates are then translated into Adobe's font coordinate system by internal Adobe software which provides the glyph coordinates and glyph instructions.

An Adobe editor then displays and manipulates the on-curve and off-curve reference points [2] of each displayed glyph altering its outline. The objective of the manipulation is to efficiently, aesthetically and accurately render the appearance of each glyph. Once an Adobe editor is satisfied with the adjusted glyph image, Adobe uses its own software which makes the final assignment of coordinates, produces instructions and hints and performs any necessary kerning. The resulting font files determine the ultimate image that is displayed or printed. Adobe claims there is some creativity involved in the manipulation and editing of the on-curve and off-curve reference points. Defendants claim there is no protectable creativity contributed by the editor in determining the desired character outline for each font.

### *2. Creation of SSI's font software programs*

Adobe contends that King loaded Adobe font software programs into his computer then created his own 1555 font software program by using FontMonger. King does not dispute that he loaded Adobe programs into his computer but does not know which programs he used in creating his own programs. Adobe further contends, and King does not dispute, that he knew FontMonger extracted reference points, or on-curve points, and stored this information. King did not have an understanding about whether FontMonger also extracted and stored off-curve points. In fact, FontMonger stores both existing on-curve points and off-curve points. FontMonger does not copy any of the glyph instructions; it inserts new glyph instructions. However, the glyph instructions are implicit in the sequence and nature of the glyph coordinates. Thus, unless the on-curve points and off-curve points are moved by the user, the glyph instructions written by FontMonger will be functionally identical to those of the original font software program. Adobe contends that after extracting all of the glyph coordinates from the Adobe programs, King merely scaled the coordinates 101% on the vertical axis in order to change the font slightly. Thus, Adobe contends that the 1555 product infringes its copyrighted Adobe font software programs.

Adobe further contends that in creating his 2002 product and 3003 product King simply started with the infringing 1555 product and used Fontographer, a different commercially available font editing program, to further modify Adobe's programs. Adobe contends that the only difference between the 1555 product and the 2002 product is that the value of each x coordinate has been increased by a uniform amount and the advance widths have been changed. Thus, Adobe contends that the 1555 product and the 2002 product are unauthorized copies or derivative works of Adobe programs. Adobe contends that King, starting with the 2002 product, used the clean-up paths command in Fontographer to create his 3003 product. Therefore, Adobe contends that the 3003 product is an unauthorized infringement of the Adobe programs.

Finally, Adobe asserts that, using a specially designed version of Fontmonger, King deleted the Adobe copyright notices and replaced those notices with his own SSI copyright notices. Adobe

contends that King did this despite his knowledge that regular copies of FontMonger would not permit a user to do this.

### *B. Third-Party Complaint*

In August 1996, SSI filed its third-party complaint against Ares alleging three causes of action: (1) declaratory relief an equitable indemnity, (2) negligent or reckless misrepresentation, [3] and (3) contribution or comparative indemnity. SSI claims that if it is found liable under the Complaint filed by Adobe, that Ares is at least partially responsible for such liability based On contributory infringement.[4] Thus, SSI seeks a declaration that as between Ares and SSI, if SSI is found liable pursuant to Adobe's complaint, responsibility for the damages rests in whole or in part with Ares.

## II. LEGAL STANDARD

Federal Rule of Civil Procedures 56 provides that summary judgment "shall be rendered forthwith pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." The entry of summary judgment is mandated, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). The court, however, must draw all justifiable inferences in favor of the nonmoving party. *Masson v. New Yorker Magazine, Inc.*, 501 U.S. 496, 520 (1991).

## III. ANALYSIS

### *A. Adobe's motion and defendant's cross-motion on copyright claims*

To prove copyright infringement a plaintiff must prove ownership of a valid copyright and copying by the defendant. *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 206 (9th Cir. 1988). The parties do not dispute that Adobe is the owner of valid copyrights of its programs. Copying may be established by direct evidence of actual copying or circumstantial evidence showing defendant's access to the copyrighted work and substantial similarity of the general ideas and expression of the copyrighted work. *Id.* No claim of copyright infringement lies for copying of unprotected matter. Thus, a plaintiff must show the existence of protectable expression and copying of that expression. *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 207-08 (9th Cir. 1989). The parties do not dispute that defendant King had access to plaintiff's programs. [5] Thus, the primary issue in this case is whether the material at issue is protectable expression under the Copyright Act.[6]

A computer program is defined by the Copyright Act as "a set of statements or instructions to be used directly or indirectly in a computer to bring about a certain result." 17 U.S.C. §101. Computer programs are protectable literary works. 17 U.S.C. §102(a); *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1247-48 (3rd Cir. 1983). Typeface designs are not copyrightable. *Eltra Corp. v. Ringer*, 579 F.2d 294, 298 (4th Cir. 1978). A computer program is not rendered unprotectable merely because its output is not protectable. See *Apple Computer, Inc. v. Formula Int'l, Inc.*, 562 F.Supp. 775, 781-2 (C.D. Cal. 1983); *aff'd*, 725 F.2d 521 (9th Cir. 1984). Thus, the fact that a computer program produces unprotectable typefaces does not make the computer program itself unprotectable.

In a 1988 Copyright Office Policy Decision, the Copyright Office determined that digitized typefaces were not copyrightable because they were not computer programs and required little selection or arrangement beyond that dictated by the uncopyrightable typeface design. "Policy Decision on the Copyrightability of Digitized Typefaces," 53 Fed. Reg. 38110-38113 (September 29, 1988).

However, in 1992 the Copyright Office issued a final regulation regarding the registrability of "computer programs that generate typefaces" which appears to back off the 1988 policy decision, although the parties dispute this. The 1992 Regulation states:

After a careful review of the testimony and the written comments, the Copyright Office is persuaded that creating scalable typefonts using already digitized typeface represents a significant change in the industry since our previous Policy Decision. We are also persuaded that computer programs designed for generating typeface in conjunction with low resolution and other printing devices may involve original computer instructions entitled to protection under the Copyright Act. For example, the creation of scalable font output programs to produce harmonious fonts consisting of hundreds of characters typically involves many decisions in drafting the instructions that drive the printer. The expression of these decisions is neither limited by the unprotectible shape of the letters nor functionally mandated. This expression, assuming it meets the usual standard of authorship, is thus registrable as a computer program.

"Registrability of Computer Programs that Generate Typefaces," 57 Fed. Reg. 35 at pp. 6201-2 (February 12, 1992). Plaintiff contends that the 1992 Regulation supports protection for the scalable typefonts at issue. Defendants contend that the 1992 Regulation reaffirms the 1988 policy decision stating that digitized typefaces are not protectable.

Defendants base their assertion on the fact that the 1992 Regulation specifically states that it "does not represent a substantive change in the rights of copyright claimants." *Id.* at 6202. They argue that the effect of the 1992 Regulation is merely to revise the procedure in referencing font-depicting data in the registration process. Thus, defendants contend that the numerical reference points that define an outline of a glyph are unprotectable as a matter of law.

Defendants argue that after one has filtered out the unprotectable elements of plaintiff's software in order to compare what remains, one finds that minimal, if any, protectable expression remains. Thus, defendants state that "merely manipulating an unprotectable font image to create another, slightly different (but still unprotectable) font image cannot possibly give rise to protectable expression. . . ." *Defs. Memo.*, pp. 15-16 Defendants assert that no matter what points are selected by the Adobe editor performing the process, they correspond directly to, and hence are determined by, the unprotectable font shape. Therefore, because the output is not protected and there cannot be any creativity in what the editor does to obtain the output, nothing is protectable.

Adobe contends that King copied literal expressions. [7] Adobe contends that while the shape of the glyph necessarily dictates some of the points to be chosen to create the glyph, it does not determine all the points to be chosen. Thus, each rendering of a specific glyph requires choices by the editor as to what points to select and where to place those points. Accordingly, Adobe asserts that the selection of points and the placement of those points are expression which is copyrightable in an original font output program. The actual code is dictated by the selected points.

Adobe relies on *Feist Publications v. Rural Telephone Serv. Co.*, 499 U.S. 340 (1991) and argues that because the glyph coordinates are not prescribed entirely by the shape of the glyph they involve creativity and are protectable. "To qualify for copyright protection, a work must be original to the author. [citation omitted]. Original, as the term is used in copyright, means only that the work was independently created by the author . . . and that it possesses at least some minimal degree of creativity." *Id.* at 345. Further, "the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, no matter how crude, humble or obvious it might be." *Id.* Thus, Adobe argues that because there is some creative choice by the editors who select the on-curve and off-curve reference points, Adobe's font software programs are protectable.

Defendants contend that FontMonger and Fontographer go beyond the code and extract the coordinates and express the coordinates in absolute values. Thus, defendants assert that the source code is not being copied but only the coordinated or points which are not protectable. Defendants then assert that FontMonger and Fontographer create code based on the selection of the points which is necessarily dictated by the shape of the glyph. Defendants contend that because they only extracted the points, they have not infringed because the points themselves are not protectable.

The evidence presented shows that there is some creativity in designing the font software programs. While the glyph dictates to a certain extent what points the editor make creative choices as to what points to select based on the image in front of them on the computer screen. The code is determined directly from the selection of the points. Thus, any coping of the points is copying of literal expression, that is, in essence, copying of the computer code itself.

Further, the selection of points is not dictated by functional concerns only. See 57 Fed Reg. 6201-2. Defendants argues the efficiency is the key which is driven by the goal of minimizing the number of reference points. However, simply because there are several ways to create the same glyph, some being more efficient than others, i.e. using fewer points, does not mean there is no creativity in the process of creating the software to produce the glyphs. That some creativity is involved is illustrated by the fact that two independently working programmers using the same data and same tools can produce an indistinguishable output but will have few points in common. Accordingly, the court finds that the Adobe font software programs are protectable original works of authorship.

Adobe has provided evidence showing that King's Veracity software program is substantially similar to Adobe's Utopia software program. The modifications made by King to the Adobe programs were simply uniform mechanical modifications such as scaling the fonts. Such trivial changes do not eliminate copyright infringement. See e.g. S&H Computer Sys., Inc. v. SAS Inst., Inc., 568 F.Supp. 416, 423 (M.D. Tenn. 1983). The court finds that plaintiffs Utopia product and defendants' Veracity product are substantially similar. Thus, the court finds that King's Veracity software program infringes Adobe's Utopia software program. [8]

King also infringed when he loaded into his computer's random access memory copies of the Adobe program. See *Sega Enters. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992). His fair use defense fails because his intermediate copying utilized unauthorized copies of the Adobe programs in an apparent attempt to avoid being a party to Adobe's license agreement. Further, the copying was not necessary to determine the unprotectable aspects of the Adobe programs. See *id.* [9]

#### *B. Adobe's motion and defendants' counter-motion on patent claims.[10]*

Adobe is the owner of six design patents. Adobe's design patents are presumed valid; however, that presumption may be overcome by clear and convincing evidence to the contrary. *Avia Group Int'l Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1562 (Fed. Cir. 1988).[11] Adobe asserts that defendants have infringed the design patents.

Defendants assert that the patents are invalid and unenforceable as a matter of law. Defendants claim that the patents are invalid because the font designs are non-statutory subject matter in violation of 35 U.S.C. section 171 (requiring "original and ornamental design for an article of manufacture") in that none of the design patents disclose an article of manufacture. Defendants further assert that the patents are invalid because the designs each lack the requisite novelty and nonobviousness for patentability. Defendants also claim that, in any event, the design patents are unenforceable because Adobe willfully failed to disclose prior art when applying for the patents. Finally, defendants claim that the patents for Minion and Minion Italic are unenforceable due to the "on-sale bar" of 35 U.S.C. section 102(b).

Each of the six patents claims the article of manufacture as "the ornamental design of a type font, as shown and described." Defendants assert that this statement is insufficient to meet the requirement that the design be embodied in an article of manufacture. Adobe contends, however, that the requisite article of manufacture in this case is the program which allows the typeface to be rendered. The court in *ex parte Tayama*, 24 U.S.P.Q.2d 1614, 1616 (Bd.Pat. App. & Int. 1992), after rejecting a claim for the ornamental design of an icon, observed

Moreover, appellant asserted that affirmance of the rejection will bring into question the validity of numerous design patents directed to type fonts. We disagree. The phrase "type font" may be properly interpreted as referring to letter blocks or pieces used in a conventional printing press. The blocks or pieces constitute an article or articles of manufacture. Unlike the designs here, which are stated to be surface ornamentation, type font designs are reasonably interpreted to be the shape or configuration of the letter blocks. The fact that the meaning of "type font" may have expanded in usage to include letters or numbers appearing on paper or on a computer screen does not invalidate the long-standing interpretation of type font designs as configuration-type designs or pieces or blocks of type.

24 U.S.P.Q. 2d at 1618. Based upon the reasoning of *Tayama*, type fonts are patentable subject matter and the program which creates the type fonts is the article of manufacture. [12] Accordingly, the court finds that the typeface designs are statutory subject matter entitled to patent protection.

Adobe, relying on the deposition of Robert Slimbach ("Slimbach"), the designer of the patented material, argues that its designs are novel and nonobvious. Adobe points to several excerpts of Slimbach's deposition testimony wherein Slimbach explains the differences between his designs and what defendants contend is the prior art. In order to prevail on their defense of nonobviousness, defendants must show that a person of ordinary skill in the art would find the design obvious. *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1443 (Fed. Cir. 1984).[13] Defendants rely on the declaration of Jerry Saperstein ("Saperstein") to show that the designs at issue are not novel and are obvious.[14] The court finds that triable issues of fact exist on the factual questions underlying the legal issues of whether the designs are novel or obvious. Slimbach explains the many differences between his designs and the prior existing designs. See generally Slimbach Depo. Saperstein describes the similarities between the various type faces. The evidence conflicts and raises a triable issue of fact.

Patentees have a duty to disclose to the patent examiner any information "known to that individual to be material to patentability." 37 C.F.R. §1.56(a). As to defendants' claim that the patents are unenforceable for failure to disclose prior art, Adobe responds that defendants have failed to offer any competent evidence that material prior art was not disclosed to the PTO. Defendants rely on the declaration of Saperstein to show that material prior art was not disclosed to the PTO. Defendants assert that Slimbach's representations that he relied on certain existing material in creating his typefaces required him to disclose that material to the PTO. Adobe contends that the ancient typeface designs relied upon by Slimbach do not constitute material prior art and were not required to have been disclosed to the PTO. Based on the conflicting evidence, the court finds that a triable issue of fact exists regarding whether the designs in existence constitute material prior art that should have been disclosed to the PTO. The court further finds a triable issue of fact exists regarding Adobe's intent. Thus, the court denies Adobe's motion and defendants' counter-motion for summary adjudication on the issue of inequitable conduct.

A person may not obtain a patent if "the invention was . . . in public use or on sale in this country more than one year prior to the date of the application for patent in the United States." 35 U.S.C. §102(5). Adobe asserts that it began selling the Minion and Minion Italic designs in July 1990. Adobe filed for patent protection for these designs on July 19, 1991. It is unclear based on the evidence whether sales of the Minion and Minion Italic designs occurred before July 9, 1990. Thus, a genuine issue of fact exists regarding whether the Minion and Minion Italic patents are unenforceable due to the "on-sale bar."

Adobe's motion for summary judgment on its patent claims is denied and defendants' counter-motion is denied because genuine issues of material fact exist regarding the validity and enforceability of the design patents.[15]

### *C. Ares' motion*

The court finds that contributory infringement is a proper basis for SSI's claims of contribution and equitable indemnity. Ares worked with King in utilizing FontMonger to achieve King's purpose. Furthermore, Ares knew King's purpose in using the software. Declaration of Paul King in Support of Defendants' Counter-motions ("King Decl."), ¶¶ 12(b), 19-21. Thus, if King is found to have infringed, there is a genuine issue of fact as to whether Ares contributed to the infringement. See *Gershwin Publishing Corp. v. Columbia Artists Management, Inc.*, 443 F.2d 1159, 1162 (2nd Cir. 1971).[16]

Ares argues that SSI is an intentional tortfeasor and therefore cannot recover under the principles of contribution and equitable indemnity. However, there are disputed issues of fact as to whether King intentionally engaged in copyright infringement. King Decl. ¶ 13 (stating that he "did not intend to infringe Adobe's (or anyone else's) copyrights"). Similarly, there are disputed issues of fact regarding the intentions of Ares. Furthermore, should there be a finding that both King and Ares engaged in intentional copyright infringement, SSI might be entitled to equitable indemnity or contribution from Ares because one intentional tortfeasor can obtain such remedies against another intentional tortfeasor. See *Baird v. Jones*, 21 Cal. App. 4th 684, 690 (1993). Therefore, the court denies Ares' motion for summary judgment on SSI's contribution and equitable indemnity claims.

## IV. ORDER

Based on the foregoing, the court grants Adobe's motion for summary judgment on its claim of copyright infringement of its Utopia software program, denies defendants' cross-motion on the copyright claims, denies Adobe's motion for summary judgment on the patent claims, denies defendants' counter-motion on the patent claims and denies Ares' motion for summary judgment on the third-party complaint.

DATED: 1/30/98

/s/RONALD M. WHYTE

United States District Judge

### FOOTNOTES

[1] The court only grants the motion as to Adobe's Utopia software program because that is the only program for which Adobe provided sufficient supporting material showing substantial similarity. See Declaration of David Parsons in Support of Motion, Ex. A. It appears that SSI's other font programs may also be substantially similar to Adobe's copyrighted programs. However, the court is unwilling to grant summary judgment on those other programs without evidence to support the bare conclusions of Mr. Parsons.

[2] "On-curve points" are points on the contour of a glyph and each point marks one end of a line or curve. "Off-curve points" are not on the contour of a glyph and are necessary to control the shape of curve which describes part of the glyph.

[3] SSI has stated in its opposition to Ares' motion for summary judgment that its misrepresentation claim is moot based on Adobe's narrowing of its claims against SSI. Thus, SSI contends that it is entitled to contribution and indemnity based solely on Ares' alleged contributory infringement.

[4] Ares argues that because SSI did not plead a cause of action for contributory infringement it cannot now attempt to do so. The court finds that Ares was given "fair notice" of the claim as required by Federal Rule of Civil Procedure 8. In fact, the first amended third-party complaint specifically states that indemnity liability is premised upon Ares' contributory infringement.

[5] Defendants argue that any similarity between King's programs and plaintiff's programs of the protectable expression is de minimis and cannot support a finding of substantial similarity. Thus, defendants' main argument is that the expression is not protectable.

[6] The parties also appear to agree that the protectability issue in this case is one of law appropriately resolved on summary judgment. See *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1046 (9th Cir. 1994).

[7] Literal expression is the computer code itself. *Computer Associates, Int'l v. Altai, Inc.*, 982 F.2d 693, 702 (2nd Cir. 1992). Non-literal expression is everything about a computer program not expressed in the code. *Cognotec Services, Ltd. v. Morgan Guaranty Trust Co.*, 862 F.Supp. 45, 49 (S.D.N.Y. 1994).

[8] The 2002 and 3003 products were derived from the 1555 product. To create the Veracity 1555 product, King mechanically altered plaintiff's Utopia program using FontMonger. To create the Veracity 2002 and 3003 products King mechanically altered the 1555 product using Fontographer. Thus, the Veracity software programs contained in the 2002 and 3003 products also infringe plaintiff's copyright in its Utopia product.

[9] Since the court finds infringement on Adobe's primary copyright theory, it does not reach Adobe's theory that defendants "bodily appropriated" expression of a compilation.

[10] Defendants request that summary judgment be granted in their favor as to the Stone patents, six design patents which Adobe apparently does not own. However, those patents are not at issue in this motion. Accordingly, defendants' request is denied. Defendants have also requested that summary judgment be granted in their favor on the issue of Adobe's entitlement to damages before June 1996 when Adobe first notified defendants of its claims of infringement. See 35 U.S.C. §287(a). Adobe agrees that it is not entitled to damages which accrued prior to June 1996. Therefore, should defendants ultimately be found liable for infringement, Adobe would only be entitled to damages which it suffered after June 1996.

[11] Because the standard for overcoming the presumption of validity is clear and convincing evidence, as opposed to a simple preponderance of the evidence, it appears the court must determine that a jury could find the patents invalid under a clear and convincing standard.

[12] In fact, the PTO's guidelines issued March 20, 1996, 61 F.R. 11380, 11381-11382, state that

The PTO considers designs for computer generated icons embodied in articles of manufacture to be statutory subject matter eligible for design patent protection under Section 171. Thus, if an application claims a computer-generated icon shown on a computer screen, monitor, other display panel, or a portion thereof, the claim complies with the "article of manufacture" requirement of section 171.

\* \* \*

Traditionally, type fonts have been generated by solid blocks from which each letter or symbol was produced. Consequently, the PTO has historically granted design patents drawn to type fonts. PTO personnel should not reject, claims for type fonts under Section 171 for failure to comply with the article of manufacture requirement on the basis that more modern methods of typesetting, including computer-generation, do not require solid printing blocks.



Thus, it appears type font designs qualify as statutory subject matter.

[13] Despite what appears to be an argument in their brief that the standard is whether an ordinary person would consider the design obvious, defendants acknowledged at the hearing that the correct standard is that of a person skilled in the art.

[14] Adobe objects to Saperstein's declaration asserting that it cannot be relied upon because Saperstein is not one skilled in the art of typeface design. Thus, Adobe contends that because Saperstein's declaration is the only evidence produced by defendants on the prior art issue, defendants have failed to offer any proof that material prior art was not disclosed and therefore conclude that summary judgment is appropriate in favor of Adobe. However, the court makes its own assessment regarding obviousness based on the underlying factual findings and is not required to rely only on evidence presented by persons skilled in the art. The only requirement is that the court make the determination viewing the evidence as one skilled in the art would view it: Of course, testimony from persons skilled in the art may assist the court in making its determination, but is certainly not required. Saperstein, although not himself a designer of type faces does have expertise which qualifies him to testify on some of the underlying factual issues.

[15] Because the court has determined that genuine issues of material fact exist regarding the validity and enforceability of Adobe's patents, it does not reach the issue of whether the patents, if valid and enforceable, have been infringed. However, under the circumstances here, defendants' argument that they have not been shown to make or use the patented fonts appears to be without merit.

[16] Ares, relying on *Sony Corp. v. Universal City Studios*, 464 U.S. 417 (1984), argues that SSI cannot sue Ares on a contributory infringement theory because FontMonger has substantial noninfringing uses. Ares' Reply Brief, pp. 2-3; Trnscpt. p. 85. However, *Sony Corp.* does not apply here because SSI is not suing Ares for merely distributing FontMonger but for contributing to the alleged infringing conduct of King.