

THE “ARTICLE OF MANUFACTURE” TODAY

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TABLE OF CONTENTS

I. INTRODUCTION.....	782
II. BACKGROUND.....	785
A. Design Patentable Subject Matter.....	785
B. Design Patent Claiming & Infringement	786
C. Remedies for Design Patent Infringement	788
III. WHAT IS THE “ARTICLE OF MANUFACTURE” IN § 289?.....	789
A. The Apple/Nordock Rule	791
B. The Supreme Court Weighs In	791
IV. WHY COURTS SHOULD NOT ADOPT THE GOVERNMENT’S APPROACH	793
A. The Test.....	794
1. The Underlying Premise.....	795
2. The Factors.....	797
B. The Nature of the Inquiry.....	802
1. A Case-by-Case Inquiry?	802
2. Is it a Question of Fact or Law?	807
C. The Burden of Proof.....	807
1. “Tainted Profits”	808
2. “Peculiar Means of Knowledge”	811
V. A NEW APPROACH.....	812
A. The Test.....	812
1. Courts Should, to the Extent that They Can, Readopt the Historical Meaning of “Article of Manufacture.”	812
2. The Question of Which Article a Design is “Applied”	

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to Should be Informed by History.....	817
<i>B. The Nature of the Inquiry</i>	827
<i>C. The Burden of Proof</i>	830
VI. POTENTIAL OBJECTIONS TO THIS APPROACH.....	832
<i>A. The Legislative History & “Apportionment”</i>	832
<i>B. The Supreme Court’s Decision in Samsung</i>	832
1. The Meaning of “Article of Manufacture”.....	832
2. The Effect of this Approach.....	833
<i>C. The Interplay with Statutory Subject Matter</i>	835
<i>D. The Problem of Overcompensation</i>	835
VII. CONCLUSION.....	838

I. INTRODUCTION

Section 289 of the Patent Act provides that, for certain acts of design patent infringement, the infringer “shall be liable to the owner to the extent of his total profit, but not less than \$250.”¹ In *Samsung v. Apple*,² the U.S. Supreme Court set forth a two-step test for “[a]rriving at a damages award under § 289.”³

- (1) Step one: “[I]dentify the ‘article of manufacture’ to which the infringed design has been applied.”⁴
- (2) Step two: “[C]alculate the infringer’s total profit made on that article of manufacture.”⁵

The Court refused to “resolve whether, for each of the design patents at issue [in *Samsung*], the relevant article of manufacture is the smartphone, or a particular smartphone component,” or to “set out a test for identifying the relevant article of manufacture at the first step of the § 289 damages inquiry.”⁶

1. 35 U.S.C. § 289 (2012); see also Sarah Burstein, *Costly Designs*, 77 OHIO ST. L.J. 107, 118 n.74 (2016) (“Notably . . . § 289 does not apply to all acts of design patent infringement. By its plain terms, it applies only to certain actions taken in the commercial context. . . . So § 289 would not apply if, for example, a design student copied a patented design in class for the purpose of learning a certain fabrication technique.”).

2. 137 S. Ct. 429, 434 (2016).

3. *Id.*

4. *Id.*

5. *Id.*

6. *Id.* at 436. When the Court referred to the “relevant article,” it was using that phrase as shorthand for “the ‘article of manufacture’ to which the infringed design has been applied.” *Id.* (referring to “identifying the relevant article of manufacture” as “the first step of the § 289 damages inquiry”); *id.* at 434 (“Arriving at a damages award under § 289 . . . involves two

So now, lower courts must determine how to “identify the relevant article” — *i.e.*, “the ‘article of manufacture’ to which the infringed design has been applied” — at *Samsung* step one.⁷ To date, the Federal Circuit has not weighed in.⁸ And all three district courts have adopted (or at least substantially adopted) the approach proposed by the U.S. Government as *amicus curiae* in *Samsung v. Apple*.⁹

Under the Government’s proposal, the jury is tasked with determining what constitutes the relevant “article of manufacture” in a given case, using a multi-factor test the Government purported to derive from design patent case law.¹⁰ This approach, however, is built on a legally and logically flawed foundation.¹¹ It will increase the cost and complexity of design patent litigation without any reasonable likelihood of

steps. First, identify the ‘article of manufacture’ to which the infringed design has been applied.”). Unless otherwise indicated, this Article will do the same.

7. For more on the phrase “relevant article,” see *supra* note 6.

8. See *Apple Inc. v. Samsung Elecs. Co.*, 678 F. App’x 1012, 1014 (Fed. Cir. 2017) (remanding the case, including the “article of manufacture” issue, for determination by the district court); *Nordock, Inc. v. Sys. Inc.*, 681 F. App’x 965, 967 (Fed. Cir. 2017) (vacating its early judgment and remanding the “article of manufacture” issue to the district court for re-determination in light of *Samsung v. Apple*).

9. See Jury Instructions at No. 10, *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, No. 3:17-cv-01781-HZ (S.D. Cal. Sept. 29, 2017), ECF No. 378 [hereinafter *Columbia Jury Instructions*] (adopting the Government’s test); Order Requiring New Trial on Design Patent Damages, *Apple Inc. v. Samsung Elecs. Co.*, No. 5:11-cv-01846, 124 U.S.P.Q.2d 1917, 2017 WL 4776443 (N.D. Cal. Oct. 22, 2017), ECF No. 3530 [hereinafter *Apple Retrial Order*] (substantially adopting the Government’s test); Decision and Order, *Nordock Inc. v. Sys. Inc.*, No. 2:11-cv-00118, 2017 WL 5633114 (E.D. Wis. Nov. 21, 2017), ECF No. 270 [hereinafter *Nordock Order*] (adopting the Government’s test and adding that “how a product is manufactured merits explicit consideration as a factor”). The Government’s test has also been endorsed by some commentators. *E.g.*, Elizabeth M. Gil, Note, *Samsung v. Apple: Taking A Bite Out of the Design Patent “Article of Manufacture” Controversy*, 25 U. MIAMI BUS. L. REV. 67, 86 (2017) (“[T]he suggested test of the United States as *amicus curiae* would be the best solution for the first step of the § 289 damages inquiry.”) (referring to Brief for the United States as *Amicus Curiae* Supporting Neither Party, *Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429 (2016), (No. 15-777), 2016 WL 3194218 [hereinafter *Gov’t Br.*]); Rachel Johns, Comment, *Samsung v. Apple: A Proposal for “Article of Manufacture.”* 2 GEO. L. TECH. REV. 93, 101 (2017) (endorsing the Government’s test and arguing that it “will help prevent unjust enrichment” and “encourage innovation”). The Government’s proposal also appears to have produced significant anchoring effects, making some jump straight to asking “What factors should be considered by the factfinder?” and bypassing the underlying questions of whether there should be a multi-factor test at all and whether this should be treated as an issue of law or an issue of fact. Perry Saidman, Elizabeth Ferrill, Damon Neagle & Tracy Durkin, *Determining the “Article of Manufacture” Under 35 U.S.C. 289*, 99 J. PAT. & TRADEMARK OFF. SOC’Y 349, 355 (2017) (proposing a multi-factor test without explaining why this should be a question of fact or a multi-factor test). See also Order at 1–2, *Nordock, Inc. v. Sys. Inc.*, No. 2:11-cv-00118 (E.D. Wis. June 20, 2017), ECF No. 255 (“[T]he parties agreed that there are some issues that require resolution, including . . . what factors are to be considered in determining the article of manufacture, and who has the burden of proof with respect to the question of the article of manufacture.”).

10. See discussion *infra* Part IV.

11. See *id.*

producing fairer, more just, or more predictable outcomes.¹² Therefore, it is not a good test for *Samsung* step one.¹³

This Article proposes a better test. It argues that, in interpreting and applying § 289, courts should, to the extent possible, readopt the original meaning of “article of manufacture.” When Congress enacted the original “total profits” remedy in 1887, “the phrase ‘article of manufacture’ referred to a tangible item made by humans — other than a machine or composition of matter — that had a unitary structure and was complete in itself for use or for sale.”¹⁴ This Article also argues that, in determining which article a design has been “applied” to, courts should look to history.¹⁵ It also sets forth a proposed framework for how these principles might translate into a test for *Samsung* step one. This approach provides a workable solution. It would be relatively cheap and easy to apply.¹⁶ It would result in damages awards that more accurately reflect the designer’s actual contribution without providing a disproportionate windfall to design patentees. It would also minimize the *in terrorem* value of patents that claim only part of the configuration or surface ornamentation of a product.¹⁷

To be clear, this Article does not argue that courts should readopt these original meanings merely because they are the original meanings. Rather, courts should readopt these original meanings because they provide a workable and sensible approach to *Samsung* step one. This

12. *See id.*

13. *See id.*

14. Sarah Burstein, *The “Article of Manufacture” in 1887*, 32 BERKELEY TECH. L.J. 1, 5 (2017). *But see* Joshua D. Sarnoff, *White Paper on Protecting the Consumer Patent Law Right of Repair and the Aftermarket for Exterior Motor Vehicle Repair Parts: The Parts Act, S. 812; H.R. 1879, 115th Congress 7–8*, https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3082289 [<https://perma.cc/4ZS7-PR9H>] (offering an alternate reading of the history of the “use or sale” criterion).

15. As discussed below, it may not be possible to completely readopt all of these principles, due to intervening changes in design patent law and U.S. Patent & Trademark Office policies. *See infra* Section V.A. However, courts should readopt these principles to the extent that they can.

16. To be clear, I mean that this would be easy and cheap to apply for the purposes of *Samsung* step one. Other approaches may make *Samsung* step two easier, at least for the patent owner. But remedy rules should not be determined solely — or even primarily — based on what is easiest for the patent owner.

17. These might be referred to as partial design patents. *Cf.* Burstein, *Costly Designs*, *supra* note 1, at 139 (referring to this type of broken-line practice as “partial claiming”). As used in this Article, the word “product” refers to “something sold by an enterprise to its customers.” *See* KARL T. ULRICH & STEVEN D. EPPINGER, *PRODUCT DESIGN AND DEVELOPMENT* 2 (5th ed. 2012). It is not used here as — and should not be considered — a synonym for “article of manufacture.” *See* Sarah Burstein, *The Patented Design*, 83 TENN. L. REV. 161, 208 (2015) (“[T]he word ‘product’ should be defined as ‘something sold by an enterprise to its customers’ Under this definition, ‘product’ would not be a synonym for ‘article of manufacture.’”) (footnote omitted) (quoting Ulrich & Eppinger, *supra* note 17, at 2); *see also* Burstein, *1887*, *supra* note 14, at 63 (“In 1887, the phrase ‘article of manufacture’ was not a synonym for ‘product.’”).

Article also does not argue that § 289 — even as originally understood — sets forth an efficient, optimal, or well-founded rule for remedying acts of design patent infringement.¹⁸ It merely argues that, as long as § 289 is the law of the land, this is how it should be interpreted. Finally, this Article does not tackle the issue of how courts should conduct *Samsung* step two, leaving that issue for later discussion.¹⁹

This Article proceeds in five parts. Part II provides a brief introduction to the relevant principles of U.S. design patent law. Part III explains what led up to — and the question left open by — the Supreme Court’s decision in *Samsung*. Part IV explains why the Government’s proposal fails to provide a good solution for how courts should proceed at *Samsung* step one. Part V proposes a new solution. Part VI evaluates some potential objections to this proposed solution.

II. BACKGROUND

A. Design Patentable Subject Matter

Design patents are available for “any new, original, and ornamental design for an article of manufacture.”²⁰ Historically, design patents were understood to protect two classes of designs, designs for “‘surface ornamentation applied to an article’ and designs for ‘the configuration

18. Others have argued that § 289 should be amended or even repealed. See Thomas F. Cotter, *Reining in Remedies in Patent Litigation: Three (Increasingly Immodest) Proposals*, 30 SANTA CLARA HIGH TECH. L.J. 1, 1 (2013) (“Congress should amend Patent Act Section 289 . . . so as to require that such awards reflect only the profit derived from the use of the infringed design (and not the entire product of which the design is a part.)”); Mark A. Lemley, *A Rational System of Design Patent Remedies*, 17 STAN. TECH. L. REV. 219, 235 (2013) (“A final possible solution is simple: change the statute. Section 289 is an anomaly, a holdover from a time when we both granted defendant’s profits as a general measure of patent damages and required proof of knowing infringement. We don’t need it.”); Dennis M. White, *Inefficiencies in Overcompensating Design Patent Damages Under 35 U.S.C. § 289 in Complex Technologies*, 95 J. PAT. & TRADEMARK OFF. SOC’Y 444, 458 (2013) (arguing that we should “do away with the § 289 statute completely and rely on § 284 for damages for design patents”). However, those issues are beyond the scope of this Article.

19. Because the step one test proposed here — like all of the tests that have been proposed to date — contemplates that the relevant article can be something less than the entire infringing product, it should not produce any different (and certainly not more difficult) problems or issues with respect to proof at step two.

One point that is relevant mainly to step two is, however, worth mentioning. It is clear from the legislative history of the 1887 Act that Congress’ intent was that, if it was too difficult to calculate the relevant profits, the default remedy was an award of the set statutory penalty — not an award of “total profits.” See *infra* notes 47–48 and accompanying text. It may seem obvious that the current penalty of \$250, an amount that hasn’t changed since 1887, is too low to constitute any sort of serious penalty due to inflation. However, that does not mean we should twist the meaning of “article of manufacture” just to give patentees larger awards. Instead, it should be left to Congress to address whether, and in what amount, the penalty should be increased.

20. 35 U.S.C. § 171(a) (Supp. I 2013).

or shape of an article.”²¹ Design patent applicants were (and still are) allowed to select what they wanted to protect — the configuration, the surface ornamentation, or a combination of both.²²

The Federal Circuit has interpreted “ornamental” to mean nonfunctional and considers a design to be ornamental unless: “(1) there are no alternative designs with ‘the same or similar functional capabilities,’ or (2) the design is concealed during the entire lifetime of the completed product.”²³ The phrase “article of manufacture” has always been used to define design patentable subject matter, though its interpretation has changed over time.²⁴

B. Design Patent Claiming & Infringement

A design patent is infringed by anyone who makes, uses, sells, offers to sell, or imports the patented invention without permission of the patentee.²⁵ Since the nineteenth century, design patent infringement has been determined by asking whether an “ordinary observer” would think the accused design looks the same as the patented design.²⁶ In the nineteenth century, as today, a design patent applicant could specify whether they wanted to protect the surface design, configuration, and/or the combination of both as applied to a particular article.²⁷ But the

21. Burstein, 1887, *supra* note 14, at 8. In *In re Zahn*, the U.S. Court of Customs and Patent Appeals suggested there may be other types of protectable designs. See *In re Zahn*, 617 F.2d 261, 268 (C.C.P.A. 1980) (stating “that § 171 . . . is inclusive of ornamental designs of all kinds including surface ornamentation as well as configuration of goods”). However, a full discussion of that issue is beyond the scope of this Article.

22. See Burstein, 1887, *supra* note 14, at 8; see also U.S. DEP’T OF COMMERCE, PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1502 (9th ed., rev. 08.2017 2018) [hereinafter MPEP] (“[T]he 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.”).

23. *Id.* at 7 (footnote omitted) (citing Sarah Burstein, *Commentary: Faux Amis in Design Law*, 105 TRADEMARK REP. 1455, 1456–57 (2015)).

24. See *id.* at 12–14, 60–67 (explaining how specialized patent courts broadened the concept of an “article of manufacture” in the late twentieth century).

25. 35 U.S.C. § 271(a) (2012); see also 35 U.S.C. § 171(b) (Supp. I 2013) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”).

26. See *Gorham Mfg. Co. v. White*, 81 U.S. 511, 527 (1871); *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 672 (Fed. Cir. 2008) (en banc); see also Burstein, *The Patented Design*, *supra* note 1, at 177 (“[W]hen read in context, it is clear that Gorham’s test is one of visual similarity, not a test of actual deception or trademark-like likelihood of confusion.”). “The ordinary observer is a hypothetical person, like the ‘reasonable person’ in tort law.” *Id.* at 174. And “[a]lthough the ordinary observer is deemed to be familiar with the prior art, that does not mean the court (or jury) must always consider it.” *Id.* For more on when the prior art does and does not need to be considered, see *id.* at 174–75.

27. See generally *Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37, 40 (describing “the two classes of invention” in design patents as “shape and ornamentation”); 1 WILLIAM C. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS § 204 (1890) (explaining that a “design may consist in the simple configuration of a substance the form given to it as a whole,

scope of the surface ornamentation, configuration, or combination design was defined by whatever the designer “invented and produced.”²⁸ The test for design patent infringement, “as it was understood in the late nineteenth century, required the factfinder to compare the entire article ‘invented and produced’ by the patentee to the entire article sold or manufactured by the defendant, regardless of the patent’s claim language.”²⁹

Today, by contrast, the claim is king. Under the current test, a design patent is infringed if the claimed design — generally, whatever is shown in solid lines in the patent drawings — looks the same as the corresponding portion (or portions) of the accused product, in light of the prior art.³⁰ Although an applicant must “identif[y] the article in which the design is embodied by the name generally known and used by the public” in both the title and the verbal claim,³¹ the U.S. Patent & Trademark Office (“USPTO”) instructs examiners to “afford the applicant substantial latitude in the language of the title/claim.”³² And, since 1980, applicants have been allowed to claim that their “design” is “something less than an entire configuration or surface ornamentation design.”³³ This is generally achieved by using broken lines to disclaim portions of a product’s design.³⁴ Applicants engage in this type of partial claiming in order to obtain a broader scope of protection.³⁵ As two practitioners recently explained:

or in the ornamentation imposed upon it without reference to its general form, or in such configuration or ornamentation both”).

28. *See, e.g.*, *Jennings v. Kibbe*, 10 F. 669, 670–71 (C.C.S.D.N.Y. 1882); *Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37, 45.

29. Burstein, *1887*, *supra* note 14, at 12 n.64 (citing *Jennings*, 10 F. at 670–71; *Gérard*, 1888 Dec. Comm’r Pat. at 45). While some nineteenth-century design patents may appear to claim only part of a configuration or surface design, the Patent Office understood those claims to be something akin to advisory opinions as to which part or parts of the design, if replicated, would result in a product that looked so similar overall as to infringe. *See, e.g.*, *Jennings*, 10 F. at 670–71; *Gérard*, 1888 Dec. Comm’r Pat. at 45.

30. *See* Burstein, *1887*, *supra* note 14, at 7–8. For a more detailed discussion of the role of the prior art, see Burstein, *The Patented Design*, *supra* note 1, at 174–75.

31. MPEP, *supra* note 22, § 1503.01(I) (“The title . . . may contribute to defining the scope of the claim.”). The same article must be named in both the claim and title. *Id.* § 1503.01(III).

32. *See id.* § 1503.01(I).

33. Burstein, *1887*, *supra* note 14, at 8 (noting that this change can be traced back to *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980)).

34. *See* Burstein, *Costly Designs*, *supra* note 1, at 114 (citing U.S. DEP’T OF COMMERCE, PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1503.02(III) (9th ed., rev. 07.2015 2015)); *see also id.* at 113–17 (discussing design patent claiming in more detail).

35. *See, e.g.*, Thomas J. Daly & Katherine Quigley, *Patent Infringement as Applied in Samsung v. Apple*, L.A. LAW., April 2017, at 10, 10–12 (“In applying [the infringement] test, all ornamental features as illustrated in the figures of the design patent must be considered. Thus, patent practitioners typically limit the ornamental features they include as part of the claimed design.” (footnote omitted)); *see also* Burstein, *Costly Designs*, *supra* note 1, 138–39 (referring to this type of broken-line practice as “partial claiming”).

Most design patents are drafted to provide clients with the broadest protection possible by limiting the number of elements in the patented design. The fewer elements in the design, the easier it is to prove that accused products have substantially the same design as required for infringement. For example, in *Samsung v. Apple*, one of Apple's design patents at issue claimed the top 'surface' of the iPhone design rather than seeking patent protection for the design of the entire electronic device. That way, to show infringement, Apple only had to prove that the "surface" of Samsung's accused Galaxy phones had the same design as Apple's patent.³⁶

Partial claiming allows a design patent owner to succeed on an infringement claim where the defendant's product, considered as a whole, doesn't look the same as the patent owner's product.³⁷ Depending on how the claim is drafted, the overall appearance of an infringing product could be markedly different than the overall appearance of the patent owner's product.³⁸ Therefore, the very nature of what can be claimed as a "design" has shifted radically since Congress enacted the design patent "total profits" remedy in 1887.

C. Remedies for Design Patent Infringement

Design patent owners are entitled to all of the remedies that utility patent owners are entitled to, including injunctive relief under § 283 of the Patent Act and "damages adequate to compensate for the infringement, but in no event less than a reasonable royalty" under § 284.³⁹ For

36. Daly & Quigley, *supra* note 35, at 10.

37. To be clear, though the degree of visual similarity required to support a finding of design patent infringement is high, perfect duplication down to the last minor detail is not required. See *Egyptian Goddess Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc) (quoting *Gorham Mfg. Co. v. White*, 81 U.S. 511, 526–27 (1871) ("[M]ere difference of lines in the drawing or sketch . . . or slight variances in configuration . . . will not destroy the substantial identity." (internal quotation marks omitted))); see also, e.g., *Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1303 (Fed. Cir. 2010) ("[M]inor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement." (quoting *Payless Shoesource, Inc. v. Reebok Int'l*, 998 F.2d 985, 991 (Fed. Cir. 1993))). And of course, there is no working requirement in the United States, so the patent owner need not make, sell, or license any commercial embodiments of the claimed design. See *Cont'l Paper Bag Co. v. E. Paper Bag Co.*, 210 U.S. 405, 429 (1908) (noting that the working requirement was repealed in 1836).

38. Of course, today, a design patent owner does not have to actually make (or license anyone else to make) anything. But the most strident appeals for harsh design patent remedies tend to contemplate a design patent owner who actually participates in the market.

39. See 35 U.S.C. §§ 283, 284 (2012) (setting forth remedies that apply to all patents). See also *Bergstrom v. Sears, Roebuck & Co.*, 496 F. Supp. 476, 498 (D. Minn. 1980) ("In addition, the plaintiff is entitled to injunctive relief under 35 U.S.C. § 283 . . ."); *Henry Hanger*

certain acts of infringement, design patent owners have an additional remedy — namely, an award of the infringer’s profits under § 289.⁴⁰ Design patent owners cannot recover damages under both § 289 and § 284 for the same act of infringement.⁴¹ And while a court may treble a damages award under § 284, it may not do so under § 289.⁴² Therefore, depending on the circumstances, a § 284 award may well be larger than a § 289 award.⁴³

III. WHAT IS THE “ARTICLE OF MANUFACTURE” IN § 289?

Section 289 of the Patent Act provides:

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his

& Display Fixture Corp. of Am. v. Sel-O-Rak Corp., 270 F.2d 635, 644 (5th Cir. 1959) (noting that § 284 “applies to design patents as well as to others” (citing *Krieger v. Colby*, 106 F. Supp. 124 (S.D. Cal. 1952)); 1-23 DONALD S. CHISUM, CHISUM ON PATENTS § 23.05 (2017) (“The monetary remedies provided by Sections 284 and 285 for patent infringement apply equally to design patents . . .”). One commentator has argued that courts should “adopt a ‘customer demand approach’ to the ‘article of manufacture’ inquiry” that would “carry over the ‘entire market value rule’ from utility patents.” Patryk Oskar Rogowski, Note, *Damages for Partial Product Design Patent Infringement*, 33 TOURO L. REV. 1243, 1281 (2017). While this may be a logical approach to design patent remedies, as a policy matter, this proposal is difficult to square with the statutory language.

40. See 35 U.S.C. § 289 (2012); see also Burstein, *Costly Designs*, *supra* note 1, at 118 n.74 (“Notably, . . . § 289 does not apply to all acts of design patent infringement. By its plain terms, it applies only to certain actions taken in the commercial context.”). Section 289 damages, like § 284 damages, are subject to the marking requirement set forth in § 287. See *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1446 (Fed. Cir. 1998).

41. See *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1291 (Fed. Cir. 2002) (“When only a design patent is at issue, a patentee may not recover both infringer profits and additional damages under § 284.”); see also *Bergstrom*, 496 F. Supp. at 494 (“A design patentee cannot recover both damages under 35 U.S.C. § 284 and the profits of the infringer under 35 U.S.C. § 289.” (citing *Henry Hanger*, 270 F.2d at 643–44)).

42. See *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 824 (Fed. Cir. 1992) (“35 U.S.C. § 284 . . . provides that a patentee may recover ‘damages adequate to compensate for the infringement’ which ‘the court may increase . . . up to three times.’ Nothing in 35 U.S.C. § 289 authorizes an increase in a patentee’s total profit.” (omission in original)).

43. The Federal Circuit has also ruled that, if a design patent owner seeks § 289 damages, the jury must determine what the design patent owner is entitled to under both § 289 and § 284 and award whichever is greater. See *Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344, 1357 (Fed. Cir. 2015), *cert. granted, judgment vacated*, 137 S. Ct. 589 (2016) (“Only where § 289 damages are not sought, or are less than would be recoverable under § 284, is an award of § 284 damages appropriate.”); *Nordock, Inc. v. Sys. Inc.*, 681 F. App’x 965, 966 (Fed. Cir. 2017) (“The fact that Nordock could recover only one type of damage on each sale . . . did not absolve the jury of its obligation to determine the amount of System’s total profits for purposes of determining damages under § 289.”).

total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.⁴⁴

This special remedy was enacted, in substantially similar form, in 1887.⁴⁵ It was enacted to address the perceived difficulty of apportioning the profits attributable to the design itself from the profits “attributable to the ‘intrinsic merits of quality and structure’ of the article” to which the design was applied.⁴⁶ For cases where the infringer made no profits or “where the exact profit in dollars and cents cannot be proved under the severe and technical rules of the law,”⁴⁷ the 1887 Act provided a \$250 minimum award for each design patent violated.⁴⁸ It also provided that a design patent owner could recover the violator’s “total profit” for the offending articles, if the plaintiff could prove that amount exceeded \$250.⁴⁹ That two-part structure has been maintained to this day and Congress has not increased the minimum amount to account for inflation.⁵⁰

44. 35 U.S.C. § 289 (2012).

45. For more on the history of this enactment, see generally Burstein, *1887, supra* note 14, at 53–60. “Although this language differs somewhat from the language of the 1887 Act, it does not appear that Congress meant to materially change the meaning of the remedy provision.” *Id.* at 15 n.87.

46. *See id.* at 54 (quoting *Dobson v. Hartford Carpet Co.*, 114 U.S. 439, 445 (1885)); *see also id.* at 58 (“Both the House and Senate reports expressed concern that it would be exceedingly difficult, if not impossible, for most design patentees to do the type of ‘apportionment’ required for an award of partial damages or profits under *Dobson*.” (citing S. REP. NO. 49-206, at 2 (1886); H.R. REP. NO. 49-1966, at 2 (1886))).

47. H.R. REP. NO. 49-1966, at 3 (1886); *accord* S. REP. NO. 49-206, at 2 (1886).

48. Act of Feb. 4, ch. 105, 24 Stat. 387, 387 (1887). Two hundred and fifty dollars in 1887 would be approximately \$6,664 in 2016 dollars. Burstein, *1887, supra* note 14, at 58 (citing *Consumer Price Index (Estimate) 1800-*, FED. RESERVE BANK OF MINNEAPOLIS, <https://www.minneapolisfed.org/community/teaching-aids/cpi-calculator-information/consumer-price-index-1800> (last visited Aug. 20, 2017) [<https://perma.cc/N7XB-LJNY>]). Thus, the minimum award under the 1887 Act would have been much more than the merely nominal damages awarded in *Dobson*. *See* 114 U.S. at 447 (“The final decrees in all of the suits are reversed, and the cases are remanded to the circuit court, with directions to disallow the award of damages in each suit, and to award six cents damages in each”). For more on the purposes of this statutory minimum, see Burstein, *1887, supra* note 14, at 58–60.

49. *See* Act of Feb. 4, ch. 105, 24 Stat. 387, 387 (1887); *see also* Burstein, *1887, supra* note 14, at 69–70 (discussing this “total profit” remedy and the burden of proof).

50. 35 U.S.C. § 289 (2012).

A. The Apple/Nordock Rule

In 2015, the U.S. Court of Appeals for the Federal Circuit interpreted the phrase “article of manufacture” in § 289 for the first time.⁵¹ In *Apple v. Samsung* and then in *Nordock v. Systems*, the court ruled that § 289 required disgorgement of the “total profits” from the entire infringing product — *i.e.*, the total profits from whatever the defendant “sold separately.”⁵² Under this rule, Samsung had to disgorge its total profits from the infringing smartphones, even though Apple’s design patents covered only certain parts of those phones.⁵³ And Systems had to disgorge its total profits from the infringing dock levelers, even though the asserted design patent covered only the lip and hinge plate.⁵⁴

B. The Supreme Court Weighs In

By the time the case was argued before the Supreme Court, both Apple and Samsung agreed that the “article of manufacture” referred to in § 289 did not have to be the end product sold to consumers.⁵⁵ But they disagreed as to what constituted the relevant “article of manufacture” in their particular case. Ultimately, however, the Court did not resolve that dispute.⁵⁶ Instead, the Court defined the issue before it narrowly:

This case involves the infringement of designs for smartphones. The United States Court of Appeals for the Federal Circuit identified the entire smartphone as the only permissible “article of manufacture” for the purpose of calculating § 289 damages because consumers could not separately purchase components of the smartphones. The question before us is whether

51. Burstein, *1887*, *supra* note 14, at 15 n.88. The Federal Circuit has exclusive jurisdiction over appeals from cases that involve design patent claims. *See* 28 U.S.C. § 1295(a) (2012).

52. *See* *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1001–02 (Fed. Cir. 2015), *rev’d sub nom.* *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016); *Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344, 1354 (Fed. Cir. 2015), *rev’d sub nom.* *Sys., Inc. v. Nordock, Inc.*, 137 S. Ct. 589 (2016); *see also* *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 432 (2016) (“[T]he United States Court of Appeals for the Federal Circuit identified the entire smartphone as the only permissible ‘article of manufacture’ for the purpose of calculating § 289 damages.”). For a longer discussion of *Apple* and *Nordock*, *see* Burstein, *1887*, *supra* note 14, at 16–23.

53. *See* Burstein, *1887*, *supra* note 14, at 18–19.

54. *See id.* at 20–22.

55. Sarah Burstein, *Samsung v. Apple: A View From Inside the Courtroom*, PATENTLY-O (Oct. 12, 2016), <http://patentlyo.com/patent/2016/10/samsung-inside-courtroom.html> [<https://perma.cc/VWB9-RRDE>].

56. *Samsung*, 137 S. Ct. at 436 (“We decline to lay out a test for the first step of the § 289 damages inquiry in the absence of adequate briefing by the parties.”).

that reading is consistent with § 289. We hold that it is not.⁵⁷

Thus, the Court limited its decision to the question of whether the Federal Circuit's *Apple/Nordock* rule was correct.⁵⁸ The Court's answer was "no."⁵⁹

According to the Court: "Arriving at a damages award under § 289 . . . involves two steps. First, identify the 'article of manufacture' to which the infringed design has been applied. Second, calculate the infringer's total profit made on that article of manufacture."⁶⁰ But the Court "decline[d] to lay out a test for the first step of the § 289 damages inquiry" because that issue had not been adequately briefed by the parties and the Court did not deem it necessary to resolve the case.⁶¹ Instead, the Court simply held that "reading 'article of manufacture' in § 289 to cover only an end product sold to a consumer gives too narrow a meaning to the phrase."⁶²

In reaching this conclusion, the Court relied on contemporary and nineteenth-century dictionary definitions of the words "article" and "manufacture."⁶³ The Court reasoned:

An "article" is just "a particular thing." J. Stormonth, *A Dictionary of the English Language* 53 (1885) (Stormonth); see also *American Heritage Dictionary*, at 101 ("[a]n individual thing or element of a class; a particular object or item"). And "manufacture" means "the conversion of raw materials by the hand, or by machinery, into articles suitable for the use of man" and "the articles so made." Stormonth 589; see also *American Heritage Dictionary*, at 1070 ("[t]he act, craft, or process of manufacturing products, especially

57. *Id.* at 432.

58. *See id.*; *see also id.* at 434 ("The only question we resolve today is whether, in the case of a multicomponent product, the relevant 'article of manufacture' must always be the end product sold to the consumer or whether it can also be a component of that product.").

59. *See id.* at 432, 435.

60. *Id.* at 434.

61. *Id.* at 436 ("We decline to lay out a test for the first step of the § 289 damages inquiry in the absence of adequate briefing by the parties. Doing so is not necessary to resolve the question presented in this case . . .").

62. *Id.*; *see also id.* at 434 ("The only question we resolve today is whether, in the case of a multicomponent product, the relevant 'article of manufacture' must always be the end product sold to the consumer or whether it can also be a component of that product.").

63. *Id.* at 434–35.

on a large scale” or “[a] product that is manufactured”). An article of manufacture, then, is simply a thing made by hand or machine.⁶⁴

The Court stated that this interpretation was consistent with the interpretation of “article of manufacture” in the design patent statutory subject matter provision and “manufacture” in the utility patent statutory subject matter provision.⁶⁵

Thus, in *Samsung*, the Court squarely rejected the *Apple/Nordock* rule but refused “to set out a test for identifying the relevant article of manufacture” — i.e., for identifying “the ‘article of manufacture’ to which the infringed design has been applied.”⁶⁶ The Court left that task for the lower courts.⁶⁷

IV. WHY COURTS SHOULD NOT ADOPT THE GOVERNMENT’S APPROACH

In the wake of *Samsung*, all three district judges who have confronted this issue have adopted — or at least substantially adopted — the Government’s test.⁶⁸ One judge instructed a jury on the government’s factors but did not explain his decision to do so in a written decision.⁶⁹ The other two issued written decisions in which they explained why they rejected the parties’ proposals, then proceeded to

64. *Id.*

65. *See id.* at 435.

66. *Id.* at 436 (referring to “identifying the relevant article of manufacture” as “the first step of the § 289 damages inquiry”); *id.* at 434 (“Arriving at a damages award under § 289 . . . involves two steps. First, identify the ‘article of manufacture’ to which the infringed design has been applied.”).

67. *See id.* (reversing and remanding for further proceedings). After it decided *Samsung*, the Court granted System’s petition for certiorari, vacated the Federal Circuit’s judgment, and remanded that case for further proceedings. *Systems, Inc. v. Nordock, Inc.*, 137 S. Ct. 589 (2016) (Mem.).

68. *See supra* note 9.

69. *See* Columbia Jury Instructions, *supra* note 9, at No. 10. It appears that the judge resolved this issue at the pretrial conference. *See* Columbia’s Memorandum Regarding Standard for Computing Design Patent Damages Under 35 U.S.C. § 289, *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, No. 3:17-cv-01781 (S.D. Cal. Sept. 25, 2017), ECF No. 342 (“At the pretrial conference, the Court held that, in identifying the relevant article of manufacture for design patent damages calculations, the Court would instruct the jury to use the test outlined in the Department of Justice’s amicus brief in *Samsung* . . .”). However, the judge did not issue a written decision from that conference. *See* Minute Order, *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, No. 3:17-cv-01781 (S.D. Cal. Sept. 11, 2017), ECF No. 275 (stating only that “[t]he Court also resolved other matters raised at the pretrial conference”). In denying Seirus’ post-trial motion for judgment as a matter of law, the judge stated only that “the Court remains convinced that, regarding the issue of the relevant article of manufacture under 35 U.S.C. § 289, the jury instructions and jury verdict were legally sufficient and that the Court correctly determined the proper legal test.” Opinion & Order at 3, *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, No. 3:17-cv-01781 (S.D. Cal. Mar. 13, 2018), ECF No. 455. Seirus has filed a notice of appeal on the

adopt the Government’s test with little further explanation.⁷⁰ For example, in *Nordock v. Systems*, the judge concluded “that the four-factor test proposed by the United States as amicus in *Samsung* is appropriate, consistent with the relevant statutory law, and supported by the case law,” without explaining how or why that test was “appropriate,” “consistent with the relevant statutory law,” or “supported by case law.”⁷¹ The judge in *Apple v. Samsung* provided a bit more explanation about why she was adopting the Government’s test but, in the end, seemed to rely heavily on the fact that the parties had previously agreed that the Government’s test was acceptable.⁷²

It is easy to understand why judges, confronted with the task of announcing a new test, would be inclined to adopt a ready-made solution that had been proposed by an ostensibly neutral party. But the Government’s solution is not a good solution. This Section will explain the problems with the Government’s approach and argue that the Federal Circuit — and, if it comes to it, the Supreme Court — should not adopt it.

A. The Test

In its *amicus* brief in *Samsung v. Apple*, the Government argued that:

Although Section 289 entitles the patent holder to recover the infringer’s “total profit” on the “article of manufacture” to which the design was applied, that “article of manufacture” will not always be the finished product that is sold in commerce. Rather, the relevant article will sometimes be a component of the ultimate item of sale. In such cases, the patentee is entitled only to the infringer’s total profit for that component, not its total profit for the finished item.⁷³

“article of manufacture” issue. See Notice of Appeal, *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, No. 3:17-cv-01781 (S.D. Cal. Dec. 20, 2017), ECF No. 423. See also Notice of Docketing, *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, No. 3:17-cv-01781 (S.D. Cal. Dec. 22, 2017), ECF No. 427 (noting that Seirus’ appeal has been docketed with the U.S. Court of Appeals for the Federal Circuit as No. 18-1331). Further entries in that case will be filed in consolidated case 18-1329. Note to File, *Columbia Sportswear v. Seirus Innovative Accessories*, No. 18-1329 (Fed. Cir. Dec. 22, 2017).

70. See *Nordock Order*, *supra* note 9, at 8–13; *Apple Retrial Order*, *supra* note 9, at 12–21.

71. *Nordock Order*, *supra* note 9, at 13.

72. *Apple Retrial Order*, *supra* note 9, at 20–21. She also explicitly relied on the fact that the judge in *Columbia v. Seirus* had also adopted the Government’s test. *Id.* at 21.

73. Gov’t Br., *supra* note 9 at 7–8.

The Government then argued that the factfinder should weigh multiple factors to determine which “article” the design has been “applied” to in a particular case.⁷⁴

This Section will address the legal premise behind the Government’s proposed test and explain why this test is fundamentally flawed. It then will critically examine the factors proposed by the Government and explain the problems created by using a multi-factor balancing test to determine the relevant “article of manufacture.”

1. The Underlying Premise

In its brief, the Government argued that “[t]he relevant ‘article of manufacture’ under Section 289 is one to which the patented design has been ‘applied.’”⁷⁵ But instead of treating this question as one that could be determined based on the patent claims and other objective information about the relevant manufacturing methods or market, the Government argued that the “application” inquiry should consist of a qualitative evaluation of the importance of the claimed design to the appearance of the product as a whole.⁷⁶

The Government based its approach on a passage from the Supreme Court’s first design patent case, *Gorham v. White*.⁷⁷ The Government cited *Gorham* for the proposition that “[a] patentable design is one that ‘gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied.’”⁷⁸ From there, the Government reasoned that a patented design should be deemed to be “applied” to whatever item to which it “gives a peculiar or distinctive appearance.”⁷⁹

According to the Government, “[i]n some cases it will be clear that the patented design ‘gives a peculiar or distinctive appearance’ only to a component (*e.g.*, a refrigerator latch) of a larger product sold in commerce, rather than to the product as a whole.”⁸⁰ In that case, the latch itself should be deemed to be the relevant article of manufacture.⁸¹ On

74. *Id.* at 27 (“The ‘article of manufacture’ inquiry entails a case-specific examination of the relationship among the design, any relevant components, and the product as a whole. Several considerations are relevant to the inquiry.” (citation omitted)). *See also id.* at 18 (“The relevant ‘article of manufacture’ under Section 289 is one to which the patented design has been ‘applied’ . . .”).

75. *Id.* at 18.

76. *See id.* at 25–26.

77. *See id.* at 18–19, 25–26 (quoting *Gorham Mfg. Co. v. White*, 81 U.S. 511, 525 (1871)).

78. *Id.* at 25–26 (quoting *Gorham*, 81 U.S. at 525).

79. *See id.* (quoting *Gorham*, 81 U.S. at 525); *see also id.* at 18 (quoting *Gorham*, 81 U.S. at 525).

80. *Id.* at 26 (quoting *Gorham*, 81 U.S. at 525).

81. *Id.* *See also id.* at 28 (“If the design is a minor component of the product, like a latch on a refrigerator, or if the product has many other components unaffected by the design, that fact suggests that the ‘article’ should be the component embodying the design.”); Transcript of Oral Argument at 28, *Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429 (2016), (No. 15-777) (Brian H. Fletcher on behalf of the Government) (“If the patented design is for a

the other hand, the Government argued that “[w]ith respect to some multi-component products, the finished product as sold in commerce is most naturally viewed as the article to which the patented design is ‘applied.’ That will be so if the ‘peculiar or distinctive appearance’ that constitutes the design predominates when viewing all the components in combination.”⁸² Thus, the Government builds its entire approach on the foundation of the “peculiar or distinctive appearance” language from *Gorham*.

That foundation, however, is flawed. The “peculiar or distinctive appearance” language from *Gorham* neither supports nor mandates the Government’s approach. It’s true that, in *Gorham*, the Supreme Court stated that “the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form.”⁸³ But *Gorham* did not discuss — let alone decide — what constitutes the relevant “article” for a given design.⁸⁴ Instead, in the quoted portion of *Gorham*, the Court was discussing the nature of the patented invention.⁸⁵ The lower court had ruled that “[a] patent for a design, like a patent for an improvement in machinery, must be for the means of producing a certain result or appearance, and not for the result or appearance itself.”⁸⁶ The Supreme Court disagreed, stating that a design patent protects “the appearance” of an article — whether it be “the result of peculiarity of configuration, or of ornament alone, or of both conjointly” — not the process used to create that appearance.⁸⁷ Therefore, *Gorham* does not support the Government’s contention that a design should be deemed to be “applied to” any item to which it gives a “peculiar or distinctive appearance.”

Moreover, even though a patentable design can be described as something that “gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied,” it does not follow that a patented design must be deemed to be “applied” to anything it “gives

refrigerator latch, no one is going to think that the latch gives the distinctive appearance to the entire refrigerator.”)

82. Gov’t Br., *supra* note 9, at 18–19 (citation omitted) (quoting *Gorham*, 81 U.S. at 525).

83. *Gorham*, 81 U.S. at 525. In this passage, the Court was describing the nature of the patented invention and, specifically, distinguishing a design from a process for making a design. *See id.* at 525–26.

84. *Id.* at 511. Nor does *Gorham* support the proposition that the determination of what constitutes the relevant “article” depends on how the design is “most naturally viewed.” Gov’t Br., *supra* note 9, at 18.

85. *Gorham*, 81 U.S. at 525.

86. *Gorham Mfg. Co. v. White*, 10 F. Cas. 827, 830 (C.C.S.D.N.Y. 1870), *rev’d*, 81 U.S. 511 (1871).

87. *Gorham*, 81 U.S. at 525 (“To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities.”).

a peculiar or distinctive appearance” to.⁸⁸ If a decorative vase is displayed in a dining room, it would be strange to say that the vase’s design had been “applied” to the room. Accordingly, the logical premise underlying the Government’s approach is fundamentally flawed.

2. The Factors

After laying out its theory of what it means for a design to be “applied,” the Government acknowledged that this approach would not lead to easy answers in all cases:

In some cases it will be clear that the patented design “gives a peculiar or distinctive appearance” only to a component (*e.g.*, a refrigerator latch) of a larger product sold in commerce, rather than to the product as a whole. There will sometimes be legitimate doubt, however, whether a patented design is best viewed as affecting the appearance of the sold product as a whole or only the appearance of a component or other portion of that product. If the design in question is the shape of the Volkswagen Beetle, for example, one might reasonably say either that the design determines the appearance of the automobile’s body or that it determines the appearance of the car as a whole.⁸⁹

The Government then recast the nature of the inquiry, arguing that “[i]n conducting this inquiry, the factfinder’s over-arching objective should be to identify the article that most fairly may be said to embody the defendant’s appropriation of the plaintiff’s innovation.”⁹⁰ According to the Government, this “anchors the inquiry in Section 289’s purpose, which is to provide the patentee with a remedy for (and to prevent the

88. Gov’t Br., *supra* note 9, at 25–26 (internal quotation marks omitted) (quoting *Gorham*, 81 U.S. at 525). Additionally, there is no reason why “application” must be viewed as some sort of metaphysical concept, as opposed to a physical shaping or decoration process.

89. *Id.* at 26. This elaboration is not particularly helpful. The Government first suggests that merely “affecting the appearance” is all that is necessary to “give[] a peculiar or distinctive appearance” to an item but, in the next sentence, suggests that the design must actually “determine[] the appearance” of the item. *Id.* (emphasis added). And the Government never explains what it means by either “affecting” or “determining” the appearance of an item. *See id.*

90. *Id.* Presumably, when the Government refers to “the plaintiff’s innovation,” it really means the “designer’s innovation” or the “patented innovation.” Not all patent owners are plaintiffs. *See generally* 28 U.S.C. § 2201(a) (2012). And not all patent owners are (or employ) designers. It is also unclear why a test that is supposed to be anchored in evaluating the extent of the *patented* innovation focuses so much on the *defendant’s* methods of manufacturing, etc. *See* Gov’t Br., *supra* note 9, at 26–29.

infringer from profiting from) the unlawful appropriation.”⁹¹ But saying that the factfinder should “identify the article that most fairly may be said to embody the defendant’s appropriation of the plaintiff’s innovation” begs the key question — namely, what *is* “the unlawful appropriation”? Unless the answer is “whatever the factfinder says it is,” this formulation provides little helpful or principled guidance for the “article of manufacture” inquiry.⁹²

Ultimately, the Government proposed four factors it deemed relevant to the “article of manufacture” inquiry:⁹³

- (1) “[T]he scope of the design claimed in the plaintiff’s patent,”⁹⁴
- (2) “[T]he relative prominence of the design within the product as a whole,”⁹⁵
- (3) “[W]hether the design is conceptually distinct from the product as a whole,”⁹⁶ and
- (4) “[T]he physical relationship between the patented design and the rest of the product.”⁹⁷

91. Gov’t Br., *supra* note 9, at 26.

92. The Government also states that the factfinder “should keep in mind the scope of the plaintiff’s innovation and should identify the article in which the patented design prominently features, without unnecessarily sweeping in aspects of the product that are unrelated to that design.” *Id.* The Government does not explain, however, how the factfinder is to avoid “sweeping” in other “aspects” or what those aspects might be. *See id.* Earlier in its brief, the Government did refer to “the quality of the materials used to create it, or the skill with which it is manufactured” as “aspects of the product . . . other than the patented design.” *Id.* at 25 (“Section 289 does not permit the infringer to show that some or most of its profit is attributable to aspects of the product (*e.g.*, the quality of the materials used to create it, or the skill with which it is manufactured) other than the patented design.”). But it is difficult to see how things such as materials qualities or manufacturing skills would be relevant to the question of whether a design was “applied” to an entire product or a component. *See id.* at 26.

93. *Id.* at 27–29. Earlier in its brief, the Government states these factors differently: “Relevant considerations include the scope of the claimed design, the extent to which the design determines the appearance of the product as a whole, the existence of unrelated, conceptually distinct elements in the product . . .” *Id.* at 9. In this formulation, it appears that factor two looks at which item the design gives a “peculiar or distinctive appearance” to, a consideration which, as discussed above, the Government suggested was *the* test. *See supra* Section IV.A.1. Perhaps the Government was really arguing that this should be the test in easy cases but, in difficult cases, it should only be one factor. *See* Gov’t Br., *supra* note 9, at 26; *see also id.* at 28 (stating, in discussing factor two, that “if the design is a significant attribute of the entire product, affecting the appearance of the product as a whole, that fact might suggest that the ‘article’ should be the product”).

94. Gov’t Br., *supra* note 9, at 27.

95. *Id.* at 28.

96. *Id.*

97. *Id.* at 29.

Although the Government discussed each factor in more detail, it did not provide much useful guidance.⁹⁸ Most importantly, the Government never explained how the various factors should be weighed, especially if different considerations point in different directions.⁹⁹ Nor does the Government link these factors to the question of what it means for a design to be “applied” to an “article of manufacture.”¹⁰⁰ All the Government says is that “[i]n conducting this inquiry, the . . . over-arching objective should be to identify the article that most fairly may be said to embody the defendant’s appropriation of the plaintiff’s innovation.”¹⁰¹ At bottom, the Government’s approach seems to boil down to: “Which item does the patent owner deserve to get the ‘total profits’ from?”

While this sort of open-ended, fairness-based inquiry might appeal to some in theory, it would be problematic in practice.¹⁰² Perhaps most importantly, the Government’s approach would make it difficult — and perhaps practically impossible — to resolve any “article of manufacture” dispute prior to a full trial on the merits. The Government sets forth a long, open-ended list of potentially relevant facts; if any of those facts are disputed, the judge will have to send the issue to the jury.¹⁰³

98. *See id.* at 27–29.

99. *See* Gov’t Br., *supra* note 9, at 27–29. Others have criticized this approach on similar grounds. *See* Brief of Amici Curiae 113 Distinguished Industrial Design Professionals and Educators in Support of Respondent, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) at 35, (No. 15-777), 2016 WL 4151446, at *35 [hereinafter Designers’ Br.] (calling this an “amorphous and indeterminate balancing test[.]”); Alden Abbott, *Supreme Court’s Samsung v. Apple Decision and the Status of Design Patents*, THE HERITAGE FOUNDATION (Dec. 20, 2016), <http://www.heritage.org/courts/commentary/supreme-courts-samsung-v-apple-decision-and-the-status-design-patents> [https://perma.cc/S7SJ-24E2] (referring to the Government’s suggested approach as “inherently malleable and vague”); Plaintiff Columbia Sportswear North America, Inc.’s Response to Defendant Seirus’s Opening Brief Regarding Legal Standard for Design Patent Infringement Damages, *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, No. 3:15-cv-00064 (D. Or. Mar. 23, 2017), ECF No. 156 [hereinafter Columbia Reply Br.] (“The DOJ ‘test[.]’ . . . contains a number of deficiencies, because the ‘test’ is not a legal test but a recitation of factors.”). *But see* Gil, *supra* note 9, at 86 (suggesting that these factors provide a “clear rule[.]”); *id.* at 88 (“Courts should adopt these factors because it would provide clear guidance going forward for patent attorneys, their clients, jurors, and judges.”). The Government also fails to define key terms such as “component.” *See* Gov’t Br., *supra* note 9, at 27–29. *See also* Burstein, 1887, *supra* note 14, at 67–68 (discussing the term “component”). Indeed, at times, the Government seems to conflate the concept of the design itself with the “component” to which it is applied. *See* Gov’t Br., *supra* note 9, at 28 (“If the design is a minor component of the product, like a latch on a refrigerator, or if the product has many other components unaffected by the design, that fact suggests that the ‘article’ should be the component embodying the design.” (emphasis added)).

100. *See* Gov’t Br., *supra* note 9, at 27–29; *see also* Designers’ Br., *supra* note 99, at 35 (arguing that the Government’s approach has “no basis in the statutory text”).

101. Gov’t Br., *supra* note 9, at 26.

102. Indeed, the Government’s approach might best be described as an approach that only a big, rich company could love.

103. After all, a court may grant summary judgment only where there is no genuine issue of material fact. *See, e.g.,* *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247–48 (1986).

So both the patent owner and the accused infringer would have to litigate, through trial, under a cloud of uncertainty.¹⁰⁴ This would, among other problems, increase the amount both sides would have to spend on damages experts, who would have to develop and defend alternative calculations of profits.

This uncertainty would also give design patent owners undue power to chill legitimate competition. The owner of any design patent could threaten a competitor with the very real possibility that a jury might decide the competitor should be on the hook for all of its profits for a given product, no matter how small or insignificant the design claimed in the patent might be or how weak the infringement claim.¹⁰⁵

Of course, not all of these design patent owners would ultimately prevail on the issue of infringement — let alone convince a jury that the entire product constitutes the relevant “article.” But that is beside the point. As Justice Scalia noted in another product-design case, “[c]ompetition is deterred . . . not merely by successful suit but by the plausible threat of successful suit.”¹⁰⁶ In terms of empowering *in terrorem* threats, the Government’s open-ended, just-throw-it-to-the-jury approach would be almost as bad as the *Apple/Nordock* rule.

Patent owners seeking to enforce their patents in good faith would also be burdened by this uncertainty. This might not concern large companies with big litigation budgets.¹⁰⁷ However, individual patent owners and small- or medium-sized companies may not be able to bear the

And where these facts are disputes, courts will be loath to grant motions to dismiss under Federal Rule of Civil Procedure 12.

104. Others have criticized the Government’s approach on similar grounds. See Brief of Amici Curiae on Behalf of Intellectual Property Professors In Support of Respondent, *Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429 (2016), (No. 15-777), 2016 WL 4239412, at *28 [hereinafter Janis S. Ct. Br.] (arguing that the Government’s approach “would be costly, complex, and unpredictable to apply”).

105. This is not just speculation or hyperbole. Under the Copyright Act of 1976, judges can award anywhere from \$750 to \$150,000 per infringed work and the “law provides scant guidance about where in that range awards should be made, other than to say that the award should be in an amount the court ‘considers just.’” Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439, 441 (2009). The result has been that awards that “are frequently arbitrary, inconsistent, unprincipled, and sometimes grossly excessive.” *Id.* The Government’s proposal would provide a wider range of possible awards (\$250 to potentially hundreds of millions of dollars or more) with guidance that’s not really much more detailed. Under those conditions, it would not be surprising to see the same problems we have seen with awards of statutory damages in copyright.

106. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000).

107. Indeed, when pressed by the Justices at oral argument, both Apple and Samsung said they approved of the Government’s approach. Transcript of Oral Argument at 20, *Samsung*, 137 S. Ct. 429 (2016) (No. 15-777) (“JUSTICE ALITO: The Solicitor General has proposed a test with four factors to determine the article question. Do you agree with those? Are there others you would add? MS. SULLIVAN: . . . We—we like the Solicitor General’s test.”); *Id.* at 42–43 (“JUSTICE SOTOMAYOR: Mr. Waxman, can we go back to the government’s test . . . Do you agree [with] that four-part test with respect to identifying just the article of manufacture? MR. WAXMAN: Yes . . .”).

risk of litigating even the most meritorious claims because they would not be able to tell with sufficient levels of confidence whether the expected reward would justify filing suit in the first place. Of course, there is risk and uncertainty in all litigation. But the Government’s approach would increase that uncertainty (and the time it would take to resolve it) dramatically. And there is no reason to believe that the Government’s approach would lead to the “right” outcome — however one defines that — often or reliably enough to justify the increased uncertainty and litigation costs.¹⁰⁸

The Government’s test also fails to address the important issue of whether should these factors be evaluated on a patent-by-patent basis. Can a patent owner aggregate different design patents into a single Frankenclaim? It’s not uncommon for patent owners to assert multiple design patents against the same accused infringer. In *Apple v. Samsung*, for example, Apple asserted three phone-related design patents against Samsung.¹⁰⁹ Before the Supreme Court, Apple argued that it deserved the total profits from all of the infringing phones because the three patents, when considered as a group, covered “the overall look-and-feel of the iPhone.”¹¹⁰ The Government’s approach would seem to allow, if not encourage, this type of claim aggregation.¹¹¹ But claim aggregation would distort the facts — and likely overstate the value of the patent — in many infringement cases.

Consider, for example, the actual infringement claims in *Apple v. Samsung*. Apple asserted three different design patents against nineteen

108. The problem is not limited to just the factors selected by the Government; any multifactor test that treats the “article of manufacture” issue as a question of fact for the jury would be susceptible to the foregoing criticisms.

109. Amended Verdict Form at 6–7, *Apple Inc. v. Samsung Elecs. Co.*, No. 5:11-cv-01846 (N.D. Cal. Aug. 24, 2012), ECF No. 1931 [hereinafter Verdict].

110. Brief in Opposition to Petition for Certiorari at 31, *Apple Inc. v. Samsung Elecs. Co.*, No. 15-777, 2016 WL 6599923 (Feb. 3, 2016) [hereinafter *Apple Cert. Br.*]; see also Brief for Respondent at 54, *Samsung*, 137 S. Ct. 429 (No. 15-777), 2016 WL 4073686 [hereinafter *Apple Merits Br.*]. That was Apple’s argument, anyway. The patents, even considered in the aggregate, did not cover the shape or size of the phone’s profile or the design for the back of the phone.

111. See Gov’t Br., *supra* note 9, at 9 (“The factfinder should identify the article in which the design prominently features, and that most fairly may be said to embody the defendant’s appropriation of the plaintiff’s innovation.”). Arguably, the Supreme Court’s decision precludes this type of claim aggregation. See *Samsung*, 137 S. Ct. at 434 (2016) (“Arriving at a damages award under § 289 thus involves two steps. First, identify the ‘article of manufacture’ to which *the* infringed design has been applied. Second, calculate the infringer’s total profit made on that article of manufacture.” (emphasis added)). See also PATRICK J. FLINN, *HANDBOOK OF INTELL. PROP. CLAIMS & REMEDIES* § 6.05 (2017) (stating that, in light of *Samsung*, “[l]ower courts must now determine the relevant ‘article of manufacture’ for each of the infringed design patents”); HOWARD C. ANAWALT & EVE BROWN, *IP STRATEGY: COMPLETE INTELL. PROP. PLANNING* § 1:38 (2017) (“Practical implications [of *Samsung v. Apple*] may include a new requirement in design patent cases that claims be individually parsed rather than analyzed holistically.”) No matter how lower courts read *Samsung*, though, evaluating each patent claim on its own merits is the superior approach.

different Samsung phones.¹¹² But Apple accused only four of those phones of infringing all three design patents.¹¹³ And the jury found that three of those phones did, in fact, infringe all three patents.¹¹⁴ Indeed, of the eighteen phones the jury found infringing, eleven of them were found to infringe only one of the asserted design patents.¹¹⁵ In this situation, evaluating the importance of the three design patents in the aggregate makes no sense. On the other hand, conducting the Government's multi-factor test for each asserted patent vis-à-vis each accused product would be an incredibly complex (not to mention expensive) endeavor. For all of these reasons, courts should not adopt the Government's test for identifying the relevant "article of manufacture" at *Samsung* step one.¹¹⁶

B. *The Nature of the Inquiry*

In its amicus brief, the Government contended that "[i]dentifying the relevant 'article of manufacture' entails a case-specific analysis of the relationship among the design, the product, and any components"¹¹⁷ and that this task "is properly assigned to the finder of fact."¹¹⁸ This Section evaluates both of these contentions.

1. A Case-by-Case Inquiry?

The Government argued that, in the early twentieth century, some courts of appeal "recognized . . . that determining the relevant 'article' for purposes of calculating profits involved a case-specific inquiry."¹¹⁹ In support of this argument, the Government pointed to the *Piano Cases* and *Young v. Grand Rapids Refrigerator Co.*¹²⁰ But, of the passages the

112. *Cf.* Janis S. Ct. Br., *supra* note 104, at 28 (arguing that the Government's approach "would be costly, complex, and unpredictable to apply").

113. *See* Verdict, *supra* note 109, at 6–7.

114. *See id.*

115. *See id.*

116. A group of design patent prosecutors has also proposed using an open-ended, multi-factor, fact-specific test. *See* Saidman et. al, *supra* note 9, at 355–56. This test suffers from many of the same infirmities as the Government's proposal but has even less legal and logical support. *See id.* at 356–59 (providing limited, mostly conclusory support for the proposed factors). Therefore, courts should reject the prosecutors' proposal for substantially the same reasons that they should reject the Government's proposal.

117. Gov't Br., *supra* note 9, at 9.

118. *See id.* at 9, 29.

119. *Id.* at 19–20.

120. *Id.* at 20–21 (citing *Bush & Lane Piano Co. v. Becker Bros.*, 222 F. 902 (2d Cir. 1915)); *Bush & Lane Piano Co. v. Becker Bros.*, 234 F. 79 (2d Cir. 1916) [hereinafter "*Bush II*"]; *Young v. Grand Rapids Refrigerator Co.*, 268 F. 966 (6th Cir. 1920)). Because there were two Second Circuit decisions in *Bush*, those decisions are sometimes referred to as "the *Piano Cases*." *See, e.g.*, Opening Brief for Defendants-Appellants at 38, *Apple Inc. v. Samsung Elecs. Co.*, Nos. 2014-1335, 2014-1368, 2014 WL 2586819 (Fed. Cir. May 23, 2014), ECF No. 33.

Government cited from those cases, only one seems to support the Government’s contention.¹²¹

The Government argued that, in the Second Circuit’s 1916 decision in the *Piano Cases*, “the court explained that it was necessary to determine ‘the article to which the design was applied’ by examining ‘the relation to the business whole of the part embodying the patent . . . from all viewpoints, technical, mechanical, popular, and commercial.’”¹²² Read in isolation, this passage might seem to support the proposition that determining the relevant “article” requires a case-by-case, factual inquiry. But the Second Circuit had already decided the “article of manufacture” issue in its first decision in the *Piano Cases*.¹²³ In its 1916 decision, the court merely repeated its conclusion that the piano case — as opposed to the completed piano — was the relevant article.¹²⁴ The issue in the 1916 decision was not how to identify the article of manufacture; it was how to calculate the profits from that article.¹²⁵

Even if it were not *dicta*, the passage the Government quoted from the *Piano Cases* does not provide strong support for the Government’s contention that the relevant “article” is a factual question that must be determined on a case-by-case basis. Here is the quoted language, in context:

[W]hen a design patentee seeks to recover more than \$250, because either he lost a greater sum by the infringement, or the infringer made a greater profit thereby, no reason is seen for departing from the construction of the statute announced by us in *Untermeyer v. Freund*:

“The manifest purpose of Congress [in enacting the Act of 1887] was to enlarge the remedy against infringers of design patents, and to declare that the measure of profits recoverable on account of the infringement should be the total net profits upon the ‘whole article.’”

Each litigation presents its own problem; it is impossible to define in advance. Probably each solution depends on the relation to the business whole of the part

121. See Gov’t Br., *supra* note 9, at 20–21.

122. Gov’t Br., *supra* note 9, at 20 (quoting *Bush II*, 234 F. at 81 (alteration in original)).

123. *Bush*, 222 F. at 905.

124. *Bush II*, 234 F. at 83.

125. See *id.* Accordingly, the portion of *Bush II* cited by the Government is *dicta*.

embodying the patent, and that relation must be considered from all viewpoints, technical, mechanical, popular, and commercial.¹²⁶

In this passage, the Second Circuit did not purport to lay down a hard and fast rule about the “article of manufacture” inquiry, stating only that it “[p]robably . . . depends on” the listed factors.¹²⁷ The court also puts undue emphasis on the phrase “whole article” — a phrase that was neither emphasized in *Untermeyer* nor used in the statute.¹²⁸ And this entire discussion ignores the fact that, when Congress enacted the special design patent disgorgement remedy, the phrase “article of manufacture” was a term of art.¹²⁹ For all of these reasons, the *Piano Cases* did not decide — let alone mandate — that the question of what constitutes the relevant “article” must be determined on a case-by-case basis.

Indeed, neither the *Piano Cases* nor *Young* support the Government’s contention that identifying the “article of manufacture” to which a patented design is applied for the purposes of § 289 must be “a case-specific inquiry.”¹³⁰ In the *Piano Cases*, the defendant sold pianos in infringing cases.¹³¹ The Second Circuit decided the defendant was liable to the plaintiff for the “total profit” from the cases, not the “total profit” from the assembled pianos as sold.¹³² In reaching this decision, the court described “[t]he principal question” before it as “whether the recovery should be confined to the subject of the patent.”¹³³ The court answered that question in the affirmative.¹³⁴ And, as the court repeatedly noted, the plaintiff’s patent claimed a design for a piano case, not

126. *Bush II*, 234 F. at 81 (quoting *Untermeyer v. Freund*, 58 F. 205, 212 (2d Cir. 1893)). Notably, the phrase “whole article” was not used in quotation marks in the original decision in *Untermeyer*. See 58 F. at 212.

127. *Bush II*, 234 F. at 81.

128. See *supra* note 126 (discussing *Untermeyer*); Act of Feb. 4, ch. 105, 24 Stat. 387, 387 (1887) (not using the phrase “whole article”).

129. See Burstein, 1887, *supra* note 14, at 59–62.

130. Gov’t Br., *supra* note 9, at 19–20.

131. See *Bush II*, 234 F. at 79.

132. *Bush & Lane Piano Co. v. Becker Bros.*, 222 F. 902, 905 (2d Cir. 1915). At times, the court was less than precise with its language and certain passages might be read out of context to suggest that the court concluded that the plaintiff was entitled only to the profits that were attributable to the design of the case, not to the case itself. See, e.g., *id.* (“When he secures the profits made by the seller of that case *based on the design itself*, he will receive all he is entitled to.” (emphasis added)). However, in the context of the decision as a whole, it is clear that the court was ruling that the plaintiff was entitled to “the profits upon the sale of the case.” *Id.* at 903; *id.* at 905 (“[T]he cause is remanded to the District Court with instructions to enter a decree based upon the *profits due to the defendant’s infringement by the sale of piano cases* embodying the design of the patent.” (emphasis added)).

133. *Id.* at 904.

134. *Id.* (stating that the plaintiff’s “recovery should have been confined to the part which alone is covered by the claim of its patent”); *id.* at 905 (“All that Lane did was to produce a design which added some new ornamental features to the old form of piano case. When he

a design for a piano.¹³⁵ The court stated that a rule “giving the owner of a design patent for a receptacle intended to hold an expensive article of manufacture the profits made on the sale of the receptacle and its contents, must certainly lead to inequitable results and cannot be sustained.”¹³⁶ The court also noted that a piano case could be “sold separate and apart from the music-making apparatus.”¹³⁷ The court did not, however, suggest that the “total profits” inquiry depended in any way on whether or not the parties to a particular case happened to sell them separately.¹³⁸ To the contrary, the court focused almost entirely on its own construction of the scope of the patent claim. Because claim construction does not depend on what the defendant sells or any of the other case-specific issues identified by the Government, the *Piano* cases do not support the Government’s suggestion that the “article of manufacture” issue must be resolved on a case-by-case basis.¹³⁹

In *Young*, “[t]he defendant manufacture[d] refrigerators, and needed, for the doors thereof, a latch which would hold the doors tightly shut; Young was in control of a company which manufactured such articles” — i.e., latches.¹⁴⁰ The defendant bought latches from Young for a while and later “made changes in the form of the latch, and made or bought” the redesigned latches to use in its refrigerators.¹⁴¹ Young accused the defendant of infringing three utility patents and two design

secures the profits made by the seller of that case based on the design itself, he will receive all he is entitled to.”)

135. *Id.* at 904 (“He received a patent for a ‘piano case’ and not for a piano”); *id.* at 905 (“Lane did not invent a piano, but a piano case; the piano could be made to fit as well in a case of entirely different design.”).

136. *Id.* at 904–05. Indeed, the court went so far as to say that “[i]f the rule be established that a design for a case enables the owner to collect damages for the case not only, but for the contents of the case as well, it will lead to results which shock the conscience.” *Id.* at 905. The court also opined, in *dicta*, that its equitable concerns did not apply in cases where “the design is inseparable from the article to which it is attached, or of which it is a part.” *Id.* at 904. The court cited *Gorham Mfg. Co. v. White*, 81 U.S. 511 (1871) and *Dominick & Haff v. R. Wallace & Sons Mfg. Co.*, 209 F. 223 (2d Cir. 1913) as two such cases. *Id.* Both of these cases dealt with designs for flatware. See *Gorham*, 81 U.S. at 512; *Dominick & Haff*, 209 F. at 223.

137. *Bush*, 222 F. at 904.

138. See *id.* Notably, in its analysis, the majority did not suggest that its analysis depended on whether the accused infringer actually made or sold the cases separately. See *id.* at 904–05. Indeed, when the evidence showed that the defendant did not, in fact, sell the cases separately, that did not change the majority’s conclusion about the relevant article. *Bush & Lane Piano Co. v. Becker Bros.*, 234 F. 79, 83 (2d Cir. 1916) (“it makes no difference in the rule of law, when once the article to which the design was applied has been ascertained.”). By contrast, in the first case, the dissenting judge suggested that the whatever the patent owner makes and sells should be deemed to be the relevant article. See *Bush*, 222 F. at 906 (Ward, J., dissenting) (“The complainant neither manufactures the case nor sells it separately. I think it is therefore entitled to all the profits derived from the sale of pianos in the case.”). But this view obviously did not persuade his colleagues.

139. See Gov’t Br., *supra* note 9, at 19–21 (citing *Bush*, 222 F. 902 (1915); *Bush II*, 234 F. 79 (2d Cir. 1916)).

140. *Young v. Grand Rapids Refrigerator Co.*, 268 F. 966, 967 (6th Cir. 1920).

141. See *id.*

patents “for latch casings.”¹⁴² The judge found the defendant had infringed two of the utility patents and one of the design patents.¹⁴³ According to the Sixth Circuit:

[I]n a case like this, the difficulty is to determine what profits have been made by a sale of the article. The patent was upon a sheet metal shell or casing which surrounds the mechanism of the latch, and was attached to the refrigerator as a part of the latch structure, and was sold by defendant (with negligible exceptions) as a part of the refrigerator. The ornamental design of the shell added something to the attractiveness of the unitary article sold; but it is not seriously contended that all the profits from the refrigerator belonged to Young. It would be less fanciful to treat the latch and casing together as a unit; but defendant did not sell them in this form, unless for occasional replacement. Any segregation of the profits due to the use of this particular design of latch casing is obviously impossible.¹⁴⁴

Thus, the problem in *Young* wasn’t how to identify the relevant “article” — there seems to have been no real dispute that the relevant “article” was either the latch casing or the latch.¹⁴⁵ The problem was how to calculate the profits from either the latch or its casing.¹⁴⁶ Since the defendant didn’t usually sell the latches as stand-alone products, there was no real-world profit data for the court to use.¹⁴⁷ Importantly, however, the court did not rule that, in the absence of this information, Young was entitled to the profits from the whole refrigerator.¹⁴⁸ Instead, where there was a failure of proof, the solution was to award the statutory minimum of \$250.¹⁴⁹ Nothing in *Young* indicates that the “article” might be something different if asserted against a different infringer or

142. *Id.*

143. *Id.* (finding infringement of Latch Casing, U.S. Design Patent No. 48,958 (issued April 25, 1916)).

144. *Id.* at 974 (emphasis added).

145. *See id.*

146. *See id.*

147. *See id.*

148. As noted above, Young was not making that argument — at least not “seriously.” *See id.* It’s also worth noting that, in *Young*, the fact that “[t]he ornamental design of the shell added something to the attractiveness of the” refrigerator was not enough to make the refrigerator the relevant article. *Young*, 268 F. at 974.

149. *Young*, 268 F. at 974 (“The statute was passed, we think, to provide for cases of this character, and to prevent the otherwise inevitable result of a recovery of merely nominal damages.”).

if Young had sold refrigerators instead of latches.¹⁵⁰ Therefore, *Young* does not support the Government’s suggestion that the “article of manufacture” issue must be resolved on a case-by-case basis.¹⁵¹

2. Is it a Question of Fact or Law?

The Government argued that “[t]he task of identifying the relevant article of manufacture is properly assigned to the finder of fact.”¹⁵² If, as the Government posits, the test should focus on the visual impact of a design on the infringing product as a whole,¹⁵³ it may make sense to characterize the “article of manufacture” inquiry as an issue of fact. But nothing in the Government’s brief or the authorities it relied upon indicates that this is a universal rule that must apply no matter how the “article of manufacture” inquiry is conceptualized.¹⁵⁴ Indeed, the only cases the Government cites in support of its factors were equity cases where the “article of manufacture” issue was decided by a judge.¹⁵⁵ Therefore, courts are not bound to treat this as an issue of fact.¹⁵⁶

C. The Burden of Proof

The Government also argued that “[w]hile the plaintiff bears the ultimate burden of establishing the infringer’s total profit, the defendant . . . should bear the burden of identifying any component that it views

150. *See id.*

151. *See* Gov’t Br., *supra* note 9, at 19–21, (citing *Bush & Lane Piano Co. v. Becker Bros.*, 222 F. 902, 904 (1915); *Bush & Lane Piano Co. v. Becker Bros.*, 234 F. 79, 81 (2d Cir. 1916); *Young*, 268 F. at 974); *see also id.* at 9.

152. Gov’t Br., *supra* note 9, at 29.

153. *See id.* at 18–19, 26.

154. Actions to recover under the 1887 Act could be brought in either law or in equity. Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387 (1887) (“[T]he full amount of such liability maybe recovered by the owner of the letters patent . . . in any circuit court of the United States having jurisdiction over the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.”); *see also* *Swarthmore Junior v. Miss Greeley Junior Frocks*, 52 F. Supp. 992, 993 (S.D.N.Y. 1943) (“This statute expressly provides that recovery may be had ‘either by action at law or upon a bill in equity.’”); *see generally* *Cotter*, *supra* note 18, at 24 (2013) (“[A]wards of defendant’s profits, which . . . historically were considered an equitable remedy for which there was no right to trial by jury.”).

155. *See* Gov’t Br., *supra* note 9, at 27–29 (citing *Bush*, 222 F. at 903–04; *Bush II*, 234 F. 79 (2d Cir. 1916); *Young v. Grand Rapids Refrigerator Co.*, 268 F. 966, 974 (6th Cir. 1920)). *See also* *Bush & Lane Piano Co. v. Becker Bros.*, 209 F. 233 (S.D.N.Y. 1913), *rev’d*, 222 F. 902 (2d Cir. 1915) (noting that the case was brought “[i]n [e]quity”); SIXTH CIRCUIT, U.S. COURT OF APPEALS, RECORDS AND BRIEFS, CASES 3316-3318 (indicating that the lower court cases in *Young* were identified as Equity Cases 1844 and 1853) (copies on file with the author). The other case the Government cites is the Commissioner of Patent’s decision in *Ex parte Brand*, 1898 Dec. Comm’r Pat. 62, 63. *See* Gov’t Br., *supra* note 9, at 29. For more on *Brand*, *see* *Burstein, 1887*, *supra* note 14, 42–43.

156. And, as discussed below, there are many reasons why it would make sense to treat this as an issue of law. *See infra* Section V.B.

as the relevant article of manufacture.”¹⁵⁷ In other words, the Government argued that the accused infringer should bear the burden of *production* on the “article of manufacture” issue if the accused infringer argues that the relevant “article” is something less than the entire accused product.¹⁵⁸ The Government did not cite any design patent cases in support of this argument.¹⁵⁹ This Section discusses the two arguments the Government made in support of this contention.

1. “Tainted Profits”

According to the Government, “once the plaintiff has shown that the defendant profited by exploiting a product containing the plaintiff’s patented design, the defendant should be required to identify, through the introduction of admissible evidence, the component that the defendant asserts is the article to which the design was applied.”¹⁶⁰ In support of this argument, the Government cites only *S.E.C. v. Teo*.¹⁶¹ According to the Government, *Teo* stands for the proposition that “once government establishes existence of tainted profits, defendant has burden of

157. Gov’t Br., *supra* note 9, at 9.

158. *See id.* at 30 (“The defendant should bear the burden of *producing* evidence that the relevant ‘article of manufacture’ in a particular case is a portion of an entire product as sold.” (emphasis added)); *id.* at 31 (“But once the plaintiff has shown that the defendant profited by exploiting a product containing the plaintiff’s patented design, the defendant should be required to *identify*, through the introduction of admissible evidence, the component that the defendant asserts is the article to which the design was applied.” (emphasis added)); *id.* (citing *Alaska Dep’t of Envtl. Conservation v. EPA*, 540 U.S. 461, 494 n.17 (2004) for the proposition that the “placement of burden of *production* may turn on which party has ‘peculiar means of knowledge’ of the facts in question” (emphasis added)); *id.* at 32 (“It is not clear, however, whether petitioners satisfied their burden of *producing* evidence to support their arguments.” (emphasis added)). The Government did not argue that the accused infringer should bear the burden of *persuasion* on the “article of manufacture” issue. *See id.* at 30–31. *See generally* 1 CHRISTOPHER B. MUELLER AND LAIRD C. KIRKPATRICK, FEDERAL EVIDENCE § 3:2 (4th ed. 2009) (“To say that a party bears the burden of persuasion . . . is to say she can win only if the evidence persuades the trier of the existence of the facts that she needs in order to prevail.”).

159. *See* Gov’t Br., *supra* note 9, at 9; *see also id.* at 30–31 (citing *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 926 F.2d 1161, 1164 (Fed. Cir. 1991); *Horvath v. McCord Radiator & Mfg. Co.*, 100 F.2d 326, 330 (6th Cir. 1938); *SEC v. Teo*, 746 F.3d 90, 112 (3d Cir. 2014); *Alaska*, 540 U.S. at 494 n.17; *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S. Ct. 843, 851 (2014)). *SmithKline* was a utility patent case that dealt with the issue of how to calculate a reasonable royalty under 35 U.S.C. § 284. *See* 926 F.2d at 1162–63. *Horvath* involved a utility patent “for a machine for making spiral tubing” and the Sixth Circuit considered the relative burdens of proof for disgorgement under the utility patent — not design patent — disgorgement provision. *See* 100 F.2d at 329–30. *SEC v. Teo* involved a securities fraud action brought by the Securities and Exchange Commission. *See* 746 F.3d at 93. *Alaska* involved an action brought under the Clean Air Act by the Environmental Protection Agency. 540 U.S. at 468. *Medtronic* was a utility patent case about the burden of proof for patent infringement. *See* *Medtronic Inc. v. Boston Sci. Corp.*, 695 F.3d 1266, 1269 (Fed. Cir. 2012), *rev’d sub nom.* *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S. Ct. 843 (2014).

160. Gov’t Br., *supra* note 9, at 31 (citing *Teo*, 746 F.3d at 112).

161. *Id.* (citing *Teo*, 746 F.3d at 112).

production to identify untainted portions.”¹⁶² The Government does not offer any reason why the profits for “a product containing the plaintiff’s patented design” should be considered analogous to the “tainted profits” in *Teo*.¹⁶³ And even if they were, *Teo* is still inapposite.

In the cited portion of *Teo*, the dissenting judge stated that “[w]hen the SEC comes forward with a reasonable approximation of tainted profits, the burden of production then shifts to the defendant to produce evidence showing that all or some part of the sum in question should not be subject to disgorgement.”¹⁶⁴ If the profits for the entire “product containing the plaintiff’s patented design” are analogous to these “tainted profits,” this passage might, at first blush, seem to support the Government’s argument.

However, as the majority in *Teo* discusses at length, “the analytic framework for determining a remedy in an SEC enforcement suit is different from private suits” brought under the Securities Exchange Act of 1934.¹⁶⁵ In a private suit, the plaintiff must prove “that disgorged profits proceed directly and proximately from the violation claimed and are not attributable to some supervening cause.”¹⁶⁶ But in a government-initiated suit, this requirement is relaxed for various policy reasons.¹⁶⁷ For example, the majority noted that “[c]oncerns . . . have been raised repeatedly about the abusive use of private enforcement [of the securities laws] and the negative impacts that such practices have on the market.”¹⁶⁸ By contrast, the court “did not see evidence of widespread concern that SEC-initiated enforcement actions were being used abusively.”¹⁶⁹ So the court found it “unsurprising that the analytic framework for determining a remedy in an SEC enforcement suit is different.”¹⁷⁰

Thus, the test the Government seeks to import from *Teo* is a special burden-shifting rule developed for use in SEC-initiated enforcement actions.¹⁷¹ The Government offered no reason why this rule should be

162. *Id.* (citing *Teo*, 746 F.3d at 112).

163. *See id.*

164. *Teo*, 746 F.3d at 112 (Jordan, J. dissenting in part) (quoting *S.E.C. v. First City Fin. Corp.*, 890 F.2d 1215, 1232 (D.C. Cir. 1989)); *see also* *Gov’t Br.*, *supra* note 9, at 31 (citing *Teo*, 746 F.3d at 112)).

165. *See Teo*, 746 F.3d at 105.

166. *See id.* at 101 (internal quotation marks omitted) (quoting *Wellman v. Dickinson*, 682 F.2d 355, 368 (2d Cir. 1982)).

167. *See id.* at 105 (“In light of all of these policy distinctions, it is unsurprising that the analytic framework for determining a remedy in an SEC enforcement suit is different from private suits . . .”).

168. *Id.* at 104 (citing *LaSala v. Bordier et Cie*, 519 F.3d 121, 128 (3d Cir. 2008)).

169. *Id.* at 105 (citing *First City Fin. Corp.*, 890 F.2d at 1231).

170. *See id.*

171. *See id.*

imported into — or even why the reasoning behind it would be analogous to — design patent cases.¹⁷² If anything, the policy concerns discussed in *Teo* suggest that design patent owners should not be given the benefit of a burden-shifting rule. In *Teo*, the court decided that applying a lower burden of proof to SEC-initiated actions was justified, at least in part, because there was no “widespread concern that SEC-initiated enforcement actions were being used abusively.”¹⁷³ The same cannot be said about design patent enforcement actions. Numerous commentators voiced concerns that the Federal Circuit’s *Apple/Nordock* rule had led (or would incentivize) abusive design patent enforcement actions.¹⁷⁴ Under the logic of *Teo*, design patent owners should *not* get the benefit of a lower burden of proof or a special burden-shifting rule. Instead, they should be treated like the private-enforcement plaintiffs and bear both the burden of proof and the burden of persuasion on the “article of manufacture” issue.¹⁷⁵

172. See Gov’t Br., *supra* note 9, at 31.

173. *Teo*, 746 F.3d at 105.

174. See, e.g., Brief for The Internet Association et al. as Amici Curiae Supporting Petitioners at 6, *Samsung Electronics Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429 (2016), (No. 15-777), 2016 WL 3194217, at *6 [hereinafter Internet Ass’n Br.] (“[T]he Federal Circuit’s decision [in *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983 (Fed. Cir. 2015)] has already prompted so-called ‘patent trolls’ to threaten design-patent litigation against high-technology companies like amici.”); Brief for the Hispanic Leadership Fund et al. as Amici Curiae Supporting Petitioners at 6, *Samsung*, 137 S. Ct. 429, (No. 15-777), 2016 WL 3253944, at *6 (“The sheer size of an entire-profits award will impart powerful leverage, enabling design-patent holders to extract extravagant sums for even small portions of product-designs that unwittingly stray too close to their own patented designs”); Timothy Coughlin, Note, *Apple, Inc. v. Samsung Electronics Co.: Economics of Design Patent Trolling*, 35 CARDOZO ARTS & ENT. L.J. 209, 219 (2016) (“The total profit rule could be the tipping point that incentivizes trolls to venture deeper into design patent territory, ultimately providing an inexpensive means with quick turnaround, high rate of issue, low risk, and high reward, to assert malevolent claims against infringing patent holders.”); Bursstein, *Costly Designs*, *supra* note 1, at 111 (“Not only are design patents easy to get and difficult to invalidate, but they carry the risk of extraordinarily high monetary awards due to a special profit-disgorgement rule. Indeed, it appears that personal-injury law firms are starting to get into the design patent game.” (footnotes omitted)); G. Nagesh Rao, *As the Smartphone Wars Reheat, the Threat of Chilling Innovation Looms*, TECHCRUNCH (June 18, 2016), <https://techcrunch.com/2016/06/18/innovation-hangs-in-the-balance-of-scotus-case/> [https://perma.cc/BN96-7XAA] (“Without the Supreme Court reversing the ruling and establishing modernizing precedent in which the remedy is more closely tied to patented design, this smartphone war/design patent ruling will enhance the performance of patent abusers, creating trolls on steroids”). *But see*, e.g., Br. of Amicus Curiae Crocs, Inc. in Support of Affirmance at 7, *Samsung*, 137 S. Ct. 429, (No. 15-777), 2016 WL 4239196, at *7 (“Petitioners’ parade of horrors ignores the unique nature of design patents, which makes hypotheticals such as innocent infringement of multiple design patents and the explosion of a design patent troll industry highly unlikely.”). Although many of these concerns were prompted by the promulgation of the *Apple/Nordock* rule, they remain valid if lower courts craft an “article of manufacture” test that effectively revives the *Apple/Nordock* rule.

175. See *Teo*, 746 F.3d at 101 (noting that, in a private suit under the Securities Exchange Act, the plaintiff must prove “that disgorged profits proceed directly and proximately from the violation claimed and are not attributable to some supervening cause”) (internal quotation marks omitted) (quoting *Wellman v. Dickinson*, 682 F.2d 355, 368 (2d Cir. 1982)).

2. “Peculiar Means of Knowledge”

The Government maintains that accused infringers should bear the burden of production when they argue that the relevant “article” is less than the entire accused product because they are more likely to have “peculiar means of knowledge” with respect to the relevant facts.¹⁷⁶ It is true that the Supreme Court has said that “the ordinary rule, based on considerations of fairness, does not place the burden upon a litigant of establishing facts peculiarly within the knowledge of his adversary.”¹⁷⁷ However, in the very next sentence, the Court stated that “this rule is far from being universal, and has many qualifications upon its application.”¹⁷⁸ And, according to the leading evidence treatise, “[t]his consideration should not be overemphasized. Very often one must plead and

176. Gov’t Br., *supra* note 9, at 30–31. The Government cites two cases, *Alaska Dep’t of Env’tl. Conservation v. EPA and Medtronic, Inc. v. Mirowski Family Ventures, LLC*, for the proposition that the “placement of [the] burden of production may turn on which party has ‘peculiar means of knowledge’ of the facts in question.” *Id.* (citing *Alaska Dep’t of Env’tl. Conservation v. EPA*, 540 U.S. 461, 494 n.17 (2004); *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S. Ct. 843, 851 (2014)). But neither of these cases provides strong support for the proposition that an accused infringer should bear the burden of production on the question of what constitutes the relevant “article of manufacture” for the purposes of § 289.

In *Alaska*, the Supreme Court held that the EPA bears the burden of proof on the issue of “[w]hether the state agency’s BACT determination was reasonable,” regardless of “which enforcement route EPA selected.” 540 U.S. at 493–94. The Court’s decision did not, however, depend on which party had the “peculiar means of knowledge.” *See id.* Instead, the Court reasoned that the EPA should not “gain[] a proof-related tactical advantage by issuing a stop-construction order instead of seeking relief through a civil action.” *Id.* at 493. In the footnote cited by the Government, the Court states, in *dicta*, that “allocations of burdens of production and persuasion may depend on which party . . . ‘presumably has peculiar means of knowledge’” but noted that this was only one consideration that might be relevant to the allocation of the burden of proof. *Id.* at 494 n.17 (citing 9 J. WIGMORE, EVIDENCE § 2486, at 288, 290 (J. Chadbourn rev. ed. 1981); *Campbell v. United States*, 365 U.S. 85, 96 (1961)).

In *Medtronic*, the Court held that a patentee has the burden of proof on infringement in declaratory judgment cases, just as in other cases. 134 S. Ct. at 846. The Court did not, however, base its decision on the parties’ relative “means of knowledge.” *See id.* at 851–52. Therefore, *Medtronic* itself does not support the government’s argument. It appears that the Government cited *Medtronic* because it’s a patent case that includes, in a parenthetical, potentially relevant language from another Supreme Court case. *See* 134 S. Ct. at 851 (“[T]he ordinary rule, based on considerations of fairness, does not place the burden upon a litigant of establishing facts peculiarly within the knowledge of his adversary.”) (internal quotation marks omitted) (quoting *Shaffer v. Weast*, 546 U.S. 49, 60 (2005)). However, *Medtronic* does not include the full context of the quote from *Shaffer*. In the quoted portion of *Shaffer*, the Court stated: “[T]he ordinary rule, based on considerations of fairness, does not place the burden upon a litigant of establishing facts peculiarly within the knowledge of his adversary. *But this rule is far from being universal, and has many qualifications upon its application.*” 546 U.S. at 60 (emphasis added).

177. *Shaffer*, 546 U.S. at 60 (2005) (quoting *United States v. New York, New Haven & Hartford R.R. Co.*, 355 U.S. 253, 256, n.5 (1957)).

178. *Id.* (citing *Greenleaf’s Lessee v. Birth*, 31 U.S. (6 Pet.) 302, 312 (1832); *McCormick* § 337, at 413). Indeed, in *Shaffer* itself, the Court’s ruling was contrary to this “ordinary rule.” *See id.* at 60–62 (holding that “[t]he burden of proof in an administrative hearing challenging an IEP is properly placed upon the party seeking relief,” whether that party is the parents or the school district, even though “[s]chool districts have a ‘natural advantage’ in information and expertise”).

prove matters as to which his adversary has superior access to the proof.”¹⁷⁹ Even if the accused infringer has “peculiar means of knowledge” with respect to the relevant facts, that does not conclusively answer the question of which party should bear the burden of proof.

Of course, the determination of which facts are relevant depends on the nature of the substantive test. So even if accused infringers are more likely to have access to the facts that are relevant under the Government’s test, the Government’s arguments are not generalizable to other tests. If a court were to adopt a different “article of manufacture” test, the Government’s arguments should carry little, if any, weight. For all of these reasons, courts should not adopt the Government’s approach to determining the relevant “article of manufacture.”

V. A NEW APPROACH

In interpreting and applying 35 U.S.C. § 289, courts should, to the extent feasible, adopt the historical meaning of “article of manufacture.” They should also look to history to determine to what article a particular design has been “applied.” This Part explains the relevant historical principles and outlines a framework for applying them today. It then discusses the nature of this inquiry and the allocation of the burden of proof.

A. *The Test*

1. Courts Should, to the Extent that They Can, Readopt the Historical Meaning of “Article of Manufacture.”

When Congress enacted the original design patent disgorgement statute in 1887, “article of manufacture” was a term of art in U.S. patent law.¹⁸⁰ It referred to a tangible item made by humans, other than a machine or composition of matter, that had a unitary structure and was complete in itself for use or for sale.¹⁸¹ Thus, “textile fabrics, articles of personal attire, general hardware, [and] house furnishing goods” were

179. 2 MCCORMICK ON EVIDENCE § 337 (7th ed. 2016).

180. Burstein, 1887, *supra* note 14, at 5.

181. *Id.*; *see also id.* (“This evidence also shows that in 1887, the phrase ‘article of manufacture’ was not a synonym for ‘product’ The evidence further demonstrates that in 1887, ‘article of manufacture’ did not mean any ‘thing made by hand or machine.’”).

all considered “articles of manufacture,”¹⁸² as were “pottery, glassware, nails, [and] screws.”¹⁸³

While an “article of manufacture” had to be something complete enough that it could be sold to someone, “that someone did not have to be the ultimate or end consumer. It could be another manufacturer or artisan.”¹⁸⁴ Thus, “article of manufacture” was not a synonym for “product:”

For example, in *Brower*, [an] inkstand and stopper were deemed to be separate articles of manufacture, even though each one would have been useless without the other and, presumably, they would have been sold together as a single product. Similarly, in *Patitz*, [a] mirror-frame and sconce were separate “articles of manufacture” even though they were designed to be used together and were designed so that they could be attached together to form a single fixture. And in *Haggard*, [a] “cradle-supporting frame” and a “cradle body” were ruled to be “two distinct articles of manufacture,” even though they were designed together and were clearly meant to be sold and used together as a single product.¹⁸⁵

182. WILLIAM EDGAR SIMONDS, A SUMMARY OF THE LAW OF PATENTS FOR USEFUL INVENTIONS AND FORMS 19 (1883). *See also* Burstein, 1887, *supra* note 14, at 33 (“[B]y 1887, a number of administrative and judicial decisions had expressly equated the phrase ‘article of manufacture’ in the design patent statute with the term ‘manufacture’ in the utility patent statute. And the phrase ‘article of manufacture’ was already being used a synonym for ‘manufacture’ in utility patent law.” (footnote omitted)).

183. EDWARD S. RENWICK, PATENTABLE INVENTION § 59 (1893) (listing “cloths, baskets, articles of clothing, pottery, glassware, nails, screws, etc.” as examples of “manufactures”).

184. Burstein, 1887, *supra* note 14, at 64 (citing SIMONDS, *supra* note 182, at 19).

185. *Id.* (citing *Ex parte Brower*, 1873 Dec. Comm’r Pat. 151, 151; *Ex parte Patitz*, 1883 Dec. Comm’r Pat. 101, 101–02; *Ex parte Haggard*, 1897 Dec. Comm’r Pat. 47, 48). Again, as used in this Article, “product” means “something sold by an enterprise to its customers.” *See* ULRICH & EPPINGER, *supra* note 17, at 2.

The category of “articles of manufacture” specifically excluded “machines” and “compositions of matter.”¹⁸⁶ These exclusions were based on the principle of *expressio unius est exclusio alterius*.¹⁸⁷ Courts and the Patent Office equated the phrase “article of manufacture” in the design patent statute with “manufacture” in the utility patent statute.¹⁸⁸ The utility patent subject matter provision, Rev. St. 4886, listed “art,” “machine,” “manufacture,” and “composition of matter” as categories of patentable inventions.¹⁸⁹ By contrast, the design patent subject matter provision, Rev. Stat. 4929, referred only to designs for “manufactures.”¹⁹⁰ And, “[b]y 1887, it was well-established that these ‘statutory classes of invention’ . . . were separate categories, ‘between which the lines of division are sharply drawn.’”¹⁹¹ Accordingly, “the Patent Office repeatedly stated that designs for machines did not constitute proper statutory subject matter.”¹⁹² The Patent Office did, however, allow “design patents for *parts* of machines — if those parts otherwise qualified as articles of manufacture.”¹⁹³

186. Burstein, *1887, supra* note 14, at 61 (citing, *inter alia*, HORACE PETTIT, THE LAW OF INVENTIONS 42 (1895) (“Manufacture. — This is a very broad term, as broad almost as its derivation implies, *not including, however, machines* or compositions of matter.” (emphasis added)); *see also* 1 WILLIAM C. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS § 183 (1890) (“[T]he parts of a machine considered separately from the machine itself, all kinds of tools and fabrics, and *every other vendible substance which is neither a complete machine nor produced by the mere union of ingredients*, is included under the title ‘manufacture.’” (emphasis added)). This was different from how the term “manufacture” was used in England. *See* GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF PATENTS FOR USEFUL INVENTIONS: AS ENACTED AND ADMINISTERED IN THE UNITED STATES OF AMERICA §§ 26–27 (1867); *see also* Burstein, *1887, supra* note 14, at 32 (“[I]t seems reasonably clear that Congress used the word ‘manufacture’ in the new design patent law to mean the same thing it meant in the existing utility patent law.”) (footnotes omitted).

187. Burstein, *1887, supra* note 14, at 61–62 (footnotes omitted); *see also, e.g., Ex parte Steck*, 1902 Dec. Comm’r Pat. 9, 13 (referring to Rev. Stat. § 4929); *see also* WILLIAM L. SYMONS, THE LAW OF PATENTS FOR DESIGNS 28 (1914) (citing *Ex parte Adams*, 1898 Dec. Comm’r Pat. 109; *Ex parte Steck*, 1902 Dec. Comm’r Pat. 9) (“The terms ‘art’, ‘machine’, ‘manufacture’, and ‘composition of matter’ have a well recognized meaning in the patent laws. . . . A machine therefore is not proper subject matter for a design patent. This has been repeatedly so held in Patent Office decisions.”). *See also generally* WILLIAM D. SHOEMAKER, PATENTS FOR DESIGNS § 88 (1929) (“There are other decisions which would deny the protection of the design patent law to machines which have movable parts, *first, because such machines do not fall within the term ‘article of manufacture,’* and secondly, because, since they have movable parts, their design is ever changing.”) (emphasis added); *id.* § 94 (“There are several decisions of the Commissioner of Patents which declare that machines do not fall within the term ‘article of manufacture’ as used in the design statute.”). Shoemaker thought, however, that this interpretation should be revised in light of the holding of *In re Hadden*. *Id.* § 94 (citing 20 F.2d 275 (D.C. Cir. 1927)).

188. Burstein, *1887, supra* note 14, at 62; *see also, e.g., Ex parte Steck*, 1891 Dec. Comm’r Pat. 9, 13 (“Under the express provisions of the statute [design] patents are limited to ‘an article of manufacture,’ and there is clear and well-defined distinction in patent law between a machine and an article of manufacture.”).

189. Burstein, *1887, supra* note 14, at 62 (footnotes omitted).

190. *Id.*

191. *Id.* at 27–28 (citing *Ex parte Blythe*, 1885 Dec. Comm’r Pat. 82, 86); *see also id.* at 19–20 (discussing how these classes of invention are defined).

In interpreting and applying § 289, courts should adopt this historical definition of “article of manufacture.” It avoids the problems that would arise from formulating a test around the word “component.”¹⁹⁴ It also provides an objective, predictable benchmark that allows for the determination of whether a given item qualifies as an “article of manufacture” with a minimum amount of evidence. If anyone anywhere manufactures, uses, or sells an item separately, that item would qualify as an “article of manufacture” — as long as the item doesn’t also qualify as a “composition of matter” or a “machine.”¹⁹⁵

Excluding machines from the definition of “article of manufacture” might strike some as “outdated.”¹⁹⁶ But excluding machines would solve many of the worst overcompensation problems that could potentially be created by § 289.¹⁹⁷ Throughout the *Apple v. Samsung* litigation, concerns have been raised about awarding the total profits from something like a car when a design patent only claims a design for the outer body or an even smaller part like a cup holder.¹⁹⁸ If a completed machine could not, as a matter of law, be the relevant “article” under

192. *Id.* at 62. Distinguishing manufactures from “compositions of matter” does not seem to have been a problem. A “composition of matter” was defined as any “artificial substance made up of two or more elements so united as to form a homogeneous whole.” HENRY CHILDS MERWIN, *THE PATENTABILITY OF INVENTIONS* § 55 (1883). Thus, this category included things like paints and medicines. *Id.* See also GEORGE TICKNOR CURTIS, *A TREATISE ON THE LAW OF PATENTS FOR USEFUL INVENTIONS: AS ENACTED AND ADMINISTERED IN THE UNITED STATES OF AMERICA* § 28 (Bos., Little, Brown and Co. 1867) (“The last class of patentable subjects mentioned in the statute is described by the term ‘composition of matter.’ It includes medicines, compositions used in the arts, and other combinations of substances intended to be sold separately.”); ALBERT H. WALKER, *TEXT-BOOK OF THE PATENT LAWS OF THE UNITED STATES OF AMERICA* § 18 (N.Y.C., L. K. Strouse & Co. 1885) (“The phrase ‘composition of matter,’ as used in the statutes, covers all compositions of two or more substances. It includes, therefore, all composite articles, whether they be the result of chemical union, or of mechanical mixture, and whether they be fluids, powders, or solids.”).

193. Burstein, *1887*, *supra* note 14, at 62 (footnotes omitted). At least one court expressed skepticism that machine parts could, in fact, be considered articles of manufacture. See *Westinghouse Elec. & Mfg. Co. v. Triumph Elec. Co.*, 97 F. 99, 102 (6th Cir. 1899).

194. See *supra* Part II.

195. Cf. Burstein, *1887*, *supra* note 14, at 60–62 (explaining the historical meaning of “article of manufacture”); cf. also *id.* at 65 (“[T]here is no evidence that, in or around 1887, the determination of whether something was an ‘article of manufacture’ was a context-specific inquiry. An item either was an ‘article of manufacture’ or it was not.”). By manufactured “separately,” I mean that the item was put together into a single unit (whether or not that unit was formed from smaller pieces joined together), not that it was manufactured by a “separate” person or in a “separate” location.

196. *Internet Ass’n Br.*, *supra* note 174, at 17 (“From today’s perspective, the machine-manufacture distinction seems outdated.”).

197. The exclusion of “composition of matter” seems unlikely to cause significant problems. See *supra* note 192.

198. See, e.g., Matt Levy, *Apple Is Trying to Muddy Design Patent Law in Order to Get Its Way*, IP WATCHDOG (Sept. 28, 2017), <http://www.ipwatchdog.com/2017/09/28/apple-trying-muddy-design-patent-law/id=88535/> [<https://perma.cc/4DDK-42ZZ>] (discussing “the ‘cup holder’ hypothetical”). The Justices also asked a number of questions related to the exterior designs of cars. E.g., Oral Arg. Tr. 27:7–17, *Samsung Elecs. Co. v. Apple Inc.*, No. 15-777 (Oct. 11, 2016) (question from Justice Kagan).

§ 289, many of these worst-case scenarios could never come to pass — indeed, they could not even be plausibly threatened.¹⁹⁹ To be clear, this Article is not arguing that machines are not “designed” or that designing machines is not important. But excluding “machines” from the category of “articles of manufacture” makes a lot of sense.

In certain circumstances, it may be difficult to draw a line between “machines” and “manufactures.” While it was clear in 1887 that a “machine” was not an “article of manufacture,” there was no broadly accepted definition of “machine.”²⁰⁰ Commentators disagreed, for example, about whether items such as tools and pianos should be classified as “machines” or “manufactures.”²⁰¹ Contemporary courts would thus have to develop a definition of “machine.” Courts have had little incentive to do so in utility patent cases but, if the issue became important, fashioning a definition is feasible.²⁰² In close cases, courts should err on the side of classifying an item as a “machine.”²⁰³ Any item on the borderline between a “machine” and “manufacture” would likely raise the same overcompensation concerns as an item that is clearly a “machine.” After all, it is likely that such borderline items are purchased mainly (if not entirely) for how they work, as opposed to how they look.

While it makes sense to maintain the historical distinction between “machines” and “articles of manufactures,” courts should not feel compelled to adopt a nineteenth-century view of what constitutes a “machine” for at least two reasons. First, as discussed above, there was no consensus on the definition. Thus, there is no well-established term of art definition that could overcome the general rule that words in the Patent Act should “be interpreted as taking their ordinary, contemporary, common meaning.”²⁰⁴ Second, nineteenth-century definitions were, necessarily, based on nineteenth-century technology. As the concept of what constitutes a machine has changed, there is no reason not to adopt that changing view in the design patent law. It would be strange and inadvisable to say that items like computers or cars are not

199. *Cf. Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) (“Competition is deterred . . . not merely by successful suit but by the plausible threat of successful suit.”).

200. Burstein, 1887, *supra* note 14, at 31.

201. *Id.*

202. *Id.* (“[I]n the utility patent context, there was little need (or incentive) to spend much time or mental effort developing a test to distinguish between these categories. As long as an invention was clearly either a ‘manufacture’ or a ‘machine,’ . . . the invention would be patentable either way.”).

203. *Cf. Wal-Mart*, 529 U.S. at 215 (“[T]o the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.”).

204. *Bilski v. Kappos*, 561 U.S. 593, 594 (2010) (quoting *Diamond v. Diehr*, 450 U.S. 175, 182 (1981)).

“machines” simply because they might not fit a nineteenth-century definition.²⁰⁵

Courts might, however, feel compelled to include machines in the definition of “article of manufacture” in light of the U.S. Court of Customs and Patent Appeals’ (“CCPA”) 1930 decision in *In re Koehring*.²⁰⁶ In *Koehring*, the Patent Office rejected “a design for a concrete mixer truck body and frame” as not being directed to patentable subject matter, among other reasons.²⁰⁷ The CCPA reversed, mainly because the majority believed that, in enacting the design patent laws, Congress “had in mind the elimination of much of the unsightly repulsiveness that characterizes many machines and mechanical devices”²⁰⁸ Although the Commissioner’s decision affirming the refusal expressly relied on the *expressio unius* rationale, the CCPA did not even mention the issue, let alone decide it.²⁰⁹ So, arguably, there is no holding on this point.²¹⁰ But even if courts feel bound by *Koehring*, the old “machine” decisions still make it clear that, at the time the predecessor to § 289 was passed, a design for a *part* of a machine was something different than a design for a *whole* machine.

2. The Question of Which Article a Design is “Applied” to Should be Informed by History.

Determining to which article a design is “applied” need not be a metaphysical or qualitative inquiry.²¹¹ Courts can and should look to

205. While the formulation of a comprehensive definition of a machine that would work well for all areas of patent law is beyond the scope of this Article, the author tentatively proposes that the term “machine” could be defined as “[a] mechanical, electric, or electronic device, such as a computer, tabulator, sorter, or collator.” MCGRAW-HILL DICTIONARY OF SCIENTIFIC AND TECHNICAL TERMS 1254 (2002).

206. See *In re Koehring*, 37 F.2d 421, 424 (C.C.P.A. 1930). Although *Koehring* dealt with the meaning of “article of manufacture” in the statutory subject matter provision, there is no reason to interpret the phrase differently there than in the remedy provision. See *infra* Section VI.C.

207. See Decision of the Commissioner December 1, 1927, as reprinted in Transcript of Record at 36, *In re Koehring*, 37 F.2d 421 (C.C.P.A. 1930) (Patent Appeal No. 2167) (on file with author) [hereinafter “*Koehring* C.D.”].

208. See *Koehring*, 37 F.2d at 422.

209. Compare *Koehring* C.D., *supra* note 207, with *Koehring*, 37 F.2d at 421–25.

210. In its first decision, the Federal Circuit adopted the *holdings* of the CCPA as binding precedent. *South Corp. v. United States*, 690 F.2d 1368, 1369 (Fed. Cir. 1982) (en banc) (“We hold that the holdings of our predecessor courts, the United States Court of Claims and the United States Court of Customs and Patent Appeals, announced by those courts before the close of business September 30, 1982, shall be binding as precedent in this court.”).

211. It appears that the Government proposed a qualitative test because it was concerned that there may be cases where a design for a part is actually very important to the appearance (or salability) of some larger whole. It may be that, in some cases, the appearance of a part — whether that part is itself an article of manufacture or a mere fragment thereof — drives sales of the end product as a whole. In those cases, however, the patent owner is free to pursue an award of damages under 35 U.S.C. § 284 using the entire market value theory. See Mark A. Lemley & Carl Shapiro, *Patent Holdup and Royalty Stacking*, 85 TEX. L. REV. 1991, 2023

the nature and scope of the claimed design.²¹² In the 1887 Act, the phrase “total profit” was expressly qualified; the patent owner was entitled to recover the “total profit” the defendant made “from the manufacture or sale . . . of the article or articles [of manufacture] to which the design, or colorable imitation thereof, has been applied”²¹³ Then, as now, the word “design” was understood to cover two classes of “designs” — specifically, “surface ornamentation applied to an article,” and designs for “the configuration or shape of an article.”²¹⁴ And applicants then, as now, could choose whether they wanted to protect the surface ornamentation, the configuration, or a combination of both.²¹⁵

In 1887, a configuration design “relate[d] to the outward form or contour [of an article of manufacture], while the surface ornamentation relates to illustrations and delineations that are printed or impressed upon or woven into it.”²¹⁶ For a design patent that claimed a design for surface ornamentation, the relevant article was whatever article the design was “printed, painted, cast, or otherwise placed on or worked into.”²¹⁷ This rule should be easy enough to apply today, at least in the vast majority of cases. Courts should ascertain what article the surface

(2007) (“[T]he ‘entire market value’ rule imported from the lost profits cases will sometimes permit patentees to recover not just the value of the patented component but also other unpatented components of the product to the extent that demand for the patented piece drove sales of the whole device.”). Admittedly, the entire market value rule is not perfect — at least not in its current form. *See, e.g.*, Brian J. Love, Note, *Patentee Overcompensation and the Entire Market Value Rule*, 60 STAN. L. REV. 263 (2007). But making patent owners prove that the design of the part does, in fact, drive sales of the whole under § 284 is preferable to warping § 289 to accommodate the possibility of this type of situation.

212. This should be a claim-by-claim analysis, not a case-by-case analysis. There is no reason to allow patent owners to cherry-pick partial claims and then stitch them together into a Frankenclaim.

213. Act of Feb. 4, ch. 105, 24 Stat. 387, 387 (1887).

214. Burstein, 1887, *supra* note 14, at 8. The common understanding of what “surface ornamentation” and “configuration” mean, however, has changed significantly. *See id.* at 8 n.36 (“In contemporary design patent law and practice, ‘configuration or shape’ is generally understood to mean ‘any three-dimensional design’ and ‘surface ornamentation’ as ‘any two-dimensional design.’ This marks a significant change from the past.”) (internal citation omitted) (citing U.S. DEP’T OF COMMERCE, PATENT & TRADEMARK OFFICE, *supra* note 34 § 1504.01(a)(1)(A) (9th ed., rev. 07.2015, 2015); *Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37, 40).

215. *Id.* at 8.

216. *Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37, 40. The statute contemplated that each article had a single shape or configuration. *See* 1 REVISED STATUTES OF THE UNITED STATES 954 (2d ed. 1878) (reprinting Rev. St. § 4929) (stating that a design patent could be obtained for “any new, useful, and original shape or configuration of any article of manufacture”). Thus, a design patent for a “shape or configuration” covered *the* “shape or configuration,” not some fragment or portion thereof.

217. 1 REVISED STATUTES OF THE UNITED STATES 954 (2d ed. 1878) (reprinting Rev. St. § 4929) (stating that a design patent could be obtained for “any new and original impression, ornament, [pattern], print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture”); *see also Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37, 40.

ornamentation is actually, physically applied to. Consider, for example, this design for a “Dinner Plate or Similar Article”:²¹⁸

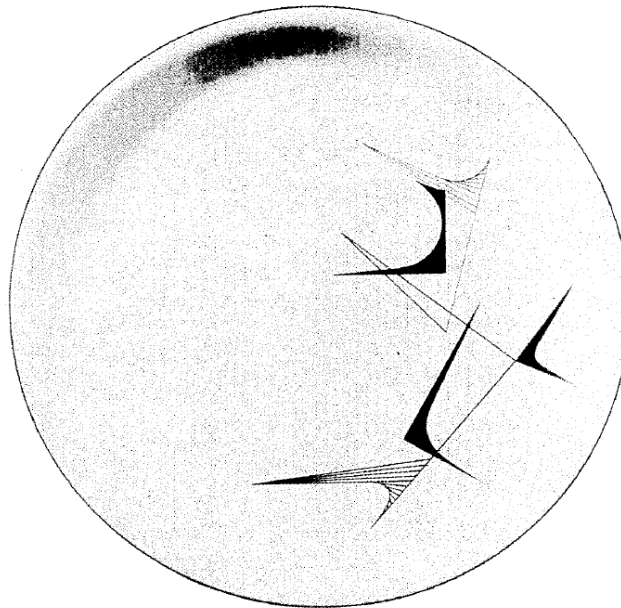


Figure 1: U.S. Patent No. D181,327

If a competitor were to apply this design to its own dinner plate, that would clearly infringe this patent.²¹⁹ And that would be the kind of use

218. U.S. Patent No. D181,327 (issued Oct. 29, 1957). Notably, although the worked portion covers only a part of the surface, the unworked portions should be considered part of the complete surface design. See PAUL ZELANSKI & MARY PAT FISHER, *DESIGN PRINCIPLES & PROBLEMS* 69 (2d ed. 1996) (“In an effective design, unworked areas are as active as anything else; they just happen to be made of the surface with which the designer started.”); see also SIAN MORSON, *DESIGNING FOR IOS WITH SKETCH* 78 (2015) (“Negative space is an important design element.”); CONNIE MALAMED, *VISUAL DESIGN SOLUTIONS: PRINCIPLES AND CREATIVE INSPIRATION FOR LEARNING PROFESSIONALS* 48 (2015) (“White or negative space includes all of the unused areas that are not filled with an image, shape or text. Effective designs create a relationship between the white space and non-white space.”). The overall design of the plate would be different if, for example, this motif was repeated ten times over its surface or if it were doubled in size.

219. See 35 U.S.C. § 271(a) (2012) (“Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”). Commentators disagree as to whether a design for surface ornamentation is — or should be — tethered in any way to the article for which the design was intended. Compare Jason J. Du Mont & Mark D. Janis, *Virtual Designs*, 17 *STAN. TECH.*

that would qualify for § 289 damages.²²⁰ A dinner plate is an article of manufacture, according to the definition proposed here. It is a tangible item made by humans that has a unitary structure and is complete in itself for use or for sale. It does not qualify as a “machine” or “composition of matter” under any reasonable definition of those terms. Therefore, the relevant article is the plate.²²¹

For surface-ornamentation designs, it may also be necessary to look at when the design is applied to determine the relevant article. Consider a situation where a particular surface design is printed onto fabric and that fabric is later cut into pieces and used to form all or part of a larger article, such as a glove.²²² In that case, the design is actually, physically applied to the fabric. Fabric qualifies as an “article of manufacture” under the definition proposed here.²²³ Therefore, the fabric — not the glove — would be the relevant article.²²⁴

L. REV. 107, 163–67 (2013) (arguing that the intended article doesn’t matter), *with* Burstein, *The Patented Design*, *supra* note 1, at 214–16 (disagreeing with Janis & Du Mont’s view). At least one court has recently held that “[d]esign patterns are limited to their article of manufacture” and granted a motion to dismiss where the patent-in-suit claimed a design for a chair but the infringing product was a basket. *Curver Luxembourg v. Home Expressions Inc.*, No. 2:17-cv-04079, 2018 WL 340036, at *9 (D.N.J. Jan. 8, 2018) (dismissing a complaint to for failure to state a claim where the design patent claimed a design for the surface ornamentation of a chair and the accused product was a basket). In situations where a surface-ornamentation design is applied to a related article that is meant to be used as a matching set, it may make sense to leave the question of infringement for the jury. For example, the same motif used in the dinner-plate example discussed above were applied to a serving platter, the jury would have to decide if that was “the same” design and, thus, constituted infringement. *See* *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc) (setting forth the contemporary test for design patent infringement). In that case — or if a court decided that the surface-ornamentation design was *not* tethered to the article identified in the patent claim — the “article of manufacture” test would remain the same. The judge could still decide what “article” the allegedly infringing design had been applied to while leaving the ultimate question of infringement for the jury.

220. *See* 35 U.S.C. § 289 (2012) (“Whoever during the term of a patent for a design, without license of the owner, . . . sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250”); *see also* Burstein, *Costly Designs*, *supra* note 1, at 118 n.74 (explaining that “§ 289 does not apply to all acts of design patent infringement”).

221. The relevant article wouldn’t be some constituent ingredient of the plate, such as the glaze that has been applied to the surface, because that glaze isn’t a tangible item complete enough that it could be sold or used by itself. *See* Burstein, *1887*, *supra* note 14, at 66–69 (discussing the concept of a “component”). And it’s not just the surface of the plate for the same reason. *See id.* The design is actually, physically applied to the plate. The plate is an article of manufacture. Therefore, the plate is the relevant article. For the same reasons, the relevant articles in the *Dobson* cases would be the carpets, not some constituent parts thereof. *See id.* (noting that, while the pile yarn or backing of a carpet might be considered “components” in some sense, they do not qualify as “articles of manufacture” under that phrase’s historical definition).

222. This appears to be what happened in *Columbia v. Seirus*. *See* *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 202 F. Supp. 3d 1186 (D. Or. 2016).

223. Indeed, fabric has long been considered an “article of manufacture.” *See* Burstein, *1887*, *supra* note 14, at 29.

224. Even if the fabric were intended to be used in a glove, that result would be neither inappropriate nor unfair. Unless the design patent claimed the particular orientation, scale,

Because designs for configurations are fundamentally different than designs for surface ornamentation, they require a different analysis.²²⁵ For a design patent that claims a design for a configuration, or for both the configuration and surface ornamentation, the relevant article would be the article whose shape is dictated by the claimed design.²²⁶ This is consistent with the historical understanding of the scope of a design patent. In 1887, a design for the configuration of a part was not considered a design for a larger whole.²²⁷ Thus, “[i]n the case of a design patent for the configuration of a casket-screw, the relevant article of manufacture would be the casket-screw, not the casket.”²²⁸ The same rule should apply today. The question should be what did the patentee actually design? Did they design the configuration of a casket screw or the configuration of a casket? To put it another way, did they create a design *for* a casket screw or a design *for* a casket?²²⁹

location, etc. for how the pattern would be used on a glove, it could not fairly be described as a design *for* a glove. And even if it did, § 289 profits should — at most — only be awarded if the infringing item uses the design in the same way disclosed in the patent. Thus, for example, if a design patent shows a fabric design as applied to the cuff of a glove, then “total profits” should only be available for a glove if the pattern is applied in the same way to the infringing gloves. *See, e.g.*, Heat Reflective Material, U.S. Patent No. D657,093 at fig.8 (issued Apr. 3, 2012) (showing “the heat reflective material as used in handwear”).

225. The analysis for configuration designs would also apply to combination designs.

226. Or, as I’ve put it before, “the article of manufacture for which the design was created.” *See* Burstein, 1887, *supra* note 14, at 70. To be clear, I don’t mean “dictated” in a metaphorical or stylistic sense. It’s true that designers sometimes speak of a salient feature as “dictating” the rest of a product’s form. *See* Brief of 26 Design Educators as Amici Curiae in Support of Appellee Apple Inc. at 3, Apple, Inc. v. Samsung Elecs. Co., (No. 14-1335), 2014 WL 4079446 (Fed. Cir. Aug. 4, 2014), ECF No. 99 (discussing the importance of a “salient” design feature). But, for the purposes of *Samsung* step one, courts should look at what the patentee’s design actually shapes.

227. Burstein, 1887, *supra* note 14, at 75–76.

228. *Id.* at 70.

229. It is true that the relevant subject matter provision no longer refers to a “shape or configuration of any article of manufacture” but, instead, refers only to a “design for an article of manufacture.” *Compare* REVISED STATUTES OF THE UNITED STATES 954 (2d ed. 1878) (emphasis added) (reproducing Rev. Stat. § 4929 as then in force), with 35 U.S.C. § 171(a) (Supp. I 2013). Some have read much into this change. *See In re Zahn*, 617 F.2d 261, 268 (C.C.P.A. 1980) (“We note also that s 171 refers, not to the design of an article, but to a design for an article . . .” (emphasis added)). However, there is no evidence that, when Congress changed this language in 1902, it intended to fundamentally change the concept of what constituted a patentable “design.” *Cf. In re Schnell*, 46 F.2d 203, 209 (C.C.P.A. 1931) (interpreting the categories of protectable designs to still cover configurations, surface ornamentation, and combinations of the two); *cf. also* Act of May 9, 1902, ch. 783, 32 Stat. 193, 193 (amending Rev. Stat. § 4929). Instead, it appears that Congress revised the statutory subject matter provision in order to clarify that design patents were meant to protect “ornamental” instead of “useful” designs. *See* S. Rep. No. 57-1139, at 1 (1902) (“The object sought by the proposed amendment is to conform the existing law to the manifest requirements of design patent law as distinguished from the law governing the subject of mechanical patents. Under existing law the courts have been compelled to strain the meaning of the word ‘useful’ to its utmost limit . . . and in some instances the purpose of Congress in enacting design patent legislation has been conspicuously evaded and aborted because of the inappropriate language found in the Revised Statutes bearing on the subject of design patents.”); *see also* Thomas B. Hudson, *A Brief History of the Development of Design Patent Protection in the United States*, 30 J.

In the nineteenth century, it wasn't difficult to identify the relevant article. Back then, the applicant had to name, and often illustrate, the entire article for which a configuration design was claimed.²³⁰ Today, however, an applicant is not required to show the entire article in the patent drawings.²³¹ And while the applicant has to "identif[y] the article in which the design is embodied by the name generally known and used by the public," the USPTO will let the applicant name essentially whatever item they wish as the relevant "article."²³² Thus, a contemporary design patent title may not provide much useful information.²³³

It may be that, for issued patents, the fact that a title refers to a "portion" of an article or uses similar language may constitute an admission that the patent does not cover the entire end product as sold. However, courts should be wary of relying too much on patent titles and should always look at what the patent claim actually covers. After all, patent titles are drafted by applicants with little to no meaningful oversight by the USPTO. If courts rely on design patent titles without actually examining the scope of the claims, then patent applicants will be able to easily game the system by giving their design patents broad titles.²³⁴

PAT. OFF. SOC'Y 380, 389 (1948) (describing the history of the enactment of the 1902 act). Even under the current statutory language, it would be strange to refer to a design for the shape of a screw as a design "for" a casket — the questionable reasoning in *Zahn* notwithstanding.

230. See WILLIAM D. SHOEMAKER, PATENTS FOR DESIGNS § 92 (1929) (citing *Ex parte Adams*, 1898 Dec. Comm'r Pat. 109) ("The design must be shown not only embodied, but with a complete embodiment, and show nothing but the applied design . . ."). The rule was different for design patents that claimed only surface ornamentation. See *id.* (citing *Ex parte Remington*, 1905 Dec. Comm'r Pat. 28) ("Where ornamentation may be applied to other articles than one shown, it is only necessary to show the one.").

231. See MPEP, *supra* note 22, § 1503.02.

232. *Id.* § 1503.01(I) (instructing examiners to "afford the applicant substantial latitude in the language of the title/claim").

233. For example, U.S. Patent No. D455,674 is entitled, "Flamingo." An actual flamingo, being an animal found in nature, would of course not qualify as an article of manufacture. Cf. *Diamond v. Chakrabarty*, 447 U.S. 303, 310 (1980) (contrasting the applicant's new bacterium with those "found in nature"). Indeed, the "Flamingo" patent appears to disclose a design for a decorative sculpture or figurine that is merely shaped like a flamingo. See U.S. Patent No. D455,674 fig. 1 (issued Apr. 16, 2002).

234. See, e.g., Article of Apparel with Three-Dimensional Fabric, U.S. Patent No. D793,070 (issued Aug. 1, 2017). Although the patentee describes its design as one for "apparel," it's clearly a design for fabric.

In any case, the “article of manufacture” inquiry should focus on the actual scope of the claimed design. For example, this design patent claims a design for the entire configuration of a “Utility Blade”.²³⁵

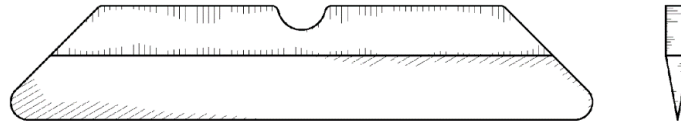


Figure 2: U.S. Patent No. D636,646

Based on just the patent drawings, the blade appears to qualify as an article of manufacture. It looks like it is constructed in a single piece and is complete enough that it could be sold separately. Moreover, based on the patent owner’s own claims in a recently-filed complaint, it appears that these types of blades are, in fact, sold separately, even if only as replacement parts.²³⁶ Whether a particular accused infringer sells the blades separately or as a component of a larger cutting device,²³⁷ this patented design should be deemed to have been “applied” to the blades, not to the larger product.²³⁸

If, counterfactually, the drawings shown below were the design patent drawings, then the entire cutting device — not the blade — would be the relevant article:²³⁹

235. Utility Blade, U.S. Patent No. D636,646, figs.3, 5 (issued Apr. 26, 2011).

236. Complaint ¶ 12, *Slice, Inc. v. Acme United Corp.*, No. 2:18-cv-00803 (D.N.J. Jan. 19, 2018), ECF No. 1 [hereinafter *Slice Complaint*] (alleging infringement of this design patent and a utility patent) showing the accused product in what appears to be an individual clamshell package. To be clear, under the analysis proposed here, the key fact is not that the *defendant* sells the blades separately — it’s that the blades are complete enough that they can be sold separately.

237. *See, e.g., id.* ¶ 40 (illustrating a “utility cutter” sold by the defendant that appears to use the blades claimed in the D’464 patent).

238. Of course, it will be easier to determine the amount of profits for the article if the infringer sells the article separately. But that should not be part of the analysis.

239. In fact, these illustrations come from the utility patent that was asserted in *Slice v. Acme*. *See Pocket Cutter*, U.S. Patent No. 9,579,808 (filed Dec. 13, 2013). *See also Slice Complaint, supra* note 236, ¶ 1.

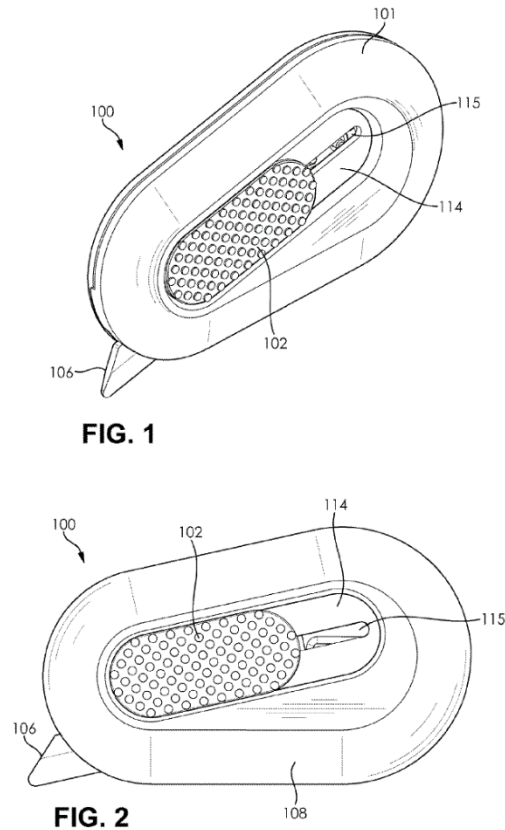


Figure 3: U.S. Patent No. 9,579,808

In this hypothetical, the cutting device would also appear to qualify as an article of manufacture. Even though it is made up of smaller components, they appear to be joined together to form a unitary whole.²⁴⁰ Based on the drawing alone, the device appears to be complete enough to be sold separately. And indeed, it appears that the patent owner does sell this as a free-standing product.²⁴¹

240. The fact that some pieces may move does not change this basic structural unity. *See Ex parte Klemm*, 1915 Dec. Comm'r Pat. 9, 9; *Chandler Adjustable Chair & Desk Co. v. Heywood Bros. & Wakefield Co.*, 91 F. 163 (C.C.D. Mass. 1898).

241. *Slice Complaint*, *supra* note 236, ¶40 (providing an illustration of this product). Again, under the analysis proposed here, the key fact is not that the plaintiff sells the blades separately — it's that the devices are complete enough that they can be sold separately.

There are two circumstances in which this test may prove difficult to apply. The first is where the design patent claims a design for a machine. For example, this design patent claims a combination design for a “Vehicle”:²⁴²

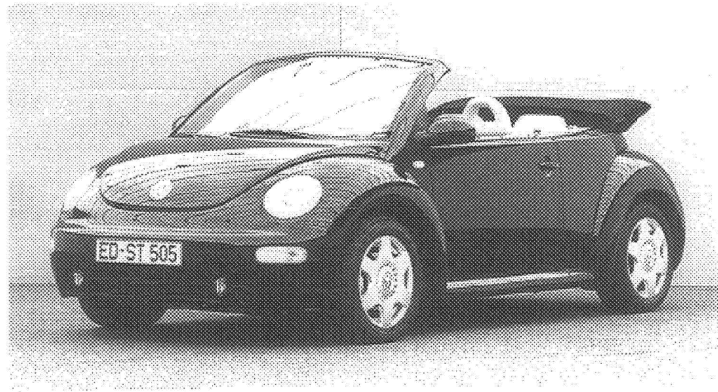


Figure 4: U.S. Patent No. D470,797

The vehicle shown here, would seem to qualify as a “machine” under any reasonable definition of that word.²⁴³ Under the approach proposed here, a machine is not an “article of manufacture.” So, for the purposes of § 289, the relevant article could not be the entire automobile. The best approach would be for courts to interpret these types of patents as claiming a design for whatever article (or articles) of manufacture the claimed design actually dictates the shape of.²⁴⁴ In this case, the design appears to be applied to all of the exterior components, including the wheels and tires but excluding the bottom of the vehicle.²⁴⁵ It also appears to be applied to parts of the headrests.²⁴⁶ This approach is admittedly imperfect due to the mismatch between the USPTO’s patenting practices and the definition put forth here. But hopefully, this rule would inspire clearer claims going forward.²⁴⁷

242. U.S. Patent No. D470,797 fig.1 (issued to Volkswagen AG on Feb. 23, 2003). This appears to be the design of the New Beetle Convertible.

243. It would certainly qualify under the tentative definition proposed here, because it is a “mechanical . . . device.” See MCGRAW-HILL DICTIONARY, *supra* note 205.

244. See *supra* note 226 and accompanying text. This approach would be roughly analogous to the treatment of pre-*Koehring* design patents that claimed designs for things like a machine “casing,” “frame,” or the like. Cf. *Westinghouse Elec. & Mfg. Co. v. Triumph Elec. Co.*, 97 F. 99, 99–100 (6th Cir. 1899) (involving Design for a Frame for Electric Machines, U.S. Patent No. D21,416 (issued Mar. 22, 1892)).

245. See D470,797, figs.1–10. By “components,” I mean an “article of manufacture” that is incorporated into a larger product. See *generally infra* note 290.

246. See *id.*

247. Ideally, if the approach adopted here were adopted by courts, the USPTO would revise its examining guidelines to provide greater clarity in future design patents.

The second potentially difficult circumstance is where the design patent claims a design for a graphical user interface (“GUI”) or some part thereof.

According to the USPTO, “Computer-generated icons, such as full screen displays and individual icons” are “surface ornamentation” and as long as “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 35 U.S.C. 171. . . . According to the USPTO, the relevant “article of manufacture” is the screen itself, not the device that generates the GUI display.”²⁴⁸

If the USPTO is correct and GUI designs are “applied” to a screen,²⁴⁹ then an infringer would only be liable for its “total profits” under § 289 when and if the infringer actually applies the design to a screen “for the purpose of sale” or sells a screen to which the GUI has been applied.²⁵⁰ In a case like *Apple v. Samsung*, the defendant could be liable for the “total profits” it made from the screens of infringing smartphones.²⁵¹ But if an infringer does not apply the design to any screen, they would not be liable for § 289 profits at all.²⁵² This result may strike some as anomalous or unfair, but it is consistent with both the text of § 289 and the USPTO’s interpretation of § 171.²⁵³

248. Burstein, *1887*, *supra* note 14, at 14 (citing U.S. DEP’T OF COMMERCE, PATENT & TRADEMARK OFFICE, *supra* note 34, § 1504.01(a)(1)).

249. This is far from clear. The USPTO’s conclusions are “based on questionable logic and has not been tested in litigation or ratified by any court.” Burstein, *1887*, *supra* note 14, at 14. But this is the theory on which these patents have been granted.

250. See 35 U.S.C. § 289 (2012). By its plain terms, § 289 does not contemplate any type of inducement or other secondary liability. See *id.*

251. See Burstein, *1887*, *supra* note 14, at 77–78. Because it would be very difficult for the design patent owner to prove these profits, it would be more likely that the owner would only be likely to recover the \$ 250 statutory minimum. See *id.*

252. That is because software is not an “article of manufacture” under the definition proposed here. Cf. Corel Corp. and Corel Inc.’s Notice of Motion and Renewed Motion for Judgment as a Matter of Law That Microsoft is Not Entitled to Disgorgement Damages Under 35 U.S.C. § 289 at 4, *Microsoft Corp. v. Corel Corp.*, No. 5:15-cv-05836 (N.D. Cal. Mar. 15, 2018), ECF No. 330 (“As Corel sells the accused Corel Home Office software products through download, those products in that instance, at a minimum, are not themselves an article of manufacture, nor are they sold by Corel in association with an article of manufacture.”). These patentees may, of course, be liable for § 284 on other theories of infringement. See generally *supra* Section II.C.

253. And, in any case, the USPTO’s “interpretation of the statute is based on questionable logic and has not been tested in litigation or ratified by any court.” Burstein, *1887*, *supra* note 14, at 14. Therefore, courts should be wary of fashioning general rules of design patent law to for the sole purpose of accommodating this highly questionable subject matter.

Ultimately, the approach proposed here would comport with the original congressional intent²⁵⁴ and be consistent with the results in prior cases.²⁵⁵ Compared to the Government’s proposal, this approach better matches the patentee’s remedy to their actual contribution and limits the power of design patentees to threaten competitors with the prospect of massively disproportionate damages awards. Consider Figure 2 above. If a competitor sold cutting devices (not just replacement blades) and a court used the Government’s approach, neither side would know until after a full trial on the merits whether the competitor would be liable for the total profits for the full devices or just the blades. This could cause the accused infringer to settle, even where the infringement claim is weak.²⁵⁶ Allowing patentees to wield this sort of *in terrorem* threat would chill legitimate competition and, potentially, allow recovery of profits awards that go far beyond the scope of the patentee’s actual contribution.

B. The Nature of the Inquiry

In the wake of *Samsung*, lower courts will have to decide whether the identification of the “article of manufacture” is a question of law or a question of fact. There is little to no guidance on this issue to be found in history or precedent. The legislative history does not speak to it. Nor do cases decided under § 289 and its predecessor, the 1887 Act.²⁵⁷ The most relevant cases decided under the 1887 Act — the *Piano Cases*, *Young*, and *Untermeyer* — were all brought in equity.²⁵⁸ But an action for monetary relief under the 1887 Act could be brought in either law or equity.²⁵⁹ Where, as here, “history and precedent provide no clear answers, functional considerations also play their part in the choice between judge and jury to define terms of art.”²⁶⁰ As the Supreme Court stated in *Markman*, “when an issue falls somewhere between a pristine legal standard and a simple historical fact, the fact/law distinction at

254. See Burstein, *1887*, *supra* note 14, at 69–77.

255. See *id.* at 72–73.

256. Indeed, in the referenced case, the accused replacement blade is plainly dissimilar from the claimed design. Slice Complaint, *supra* note 236, ¶ 58. And the overall appearance of the defendant’s cutting device looks quite different, overall, from the plaintiff’s cutting device. See *id.* ¶ 40.

257. At least, no cases that I have been able to find.

258. *Untermeyer v. Freund*, 50 F. 77 (C.C.S.D.N.Y. 1892), *aff’d*, 58 F. 205 (2d Cir. 1893) (noting that the case was brought “In Equity”); *Bush & Lane Piano Co. v. Becker Bros.*, 209 F. 233 (S.D.N.Y. 1913), *rev’d*, 222 F. 902 (2d Cir. 1915) (noting that the case was brought “In Equity”); SIXTH CIRCUIT, U.S. COURT OF APPEALS, RECORDS AND BRIEFS, CASES 3316–18 (indicating that the lower court cases in *Young* were identified as Equity Cases 1844 and 1853) (copies on file with the author).

259. Act of Feb. 4, ch. 105, 24 Stat. 387, 387 (1887).

260. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388 (1996).

times has turned on a determination that, as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question.”²⁶¹

The determination of which article a design has been “applied” to is neither a “pristine legal standard” nor a “simple historical fact.”²⁶² Judges, not juries, would seem to be better suited to determine the relevant article of manufacture under § 289.²⁶³ Deciding which article of manufacture a design has been applied to should involve consideration of the scope of the patent claim.²⁶⁴ It is, therefore, analogous to the issue in *Markman*. In *Markman*, the Supreme Court held that the “mongrel practice” of “construing a term of art” used in a patent claim “following receipt of evidence” was an issue of law “exclusively within the province of the court.”²⁶⁵

As the Court noted in *Markman*, “[t]he construction of written instruments is one of those things that judges often do and are likely to do better than jurors.”²⁶⁶ Although the interpretation of design patent claims is different than the interpretation of utility patent claims, judges are similarly better suited to the task than juries. The question of what constitutes the relevant article of manufacture does not require the type of determinations generally reserved to juries, such as the ability “to evaluate demeanor, to sense the ‘mainsprings of human conduct,’ or to reflect community standards.”²⁶⁷

261. *Id.* (internal quotation marks omitted) (quoting *Miller v. Fenton*, 474 U.S. 104, 115 (1985)); see also *Miller*, 474 U.S. at 114–15 (“[T]he decision to label an issue a ‘question of law,’ a ‘question of fact,’ or a ‘mixed question of law and fact’ is sometimes as much a matter of allocation as it is of analysis.” (citing Henry P. Monaghan, *Constitutional Fact Review*, 85 COLUM. L. REV. 229, 237 (1985))).

262. See *Markman*, 517 U.S. at 388 (internal quotation marks omitted) (quoting *Miller*, 474 U.S. at 114).

263. *Cf. id.* (“Judges, not juries, are the better suited to find the acquired meaning of patent terms.”).

264. See *supra* Section V.A.

265. *Markman*, 517 U.S. at 372 (“We hold that the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.”); *id.* at 378 (describing the act of “construing a term of art following receipt of evidence” as an example of a “mongrel practice”). Deciding whether a particular item qualifies as an “article of manufacture” may require the “receipt of evidence” but, as with regular claim construction, that does not mean that it must be deemed an issue of fact. See *id.* at 390 (“We accordingly think there is sufficient reason to treat construction of terms of art like many other responsibilities that we cede to a judge in the normal course of trial, notwithstanding its evidentiary underpinnings.”). Under the approach proposed here, the relevant evidence could include information about whether a particular item is — or could be — sold, used, or manufactured separately.

266. *Markman*, 517 U.S. at 388.

267. See *id.* at 389–90. For example, it seems unlikely that the necessary evidentiary underpinnings would usually — if ever — be decided solely on the basis of fact witness testimony. It seems much more likely that “any credibility determinations will be subsumed within the necessarily sophisticated analysis of the whole document, required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole.” *Id.* at 389.

Treating the “article of manufacture” issue as one law would promote “uniformity in the treatment of a given patent.”²⁶⁸ As the Court noted in *Markman*,

[W]hereas issue preclusion could not be asserted against new and independent infringement defendants even within a given jurisdiction, treating interpretive issues as purely legal will promote (though it will not guarantee) intrajurisdictional certainty through the application of *stare decisis* on those questions not yet subject to interjurisdictional uniformity under the authority of the single appeals court.²⁶⁹

Similarly, if judges decide as a matter of law what the relevant article (or potential range of articles) is for a given design patent, it would provide greater certainty in future cases.

Characterizing the “article of manufacture” issue as one of law would also allow for early determination by the court. This would give both sides a better idea of the risks and benefits of litigating a particular case. For example, a patent owner with a strong claim may be loathe to pursue a costly enforcement action if they cannot determine until after trial whether they will be able to recover the profits for the entire infringing product, or just the profits for some smaller part thereof. This uncertainty could pose an especially significant problem for individuals or small businesses. Providing both sides with a better idea of the expected reward and risk early on would encourage the litigation of meritorious claims and defenses and discourage the assertion of weak ones.²⁷⁰

For cases that do go to trial, early determination of the “article of manufacture” issue would lower litigation costs for both sides. If the question is left to the jury, parties would have to pay their damages experts to calculate both the profits on whatever the plaintiff deems to be the relevant article and the profits from whatever the defendant deems to be the relevant article. If any party had alternative theories about what constitutes the relevant article, the costs would be even

268. *See id.* at 390 (describing this as “an independent reason to allocate all issues of construction to the court”). It is true that *Markman* itself ultimately failed in providing much uniformity in the field of patent claim construction. But that is because the Federal Circuit has failed to provide district courts with a workable test or approach — not because the inquiry was given to the judge.

269. *Id.* at 391 (citation omitted).

270. This approach would also limit the *in terrorem* value of design patents. As discussed above, if the “article of manufacture” question is left to the jury, the owners of patents that cover only a very small part of a larger product and patent owners with dubious infringement claims could still use their patents to chill legitimate competition. *See supra* notes 105–106 and accompanying text.

higher. But if the court determines what the relevant article is before trial — and, ideally, before expert discovery — that would limit these costs by allowing the parties to focus on the article or articles identified by the court. For all of these reasons, the “article of manufacture” determination should be treated as an issue of law to be decided by the judge, not an issue of fact to be decided by the jury.²⁷¹

C. The Burden of Proof

If, as this Article argues, the *Samsung* step one inquiry is a question of law then there is no need to allocate the burden of proof.²⁷² If, however, the “article of manufacture” inquiry is deemed to be an issue of fact — or an issue of law based on factual underpinnings — then the burden of proof for *Samsung* step one should be placed on the patent owner.²⁷³ Specifically, the patent owner should have the burden of proving what article of manufacture the patented design has been applied to.²⁷⁴

As a general rule, the party seeking relief from the court bears the burden of proof unless there is “some reason to believe that Congress intended otherwise.”²⁷⁵ There is no reason to believe that Congress intended otherwise with respect to the disgorgement of profits under § 289. By the time the predecessor to § 289 was passed, “it was well-established that ‘[t]he burden of proving damages for the infringement

271. Or, perhaps, as an issue of law based on evidentiary underpinnings. *Cf.* *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 835 (2015) (holding that the appellate court must apply a clear error not a *de novo*, standard of review when reviewing a district court’s claim construction, “where the construction of a term of art has ‘evidentiary underpinnings.’”). Even if courts disagree with this analysis and decide that this should be a fact issue, the test proposed here would still lend itself to early determination by a judge because the factual underpinnings should rarely, if ever, be in serious dispute.

272. *See, e.g.*, *Level One Commc’ns, Inc. v. Seeq Tech., Inc.*, 987 F. Supp. 1191, 1196 (N.D. Cal. 1997) (“[M]atters of law generally are not subject to traditional burdens of proof.”) (internal citation omitted); Paul M. Janicke, *An Interim Proposal for Fixing Ex Parte Patent Reexamination’s Messy Side*, 4 HOUS. L. REV. 43, 55–56 (2013) (“Where the preclusive determination resolves a question of law, concepts like burden of proof and quantum of required evidence are inapplicable. For a question of law, no ‘proof’ is needed.”).

273. There does not seem to be any good reason to allocate the burdens of production and persuasion separately. *See generally* MUELLER & KIRKPATRICK, *supra* note 158, § 3:2 (discussing these two concepts). Additionally, even though this Article focuses on *Samsung* step one, the arguments in this Section would apply with equal force to *Samsung* step two.

274. For the reasons discussed in this section, the patent owner should also bear the burden of proving what profits are attributable to the relevant article at *Samsung* step two.

275. *Schaffer v. Weast*, 546 U.S. 49, 57–58 (2005). *See also* 2 MCCORMICK, *supra* note 179, § 337 (“The burdens of pleading and proof with regard to most facts have been and should be assigned to the plaintiff who generally seeks to change the present state of affairs and who therefore naturally should be expected to bear the risk of failure of proof or persuasion.”); William Baude & Stephen E. Sachs, *The Law of Interpretation*, 130 HARV. L. REV. 1079, 1111–12 (2017) (“In general, our system holds that ‘he who asserts must prove,’ so that burdens of persuasion largely track the assigned burdens of pleading.”) (footnote omitted).

of a patent is upon the plaintiff, and he must establish his damages by competent evidence.”²⁷⁶ Neither the text of the 1887 Act nor its legislative history indicate that Congress meant to change that rule.²⁷⁷ “To the contrary, both the House and Senate reports expressly contemplate that the patentee would continue to bear the burden of proving its entitlement to profits or damages.”²⁷⁸ There is no indication that Congress meant to change this allocation when it overhauled the Patent Act in 1952.²⁷⁹

Policy concerns also support the conclusion that the patent owner should bear the burden of proof with respect to the “article of manufacture” issue.²⁸⁰ As a general matter, “[t]he party who created the uncertainty should bear the burden of proving the hard-to-prove fact.”²⁸¹ If a patent owner chooses, for strategic purposes, to claim a design that covers less than an entire end product, it is the patentee and not an infringer who has created any uncertainty that might arise with respect to the application of § 289.

276. Burstein, *1887*, *supra* note 14, at 69 n.419 (quoting *Hunt Bros. Fruit Packing Co. v. Cassidy*, 53 F. 257, 261–62 (9th Cir. 1892)).

277. *Id.* at 69 (“There is . . . no indication that Congress meant to change or affect the parties’ burdens of proof with respect to patent damages.”).

278. *Id.*; *see also* H.R. REP. NO. 49-1966, at 3 (1886) (emphasis added) (“The patentee recovers the profit actually made on the infringing article *if he can prove that profit . . .*”); S. REP. NO. 49-206, at 2 (1886) (“The bill . . . also meets the case where the exact profits in dollars and cents cannot be proved under the technical rules of law as laid down by the Supreme Court in [*Dobson v. Dorman*, 118 U.S. 10 (1886)], by prescribing a minimum recover of \$250 . . .”).

279. *See Georgia-Pac. Corp. v. U.S. Plywood Corp.*, 243 F. Supp. 500, 521 (S.D.N.Y. 1965) (“[T]he 1952 codification was not intended to make substantive modifications in the provisions relating to recovery . . .” (citing S. REP. NO. 1979, 82d Cong., 2d Sess. 9 (1952); Charles J. Zinn, *Commentary on New Title 35, U.S. Code “Patents,”* U.S. Code Cong. & Admin. News 2507, 2523 (1952))). Indeed, comparing the plain text of § 289 to other profit-disgorgement provisions in related regimes suggests that, when Congress meant to shift the burden of proof to the infringer, it knew how to do so. *See Columbia Reply Br.*, *supra* note 99, at 22 (noting that, while “the trademark damages statute allows the plaintiff to seek an accounting or disgorgement of profits and provides for a shifted burden . . . Section 289 contains no such explicit shift.”); *see also* Brief for Petitioners at 17, *Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429 (2016), (No. 15-777), 2016 WL 6599922, at *5 [hereinafter *Samsung Merits Br.*] (“Nothing in the text of Section 289 reveals any intent to impose any burden of proof on defendants, in sharp contrast to other profits-disgorgement statutes that explicitly shift burdens to defendants, *see, e.g.*, 15 U.S.C. 1117(a) (trademark); 17 U.S.C. 504(b) (copyright).”).

280. *See* Edward W. Cleary, *Presuming and Pleading: An Essay on Juristic Immaturity*, 12 STAN. L. REV. 5, 11 (1959) (“[T]he reported decisions involving problems of allocation [of the burden of proof] rarely contain any satisfying disclosure of the *ratio decidendi*. Implicit, however, seem to be considerations of policy, fairness and probability.”) (footnote omitted).

281. Daniel A. Crane, *Patent Pools, RAND Commitments, and the Problematics of Price Discrimination*, in *WORKING WITHIN THE BOUNDARIES OF INTELLECTUAL PROPERTY: INNOVATION POLICY FOR THE KNOWLEDGE SOCIETY* 371, 392 (Rochelle C. Dreyfuss et al. eds., 2010).

VI. POTENTIAL OBJECTIONS TO THIS APPROACH

A. The Legislative History & “Apportionment”

It may be argued that this approach would, in practice, revive the “apportionment” that the 45th Congress sought to eliminate when it passed the 1887 Act.²⁸² However, this historical approach “would not ‘restitute the apportionment rule from the Dobson cases.’”²⁸³ It is true that the 45th Congress was concerned about “apportionment,” but only in one particular sense. Namely, Congress wanted to spare design patent owners from having to apportion “between the profits attributable to the design itself and those attributable to the ‘intrinsic merits of quality and structure’ of *the article itself*.”²⁸⁴ Nothing in the approach proposed here would require that sort of apportionment. To the contrary, by following the historical meaning of “article of manufacture,” this approach would most clearly match the application of the special design patent remedy at the time it was enacted.²⁸⁵

B. The Supreme Court’s Decision in Samsung

1. The Meaning of “Article of Manufacture”

It may be argued that adopting the historical meaning of “article of manufacture” would conflict with the Supreme Court’s decision in *Samsung*. The Court did note that “[t]he term ‘article of manufacture,’ as used in § 289, encompasses both a product sold to a consumer and a component of that product.”²⁸⁶ However, the Court did not state, let alone hold, that anything that could colloquially be referred to as a “component” must also be considered an “article of manufacture.” It is also true that, after reviewing several dictionaries, the Court said that “[a]n article of manufacture . . . is simply a thing made by hand or machine.”²⁸⁷ This may seem, at first glance, to require that machines be

282. Cf. Janice M. Mueller, *Essay: The Supreme Court Reinstates Apportionment of Design Patent Infringers’ Total Profits for Multicomponent Products*, in 2 MUELLER ON PATENT LAW § 23.04[B] (forthcoming 2017) (manuscript at 1) (arguing that the Supreme Court “re-institute[d] apportionment” by recognizing that a component can be an article of manufacture”); Janis S. Ct. Br. *supra* note 104, at 27 (arguing “that Congress slammed the door on apportionment by using the term ‘total’”); *id.* at 26 (“The Phrase ‘Article of Manufacture’ Does Not Authorize a Back-Door, Quasi-Apportionment Analysis.”).

283. Burstein, *1887*, *supra* note 14, at 78 (quoting Janis S. Ct. Br. *supra* note 104, at 8). For more on the *Dobson* cases and Congress’ response, see *id.* at 52–59.

284. *Id.* at 78.

285. See *id.* at 67–76.

286. *Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429, 434 (2016).

287. *Id.* at 435.

considered “articles of manufacture.”²⁸⁸ However, the Court was not presented with, and therefore had no occasion to decide, the *expressio unius* issue. In any case, the Court was not necessarily stating a comprehensive, final definition of “article of manufacture.” To the contrary, the Court emphasized that: “The only question we resolve today is whether, in the case of a multicomponent product, the relevant ‘article of manufacture’ *must always be the end product* sold to the consumer *or whether it can also be a component* of that product.”²⁸⁹ The Court held that “the term ‘article of manufacture’ is broad enough to embrace both a product sold to a consumer and a component of that product, whether sold separately or not. Thus, reading ‘article of manufacture’ in § 289 to cover only an end product sold to a consumer gives too narrow a meaning to the phrase.”²⁹⁰ Accordingly, the definition proposed here would not conflict with the Court’s holding in *Samsung*.²⁹¹

2. The Effect of this Approach

It may also be argued that this approach would conflict with *Samsung* in a different way. On remand from the Supreme Court, *Samsung* argued:

288. This statement might also seem to include fragments, broken pieces, or other items that are not complete enough to be used or sold separately. However, that issue was not before the Court.

289. *Id.* at 434 (emphasis added).

290. *Id.* at 436; *see also id.* at 432 (“the Federal Circuit identified the entire smartphone as the only permissible ‘article of manufacture’ . . . because consumers could not separately purchase components of the smartphones. The question before us is whether that reading is consistent with § 289. We hold that it is not.”). Unfortunately, the word “component” itself is not particularly helpful in answering any of the questions raised by the Court in *Samsung*. As used in common parlance, “component” can refer to “any part of a larger whole,” including intangible characteristics and incomplete fragments of the whole. *See* Burstein, 1887, *supra* note 14, at 66–67. Additionally, while the word “component” is not used in § 289, it *is* used in other provisions of the Patent Act. *E.g.*, 35 U.S.C. § 271(c) (2012). If the test for what constitutes an “article of manufacture” under § 289 devolves into a test about the meaning of the word “component,” that could result in significant confusion — especially if, as seems likely, the term is interpreted to mean something different in § 289 than it does in the context of § 271. For these reasons, lower courts should be careful in how, if at all, they use the word “component” in formulating a test for *Samsung* step one. Ideally, courts should avoid the word “component” altogether in defining or discussing the statutory phrase “article of manufacture.” It is true that the Supreme Court talked about “components” in *Samsung*. But nothing in the Court’s decision requires that the “article of manufacture” inquiry revolve around the word “component.” At most, the Court’s discussion of “components” should be viewed as a response to the way the parties framed the issues in that case. The best way to read *Samsung* is to assume that, where the Court said “component,” it was referring to an “article of manufacture” that is incorporated into a larger product.

291. Some might argue that the Court’s holding means that every “product sold to a consumer” must be considered an “article of manufacture” even though it might not be the “relevant” article in a given case. *See Samsung*, 137 S. Ct. at 436. But the Court did not say, let alone suggest, such a thing. And the word “relevant” does not suggest, let alone require, a qualitative inquiry. The Court merely used “the relevant article” as shorthand for the article to which a design is applied. *See supra* note 6.

The relevant article of manufacture does not include any part, portion, or component of a product that is disclaimed by the patent or that does not correspond to the claimed attributes of the patented design, including any part, portion, or component of a product that is not considered when determining infringement.²⁹²

Judge Koh rejected this argument.²⁹³ According to Judge Koh, “Samsung’s test is not consistent with the U.S. Supreme Court’s decision, which left open the possibility that a multicomponent product could be the relevant article of manufacture.”²⁹⁴ Judge Koh appears to have read the Supreme Court’s decision as contemplating that, where the infringing product is a multicomponent product, it must be possible for the patent owner to sometimes recover the “total profits” from that entire multicomponent product, regardless of what the patent-in-suit actually claims.²⁹⁵ But the Supreme Court said no such thing.

In *Samsung*, the Court rejected the Federal Circuit’s conclusion that the entire end product was *always* the relevant article, regardless of what the patent claimed.²⁹⁶ But the Court never said that the claim scope was irrelevant to the “article of manufacture” determination.²⁹⁷ And it certainly never said that, in cases where a design patent covers only a component of a larger product, it must still be possible for the design patent owner to recover the “total profits” from the larger product.²⁹⁸ Accordingly, the approach proposed here does not conflict with the Supreme Court’s decision in *Samsung*.

292. Samsung’s Opening Brief Pursuant to Order of July 28, 2017 Regarding Necessity of New Trial on Design-Patent Damages at 3, *Apple Inc. v. Samsung Elecs. Co.*, No. 5:11-cv-01846 (N.D. Cal. Set. 8, 2017), ECF No. 3521 [hereinafter “Samsung Remand Brief”].

293. Apple Retrieval Order, *supra* note 9, at 9–10.

294. *Id.* at 10.

295. *See id.* at 9 (“Logically, if the patent holder is only sometimes entitled to the infringer’s total profit from a component of the end product, then the patent holder is also sometimes entitled to the infringer’s total profit on the entire end product.”) (referring to *Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429, 434 (2016)).

296. *Samsung*, 137 S. Ct. at 434.

297. *See id.* at 432–36.

298. It is true that, as Judge Koh noted, “the U.S. Supreme Court did not adopt a per se rule that the relevant article of manufacture in a multicomponent product is *always* only a component.” Apple Retrieval Order, *supra* note 9, at 9. But the Court specifically refused to pick *any* rule for identifying the relevant article. *Samsung*, 137 S. Ct. at 436. If the logic here is that any test the Court could have adopted, but did not, was implicitly rejected, that would be hard to reconcile with Judge Koh’s ultimate conclusion the test proposed by the Government to the Supreme Court “best embody the relevant [§ 289] inquiry.” Apple Retrieval Order, *supra* note 9, at 12.

C. The Interplay with Statutory Subject Matter

It may also be argued that readopting the historical meaning of the phrase “article of manufacture” for the purposes of § 289 would lead to an undue constriction of statutory subject matter under § 171. That provision provides that:

Whoever invents any new, original and ornamental design for an *article of manufacture* may obtain a patent therefor, subject to the conditions and requirements of this title.²⁹⁹

There does not seem to be any good reason to interpret the phrase “article of manufacture” differently in § 289 than in § 171.³⁰⁰ Therefore, if the historical meaning of “article of manufacture” is adopted for the purposes of § 289, it should also be adopted for the purposes of § 171. So it is true that the adoption of this proposal would lead to a constriction of statutory subject matter, as compared to the current “anything goes” regime — whether or not courts go along with the “machine” part.³⁰¹ But that is not necessarily a bad thing. Many of the decisions that laid the groundwork for the current statutory subject matter rules rest on unsound reasoning.³⁰² It may well be time to reevaluate them.³⁰³

D. The Problem of Overcompensation

It may be argued that this approach will still result in the overcompensation of some design patent owners. It admittedly will. For example, consider this recently-asserted design patent, entitled “Electronic Device Case with Cut-Out Having Asymmetric Corners”:³⁰⁴

299. 35 U.S.C. § 171(a) (Supp. I 2013) (emphasis added).

300. Indeed, “neither the text of the 1887 Act nor its legislative history provide any indication that Congress intended the phrase “article of manufacture” to mean something different in the new remedy provision than it did in the existing subject-matter provision.” Burstein, 1887, *supra* note 14, at 60.

301. For more on the “machine” issue, see *supra* note 206 and accompanying text. For more on the current regime, see *supra* Section II.A.

302. For example, in *Hruby*, “the CCPA did not mention any of the prior judicial or administrative interpretations of the phrase ‘article of manufacture.’” Burstein, 1887, *supra* note 14, at 13 (discussing *In re Hruby*, 373 F.2d 997 (C.C.P.A. 1967)). See also *supra* note 229 (discussing some of the questionable reasoning in *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980)).

303. Moreover, even if the concept of what constitutes an “article of manufacture” is narrowed, that still leaves open the question of what constitutes a “design for” an article. See 35 U.S.C. § 171(a) (Supp. I 2013). That is another issue that deserves much more scrutiny and study; however, a full discussion of that issue is beyond the scope of this Article.

304. U.S. Patent No. D728,550 figs.4–7 (issued May 5, 2015) (replacement drawings as filed May 6, 2014, available on Public PAIR). See also Complaint, *Case-Mate, Inc. v. Velvet*

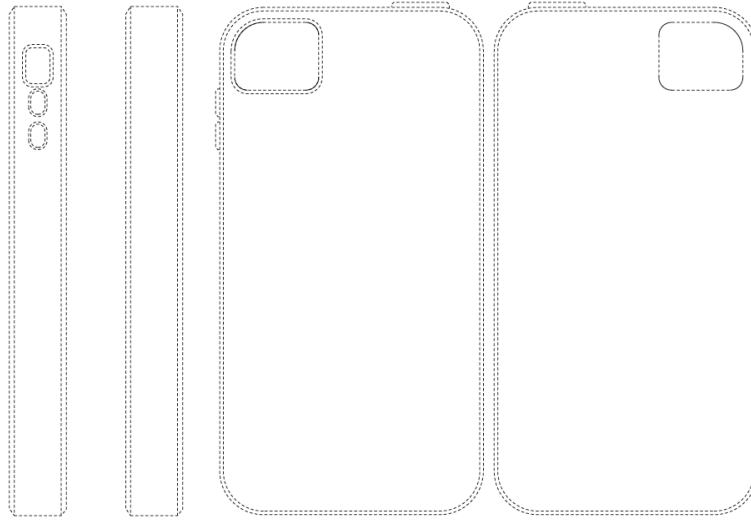


Figure 5: U.S. Patent No. D728,550

Only the parts in solid lines are claimed.³⁰⁵ Therefore, the patent is only claiming the shape and arrangement of the corners of the camera hole of a smartphone case.³⁰⁶ If an infringer sells an infringing smartphone case, the case would be the relevant article. But the patentee’s contribution to the overall design of a smartphone case is — by any reasonable measure — miniscule. Users likely don’t care about, or purchase smartphone cases based upon, the shape of the corners of the camera holes. Nonetheless, under the approach proposed here, the patentee would be entitled to the “total profits” from any infringing phone cases — a windfall if there ever were one.³⁰⁷

But the problem isn’t the method used to identify the relevant article. The problem is that the very concept of what constitutes a protectable “design” has changed dramatically since 1887.³⁰⁸ Today, a design patent applicant can claim a “design” for the configuration or surface ornamentation of only a fragment of an article — *i.e.*, a part of an article

Caviar Group, Inc., No. 2:18-cv-00238 (E.D.N.Y. Jan. 12, 2018), ECF No. 1 (alleging infringement of this design patent, among other claims).

305. See MPEP, *supra* note 22, § 1503.01(III) (“Full lines in the drawing show the claimed design.”).

306. The patentee describes the claimed design as follows: “The claimed design comprises only four corner segments of the edge defined by the intersection of the rear panel interior surface with the beveled surface of the aperture of the case. No surfaces are claimed. The broken lines depict unclaimed portions of the electronic device case.” U.S. Patent No. D728,550 at Description.

307. It is worth asking whether this type of design should, in fact, be considered design patentable subject matter. But that issue is beyond the scope of this Article.

308. See *supra* Section II.A.

that isn’t manufactured (and cannot be sold) separately.³⁰⁹ In these instances of fragment claiming, the approach proposed by this Article will, admittedly, result in a windfall to the patent owner.³¹⁰ But at least the windfall would be predictable. Indeed, the potential for such a windfall might prompt courts and juries to take the issues of validity and ornamentality more seriously with respect to fragment claiming.³¹¹ Perhaps it could even spur legislative or doctrinal changes to the current understanding of what constitutes a patentable “design.” But as long as our system allows fragment claiming, this type of problem will persist.

But no rule for *Samsung* step one, no matter how carefully formulated, should be expected to fix all of the problems in the contemporary design patent system. And such attempts might have unintended consequences. For example, it could be argued that the “article of manufacture” is whatever portion (or portions) of an article that the claimed design is applied to.³¹² If a design patent claims a design for the configuration of a fragment of an article — as opposed for the entire article — that would ameliorate the problem of overcompensation in “total profits” awards. But such an approach could cause problems in the context of statutory subject matter. If the “article of manufacture” were deemed to be whatever part of whatever item the applicant wishes their claim to cover, that would only further lock in and legitimize the USPTO’s

309. *See id.* And, to make matters worse, the patentee can do so after the competitor has launched what would otherwise be a non-infringing design-around. *See supra* Section II.B. It may be that design patent law would benefit from having a rule that limits the “total profits” remedy to situations where the infringement began *after* a particular design was patented. *Cf.* 17 U.S.C. § 412 (limiting the availability of statutory damages and fees in copyright based on the date of registration). Thus, the remedy would be limited to situations where the infringer had constructive notice of the design patent claim. However, a full discussion of that issue is beyond the scope of this Article.

310. Of course, some may argue that, if the claimed part is sufficiently important to the appearance of the article as a whole, awarding the profits for the whole would not result in a windfall. But there is no requirement that, when a design patent applicant claims a design for only part of a product or article, that part be “an important, distinctive or otherwise salient design feature” of the product or article as a whole. *See* Burstein, *Costly Designs*, *supra* note 1, at 116. So it would be wrong to assume that all — or even most — of these claims do, in fact, cover important parts of a product or article’s overall design. And, in any case, patentees are still entitled to seek “entire market value” damages under 35 U.S.C. § 284. So there is no need to warp § 289 to account for this possibility. *See supra* note 211.

311. At least in theory, these types of broad claims should be easier to invalidate. In practice, the Federal Circuit has made it very difficult for courts to invalidate — and the USPTO to reject — design patent claims. *See* Burstein, *Costly Designs*, *supra* note 1, at 139–40. Perhaps this proposed rule could put new pressure on the Federal Circuit to take validity seriously.

312. *See Samsung Remand Brief*, *supra* note 292, at 3. Some may argue that *Zahn* already defined “article of manufacture” in this manner. *See* Burstein, *1887*, *supra* note 14, at 13 (noting that “some commentators have read *Zahn* as redefining ‘article of manufacture’ to include ‘part of an article’”) (discussing *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980)). However, *Zahn* is best understood as a case about what it means to be a patentable “design,” not about what it means to be an “article of manufacture.” *See id.* at 9, 9 n.42 (noting that *Zahn* radically redefined the statutory term “design”).

current *laissez-faire* rules for fragment claiming.³¹³ And there may be very good policy reasons to avoid such a result.³¹⁴ It would, thus, be better to address separate problems with design patent law and practice separately.

VII. CONCLUSION

For the reasons discussed above, the Federal Circuit (and if it comes to it, the Supreme Court) should not adopt the approach proposed by the Government in *Samsung v. Apple*.³¹⁵ Instead, the relevant article of manufacture should be determined in light of the nature and scope of the claimed design. For a design patent claiming a design for surface ornamentation, the relevant article should be deemed to be whatever article the design was printed, painted, cast, or otherwise placed on or worked into.³¹⁶ For a design patent that claims a design for a configuration or a combination design, the relevant article should be deemed to be the article whose shape is dictated by the claimed design.³¹⁷

In conducting this inquiry, this phrase “article of manufacture” should be interpreted according to its historical meaning. It should be interpreted to refer to a tangible item made by humans that has a unitary structure and is complete in itself for use or for sale and does not also qualify as a “machine” or a “composition of matter.”³¹⁸ Even if courts feel compelled to include machines in the category of “articles of manufacture,”³¹⁹ courts should treat the exterior housings or shells of machines as the relevant articles because these items are manufactured and could be sold separately.³²⁰ Importantly, this was not and should not be a dispute-specific inquiry. The relevant question is not whether the plaintiff or defendant in a particular infringement action actually man-

313. For more on the USPTO’s current rules, see *supra* Section II.B.

314. While a full discussion of these issues is beyond the scope of this Article, the CCPA’s decision in *Zahn*, which heralded in the era of fragment claiming, was ill-reasoned and has led to a number of practical and legal problems. So it would be well worth reevaluating it in the future.

315. See *supra* Part IV.

316. See *supra* notes 217–224 and accompanying text.

317. See *supra* note 226 and accompanying text.

318. Burstein, 1887, *supra* note 14, at 5.

319. See *supra* notes 206–210 and accompanying text.

320. See generally *Simpson v. Davis*, 12 F. 144, 145–46 (C.C.E.D.N.Y. 1882); *Pullman Couch Co., Inc. v. Union*, 39 U.S.P.Q. 100 (D. Md. 1938) (indicating a furniture post that was “produced separate and distinct from the complete article of furniture” could be a separate “article of manufacture” even though it was “not sold, and can not profitably be sold, as a separate article” in commerce).

ufactures, uses, or sells the item to which the design is applied separately. The relevant question is whether *anyone* manufactures, uses, or sells that kind of item separately.³²¹

Additionally, the determination of what constitutes the relevant article should be deemed an issue of law.³²² In that case, there would be no need to allocate the burden of proof.³²³ But if courts determine this is an issue of fact, the burden of proof should be placed on the patent owner.³²⁴ In either case, this proposed approach would allow for pre-trial determination of the “article of manufacture” issue, perhaps in something like a *Markman* hearing. Such an approach would lower litigation costs for both sides.

Unlike other proposed approaches, this approach is based in and faithful to the text of the Patent Act. It is also faithful to the history and original intent behind the Act of 1887. This interpretation will result in awards that correspond better to the designer’s actual contribution by focusing on what the designer actually designed, not on what the defendant makes or how the defendant chooses to manufacture his products.

Again, this Article is not arguing that § 289 represents a first-best rule for design patent damages.³²⁵ Nor is it arguing that courts should adopt the original meaning of “article of manufacture” simply because it is the original meaning. But looking to that original meaning and using history as a guide would result in a workable solution that would, on the whole, produce better outcomes at a lower price, as compared to the approaches adopted so far by the district courts.

321. *See supra* note 195 and accompanying text.

322. *See supra* Section V.B.

323. *See supra* Section V.C.

324. *Id.*

325. For more on the concept of the “first-best,” see for example Lawrence B. Solum, *Constitutional Possibilities*, 83 IND. L.J. 307, 311 (2008).