
2022

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**THE PATENTABILITY OF SEPARABILITY:
DESIGNING A TEST FOR “ARTICLE OF
MANUFACTURE” IDENTIFICATION IN
SECTION 289 OF THE PATENT ACT**

Samantha M. Wald*

The U.S. Supreme Court’s decision in Samsung Electronics v. Apple Inc. regarding the meaning of the term “article of manufacture” in Section 289 of the Patent Act neglects to resolve foundational distinctions in the protected scope of multi-component devices. Cloaked in ambiguity, the Court’s brief and ostensibly limited opinion critically fails to demonstrate when the relevant “article of manufacture” should be treated as the whole commercial product or as some smaller unit; nor does it explain how to identify the relevant “article of manufacture” if it is less than the product as a whole. Instead, the Supreme Court’s dictionary-based definition of the term “article of manufacture” has unearthed more questions than answers, the most salient being how to identify the relevant “article of manufacture” and appropriate remedy for infringement of multifaceted products.

This Article attempts to do what the United States Supreme Court would not: it sets out a test for identifying the relevant “article of manufacture” at step one of the Section 289 damages inquiry. Finding inspiration in the copyright doctrine of separability, it advances a statutory framework, judiciously delineating a more standardized approach to “article of manufacture” identification in multi-component devices. Specifically, through the development of a “separability” test, this Article imposes a constructive foundation of statutory guidance that does not broadly capture or exclude all components of the claimed design. Instead, it proposes a workable standard that explicitly determines when the component of an invention, rather than the

* LL.M., Intellectual Property Law, The George Washington University Law School, 2022; J.D., Benjamin N. Cardozo School of Law, 2020; B.A., Mathematics, Syracuse University, 2017. A special thank you to my people—Monica, Steven, and Zachary—for being a constant source of support and inspiration, always and forever. Because of you, I am living my dream.

invention itself, should constitute the relevant “article of manufacture.” If implemented, this test would foster consistency in the practice of design patent law by establishing predictability through the furtherance of more precise guidelines.

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I. INTRODUCTION

The special disgorgement of profits remedy, codified in Section 289 of the Patent Act, and available exclusively for patentable designs, 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 The United States Supreme Court, in *Samsung Electronics Co. v. Apple Inc.*, announced a two-step test for “[a]rriving at a damages award under [Section] 289 . . . [:] 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.”² Unfortunately, however, while the Court maintained “that the ‘article of manufacture’ for which total profits are awarded under [Section] 289 [need] not necessarily [be] limited to the product that is sold to consumers, but may be either ‘a product sold to a consumer [or] a component of that product,’”³ it refused to “resolve whether . . . the relevant article of manufacture [in *Samsung*] [wa]s the smartphone[] or a particular smartphone component.”⁴ Nor would the Supreme Court “set out a test for identifying the relevant article of manufacture at the first step of the [Section] 289 damages inquiry.”⁵

Significantly, this fiercely contested, seven-year litigious battle—concerning the infringement of design patents for the first-generation iPhone—between Samsung Electronics and Apple Inc. fundamentally propelled design patent law back into the limelight after more than a century, occasioning the first United States Supreme Court decision on the matter in over one hundred and twenty-five years.⁶ However, while the Court’s momentous decision *should* have brought “clarity and common sense to modern-day design patent law, particularly as it relates to multi-component devices,” a salient question still remains: “namely, *how* to determine the *article of manufacture* and appropriate remedy for infringement of multifaceted products.”⁷ The U.S. Supreme Court purported to resolve this problem, albeit unsuccessfully, by focusing on

1. Patent Act, 35 U.S.C. § 289 (2020); see Sarah Burstein, *Costly Designs*, 77 OHIO ST. L.J. 107, 118 n.74 (2016) (“[Section] 289 does not apply to all acts of design patent infringement. . . . [I]t applies only to certain actions taken in the commercial context.”).

2. *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 59 (2016).

3. *Apple Inc. v. Samsung Elecs. Co.*, No. 11-CV-01846-LHK, 2017 U.S. Dist. LEXIS 119149, at *56 (N.D. Cal. July 28, 2017) (alteration in original) (quoting *Samsung Elecs. Co.*, 580 U.S. at 60).

4. *Samsung Elecs. Co.*, 580 U.S. at 62.

5. *Id.*

6. See Courtland Reichman & Bahrad Sokhansanj, *Samsung V. Apple: Impacts Beyond Damages*, LAW360 (Dec. 11, 2016, 10:33 PM), <https://www.law360.com/articles/866580/samsung-v-apple-impacts-beyond-damages>; see also Tracy-Gene G. Durkin, *The Design Patent Case of the Century*, STERNE KESSLER (July 2016), <https://www.sterneessler.com/news-insights/publications/design-patent-case-century> [https://perma.cc/5PHC-XTA6].

7. G Nagesh Rao, *Apple v. Samsung Retrial: An Opportunity to Finally Clarify Design Patent Law*, IPWATCHDOG (May 11, 2018, 7:15 AM), <https://www.ipwatchdog.com/2018/05/11/apple-v-samsung-retrial-clarify-design-patent-law/id=97031/> [https://perma.cc/9H3Y-F7RK].

the definition and scope of the term “article of manufacture.”⁸ Instead, the Supreme Court’s brief and ostensibly limited opinion—which neither establishes “when courts should treat the relevant article of manufacture as the commercial product or as some smaller unit,” nor explains “how one should identify the relevant article if it is less than the product as a whole”⁹—has necessarily “unearthed foundational conflicts in the scope of design patent claims.”¹⁰

The United States Supreme Court’s exceedingly broad, perhaps overly simplified, reading of the term “article of manufacture” critically fails to demonstrate when the relevant “article of manufacture” should be treated as the whole commercial product or as some smaller component thereof; nor does it identify how to categorically ascertain the relevant “article of manufacture” if it is less than the product as a whole. Absent a more definitive framework, the standard for determining the relevant “article of manufacture,” as articulated by the Court, will continue to sow confusion, “[f]or while [it is] true that not all articles of manufacture are complete commercial products, neither should all components be considered articles of manufacture.”¹¹

This Article attempts to do what the United States Supreme Court would not: it “set[s] out a test for identifying the relevant article of manufacture at the first step of the [Section] 289 damages inquiry.”¹² It argues that, in determining a more appropriate “article of manufacture” framework in Section 289 of the Patent Act, the courts should, to the extent possible, adopt a definition of “article of manufacture” that more closely mirrors the statutory term’s original meaning. In 1887, when Congress first enacted the special “total profits” remedy for design patent law, “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.”¹³ Accordingly, this Article develops a more standardized test for “article of manufacture” identification at step one of the Section 289 damages inquiry that, like the statutory phrase’s early definition, does

8. See Mark McKenna, *Designing Design Patent Subject Matter*, JOTWELL (Mar. 22, 2018), <https://ip.jotwell.com/designing-design-patent-subject-matter/> [<https://perma.cc/Q8H3-GVG8>] (reviewing Sarah Burstein, *The “Article of Manufacture” in 1887*, 32 BERKELEY TECH. L.J. 1 (2017), https://bitlj.org/data/articles2017/vol32/32_1/burstein_web.pdf [<https://perma.cc/LZM9-AGXW>]).

9. *Id.*

10. Reichman & Sokhansanj, *supra* note 6 (examining the inconsistencies “lurking under the terse logic of *Samsung*”).

11. McKenna, *supra* note 8.

12. *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 62 (2016).

13. Burstein, *supra* note 8, at 5.

not broadly capture or exclude all components, but instead fundamentally delineates when the component of an invention, rather than the invention itself, constitutes the relevant “article of manufacture.” Specifically, it proposes an unambiguous statutory framework that explicitly recognizes that only those components that are physically separable from the whole commercial product, and which may be “identifi[ed] as discrete parts (even if ultimately combined into a bigger commercial product),” will be considered the relevant “article of manufacture” in a multi-component device.¹⁴ Moreover, finding inspiration in the copyright doctrine of separability, this comprehensive legal approach to “article of manufacture” identification advances a more constructive foundation of statutory guidance. It establishes a workable standard for distinguishing the components of a claimed design that constitute the relevant “article of manufacture” from those that are merely incorporated features of the commercial product itself. If adopted, this modern separability framework to design patent law would provide predictability through the furtherance of more precise guidelines, and thereby foster consistency in the practice of design patent law.

To clarify, this Article does not suggest that the courts should necessarily readopt the 1887 definition of the phrase “article of manufacture,” but argues only that, in formulating an appropriate test for “article of manufacture” identification in Section 289 of the Patent Act, the statutory term’s historical context has significant implications that may be consequential to the development of this modern framework. Nor does this Article argue that the United States Supreme Court’s dictionary-based interpretation of the scope of the term “article of manufacture” is patently incorrect. Instead, it merely contends that, based on the historical evidence, which demonstrates that the “article of manufacture” in 1887 did not simply mean any “thing made by hand or machine,”¹⁵ the Supreme Court’s definition of the statutory phrase, without more, is too broad to effectuate any meaningful legal guidance. Finally, while this Article *does* attempt to resolve the issue of how the courts should identify the relevant “article of manufacture” at step one of the Section 289 damages inquiry, it *does not* address the merits of the United States government’s proposed test.

This Article proceeds in five parts. Part II provides a brief introduction to the relevant fundamental principles of U.S. design patent law. Part III carefully examines the highly contentious, seven-year legal

14. McKenna, *supra* note 8.

15. *Samsung Elecs. Co.*, 580 U.S. at 60.

battle between Apple and Samsung. Particular attention will be paid to the United States Supreme Court's focus on the meaning of the term "article of manufacture," within the framework of Section 289, to determine how the statutory term of art is defined today. Part IV explores what the phrase "article of manufacture" meant in 1887, when Congress first enacted the "total profits" remedy and considers the legislative history surrounding the statutory term's early interpretation. Part V offers a rudimentary understanding of the relevant policies and practices of U.S. copyright law central to this discussion, which have largely influenced the new legal framework subsequently proposed herein. Lastly, Part VI explains why the Supreme Court's broad, dictionary-based definition of the term "article of manufacture," standing alone, fails to resolve critical foundational distinctions in the protected scope of multi-component devices. This Section then advances a potential blueprint for design patent law's future success in achieving a more systematic approach to "article of manufacture" identification in Section 289 of the Patent Act. Finally, after applying this new, categorical test to an assortment of patentable designs, this Section reviews certain benefits associated with, and potentially stemming from, the courts' adoption of a more comprehensive legal framework for determining the relevant "article of manufacture" under the special "total profits" remedy provision.

II. BACKGROUND

The federal patent laws offer a meaningful form of protection, by way of design patents, for "any new, original[,] and ornamental design for an article of manufacture."¹⁶ Design patent protection extends to "the non-functional aspects of an ornamental design as shown in a patent."¹⁷ Therefore, because "a design is manifested in appearance," the subject matter of a patentable design may comprise "the configuration or shape of an article, . . . the surface ornamentation applied to an article, or . . . the combination of configuration and surface ornamentation."¹⁸ Simply

16. 35 U.S.C. § 171(a); see *Samsung Elecs. Co.*, 580 U.S. at 55-56 ("The . . . patent laws have long permitted those who invent designs for manufactured articles to patent their designs.").

17. *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993) (citing *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188-89 (Fed. Cir. 1988)).

18. See EDWARD LEE ET AL., *THE LAW OF DESIGN: DESIGN PATENT, TRADEMARK, & COPYRIGHT—PROBLEMS, CASES, AND MATERIALS* 46 (2017); see also 8 DONALD S. CHISUM, *CHISUM ON PATENTS* § 23.01 (2021); see also U.S. DEP'T OF COMMERCE, PATENT & TRADEMARK OFFICE, *MANUAL OF PATENT EXAMINING PROCEDURE* § 1504.01 (9th ed. Rev. 8, Jan. 2018) [hereinafter MPEP].

put, the protection afforded by a design patent is limited exclusively to the way an article looks; it does not extend to how that article works or the way it is used.¹⁹

A. Requirements for Patentability

“A design, consisting of the configuration or surface ornamentation of an article of manufacture, may be eligible for patenting only if it satisfies the necessary prerequisites for design patentability: novelty, nonobviousness, ornamentality, and definiteness.”²⁰

1. The Novelty Requirement of the Patent Act

The novelty requirement, codified in Section 171 of the Patent Act, dictates that, for the features of a claimed design to be patentable, it must first be “new.”²¹ Consequently, because “[a] design is patentable for its appearance,” the patentable novelty of a particular “design resides in the novelty of appearance, and is measured by exhibiting and contemplating the appearances of compared designs.”²² A design is deemed to exhibit the requisite novelty under this comparative test of appearances “[i]f the general or ensemble appearance-effect of a design is different from that

19. Unlike utility patents, which safeguard the functional and mechanical aspects of the invention, design patents protect the visual appearance of a useful article. *See* LEE ET AL., *supra* note 18, at 58; *see also* 8 CHISUM, *supra* note 18, § 23.01 (“A design patent fundamentally differs from a utility patent.”); *see also* MPEP, *supra* note 18, a§ 1502.01 (“[A] ‘utility patent’ protects the way an article is used and works . . . , while a ‘design patent’ protects the way an article looks”). Significantly, design patent protection is restricted only to the exterior of a product and does not insulate its function, structure, or inner workings from potential infringement. *See* Gene Quinn, *Design Patents: The Under Utilized and Overlooked Patent*, IPWATCHDOG (Sept. 10, 2016), <http://www.ipwatchdog.com/2016/09/10/design-patents/id=72714/> [<https://perma.cc/N5WH-YCHM>] (“Design patents do NOT protect an idea or an invention, but rather only protect [the] ornamental design of exactly what is pictured. . . . [T]he function, structure and interior workings of an invention [are the province of utility patents] . . .”).

20. Samantha M. Wald, Note, *Siri, Define “Article of Manufacture”*: Redesigning the Definition of “Article of Manufacture” in Section 289 of the Patent Act, 38 CARDOZO ARTS & ENT. L.J. 569, 574 (2020), <https://cardozoelj.com/siri-define-article-of-manufacture-redefining-the-definition-of-article-of-manufacture-in-section-289-of-the-patent-act/>; *see* MPEP, *supra* note 18, § 1504; *see also* 8 CHISUM, *supra* note 18, § 23.03; *see also* LEE ET AL., *supra* note 18, at 46. “The inventive novelty or unobviousness resides in the ornamental shape or configuration of the article in which the design is embodied or the surface ornamentation which is applied to or embodied in the design.” MPEP, *supra* note 18, § 1504. The definiteness requirement, codified in Section 112(b) of the Patent Act, necessitates that a claimed design “ ‘ particularly point out and distinctly claim the subject matter’ sought to be patented.” LEE ET AL., *supra* note 18, at 68 (quoting 35 U.S.C. § 112(b)).

21. *See* 35 U.S.C. § 171; *see also* 8 CHISUM, *supra* note 18, § 23.03(5).

22. WILLIAM D. SHOEMAKER, PATENTS FOR DESIGNS 76 (1929).

of others in the eyes of ordinary observers.”²³ The fundamental degree of difference necessary to establish the novelty requirement is satisfied “when the average observer takes the new design for a different, and not a modified already-existing, design.”²⁴ Therefore, to successfully determine the novelty of a given design, the overall appearance of the design itself must be observed in its entirety; it is immaterial “that any one feature of a design is old, or [that] all the features are old, . . . as the novelty can reside in the assemblage of [those] features, since it is the appearance as a whole, and the impression it makes on the eye which must be considered.”²⁵

If the ornamental features of a claimed design are not “new” but are instead substantially the same as an earlier design, the earlier design constitutes a prior art reference that anticipates the appearance of the subsequently claimed design.²⁶ That is, where a single prior-art reference “discloses each and every limitation of the relevant patent claim . . . in a manner that . . . sufficiently enables others to reproduce and use the claimed [design],” the claimed design “is said to be ‘anticipated’ by that reference and thus to lack novelty.”²⁷ However, where “no individual prior-art reference discloses all limitations of the relevant patent claim,” the ornamental features of the claimed design are “considered to satisfy patent law’s novelty requirement,” regardless of “how seemingly trivial the difference between the claimed [design] and any individual prior-art disclosure.”²⁸

2. *The Nonobviousness Requirement of the Patent Act*

“The nonobviousness requirement fundamentally considers the seemingly trivial differences between a claimed design and any individual prior art disclosure to determine whether the design is

23. *Id.*

24. *Id.*; see 35 U.S.C. § 102 (Supp. 2019).

25. SHOEMAKER, *supra* note 22, at 77.

26. *See id.* at 99.

27. JOHN M. GOLDEN ET AL., PRINCIPLES OF PATENT LAW: CASES AND MATERIALS 181 (7th ed. 2018) (“The identity requirement for anticipation is . . . strict.”); *see* Schering Corp. v. Geneva Pharm., Inc., 339 F.3d 1373, 1377 (Fed. Cir. 2003) (“A patent is invalid for anticipation [under 35 U.S.C. § 102] if a single prior art reference discloses each and every limitation of the claimed invention.”). “However, in some instances, where the ornamental feature of a claimed design is necessarily present, or inherent, in the single prior-art reference, that reference may anticipate without disclosing that feature.” Wald, *supra* note 20, at 575 n.29; *see* Allergan, Inc. v. Apotex Inc., 754 F.3d 952, 958 (Fed. Cir. 2014) (“Anticipation is a question of fact that we review for clear error.”).

28. GOLDEN ET AL., *supra* note 27, at 181.

sufficient to establish patentability.”²⁹ Specifically, because “[p]atentability is to depend . . . upon the ‘non-obvious’ nature of the ‘subject matter sought to be patented’ to a person having ordinary skill in the pertinent art,”³⁰ the patentability of a claimed design will be negated under Section 103 of the Patent Act when “the differences between [the] claimed [design] and the prior art are such that the claimed [design] as a whole would have been obvious before [its] effective filing date . . . to a person having ordinary skill in the art to which the claimed [design] pertains.”³¹ However, while the nonobviousness requirement necessitates that the ornamental features of a claimed design be significantly different from those of the prior art to maintain patentability, it does not demand that they be intrinsically better.³² Therefore, “in determining the nonobviousness of [novel] designs under [Section 103 of the Patent Act], . . . ‘[the] test is inherently . . . visual . . . , for the design is nothing more than appearance, and the appearance is that of the article as a whole.’”³³

3. Ornamentality vs. Functionality

“An ornamental design, within the framework of design patent law, must present, by means of lines, images, configuration, and the like, taken as a whole, an aesthetically pleasing appearance that is not dictated solely by functional considerations.”³⁴ To be ornamental, the design must be “one which was ‘created for the purpose of ornamenting;’” it cannot merely be “the result or ‘. . . by-product’ of functional or mechanical considerations.”³⁵ That is, where the overall appearance of a particular design serves an intrinsically functional purpose, the design is not primarily ornamental, but is instead “dictated by” its function, and, as such, is therefore not entitled to design patent protection.³⁶ Put

29. Wald, *supra* note 20, at 575-76; see GOLDEN ET AL., *supra* note 27, at 181.

30. *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966).

31. 35 U.S.C. § 103.

32. See GOLDEN ET AL., *supra* note 27, at 397.

33. *In re Zahn*, 617 F.2d 261, 270 (C.C.P.A. 1980) (Baldwin, J., dissenting) (quoting *In re Laverne*, 356 F.2d 1003, 1006 (C.C.P.A. 1966)).

34. Wald, *supra* note 20, at 576; see 8 CHISUM, *supra* note 18, § 23.01; see also *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989); but cf. *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 1567 (Fed. Cir. 1996) (Newman, J., dissenting).

35. MPEP, *supra* note 18, § 1504.01(c); see *Bonito Boats, Inc.*, 489 U.S. at 148; see also *Metrokane, Inc. v. Wine Enthusiast*, 185 F. Supp. 2d 321, 328 (S.D.N.Y. 2002) (“The design patent laws were established to encourage the decorative arts by providing temporally limited protection for meritorious ornamental designs.”).

36. See *Sports Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1320 (Fed. Cir. 2016) (“[A] design patent cannot claim a purely functional design—a design patent is invalid if its

differently, while function may influence the elements of a particular design, a design that is compelled *purely* by functional considerations is not protectable, as it falls beyond the limited scope of design patent law.³⁷ Thus, where the claimed design's exclusive "points of novelty or nonobviousness over [the] prior [art] are dictated [only] by functional improvement or alteration," the design is not subject to patentability.³⁸

There are two primary justifications for employing the rule on functionality in the design patent context:

First, where function dictates the configuration, there has been no ornamental creativity. Thus, the purpose of the design patent law to foster the "decorative arts" is not served by extending a monopoly on the design. Second, allowance of a design patent may grant in effect a monopoly on functional features that do[] not meet the normal requirements for a utility patent on a product or process.³⁹

Importantly, because the ornamentality requirement, codified in Section 171(a) of the Patent Act, mandates that, for a design to be patentable, its appearance, taken as a whole, must be primarily ornamental,⁴⁰ only those designs that are not "essential to the use of an article" are subject to design patent protection.⁴¹ A claimed design is deemed "essential to the use of an article when . . . [it] is 'dictated by' the use or purpose of the article."⁴² Accordingly, to effectively determine whether the overall appearance of a particular design is *primarily functional* or *primarily ornamental*, the claimed design must be examined in its entirety, "for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article."⁴³

A design will generally satisfy the statutory requirement of ornamentality unless: (1) the design is the only configuration that is fit to perform the particular purpose of the useful article,⁴⁴ i.e., "there are

overall appearance is 'dictated by' its function." (citing *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 668 (Fed. Cir. 2008))).

37. *Id.*

38. 8 CHISUM, *supra* note 18, § 23.03(4) ("A design need not meet the requirement of utility and indeed will not be patentable if its form is dictated solely by considerations of function.").

39. *Id.* (internal footnote omitted).

40. See MPEP, *supra* note 18, § 1504.01(c); see also *LEE ET AL.*, *supra* note 18, at 58; see also 8 CHISUM, *supra* note 18, § 23.03(2).

41. *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1328 (Fed. Cir. 2015).

42. *Id.*

43. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).

44. See *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002).

no alternative designs with ‘the same or similar functional capabilities,’ or (2) the design is concealed during the entire lifetime of the completed product.”⁴⁵ However, because there is “almost always [an] alternative design[] available,” and because virtually “every part of every product is visible to someone at some point during the product’s lifecycle,” these conditions for invalidity seldom materialize.⁴⁶

B. Definition of a Design

The claimed subject matter of a patentable design is limited to the visual qualities and ornamental characteristics embodied in or applied to a particular “article of manufacture.”⁴⁷ “Design is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation.”⁴⁸ Thus, to achieve patentability, the claimed design “must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method.”⁴⁹

C. Definition of the “Article of Manufacture”

While a design patent claims the aesthetic appearance and ornamental design of an “article of manufacture,”⁵⁰ the patent protection afforded to such a claimed design extends only insofar as that design is applied to or embodied in an the “article of manufacture.”⁵¹ Therefore, whereas “[a] picture standing alone is not patentable under . . . [Section] 171” of the Patent Act, a design that is applied to or embodied in an “article of manufacture” may be awarded protection.⁵² This qualifying language of application or embodiment thus “distinguishes statutory design subject matter from mere picture or ornamentation, *per se* (i.e.,

45. Burstein, *supra* note 8, at 7 (internal footnote omitted) (“These conditions rarely occur. . . . Therefore, the USPTO regularly grants . . . design patents for designs that are valuable solely for their utilitarian (as opposed to aesthetic) characteristics and for designs that are not intended to be seen by their end users.” (internal footnote omitted)).

46. *Id.*

47. See LEE ET AL., *supra* note 18, at 46; see also MPEP, *supra* note 18, § 1502.

48. MPEP, *supra* note 18, § 1502; see Quinn, *supra* note 19 (“A protectable design consists of the visual ornamental characteristics embodied in, or applied to, an article of manufacture. . . . A design for surface ornamentation is inseparable from the article to which it is applied and cannot exist alone. It must be a definite pattern of surface ornamentation, applied to an article of manufacture.”).

49. MPEP, *supra* note 18, § 1502.

50. See LEE ET AL., *supra* note 18, at 58 (“Design patents claim the appearance of an ‘article of manufacture.’ Unlike utility patents which cover the mechanical structures and functions of articles, design patents protect the visual look of an article.”).

51. See 8 CHISUM, *supra* note 18, § 23.03(2); see also MPEP, *supra* note 18, § 1504.01.

52. MPEP, *supra* note 18, § 1504.01.

abstract design).”⁵³ That is, to achieve patentability under Section 171 of the Patent Act, “the design must be shown as applied to or embodied in an article of manufacture”; otherwise, if the claim fails to demonstrate the design’s application to or embodiment in an “article of manufacture,” it must be rejected as directed to non-statutory subject matter.⁵⁴ Accordingly, understanding *what* the phrase “article of manufacture” means is fundamental to determining *how* design patentable subject matter is defined. A comprehensive analysis discussing the scope of the term “article of manufacture” is considered in further detail below.⁵⁵

D. Design Patent Specification and Claim

A design patent covers the specific design of an “article of manufacture,” as disclosed in the patented claims, “which invariably refer[s] to the appearance of what is illustrated in the patent’s drawings”;⁵⁶ that is, design patents cannot claim general concepts or ideas.⁵⁷ Accordingly, because full disclosure and definiteness of scope are achieved principally through drawings in a design patent application, pictorial depictions of the claimed design are fundamental to determining patentability.⁵⁸

While a design patent must be limited to a single claim, “that claim can refer to figures illustrating multiple embodiments.”⁵⁹ Additionally, where the asserted design comprises both functional and non-functional features, “the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”⁶⁰ “Therefore, because the scope of a patented design must always be limited to the design’s overall ornamental representation, as opposed to

53. *Id.*

54. *Id.*

55. See discussion *infra* Part III.

56. *Hoop v. Hoop*, 279 F.3d 1004, 1009 (Fed. Cir. 2002) (Lourie, J., dissenting); see LEE ET AL., *supra* note 18, at 49 (“The scope of design patents is determined by the claim, which in turn, references the figures.”). Within the legal framework of design patent law, the utilization of drawings in a design patent application is equivalent to the written descriptions of an invention in a claim for a utility patent. See *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013).

57. See 8 CHISUM, *supra* note 18, § 23.03(7); see also LEE ET AL., *supra* note 18, at 46.

58. See 8 CHISUM, *supra* note 18, § 23.01; see also LEE ET AL., *supra* note 18, at 49.

59. LEE ET AL., *supra* note 18, at 51; see 8 CHISUM, *supra* note 18, § 23.04(1).

60. *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (“[T]he[] functional characteristics [of a design] do not invalidate the design patent, but merely limit the scope of the protected subject matter.”).

broader general design conceptions, a proper interpretation of a patentee's claimed design centers on the visual impression it creates."⁶¹

1. Solid Lines vs. Broken Lines

The ornamental features of a claimed design are expressed through the depiction of solid lines in a drawing.⁶² Inversely, those features in the drawings of a design patent application that do not wish to be claimed are represented through the depiction of broken lines.⁶³ Broken lines are incorporated into a drawing for exclusively illustrative purposes, as they can furnish the context or environment for the claimed design.⁶⁴ More precisely, broken lines may be used to depict “[s]tructure[s] that [are] not part of the claimed design, but [that are] considered necessary to show the environment in which the design is associated”—i.e., “any portion of an article in which the design is embodied, or applied to, that is not considered part of the claimed design.”⁶⁵

E. Design Patent Infringement

A design patent is impermissibly infringed and subject to legal compensation when a party, acting without proper authority and/or permission, makes, uses, offers to sell, or sells any patented design during the effective lifetime of the patent therefor.⁶⁶ More precisely, “[w]hether a design patent is infringed is determined by first construing the claim to the design, when appropriate, and then comparing it to the design of the accused device.”⁶⁷ Thus, when contemplating a finding of design patent infringement, the threshold question is whether the accused article falls within the scope of the patented claim.⁶⁸ Most fundamental to this determination is an essential inquiry into the views of an ordinary observer—that is, whether,

61. Wald, *supra* note 20, at 579 (citing *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 104 (Fed. Cir. 1996)).

62. See LEE ET AL., *supra* note 18, at 49; see also MPEP, *supra* note 18, § 1503.02 (“The ornamental design which is being claimed must be shown in solid lines in the drawing.”).

63. See LEE ET AL., *supra* note 18, at 50 (“The basic rule is that [broken] lines are *not* part of the claimed design.”).

64. See *id.*

65. MPEP, *supra* note 18, § 1503.02 (“The two most common uses of broken lines are to disclose the environment related to the claimed design and to define the bounds of the claim.”).

66. See 35 U.S.C. § 271(a).

67. *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1404 (Fed. Cir. 1997); see *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

68. See LEE ET AL., *supra* note 18, at 107.

in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.⁶⁹

Moreover, because design patent infringement is a question of fact, the patent owner, bearing the burden of proof, must demonstrate by a preponderance of the evidence that the alleged infringement has occurred.⁷⁰

Accordingly, “[t]he comparison step of the infringement analysis requires the fact-finder to determine whether the patented design as a whole is substantially similar in appearance to the accused design.”⁷¹ However, to support a finding of infringement, these two designs need not be identical;⁷² minor differences between the patented design and the accused design “cannot, and shall not, prevent a finding of infringement.”⁷³ Additionally, because the availability of patent protection is limited exclusively to the novel, ornamental features of a design, only the non-functional aspects of the patented design are germane to determinations of infringement.⁷⁴ Thus, “[i]f . . . a design contains both functional and ornamental features, the patentee must show that the perceived similarity is based on the ornamental features of the design.”⁷⁵ That is, “[t]he patentee ‘must establish that an ordinary

69. *Gorham Co. v. White*, 81 U.S. 511, 528 (1872); see 8 CHISUM, *supra* note 18, § 23.01 (“An article infringes if it so resembles the patented design as to deceive the ordinary observer who gives such attention as a purchaser usually gives.”).

70. See *OddzOn Prods., Inc.*, 122 F.3d at 1405.

71. *Id.* (“It is the appearance of a design as a whole which is controlling in determining infringement.”); see LEE ET AL., *supra* note 18, at 107 (explaining that the ordinary observer test “focuses on the overall ornamental appearance of the claimed design, not [individual] ornamental features”); see also *Gorham Co.*, 81 U.S. at 525-26 (“A patent for a product is a distinct thing from a patent for the elements entering into it, or for the ingredients of which it is composed, or for the combination that causes it.”).

72. See *OddzOn Prods., Inc.*, 122 F.3d at 1405 (“The patented and accused designs do not have to be identical in order for design patent infringement to be found.”); see also *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 820 (Fed. Cir. 1992).

73. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984).

74. See *OddzOn Prods., Inc.*, 122 F.3d at 1405; see also *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988).

75. *OddzOn Prods., Inc.*, 122 F.3d at 1405; see *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1315 (Fed. Cir. 2015) (“After the functional aspects of the claimed designs are properly excluded from the infringement analysis, [the patentee must show that] the claimed ornamental designs are . . . [similar to] the ornamental design[s] of . . . [the] accused products.”).

person would be deceived by reason of the common features in the claimed and accused designs which are ornamental.’”⁷⁶

“[T]he ‘ordinary observer’ analysis is not limited to those features visible at the point of sale, but instead must encompass all ornamental features visible at any time during normal use of the product.”⁷⁷ Within the framework of design patent law, the term “normal use” has been construed to comprise “a period in the article’s life, beginning after completion of manufacture or assembly and ending with the ultimate destruction, loss, or disappearance of the article.”⁷⁸ Put differently, “the ‘ordinary observer’ analysis is not limited to those features visible during only one phase or portion of the normal use lifetime of an accused product. Instead, the comparison must extend to all ornamental features visible during normal use of the product”⁷⁹

E. Remedies for Design Patent Infringement

Where a valid design patent has been statutorily infringed, and the patent owner thereof is entitled to compensatory relief, an award of monetary damages, in the form of either lost profits or reasonable royalties and attorney fees, is certified under Sections 284 and 285 of the Patent Act,⁸⁰ which are supplemented by a special “total profits” remedy in Section 289.⁸¹ Alternatively, under Section 283 of the Patent Act, a design patentee may be granted injunctive relief, “in accordance with the principles of equity[,] to prevent the [further] violation of any right secured by [design] patent, on such terms as the court deems reasonable,” upon a finding of infringement.⁸² However, for specific acts of design patent infringement, the patentee also has available an

76. *OddzOn Prods., Inc.*, 122 F.3d at 1405 (quoting *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 825 (Fed. Cir. 1992)).

77. *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1381 (Fed. Cir. 2002).

78. *Id.* at 1379 (quoting *In re Webb*, 916 F.2d 1553, 1557-58 (Fed. Cir. 1990)).

79. *Id.* at 1380 (internal citation omitted).

80. See 35 U.S.C. §§ 284-285 (announcing the statutory requirements for awards of enhanced damages and attorney fees, respectively, in a patent infringement action); see also 8 CHISUM, *supra* note 18, § 23.05(1); see also *Bergstrom v. Sears, Roebuck & Co.*, 496 F. Supp. 476, 498 (D. Minn. 1980).

81. See 35 U.S.C. § 289; see also 8 CHISUM, *supra* note 18, § 23.05(1); see also *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1290 (Fed. Cir. 2002) (“A design patentee may recover damages under 35 U.S.C. § 284 or under 35 U.S.C. § 289”); see also *Schnadig Corp. v. Gaines Mfg. Co.*, 620 F.2d 1166, 1171 (6th Cir. 1980).

82. 35 U.S.C. § 283; see Sarah Burstein, *The “Article of Manufacture” Today*, 31 HARV. J.L. & TECH. 781, 788 (2018), <https://jolt.law.harvard.edu/assets/articlePDFs/v31/The-Article-of-Manufacture-Today-Sarah-Burstein.pdf> [<https://perma.cc/N66E-S4JD>]; see also *Bergstrom*, 496 F. Supp. at 498 (holding that “the plaintiff [was] entitled to injunctive relief under 35 U.S.C. § 283 to prevent further infringement”).

“additional remedy,” codified in Section 289, whereby the indemnification sought comprises the equitable disgorgement of profits—i.e., a measure of damages that compensates for the recovery of the infringer’s total profits earned.⁸³ Importantly, where only a single act of design patent infringement is concerned, recovery will be restricted to damages under *either* Section 284 *or* Section 289; however, under no circumstances is a design patent owner permitted to secure remedial compensation under both damages provisions.⁸⁴ Moreover, while a court, acting within the statutory framework of Section 284, may authorize, to the design patent owner, an award of treble damages upon a finding of patent infringement, such autonomy is not afforded under Section 289.⁸⁵ Finally, if the sum of damages recoverable under Section 284 exceeds those available under Section 289, the court, in assigning the appropriate grant of damages for design patent infringement, will favor the superior damages award afforded under Section 284.⁸⁶

1. Section 289 of the Patent Act

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

83. See 35 U.S.C. § 289; see also *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 58-59 (2016); see also John G. Froemming et al., *U.S. Supreme Court Creates Test for Assessing Damages for Design Patent Infringement*, JONES DAY: INSIGHTS (Dec. 2016), <https://www.jonesday.com/en/insights/2016/12/us-supreme-court-creates-test-for-assessing-damages-for-design-patent-infringement> [<https://perma.cc/U2KG-FN7G>] (“Section 289 creates a special form of damages for infringement of design patents, whereby a patent owner may elect to pursue ‘total profits’ . . . as an alternative to the traditional patent damages available under Section 284, such as reasonable royalty. ‘Total profits’ damages are calculated using the infringer’s total sales and subtracting appropriate costs and expenses.”).

84. See Burstein, *supra* note 82, at 788-89; see also *Catalina Lighting, Inc.*, 295 F.3d at 1291 (“When only a design patent is at issue, a patentee may not recover both infringer profits and additional damages under [Section] 284.”).

85. See Burstein, *supra* note 82, at 789; see also *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 824 (Fed. Cir. 1992) (“[Section] 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 . . . [Section] 289 authorizes an increase in a patentee’s total profit.” (alteration in original)).

86. See Burstein, *supra* note 82, at 789 n.43. Where a design patent owner seeks to recover damages under Section 289 of the Patent Act, the jury, in reaching an appropriate remedy, must first determine what damages would be available to the patentee under both Section 284 and Section 289. See *Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344, 1357 (Fed. Cir. 2015), *vacated*, 580 U.S. 1028 (2016). Following its engagement in this comparative examination, the jury will then grant the patent owner an award of damages in whichever amount is greater. *Id.* (“Only where [Section] 289 damages are not sought, or are less than would be recoverable under [Section] 284, is an award of [Section] 284 damages appropriate.”).

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 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.⁸⁷

This “total profits” remedy is limited exclusively to matters concerning design patent infringement.⁸⁸ Notably, Congress first enacted this special design patent-specific damages provision, in substantially similar form, in 1887,⁸⁹ following the U.S. Supreme Court’s decisions in the *Dobson* cases, a series of design patent infringement actions involving the designs of carpets.⁹⁰ In *Dobson v. Hartford Carpet Co.*, “the lower courts had awarded the holders of design patents on carpets damages in the amount of ‘the entire profit to the [patent holders], per yard, in the manufacture and sale of carpets of the patented designs, and not merely the value which the designs contributed to the carpets.’”⁹¹ However, the Supreme Court subsequently reversed this holding, construing “the statute [in effect at the time] to require proof that the profits were” attributable to the use of the infringing designs.⁹² Thus, the Court held that, “because the patentees could not show what portion of their losses or the infringers’ profits was due to the patented design and what portion was due to the unpatented carpet,”⁹³ each plaintiff was only entitled to an award of nominal damages.⁹⁴

87. 35 U.S.C. § 289.

88. See *Samsung Elecs. Co.*, 580 U.S. at 55.

89. See generally Burstein, *supra* note 8, at 53-61. “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.

90. See *Dobson v. Hartford Carpet Co.*, 114 U.S. 439 (1885); see also *Dobson v. Dornan*, 118 U.S. 10 (1886). “The cases involved the Dobson brothers, who were found to have infringed patented designs for carpets.” *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1441 (Fed. Cir. 1998).

91. *Samsung Elecs. Co.*, 580 U.S. at 56 (alteration in original) (quoting *Hartford Carpet Co.*, 114 U.S. at 443).

92. *Id.* at 433; see *Hartford Carpet Co.*, 114 U.S. at 444; see also *Dornan*, 118 U.S. at 17 (“The plaintiff must show what profits or damages are attributable to the use of the infringing design.”).

93. *Nike, Inc.*, 138 F.3d at 1441.

94. See *Dornan*, 118 U.S. at 18; see also *Hartford Carpet Co.*, 114 U.S. at 447.

Accordingly, in 1887, Congress, “concerned that the *Dobson* cases weakened design patent law to the point of ‘provid[ing] no effectual money recovery for infringement,’ ” swiftly “enacted the predecessor to [Section] 289, which eliminated the ‘need to apportion the infringer’s profits between the patented design and the article bearing the design.’ ”⁹⁵ Rather than “requiring proof that profits were attributable to the patented design,” the 1887 predecessor to the special remedies provision “allowed the patentee to recover ‘the total profit’ made by the infringer from the ‘manufacture or sale . . . of the article or articles to which the design, or colorable imitation thereof, has been applied.’ ”⁹⁶ The Patent Act of 1952 later “codified that ‘total profit’ remedy for design patent infringement in [Section] 289”⁹⁷ and thus solidified the precedent proscribing the apportionment of design patent damages under Section 289 of the Patent Act.⁹⁸

III. THE “ARTICLE OF MANUFACTURE” TODAY: *SAMSUNG ELECTRONICS CO. V. APPLE INC.*

A. Background

1. The Design Patent and Trial Proceedings

In 2007, Apple, anticipating the release of its first-generation iPhone, “took important [legal] measures to . . . protect its modern smartphone’s unparalleled exterior design [and revolutionary appearance] from future competitors,” securing a multitude of design patents in the device’s many ornamental features.⁹⁹ However, of the several design patents acquired by Apple, only three are pertinent to the discussion presented herein. These design patents include: (1) the D618,677 patent (the “D’677 patent”),¹⁰⁰ “which covers a black

95. *Apple Inc. v. Samsung Elecs. Co.*, No. 11-CV-01846-LHK, 2017 U.S. Dist. LEXIS 177199, at *52 (N.D. Cal. Oct. 22, 2017) (first quoting H.R. REP. NO. 49-1966, at 1 (1886); then quoting *Nike, Inc.*, 138 F.3d at 1441-42); see *Samsung Elecs. Co.*, 580 U.S. at 56 (“In 1887, in response to the *Dobson* cases, Congress enacted a specific damages remedy for design patent infringement.”).

96. *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *52 (quoting *Samsung Elecs. Co.*, 580 U.S. at 57).

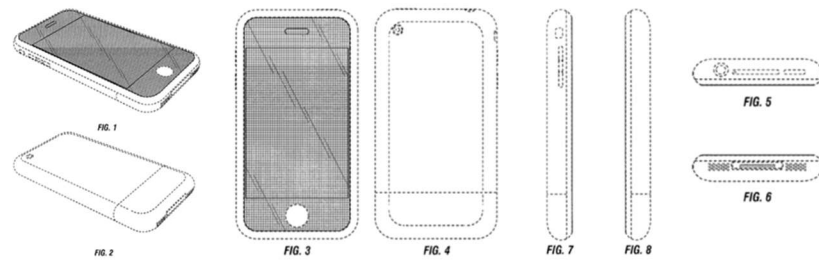
97. *Id.* at *52-53.

98. See *Nike, Inc.*, 138 F.3d at 1441-43.

99. Wald, *supra* note 20, at 571 (citing Sam Oliver, *Apple wins patent for first iPhone, designed by Jobs & Ive*, APPLEINSIDER (Dec. 18, 2012, 12:12 PM), <https://appleinsider.com/articles/12/12/18/apple-wins-patent-for-first-iphone-designed-by-jobs-ive> [<https://perma.cc/CN4C-5ME8>]); see *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *53.

100. The D’677 patent discloses a single embodiment that focuses on the front face design elements of the Apple iPhone:

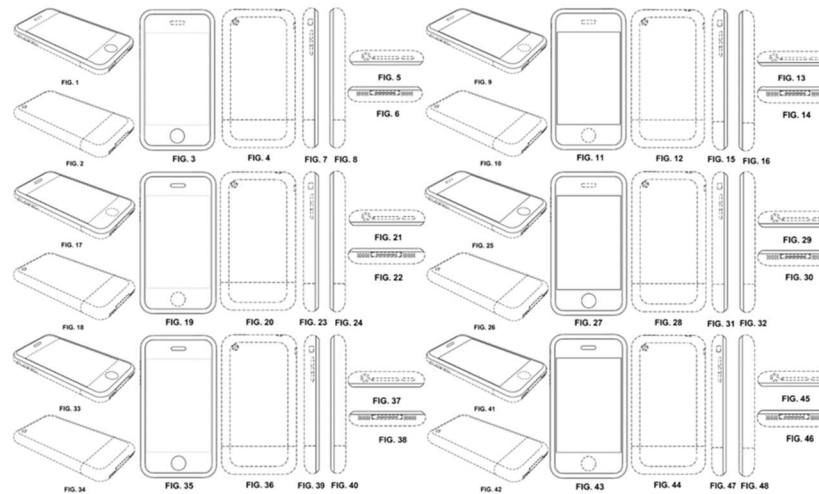
rectangular front face of a phone with rounded corners;”¹⁰¹ (2) the D593,087 patent (the “D’087 patent”),¹⁰² “which covers a rectangular front face of a phone with rounded corners and a raised rim;”¹⁰³ and (3)



U.S. Patent No. D618,677 figs.1, 2, 3, 4, 5, 6, 7 & 8 (filed Nov. 18, 2008).

101. *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *53.

102. The D’087 patent discloses six distinct design features, all directed at the front face of the device, that extend to the outer bezel of the iPhone:



U.S. Patent No. D593,087 figs.1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47 & 48 (filed July 30, 2007).

103. *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *53.

the D604,305 patent (the “D’305 patent”),¹⁰⁴ “which covers a grid of [sixteen] colorful icons on a black screen.”¹⁰⁵

Unsurprisingly, the original “iPhone inspired a generation of copycats, setting in motion the widespread adoption of devices that mirrored the [unprecedented] smartphone’s attractive appearance and innovative capabilities.”¹⁰⁶ In particular, following Apple’s debut of the first-generation iPhone, Samsung Electronics, a competing manufacturer of smartphones and electronic devices, released a series of remarkably similar smartphones that greatly resembled the early Apple device.¹⁰⁷ Accordingly, on April 15, 2011, Apple initiated a lawsuit against Samsung, asserting, insofar as germane here, that various Samsung smartphones infringed Apple’s D’677, D’087, and D’305 design patents.¹⁰⁸ A thirteen-day jury trial ensued, and, after approximately three full days of deliberation, a nine-person jury reached a verdict of design patent infringement in favor of Apple and against Samsung, finding that several of Samsung’s devices had indeed infringed on the three patented designs.¹⁰⁹ Consistent with this infringement determination, the jury then awarded Apple damages in an amount

104. *Id.* The D’305 patent claims “the ornamental design for a graphical user interface for a display screen or portion thereof” as shown in the following drawing:



U.S. Patent No. D604,305 figs.1 & 2 (filed June 23, 2007).

105. *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *53.

106. Wald, *supra* note 20, at 570-71 (first citing *The impact of the iPhone, 10 years on*, NATIONAL: OPINION (June 30, 2017), <https://www.thenational.ae/opinion/the-impact-of-the-iphone-10-years-on-1.1510> [<https://perma.cc/6H3M-2RBC>] (“Companies like Samsung rose on the back of [Apple’s] products”); then citing Lisa Eadicicco, *This Is Why the iPhone Upended the Tech Industry*, TIME: TECH (June 29, 2017), <http://time.com/4837176/iphone-10th-anniversary/> [<https://perma.cc/JR65-LQRR>] (“Google . . . rebuilt its first Android phone from the ground up after Apple’s keynote.”)).

107. *See* Samsung Elecs. Co. v. Apple Inc., 580 U.S. 53, 57 (2016).

108. *Id.* at 57-58.

109. *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *59.

equaling the total profits earned by Samsung from the sale of its infringing smartphones.¹¹⁰

Following this finding of infringement, Samsung engaged in subsequent post-trial motions practice and, on the theory that Apple's "design patent infringement damages numbers relied on improper notice dates," successfully moved for judgment as a matter of law.¹¹¹ Specifically, because Apple had failed to present sufficient evidence necessary "to recalculate the appropriate damages award for some of the infringing sales at issue in light of the proper notice dates," the court curtailed the original jury award and "ordered a limited new trial on utility and design patent damages relating only to the sales of those products."¹¹² On November 13, 2013, a six-day retrial commenced, and, after two days of deliberation, a jury granted Apple a reduced damages award, less approximately \$120 million, to remedy Samsung's design and utility patent infringement.¹¹³ Finally, on March 6, 2014, after the filing, and subsequent rejection, of an additional post-trial motion by Samsung, the court entered a final judgment in favor of Apple.¹¹⁴

2. Appeal of the Final Judgment

Upholding the jury verdict on appeal, the United States Court of Appeals for the Federal Circuit affirmed the damages award for design patent infringement, the amount of which paralleled "the entire profit Samsung made from its sales of the infringing smartphones."¹¹⁵ In so doing, the Federal Circuit rejected Samsung's argument that "the district court legally erred in allowing the jury to award [its] entire profits on its infringing smartphones as damages," and repudiated the two theories advanced by Samsung to support its contention "that design patent

110. *Id.*

111. *Id.* at *60.

112. *Id.* at *61.

113. *Id.* at *63 ("The [c]ourt specified . . . that '[t]he [c]ourt's prior rulings on the parties' *Daubert* motions, motions *in limine*, discovery disputes, and evidentiary objections [from the original trial would] remain in effect as law of the case. The parties [could] not relitigate these issues. Thus, the Court limited the evidence and witnesses at the 2013 trial to the evidence that was admissible at the 2012 trial." (alteration in original) (internal citation omitted)).

114. *Id.*

115. *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 58 (2016). The Federal Circuit, "agree[ing] with the district court that there was no legal error in the jury instruction on the design patent damages. . . , affirm[ed] the damages awarded [to Apple] for design patent infringements." *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1002 (Fed. Cir. 2015), *rev'd*, 137 S. Ct. 429 (2016).

damages should have been less than [its] ‘entire profits on its infringing smartphones.’”¹¹⁶

“First, Samsung argued that ‘[t]he damages . . . should have been limited to the profit attributable to the infringement’ and that ‘consumers chose Samsung [products] based on a host of other factors [besides the infringed designs].’”¹¹⁷ In evaluating this theory, the Federal Circuit held that, because “Section 289 explicitly authorizes the award of total profit from the article of manufacture bearing the patented design,” the acceptance of any “causation” argument, including that urged by Samsung, would directly contravene the clear statutory language forbidding the adoption of such a rule.¹¹⁸ More precisely, the Federal Circuit explained that this theory, which would fundamentally “require[] [the patentee] to show what portion of the infringer’s profit, or of his own lost profit, was due to the design and what portion was due to the article itself,”¹¹⁹ must be rejected under Section 289 of the Patent Act, as it would inappropriately “advocate [for] the same ‘apportionment’ requirement that Congress rejected” for design patent infringement damages under the special remedies provision.¹²⁰

“Second, Samsung argued that ‘the profits awarded [for design patent infringement] should have been limited to the infringing “article of manufacture,” not the entire infringing product’”¹²¹—i.e., “to the portion of the product as sold that incorporates or embodies the subject matter of the patent.”¹²² Relying on *Bush & Lane Piano Co. v. Becker Bros.* (“*Piano I*”),¹²³ and *Bush & Lane Piano Co. v. Becker Bros.* (“*Piano II*”),¹²⁴ (collectively, “the *Piano* cases”), Samsung maintained that, because the Second Circuit, in those cases, “allowed an award of infringer’s profits from the patented design of a *piano case* but *not* from the sale of the *entire piano*,” the district court, in this case, was similarly

116. *Apple Inc.*, 786 F.3d at 1001-02; see *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *63 (citing *Apple Inc.*, 786 F.3d at 1001-02) (“The Federal Circuit held that both theories lacked merit.”).

117. *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *63 (alterations in original) (quoting *Apple Inc.*, 786 F.3d at 1001).

118. *Apple Inc.*, 786 F.3d at 1001-02.

119. *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1441 (Fed. Cir. 1998).

120. *Apple Inc.*, 786 F.3d at 1001 (“The Act of 1887, specific to design patents, removed the apportionment requirement . . .” (alteration in original) (quoting *Nike, Inc.*, 138 F.3d at 1441)).

121. *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *64 (quoting *Apple Inc.*, 786 F.3d at 1002).

122. *Apple Inc.*, 786 F.3d at 1002.

123. *Bush & Lane Piano Co. v. Becker Bros.*, 222 F. 902 (2d Cir. 1915).

124. *Bush & Lane Piano Co. v. Becker Bros.*, 234 F. 79 (2d Cir. 1916) (opinion after appeal following remand).

obligated to limit the damages awarded for design patent infringement.¹²⁵ However, the Federal Circuit belied this contention, finding the factual underpinnings of those Second Circuit opinions—i.e., a factual situation where “[a] purchaser desiring a piano of a particular manufacturer [was capable of] hav[ing] the piano placed in any one of several cases dealt in by the maker”¹²⁶—to be inherently different from the circumstances existing in the present case.¹²⁷ Put differently, because “[t]he innards of Samsung’s smartphones were not sold separately from their shells as distinct articles of manufacture to ordinary purchasers,” the Federal Circuit rejected this theory for being without merit.¹²⁸ Instead, the Federal Circuit held that “the design patent damages did not need to be limited to profits attributable to an article of manufacture less than the entirety of each infringing Samsung phone.”¹²⁹

3. *Proceedings Before the United States Supreme Court*

The United States Supreme Court granted certiorari in this case.¹³⁰ “The question for which certiorari was granted was: ‘Where a design patent is applied to only a component of a product, should an award of infringer’s profits be limited to those profits attributable to the component?’”¹³¹ The Court held that, because “Section 289 allows a patent holder to recover the total profit an infringer makes from the infringement,” and because

‘[t]otal’ . . . means all[,] [t]he ‘total profit’ for which [Section] 289 makes an infringer liable is thus all of the profit made from the prohibited conduct, that is, from the manufacture or sale of the

125. *Apple Inc.*, 786 F.3d at 1002. In the *Piano* cases, “the Second Circuit held that the patentee had been overcompensated for being awarded the profits from an entire piano when the design patent at issue only applied to the piano case, not the internal components of the piano itself.” *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *56.

126. *Bush & Lane Piano Co.*, 222 F. at 903. “That factual situation occurred in the context of the commercial practice in 1915 in which ordinary purchasers regarded a piano and a piano case as distinct articles of manufacture.” *Apple Inc.*, 786 F.3d at 1002.

127. See *Apple Inc.*, 786 F.3d at 1002.

128. *Id.*

129. *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *64. “[T]he Federal Circuit identified the entire smartphone as the only permissible ‘article of manufacture’ for the purpose of calculating [Section] 289 damages because consumers could not separately purchase components of the smartphones.” *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 55 (2016).

130. *Samsung Elecs. Co. v. Apple Inc.*, 577 U.S. 1215 (2016) (granting certiorari).

131. *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *65-66 (“At oral argument . . . , Samsung abandoned its apportionment argument, and thus interpretation of the term ‘article of manufacture’ was the only issue before the U.S. Supreme Court.”).

‘article of manufacture to which [the patented] design or colorable imitation has been applied.’¹³²

Accordingly, the Supreme Court held that “[a]rriving at a damages award under [Section] 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.”¹³³

On the first step, the U.S. Supreme Court concluded that, because “[t]he term ‘article of manufacture,’ as used in [Section] 289 [of the Patent Act], encompasses both a product sold to a consumer and a component of that product,” the statutory text resolved this case.¹³⁴ More specifically, the Court held that “the ‘article of manufacture’ for which total profits are awarded under [Section] 289 was not necessarily limited to the product that is sold to consumers, but may be either ‘a product sold to a consumer [or] a component of that product.’”¹³⁵ However, while the Court concluded that, “[i]n the case of a multicomponent product, the relevant ‘article of manufacture’ for arriving at a [Section] 289 damages award need not be the end product sold to the consumer but may be only a component of that product,”¹³⁶ it declined to “resolve whether, for each of the design patents at issue [in *Samsung*], the relevant article of manufacture [was] the smartphone, or a particular smartphone component.”¹³⁷ Nor did the U.S. Supreme Court agree to establish a test for identifying the relevant “article of manufacture” at the first step of the Section 289 damages inquiry,¹³⁸

132. *Samsung Elecs. Co.*, 580 U.S. at 59 (first quoting *Total*, AM. HERITAGE DICTIONARY ENG. LANGUAGE, <https://ahdictionary.com/word/search.html?q=total&submit.x=0&submit.y=0> [<https://perma.cc/5UE8-GUAP>]; then quoting 35 U.S.C. § 289); see *Total*, BALLENTINE’S LAW DICTIONARY (3d ed. 1969) (“The whole amount; the entire quantity.”).

133. *Samsung Elecs. Co.*, 580 U.S. at 59.

134. *Id.*

135. *Apple Inc.*, 2017 U.S. Dist. LEXIS 177199, at *66 (alteration in original) (quoting *Samsung Elecs. Co.*, 580 U.S. at 59).

136. *Samsung Elecs. Co.*, 580 U.S. at 53.

137. *Id.* at 62 (“Doing so would require [the Court] to set out a test for identifying the relevant article of manufacture at the first step of the [Section] 289 damages inquiry and to parse the record to apply that test in this case.”).

138. *Id.* (“The United States as *amicus curiae* suggested a test but Samsung and Apple did not brief the issue. [Thus, the Court] decline[d] to lay out a test for the first step of the [Section] 289 damages inquiry in the absence of adequate briefing by the parties.” (internal citation omitted)); see Brief for the United States as Amicus Curiae Supporting Neither Party at 27-29, *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53 (2016) (No. 15-777).

doing so, the Court reasoned, was “not necessary to resolve the question presented in this case.”¹³⁹

a. The U.S. Supreme Court’s Reading of the Term “Article of Manufacture” in Section 289 of the Patent Act

The threshold matter presented in this case and, consequently, addressed by the U.S. Supreme Court is “the scope of the term ‘article of manufacture’”; that 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.”¹⁴⁰ The Court purported to resolve this question by fixating on the meaning of the term “article of manufacture” within the textual framework and statutory language of Section 289.¹⁴¹ More specifically, relying almost exclusively on the statutory term’s dictionary definition, the Supreme Court held that, because “[a]n ‘article’ is just ‘a particular thing,’”¹⁴² and because “‘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,’”¹⁴³ an “article of manufacture” is “simply a thing made by hand or machine.”¹⁴⁴

139. *Samsung Elecs. Co.*, 580 U.S. at 62. The epic seven-year battle between Apple and Samsung over the three iPhone design patents ended in May 2018 when the parties settled the case. Gene Quinn, *What Mattered in 2018: Industry Insiders Reflect on the Biggest Moments in IP*, IPWATCHDOG (Dec. 30, 2018, 11:35 AM), <https://www.ipwatchdog.com/2018/12/30/2018-biggest-moments-ip/id=104351/> [<https://perma.cc/Y9E4-PWYD>]. After many twists and turns, Apple was ultimately awarded \$539,000,000 in damages for Samsung’s design patent infringement. *Id.*

140. *Samsung Elecs. Co.*, 580 U.S. at 59 (“Under the former interpretation, a patent holder will always be entitled to the infringer’s total profit from the end product. Under the latter interpretation, a patent holder will sometimes be entitled to the infringer’s total profit from a component of the end product.”).

141. *See id.* (“The text resolves this case.”).

142. *Id.* (quoting JAMES STORMONTH & PHILIP H. PHELP, A DICTIONARY OF THE ENGLISH LANGUAGE 53 (N.Y., Harper & Bros. 1885)) (defining “article” as “a jointed thing or part; a clause or item; a particular thing”); *see Article*, AM. HERITAGE DICTIONARY ENG. LANGUAGE, <https://ahdictionary.com/word/search.html?q=article&submit.x=0&submit.y=0> [<https://perma.cc/USZ5-FVZ2>] (“An individual thing or element of a class; a particular object or item . . .”).

143. *Samsung Elecs. Co.*, 580 U.S. at 60 (quoting STORMONTH & PHELP, *supra* note 142, at 589) (defining “manufacture” as “the conversion of raw materials by the hand, or by machinery, into articles suitable for the use of man”); *see Manufacture*, AM. HERITAGE DICTIONARY ENG. LANGUAGE, <https://ahdictionary.com/word/search.html?q=manufacture&submit.x=65&submit.y=21> [<https://perma.cc/HSL7-CTUN>] (“The act, craft, or process of manufacturing products, especially on a large scale[;] [a] product that is manufactured.”).

144. *Samsung Elecs. Co.*, 580 U.S. at 60. “The opinion rests directly . . . on the idea that, according to its dictionary definition, an ‘article of manufacture’ is any ‘thing made by hand or machine.’” Ronald J. Mann, *Design Patent Damages After Samsung v. Apple*, 1

In reaching this conclusion, the Court reasoned that, “[s]o understood, the term ‘article of manufacture’ is broad enough to encompass both a product sold to a consumer [and] a component of that product.”¹⁴⁵ Thus, the Supreme Court rationalized, the inherent capacity of “[a] component of a product, not less than the product itself,” to “be integrated into a larger product . . . does not put it outside the category of articles of manufacture.”¹⁴⁶ Put differently, because “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,” the Court held that Section 289 of the Patent Act could not be narrowly construed to cover only the end product sold to consumers.¹⁴⁷ Instead, it held that, depending on the particular circumstances, statutory damages may be available at *either* the component level *or* the end level under the Section 289 special remedies provision.¹⁴⁸

Moreover, while the Court held that “[t]he Federal Circuit’s narrower reading of ‘article of manufacture’ [could not] be squared with the text of [Section] 289,”¹⁴⁹ it determined its broad reading of the term “article of manufacture” in Section 289 to be consistent with both Section “171(a), which makes ‘new, original and ornamental design[s] for an article of manufacture’ eligible for design patent protection,”¹⁵⁰ and Section “101, which makes ‘any new and useful . . . manufacture . . . or any new and useful improvement thereof’ eligible for . . . patent protection.”¹⁵¹ More precisely, reasoning 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

CRITERION J. ON INNOVATION 197, 198 (2016), <https://www.criterioninnovation.com/articles/mann-design-patent-damages-after-samsung-v-apple.pdf> [<https://perma.cc/X4QT-8CQ6>].

145. *Samsung Elecs. Co.*, 580 U.S. at 60.

146. *See id.*

147. *Id.* at 62.

148. *See id.*; *see also* Dennis Crouch, *Samsung v. Apple: Design Patent Damages May be Limited to Components*, PATENTLY-O (Dec. 6, 2016), <https://patentlyo.com/patent/2016/12/samsung-limited-components.html> [<https://perma.cc/9CPH-ZSBX>].

149. *Samsung Elecs. Co.*, 580 U.S. at 61.

150. *Id.* at 60 (alteration in original) (“The Patent Office and the courts have understood [Section] 171 to permit a design patent for a design extending to only a component of a multicomponent product.”); *see, e.g., Ex parte Adams*, 84 Off. Gaz. Pat. Office 310, 311 (1898) (“The several articles of manufacture of peculiar shape which when combined produce a machine or structure having moveable parts may each separately be patented as a design”); *see also In re Zahn*, 617 F.2d 261, 268 (C.C.P.A. 1980) (“Section 171 authorizes patents on ornamental designs for articles of manufacture. While the design must be embodied in some article, the statute is not limited to designs for complete articles, or ‘discrete’ articles, and certainly not to articles separately sold”); *see also* 35 U.S.C. § 171(a).

151. *Samsung Elecs. Co.*, 580 U.S. at 61 (alteration in original); *see* 35 U.S.C. § 101; *see also* *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980).

not,” the Supreme Court concluded that the Federal Circuit’s “reading [of] ‘article of manufacture’ in [Section] 289 to cover only an end product sold to a consumer [gave] too narrow a meaning to the phrase.”¹⁵² Thus, the Court held that “components of the infringing smartphones could . . . be the relevant article of manufacture” under Section 289, even though “consumers could not purchase those components separately from the smartphones.”¹⁵³

IV. THE “ARTICLE OF MANUFACTURE” IN 1887

A. The Definition of “Article of Manufacture” in 1887

When the United States Congress first enacted the original design patent disgorgement statute in the 1887 Patent Act—i.e., the predecessor to the special “total profits” remedy provision codified in Section 289 of the Patent Act today—the phrase “article of manufacture” was a term of art that did not simply “refer to any ‘article’ that was ‘manufactured.’ ”¹⁵⁴ Instead, the “article of manufacture” language, so understood, “referred to a tangible item made by humans—other than a machine or [a] composition of matter—that had a unitary structure and was complete in itself for use or for sale.”¹⁵⁵ Notably, “[t]o be ‘complete’ in this sense, the item did not have to be the ultimate product sold or used by the ultimate consumer.”¹⁵⁶ This early interpretation of the term “article of manufacture” has important implications that must be considered in formulating a more comprehensive framework for “article of manufacture” identification in Section 289 of the Patent Act.

152. *Samsung Elecs. Co.*, 580 U.S. at 62.

153. *Id.* at 61; *see* *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1002 (Fed. Cir. 2015) (declining to limit a Section 289 award to a component of the smartphone because “[t]he innards of Samsung’s smartphones were not sold separately from their shells as distinct articles of manufacture to ordinary purchasers”), *rev’d*, 580 U.S. 53 (2016); *see also* *Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344, 1355 (Fed. Cir. 2015), *vacated*, 580 U.S. 1028 (2016) (declining to limit a Section 289 award to the design for a “lip and hinge plate” because it was “welded together” with a leveler, and there was no evidence that it was sold “separate[ly] from the leveler as a complete unit”).

154. Burstein, *supra* note 8, at 61. *See generally* Act of Feb. 4, 1887, ch. 105, 24 Stat. 387.

155. Burstein, *supra* note 8, at 61-62 (“The . . . words ‘article’ and ‘manufacture’ indicate that an ‘article of manufacture’ had to be both tangible and made by humans. The Patent Office repeatedly ruled that an article of manufacture had to have a ‘single, unitary structure.’ An article of manufacture also had to be complete in itself for use or for sale. To be ‘complete’ in this sense, the item did not have to be the ultimate product sold or used by the ultimate consumer.” (internal footnotes omitted)).

156. *Id.* at 62 (“For example, a mantel was an article of manufacture even though it was meant to ‘ultimately becom[e] part of a house.’ ” (alteration in original) (quoting *Ex parte* Lewis, 1891 Dec. Comm’r Pat. 61, 63)).

1. *The Legislative History of the Term “Article of Manufacture” in 1887*

The statutory language first utilized in 1887 and currently employed in the Patent Act’s special damages provision today has remained fundamentally unchanged.¹⁵⁷ Significantly, the genesis of this legislation arose out of a consolidation of Supreme Court decisions, entered between 1885 and 1886, to “limit[] a design patent owner to [the] recovery of ‘only nominal damages,’ for want of evidence apportioning the value of the design and the value of the article of manufacture itself” in the *Dobson* cases.¹⁵⁸ These Supreme Court decisions prompted a swift congressional rejection of the apportionment requirement in design patent law, thereby forming the statutory precursor for the contemporary special remedies provision in Section 289 of the Patent Act.¹⁵⁹

a. *The Carpet Cases*

The 1885 Supreme Court decision in *Dobson v. Hartford Carpet Co.* “consolidated three suits in equity for design patent infringement brought against John Dobson and James Dobson by the Hartford Carpet Co. and Bigelow Carpet Co.”¹⁶⁰ In each of the respective “Carpet Cases,” John and James Dobson were accused of infringing design patents for the surface ornamentation of carpet designs.¹⁶¹ Notwithstanding the fact that the Dobson brothers were quickly found liable for “nicking” the designs from the opposing carpet makers and advertising them as their own,¹⁶² the Court grappled with the question of damages,¹⁶³ that is, “the judges [could not] determine precisely how valuable [the] design was when compared with everything else that goes

157. See Brief of Amicus Curiae American Intellectual Property Law Association in Support of Respondent at 6, *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53 (2016) (No. 15-777), <https://www.scotusblog.com/wp-content/uploads/2016/08/15-777-amicus-resp-AIPLA.pdf> [<https://perma.cc/C5QL-TYKK>].

158. *Id.* (first citing *Dobson v. Dornan*, 118 U.S. 10 (1886); then citing *Dobson v. Hartford Carpet Co.*, 114 U.S. 439 (1885)).

159. See *id.*

160. *Id.* at 10; see *Hartford Carpet Co.*, 114 U.S. at 440. Collectively, these cases became known as the “Carpet Cases.”

161. See generally *Hartford Carpet Co.*, 114 U.S. 439.

162. See Dave Lee, *Apple and Samsung reach Supreme Court in patent row*, BBC: NEWS (Oct. 11, 2016), <https://www.bbc.com/news/technology-37614014> [<https://perma.cc/XVT5-9C8T>].

163. See Brief of Amicus Curiae Industrial Designers Society of America in Support of Neither Party at 9, *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53 (2016) (No. 15-777), <https://www.scotusblog.com/wp-content/uploads/2016/06/15-777-ac-IDSA-supporting-neither-party.pdf> [<https://perma.cc/E874-6PN2>].

into making a nice carpet.”¹⁶⁴ While the appellate court ultimately “awarded the patent holders the profits which they would have made on the sale of the quantity of carpets sold by the Dobson[] [Brothers],” the Supreme Court subsequently reversed.¹⁶⁵ Instead, finding that the patentees were incapable of distinguishing the “portion of the infringer’s profits [that were] attributable to the design” from those that were attributable to the carpet itself, the U.S. Supreme Court held that “the infringers of [the] patented designs for carpets were liable for only nominal damages of six cents.”¹⁶⁶

Simply put, the “Carpet Cases” exposed the problematic nature of an apportionment rule in cases of design patent infringement—namely, by allocating nominal damages as the sole compensatory remedy for such infringements, these decisions regularly left the design patentee exposed and without any meaningful form of monetary relief.¹⁶⁷ Thus, in 1887, Congress responded to the *Dobson* “Carpet Cases” by enacting remedial legislation, now codified in Section 289, that overturned these Supreme Court decisions, and which effectively eliminated “the need to apportion the infringer’s profits between the patented design and the article bearing the design.”¹⁶⁸ Plainly rejecting the continued use of an apportionment rule as a limitation on an award of profits,¹⁶⁹ the accompanying House Report explained that “[i]t is expedient that the infringer’s entire profit on the article should be recoverable, as otherwise none of his profit can be recovered, for it is not apportionable; and . . . the entire profit on the article should be recoverable . . . , for it is the

164. Lee, *supra* note 162 (“A lovely design on a poor quality rug [would not] sell . . .”).

165. Brief of Amicus Curiae American Intellectual Property Law Association in Support of Respondent, *supra* note 157, at 10; see *Hartford Carpet Co.*, 114 U.S. at 445-46 (“The [apportionment] rule . . . is even more applicable to a patent for a design than to one for mechanism. A design or pattern in ornamentation or shape appeals only to the taste through the eye, and is often a matter of evanescent caprice.”); accord *Dobson v. Dornan*, 118 U.S. 10, 17-18 (1886) (reversing the award of lost profits to the patentee based on the quality of the carpets sold by the defendants).

166. Brief of Amicus Curiae Industrial Designers Society of America in Support of Neither Party, *supra* note 163, at 9; see *Hartford Carpet Co.*, 114 U.S. at 445-46.

167. See Brief of Amicus Curiae Industrial Designers Society of America in Support of Neither Party, *supra* note 163, at 9; see H.R. REP. NO. 49-1966, at 1 (1886) (“It now appears that the design patent laws provide no effectual money recovery for infringement.”).

168. *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1442 (Fed. Cir. 1998); see H.R. REP. NO. 49-1966, at 1; see also *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 56 (2016). “Congress established Section 289 in 1887 in response to the Carpet Cases, where only nominal damages were awarded because of the difficulty in proving an apportioned amount.” Brief of Amicus Curiae Industrial Designers Society of America in Support of Neither Party, *supra* note 163, at 11; see, e.g., *Dornan*, 118 U.S. 10.

169. See Brief of Amicus Curiae American Intellectual Property Law Association in Support of Respondent, *supra* note 157, at 11.

design that sells the article”¹⁷⁰ Similarly, and in relatively comparable language, the corresponding Senate Report echoed these findings, emphasizing that any failure to ratify this bill would “virtually repeal the design patent laws.”¹⁷¹ Therefore, the statutory language announced in the 1887 Act “constitutes a congressional rejection of a causation consideration, *i.e.*, an apportionment requirement, and authorizes [the] recovery of [an] infringer’s total profit from the article of manufacture bearing the patented design.”¹⁷²

2. *The Supreme Court’s Definition of “Article of Manufacture” vs. the Definition of “Article of Manufacture” in 1887*

Generally, entrenched in the United States’ long-standing history of statutory interpretation is the fundamental principle that “when Congress reenacts existing statutory language, it is presumed to acquiesce in the way the courts have interpreted that language.”¹⁷³ More specifically, “it is a cardinal rule of statutory construction that, when Congress employs a term of art, it presumably knows and adopts the cluster of ideas that were attached to each borrowed word in the body of learning from which it is taken.”¹⁷⁴ That is, where the language being construed constitutes a statutory term of art, “it is the traditional use, *not* the plain meaning, that governs.”¹⁷⁵ Therefore, guided by these canons of construction, considerable weight must be afforded to the 1887 definition of “article of manufacture” in order to evaluate the practical feasibility of the Supreme Court’s definition for the statutory term of art.

Holding that “[t]he term ‘article of manufacture’ . . . encompasses both a product sold to a consumer and a component of that product,” the United States Supreme Court, in *Samsung*, effectively counseled that any “end product sold to the consumer” would qualify as an “article of

170. H.R. REP. NO. 49-1966, at 3; *see Nike, Inc.*, 138 F.3d at 1442 (“The difference for design patents, as enacted in 1887, was the removal of the need to apportion the infringer’s profits between the patented design and the article bearing the design.”).

171. S. REP. NO. 49-206, at 1 (1886).

172. Brief of Amicus Curiae American Intellectual Property Law Association in Support of Respondent, *supra* note 157, at 6; *see Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1002-03 (Fed. Cir. 2015), *rev’d*, 580 U.S. 53 (2016).

173. Mark A. Lemley, *Does “Public Use” Mean the Same Thing It Did Last Year?*, 93 TEX. L. REV. 1119, 1126 (2015), <http://texaslawreview.org/wp-content/uploads/2015/08/Lemley-93-5.pdf> [<https://perma.cc/RUE9-PFAH>].

174. *Air Wis. Airlines Corp. v. Hooper*, 571 U.S. 237, 248 (2014) (quoting *Fed. Aviation Admin. v. Cooper*, 566 U.S. 284, 292 (2012)).

175. Lemley, *supra* note 173, at 1127.

manufacture” under Section 289 of that Patent Act.¹⁷⁶ However, the historical evidence surrounding the statutory meaning of the term of art in 1887 belies this interpretation.¹⁷⁷ In 1887, “the phrase ‘article of manufacture’ was not a synonym for ‘product’ ”;¹⁷⁸ rather, the historical evidence demonstrates that not every product “sold by an enterprise to its customers” was considered an “article of manufacture” in 1887.¹⁷⁹ Put differently, although an “article of manufacture” had to be a “product” insofar as “it had to be complete enough to be sold to someone,” the statutory term, as understood in 1887, did not require that “that ‘someone’ be the ultimate or end consumer”—i.e., the purchaser of the “article of manufacture” could have been another manufacturer or artisan.¹⁸⁰ Thus, in 1887, while every “article of manufacture” needed to be a complete “product” capable of individual sale, “not every ‘end product sold to the consumer’ qualified as an ‘article of manufacture.’ ”¹⁸¹

Moreover, central to the Court’s determination in *Samsung* was the fundamental presumption that the term “article of manufacture” in Section 289 of the Patent Act “is simply a thing made by hand or machine.”¹⁸² However, once again, the historical evidence indicates that, in 1887, “not all ‘thing[s] made by hand or machine’ were considered ‘articles of manufacture.’ ”¹⁸³ Similarly, contrary to the Supreme Court’s holding in *Samsung* that “[t]he term ‘article of manufacture,’ as used in [Section] 289, encompasses both a product sold to a consumer and a component of that product,”¹⁸⁴ which could “be read as suggesting that any ‘component’ can be an ‘article of manufacture’

176. *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 59-62 (2016); see Burstein, *supra* note 8, at 64.

177. Burstein, *supra* note 8, at 64.

178. *Id.*

179. KARL T. ULRICH & STEVEN D. EPPINGER, *PRODUCT DESIGN AND DEVELOPMENT* 2 (5th ed. 2012); see Burstein, *supra* note 8, at 64. For example, in a case involving a glass inkstand and a removable stopper, the Patent Office deemed the two elements to be distinct “articles of manufacture,” albeit both being presumably sold together as a single unitary product and each being individually useless on its own. *Ex parte* Brower, 1873 Dec. Comm’r Pat. 151, 151. Similarly, in a design patent application for a pocket watch, the Patent Office held that the mirror-frame and adjoining sconce comprised two separate “articles of manufacture,” despite being seemingly attached to form a single fixture and designed to be used together. *Ex parte* Patitz, 1883 Dec. Comm’r Pat. 101, 102.

180. Burstein, *supra* note 8, at 65.

181. *Id.* at 66 (citing *Samsung Elecs. Co.*, 580 U.S. at 59).

182. *Samsung Elecs. Co.*, 580 U.S. at 60 (“An article of manufacture, then, is simply a thing made by hand or machine.”); see Burstein, *supra* note 8, at 67.

183. Burstein, *supra* note 8, at 66-67 (alteration in original).

184. *Samsung Elecs. Co.*, 580 U.S. at 59.

for the purposes of [Section] 289,”¹⁸⁵ the 1887 definition of the statutory term held that, although a component could indeed be an “article of manufacture,” not all “components” necessarily were “articles of manufacture.”¹⁸⁶ Thus, while it is was true that, under the statutory language of the 1887 Patent Act, “not all articles of manufacture [were] complete commercial products, neither [were] all components . . . considered articles of manufacture.”¹⁸⁷

V. COPYRIGHT LAW AND THE DOCTRINE OF SEPARABILITY

A. Background

Section 101 of the Copyright Act provides that a “pictorial, graphic, or sculptural feature[.]” incorporated into the “design of a useful article” is eligible for copyright protection if, and only to the extent that, it (1) “can be identified separately from,” and (2) is “capable of existing independently of, the utilitarian aspects of the article.”¹⁸⁸ A “useful article,” as defined in this statutory title, “is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”¹⁸⁹ Thus, while copyright protection cannot preserve the purely utilitarian aspects of a design, it will nevertheless survive where the asserted work of authorship—comprising a pictorial, graphic, or sculptural feature—is either physically or ‘conceptually’ separable from the utilitarian aspects of the useful article.¹⁹⁰ Therefore, central to determining the copyrightability of a useful article—or, stated more aptly, the copyrightability of the pictorial, graphic, or sculptural features comprising that article—is the doctrine of separability.

185. Burstein, *supra* note 8, at 67 (citing Michael Risch, *Samsung v. Apple: Drilling Down on Profit Calculations*, WRITTEN DESCRIPTION (Dec. 6, 2016), <https://writtendescription.blogspot.com/2016/12/samsung-v-apple-drilling-down-on-profit.html> [<https://perma.cc/7JZN-P93X>]).

186. *Id.* at 68.

187. McKenna, *supra* note 8.

188. Copyright Act, 17 U.S.C. § 101 (Supp. 2019).

189. *Id.*; see Grady Garrison, *Copyright protection for designs of useful articles*, IAM (Apr. 13, 2016), <https://www.iam-media.com/copyright/copyright-protection-designs-useful-articles> [<https://perma.cc/L3L2-9V3A>] (“Under this definition, a lamp is a useful article, whereas a painting is not.”).

190. Robert W. Clarida, *Gimme an “S” for Separability: Supreme Court to Consider Copyrightability of Designs on Cheerleading Uniforms*, LANDSLIDE, Nov./Dec. 2016, at 57, 58.

1. *The Separability Requirement*

The doctrine of separability fundamentally “derives from the notion that an otherwise copyrightable item should not be denied protection [simply] because it is employed as part of a useful article.”¹⁹¹ Thus, under the “separability” threshold imposed by the Copyright Act, copyright protection extends to a useful article only insofar as the ornamental design elements, reflecting the independent artistic judgments of the author, are distinct from their mechanical and utilitarian functions.¹⁹² However, where the incorporated features of a useful article are not separable from the mechanical or utilitarian function of the article itself, the “[i]nseparable design features, whatever their aesthetic appeal, are not protected under copyright law.”¹⁹³ Accordingly, to determine whether the design features of a useful article are separable from its utilitarian elements and, therefore, are eligible for copyright protection, two statutory tests are employed: the physical separability test and the conceptual separability test.¹⁹⁴

a. *The Physical Separability Test*

A pictorial, graphic, or sculptural “feature is *physically* separable from the underlying useful article if it can ‘be physically separated from the article by ordinary means while leaving the utilitarian aspects of the article completely intact.’”¹⁹⁵ Put differently, the physical separability test is satisfied when the copyrightable elements—i.e., the incorporated

191. Carl Mazurek, *Fashion Copyright and the Muddling of the Useful Articles Doctrine*, JIPEL: THE BLOG (Apr. 11, 2016), <https://blog.jipel.law.nyu.edu/2016/04/fashion-copyright-and-the-muddling-of-the-useful-articles-doctrine/> [<https://perma.cc/KLL4-NBS9>].

192. See Jim Stronski et al., *The New Standard for Copyright Protection of Useful Articles: Star Athletica and its Impact on the 3-D Printing Industry*, 94 PAT., TRADEMARK & COPYRIGHT J. 738 (2017).

193. Jane C. Ginsburg, “Courts Have Twisted Themselves into Knots”: *U.S. Copyright Protection for Applied Art*, 40 COLUM. J.L. & ARTS 1, 2 (2016), https://scholarship.law.columbia.edu/cgi/viewcontent.cgi?article=3001&context=faculty_scholarship [<https://perma.cc/PFM8-848V>].

194. See U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2 (3d ed. 2014) [hereinafter COMPENDIUM], <https://www.copyright.gov/comp3/docs/compendium-12-22-14.pdf> [<https://perma.cc/N4HX-4DXE>]. Note that, while the U.S. Supreme Court, in *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, “necessarily abandon[ed] the distinction between ‘physical’ and ‘conceptual’ separability,” *Star Athletica L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1014 (2017), to effectively illustrate the statutory background upon which the proposed legal framework recommended herein is primarily based, see discussion *infra* Part VI, for the purpose of this Article, physical and conceptual separability will be discussed as discrete statutory tests.

195. *Star Athletica L.L.C.*, 137 S. Ct. at 1014 (quoting COMPENDIUM, *supra* note 194, § 924.2(A)).

pictorial, graphic, or sculptural features of a useful article—can “be physically removed without altering the useful aspects of the article.”¹⁹⁶ Therefore, because a hood ornament that is physically removed from an automobile is nevertheless capable of existing independently of that automobile, and because the purely artistic features of that hood ornament can be identified separately from the utilitarian functions of the automobile, “[a] sufficiently creative decorative hood ornament on an automobile” is copyrightable under the physical separability test.¹⁹⁷

b. The Conceptual Separability Test

Alternatively, conceptual separability is determinative of copyrightability when “a feature of the useful article is clearly recognizable as a pictorial, graphic, or sculptural work, notwithstanding the fact that it cannot be physically separated from the article by ordinary means.”¹⁹⁸ Therefore, under the conceptual separability test, even where an artistic feature is not physically separable from the useful article, it may be eligible for copyright protection if it is “capable of being visualized . . . as a work of authorship that is independent from the overall shape of the useful article.”¹⁹⁹ That is, “the feature must be imagined separately and independently from the useful article without destroying the basic shape of that article.”²⁰⁰ “A pictorial, graphic, or sculptural feature satisfies this requirement only if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article.”²⁰¹ For example, under the conceptual separability test, “the carving on the back of a chair” is copyrightable because “one could imagine the carving . . . as a drawing on a piece of paper that is entirely distinct from the overall shape of the chair”—i.e., “[e]ven if the carving . . . was removed[,] the shape of the chair . . . would remain unchanged, and . . . [it] would still be capable of serving a useful purpose.”²⁰² The

196. COMPENDIUM, *supra* note 194, § 924.2(A).

197. *Id.*

198. *Id.* § 924.2(B).

199. *Id.*

200. *Id.* (“The U.S. Copyright Office applies the conceptual separability test only if it determines that the useful article contains pictorial, graphic, or sculptural features that cannot be physically separated from that article.”).

201. *Id.*

202. *Id.* (citing H.R. REP. NO. 94-1476, at 55 (1976)) (detailing an illustrative list of additional artistic examples, held to be conceptually separable, which included works comprising “[a]rtwork printed on a t-shirt, beach towel, or carpet,” “[a] colorful pattern decorating the surface of a shopping bag,” “[a] drawing on the surface of wallpaper,” and “[a] floral relief decoration the handle of a spoon”); see *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 732

same is true for “an engraving on a vase”—the engraving, albeit not physically separable, is nevertheless copyrightable because it can be imagined apart from the vase as a wholly distinct two-dimensional pictorial, graphic, or sculptural work, and because, even when it is removed, the vase, remaining unchanged in shape, is still capable of serving a useful purpose.²⁰³

For a pictorial, graphic, or sculptural feature to satisfy the conceptual separability test, the artistic design and the utilitarian function of the useful article, into which it is incorporated, must be inherently distinct. Otherwise, where the ornamental elements of a useful article are inherently the same as its mechanical and utilitarian function, the pictorial, graphic, or sculptural features of that useful article are neither capable of conceptual separability nor entitled to copyright protection. Notably, however, the mere fact that “a useful article could have been designed differently[,] or . . . that an artistic feature is not necessary to or dictated by the utilitarian aspects of that article is irrelevant to this analysis.”²⁰⁴ Moreover, where the artistic feature comprises “an integral part of the overall shape or contour of the useful article, that feature cannot be considered conceptually separable because removing it would destroy the basic shape of the useful article.”²⁰⁵ In other words, when the ornamental form and the utilitarian function of a useful article are perfectly married—i.e., each artistic design element of the useful article is dictated and/or simultaneously influenced by its functional features—the incorporated pictorial, graphic, or sculptural features of that article are not copyrightable.²⁰⁶

2. *The Independent-Existence Requirement*

“To satisfy the independent-existence requirement, the [artistic] feature must be able to exist as its own pictorial, graphic, or sculptural work once it is imagined apart from the useful article”²⁰⁷—i.e., independence manifests in the physical or conceptual separability of the

F.2d 989 (2d Cir. 1980) (holding that, although belt buckles are ordinarily utilitarian objects not subject to copyright protection, belt buckles comprising sculptural designs cast in precious metals, which are decorative in nature and utilized primarily as jewelry by wearers, are nevertheless copyrightable because they contain “conceptually separable sculptural elements,” employed primarily for ornamentation, that, despite being physically invisible, are inherently distinct “from their subsidiary utilitarian function”).

203. COMPENDIUM, *supra* note 194, § 924.2(B).

204. *Id.*

205. *Id.*

206. Rather, when form and function are perfectly married, intellectual property rights in the artistic design are limited exclusively to design patentability, not copyright protection.

207. *Star Athletica L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1005 (2017).

artistic design from the useful article.²⁰⁸ However, if the ornamental design feature “could not exist as a pictorial, graphic, or sculptural work on its own,” it necessarily fails the independent-existence requirement, as “it is simply one of the article’s utilitarian aspects.”²⁰⁹ Thus, when confronting the independent-existence requirement, the threshold inquiry is whether “the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article.”²¹⁰

Importantly, because “[t]he focus of the separability inquiry is on the extracted feature,” and not those aspects of the useful article that remain subsequent to the imaginary or literal extraction, “[t]he statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature”—that is, in determining whether an artistic feature is capable of independent existence, there is no statutory mandate that a non-artistic replacement for the removed feature be imagined.²¹¹ Consequently, to establish independent existence under the Copyright Act, the controlling statutory language only “requires that the separated feature qualify as a [non-useful] pictorial, graphic, or sculptural work on its own.”²¹² Therefore, adhering to these statutory bounds, and in accordance with the independent-existence requirement, the useful article doctrine provides that “a feature of the design of a useful article is eligible for copyright [protection] if, when identified and imagined apart from the useful article, it would qualify as a pictorial, graphic, or sculptural work either on its own or when fixed in some other tangible medium” of expression.²¹³

208. Brief for the Respondents at *29, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (No. 15-866) (“Independence is established if an artistic feature is either physically separable from the useful article (e.g., a hood ornament on a car) or conceptually separable (e.g., a carving on the back of a chair).”).

209. *Star Athletica L.L.C.*, 137 S. Ct. at 1005.

210. *Id.* at 1010 (“[T]he feature must be able to exist as its own pictorial, graphic, or sculptural work as defined in [Section] 101 once it is imagined apart from the useful article. If the feature is not capable of existing as a pictorial, graphic, or sculptural work once separated from the useful article, then it was not a pictorial, graphic, or sculptural feature of that article, but rather one of its utilitarian aspects.”).

211. *Id.* at 1013-14 (“[B]ecause the removed feature may not be a useful article—as it would then not qualify as a pictorial, graphic, or sculptural work—there necessarily would be some aspects of the original useful article ‘left behind’ if the feature were conceptually removed. But the statute does not require the imagined remainder to be a fully functioning useful article at all, much less an equally useful one.”).

212. *Id.* at 1013.

213. *Id.* at 1012.

VI. A RECOMMENDATION FOR A NEW, MORE DISCRIMINATING
DOCTRINE OF SEPARABILITY, DELINEATING A CATEGORICAL TEST FOR
“ARTICLE OF MANUFACTURE” IDENTIFICATION WITHIN THE
FRAMEWORK OF SECTION 289, IN DESIGN PATENT LAW

“[I]f history is our guide to the proper definition of ‘article of manufacture,’ there is more the [United States Supreme] Court could have done [in *Samsung*]; [f]or while [it is] true that not all articles of manufacture are complete commercial products, neither should all components be considered articles of manufacture.”²¹⁴ Particularly, while the Supreme Court correctly asserts that the “article of manufacture” in Section 289 of the Patent Act need not necessarily be the complete commercial product sold to consumers, but may, in some circumstances, be a lesser component thereof, its inordinately broad dictionary-based definition of the statutory term fundamentally fails to demonstrate when the relevant “article of manufacture” should be treated as the whole commercial product or as some smaller unit; nor does it announce a definitive categorical framework for identifying the relevant article where it is less than the product as a whole.²¹⁵ Thus, standing alone, the Court’s definition critically fails to resolve foundational distinctions in the protected scope of multi-component devices.

This Article proposes a comprehensive test for “identifying the relevant article of manufacture at the first step of the [Section] 289 damages inquiry.”²¹⁶ Finding inspiration in the copyright doctrine of separability, it identifies a statutory framework, judiciously delineating a more standardized approach to “article of manufacture” identification in multi-component devices, that advances a more workable and

214. McKenna, *supra* note 8.

215. *See id.* (“[T]he Court gave no guidance as to when courts should treat the relevant article of manufacture as the commercial product or as some smaller unit, nor did it explain how one should identify the relevant article if it is less than the product as a whole.”); *see also* Ronald Mann, *Opinion analysis: Justices tread narrow path in rejecting \$400 million award for Samsung’s infringement of Apple’s cellphone design patents*, SCOTUSBLOG (Dec. 6, 2016, 4:09 PM), <http://www.scotusblog.com/2016/12/opinion-analysis-justices-tread-narrow-path-in-rejecting-400-million-award-for-samsungs-infringement-of-apples-cellphone-design-patents/> [<https://perma.cc/6BMB-EH88>] (“The opinion . . . offers no guidance on how one might go about distinguishing the ‘article of manufacture’ of relevance from the actual cellphones at issue. [It is] not just that the opinion [does not] specify the relevant article of manufacture (the case? the screen? both?)—the opinion [does not] even instruct the Federal Circuit definitively to reject the entire cellphone as the article of manufacture.”); *see also* Rao, *supra* note 7 (“[T]he Supreme Court’s decision was limited in that it provided no clarification regarding the manner in which the ‘relevant ‘article of manufacture’ is determined.”).

216. *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 62 (2016).

consistent standard for determining when the relevant “article of manufacture” should comprise the whole commercial product or some smaller unit. More precisely, through the development of a “separability” test, it establishes a constructive foundation of legal guidance that is capable of distinguishing the components of a claimed design, comprising distinct parts of the whole commercial product, that constitute the relevant “article of manufacture” from those that are merely incorporated features of the whole commercial product.

A. The Problem with the Supreme Court’s Modern Reading of the Term “Article of Manufacture” in Section 289 of the Patent Act

The United States Supreme Court’s dictionary-based interpretation of the term “article of manufacture” forms an incomplete and generally unqualified definition of the statutory phrase that fundamentally fails to pragmatically achieve its deliberate purpose. Significantly, while the U.S. Supreme Court’s reconceptualization of the Section 289 term of art was intended to “encompass[] both a product sold to a consumer and a component of that product,”²¹⁷ its compilation of incredibly vague terminology, as adopted in the definition of “article of manufacture,” fails to demonstrate this “either-or” objective. Instead, the Court, by utilizing this hopelessly overbroad language, unwittingly misconstrues the intended scope of the statutory term: the term “article of manufacture,” as broadly construed in this definition, could “be read as suggesting that *any* ‘component’ can be an ‘article of manufacture’ for the purposes of [Section] 289.”²¹⁸ Therefore, neither “the Federal Circuit’s narrower reading of ‘article of manufacture’” nor the Supreme Court’s broader interpretation of the statutory term of art can be fitly “squared with the text of [Section] 289.”²¹⁹

B. The Proposed Design Patent Separability Test for Determining the

217. *Id.* at 434.

218. Burstein, *supra* note 8, at 67 (emphasis added); see Risch, *supra* note 185 (demonstrating how the U.S. Supreme Court’s broad, dictionary-based definition of the statutory term can be misinterpreted in this way); see also Shara Tibken, *Apple and Samsung face off in court over design patents once again*, CNET (May 10, 2018, 5:00 AM PT), <https://www.cnet.com/news/apple-and-samsung-face-off-again-in-san-jose-california-court-over-design-patents/> [<https://perma.cc/2D8J-FCE5?type=image>] (misconstruing the Supreme Court’s decision to mean that, while “[p]reviously, an infringing ‘article of manufacture’ [could be] considered [the] entire device[,] [n]ow an article of manufacture can be only a small portion of [the] device”).

219. *Samsung Elecs. Co.*, 580 U.S. at 61.

Relevant “Article of Manufacture” in Section 289 of the Patent Act

An appropriate test for identifying the relevant “article of manufacture” for a multi-component device at step one of the Section 289 damages inquiry is: a component-part of the whole commercial product shall be deemed the relevant “article of manufacture” in Section 289 of the Patent Act if, and only to the extent that, it is (1) physically separable from, and (2) capable of existing independently of the whole commercial product sold to consumers.

First, to be physically separable at step one of the proposed test, a component must have the capacity to be physically removed from the complete commercial product by ordinary means, while keeping intact its tangible form and recognizably distinct features.²²⁰ However, where a component, comprising an ornamental configuration or decorative embodiment, cannot be physically detached from the entire commercial product but may only achieve separability through conceptual means, it must necessarily fail the physical separability requirement, as imaginative extraction ought never to be an acceptable substitute for actual extraction.²²¹ Notably, that a conceptually separable design cannot sufficiently satisfy the physical separability requirement, at step one of the proposed test, is neither inconsistent with the fundamental principles of design patent law nor the general precepts derived therefrom.²²² Therefore, if, at step one of the proposed test, a component-part is determined to be physically separable from the whole commercial product, the “article of manufacture” inquiry must proceed to step two, and the central question should inexorably become one of independent existence. Otherwise, when a component of the complete commercial product fails to satisfy the physical separability requirement, the proposed separability test terminates at step one, and the whole commercial product shall constitute the relevant “article of manufacture,” not the component.

Next, at step two of the proposed test, for a physically separable component of the whole commercial product to sufficiently satisfy the independent-existence requirement, it must be able to exist on its own as a single unitary structure, having a concrete and physical form that is complete in itself for use or for sale. To be “complete,” under the legal framework advanced herein, the component need not necessarily be the

220. Importantly, so understood, the classification of physical separability, as applied in this proposed identification test, is consistent with that of the copyright laws.

221. Note that the conceptual separability terminology adopted herein likewise parallels that of the modern separability doctrine to copyright law.

222. See discussion *infra* Section VI.B.1.

“ultimate product sold [to] or used by the ultimate consumer.”²²³ Instead, within the statutorily defined bounds of this test, a component may be considered “complete” insofar as it is distributed for the fundamental purpose of downstream incorporation—i.e., its subsequent contribution to or integration in the final commercial product marketed to and enjoyed by the end consumer. Therefore, when confronting the independent-existence requirement, the threshold inquiry is whether the component can exist apart from the whole commercial product, notwithstanding the fact that it can be physically separated. Accordingly, under the modern separability test to design patent law, as announced in this Article, a component of the whole commercial product should be treated as the relevant “article of manufacture” if, when physically separated from the entire commercial product sold to consumers, it would qualify, on its own, as an independently discrete and otherwise complete item for use or for sale. Conversely, where a component of the entire commercial product constitutes a purely decorative or ornate feature applied to or embodied in the ultimate product’s overall design, the whole commercial product, and not a component of that product, must be treated as the relevant “article of manufacture.” Likewise, where a component of the whole commercial product is neither physically separable from nor capable of existing independently of the finished commercial product sold to or used by consumers, the relevant “article of manufacture” at step one of the U.S. Supreme Court’s Section 289 damages inquiry must necessarily comprise the whole commercial product, not a lesser component thereof.

This statutory framework forms a universally applicable test for determining the relevant “article of manufacture” at step one of the Section 289 damages inquiry that properly balances the ever-present tension between consistency and flexibility in the practice of design patent law. On the one hand, courts require a legal framework for “article of manufacture” identification that breeds consistency through uniformity by establishing a categorical blueprint that juries may unambiguously follow with confidence and ease. The proposed test offers this consistency. On the other hand, courts also need the flexibility to tailor the language utilized in the statutory framework for “article of manufacture” determinations to the myriad of fundamentally distinct patented designs and the innumerable, factually unique circumstances they pose. The separability test for “article of

223. Burstein, *supra* note 8, at 62.

manufacture” identification, proposed herein, likewise offers this flexibility.

For a demonstration on how the recommended “article of manufacture” identification test advanced in this Article is applied, and why it introduces a practical statutory framework for determining the relevant “article of manufacture” at step one of the Section 289 damages inquiry, consider the following examples.

1. The Proposed Design Patent Separability Test Applied to: The Carpet Cases

Consider first a design patent for the surface ornamentation of a carpet. Generally, as a fundamental principle of design patent law, where there exists a design for surface ornamentation, it is invariably presumed that the design, for which surface ornamentation is claimed, is inseparable from the article to which it is applied, as the design itself is incapable of existing alone—that is, the capacity for separability possessed by a design for surface ornamentation is purely conceptual.²²⁴ Thus, to achieve design patent protection, a design for surface ornamentation must necessarily comprise a definite pattern of surface ornamentation *applied to* the relevant “article of manufacture.”²²⁵ Significantly, then, a finding of mere conceptual separability—i.e., that a design, albeit physically inseparable, is nevertheless capable of being imagined separately from, or visualized independently of the whole commercial product sold to or used by consumers—is fundamentally determinative of whether the relevant “article of manufacture” must be treated as the whole commercial product or some lesser component thereof.

Accordingly, here, under the guidance of the proposed separability test, the relevant “article of manufacture” in a patented design for carpets would comprise the whole commercial product—i.e., the ultimate carpet sold to consumers, in its entirety—and not some lesser component thereof—i.e., the design for surface ornamentation applied to or embodied in the carpet itself. More specifically, because the ornamental surface design featured on a carpet constitutes a purely decorative element that is physically inseparable, or merely conceptually separable, from the carpet itself, the whole carpet, as opposed to the design for surface ornamentation subsumed thereon, must be treated as the relevant “article of manufacture.”

224. See Quinn, *supra* note 19.

225. *Id.*

This conclusion is further corroborated by an application of the proposed “article of manufacture” identification test delineated herein. The physical separability requirement, announced at step one of the proposed test, is satisfied only when a component, incorporated into the overall design of an article, can be physically removed from the whole commercial product while simultaneously keeping intact a recognizably distinct and individually tangible form apart from that product. Otherwise, where a component of the whole commercial product is subject exclusively to imaginative extraction, it is conceptually separable and, thus, fundamentally incapable of satisfying the physical separability requirement, as there is no substantively discrete or tangible form, apart from the whole commercial product, to which *de facto* separability could meaningfully attach. Consistent with this distinction, under the proposed framework, an ornamental surface design applied to or embodied in a carpet is physically inseparable, or merely conceptually separable, from the whole carpet sold to consumers for use or for sale.

To the extent that the design for surface ornamentation, when taken apart from the carpet itself, neither possesses an individually tangible form, discrete from that of the whole carpet, nor is capable of being physically detached from the ultimate carpet sold to consumers, it is evident that no physical separability exists. Thus, because a determination of conceptual separability, generally being the antithesis to a finding of physical separability, cannot effectively satisfy the *de facto* separability requirement, and because an ornamental surface design, as applied to or embodied in a carpet, is characteristically subject exclusively to conceptual separability, a design for the surface ornamentation of a carpet must necessarily fail the physical separability requirement at step one of the proposed test. This failure thereby necessitates an immediate termination of the recommended test at step one, precipitately prompting an accelerated “article of manufacture” determination irrespective of the step two independent-existence requirement.

Therefore, under this Article’s proposed “article of manufacture” identification test, and pursuant to Section 289 of the Patent Act, upon infringement, the holder of a patent claiming the ornamental surface design of a carpet is entitled to the total profits earned by the infringer from the manufacture and sale of the whole infringing carpet.

2. The Proposed Design Patent Separability Test Applied to: The

Piano Cases

For this example, consider a patent covering the design for the outer casing of a piano.²²⁶ The proposed separability framework for “article of manufacture” identification at step one of the Section 289 damages inquiry demonstrates that, as applied here, the relevant “article of manufacture” would comprise the component—i.e., the outer casing of the piano—rather than the ultimate commercial product sold to consumers—i.e., the whole piano, sold in its entirety. Namely, the ornamental design for the outer piano case must be treated as the relevant “article of manufacture” because, irrespective of its innards, the outside casing of the piano is not only physically separable from the whole commercial product but is also capable of existing on its own, as an independently discrete and otherwise complete item for use or for sale. Put differently, because the outer casing, even when physically removed from the innards of the piano, is still capable of being identified separately from, and existing independently of the whole piano sold to consumers, the outer casing of the piano, less the innards of the finished product, must necessarily constitute the relevant “article of manufacture” in Section 289 of Patent Act.

When applying the proposed “article of manufacture” identification test, delineated herein, it becomes clear that the outer shell of a piano, separate from the piano as a whole, does not comprise a merely ornamental feature or decorative characteristic that is unable to exist absent the inclusion of its inner components. To the extent that the piano’s exterior can be selected separately from the piano’s interior, it is evident that the physical separability requirement, at step one of the proposed test, is satisfied. More specifically, that there are several alternatives, which, taken together, categorically favor the power of preference, plainly demonstrates that, as is consistent with step one of the proposed test, the outer casing of the piano has the capacity to be physically removed from the complete piano by ordinary means while keeping intact its tangible form and recognizably distinct features. Likewise, when considering the independent-existence requirement at step two of the proposed test, the diversity in selection further confirms that the outer casing of a piano is capable of existing on its own as a single unitary structure, having a concrete and physical form that is complete in itself for use or for sale. Notably, under step two of the

226. For this example, imagine a set of circumstances that are factually identical to those in the *Piano* cases, where “[a] purchaser desiring a piano of a particular manufacturer may have the piano placed in any one of several cases dealt in by the maker.” *Bush & Lane Piano Co. v. Becker Bros.*, 222 F. 902, 903 (2d Cir. 1915).

proposed test, and within the framework of Section 289, a design for the outer casing of a piano, although not the ultimate product sold to or used by the ultimate consumer, is nevertheless complete insofar as it is supplied with the fundamental purpose of being incorporated into the final piano marketed to and enjoyed by the end purchaser.

Therefore, under the test for “article of manufacture” identification proposed herein, the “total profits” remedy provision of the Patent Act provides that, upon infringement, the owner of a design patent claiming the outer casing of a piano is only entitled to the infringer’s total profits from the manufacture or sale of the infringing piano case, and not to the infringer’s total profits from the manufacture or sale of the entire piano.

3. The Proposed Design Patent Separability Test Applied to: A Pencil Eraser

Now consider a hypothetical design patent for the ornamental shape of a pencil eraser.²²⁷ Applying the separability test for “article of manufacture” identification advanced herein, the relevant “article of manufacture” would be the component—i.e., the eraser itself—not the entire commercial product sold to consumers—i.e., the pencil as a whole. Particularly, to the extent that the ornamental design for an eraser, irrespective of its shape or configuration, is almost invariably detachable, by ordinary means, from the pencil as a whole, while simultaneously keeping intact a recognizably distinct and tangible form apart from the pencil, it is manifestly apparent that the physical separability requirement, at step one of the proposed test, is effectively achieved. Moreover, advancing to the independent-existence requirement at step two of the proposed test, it is also evident that the eraser, when physically separated from the pencil as a whole, is able to exist on its own as a single unitary structure, having a concrete and physical form that is complete in itself for use or for sale. Specifically, this satisfaction of the independent-existence requirement is fundamentally demonstrated through the physically separated pencil eraser’s capacity to subsist in several distinct forums and/or configurations, whether that be its attachment to a different writing apparatus—i.e., a mechanical pencil, a pen, a crayon, a colored pencil, or a marker—or its continuation as a sundered object, affixed to nothing at all—i.e., a freestanding eraser, wholly detached from all writing mechanisms.

227. For this example, assume that the writing utensil in question is a standard No. 2 pencil, having a rubber eraser, comprising a specific shape, mounted to one end.

Significantly, then, at step two of the proposed test, and consistent with the independent-existence framework introduced therein, a design for the eraser of a pencil is complete insofar as it can be *either* the ultimate product sold to or used by the ultimate consumer *or* some lesser component thereof, wholesaled to an intermediary purchaser for the singular purpose of subsequent downstream incorporation.

Therefore, under this Article's proposed test for "article of manufacture" identification, and pursuant to the Patent Act's special remedies provision, upon infringement, the owner of a design patent claiming the shape of a pencil eraser is only entitled to the infringer's total profits from the manufacture or sale of the infringing eraser, and not to the infringer's total profits from the manufacture or sale of the whole pencil.

4. The Proposed Design Patent Separability Test Applied to: The Original iPhone

In this example, consider two design patents for the first-generation iPhone, respectively claiming the ornamental shape of (1) the glass screen and (2) the black, front-facing rectangular configuration of the device, comprising rounded corners and a raised rim. Here, under the test for "article of manufacture" identification advanced in this Article, whereas, for the former, the relevant "article of manufacture" constitutes a component of the whole commercial product, for the latter, the relevant "article of manufacture" comprises the whole commercial product itself. Specifically, the relevant "article of manufacture" for the ornamental design of the glass screen would be a component—i.e., the glass screen itself—and not the entire commercial product sold to consumers—i.e., the whole smartphone; however, the relevant "article of manufacture" for the ornamental shape of the first-generation iPhone's black, front-facing rectangular configuration would be the entire commercial product sold to consumers—i.e., the whole smartphone—and not a lesser component of that product—i.e., the design for the ornamental shape or configuration applied to or embodied in the smartphone itself.

a. The Ornamental Design for the Glass Screen of the First-Generation iPhone

The ornamental design for the glass screen of a smartphone must be treated as the relevant "article of manufacture" because, under the proposed test, where a "design pertains to a component that a user or seller can physically separate from the product as a whole, that fact suggests that the design has been applied to the component alone rather

than to the complete [commercial] product” sold to or used by consumers.²²⁸ Likewise, to the extent that the glass screen for the mobile device can be sold separately from the whole commercial smartphone, as, for instance, a substitute article for replacement purposes, it is patently true that the independent-existence requirement, at step two of the proposed test, is also effectively achieved.²²⁹

Central to this conclusion is the capacity of the glass screen to be replaced or serve as a replacement. Particularly, the fact that a defective glass screen can be detached from an otherwise functioning device and, where necessary, substituted with an unimpaired equivalent substantially demonstrates that, congruous with step one of the proposed test, the glass screen is, indeed, physically separable, as it is capable of being physically removed from the whole smartphone by ordinary, or not unduly onerous, means while simultaneously keeping intact its distinct and tangible form. The same is true at step two of the proposed test. Namely, because the glass screen, when taken apart from the mobile device as a whole, has the capacity to exist on its own, through the contours of a replacement, as a single unitary structure, having a concrete and physical form that is complete in itself for use or for sale, the ornamental design for the glass screen of a first-generation iPhone sufficiently satisfies the proposed criteria for the independent-existence requirement advanced herein. Thus, within the independent-existence framework of the proposed test, the glass screen must necessarily be considered complete insofar as it is distributed purely as a replacement component for the whole commercial smartphone sold, albeit it being presumably purchased with the sole objective of subsequent incorporation into the iPhone and, so understood, individually useless on its own.

Therefore, under the proposed separability test for “article of manufacture” identification advocated for in this Article, and pursuant to Section 289 of the Patent Act, upon infringement, the owner of a design patent claiming the ornamental shape of the glass screen for the first-generation iPhone is only entitled to the infringer’s total profits from the manufacture or sale of the infringing glass screen, and not to the infringer’s total profits from the manufacture or sale of the whole smartphone.

228. Brief for the United States as Amicus Curiae Supporting Neither Party, *supra* note 138, at 29.

229. *See id.* (“The [design is applied to a component, not the complete product,] . . . if [it] is embodied in a component that is manufactured separately from the rest of the product[] or if the component can be sold separately (for instance, for replacement purposes).”).

b. The Ornamental Design for the Front-Facing Rectangular Configuration of the First-Generation iPhone

Alternatively, here, the relevant “article of manufacture” in a patented design for the black, front-facing rectangular configuration of the first-generation iPhone, unlike that of the glass screen, must comprise the whole smartphone because, under the proposed test, where a design constitutes a significant attribute of the whole commercial product sold, fundamentally influencing the overall appearance of the product in its entirety, that fact suggests that the design, being embodied in the complete commercial product itself, must extend beyond any one component incorporated therein. More simply, notwithstanding the fact that the design for the black, front-facing rectangular configuration of the original smartphone is inextricably anchored in the appearance of the iPhone as a whole, because the ornamental shape of the whole iPhone is physically inseparable, or only conceptually separable, from the device itself, it must necessarily fail the physical separability requirement at step one of the proposed test.

Adhering to the “article of manufacture” identification framework advanced in this Article, and applying the physical and conceptual separability distinction adopted at step one of the proposed test, because the design for the ornamental shape of a mobile device is inexorably tied to the underlying appearance of the ultimate device marketed to and enjoyed by consumers, it cannot realistically possess an individually tangible form, discrete from that of the whole commercial smartphone, which, in turn, has the capacity to be physically removed from the whole smartphone by ordinary means. Put differently, to the extent that an ornamental design for the shape of the first-generation iPhone can only be imagined away from the overall smartphone as merely a drawing on a piece of paper, but not as an identifiably separable nor independently existing object for use or for sale, it is abundantly clear that the design for the black, front-facing rectangular configuration of the original smartphone, being only conceptual separable from the smartphone as a whole, emphatically fails to satisfy the physical separability requirement at step one of the proposed test. This outright failure to satisfy the physical separability requirement, at step one, thereby compels an immediate cessation of the recommended test, instantaneously prompting a truncated “article of manufacture” determination, irrespective of the independent-existence requirement at step two.

Therefore, under the proposed separability test for “article of manufacture” identification advanced herein, Section 289 of the Patent Act provides that, upon infringement, the owner of a design patent

claiming the ornamental shape of the black, front-facing rectangular configuration of the first-generation iPhone is entitled to the total profits earned by the infringer from the manufacture and sale of the whole infringing smartphone.

C. The Benefits of Adopting a Comprehensive Test for Determining the Relevant “Article of Manufacture” in Section 289 of the Patent Act

Simply put, where the scope of the term “article of manufacture” is vaguely defined, and the identity of a relevant “article” cannot be conclusively determined, inventors and manufactures cannot reliably distinguish between those designs that they are legally permitted to produce and those for which the law would explicitly forbid, as a fundamental undertaking of design patent infringement. More specifically, for so long as there remains ambiguity surrounding how to determine what constitutes a relevant “article of manufacture,” inventors will continue to become increasingly dissuaded from introducing new products to the market, as they lack the intrinsic readiness required to reasonably ascertain, with more than an iota of certainty, which design features might constitute a legally protectable “article of manufacture” under Section 289 of the Patent Act.²³⁰ Thus, the definition of the term “article of manufacture” matters “to anyone who invents, produces, sells—or, indeed buys—any complex, multicomponent product.”²³¹ And, because “[b]usinesses seek clarity on the law, . . . the possibility of massive exposure for design patent infringement could have a [potentially] chilling effect, making companies wary of launching products.”²³²

The adoption of a more comprehensive legal approach, in conjunction with a single, well-defined “article of manufacture” identification test, such as the one proposed herein, would breed the uniformity necessary to remedy the current trajectory of the existing statutory framework to design patent law. More specifically, by

230. See Michael Annis & Myers Dill, *For Design Patent Owners (and Alleged Infringers), The Third Time is Not a Charm*, IPWATCHDOG (July 22, 2018, 9:45 AM), <https://www.ipwatchdog.com/2018/07/22/design-patent-owners-alleged-infringers/id=98840/> [<https://perma.cc/XTH6-EJQY>].

231. Carl Cecere, *The ‘Samsung v. Apple’ Retrial is an Opportunity to Solidify Progress on Design Patents*, LAW.COM: NAT’L L.J. (May 1, 2018, 6:26 PM), <https://www.law.com/nationallawjournal/2018/05/01/the-samsung-v-apple-retrial-is-an-opportunity-to-solidify-progress-on-design-patents/?slreturn=20200031000522>.

232. Ryan Davis, *Design Patent Damages Still Murky After \$539M Apple Verdict*, LAW360 (May 30, 2018, 8:55 PM), <https://www.law360.com/articles/1048502/design-patent-damages-still-murky-after-539m-apple-verdict>.

establishing a design patent system that has the capacity to enable stakeholders in design patented works to develop policies and practices targeted at where the relevant “article of manufacture” is most likely to be identified, the implementation of such a test would instill confidence in the larger community; that is, it would furnish a more enabling environment conducive to lucidity and greater preparedness, wherein the possibility for early foresight invites the opportunity for precautionary measures that, if imposed, may minimize the risk of exposure to future infringement damages and liabilities. A consistently structured and reliable “article of manufacture” identification test, which explicitly delineates when the relevant “article” comprises either the entire commercial product sold or a lesser component therein, would indubitably stimulate the predictability essential for effectuating a more efficient system, whereby all parties and innovators possess the requisite guidance to operate with, at a minimum, a scintilla of confidence.²³³ Moreover, by employing a more methodical framework for “article of manufacture” identification at step one of the Section 289 damages inquiry, the separability test, advanced in this Article, fosters a more predictable environment that promotes judicial efficiency by substituting generally debilitating uncertainty with more informative, instruction forward legal guidance. Importantly, this proposed legal framework will provide the inventors of design patents with an overriding awareness that presently does not exist: it will afford a fundamental and anticipatory understanding, at the forefront of the design patenting process, of the legal protections likely to be afforded and the range of remedial damages to which those protections may be entitled upon infringement. Therefore, the proposed separability test for “article of manufacture” identification, as advanced in this Article, grants owners of design patents a prospective knowledge, at the inception of the design patenting process, and not merely sometime after the infringement has already transpired, of the general rights and remedies to which they may be entitled should infringement occur.

VII. CONCLUSION

The United States Supreme Court’s decision in *Samsung* represents a meaningful transformation in the law concerning damages under Section 289 of the Patent Act;²³⁴ however, more than its general rejection of “the idea that [the] ‘article of manufacture’ must be the finished

233. See Rao, *supra* note 7.

234. See generally *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 56-62 (2016).

product sold to consumers,” the Court’s exceedingly broad opinion remains profoundly ambiguous.²³⁵ The Supreme Court’s overly simplified reading of the term “article of manufacture” extends little guidance on a decisive issue in design patent law: how to identify the relevant article of manufacture in a multifaceted product. Significantly, however, while “article of manufacture” identification can and will continue to present challenges for courts confronting the Section 289 special remedies provision, devising a more consistent identification framework to be applied at step one of the damages inquiry would substantially mitigate that difficulty.

This Article advances a comprehensive test for “identifying the relevant article of manufacture at the first step of the [Section] 289 damages inquiry.”²³⁶ More specifically, finding inspiration in the copyright doctrine of separability, this test delineates an appropriate framework for determining when the relevant “article of manufacture” should comprise the whole commercial product or some smaller unit. Through the lens of a “separability” analysis, this test advances a constructive foundation of legal guidance, whereby it establishes a more workable standard for distinguishing those components of a claimed design, comprising distinct parts of the whole commercial product, that constitute the relevant “article of manufacture” from those that are merely incorporated features of the whole commercial product. If implemented, this modern separability framework to design patent law would establish predictability through the furtherance of clearer guidelines; therefore, the adoption of the multi-component test for identifying the relevant “article of manufacture” at step one of the Section 289 damages inquiry, as proposed in this Article, would indubitably foster consistency in design patent law.

235. Daniel Fisher, *Samsung Wins At Supreme Court In \$400 Million Battle Over Apple iPhone Design*, FORBES (Dec. 6, 2016, 11:40 AM), <https://www.forbes.com/sites/danielfisher/2016/12/06/samsung-wins-at-supreme-court-in-400-million-battle-over-apple-iphone-design/#1682c0e54e81> [https://perma.cc/6MU6-GASY].

236. *Samsung Elecs. Co.*, 580 U.S. at 62.