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DETERMINING THE "ARTICLE OF MANUFACTURE" UNDER 35 U.S.C. § 289

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I. INTRODUCTION

This paper is the result of a collaborative effort among a small group of patent attorneys who specialize in design patent law and are very concerned about the future of the design patent system in the wake of the decision of the U.S. Supreme Court in *Samsung Electronics Co. v. Apple Inc.*, 137 S. Ct. 429 (2016). In this decision, the Court left open the critical question of how to determine an infringer's "article of manufacture" under 35 U.S.C. § 289 when calculating the total profit to be disgorged by the infringer. The answer to that question will have a profound effect on the effectiveness of the design patent system and the balance between incentivizing design-driven product innovation and deterring knockoff products. Moreover, the uncertainty surrounding the answer to that question requires it to be resolved as soon as possible, so that the users of the design patent system will be able to better evaluate their positions in obtaining and enforcing design patents.

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II. A BRIEF HISTORY OF 35 U.S.C. § 289

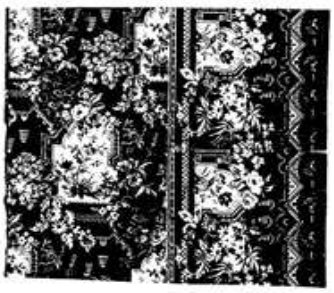
Congress acted to adopt the total profit remedy available to design patentees in 1887 after three Supreme Court decisions, *Dobson v. Hartford Carpet Co.*, 114 U.S. 439 (1885), *Dobson v. Bigelow Carpet Co.,* 114 U.S. 439 (1885), and *Dobson v. Dornan*, 118 U.S. 10 (1886), revealed the disadvantaged position of design patent holders under the then current law. The *Dobson* cases involved owners of several design patents for carpet designs: U.S. Patent Nos. D11,074; D10,778; and D10,870 (illustrated left to right below).



U.S. Patent No. D11,074



U.S. Patent No. D10,778



U.S. Patent No. D10,870

After proving infringement of their design patents by the Dobson brothers, the three patent owners sought lost profits from sales of the carpets containing the infringing designs. The Court refused this award, instead awarding the patentees six cents, relying on reasoning that Congress would eventually render inapplicable to design patentees through the Act of 1887. Since this reasoning reflects the harm that Congress sought to prevent, revisiting the *Dobson* cases provides insight into the congressional intent behind shielding design patentees from apportionment.

In *Dobson v. Hartford Carpet Co.*, the Court held that design patentees can only receive total profits from a patented article if they prove, "by reliable evidence, that the entire profit is due to the figure [or] pattern." 114 U.S. at 444. The Court also expressed the view that an article's design

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