UT LAW CLE THE UNIVERSITY OF TEXAS SCHOOL OF LAW

PRESENTED AT

15th Annual Advanced Patent Law Institute

March 12-13, 2020
Alexandria, VA

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

Perry Saidman, Elizabeth Ferrill, Damon Neagle, and Tracy Durkin

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

Perry Saidman, Elizabeth Ferrill, Damon Neagle, and Tracy Durkin[1]

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.

---

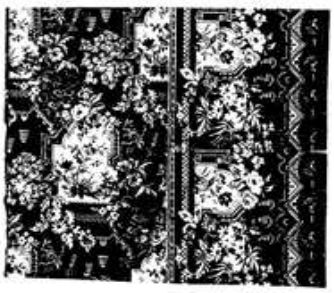
[1] Perry Saidman is the Principal of Saidman DesignLaw Group in Silver Spring, MD; Elizabeth Ferrill is a partner at Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, in Washington, DC; Damon Neagle is the Principal of Design IP of Allentown, PA; and Tracy Durkin is a Director at Sterne, Kessler, Goldstein & Fox in Washington, DC. Together, they have nearly 100 years of experience in the design patent field. In 2016 alone, they filed almost 1,300 design patent applications with the U.S. Patent and Trademark Office (USPTO) on behalf of more than 100 applicants. Mr. Saidman, as an adjunct professor, has taught Design Law at the George Washington University Law School. Ms. Durkin, as an adjunct professor, has taught Patent Law at the Antonin Scalia School of Law, George Mason University. The authors acknowledge with appreciation the contributions of other design lawyers to the ideas expressed in this paper. The opinions expressed herein are those of the authors only and do not necessarily represent those of their respective firms or any client of their respective firms.

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

Title search: Determining the "Article of Manufacture" Under 35 U.S.C. Section 289

Also available as part of the eCourse
2020 Advanced Patent Law (USPTO) eConference

First appeared as part of the conference materials for the
15th Annual Advanced Patent Law Institute session
"Potpourri of Hot Design Patent Issues: Practical Implications"