

Designing Design Patent Subject Matter

Author : Mark McKenna

Date : March 22, 2018

Sarah Burstein, [The Article of Manufacture in 1877](#), 32 *Berkeley Tech. L.J.* 1 (2017).

Designs for articles of manufacture are eligible for design patent protection under section 171 of the Patent Act if they are “new, original and ornamental.” As is clear on the face of this provision, design patent subject matter is limited to designs for “articles of manufacture”—other types of design, including architectural design, would seem to be excluded. But what exactly is *included*? What is a “design for an article of manufacture”? In an important new article, *The Article of Manufacture in 1877*, Sarah Burstein provides critical historical context on that question.

Courts and the Patent Office have in recent years given “article of manufacture” a very broad interpretation. They have, for instance, accepted as design patent subject matter the design of a spray pattern for a water fountain, the design of the shank portion of a drill bit, and graphical user interface (GUI) designs (so long as they are depicted in a little rectangle to indicate—nominally—that they show up on a screen). As a subject matter threshold, then, the article of manufacture requirement has in recent years excluded very little from design patent protection.

But the Supreme Court’s decision in [Apple v. Samsung](#) made the relevant article of manufacture central to determining damages, putting new pressure on design patent law’s understanding of that concept. The issue in *Apple v. Samsung* was the appropriate way to calculate damages in a case involving a “partial design”—that is, a case in which the design patent claimed only part of the article to which it was applied. Design patent has a special damages rule under which an infringer is “liable to the owner to the extent of his total profit, but not less than \$250.” 35 U.S.C. § 289. Congress added that rule to the Patent Act after the Supreme Court’s decision in [Dobson v. Hartford Carpet Co.](#), 114 U.S. 439 (1885), in which the Court refused to allow the owner of a patented carpet design to recover the full profits from the sale of infringing rugs. According to the Court, profits attributable to the design had to be distinguished from those attributable to the “intrinsic merits of quality and structure” of the article. Thus, in order to recover the entire profits from the sale of articles bearing the patented design, those articles must have sold for higher prices than those without the design. *Dobson*, 114 U.S. at 444.

Since there is little dispute that Congress intended § 289 as a rejection of the result in *Dobson*, courts have long understood that section to prohibit apportionment of damages. In the view of the Federal Circuit, that meant that damages in a design patent case were calculated based on sales of the entire commercial product, even if the design patent at issue claimed only a small part of the design of that product (say, the rounded corners of a device, to pick a not-so-random example). But as the Supreme Court seemed to understand, that approach implicitly attributes zero value to the function of the device or any of its other features, a consequence that seems indefensible, particularly in the context of something so complex as a smartphone. Indeed, applying its “no apportionment” rule, the Federal Circuit upheld a jury award of Samsung’s entire profit on the sale of the infringing smartphones, even though those devices employed hundreds or thousands of other patented and unpatented components.

The Supreme Court purported to solve this problem by focusing on the meaning of “article of manufacture.” While the statute requires courts to award the defendant’s “total profits,” those profits must be determined in relation to the relevant article of manufacture to which the patented design was applied. Crucially, and contrary to the Federal Circuit’s assumption, the article of manufacture need not be the entire commercial product sold to consumers; it might be something less than that. So far, so good. Unfortunately, the 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.

It seems likely, however, that the claim will prove important here: Because a design must be for an article of manufacture, the article of manufacture will be defined in relation to the claimed aspects of the broader article shown in the drawings. So understood, “partial design” is a misnomer—patents that claim only a component of the article are not partial designs of an article; instead the article is, at least in some cases, defined by reference to the claim.

If it can be operationalized, the Court’s reconceptualization of the article of manufacture may prove an elegant solution to the remedies problem. But as Burstein shows in her article, if history is our guide to the proper definition of “article of manufacture,” there is more the Court could have done here. For while it’s true that not all articles of manufacture are complete commercial products, neither should all components be considered articles of manufacture.

Surveying early case law, Burstein concludes that “article of manufacture” was a term of art that did not simply refer to any article that was manufactured. (P. 42.) “Instead, it referred to a tangible item—other than a machine or a composition of matter—with a unitary structure made by humans and complete in itself for use or for sale.” (P. 43.) That definition didn’t exclude all components; indeed, several of the cases Burstein cites involve design patents on parts. But only those components that were manufactured separately and identifiable as discrete parts (even if ultimately combined into a bigger commercial product) counted.

That’s obviously not a self-applying rule. Among other things, its workability depends on courts’ ability to identify the claimed design as a relevant *part* of a product and not just as a feature of the product. That may sometimes be quite difficult. Still, conceiving of the article of manufacture in this way frames the inquiry very differently, and the implications go far beyond remedies. As Burstein highlights, the remedies problem is illustrative of a much bigger issue: Because the PTO and the courts have paid so little attention to what should count as a relevant article of manufacture, they have extended design patent protection to a number of designs that are subject to the *Apple v. Samsung* problem. Rather than solving it at the remedies stage, perhaps the better approach is to reconsider the scope of design patent subject matter.

Rethinking subject matter would go a long way toward addressing a number of other problems in design patent law. Accepting that one can patent small portions of the design of an article has made claiming more mysterious. That, in turn, has made it difficult for courts to compare claimed designs to the prior art to assess novelty and obviousness. It has exacerbated the difficulties courts face in giving a valid design its proper scope. Burstein acknowledges that there may be reasons to depart to some degree from the 1877 approach, particularly in light of the range of designs now impacted by design patent. But we can do so, she argues, without surrendering the idea that the article of manufacture has limiting content—the “article of manufacture” cannot just be whatever the claimant suggests it is. That’s a lesson that could profoundly affect all of our thinking about design patents for years to come.

Cite as: Mark McKenna, *Designing Design Patent Subject Matter*, JOTWELL (March 22, 2018) (reviewing Sarah Burstein, *The Article of Manufacture in 1877*, 32 **Berkeley Tech. L.J.** 1 (2017)), <https://ip.jotwell.com/designing-design-patent-subject-matter/>.