

# THE “ARTICLE OF MANUFACTURE” IN 1887

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## ABSTRACT

One of the most important questions in contemporary design patent law is how to interpret the phrase “article of manufacture” in 35 U.S.C. § 289. While there has been much discussion about what Congress intended when it enacted the predecessor to § 289 in 1887, there has been little discussion about what the phrase “article of manufacture” meant in 1887. This Article aims to fill that gap. It examines the relevant statutory text, late nineteenth-century patent treatises, Patent Office decisions, and court cases. Based on this evidence, this Article concludes that in 1887, the phrase “article of manufacture” was not a synonym for “product” and did not refer to any “thing made by hand or machine.” Instead, “article of manufacture” was a term of art that 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. This historical evidence should be considered in evaluating arguments about the statute’s “plain meaning” and the original congressional intent. It also undercuts both the Federal Circuit and Supreme Court interpretations of the phrase “article of manufacture.” Additionally, this evidence demonstrates that, because machines were not considered “articles of manufacture” in 1887, the 45th Congress did not intend the results decreed by the Federal Circuit in its 2015 decisions in *Apple v. Samsung* and *Nordock v. Systems*.

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## I. INTRODUCTION

Section 289 of the Patent Act provides that any person who, “without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250 . . . .”<sup>1</sup> This remedy has been a part of U.S. patent law since 1887, but the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) did not have to decide how to interpret the phrase “article of manufacture” in § 289 until 2015.<sup>2</sup>

In its 2015 decisions in *Apple v. Samsung* and *Nordock v. Systems*, the Federal Circuit ruled that when design patent owners prevail on infringement claims, § 289 requires courts to award no less than the “total profit from the article of manufacture bearing the patented design”<sup>3</sup> and that, in this context, “article of manufacture” means the entire infringing

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1. 35 U.S.C. § 289 (2012); *see also* Sarah Burstein, *The Patented Design*, 83 TENN. L. REV. 161, 219 (2015) [hereinafter Burstein, *The Patented Design*] (noting that this provision “provides design patent owners with a special remedy for certain commercial acts of infringement”). Design patent owners are also entitled to most of the other remedies available under the Patent Act, including monetary remedies under 35 U.S.C. § 284. *See* Sarah Burstein, *Costly Designs*, 77 OHIO ST. L.J. 107, 118–19 (2016) [hereinafter Burstein, *Costly Designs*]. However, provisional rights are not available for regular design patent applications because those applications are not published prior to issuance. *See* 35 U.S.C. § 154(d)(3); 35 U.S.C. § 122(b)(2)(iv).

2. *See infra* Section III.B.1.a). The Federal Circuit has had exclusive jurisdiction over patent appeals since 1982. *See* Federal Courts Improvement Act of 1982, 28 U.S.C. § 1295(a)(1).

3. *See* *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1001–02 (Fed. Cir. 2015), *rev’d sub nom.* *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016).

product.<sup>4</sup> In its 2016 decision in *Samsung v. Apple*, the Supreme Court rejected the Federal Circuit’s interpretation, stating “[t]he term ‘article of manufacture,’ as used in § 289, encompasses both a product sold to a consumer and a component of that product”<sup>5</sup> because “[a]n ‘article of manufacture’ . . . is simply a thing made by hand or machine.”<sup>6</sup> The Court, however, refused to provide any test or further guidance regarding how lower courts should decide what constitutes the relevant “article” in a given case.<sup>7</sup> So now, the question of how to interpret the phrase “article of manufacture” in § 289 is more important than ever. Hundreds of millions of dollars hang in the balance in *Apple* alone.<sup>8</sup>

Throughout the *Apple* and *Nordock* litigation, there has been much discussion about what Congress intended when it enacted the predecessor to § 289 in 1887.<sup>9</sup> However, there has been little discussion about what the phrase “article of manufacture” meant in 1887.<sup>10</sup> This Article aims to fill that gap. It is the first article to comprehensively examine what the phrase “article of manufacture” meant when Congress enacted the predecessor to § 289 in 1887.<sup>11</sup> It examines what the phrase “article of manufacture” meant

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4. *Id.* at 1002; *Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344, 1354 (Fed. Cir. 2015), *rev’d sub. nom. Sys., Inc. v. Nordock, Inc.*, 137 S. Ct. 589 (2016). These cases are discussed in more detail *infra* Section III. Unless indicated otherwise, this Article will use the word “product” to mean “something sold by an enterprise to its customers.” KARL T. ULRICH & STEVEN D. EPPINGER, *PRODUCT DESIGN AND DEVELOPMENT* 2 (5th ed. 2011).

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

6. *Id.* at 435.

7. *See id.* at 436.

8. *See* Brief for Petitioners at 5, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 6599922 (noting that the \$399 million award that was at issue on certiorari was only part of the potential profits award).

9. *See, e.g.*, Brief for Roger Cleveland Golf Company, Inc. as Amicus Curiae in Support of Respondent at 22, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 4205620 (“Congress has seen fit to retain the relevant ‘total profit’ statutory language and hence has retained intact its intent since 1887, for nearly 130 years . . . .”); Brief for Computer & Communications Industry Association in Support of Petitioner at 3, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 3227039 (“Congress never intended the ‘article of manufacture’ to automatically swallow the end-good in which the article incorporating an infringing design is included.”).

10. A few of the *Samsung v. Apple* amicus briefs touched on some of the cases and decisions discussed in this Article. *See, e.g.*, Brief for The Internet Association et al. as Amici Curiae Supporting Petitioners at 15–17, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 3194217. But none conducted an in-depth analysis of all of the historical evidence discussed here.

11. In a 2013 article, William J. Seymour and Andrew W. Torrance noted that the meaning of “article of manufacture” has changed over time but focused their analysis mainly on twentieth century case law and late-twentieth century Patent Office decisions.

in the context of statutory subject matter—considering the relevant statutory text, Patent Office decisions, and judicial decisions—and analyzes the history behind the enactment of the 1887 Patent Act. This Article concludes that in 1887, the phrase “article of manufacture” was a term of art in U.S. patent law that 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.<sup>12</sup> There is no evidence that Congress meant to depart from this well-established meaning when it enacted the predecessor to § 289.<sup>13</sup>

This does not necessarily mean that courts must read the phrase “article of manufacture” in § 289 the same way as it was read in 1887.<sup>14</sup> But this historical context has important implications for current debates over the intent and interpretation of § 289. For example, the historical evidence indicates that in 1887, “article of manufacture” was a term of art in U.S. patent law.<sup>15</sup> This undermines the Federal Circuit’s “plain meaning” interpretation of § 289.<sup>16</sup> This evidence also shows that in 1887, the phrase “article of manufacture” was not a synonym for “product”<sup>17</sup> and that Congress did not intend the results in *Apple* and *Nordock* because, among other reasons, machines were not considered “articles of manufacture.”<sup>18</sup> The evidence further demonstrates that in 1887, “article of manufacture” did not mean any “thing made by hand or machine.”<sup>19</sup> Therefore, the Supreme Court’s dictionary-based interpretation was incomplete, at least as a historical matter.<sup>20</sup>

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See William J. Seymour & Andrew W. Torrance, *(R)evolution in Design Patentable Subject Matter: The Shifting Meaning of “Article of Manufacture”*, 17 STAN. TECH. L. REV. 183, 190–205 (2013). Other commentators have criticized the district court’s “total profits” ruling in *Apple v. Samsung* but have not focused on the “article of manufacture” issue. See Mark A. Lemley, *A Rational System of Design Patent Remedies*, 17 STAN. TECH. L. REV. 219, 221 (2013); Thomas F. Cotter, *Reining in Remedies in Patent Litigation: Three (Increasingly Immodest) Proposals*, 30 SANTA CLARA HIGH TECH. L.J. 1, 20–21 (2013).

12. See *infra* Section V.A.

13. See *infra* Section IV.B.2.

14. There are good reasons for courts to readopt this historical meaning of “article of manufacture.” However, a full discussion of those reasons is beyond the scope of this Article.

15. See *infra* Section V.A.

16. See *infra* Section V.A.

17. See *infra* Section V.B.1.

18. See *infra* Section V.C.

19. See *infra* Section V.B.2.

20. See *infra* Sections III.B.2, V.A.

This Article proceeds in six parts. Part II provides a brief introduction to the relevant portions of U.S. design patent law. Part III provides a critical analysis of the Federal Circuit's interpretation of the phrase "article of manufacture" in § 289 and the Supreme Court's reversal of that interpretation. Part IV examines the relevant statutory text, late nineteenth-century patent treatises, Patent Office decisions, and court cases to determine what the phrase "article of manufacture" meant in 1887. Part V discusses the lessons that can be learned from—and some key implications of—the historical evidence presented in Part IV. Part VI addresses some potential objections.

## II. DESIGN PATENTS – A BRIEF INTRODUCTION

Like other patents, design patents are granted by the United States Patent and Trademark Office ("USPTO") following substantive examination.<sup>21</sup> Like other patents, design patents are subject to the statutory requirements of novelty and nonobviousness.<sup>22</sup> The Federal Circuit has exclusive jurisdiction over appeals from design patent cases, like it does for other patent cases.<sup>23</sup> However, design patents differ from other patents in important ways, including what types of inventions are protected, how those inventions are claimed, and how courts evaluate infringement. This Section describes the current law regarding design patent claiming, design patent infringement, and design patentable subject matter.

### A. STATUTORY SUBJECT MATTER

Since 1902, design patents have been available for "any new, original, and ornamental design for an article of manufacture."<sup>24</sup> Today, that language appears in § 171(a) of the Patent Act.<sup>25</sup> There are three key

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21. See 35 U.S.C. § 131 (2012). Currently, the United States grants three types of patents: utility patents, plant patents, and design patents. U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 200-01 (9th ed. 7th rev., Nov. 2015) [hereinafter MPEP].

22. See 35 U.S.C. § 171(b) (Supp. I 2013); see also *id.* §§ 102, 103. However, courts use different tests for novelty and nonobviousness in the design patent context than they do in the utility patent context. See Sarah Burstein, *Moving Beyond the Standard Criticisms of Design Patents*, 17 STAN. TECH. L. REV. 305, 322–28 (2013).

23. See 28 U.S.C. 1295(a) (2012).

24. Act of May 9, 1902 ch. 783, 32 Stat. 193, 193 (amending Rev. Stat. § 4929); Act of July 19, 1952, ch. 950, 66 Stat. 805 (codified at 35 U.S.C. § 171 (2012)); 35 U.S.C. § 171(a) (Supp. I 2013).

25. 35 U.S.C. § 171(a) (Supp. I 2013).

requirements for design patentable subject matter; this Section discusses them in turn.<sup>26</sup>

### 1. “Ornamental”

Ornamentality has been an explicit requirement for design patentability since 1902.<sup>27</sup> Under current Federal Circuit case law, a design will be deemed “ornamental” unless: (1) there are no alternative designs with “the same or similar functional capabilities,”<sup>28</sup> or (2) the design is concealed during the entire lifetime of the completed product.<sup>29</sup> These conditions rarely occur. There are almost always alternative designs available. And almost every part of every product is visible to someone at some point during the product’s lifecycle, even if only during repairs. Therefore, the USPTO regularly grants—and courts are required to uphold—design patents for designs that are valuable solely for their utilitarian (as opposed to aesthetic) characteristics<sup>30</sup> and for designs that are not intended to be seen by their end users.<sup>31</sup>

### 2. “Design”

For the first sixty years of the U.S. design patent system, Congress set forth the types of patentable designs in long, detailed lists.<sup>32</sup> The first design patent act protected, for example, “any new and original design for the

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26. To date, the phrase “new and original” has not been given independent significance in design patent case law. *But see* Int’l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1238 (Fed. Cir. 2009) (suggesting in dicta that the originality requirement “likely was designed to incorporate the copyright concept of originality—requiring that the work be original with the author . . .”) (citing 1–2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01 (2005)).

27. *See* Act of May 9, 1902, ch. 783, 32 Stat. 193, 193 (revising Rev. Stat. § 4929); Act of July 19, 1952, ch. 950, 66 Stat. 805 (codified at 35 U.S.C. § 171 (2012)); 35 U.S.C. § 171(a) (Supp. I 2013).

28. *See* Sarah Burstein, *Commentary: Faux Amis in Design Law*, 105 TRADEMARK REP. 1455, 1456–57 (2015) (quoting *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1331 (Fed. Cir. 2015)).

29. *Id.* at 1457 (explaining the Federal Circuit’s “hidden in use” rule).

30. *See, e.g.*, Integrated Supercharger and Charge-Air Cooler System, U.S. Patent No. D762,246 (issued July 26, 2016); Medical Connector, U.S. Patent No. D761,421 (issued July 12, 2016); Busbar, U.S. Patent No. D757,657 (issued May 31, 2016).

31. *See, e.g.*, Interbody Implant, U.S. Patent No. D748,263 (issued Jan. 26, 2016); Mattress Foundation, U.S. Patent No. D682,594 (Hartley) (issued May 21, 2013); Turf Underlayment, U.S. Patent No. D637,318 (issued May 3, 2011).

32. *See, e.g.*, Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44. The word “design,” by itself, provides little help in defining the universe of covered subject matter. *See* Burstein, *The Patented Design*, *supra* note 1, at 166; Burstein, *supra* note 22, at 308.

printing of woollen, silk, cotton, or other fabrics” and “any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material.”<sup>33</sup> Beginning in 1902, however, Congress took a new approach, revising the statute to state that design patents could be obtained for “any . . . design for an article of manufacture.”<sup>34</sup> This language is still used today.<sup>35</sup>

Regardless of the precise statutory language used, it has long been held that there are two classes of protectable designs—designs for “surface ornamentation applied to an article” and designs for “the configuration or shape of an article”—and that applicants can claim a design for configuration, surface ornamentation, or a combination of both.<sup>36</sup> Today, however, design patent applicants can define their “design” as something less than an entire configuration or surface ornamentation design. This change can be traced back to a 1980 decision by the Court of Customs and Patent Appeals (“CCPA”).<sup>37</sup>

In *Zahn*, the applicant claimed a design for the shank portion of a drill bit.<sup>38</sup> The drill bit was “integral—all in one piece.”<sup>39</sup> The applicant submitted the following drawings, using dotted lines to indicate the portions of the drill bit he wished to exclude from the scope of his claim<sup>40</sup>:

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33. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44.

34. Act of May 9, 1902, ch. 783, 32 Stat. 193, 193 (revising Rev. Stat. § 4929).

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

36. See MPEP, *supra* note 21, at § 1502; *In re Schnell*, 46 F.2d 203, 209 (C.C.P.A. 1931); *Gorham Mfg. Co. v. White*, 81 U.S. 511, 525 (1871). In contemporary design patent law and practice, “configuration or shape” is generally understood to mean “any three-dimensional design” and “surface ornamentation” as “any two-dimensional design.” See, e.g., MPEP, *supra* note 21, at § 1504.01(a)(I)(A) (suggesting that any “2-dimensional images” would qualify as “surface ornamentation”). This marks a significant change from the past. Compare, e.g., *id.*, with *Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37, 40.

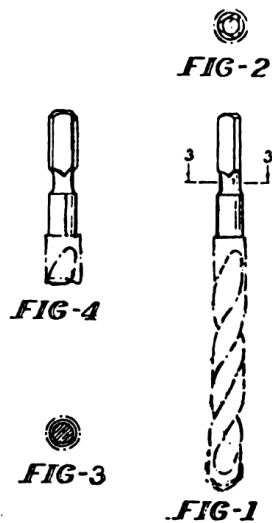
37. See *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980). In its first decision, the Federal Circuit adopted the precedents of the CCPA as its own. *South Corp. v. United States*, 690 F.2d 1368, 1370 (Fed. Cir. 1982).

38. *Zahn*, 617 F.2d at 263.

39. See *id.*; see also *id.* at 262 (showing the applicant’s drawings).

40. *Id.* at 262–63.





The USPTO rejected the claim because, among other reasons, “a design which is embodied in less than all of an article of manufacture at least in one which is an integral or one-piece article such as a drill, or a screwdriver” did not qualify as “any new, original and ornamental design for an article of manufacture.”<sup>41</sup> The CCPA reversed, holding that “a design for an article of manufacture may be embodied in less than all of an article of manufacture.”<sup>42</sup>

Since *Zahn*, design patent applicants have been allowed to claim any portion—or portions—of a configuration or surface ornamentation design as their “design.” These portions do not have to be physically separable or be manufactured separately; like the claim in *Zahn* itself, the claimed portion can be a fragment of a solid whole.<sup>43</sup> Nothing in *Zahn* requires that the claimed portion (or portions) cover an important, salient, or otherwise

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41. *Id.* at 267.

42. *Id.* This was a radical redefinition of the statutory term “design.” Compare *id.*, with, e.g., *Ex parte Pope*, 1883 Dec. Comm’r Pat. 74, and *Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37. However, a full discussion of that issue is beyond the scope of this Article.

43. This is sometimes referred to as “partial claiming.” See, e.g., Burstein, *Costly Designs*, *supra* note 1, at 114 n.49. It may be more accurately referred to as “fragment claiming.” However, a full discussion of this nomenclature issue is beyond the scope of this Article.

material part of the overall design. An applicant is free to claim whatever best serves their strategic purposes.<sup>44</sup>

### 3. “Article of Manufacture”

Ever since Congress passed the first U.S. design patent statute in 1842, the phrase “article of manufacture” has been used to define design patentable subject matter.<sup>45</sup> The interpretation of this phrase under the current Patent Act is discussed in detail below.<sup>46</sup>

## B. CLAIMING DESIGNS

Today, a design patent can contain only one claim.<sup>47</sup> The verbal portion of the claim is pro forma; it “shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described.”<sup>48</sup> The claimed design must be “shown” using drawings or photographs.<sup>49</sup> In a drawing, the claimed design must be shown in solid lines.<sup>50</sup> Any disclaimed matter<sup>51</sup> must be shown in broken lines.<sup>52</sup> Broken lines can also be used to illustrate environmental matter<sup>53</sup> or “to define the bounds of a claimed design . . . when a boundary does not exist in reality in the article embodying the design.”<sup>54</sup> In the latter case, “[i]t would be understood that the claimed design extends to the boundary but does not include the boundary.”<sup>55</sup> These boundary lines are often, though not always,

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44. These types of claims are valuable strategically because they broaden the scope of protection. *See, e.g.,* Michael P.F. Phelps, *Broadening Design Patents to Disclaim Subject Matter: How Little Is Too Much?*, FED. LAW., August 2013, at 12.

45. *See* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44; Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248; Act of July 8, 1870, ch. 230, § 24, 16 Stat. 198, 201; Act of May 9, 1902, ch. 783, 32 Stat. 193, 193 (codified as amended at Rev. Stat. § 4929); Act of July 19, 1952, ch. 950, 66 Stat. 805 (codified at 35 U.S.C. § 171 (2012)); 35 U.S.C. § 171(a) (Supp. I 2013); REVISED STATUTES OF THE UNITED STATES 962 (1st ed. 1875) (reproducing Rev. Stat. § 4929).

46. *See infra* Section III.A.

47. 37 C.F.R. § 1.153 (2016). That was not always the case. From 1870 to 1898, the Patent Office allowed multiple claims in design patents. *See* WILLIAM L. SYMONS, *THE LAW OF PATENTS FOR DESIGNS* 90 (1914).

48. 37 C.F.R. § 1.153(a) (2016).

49. *See id.*; MPEP, *supra* note 21, at § 1503.02.

50. *See* MPEP, *supra* note 21, at § 1503.01(III) (“Full lines in the drawing show the claimed design.”).

51. *See supra* Section II.A.2 (discussing *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980)).

52. MPEP, *supra* note 21, at § 1503.02(III).

53. *Id.*

54. *Id.*

55. *Id.*

indicated using dot–dash lines.<sup>56</sup> No verbal description of the design is required; however, if certain drawing conventions are used, their use must be described in the specification.<sup>57</sup>

### C. DESIGN PATENT INFRINGEMENT

Like utility patents, a design patent is infringed by anyone who makes, uses, sells, offers to sell, or imports the patented invention without permission of the patentee.<sup>58</sup> To determine whether an accused product embodies “the patented invention,” however, courts do not use the “all elements” test used in utility patent cases.<sup>59</sup> Instead, courts use a specialized design patent infringement test.

The contemporary test for design patent infringement was announced by the en banc Federal Circuit in its 2008 decision in *Egyptian Goddess, Inc. v. Swisa, Inc.*<sup>60</sup> Under *Egyptian Goddess*, a design patent is infringed when “an ordinary observer, familiar with the prior art, would be deceived into thinking that the accused design was the same as the patented design.”<sup>61</sup> In this context, “the patented design” means “the claimed design.”<sup>62</sup> Therefore, in analyzing infringement, the fact finder must compare the claimed portion of the design—i.e., whatever is shown in solid lines in the patent drawings—to the corresponding portion of the accused design.<sup>63</sup> If the relevant portion looks “the same,” in light of the prior art, the patent is infringed.<sup>64</sup>

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56. See Sarah Burstein, *In re Owens*, PATENTLY-O (Mar. 29, 2013), <http://patentlyo.com/patent/2013/03/in-re-owens.html>.

57. See, e.g., MPEP, *supra* note 21, at § 1503.02(III).

58. 35 U.S.C. § 271(a) (2012); see also 35 U.S.C. § 171(b) (Supp. I 2013) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”).

59. See generally *TIP Sys., LLC v. Phillips & Brooks/Gladwin, Inc.*, 529 F.3d 1364, 1379 (Fed. Cir. 2008) (“Under the ‘all elements’ rule, to find infringement, the accused device must contain ‘each limitation of the claim, either literally or by an equivalent.’” (quoting *Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005))).

60. See 543 F.3d 665, 672 (Fed. Cir. 2008) (en banc).

61. *Id.* at 672.

62. See, e.g., *id.* (indicating that the infringement analysis should compare “the claimed and accused designs”) (emphasis added).

63. See, e.g., *Hutzler Mfg. Co. v. Bradshaw Int’l, Inc.*, No. 1:11-cv-07211, 2012 WL 3031150, at \*9-10 (S.D.N.Y. July 24, 2012).

64. See *Egyptian Goddess*, 543 F.3d at 672; see also Burstein, *The Patented Design*, *supra* note 1, at 166 (discussing the role of the prior art in this analysis). In *Egyptian Goddess*, the Federal Circuit incorporated some of the language from—and suggested that it was adopting—the test announced by the Supreme Court in *Gorham Manufacturing Co.*

### III. THE “ARTICLE OF MANUFACTURE” TODAY

The phrase “article of manufacture” appears in two key provisions of the Patent Act—§ 171, which defines the scope of design patentable subject matter,<sup>65</sup> and § 289, which provides design patent owners with an additional remedy for certain acts of infringement.<sup>66</sup> This Section discusses how courts have interpreted the phrase “article of manufacture” in both of these contexts.

#### A. STATUTORY SUBJECT MATTER

The statutory language that defines design patentable subject matter—that design patents will be available for “any new, original, and ornamental design for an article of manufacture”—has not changed since 1902.<sup>67</sup> When the Patent Act was overhauled in 1952, Congress codified this language in 35 U.S.C. § 171, where it remains to this day.<sup>68</sup> Over the past fifty years, specialized patent courts and the USPTO have interpreted the phrase “article of manufacture” in § 171 quite broadly.

##### 1. *In re Hruby* (1967)

In *Hruby*, the CCPA held, with little support or analysis, design patents for patterns “formed by continually moving droplets of water in a

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v. *White*. See *id.* at 678, 683 (citing *Gorham Mfg. Co. v. White*, 81 U.S. 511 (1871)). However, the contemporary test differs from *Gorham* in at least one important respect. The *Gorham* test, as it was understood in the late nineteenth century, required the factfinder to compare the entire article “invented and produced” by the patentee to the entire article sold or manufactured by the defendant, regardless of the patent’s claim language. See, e.g., *Jennings v. Kibbe*, 10 F. 669, 670–71 (C.C.S.D.N.Y. 1882); *Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37, 45. The current test for design patent infringement does *not* require an article-level comparison when the patent disclaims portions of a design. See *supra* notes 62–63 and accompanying text. The shift from a full-article comparison to a claimed-portion comparison occurred sometime prior to *Egyptian Goddess*. See, e.g., *id.*; *E. Am. Trio Prod., Inc. v. Tang Elec. Corp.*, 97 F. Supp. 2d 395, 405 (S.D.N.Y. 2000). However, a full exploration of the timing and circumstances of this change is beyond the scope of this Article.

65. See *supra* Section II.A.3.

66. See 35 U.S.C. § 171(a) (Supp. I 2013); 35 U.S.C. § 289 (2012).

67. See *supra* Section II.A.

68. An Act to Revise and Codify the Laws Relating to Patents and the Patent Office and to Enact the Laws into Title 35 of the United States Code, Pub. L. No. 82-593, ch. 950, 66 Stat. 792 (1952). In 2013, Section 171 was divided into three subparts, among other changes not relevant to this Article, as part of the America Invents Act; however, the relevant language did not change. Compare 35 U.S.C. § 171 (2012), with 35 U.S.C. § 171(a) (Supp. I 2013), as amended by Pub. L. No. 112-211, § 202(a), 126 Stat. 1527, 1535 (2012).

fountain”<sup>69</sup> satisfied the “article of manufacture” requirement of § 171.<sup>70</sup> In doing so, the court suggested anything “made by man” would qualify as an article of manufacture.<sup>71</sup> In its decision, the CCPA did not mention any of the prior judicial or administrative interpretations of the phrase “article of manufacture.”<sup>72</sup>

## 2. *In re Zahn* (1980)

Even though the CCPA’s decision in *Zahn* turned on the definition of the word “design,”<sup>73</sup> *Zahn* changed how many thought about the phrase “article of manufacture.” Following *Zahn*, an applicant can disclaim any portion—or portions—of a configuration design using dotted lines.<sup>74</sup> Conceptually, the *Zahn* rule can be viewed two ways; it could be understood as allowing applicants to claim only *part* of a design for the configuration of an article of manufacture or as allowing applicants to claim a complete design for the configuration of *part* of an article of manufacture. Thus, some commentators have read *Zahn* as redefining “article of manufacture” to include “part of an article.”<sup>75</sup>

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69. *In re Hruby*, 373 F.2d 997, 1002 n.1 (C.C.P.A. 1967) (Worley, C.J., dissenting) (“Appellant concedes that[:] ‘Each application here under consideration is a design formed by continually moving droplets of water in a fountain. . . . Although there is a spray head and a catch basin, these mechanical appurtenances do not form a part of the design.’” (emphasis omitted)).

70. *Id.*

71. *Id.* at 1000 (“The fountains are certainly made by man (manufactured) for sale to and use by such buyers.”).

72. There were, in fact, prior interpretations. See *infra* Section IV.

73. See *supra* Section II.A.2; see also Janice M. Mueller, *Essay: The Supreme Court Reinstates Apportionment of Design Patent Infringers’ Total Profits for Multicomponent Products*, in 2 MUELLER ON PATENT LAW § 23.04[B] (forthcoming 2017) (“*Zahn* did not redefine ‘article of manufacture’ to mean something less than the complete product sold to consumers.”), <https://ssrn.com/abstract=2882765>. Nonetheless, the CCPA relied on *Hruby*—a case about the meaning of “article of manufacture”—in support of its decision in *Zahn*. See *In re Zahn*, 617 F.2d 261, 268 (C.C.P.A. 1980) (“In *In re Hruby*, the shape of the water sprayed by a fountain was held proper design patent subject matter, indicative of a liberal construction of § 171.” (internal citation omitted)).

74. See Burstein, *Costly Designs*, *supra* note 1, at 114–115 (discussing contemporary claiming practices and rules).

75. See, e.g., Kevin E. Mohr, *At the Interface of Patent and Trademark Law: Should A Product Configuration Disclosed in a Utility Patent Ever Qualify for Trade Dress Protection?*, 19 HASTINGS COMM. & ENT. L.J. 339, 357 n.69 (1997) (stating that *Zahn* held that “part of an article—the shank of a drill bit—qualifies as an ‘article of manufacture’”). Indeed, throughout its opinion, the CCPA referred to the drill bit as the relevant “article of manufacture,” but repeatedly referred to the claim as covering a design *for* “the shank

### 3. *The GUI Guidelines*

In the mid-1990s, the USPTO decided that graphical user interface (“GUI”) designs constitute proper statutory subject matter for design patents.<sup>76</sup> According to the USPTO, “[c]omputer-generated icons, such as full screen displays and individual icons” are “surface ornamentation” and as long as “an application claims a computer-generated icon shown on a computer screen, monitor, other display panel, or a portion thereof, the claim complies with the ‘article of manufacture’ requirement of 35 U.S.C. 171.”<sup>77</sup> This interpretation of the statute is based on questionable logic<sup>78</sup> and has not been tested in litigation or ratified by any court.<sup>79</sup> Nonetheless, the USPTO continues to grant design patents for these types of designs at a rapid pace.<sup>80</sup>

The USPTO does not require a design patent applicant to show or even identify what type of device the screen—or other type of display panel—is attached to or incorporated into.<sup>81</sup> According to the USPTO, the relevant “article of manufacture” is the screen itself, not the device that generates the GUI display.<sup>82</sup>

#### B. REMEDY

Design patent owners are entitled to almost all of the remedies available to utility patent owners.<sup>83</sup> For example, a design patent owner may obtain injunctive relief under 35 U.S.C. § 283 and recover damages under 35

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portion,” not a design *for* a drill bit. *Compare, e.g., Zahn*, 617 F.2d at 267, *with, e.g., id.* at 263.

76. See Seymour & Torrance, *supra* note 11, at 206–14 (criticizing this shift); Jason J. Du Mont & Mark D. Janis, *Virtual Designs*, 17 STAN. TECH. L. REV. 107, 123–28 (2013) (applauding this shift).

77. MPEP, *supra* note 21, at § 1504.01(a)(I).

78. See *e.g.*, Seymour & Torrance, *supra* note 11, at 206–14 (criticizing the USPTO’s current policy regarding GUI designs). There are a number of other problems with the USPTO’s policy regarding GUI designs; however, a full discussion of those problems is beyond the scope of this Article.

79. To the best of the author’s knowledge, *Apple v. Samsung* was the first case in which a GUI design patent was actually asserted in court. It is certainly the first such case litigated to a published decision.

80. See Du Mont & Janis, *supra* note 76, at 129 (“Virtual designs are among the fastest growing segments of design patent filings at the USPTO.”).

81. See MPEP, *supra* note 21, at § 1504.01(a).

82. See *id.* But see Lance L. Vietzke, *Software As the Article of Manufacture in Design Patents for Icons*, 21 AIPLA Q.J. 138, 139 (1993) (“This Article argues that the software which produces an icon is the article of manufacture.”).

83. See *supra* note 1.

U.S.C. § 284.<sup>84</sup> Section 289 provides an additional remedy for certain acts of design patent infringement.<sup>85</sup> It states that:

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any *article of manufacture* for the purpose of sale, or (2) sells or exposes for sale any *article of manufacture* to which such design or colorable imitation has been applied shall be liable to the owner *to the extent of his 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.<sup>86</sup>

This provision was enacted in its current form when the Patent Act was overhauled in 1952.<sup>87</sup> The Federal Circuit did not, however, interpret the phrase “article of manufacture” in § 289 until 2015.<sup>88</sup>

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84. See generally 35 U.S.C. § 171(b) (Supp. I 2013).

85. See Burstein, *Costly Designs*, *supra* note 1, at 118–19.

86. 35 U.S.C. § 289 (2012) (emphasis added).

87. See Act of July 19, 1952, ch. 950, 66 Stat. 797, 813–14. 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. 1–23 DONALD S. CHISUM, CHISUM ON PATENTS § 23.02 (2015) (“In the Patent Act of 1952, the design patent statutes were carried forward without substantive change in Sections 171, 172, 173, and 289.” (parenthetical omitted)); see also Brief for the United States as Amicus Curiae Supporting Neither Party at 13, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 3194218 [hereinafter Gov’t Brief] (“In 1952, when Congress reenacted the ‘total profit’ standard in Section 289, it did not materially alter the statutory text or suggest any disagreement with the settled understanding of that language.” (citing *Patent Law Codification and Revision: Hearings on H.R. 3760 Before Subcomm. No. 3 of the Comm. on the Judiciary*, 82d Cong., 1st Sess. 109–10 (1951) (statement of P.J. Federico, U.S. Patent Office))).

88. Although the Federal Circuit decided other cases involving awards of profits pursuant to § 289 where the patent-in-suit claimed less than an entire product configuration, the meaning of the phrase “article of manufacture” was not disputed in those prior cases. See *Alan Tracy, Inc. v. Trans Globe Imports, Inc.*, 60 F.3d 840, 1995 WL 331109, at \*2 (Fed. Cir. 1995); *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437 (Fed. Cir. 1998). In *Nike*, the Federal Circuit discussed the history and purpose of § 289 but did not actually address—let alone decide—how to interpret “article of manufacture.” 138 F.3d at 1441–43. In *Nike*, the patent-in-suit only claimed a design for a shoe upper but the parties agreed that, if Nike was entitled to profits, it was entitled to the profits from the whole shoe. See *Nike*, 138 F.3d at 1447; *Nike Inc. v. Wal-Mart Stores Inc.*, No. 1:96-cv-00038, 1996 WL 754076, at \*3 (E.D. Va. Nov. 18, 1996) (noting that the parties had

This Section discusses the two decisions in which the Federal Circuit first interpreted this key phrase. It then discusses how the Supreme Court rejected the Federal Circuit's interpretation.

1. *The Federal Circuit's Interpretation*

a) *Apple v. Samsung*

Apple claimed, inter alia, that Samsung infringed three different design patents for smartphones.<sup>89</sup> The jury found the three patents were not invalid and each had been infringed by at least one of the nineteen accused Samsung phones.<sup>90</sup>

Two of the patents claimed partial designs for smartphones.<sup>91</sup> The first, U.S. Patent No. D618,677 ("the D'677 patent"), claimed the configuration and coloring of the flat, black front face of the iPhone, excluding the home button<sup>92</sup>:

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"stipulated to the amount of sales of shoes" and making no mention of any controversy over whether Nike was entitled to the profits for the whole shoe or just the upper); *id.* at \*1 (listing "the issues presented" and making no mention of an "article of manufacture" dispute); *see also* Shoe Upper, U.S. Patent No. D348,765 (issued July 19, 1994). So the issue of whether Nike was, in fact, entitled to the profits for the whole shoe was not before the Federal Circuit. Indeed, the parties made no mention of any "article of manufacture" dispute in their briefing before the Federal Circuit. *See* Brief for Defendants-Appellants Wal-Mart Stores, Inc. and Hawe Yue, Inc., Nike, Inc. v. Wal-Mart Stores, Inc., 138 F.3d 1437 (Fed. Cir. 1998) (No. 97-1173), 1997 WL 33544935; Brief of the Plaintiff-Appellee Nike, Inc., Nike, Inc. v. Wal-Mart Stores, Inc., 138 F.3d 1437 (Fed. Cir. 1998) (No. 97-1173), 1997 WL 33544933; Reply Brief for Defendants-Appellants Wal-Mart Stores, Inc. and Hawe Yue, Inc., Nike, Inc. v. Wal-Mart Stores, Inc., 138 F.3d 1437 (Fed. Cir. 1998) (No. 97-1173), 1997 WL 33544931. Therefore, *Nike* did not decide—let alone hold—that the owner of a design patent for a partial design is entitled to the profits for the entire infringing product. *See generally* BRIAN A. GARNER ET. AL., THE LAW OF JUDICIAL PRECEDENT § 23 (2016) (noting a general "rule that a court won't normally accept as binding precedent a point that was passed by in silence, either because the litigants never brought it up or because the court found no need to discuss it").

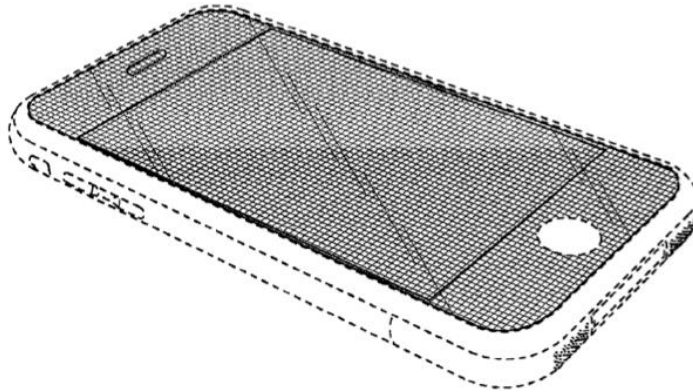
89. *See* Amended Verdict Form, Apple Inc. v. Samsung Elecs. Co., No. 5:11-cv-01846 (N.D. Cal. Aug. 24, 2012), ECF 1931 [hereinafter Verdict].

90. *Id.* at 6–7. Apple did not claim that all nineteen Samsung phones infringed all three design patents. *Id.*

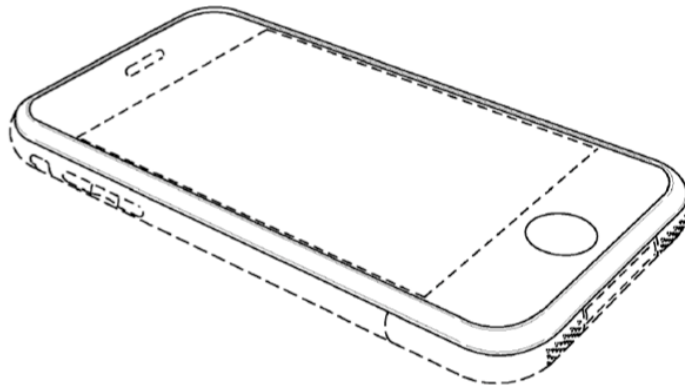
91. By "partial design," I mean a design that is defined to include something less than the entire configuration or surface ornamentation of a particular product.

92. Electronic Device, U.S. Patent No. D618,677 fig.1 (issued June 29, 2010). This patent is currently undergoing ex parte reexamination. The Patent Office issued a non-final rejection of that claim in August 2015; Apple has been trying to get that decision vacated ever since. *See In re Andre et al.*, Reexamination Control No. 90/012,884 (U.S. Patent & Trademark Office Decision Denying Petition Under 37 CFR 1.181(a)(3), Oct. 3, 2016) (on file with the Berkeley Technology Law Journal).





The jury found that twelve of the accused Samsung phones infringed the D'677 patent.<sup>93</sup> The second patent, U.S. Patent No. D593,087 (“the D'087 patent”), claimed a design for the configuration of the front, flat screen of the iPhone and the bezel<sup>94</sup>:



The jury found that three of the accused Samsung phones infringed the D'087 patent.<sup>95</sup> The third patent, U.S. Patent No. D604,305 (“the D'305 patent”), claimed this design for a screenshot from the iPhone GUI<sup>96</sup>:

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93. Verdict, *supra* note 89, at 6.

94. Electronic Device, U.S. Patent No. D593,087 fig.1 (issued May 26, 2009). Although some of the embodiments claimed in this patent included the home button and/or the capsule-shaped speaker, Judge Koh did not construe the claim to require any of these elements. *See* Final Jury Instruction at No. 43, Apple Inc. v. Samsung Elecs. Co., No. 5:11-cv-01846 (N.D. Cal. Aug. 21, 2012), ECF 1903 [hereinafter Apple Jury Instructions].

95. Verdict, *supra* note 89, at 6.

96. Graphical User Interface for a Display Screen or Portion Thereof, U.S. Patent No. D604,305 fig.2 (issued Nov. 17, 2009). This color version of the second embodiment was obtained from an expert report. *See* Expert Report of Susan Kare at 10, Apple Inc. v. Samsung Elecs. Co., 920 F. Supp. 2d 1079 (N.D. Cal. June 1, 2012) (No. 5:11-cv-01846), ECF 927-25.



The jury found that thirteen of the accused Samsung phones infringed the D'305 patent.<sup>97</sup> As can be seen from these illustrations, none of the asserted phone patents claimed a design for an entire phone.<sup>98</sup> Nonetheless, the jury awarded Apple all profits that Samsung made from every phone the jury found infringed any of the three design patents.<sup>99</sup> In doing so, the jury followed Judge Koh's instruction that: "If you find infringement by any Samsung defendant, Apple is entitled to all profit earned by that defendant on sales of articles that infringe Apple's design patents."<sup>100</sup> In that instruction, Judge Koh used the word "article" as a synonym for "product."<sup>101</sup>

On appeal, the Federal Circuit found "no legal error in the jury instruction on the design patent damages."<sup>102</sup> The court held, "[i]n reciting

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97. Verdict, *supra* note 89, at 7.

98. Apple argues that, when considered as a group, they "protect the overall look-and-feel of the iPhone." Brief in Opposition to Petition for a Writ of Certiorari at 31, Apple Inc. v. Samsung Elecs. Co., 136 S. Ct. 1453 (2016) (No. 15-777), 2016 WL 6599923 [hereinafter Apple Cert. Br.]; *see also* Brief for Respondent at 54, Apple Inc. v. Samsung Elecs. Co., 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 4073686 [hereinafter Apple Merits Br.]. Even if that were correct, Apple only claimed that four of the nineteen accused Samsung phones infringed all three of these design patents and the jury only found that three Samsung phones infringed all three design patents. Verdict, *supra* note 89, at 6–7.

99. *See* Apple Inc. v. Samsung Elecs. Co., 786 F.3d 983, 1001 (Fed. Cir. 2015), *cert. granted in part*, 136 S. Ct. 1453 (2016) (mem.) ("Samsung argues that the district court legally erred in allowing the jury to award Samsung's entire profits on its infringing smartphones as damages.").

100. Apple Jury Instructions, *supra* note 94, at No. 54.

101. *See id.*

102. *Apple*, 786 F.3d at 1002.

that an infringer ‘shall be liable to the owner to the extent of [the infringer’s] total profit,’ Section 289 explicitly authorizes the award of total profit from the article of manufacture bearing the patented design.”<sup>103</sup>

The Federal Circuit rejected Samsung’s argument that the relevant “article of manufacture” could be something less than “the entire infringing product.”<sup>104</sup> The court repeatedly used the phrase “article of manufacture” as a synonym for “product”<sup>105</sup> in distinguishing *Apple v. Samsung* from prior cases<sup>106</sup>:

Samsung contends that [in the *Piano Cases*] the Second Circuit had “allowed an award of infringer’s profits from the patented design of a piano case but not from the sale of the entire piano.” These Second Circuit opinions, however, addressed a factual situation 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.” 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. The facts at hand are different. The innards of Samsung’s smartphones were not sold separately from their shells as distinct articles of manufacture to ordinary purchasers. We thus do not agree with Samsung that these Second Circuit cases required the district court to limit the damages for design patent infringement in this case.<sup>107</sup>

Samsung argued “in the *Piano Cases*, the Second Circuit construed the term ‘article of manufacture’ as distinct from the entire product as sold.”<sup>108</sup> In

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103. *Id.* at 1001–02 (alteration in original) (referring to 35 U.S.C. § 289 (2012)). Of course, the statute does not “explicitly” say that the patent owner is entitled to “total profit from the article of manufacture bearing the patented design.” Compare *id.*, with 35 U.S.C. § 289 (2012). But this does seem to be a fair reading of the statute and it is consistent with the explicit language of the 1887 Act. See Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387.

104. *Apple*, 786 F.3d at 1002 (“Samsung argues for limiting the profits awarded to ‘the portion of the product as sold that incorporates or embodies the subject matter of the patent.’” (quoting Opening Brief for Defendants-Appellants at 38, *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983 (Fed. Cir. 2015) (Nos. 2014-1335, 2014-1368), 2014 WL 2586819, ECF 33 [hereinafter *Samsung App. Br.*])).

105. See *supra* note 4 (defining “product” as “something sold by an enterprise to its customers”).

106. See *Samsung App. Br.*, *supra* note 104, at 38 (referring to *Bush & Lane Piano Co. v. Becker Bros.*, 222 F. 902 (2d Cir. 1915) and *Bush & Lane Piano Co. v. Becker Bros.*, 234 F. 79 (2d Cir. 1916) as “the *Piano Cases*”).

107. *Apple*, 786 F.3d at 1002 (internal citations omitted).

108. *Samsung App. Br.*, *supra* note 104, at 38.

making this argument, Samsung viewed “the entire piano” as the product.<sup>109</sup> But the Federal Circuit seemed to view the piano case and internal piano mechanism as separate products—in other words, as items that were “sold separately” to the defendants’ customers.<sup>110</sup> According to the Federal Circuit, that meant that the piano cases themselves were the relevant “articles of manufacture” for the purposes of § 289.<sup>111</sup>

Thus, in *Apple v. Samsung*, the Federal Circuit interpreted the phrase “article of manufacture” in § 289 as a synonym for the infringing product—i.e., as a synonym for whatever the defendant “sold separately . . . to ordinary purchasers.”<sup>112</sup> However, the Federal Circuit never explained why “article of manufacture” should be interpreted that way, other than to suggest it was the statute’s plain meaning.<sup>113</sup> And the court never mentioned its own precedents interpreting the phrase “article of manufacture” in § 171.<sup>114</sup>

b) *Nordock v. Systems*

The Federal Circuit reaffirmed its interpretation of § 289 a few months later in *Nordock v. Systems*.<sup>115</sup> Nordock sued a competitor for infringement of U.S. Patent No. D579,754 (“the D’754 patent”).<sup>116</sup> The D’754 patent claimed design for a “Lip and Hinge Plate for a Dock Leveler.”<sup>117</sup> A representative drawing from the D’754 patent is shown below<sup>118</sup>:

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109. *See id.*

110. *Apple*, 786 F.3d at 1002; *see also supra* note 4 (defining “product” as “something sold by an enterprise to its customers”).

111. *Apple*, 786 F.3d at 1002.

112. *See id.* Unfortunately, the court failed to make this interpretation as explicit as it might have. Nonetheless, for the reasons discussed above, it is clear that the Federal Circuit interpreted “article of manufacture” to mean “infringing product.” *See id.* at 1001–02; Gov’t Brief, *supra* note 87, at 16 (“The court below appears to have assumed that the relevant ‘article of manufacture’ is necessarily the final product as sold in commerce.”).

113. *See Apple*, 786 F.3d at 1002 (referring to “[t]he clear statutory language”).

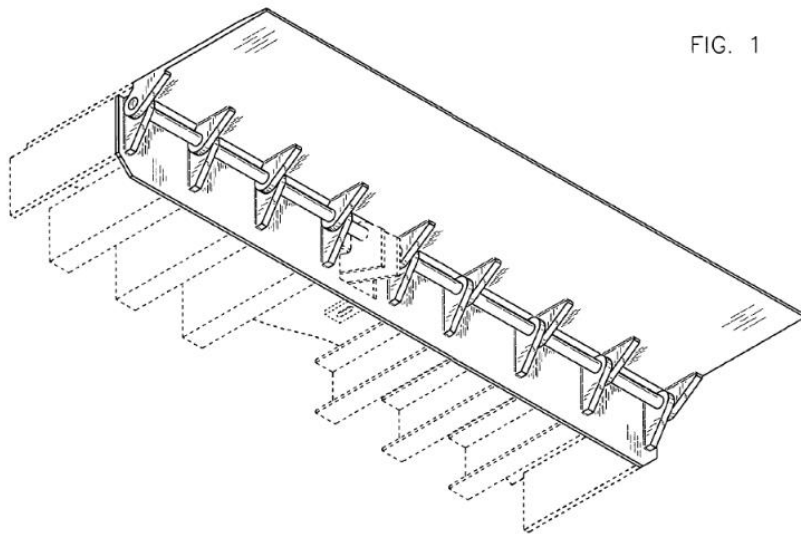
114. *Compare id.*, with Section II.A.2, *supra*.

115. *Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344, 1344–45 (Fed. Cir. 2015).

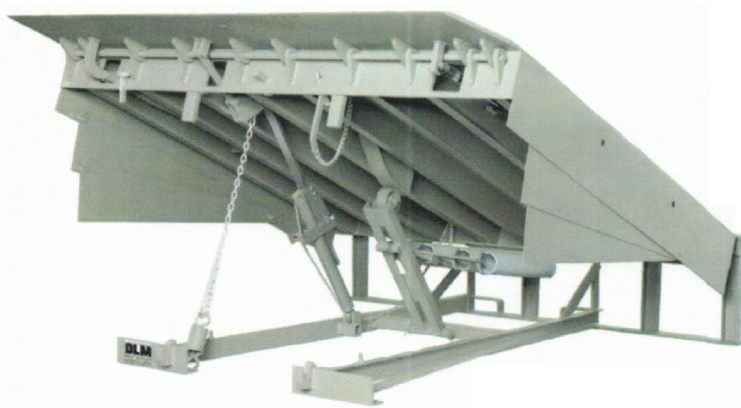
116. *Id.* at 1347.

117. U.S. Patent No. D579,754 (issued Nov. 4, 2008).

118. *Id.* at fig.1.



The accused products were dock levelers, including the one shown below<sup>119</sup>:



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119. Complaint, Exhibit C, *Nordock, Inc. v. Sys. Inc.*, 927 F. Supp. 2d 577 (E.D. Wis. Jan. 28, 2011) (No. 11-C-118), 2011 WL 444979.

Systems “began selling the accused levelers in October 2005.”<sup>120</sup> Nordock applied for the D’754 patent on May 31, 2007, as a continuation of an unsuccessful utility patent application.<sup>121</sup> The D’754 patent was issued on November 4, 2008.<sup>122</sup> Nordock sued Systems in 2011.<sup>123</sup>

At trial, the jury found that Systems had infringed the D’754 patent.<sup>124</sup> The jury also found that Systems had made no profits from the infringing products and “awarded Nordock \$46,825 as a reasonable royalty.”<sup>125</sup>

On appeal, the Federal Circuit vacated the jury’s award and remanded for a new trial on damages.<sup>126</sup> In doing so, the court rejected Systems’ argument “that Nordock [was] not entitled to recover profits on the entire dock leveler, but rather only those profits attributable to the ‘lip and hinge plate’ shown in the D’754 Patent.”<sup>127</sup> According to the court:

The D’754 Patent is entitled “Lip and Hinge Plate for a Dock Leveler,” and *makes clear that the claimed design is applied to and used with a dock leveler*. And, as Nordock points out, the evidence and testimony at trial demonstrated that *the levelers are welded together*. Importantly, there was *no evidence that Systems sold a “lip and hinge plate” separate from the leveler as a complete unit*. We therefore reject Systems’ attempts to apportion damages to the lip and hinge plate where it is clear that the article of manufacture at issue is a dock leveler.<sup>128</sup>

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120. *Nordock*, 803 F.3d at 1349.

121. *See* U.S. Patent No. D579,754 (filed as Application No. 29/288,137); U.S. Patent Application No. 29/288,137 (“This application is a continuation of Application No. 11/179,941 filed July 12, 2005 . . . .”); Non-Final Rejection, U.S. Patent Application No. 11/179,941 (Mar. 23, 2007) (rejecting all then-pending claims as obvious over the prior art) (on file with the Berkeley Technology Law Journal). *But see Nordock*, 803 F.3d at 1348 (incorrectly characterizing the application that matured into the D’754 patent as a “divisional application”). Nordock abandoned the ’941 utility patent application in November 2007. Notice of Abandonment, U.S. Patent Application No. 11/179,941 (Nov. 14, 2007).

122. U.S. Patent No. D579,754.

123. Complaint, *Nordock, Inc. v. Sys., Inc.*, 927 F. Supp. 2d 577 (E.D. Wis. Jan. 28, 2011) (No. 11-C-118), 2011 WL 444979.

124. *Nordock*, 803 F.3d at 1347.

125. *Id.* at 1353.

126. *Id.* at 1362.

127. *Id.* at 1354 (“Section 289 explicitly authorizes the award of total profit from the article of manufacture bearing the patented design.” (quoting *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1001–02 (Fed. Cir. 2015) (internal quotation marks omitted))).

128. *Id.* at 1355 (internal citation omitted) (emphasis added).

Thus, as in *Apple*, the court interpreted the phrase “article of manufacture” to mean “the infringing product”—i.e., as whatever the defendant “sold . . . separate[ly]” to its customers.<sup>129</sup>

## 2. *The Supreme Court’s Interpretation*

Samsung and Systems both petitioned the United States Supreme Court for certiorari on the issue of how to interpret § 289.<sup>130</sup> The Court granted Samsung’s petition on March 21, 2016.<sup>131</sup> Specifically, the Court granted certiorari on the following issue: “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?”<sup>132</sup> By the time the case was fully briefed, Apple, Samsung, and the United States, participating as amicus curiae, all agreed “that the relevant ‘article of manufacture’ could be something less than the entire infringing product.”<sup>133</sup> They disagreed, however, about when—or whether—that fact should affect a patentee’s ability to recover the “total profit” from the infringing product.<sup>134</sup>

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129. *Id.*; see also *id.* at 1354 (criticizing Systems’ damages expert, Bero, for limiting his analysis “to the ‘lip and hinge plate’ portion of the dock levelers” because “[i]n doing so, Bero ignored the fact that total profits are based on the article of manufacture to which the D’754 Patent is applied—not just a portion of that article of manufacture”). The Federal Circuit also suggested that its decision was based on, if not compelled by, its 1998 decision in *Nike v. Wal-Mart*. See *id.* (“[T]his court has interpreted § 289 to require ‘the disgorgement of the infringers’ profits to the patent holder, such that the infringers retain no profit from their wrong.’”) (citing *Nike Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1448 (Fed. Cir. 1998)). It is true that in *Nike* the Federal Circuit expressed concern “that the infringers retain no profit from their wrong.” *Nike*, 138 F.3d at 1448. But it did so in the context of deciding whether to award pre-tax or post-tax profits—not in deciding what was the relevant “article of manufacture.” See *id.* Moreover, in assuming that Systems’ “wrong” was profiting from the entire dock leveler, the *Nordock* court begged the disputed question. And unlike Wal-Mart, Systems disputed that the whole product was the relevant “article” for the purposes of § 289. For more on *Nike*, see *supra* note 88.

130. Petition for a Writ of Certiorari, *Samsung Elecs. Co. v. Apple Inc.*, 136 S. Ct. 1453 (2016) (No. 15-777), 2015 WL 10435543 [hereinafter *Samsung Pet.*]; Petition for a Writ of Certiorari, *Sys., Inc. v. Nordock Inc.*, 137 S. Ct. 589 (2016) (mem.) (No. 15-978), 2016 WL 386728.

131. *Samsung*, 136 S. Ct. at 1453.

132. *Samsung Pet.*, *supra* note 130, at (i). Samsung actually raised two issues in its petition but the Court denied *certiorari* on the other issue. See *Samsung Elecs. Co. v. Apple Inc.*, 136 S. Ct. 1453 (2016) (mem.) (limiting grant of review to Question 2).

133. Sarah Burstein, *Samsung v. Apple: A View From Inside the Courtroom*, PATENTLY-O (Oct. 12, 2016), <http://patentlyo.com/patent/2016/10/samsung-inside-courtroom.html>.

134. See Brief for Petitioners at 5, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 6599922; Gov’t Brief, *supra* note 87; Apple Merits Br., *supra* note 98.

The Supreme Court issued its decision in *Samsung v. Apple* on December 6, 2016.<sup>135</sup> In a unanimous decision written by Justice Sotomayor, the Court framed the issue as follows:

The United States Court of Appeals for the Federal Circuit identified the entire smartphone as the only permissible “article of manufacture” for the purpose of calculating § 289 damages because consumers could not separately purchase components of the smartphones. The question before us is whether that reading is consistent with § 289.<sup>136</sup>

The Court held that it was not.<sup>137</sup> The Court observed that the plain language of § 289 requires disgorgement of “all of the profit made from the prohibited conduct, that is, from the manufacture or sale of the ‘article of manufacture to which [the patented] design or colorable imitation has been applied.’”<sup>138</sup> According to the Court, “[a]rriving at a damages award under § 289 . . . involves two steps. First, identify the ‘article of manufacture’ to which the infringed design has been applied. Second, calculate the infringer’s total profit made on that article of manufacture.”<sup>139</sup>

Instead, the Court stated that “[t]he only question we resolve today is whether, in the case of a multicomponent product, the relevant ‘article of manufacture’ must always be the end product sold to the consumer or whether it can also be a component of that product.”<sup>140</sup> To answer that question, the Court looked to the definitions of the words “article” and “manufacture,” citing one contemporary dictionary and one late nineteenth-century dictionary.<sup>141</sup> Based on these definitions, the Court concluded that “[a]n ‘article of manufacture’ . . . is simply a thing made by hand or machine.”<sup>142</sup> Therefore, the Court concluded that “[t]he term ‘article of

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

136. *Id.* at 432.

137. *Id.*

138. *Id.* at 434 (quoting 35 U.S.C. § 289 (2012)).

139. *Id.*

140. *Id.* at 434.

141. *Id.* at 434–35 (citing J. STORMONTH, A DICTIONARY OF THE ENGLISH LANGUAGE 53 (1885); AMERICAN HERITAGE DICTIONARY 101 (5th ed. 2011)).

142. *Id.* at 435. This definition is essentially the same as the one suggested by *Hruby*. Compare *id.*, with *In re Hruby*, 373 F.2d 997, 999 (C.C.P.A. 1967) (suggesting that an “article of manufacture” is anything “made by man”). But the Court made no mention of *Hruby*. And while the Court stated that its interpretation “of article of manufacture in § 289 is consistent with 35 U.S.C. § 171(a),” the Court did not cite any cases interpreting “article of manufacture” in § 171. See *Samsung*, 137 S. Ct. at 435. Instead, the Court cites *Zahn* and one late nineteenth-century case interpreting Rev. Stat. § 4929. *Id.* (citing *Ex parte*



manufacture,’ as used in § 289, encompasses both a product sold to a consumer and a component of that product.”<sup>143</sup> The Court refused to formulate a test for lower courts to use in identifying the relevant “article of manufacture.”<sup>144</sup> According to the Court, that issue was not sufficiently briefed.<sup>145</sup> Therefore, the Court remanded the case to the Federal Circuit for further proceedings.<sup>146</sup>

Following its decision in *Samsung*, the Court granted Systems’ petition for certiorari, vacated the Federal Circuit’s judgment, and remanded *Systems v. Nordock* for further proceedings.<sup>147</sup> The Federal Circuit remanded both *Apple* and *Nordock* to their respective district courts.<sup>148</sup>

#### IV. THE “ARTICLE OF MANUFACTURE” IN 1887

Congress enacted the predecessor to 35 U.S.C. § 289 in 1887.<sup>149</sup> To evaluate what the phrase “article of manufacture” meant in 1887, this Part explores the meaning of that phrase in the context of statutory subject matter by examining the relevant statutory text, late nineteenth-century patent treatises, Patent Office decisions, and court cases. It also traces the relevant history behind the enactment of the 1887 Act.

##### A. STATUTORY SUBJECT MATTER

When Congress enacted the 1887 Act, the phrase “article of manufacture” was not new to U.S. patent law. It had been used for over forty years to define the scope of design patentable subject matter.<sup>150</sup> Given

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Adams, 1898 Dec. Comm’r Pat. 115; *In re Zahn*, 617 F.2d 261, 268 (C.C.P.A.1980)). As discussed above, *Zahn* itself did not purport to interpret “article of manufacture,” although some commentators have read it that way. See *supra* note 75 and accompanying text. And *Adams* was interpreting Rev. Stat. § 4949, not § 171. Although Rev. Stat. § 4949 was the predecessor to § 171 and contains the same key phrase, “article of manufacture,” it is still strange that the Court ignored the more recent interpretations of that statutory phrase.

143. *Samsung*, 137 S. Ct. at 435.

144. *Id.* at 436.

145. *Id.*

146. *Id.*

147. *Sys., Inc. v. Nordock, Inc.*, 137 S. Ct. 589 (2016) (mem.).

148. *Apple Inc. v. Samsung Elecs. Co.*, 678 F. App’x 1012, 1014 (Fed. Cir. 2017) (per curiam) (“[T]he parties dispute what jury instructions the current trial record supports. Because the district court is better positioned to parse the record to evaluate the parties’ competing arguments, we remand for the district court to consider these issues in the first instance.”); *Nordock, Inc. v. Sys. Inc.*, 681 F. App’x 965, 966 (Fed. Cir. 2017).

149. Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387.

150. See Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44; Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248; Act of July 8, 1870, ch. 230, § 24, 16 Stat. 198, 201; REVISED

this history, the general rule that “identical . . . terms in statutes should be construed in the same way” is significant in interpreting the 1887 Act.<sup>151</sup> There is no evidence—either in the text of the 1887 Act or in the legislative history—indicating that Congress meant the phrase “article of manufacture” to have a different meaning in the new remedy provision than in the statutory subject matter provision. To understand what Congress meant when it used the phrase “article of manufacture” in the 1887 Act, it is essential to understand how the phrase was understood in the context of statutory subject matter. This Section investigates that question by examining the relevant statutory text, Patent Office decisions, and federal case law.

### 1. Statutory Text

The text of the statutory subject matter provisions for both utility and design patents helps shed light on the meaning of the phrase “article of manufacture” in 1887. The phrase “article of manufacture” has been used to define the scope of design patentable subject matter since the first design patent act was enacted in 1842.<sup>152</sup> By 1842, the word “manufacture” already had a long pedigree in Anglo–American utility patent law.<sup>153</sup> This Section examines the meaning of “manufacture” in the context of nineteenth-century utility patent law, the “article of manufacture” in nineteenth-century design patent law, and how those two categories are related.

#### a) The “Manufacture” in Utility Patent Law

In 1624, the English Statute of Monopolies defined patentable subject matter as the “working or making of any manner of new manufactures.”<sup>154</sup> English courts interpreted the term “manufactures” to include “any species

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STATUTES OF THE UNITED STATES 962 (1st ed. 1875) (reproducing Rev. Stat. § 4929 as enacted).

151. Jacob Scott, *Codified Canons and the Common Law of Interpretation*, 98 GEO. L.J. 341, 362 (2010); see also *id.* at 362 n.100 (“A presumption exists that the legislature uses the same term consistently in different statutes.” (quoting 2A NORMAN J. SINGER & J.D. SHAMBIE SINGER, *STATUTES AND STATUTORY CONSTRUCTION* § 46:5 n.10 (7th ed. 2007))).

152. See *supra* Section II.A.3.

153. See *Ex parte* Lewis, 1891 Dec. Comm’r Pat. 61, 62 (“The word ‘manufacture’ has been employed in statutes relating to the granting of patents ever since the passage of the statute relating to monopolies in the reign of James the First.”).

154. See *id.*; see also LEWIS EDMUNDS, *THE LAW AND PRACTICE OF LETTERS PATENT FOR INVENTIONS* 12–13 (2d ed. 1897) (stating that the Statute of Monopolies was passed in 1624 and referring to An Act concerning Monopolies and Dispensations with Penal Laws and the Forfeitures thereof, 21 Jac. I. ch. 8. § 5).

of new manufactured article, or tangible product of industry; or a new machine” as well as “a new method or process.”<sup>155</sup>

When Congress enacted the first U.S. patent act in 1790, it imported the statutory term “manufacture” from English law but not the capacious meaning the term had been given by the English courts.<sup>156</sup> In the 1790 Act, Congress defined patentable subject matter as “any useful art, manufacture, engine, machine, or device.”<sup>157</sup> Thus, it appears that Congress intended U.S. patent law to cover the same subject matter as English patent law, without torturing the word “manufacture” into covering such a broad range of inventions.<sup>158</sup> After all, if Congress had meant to adopt the English courts’ meaning of “manufacture,” all of the other categories would have been superfluous.

In 1793, Congress revised the utility patent subject matter provision, redefining statutory subject matter as “any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof.”<sup>159</sup> The utility patent subject matter provision in force in 1887, Revised Statutes § 4886, contained the same language.<sup>160</sup>

By 1887, it was well-established that these “statutory classes of invention”—“art,” “machine,” “manufacture,” and “composition of matter”—were separate categories, “between which the lines of division are sharply drawn.”<sup>161</sup> Each of the statutory terms had “a well recognized meaning in the patent laws.”<sup>162</sup> An “art” was a “process.”<sup>163</sup> A “composition

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155. GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF PATENTS FOR USEFUL INVENTIONS: AS ENACTED AND ADMINISTERED IN THE UNITED STATES OF AMERICA § 4 (1867); *see also Ex parte Ackerson*, 1869 Dec. Comm’r Pat. 74, 75 (“Under the English law all patentable subject-matter is classed under the phrase ‘new manufacture.’ Everything, whether it be machine, process, or composition of matter, is grouped under this one title.”).

156. *See* ALBERT H. WALKER, TEXT-BOOK OF THE PATENT LAWS OF THE UNITED STATES OF AMERICA § 17 (1885); CURTIS, *supra* note 155, at § 9.

157. *Ex parte Lewis*, 1891 Dec. Comm’r Pat. 61, 62; CURTIS, *supra* note 155, at § 8 (emphasis omitted).

158. *See* CURTIS, *supra* note 155, at § 9.

159. *See Ex parte Lewis*, 1891 Dec. Comm’r Pat. 61, 62 (punctuation omitted).

160. REVISED STATUTES OF THE UNITED STATES 946 (2d ed. 1878) (reproducing Rev. Stat. § 4886, as then in force). This language still remains in effect today, save for the substitution of “process” for “art.” *See* 35 U.S.C. § 101.

161. *Ex parte Blythe*, 1885 Dec. Comm’r Pat. 82, 86 (citing to Rev. Stat. § 4886).

162. SYMONS, *supra* note 47, at 28 (citing *Ex parte Adams*, 1898 Dec. Comm’r Pat. 115; *Ex parte Steck*, 1902 Dec. Comm’r Pat. 9).

163. JAMES LOVE HOPKINS, THE LAW OF PATENTS AND PATENT PRACTICE IN THE PATENT OFFICE AND THE FEDERAL COURTS, WITH RULES AND FORMS § 31 (1911).

of matter” was “an artificial substance made up of two or more elements so united as to form a homogeneous whole,” such as paint or a medicine.<sup>164</sup>

A “machine” was considered a distinct and separate category of invention.<sup>165</sup> However, coming up with a clear, comprehensive definition of a “machine” proved difficult.<sup>166</sup> In 1853, the Supreme Court rather circularly defined a “machine” as “includ[ing] every mechanical device or combination of mechanical powers and devices” that “perform some function and produce a certain effect or result.”<sup>167</sup> In 1863, the Court did not provide much more guidance when it stated “[a] machine is a concrete thing, consisting of parts, or of certain devices and combination of devices.”<sup>168</sup> By the late nineteenth century, some treatise writers defined “machine” with reference to motion, seemingly using motion as a proxy for “mechanical.” For example, in 1885, the first edition of WALKER ON PATENTS defined “machine” as “a combination of moving mechanical parts, adapted to receive motion, and to apply [that motion] to the production of some mechanical result or results.”<sup>169</sup> In 1890, Robinson defined a “machine” as “an instrument composed of one or more of the mechanical powers, and capable, when set in motion, of producing, by its own operation, certain predetermined physical effects.”<sup>170</sup> But not all commentators viewed motion as an essential part of a “machine.”<sup>171</sup> For example, in 1883, Simonds endorsed a definition that included—but was not limited to—devices with moving parts.<sup>172</sup>

A “manufacture” was most broadly defined as any “‘thing’ made or manufactured by hand or by machine” that was “not itself a ‘machine’ or a ‘composition of matter.’”<sup>173</sup> According to Robinson, this included “parts of

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164. HENRY CHILDS MERWIN, *THE PATENTABILITY OF INVENTIONS* § 55 (1883); see also CURTIS, *supra* note 155, at § 28; WALKER, *supra* note 156, at § 18.

165. See generally *Ex parte* Blythe, 1885 Dec. Comm’r Pat. 82, 86.

166. See, e.g., John L. Seymour, *Of Machines*, 11 J. PAT. OFF. SOC’Y 248, 252 (1929). At least one commentator thought this category was self-explanatory. See HORACE PETTIT, *THE LAW OF INVENTIONS* 42 (1895) (“Every one knows what a machine is.”).

167. *Corning v. Burden*, 56 U.S. 252, 267 (1853).

168. *Burr v. Duryee*, 68 U.S. 531, 570 (1863).

169. WALKER, *supra* note 156, at § 16.

170. 1 WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* § 173 (1890).

171. See, e.g., CURTIS, *supra* note 155, at § 20; EDWARD S. RENWICK, *PATENTABLE INVENTION* § 38 (1893); PETTIT, *supra* note 166, at 35.

172. See WILLIAM EDGAR SIMONDS, *A SUMMARY OF THE LAW OF PATENTS FOR USEFUL INVENTIONS AND FORMS* 18 (1883).

173. HENRY HOWSON & CHARLES HOWSON, *A BRIEF TREATISE ON UNITED STATES PATENTS, FOR INVENTORS AND PATENTEES* 34 (1876).

a machine considered separately from the machine itself, all kinds of tools and fabrics, and every other vendible substance which is neither a complete machine nor produced by the mere union of ingredients.”<sup>174</sup> Another commentator gave the following examples of articles of manufacture: “cloths, baskets, articles of clothing, pottery, glassware, nails, screws, etc.”<sup>175</sup>

A number of Patent Office decisions indicated that “manufactures” had to be “complete” in the sense of being manufactured, used, or sold separately.<sup>176</sup> For example, in *Ex parte Blanchard*, Commissioner Fisher wrote:

By the true construction of the word “manufacture,” as used in the patent act, it fairly covers only such manufactured articles or products as are *complete in themselves, or, if parts of a whole, are so far complete as to be the subject of separate manufacture and sale*. Thus a lamp chimney is intended to be used with a lamp and not otherwise, nevertheless, it may properly be made, sold, and patented as a new manufacture.

In this case, applicant admits that “this mold board is adapted and applicable only to this single kind of plow.” It is, in other words, a mere fraction of a machine. If a material part [of the machine], it may be claimed as such, but it is not, in any proper sense, an article of manufacture.<sup>177</sup>

This analysis suggests that a part of a machine could qualify as a “manufacture” only if that part were capable of being used in more than one type of machine, as opposed to being “adapted and applicable only to [a]

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174. ROBINSON, *supra* note 170, at § 183, 270.

175. RENWICK, *supra* note 171, at § 59. Simonds provided a similar list of examples. SIMONDS, *supra* note 172, at 19 (“The word or term ‘manufacture’ includes most of the ordinary and vendible articles of trade, such as textile fabrics, articles of personal attire, general hardware, house furnishing goods and the like.”); *see also* JOSEPH J. DARLINGTON, A TREATISE ON THE LAW OF PERSONAL PROPERTY 232 (1891) (giving “cloths, utensils, implements, shoes, single objects, etc.” as examples of “manufactures”).

176. *Ex parte Blanchard*, 1870 Dec. Comm’r Pat. 59, 59 (“[T]he word ‘manufacture,’ as used in the patent act . . . fairly covers only such manufactured articles or products as are complete in themselves, or, if parts of a whole, are so far complete as to be the subject of separate manufacture and sale.”); *Ex parte Campbell*, 1872 Dec. Comm’r Pat. 228, 228 (deciding that the applicant’s invention was not an “article of manufacture” because it was “not a device or article that he can offer to the public as complete for their use”); *see also* Wilson v. Rousseau, 30 F. Cas. 162, 211–12 (C.C.N.D.N.Y. 1845) (suggesting that something that “may be” used separately constitutes a “separate and distinct” manufacture).

177. *Ex parte Blanchard*, 1870 Dec. Comm’r Pat. 59, 59 (emphasis added).

single kind” of machine, in which case it would be a “mere fraction of a machine.”<sup>178</sup> But it is not clear if this was a widely-held view.

*Blanchard* also indicated that a piece of a larger product (including a machine) could qualify as a “manufacture” only if that piece were manufactured separately or could be sold separately.<sup>179</sup> Other decisions reached similar conclusions.<sup>180</sup> Simonds summarized this line of decisions as follows:

As understood by the Patent Office—and no reason is seen for dissenting from the understanding—*an article does not need to be a finished product in order to enable it to be an “article of manufacture”*; the term fairly covers such products as are complete in themselves, or are so far complete as to be subject to independent manufacture and sale. Thus in a community of boot and shoe manufacturers, certain shops make and sell only certain parts of a boot or shoe, and in such case these parts are “articles of manufacture.” Again in a community of clock-makers, certain manufacturers produce but a certain part, clock-springs for

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178. See *id.*; see also generally *Ex parte* Howard, 1924 Dec. Comm’r Pat. 75, 76 (suggesting that “clay tiles, beams, bolts, rivets, etc.” could, if new, be “patentable as a ‘manufacture’” because they are “inherently useful and complete in themselves,” even if ultimately used to build something larger, like a roof). But see *Ex parte* Sellers, 1872 Dec. Comm’r Pat. 197, 198 (stating that an “article of manufacture” must be “complete in itself for some special use, and not to be applied to general purposes like pipes or tubes” (emphasis added)). Additionally, at least one design patent decision indicated that an “article of manufacture” had to be something fairly specific. See *Ex parte* Proeger, 1891 Dec. Comm’r Pat. 182, 182 (“[I]t would not be advisable to extend the meaning of the word ‘manufacture’ in the statute to include such a generic term as the word ‘tableware.’”).

179. See *Ex parte* Blanchard, 1870 Dec. Comm’r Pat. 59, 59.

180. See *Ex parte* Butterfield, 1872 Dec. Comm’r Pat. 153, 154 (deciding that a shoe upper was an “article of manufacture” because it was “an article of trade”—*i.e.*, because it was sold separately, presumably to shoemakers); *Ex parte* Moore, 1871 Dec. Comm’r Pat. 249, 249–51 (deciding that a clock-case was patentable as an “article of manufacture” because it was “intended as an article of trade, not as a clock, but as a clock-case; intended to be put upon the market simply as a clockcase, and sold to clock-makers”); see also WILLIAM EDGAR SIMONDS, A DIGEST OF PATENT OFFICE DECISIONS: 1869-1879 at 29 (1880) (“A part of a device is an ‘article of manufacture’ when separately sold in the trade” (citing *Ex parte* Blanchard, 1870 Dec. Comm’r Pat. 59)); *id.* (“‘Manufacture’ fairly covers only such products as are complete in themselves, or so far complete as to be subject to independent manufacture and sale” (citing *Ex parte* Butterfield, 1872 Dec. Comm’r Pat. 153)); ROBINSON, *supra* note 170, at § 188, 276 (referring to a “manufacture” as a “finished product”).

instance, and in that case a clock-spring is an “article of manufacture.”<sup>181</sup>

The question was not whether a particular patent applicant—or accused infringer—actually sold the item as a freestanding product to the ultimate consumer. Instead, the inquiry focused on whether the item was (or could be) sold to someone, including to another manufacturer, for incorporation of the item into a larger product.

Thus, by 1887, it was clear that “machines” were different than “manufactures” but there was no universally agreed-upon, bright-line test for distinguishing between “manufactures” and “machines.”<sup>182</sup> For example, there was some debate over whether tools should be classified as “manufactures” or “machines.”<sup>183</sup> There was also some disagreement over the proper classification of pianos.<sup>184</sup> Of course, in the utility patent context, there was little need (or incentive) to spend much time or mental effort developing a test to distinguish between these categories. As long as an invention was clearly either a “manufacture” or a “machine,” it did not really matter which one it was—the invention would be patentable either way.<sup>185</sup>

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181. SIMONDS, *supra* note 172, at 19 (emphasis added) (citing *Ex parte* Blanchard, 1870 Dec. Comm’r Pat. 59; *Ex parte* Butterfield, 1872 Dec. Comm’r Pat. 153).

182. WALKER, *supra* note 156, at § 19 (“The distinction between a machine and a manufacture cannot be so stated that its application to every case would be clear and satisfactory to every mind.”).

183. See HOPKINS, *supra* note 163, at § 32 (“There has been some discussion by text writers as to whether the word ‘machine’ includes tools.” (citing MACOMBER, *FIXED LAW OF PATENTS* § 768 (1st ed. 1909); ROBINSON, *supra* note 170, at § 175)); see also SIMONDS, *supra* note 172, at 18 (suggesting that tools with “fixed and immovable parts, [such] as a hatchet or gimlet” should be considered “manufactures” instead of machines).

184. Compare *Ex parte* Blythe, 1886 Dec. Comm’r Pat. 82, 87 (stating that a piano should be considered a “machine” for the purposes of patent law even though it would seem strange, in normal parlance, to call an apparatus like a piano a “machine”), with ROBINSON, *supra* note 170, at § 175, 260 n.1 (“A piano is not a machine, though the mechanism which is constituted by each of its keys, in connection with its own hammer, &c., might be so regarded; nor is a tool or an implement characterized by any *modus operandi*, but is an ordinary manufacture.”).

185. See, e.g., HOPKINS, *supra* note 163, at §§ 32–33 (describing the question of what constitutes a “machine” versus a “manufacture” under Rev. Stat. § 4886 as being “largely academic” in the context of utility patents).

b) The “Article of Manufacture” in Design Patent Law

i) The Original Design Patent Act

Congress enacted the first U.S. design patent act in 1842.<sup>186</sup> It defined design patentable subject matter as:

[A]ny new and original design *for a manufacture*, whether of metal or other material or materials, or any new and original design for the printing of woollen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas relief or composition in alto or basso relievo, or any new and original impression or ornament, or *to be placed on any article of manufacture*, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, *any article of manufacture*, or any new and original shape or configuration of *any article of manufacture* not known or used by others before his, her, or their invention or production thereof . . . .<sup>187</sup>

Thus, under the 1842 Act, most types of protectable designs were designs for (or of) a “manufacture” or an “article of manufacture.”

The phrase “article of manufacture” appears to have been borrowed from the 1839 English design copyright statute.<sup>188</sup> That might be taken to suggest that Congress meant to adopt the English courts’ interpretations of that phrase.<sup>189</sup> However, it seems reasonably clear that Congress used the word “manufacture” in the new design patent law to mean the same thing it meant in the existing utility patent law. By 1842, the word “manufacture” already had a long history in American patent law.<sup>190</sup> Therefore, normal rules of statutory construction would dictate that it be given the same

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186. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44. “Very few design patents were granted under this act, and the books contain no Patent Office decisions, and but three litigated cases in the courts, founded on patents applied for or granted in pursuance of this law.” HECTOR T. FENTON, *THE LAW OF PATENTS FOR DESIGNS* 2 (1889) (citing *Root v. Ball*, 4 McLean 177; *Sparkman v. Higgins*, 1 Blatch. 205; *Booth v. Garrelly*, 1 Blatch. 247).

187. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44 (emphasis added).

188. See Jason J. Du Mont & Mark D. Janis, *The Origins of American Design Patent Protection*, 88 IND. L.J. 837, 860–61 (2013).

189. Scott, *supra* note 151 (“The borrowed statute rule states that when a legislature adopts a statute from a foreign jurisdiction, it implicitly incorporates the settled interpretations of the foreign statute’s judiciary.”).

190. See *supra* Section IV.A.1.a).



meaning in the design patent subject matter provision that it had been given in the utility patent subject matter provision.<sup>191</sup>

Moreover, as discussed above, Congress deliberately avoided adopting the English meaning of the word “manufacture” when it first imported that term into U.S. patent law in 1790. It would be strange for Congress to consciously avoid adopting the English meaning of the word “manufacture” in one part of the Patent Act and silently adopt it in another.

In any case, by 1887, a number of administrative and judicial decisions had expressly equated the phrase “article of manufacture” in the design patent statute with the term “manufacture” in the utility patent statute.<sup>192</sup> And the phrase “article of manufacture” was already being used a synonym for “manufacture” in utility patent law.<sup>193</sup>

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191. See *Ex parte* Lewis, 1891 Dec. Comm’r Pat. 61, 63 (“When . . . the American statute relating to patents was amended by the act of 1842, providing for the granting of design patents, and the word ‘manufacture’ was studiously employed and repeated therein, the fundamental rules of construction required that the same meaning should be ascribed to the word as used therein which had been associated with it, not only as found in the statute directly amended, but in all preceding statutes relating to Letters Patent and employing the same word.”); see also Scott, *supra* note 151, at 362 (“Generally, identical or similar terms in statutes should be construed in the same way . . .”).

192. See, e.g., *Ex parte* Sellers, 1872 Dec. Comm’r Pat. 197, 198 (relying solely on utility patent decisions for its definition of “article of manufacture” in the design patent statute); see also Pratt v. Rosenfeld, 3 F. 335, 335–36 (C.C.S.D.N.Y. 1880) (“The statute (Rev. Stat. Sec. 4929) authorizes the grant of a patent to any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture . . . . The subject of this patent is not covered by this statute unless it is included in the term ‘manufacture.’”).

193. See, e.g., *Ex parte* Ackerson, 1869 Dec. Comm’r Pat. 74, 74 (discussing a utility patent claim for “a new article of manufacture”); Cone v. Morgan Envelope Co., 6 F. Cas. 268, 269 (C.C.D. Mass. 1879) (describing a utility patent for a “manufacture” as a “patent for a new article of manufacture”); see also HOWSON & HOWSON, *supra* note 173, at 34 (“Patents are granted for any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof. It would seem that *the word ‘manufacture’ is used here in the sense of an article of manufacture . . .*” (emphasis added)). In recent years, the Federal Circuit has called this longstanding understanding of equivalency into question. See *In re* Nuijten, 500 F.3d 1346, 1357 n.9 (Fed. Cir. 2007) (suggesting that a § 101 “manufacture” need not be the same as a § 171 “article of manufacture”). Granted, the court did this in the context of trying to avoid some ill-reasoned—but binding—design patent precedent. See *id.* (attempting to distinguish *In re* Hruby, 373 F.2d 997 (1967)). It is not clear that the traditional understanding was correct; after all, the traditional view gives no meaning at all to the phrase “article of” in the design patent provision. However, a full discussion of that issue is beyond the scope of this Article.

ii) Revised Statutes § 4929

Between 1842 and 1887, the design patent subject matter provision was revised multiple times but none of these revisions significantly changed the scope of the statutory subject matter—at least not in ways that are relevant to this discussion.<sup>194</sup> In 1887, Revised Statutes § 4929 defined the protectable subject matter as:

[A]ny new and original design *for a manufacture*, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, [pattern], print, or picture to be printed, painted, cast, or otherwise placed on or worked into *any article of manufacture*; or any new, useful, and original shape or configuration of *any article of manufacture* . . . .<sup>195</sup>

This provision, like its predecessors, was interpreted as covering two different types of designs—“configuration” (or “shape”) and “ornamentation.”<sup>196</sup>

Section 4929 of the Revised Statutes, like its predecessors, used the well-established terms of art “manufacture” and “article of manufacture” to describe the protectable subject matter.<sup>197</sup> As one early 20th century treatise writer explained:

The terms “art”, “machine”, “manufacture”, and “composition of matter” have a well recognized meaning in the patent laws. While section 4886, Revised Statutes permits the grant of a patent for

194. Compare Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44, with Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248, and Act of July 8, 1870, ch. 230, § 24, 16 Stat. 198, 201, and REVISED STATUTES OF THE UNITED STATES 962 (1st ed. 1875) (reproducing Rev. Stat. § 4929); see also generally WILLIAM EDGAR SIMONDS, THE LAW OF DESIGN PATENTS 179–80 (1874) (noting the lack of major substantive change between the 1842, 1861, and 1870 acts.).

195. REVISED STATUTES OF THE UNITED STATES 954 (2d ed. 1878) (reproducing Rev. Stat. § 4929, as then in force) (emphasis added); see also WALKER, *supra* note 156, at § 20 (explaining that the word “patent” in the phrase “impression, ornament, patent, print, or picture” appeared to be a typo).

196. *Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37, 40 (describing “the two classes of invention” in design patents as “shape and ornamentation”); see also ROBINSON, *supra* note 170, at § 204 (explaining that a “design may consist in the simple configuration of a substance the form given to it as a whole, or in the ornamentation imposed upon it without reference to its general form, or in such configuration or ornamentation both” in a section entitled “Design may Consist in Configuration or Ornamentation or Both”).

197. See Rev. Stat. § 4929; see also FENTON, *supra* note 186, at 183 (interpreting each of the three clauses of Section 4929 as pertaining to designs for “articles of manufacture” or “manufacture[s]”).

any new invention in any of them, section 4929 names only a “manufacture” as proper subject matter for a design patent.<sup>198</sup>

Therefore, it is “essential . . . to know what is properly included in the term ‘article of manufacture.’”<sup>199</sup> The next Section analyzes the judicial and administrative decisions that help shed light on this key question.

## 2. Patent Office Decisions

In 1869, the Patent Office began publishing the decisions of the Commissioner of Patents.<sup>200</sup> While these decisions were not binding on courts,<sup>201</sup> they still provide a valuable window into Patent Office practice and policy, as well as the then-current understanding of the phrase “article of manufacture.”

It also appears that the commencement of publication of these decisions coincided with an uptick of interest in design patents. In his 1869 decision in *Ex parte Bartholemew*, Commissioner Fisher stated that:

Letters patent for designs have increased in importance within the last few years. Formerly, but few were granted; now, many are issued. To this day they have made so little figure in litigation that but three reported cases are known, in which design patents have come into controversy. With their increase, questions have arisen concerning their scope and character, which have given rise to dispute and to inquiry as to the correctness of the current practice of the office in this branch of invention.<sup>202</sup>

Commissioner Fisher added that, at least with respect to certain issues of design patent claiming, “the practice of the office ha[d] not been uniform, and that the true practice [was] still to be adopted and followed.”<sup>203</sup>

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198. SYMONS, *supra* note 47, at 28.

199. WILLIAM D. SHOEMAKER, PATENTS FOR DESIGNS 150 (1929).

200. Jason J. Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 GONZ. L. REV. 531, 538 n.34 (2010) (“The Patent Office began publishing the Commissioner’s decisions in 1869.” (citing William I. Wyman, *Samuel Sparks Fisher*, 2 J. PAT. OFF. SOC’Y 490, 497–98 (1920))).

201. On other issues of design patent law, the decisions vacillated—sometimes wildly—from Commissioner to Commissioner. See Gerard N. Magliocca, *Ornamental Design and Incremental Innovation*, 86 MARQ. L. REV. 845, 874–80 (2003) (recounting the vacillations from Commissioner to Commissioner on the issue of whether patentable designs had to have aesthetic content or merely be “useful”). However, the decisions in this area seem to be much more stable, or at least reconcilable.

202. *Ex parte Bartholemew*, 1869 Dec. Comm’r Pat. 103, 103.

203. *Id.* at 105.

This Section discusses a number of Patent Office decisions that help shed light on the meaning of the phrase “article of manufacture” in 1887, including some decisions issued shortly after that date that help explain and expand upon the earlier decisions.

a) *Ex parte* Brower (1873)

Brower claimed a “design for a glass inkstand and stopper of glass, made square, with equally chamfered edges.”<sup>204</sup> The examiner objected to the claim because “the bottle and the stopper are separate articles, and exhibit separate and independent designs.”<sup>205</sup> On petition to the Commissioner of Patents, Brower apparently did not dispute the inkstand and stopper were separate “articles of manufacture.”<sup>206</sup> Instead, he argued he had created a single “design,”<sup>207</sup> presumably because the pieces were designed to be sold together as a single product.

Acting Commissioner Thacher did not agree.<sup>208</sup> According to Thacher, the main problem was that the appearance of the set as a whole could—and was likely to—be varied. He stated that “a design . . . as a general rule” is “a thing essentially unitary and unvarying in character” and that a patentable design “cannot embrace in its scope alternates or equivalents in form.”<sup>209</sup> Therefore, “the relative positions of the two parts, when connected, ought to be uniform and fixed” to qualify as statutory subject matter.<sup>210</sup> So while Brower could have patented his designs for the inkstand and the stopper separately,<sup>211</sup> he could not patent them together in the same application because they did not constitute “a single unitary design for an article of manufacture.”<sup>212</sup>

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204. *Ex parte* Brower, 1873 Dec. Comm’r Pat. 151, 151.

205. *Id.*

206. *See id.*

207. *Id.*

208. *Id.* at 152.

209. *Id.*

210. *Id.*

211. *See id.*

212. *Id.* A few years later, Commissioner Spear refused to follow *Brower* in a case about casket-screws. *See Ex parte* Rogers, 1878 Dec. Comm’r Pat. 62, 63. Spear did not offer any critique of the legal reasoning in *Brower*; instead, he just said he thought “that it would be [an] unnecessary hardship to require the applicant to make two separate applications . . . .” *Id.* It appears that Spear considered—and that *Rogers* is best viewed as—a case about when multiple claims could be allowed in the same application. *See id.* The “article of manufacture” issue was not discussed in *Rogers*; instead, it was decided on the basis of what constitutes a single “design.” *See id.* at 62–63.

b) *Ex parte* Patitz (1883)

Patitz designed a mirror frame and a sconce that could be attached to and detached from each other.<sup>213</sup> According to Patitz, the combination constituted a single “design” for a product that could “be varied and changed to suit the taste by a disassociation of the particular mirror–frame from the sconce, and *vice versa*.”<sup>214</sup>

The examiner rejected the claim and Commissioner Butterworth affirmed, relying on *Ex parte Brower*.<sup>215</sup> Butterworth explained the mirror frame and sconce were “two distinct articles of manufacture” with “uses as separate and distinct as those pertaining to a watch and the chain to which it is to be attached.”<sup>216</sup> He suggested the designs for both articles could have been claimed in a single application if there had been some “necessary connection between the design for the mirror-frame and the sconce” such that “their union in the manner contemplated in this application” would “constitute a unity of design.”<sup>217</sup> But the mere fact the designs were made to be used—and even connected—to each other was not enough.<sup>218</sup> Therefore, the designs for the two separate articles could not be claimed in a single design patent.<sup>219</sup>

c) *Ex parte* Lewis (1891)

Lewis sought a design patent “for the exterior of a country house.”<sup>220</sup> When “asked to affix [his] signature to [the] patent,” Commissioner Mitchell refused, apparently *sua sponte*.<sup>221</sup> According to Mitchell, the claimed design was not proper statutory subject matter unless it could be classified as a “manufacture” under Section 4929 of the Revised Statutes.<sup>222</sup> Mitchell noted the word “manufacture” in the design patent subject matter provision had to be construed to mean the same thing as it did in the utility patent subject matter provision.<sup>223</sup> In the latter provision, a “manufacture”

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213. *Ex parte* Patitz, 1883 Dec. Comm’r Pat. 101, 102.

214. *Id.*

215. *Id.*

216. *Id.* at 101.

217. *See id.* at 102.

218. *See id.*

219. *Id.*

220. *Ex parte* Lewis, 1891 Dec. Comm’r Pat. 61, 62.

221. *See id.* at 62–63.

222. *Id.* at 62.

223. *See id.* at 63.

was only one of the separately-listed, distinct categories of invention.<sup>224</sup>

Mitchell stated that, despite the long use of the term “manufacture” in U.S. patent law, “no case can be found in which it has ever been construed to include any article not classifiable as personal property.”<sup>225</sup> Even though English courts interpreted the word “manufacture” more broadly, “no latitude of judicial construction under any statute, foreign or domestic, has extended it to include realty.”<sup>226</sup> Mitchell concluded “the word ‘manufacture’ must be limited to manufactured articles—that is to say, articles made by hand, machinery, or art, from raw or prepared materials.”<sup>227</sup> Read in a vacuum, this definition might appear to include houses. But according to Mitchell, it did not “include a dwelling-house or any other article of realty.”<sup>228</sup>

Mitchell also distinguished designs for houses from designs for “articles, such as mantels,” which “are manufactured and sold with reference to ultimately becoming part of a house.”<sup>229</sup> He stated that such articles were “manufactures” and suggested that designs for such articles could be patented.<sup>230</sup>

d) *Ex parte* Haggard (1897)

Haggard submitted a design patent application with two claims, one for “a cradle-supporting frame” and a “cradle body.”<sup>231</sup> The illustration showed the two pieces “movably connected together, the cradle-body swinging in

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224. *See id.* at 62 (“The statute of 1793 provides for the granting of a patent to any one who has invented any ‘new or useful art, machine, manufacture, or composition of matter.’”) (emphasis omitted); *see also id.* at 63 (contrasting this with the broad English interpretation of “manufactures”).

225. *Id.* at 62–63.

226. *Id.* at 63.

227. *Id.* In context, it is clear that Mitchell saw the statutory classes of invention listed in Rev. Stat. § 4886 as distinct and separate categories. *See id.* at 62. Therefore, Mitchell’s definition should not be read to include or overlap with other statutory categories like “machines.”

228. *Id.* The Patent Office’s position on this issue was later reversed. *See In re Hadden*, 20 F.2d 275, 275 (D.C. Cir. 1927) (reversing “a Patent Office decision refusing to allow applicant’s claim covering a design for a grandstand, on the ground that, although it may be a manufacture, it is not an article of manufacture”) (emphasis omitted); *Ex parte* Foshay, 7 U.S.P.Q. (BNA) 121 (Pat. Off. Bd. App. 1930) (holding that “the ornamental design for a building” qualified as proper statutory subject matter). Thus, architectural structures are now considered “articles of manufacture.”

229. *Ex parte* Lewis, 1891 Dec. Comm’r Pat. 61, 63.

230. *Id.*

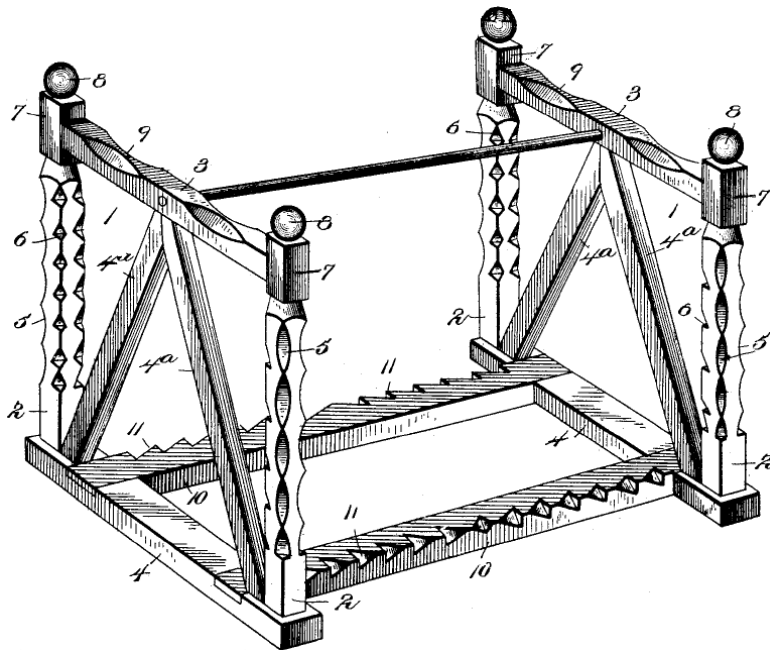
231. *Ex parte* Haggard, 1897 Dec. Comm’r Pat. 47, 48.

the frame.”<sup>232</sup> The examiner issued a restriction requirement on the basis that the application claimed two separate designs.<sup>233</sup>

Acting Commissioner Greeley agreed, describing the pieces as “two distinct articles of manufacture.”<sup>234</sup> According to Greeley:

While claims for a design and for a distinctive segregable portion of the design have been permitted to be made in one application, I am not aware that two separate designs have ever been permitted in one application. The requirement of the Examiner is clearly right under the practice as laid down in *ex parte Patitz*, which followed *ex parte Brower*.<sup>235</sup>

Following this decision, Haggard amended his application to claim only the frame and received a design patent for the design shown below<sup>236</sup>:



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232. *Id.*

233. *See id.*

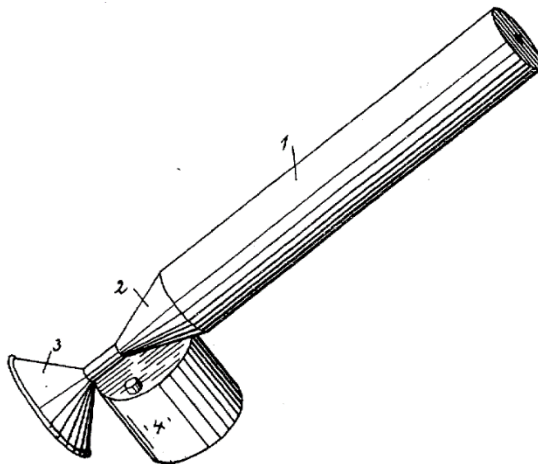
234. *Id.*

235. *Id.* (internal citations omitted) (citing *Ex parte Patitz*, 1883 Dec. Comm’r Pat. 101; *Ex parte Brower*, 1873 Dec. Comm’r Pat. 151).

236. *See id.* (discussing Application No. 621,243); Cradle-Frame, U.S. Patent No. D27,726 fig.1 (issued Oct. 12, 1897 to Ries W. Haggard from Application No. 621,243).

e) *Ex parte* Smith (1897)

Smith claimed a design patent for an atomizer.<sup>237</sup> The atomizer was made up of various parts, including a syringe and a handle that was attached to the body of the atomizer with a rod.<sup>238</sup> The body apparently looked like this<sup>239</sup>:



According to the specification, the rod “may be more or less withdrawn or forced into the body of the atomizer, and to this extent will vary the appearance of the instrument.”<sup>240</sup> The examiner rejected the claim “upon the ground that a machine does not fall within the province of the design act.”<sup>241</sup>

On petition to Acting Commissioner Greeley, Smith framed the issue as whether the handle and rod “shown in the drawings of this application can or cannot be shown in a design patent in connection with the remainder” of

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237. *Ex parte* Smith, 1897 Dec. Comm’r Pat. 170, 171 (“The claim is: ‘The design of atomizer herein shown and described.’”).

238. *See id.* (“It is also evident that the real merit of the design, if any, consists in the shape of the syringe, provided with a flaring mouthpiece.”); *id.* (“The specification closes with the statement: ‘The instrument is also provided with a handle 5 on the end of the rod 6, which may be more or less withdrawn or forced into the body of the atomizer, and to this extent will vary the appearance of the instrument.’”).

239. *See id.* at 170 (discussing Application No. 620,471); *Sprayer Body*, U.S. Patent No. D30,293 (issued Feb. 28, 1899 from Application No. 620,471) (“What I claim is—The design for an atomizer-body as herein shown and described.”).

240. *Ex parte* Smith, 1897 Dec. Comm’r Pat. 170, 171.

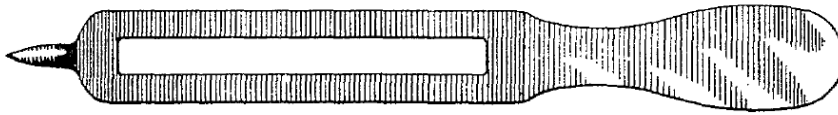
241. *Id.* at 170 (quoting the examiner’s statement).



the instrument.<sup>242</sup> Greeley denied the petition. According to Greeley, “the elements of any design should be of an unchanging character, since any change in these changes the shape or configuration of the whole, and thereby changes the identity of the design as such,” therefore, “the movable handle in this case should not be made an element of the design.”<sup>243</sup> Greeley also indicated that a design for a machine was not proper statutory subject matter.<sup>244</sup> Following this decision, Smith amended his application to claim only the “atomizer-body” and the Patent Office granted the patent.<sup>245</sup>

f) *Ex parte* Tallman (1897)

Tallman submitted an application for a design patent for a “can-opener.”<sup>246</sup> The illustrated device included “a ‘blade-holder,’ which could be moved along an opening in the body.”<sup>247</sup> Apparently, the body portion looked like this<sup>248</sup>:



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242. *See id.*

243. *Id.* at 171.

244. *See id.* at 170 (“The grounds of rejection were two—namely, anticipation and that the subject-matter of the application is not proper subject-matter for a design patent, being for an apparatus. . . . It is clear that *both of these are proper grounds for rejection* and for appeal to the Examiners-in-Chief . . . .”) (emphasis added). The question of whether the atomizer was, in fact, a machine was not before Greeley. At the time, only questions of form (i.e., “one that relates to the fitness of the application for an examination on its merits, or involves merely some rule of Office practice”) were directly appealable to the Commissioner of Patents; questions on the merits had to first be appealed to the Examiners-in-Chief. *See* 2 WILLIAM C. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS at § 566, 183 (1890). Thus, to the extent there was a dispute over whether this device actually was an “apparatus” (i.e., “machine”), that was a matter for Examiners-in-Chief. *See id.*

245. *See* U.S. Patent No. D30,293 (issued Feb. 28, 1899 from Application No. 620,471) (“What I claim is—The design for an atomizer-body as herein shown and described.”); *see also Ex parte* Smith, 1897 Dec. Comm’r Pat. 170, 170 (relating to Application No. 620,471).

246. *Ex parte* Tallman, 1898 Dec. Comm’r Pat. 10, 10.

247. *See id.*

248. *See id.* (discussing Application No. 634,949); U.S. Patent No. D28,232 fig.1 (issued Feb. 1, 1898 from Application No. 634,949).

The application contained “two claims, one for a design for the body and the other for a design for the cutter.”<sup>249</sup> The examiner rejected the application on the basis that the claimed design was “not for an article of manufacture, but for an apparatus,” i.e., for a machine.<sup>250</sup> The examiner also argued that even if the two pieces could be considered as a single article of manufacture, “the applicant does not claim the entirety, and that without this no design patent can issue.”<sup>251</sup>

Acting Commissioner Greeley agreed that the claim was not allowable because “the design law was never intended to apply to structures having movable parts.”<sup>252</sup> Greeley stated that if Tallman’s “intention were to make the device all in one piece, as by casting, a claim for the structural design might be proper; but it is obvious that at present as the knife is shifted the form or contour of the article will be changed.”<sup>253</sup> Greeley did not address the question of whether a can-opener was a machine.<sup>254</sup> Following this decision, Tallman amended his claim to cover only the “can-opener body” and the Patent Office issued the patent.<sup>255</sup>

g) *Ex parte* Brand (1897)

Brand sought a design patent “for the parts of a joint for bedstead-rails.”<sup>256</sup> The application showed “a casting on the side rail of a bedstead and another adapted to be attached to the frame of the bedstead, which castings are adapted to interlock and form a joint.”<sup>257</sup> The examiner issued a restriction requirement and Assistant Commissioner Greeley affirmed.<sup>258</sup> According to Greeley, the application “cover[ed] two separate and distinct articles” and “[t]he fact that two articles are used together does not make them, when so used, constitute a unitary design.”<sup>259</sup> Greeley concluded that a protectable design must be for “a single unchangeable article of

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249. *Ex parte* Tallman, 1898 Dec. Comm’r Pat. 10, 10.

250. *See id.* at 11.

251. *Id.*

252. *Id.* (citing *Ex parte* Smith, 1897 Dec. Comm’r Pat. 170).

253. *Id.*

254. *See id.*

255. *See id.* at 10 (discussing Application No. 634,949); U.S. Patent No. D28,232 (issued Feb. 1, 1898 from Application No. 634,949).

256. *Ex parte* Brand, 1898 Dec. Comm’r Pat. 62, 63.

257. *Id.*

258. *Id.*

259. *Id.* (citing *Ex parte* Patitz, 1883 Dec. Comm’r Pat. 101; *Ex parte* Haggard, 1897 Dec. Comm’r Pat. 47).

manufacture and must not be made up of independent detachable parts.”<sup>260</sup> In Brand’s case, the two casings were “designed for the very purpose of attachment and detachment from each other” and, accordingly, did not “constitute a unitary design.”<sup>261</sup>

h) *Ex parte Adams* (1898)

Walter S. Adams claimed a design for a “Truck Side Frame.”<sup>262</sup> The examiner refused to consider the application because:

A machine does not fall within the purview of section 4929, Revised Statutes. On the contrary, the only subject of the design act is the “manufacture” named in section 4886, Revised Statutes.<sup>263</sup>

In support of his position, the examiner cited *Ex parte Lewis*.<sup>264</sup> Assistant Commissioner Greeley ruled that he did not have jurisdiction to consider the propriety of the examiner’s action.<sup>265</sup> Nonetheless, Greeley stated that the claim should fail for an independent reason:

[T]he design law was never intended to apply to structures having movable parts. If the parts are movable, the structure presents a great variety of forms instead of being *limited to a single shape or configuration of* an article of manufacture, as provided in section 4929 of the Revised Statutes.<sup>266</sup>

According to Greeley, the problem was that the applicant was not trying to patent a single “design.”<sup>267</sup>

Greeley noted, however, that while a design for a “machine itself” could not be patented, “[t]he several articles of manufacture of peculiar shape which when combined produce a machine or structure having movable parts” could be patented.<sup>268</sup>

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260. *See id.*

261. *Id.*

262. *Ex parte Adams*, 1898 Dec. Comm’r Pat. 115, 115.

263. *See id.* at 116 (quoting the examiner’s letter).

264. *See id.* at 116 (citing *Ex parte Lewis*, 1891 Dec. Comm’r Pat. 61).

265. *Ex parte Adams*, 1898 Dec. Comm’r Pat. 115, 116. Instead, it should have been appealed to the Examiners-in-Chief. *Id.*; *see also supra* note 244 (discussing the Commissioner’s jurisdiction over appeals).

266. *Ex parte Adams*, 1898 Dec. Comm’r Pat. 115, 116 (emphasis added).

267. *See id.*

268. *Id.*

i) *Ex parte* Amberg (1898)

Amberg sought a design patent for a “design for banners, badges, buttons, and other decorative devices and displays.”<sup>269</sup> The examiner required that he change the title because “the description and drawing show[ed] that” Amberg had only produced the design as applied to a “banner or flag.”<sup>270</sup> On petition to the Commissioner, Amberg argued he should not have to change the title because his design was for a “surface ornamentation that may be placed on other articles.”<sup>271</sup>

Commissioner Duell sustained the examiner’s requirement, noting that even if Amberg’s design could be applied to other articles, Amberg had not actually done so.<sup>272</sup> Because Amberg had not “invented *and produced* this design on any other article of manufacture,” he had to change his title and the claim to cover only “what he has produced and shown and described . . . leaving to the courts the question as to whether he may use it on any other article . . . or whether any other party using it on other devices would infringe his design.”<sup>273</sup> Although *Amberg* does not directly address the issue of what constituted an “article of manufacture,” it does shed light on how the Patent Office conceptualized the scope of design patents for surface ornamentation. For example, it shows that the Patent Office thought that a design patent for surface ornamentation could be—but would not necessarily be—infringed by using the design on an article that was different than the one produced by the patent owner.

j) *Ex parte* Kapp (1898)

The applicants claimed a design for “a device for removing clothes from washboilers”—i.e., for a pair of tongs.<sup>274</sup> If submitted today, the illustrations might have looked something like this<sup>275</sup>:

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269. *Ex parte* Amberg, 1898 Dec. Comm’r Pat. 117, 117.

270. *See id.* 117–18.

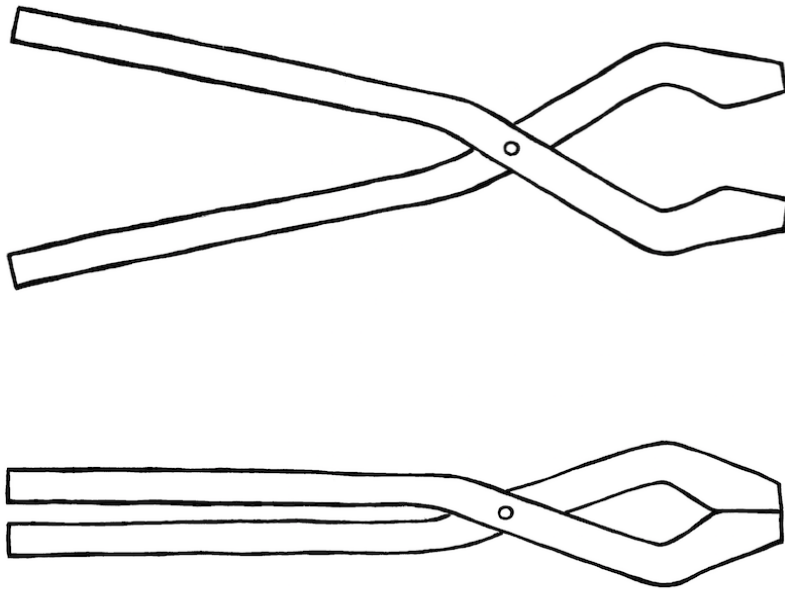
271. *Id.* at 118.

272. *Id.*

273. *Id.*

274. *Ex parte* Kapp, 1898 Dec. Comm’r Pat. 108, 108.

275. *See id.* (discussing the design disclosed in Application No. 629,446); Design for a Member of a Pair of Tongs, U.S. Patent No. D29,307 (issued Sept. 6, 1898 from Application No. 629,446); *see also supra* Section II.B (discussing contemporary design patent claiming rules); Burstein, *Costly Designs*, *supra* note 1, at 114 (same).



The examiner required the applicants to amend the application because it showed an “apparatus” instead of an “article of manufacture.”<sup>276</sup>

On appeal, Commissioner Duell sustained the requirement on a different basis. Like Assistant Commissioner Greely did in *Adams* and *Tallman*, Duell avoided the issue of whether the design was for a “machine” or a “manufacture” and instead focused on the fact that the configuration changed when the article was in use.<sup>277</sup> Duell noted “the form or contour of which as a whole is changed as the tongs are opened or closed” and stated

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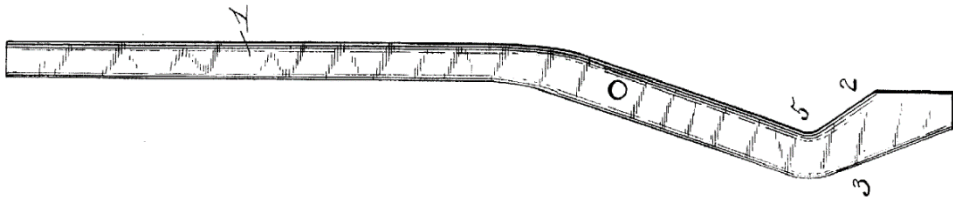
276. See *Ex parte Kapp*, 1898 Dec. Comm’r Pat. 108, 108 (“This is a petition from the action of the Examiner of May 24, 1898, that ‘if applicant should revise his application to set up the design as residing in one of the members of the tongs, in order that the claim be for the design for the shape and configuration of an article of manufacture, and not of an organized apparatus, as is now the case, further consideration will be given the application.’”).

277. Compare *id.*, with *Ex parte Adams*, 1898 Dec. Comm’r Pat. 115, 116, and *Ex parte Tallman*, 1898 Dec. Comm’r Pat. 10, 11. Arguably, the question of whether the device was really a “machine” was closer in *Kapp* than in *Adams*, which might explain why Duell wanted to resolve the case on different grounds. See generally *supra* Section IV.A.1.a) (discussing the debate over how tools should be classified).

that “[i]t is not the intent of the design law to cover designs of this character.”<sup>278</sup> Furthermore, according to Duell:

If applicants have invented and produced anything that is novel, it is not a pair of tongs, but the shape or configuration of a member or jaw of a pair of tongs. Their description and claim should be limited to this.<sup>279</sup>

Following this decision, the Patent Office approved the application as amended to claim only one piece of the tongs:<sup>280</sup>



k) *Ex parte* Wiessner (1898)

Wiessner sought a design patent for a “metallic bedstead.” The drawing showed “a bedstead consisting of the headboard, footboard, and side rails.”<sup>281</sup> The headboard and footboard looked “somewhat similar” but were not identical in appearance.<sup>282</sup> The footboard apparently looked like this:<sup>283</sup>

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278. *Ex parte* Kapp, 1898 Dec. Comm’r Pat. 108, 108 (internal citations omitted) (citing *Ex parte* Smith, 1897 Dec. Comm’r Pat. 170; *Ex parte* Tallman, 1898 Dec. Comm’r Pat. 10, 10).

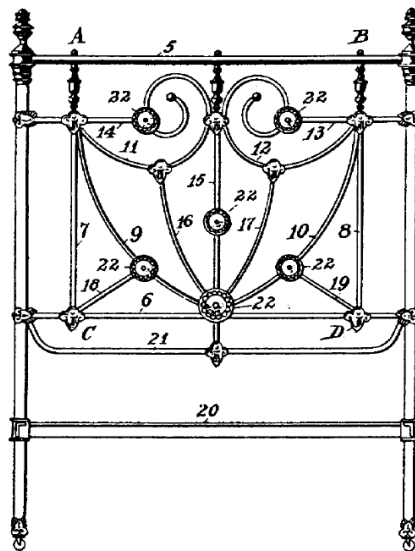
279. *Id.*

280. Design for a Member of a Pair of Tongs, U.S. Patent No. D29,307 (issued Sept. 6, 1898 from Application No. 629,446); see also *Ex parte* Kapp, 1898 Dec. Comm’r Pat. 108, 108 (discussing the design disclosed in Application No. 629,446).

281. *Ex parte* Wiessner, 1898 Dec. Comm’r Pat. 236, 237.

282. See *id.* (“The headboard and footboard contain somewhat similar ornamentation, but differ from each other in certain particulars.”).

283. See *id.* (discussing Application No. 683,863); End Piece for Bedsteads, U.S. Patent No. 30,017 (issued Jan. 17, 1899 from Application No. 683,863).



In his application, Wiessner claimed:

1. In a design for a metallic bedstead, the design for a headboard, substantially as shown and described.
2. In a design for a metallic bedstead, the design for a footboard, substantially as shown and described.
3. The design for a metallic bedstead, substantially as shown and described.<sup>284</sup>

The examiner required a division, noting the headboard and footboard were “separate and distinct articles of manufacture,” even though they were “parts or elements of the entire bedstead.”<sup>285</sup> On petition, Assistant Commissioner Greeley had to decide whether “the applicant may . . . have claims to two separate parts of that bedstead” in the same application as a

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284. *Ex parte* Wiessner, 1898 Dec. Comm’r Pat. 236, 237.

285. *See id.* at 238.

claim for the entire bedstead.<sup>286</sup> Greeley ruled that the applicant could not.<sup>287</sup>

According to Greeley, if a larger article contained “segregable parts” that were “separate articles of manufacture, complete within themselves,” designs for those constituent articles could be patented separately from a design for the larger article; however, those claims covered separate designs and had to be made in separate applications.<sup>288</sup> He stated that “[t]he fact that these articles may be united and form still another article of manufacture furnishes no reason for allowing them in one case.”<sup>289</sup> He reasoned that designs for these “segregable parts” were “beyond question separate and independent designs and neither would infringe a patent on the other, and therefore to allow them in one case [i.e., in one application] would be to grant a single patent on a great number of different articles of manufacture.”<sup>290</sup>

Following this decision, Wiessner amended his application to claim only the “end piece” of the bedstead and the Patent Office allowed the claim.<sup>291</sup>

1) *Ex parte* Steck (1901)

Steck claimed a design for “an improvement in frames of water-towers,” specifically the type “used by fire departments to support the hose when playing upon a fire in a tall building.”<sup>292</sup> The examiner rejected Steck’s design patent claim “on the ground that the application [was] not limited to a single definite article of manufacture.”<sup>293</sup>

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286. *Id.* The examiner also raised other concerns about Claims 1 and 3; however, those issues were not properly before the Commissioner. *Id.* (“Claim 3 covers the entire bedstead; whether properly so or not cannot now be considered . . . .”); *id.* at 242 (“The Examiner has rejected claim 1 as not being limited to a single article of manufacture; but that question has not been considered on this petition, since it is a matter for the Examiners-in-Chief on appeal.”); *see also supra* note 244 (discussing the Commissioner’s jurisdiction to hear appeals). Wiessner eventually received a design patent for the end-piece (Claim 2). *See infra* note 291 and accompanying text. But it does not appear that he ever received a design patent for either the headboard or the whole.

287. *Ex parte* Wiessner, 1898 Dec. Comm’r Pat. 236, 242.

288. *See id.*

289. *Id.*

290. *Id.*

291. *See id.* at 237 (discussing Application No. 683,863); End Piece for Bedsteads, U.S. Patent No. 30,017 (issued Jan. 17, 1899 from Application No. 683,863).

292. *Ex parte* Steck, 1902 Dec. Comm’r Pat. 9, 15.

293. *Id.* at 10.



Commissioner Allen agreed the claim should not be allowed, but on a different basis—namely, that the application claimed a design for “a machine and not an article of manufacture.”<sup>294</sup> Allen noted, “[u]nder the express provisions of the statute [design] patents are limited to ‘an article of manufacture,’ and there is clear and well-defined distinction in patent law between a machine and an article of manufacture.”<sup>295</sup>

Allen suggested Congress may have decided to exclude designs for machines from design patent protection because “[t]he subject-matter of patents must be definite and certain” and a design for the configuration of “a machine made up of movable parts” would be constantly changing.<sup>296</sup> But, according to Allen:

It has never . . . been the practice of the [Patent] Office to require absolute immovability of the parts of an article in order to warrant the holding that it is an article of manufacture and patentable as a design. There may be some relative movement of the parts of a single article of manufacture without changing the appearance of the article, and in such case it comes within the design law; *but nothing which amounts to a machine can come within the law.*<sup>297</sup>

Allen then framed the issues in a two-part test that seems to reconcile many of the previous Commissioner decisions:

[F]irst, is its shape fixed and definite? and, second, is it an article of manufacture and not a machine? . . . If it is a machine, it is not patentable under the law, whether or not the movement of the parts is such as to materially change the appearance of the machine as a whole.<sup>298</sup>

Thus, under the *Steck* framework, if a design was not “fixed and definite” due to moving parts, there would be no need to ask whether the design was for a “machine.”

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294. *Id.* at 15.

295. *Id.* at 13 (citing to Rev. Stat. § 4929).

296. *Id.*

297. *Id.* (emphasis added).

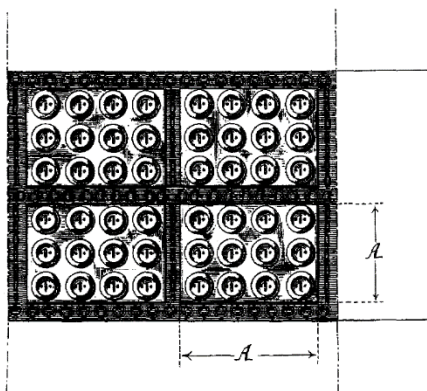
298. *Id.* This framing helps explain—or at least reconcile—decisions in which previous Commissioners seemed to duck the “machine” issue. *See, e.g., Ex parte Kapp*, 1898 Dec. Comm’r Pat. 108; *Ex parte Adams*, 1898 Dec. Comm’r Pat. 115.

### 3. Court Decisions

By 1887, there were not many court cases involving design patents generally<sup>299</sup> and even fewer that addressed the “article of manufacture” issue. This Section discusses the three judicial decisions that help shed light on what “article of manufacture” meant in 1887.

#### a) *Pratt v. Rosenfeld* (1880)

In *Pratt*, the asserted patent claimed “a design for a card of buttons, divided into spaces, covered with foil, by narrow bands, with a dozen of pearl buttons in rows, as shown below<sup>300</sup>:



The trial court dismissed the complaint because the patent did not claim a design “for a manufacture.”<sup>301</sup> The court saw the buttons as the relevant “manufactures” because “the buttons are to be used by the purchaser, but the card is not, either with them or by itself.”<sup>302</sup> The applicant had not, however, invented a new design *for* the buttons; instead, the applicant had

299. According to Commissioner Fisher, by 1869 there had only been three litigated design patent cases. *See, e.g., Ex parte Bartholemew*, 1869 Dec. Comm’r Pat. 103, 103 (“[Design patents] have made so little figure in litigation that but three reported cases are known”). Fenton’s 1889 treatise on design patents, which purported to contain “all reported cases” included ninety-four reported judicial decisions. *See FENTON, supra* note 186, at iii, vii–xii.

300. *Pratt v. Rosenfeld*, 3 F. 335, 335 (C.C.S.D.N.Y. 1880) (“This suit is brought upon design patent No. 7,914 . . .”); *see also* U.S. Patent No. D7,914 (issued Dec. 8, 1874).

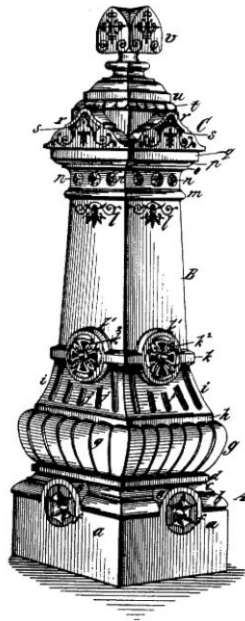
301. *See Pratt*, 3 F. at 335–36 (“The statute (Rev. Stat. Sec. 4929) authorizes the grant of a patent to any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture . . . The subject of this patent is not covered by this statute unless it is included in the term ‘manufacture.’”).

302. *See id.* at 337.

merely created a new “method of putting [those buttons] up for sale.”<sup>303</sup> The court reasoned, “merely changing the mode of keeping and presenting an article for sale, without changing its form or appearance, will not support a patent for a design.”<sup>304</sup> Instead, the applicant had to do “something affecting the article itself.”<sup>305</sup> *Pratt* also suggests that an “article of manufacture” had to be something actually “used by the purchaser,” as opposed to packaging or a way of displaying items for sale.<sup>306</sup>

b) *Simpson v. Davis* (1882)

In *Simpson*, the plaintiff had a patent for the design a newel post.<sup>307</sup> The illustration from that patent is shown below<sup>308</sup>:



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303. *See id.* at 336; *see also id.* (noting that the buttons were “not changed at all, either in form or appearance, by the patented invention”).

304. *Id.* at 337.

305. *Id.*

306. *See id.* Importantly, the court in *Pratt* did not have to decide—and therefore, did not hold—that an “article of manufacture” was always whatever was “used by the purchaser.” Instead, it merely concluded that if something was not “used by the purchaser,” it was not (or not a part of) an “article of manufacture.”

307. *Simpson v. Davis*, 12 F. 144, 144 (C.C.E.D.N.Y. 1882).

308. U.S. Patent No. D12,026 (issued Nov. 9, 1880); *see also Simpson*, 12 F. at 144 (identifying this as the patent-in-suit).

The patent-in-suit contained multiple claims.<sup>309</sup> The defendant argued the sixth claim—which claimed a design for the cap of a newel post—was invalid because the cap of a newel post was not a “manufacture.”<sup>310</sup>

There was evidence in the record indicating “the cap of a newel post is a distinct article often manufactured by itself, but never used except in connection with other parts . . . to make up what is known as a newel post.”<sup>311</sup> Based on that evidence, the court thought the cap “may be held to be a manufacture.”<sup>312</sup> But the court concluded the validity of the sixth claim was “of no importance” to the ultimate resolution of the case because the seventh claim—which claimed the entire newel post—was infringed and not invalid.<sup>313</sup> Therefore, the discussion of the sixth claim in *Simpson* is *dicta*. But it suggests that an “article of manufacture” was something that is “manufactured by itself,” even if it was “never used except in connection with other parts . . . to make up” a larger product.<sup>314</sup>

c) *Westinghouse Elec. & Mfg. Co. v. Triumph Elec. Co.* (1899)

The patent-in-suit claimed a design for “a frame for electric machines,” as shown below<sup>315</sup>:

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309. *Simpson*, 12 F. at 144 (“There are 11 claims. Only the fifth, the sixth, and the eleventh are relied on here.”).

310. *See id.* at 145 (“The first question presented by this claim is whether the cap of a newel post is a manufacture within the meaning of the statute.”).

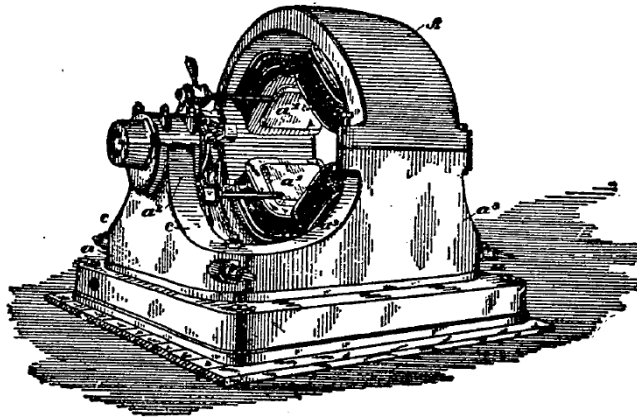
311. *Id.* at 145–46.

312. *Id.* at 146.

313. *Id.*

314. *See id.*

315. *Westinghouse Elec. & Mfg. Co. v. Triumph Elec. Co.*, 97 F. 99, 99–100 (6th Cir. 1899); Design for a Frame for Electric Machines, U.S. Patent No. D21,416 (issued Mar. 22, 1892).



The defendant argued the design patent was invalid because, inter alia, it did not claim a design for an “article of manufacture.”<sup>316</sup> Specifically, the defendant argued that “the frame of the electric machine is not an article of manufacture” and “a design patent cannot be granted for the configuration of what is part of a machine, rather than an article of manufacture.”<sup>317</sup> The Sixth Circuit characterized this issue as one “not free from difficulty” but decided that it was not necessary to resolve it because the design was invalid on another basis—namely, because the design “was not new or original.”<sup>318</sup>

Although the court did not answer the “article of manufacture” question, the fact that the court found the question difficult suggests at least some disagreement with the Patent Office’s conclusion that a part of a machine could qualify as an “article of manufacture.”<sup>319</sup>

#### B. REMEDY

On February 4, 1887, Congress enacted the additional design patent remedy provision. This Section reviews the Supreme Court case that prompted Congress to act and explains the aspects of the legislative history relevant to the question of what the phrase “article of manufacture” meant in 1887.

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316. *Westinghouse*, 97 F. at 101.

317. *Id.* at 102.

318. *Id.* at 102–03.

319. Compare *id.*, with, e.g., *Ex parte Smith*, 1897 Dec. Comm’r Pat. 170. Notably, however, nothing in *Westinghouse* indicates any disagreement with the notion that there was a fundamental distinction between the statutory categories of “machines” and “articles of manufacture.” Instead, it merely expresses at least some mild skepticism that machine components could be the subject of design patents at all.

### 1. *The Carpet Cases*

In *Dobson v. Hartford Carpet Co.*, the Supreme Court was called on to decide three consolidated cases for design patent infringement.<sup>320</sup> The defendants accused John and James Dobson of infringing three design patents.<sup>321</sup> Each of those patents claimed a design for surface ornamentation for a piece of carpet.<sup>322</sup> The lower court found the defendants liable for infringing all three design patents.<sup>323</sup> The plaintiffs “waived all claim for profits” and sought actual damages based on lost sales.<sup>324</sup> Both the plaintiffs and the defendants sold their carpets by the yard.<sup>325</sup> The lower court calculated the plaintiffs’ actual damages by multiplying the number of yards of infringing carpet the defendants sold by the profits the plaintiffs made per yard on their own commercial embodiments,<sup>326</sup> for a total of \$2,799.50 in damages.<sup>327</sup> The defendants appealed these awards to the Supreme Court.<sup>328</sup>

The Supreme Court reversed.<sup>329</sup> The Court held that the rule it established for the recovery of profits or damages in utility patent cases also applied in design patent cases.<sup>330</sup> That rule, as stated in *Garretson v. Clark*, was:

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320. *Dobson v. Hartford Carpet Co.*, 114 U.S. 439, 440 (1885).

321. *Id.* The Dobsons “trad[ed] as John and James Dobson and as ‘The Falls of Schuylkill Carpet Mills.’” *Id.*

322. *Id.* The design patents in suit were: U.S. Patent No. D11,074 (issued Mar. 18, 1879); U.S. Patent No. D10,778 (issued Aug. 13, 1878); and U.S. Patent No. D10,870 (issued Oct. 15, 1878). *See id.* Thus, *Dobson* is sometimes referred to as “the Carpet Cases.” *See, e.g.,* *Untermeyer v. Freund*, 50 F. 77, 78 (C.C.S.D.N.Y. 1892), *aff’d*, 58 F. 205 (2d Cir. 1893).

323. *Dobson*, 114 U.S. at 441.

324. *See id.* at 441–43.

325. *See id.*

326. *See id.*

327. *See* *Bigelow Carpet Co. v. Dobson*, 10 F. 385, 387–88 (C.C.E.D. Pa. 1882) (awarding \$737 for infringement the first design patent, \$750 for the second, and \$1,312.50 for the third). \$2,799.50 in 1882 would be worth almost \$70,000 in 2016. *See Consumer Price Index (Estimate) 1800-*, FED. RES. BANK OF MINNEAPOLIS <https://www.minneapolisfed.org/community/teaching-aids/cpi-calculator-information/consumer-price-index-1800> (last visited Aug. 20, 2017) [hereinafter *CPI Calculator*] (2799.50 x (719.7/29) = 69,475.8672).

328. *Dobson*, 114 U.S. at 442. At the time, patent cases were directly appealable to the Supreme Court. *See* John F. Duffy, *The Festo Decision and the Return of the Supreme Court to the Bar of Patents*, 2002 SUP. CT. REV. 273, 286–87 (2002).

329. *Dobson*, 114 U.S. at 446.

330. *Id.* at 444–45.

The patentee must . . . give evidence tending to separate or apportion the defendant's profits and the patentee's damages between the patented feature and the unpatented features, and such evidence must be reliable and tangible, and not conjectural or speculative; *or* he must show, by equally reliable and satisfactory evidence, that the profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine . . . is properly and legally attributable to the patented feature.<sup>331</sup>

As applied to design patents, this rule allowed for an award of profits or damages in two different scenarios.<sup>332</sup> First, where the patentee could prove that some portion of the profits or damages from the infringing article were attributable to the patented design, the patentee could recover those apportioned profits or damages.<sup>333</sup> Second, in cases where the patentee could prove that “the entire value” of the infringing product was “properly and legally attributable” to the patented design, the patentee could recover the profits or damages for the entire article.<sup>334</sup>

As to the first scenario, the Court made it clear that the requisite “apportionment” would require distinguishing between the profits or damages attributable to design—i.e., the surface ornamentation and/or configuration of the article—and the profits or damages attributable to the “intrinsic merits of quality and structure” of the article itself.<sup>335</sup> As to the

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331. *Id.* at 445 (quoting *Garretson v. Clark*, 111 U.S. 120, 121 (1884)) (internal quotation marks omitted) (emphasis added). Although this passage from *Garretson* refers to patented “features,” it is clear from the context that the *Dobson* Court was drawing a distinction between patented *designs* and the underlying articles, not anticipating our current fragment-claiming system, wherein one part of a configuration could be claimed and the rest disclaimed. *Compare id.*, with Section II.B, *supra*.

332. *See Dobson*, 114 U.S. at 445.

333. *See id.*

334. *See id.* (stating that this type of recovery was applicable in “exceptional cases”); *see also id.* at 445–46 (stating that the entire profit for a decorated article could not be attributed to—and thus awarded for—infringement of the patented surface ornamentation “*unless* it is shown, by evidence, as a fact, that the profit ought to be so attributed” (emphasis added)).

335. *See id.* (“Approval of the particular design or pattern may very well be one motive for purchasing the article containing it, but the article must have *intrinsic merits of quality and structure*, to obtain a purchaser, aside from the pattern or design . . .”) (emphasis added); *see also id.* at 444 (distinguishing between “the profits from carding, spinning, dyeing and weaving” a carpet and the “profits . . . due to the figure or pattern”); *id.* at 445 (distinguishing between “[a] design or pattern in ornamentation or shape” and “[t]he article which embodies it”); *see also* S. REP. NO. 49-206, at 1–2 (1886) (stating that the Court “held . . . that the complainant must clearly prove what part of his own damage or what part of defendant’s whole profit on the article made and sold was directly due to the

second scenario, the Court stated a design patent owner would have to prove articles bearing the patented design sold for a higher price than articles not bearing the patented design in order to recover the “entire profit” for sales of an infringing article.<sup>336</sup> Applying this rule to the facts of *Dobson*, the Court stated:

[N]o rule has been sanctioned which will allow, in the case of a patent for a design for ornamental figures created in the weaving of a carpet, or imprinted on it, the entire profit from the manufacture and sale of the carpet, as profits or damages, including all the profits from carding, spinning, dyeing, and weaving, thus regarding the entire profits as due to the figure or pattern, unless it is shown, by reliable evidence, that the entire profit is due to the figure of pattern.<sup>337</sup>

In *Dobson*, there “was no evidence” in the record as to “the value which the designs contributed to the carpets,” and therefore no support for an award of either apportioned profits or entire profits.<sup>338</sup> Accordingly, the Court reversed the lower court’s entire-profit awards and remanded the cases with instructions to award nominal damages of six cents in each of the three consolidated cases.<sup>339</sup>

## 2. Congress Steps In

The Supreme Court issued its decision in *Dobson* on April 20, 1885.<sup>340</sup> At that time, the chairs of the U.S. Senate and U.S. House Committees on

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*appearance of those articles as distinguished from their material, their fabric, their utility, &c., the design, to wit, the appearance being the only thing patented.”* (emphasis added)); H.R. REP. NO. 49-1966, at 1–2 (1886) (same); FENTON, *supra* note 186, at 186–87 (stating that the 1887 Act was meant to address the difficulty of apportioning between the design and “the article itself”); *Untermeyer v. Freund*, 50 F. 77, 79 (C.C.S.D.N.Y. 1892), *aff’d*, 58 F. 205 (2d Cir. 1893) (“*It is the profit on the sale of the article for which the infringer must account, and not alone the profit which can be demonstrated as due to the design.*” (emphasis added)); *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1442 (Fed. Cir. 1998) (“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.” (emphasis added)).

336. *Dobson*, 114 U.S. at 444.

337. *Id.*

338. *Id.* at 443.

339. *Id.* at 447. The next year, the Supreme Court reached the same conclusion in a similar case against the Dobsons. See *Dobson v. Dornan*, 118 U.S. 10 (1886).

340. *Dobson*, 114 U.S. at 439.



Patents were both from Connecticut.<sup>341</sup> Textile manufacturing was a major industry in Connecticut.<sup>342</sup> According to one study, in 1880, 29% of Connecticut manufacturing jobs were in the textiles industry,<sup>343</sup> which employed 33,150 people and had a “value output” of over \$53 million.<sup>344</sup> The carpet sector alone employed 1,654 people and had an output of over \$2.5 million.<sup>345</sup>

After *Dobson* was decided, Senator Orville Hitchcock Platt of Connecticut, who was the chair of the Senate Committee on Patents, introduced a bill that would create a new remedy for certain acts of design patent infringement.<sup>346</sup> On February 15, 1886, Representative Charles Le Moyne Mitchell of Connecticut, who was the chair of the House Committee on Patents, introduced a substantially identical bill in the House.<sup>347</sup> A modified version of the Senate bill was enacted on February 4, 1887.<sup>348</sup> As enacted, the new provision stated:

That hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied. Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty

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341. See BIOGRAPHICAL DIRECTORY OF THE UNITED STATES CONGRESS, 1774-1989: BICENTENNIAL EDITION 1512 (1989) [hereinafter BICENTENNIAL DIRECTORY] (entry for Charles Le Moyne Mitchell); *id.* at 1653 (entry for Orville Hitchcock Platt).

342. See, e.g., LEIGH FOUGHT, A HISTORY OF MYSTIC, CONNECTICUT: FROM PEQUOT VILLAGE TO TOURIST TOWN 63 (2007) (stating that, from 1815 to 1914, “[f]or New England, whaling and textiles would be the biggest of businesses”).

343. See GRACE PIERPONT FULLER, AN INTRODUCTION TO THE HISTORY OF CONNECTICUT AS A MANUFACTURING STATE 55–56 (1915).

344. *Id.* at 56. In 1880, Connecticut had a total population of 622,700. U.S. CENSUS BUREAU, RESIDENT POPULATION AND APPORTIONMENT OF THE U.S. HOUSE OF REPRESENTATIVES: CONNECTICUT, <https://www.census.gov/dmd/www/resapport/states/connecticut.pdf>.

345. FULLER, *supra* note 343, at 56.

346. See S. 1034, 49th Cong. § 1 (1886); see also BICENTENNIAL DIRECTORY, *supra* note 341, at 1653.

347. H.R. 5570, 49th Cong. (1886); BICENTENNIAL DIRECTORY, *supra* note 341, at 1512.

348. Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387. The differences between the original and modified bill are not relevant to the discussion here.

dollars; and in case the total profit made by him from the manufacture or sale . . . of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of two hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars; and the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any circuit court of the United States having jurisdiction of the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.

Sec. 2. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same, might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement.<sup>349</sup>

Unlike the current statute, the 1887 Act explicitly described the potentially recoverable “total profit” as the “total profit made by [the infringer] from the manufacture or sale . . . of the article or articles . . . .”<sup>350</sup> And by “article or articles,” Congress was clearly referring to the “article[s] of manufacture” mentioned earlier in the same paragraph.<sup>351</sup>

As for the rationale behind this new “rule of recovery,” the legislative history suggests Congress was concerned that most design patent owners would not be able to recover damages—other than nominal damages—or profits in the wake of *Dobson*.<sup>352</sup> Both the House and Senate reports expressed concern that it would be exceedingly difficult, if not impossible, for most design patentees to do the type of “apportionment” required for an award of partial damages or profits under *Dobson*.<sup>353</sup> Both reports expressed

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349. *Id.* at 387–88.

350. Compare *id.*, with 35 U.S.C. § 289 (2012). Of course, as discussed above, the Federal Circuit has effectively read the “from the manufacture or sale . . . of the article or articles” language back into the statute. See generally *supra* note 103 and accompanying text. No party disputed—and the Supreme Court did not reverse—that portion of the Federal Circuit’s decision. See *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016).

351. See Act of Feb. 4, 1887, ch. 105, § 1, 24 Stat. 387, 387 (“[I]t shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture . . .” (emphasis added)).

352. See S. REP. NO. 49-206, at 1 (1886); H.R. REP. NO. 49-1966, at 3 (1886).

353. Both reports stated that “[i]t has been abundantly shown . . . that the proof thus called for can never be furnished.” S. REP. NO. 49-206, at 2 (1886); H.R. REP. NO. 49-1966, at 2 (1886). However, neither report stated who made such a showing or what type of evidence had been presented. The Senate report also backed down off the “never” point

doubt that any patentee would be able to recover a defendant's entire profits under the *Dobson* test because "designs do not increase the selling price, but only increase the quantity sold of the articles on which they appear."<sup>354</sup>

The new statute provided for a minimum penalty for \$250.<sup>355</sup> That would be about \$6,664 in 2016 dollars.<sup>356</sup> According to the Senate report, the \$250 minimum penalty was meant to address two different scenarios: (1) where the infringer made no profit; and (2) "where the exact profit in dollars and cents cannot be proved under the technical rules of the law as

later on, stating that the requisite proof would not be available in "the large majority of suits," as opposed to in *all* suits. *See* S. REP. NO. 49-206, at 2 (1886). As noted above, the Court made it clear in *Dobson* the requisite "apportionment" would require distinguishing between the profits or damages attributable to the design and the profits or damages attributable to the other (nonvisual) attributes of the infringing article of manufacture. *See supra* note 335 and accompanying text; *see also* *Untermeyer v. Freund*, 58 F. 205, 212 (2d Cir. 1893) ("The rule which congress declared for the computation of profits was the total profit from the manufacture or sale of the *article* to which the design was applied, as distinguished from the pre-existing rule of the profit which could be proved to be attributable to the *design*." (emphasis added)).

354. S. REP. NO. 49-206, at 2 (1886); H.R. REP. NO. 49-1966 at 2 (1886). While both reports stated that this fact had been "abundantly proved before your committee," neither report substantiated such claim. *See* S. REP. NO. 49-206, at 2 (1886); H.R. REP. NO. 49-1966 at 2 (1886). Today, by contrast, there is evidence that consumers *will* pay a premium for aesthetic product design. *See* Brief of Amicus Curiae Industrial Designers Society of America in Support of Neither Party at 4–5, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 3227035 [hereinafter *IDSA Br.*] ("Aesthetic contributions by industrial designers are not just the lynchpin for purchases of similarly performing products; *consumers often pay a premium for product beauty.*") (emphasis added).

355. S. REP. NO. 49-206, at 2 (1886). The House and Senate reports both describe the \$250 penalty as "the method of the English statute, which prescribes a remedy of £50 on proof of a violation of a design registration, a law that has been in successful operation for upwards of forty years." *Id.* (referring to Patents, Designs, & Trade Marks Act, 1883, 46 & 47 Vict., ch. 57, § 58 (Eng.)); H.R. REP. NO. 49-1966 at 3 (1886) (same). But in reality, the method of the referenced English statute was quite different; it provided for a £50 *maximum* monetary penalty for each violation while the U.S. bill provided for a \$250 *minimum* monetary penalty for each violation. *Compare* S. 1813, 49th Cong. § 1 (1886) ("Any person violating the provisions, or either of them, of this section, *shall be liable in the amount of two hundred and fifty dollars . . .*" (emphasis added)), *with* Patents, Designs, & Trade Marks Act, 1883, 46 & 47 Vict., c. 57, § 58 (Eng.) ("Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum *not exceeding fifty pounds . . .*" (emphasis added)). And it appears that the English statute was not, in fact, very successful; it was revised in 1888 "to prevent the possibility of ruinous penalties being imposed." *See* DAVID FULTON, A PRACTICAL TREATISE ON PATENTS, TRADE MARKS AND DESIGNS 155 (1894) ("[I]n the Amending Act of 1888 the total amount of penalties to be forfeited in respect of any one design was limited to a maximum of £100").

356. \$250 in 1887 would be worth approximately \$6,664 in 2016. *See CPI Calculator*, *supra* note 327 (250 x (719.7/27) = 6663.888889).

laid down by the Supreme Court” in *Dobson*.<sup>357</sup> The House report, like the Senate report, states that the \$250 penalty was meant to apply in two scenarios.<sup>358</sup> First, the penalty was meant to provide for monetary relief in “the case of an infringement actually committed without profit.”<sup>359</sup> Second, according to the House report, it was meant to provide for monetary relief “when the exact profit in dollars and cents cannot be proved under the severe and technical rules of the law (and this would not infrequently occur with defendant the only witness and his books the only evidence).”<sup>360</sup> This suggests that the House committee was particularly concerned about the possibility that defendants might withhold or misrepresent evidence relating to their profits.<sup>361</sup> Notably, both reports seem to contemplate that at least some of the “technical rules of the law” of damages would be left in place.<sup>362</sup>

Importantly, neither the text of the 1887 Act nor its legislative history provide any indication that Congress intended the phrase “article of manufacture” to mean something different in the new remedy provision than it did in the existing subject-matter provision. Nor is there any indication that Congress intended to give that phrase some new meaning or to otherwise depart from its well-established meaning as a term of art.<sup>363</sup> Nor was there any indication that Congress intended to change the scope of any design patents. To the contrary, both the House and Senate reports state

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357. S. REP. NO. 49-206, at 2 (1886). Thus, the \$250 was not solely meant for situations in which the infringer had made no profits. See Corrected Brief of Amici Curiae Jason J. Du Mont and Mark D. Janis in Support of Appellee Apple Inc. at 19, *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983 (Fed. Cir. 2015) (No. 14-1335), 2014 WL 4205378 [hereinafter Janis App. Br.].

358. Compare H.R. REP. NO. 49-1966, at 3 (1886), with S. REP. NO. 49-206, at 2 (1886). The House report, unlike the Senate report, also mentions deterrence as one purpose of the new provision. H.R. REP. NO. 49-1966, at 3 (1886).

359. Compare H.R. REP. NO. 49-1966, at 3 (1886), with S. REP. NO. 49-206, at 2 (1886).

360. H.R. REP. NO. 49-1966, at 3 (1886).

361. This was, of course, long before the era of expansive modern discovery practices. See generally Richard C. Reuben, *Constitutional Gravity: A Unitary Theory of Alternative Dispute Resolution and Public Civil Justice*, 47 UCLA L. REV. 949 (2000) (noting “the advent of modern discovery in 1938”).

362. See H.R. REP. NO. 49-1966, at 3 (1886); S. REP. NO. 49-206, at 2 (1886).

363. And of course, “under the normal rules of statutory construction the Court ‘assumes that identical words used in different parts of the same act are intended to have the same meaning’ . . . .” *Roell v. Withrow*, 538 U.S. 580, 593 (2003) (quoting *Sorenson v. Sec’y of Treasury*, 475 U.S. 851, 860 (1986)); see also *Atl. Cleaners & Dyers v. United States*, 286 U.S. 427, 433 (1932) (“Undoubtedly, there is a natural presumption that identical words used in different parts of the same act are intended to have the same meaning.” (citing *Courtauld v. Legh*, L. R., 4 Exch. 126, 130)).

that, aside from adding a new “rule of recovery,”<sup>364</sup> “[t]he bill leaves the present design law just as it is.”<sup>365</sup>

## V. LESSONS & IMPLICATIONS

This historical evidence provides a number of important lessons and may have significant implications for current debates about how to interpret and apply 35 U.S.C. § 289. This Section discusses some of those lessons and implications.

### A. IN 1887, “ARTICLE OF MANUFACTURE” WAS A TERM OF ART

This historical evidence demonstrates that by 1887, the term “article of manufacture” was a term of art in U.S. design patent law. It did not refer to any “article” that was “manufactured.” Instead, it referred to a tangible item made by humans—other than a machine or composition of matter—that had a unitary structure and was complete in itself for use or for sale.

The very words “article” and “manufacture” indicate that an “article of manufacture” had to be both tangible and made by humans.<sup>366</sup> The Patent Office repeatedly ruled that an article of manufacture had to have a “single, unitary structure.”<sup>367</sup> An article of manufacture also had to be complete in

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364. S. REP. NO. 49-206, at 1 (1886); H.R. REP. NO. 49-1966, at 3 (1886).

365. See S. REP. NO. 49-206, at 2 (1886); H.R. REP. NO. 49-1966, at 4 (1886).

366. See generally *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 434–35 (2016) (using contemporary and nineteenth-century dictionaries to conclude that “[a]n article of manufacture, then, is simply a thing made by hand or machine.”). Nineteenth century commentators confirmed that a “manufacture” had to be tangible. See, e.g., WALKER, *supra* note 156, at § 339 (referring to both “machines” and “manufactures” as “classes of tangible things”); CURTIS, *supra* note 155, at § 211 (referring to a manufacture as something “tangible”); HOPKINS, *supra* note 163, at § 31, 46 (“[A]s the Supreme Court has pointed out, the process alone remains invisible to the eye, a conception of the mind, known only by its results, while the machine, the manufacture and the composition of matter develop into tangible and visible substance.” (citing *Cochrane v. Deener*, 94 U.S. 780 (1876))). The fact that “manufactures” have historically been understood as being tangible items was also recently recognized by the Federal Circuit in *In re Nuijten*. 500 F.3d 1346, 1357 (Fed. Cir. 2007) (holding that the claimed “signals, standing alone, are not ‘manufactures’ under the meaning of that term in § 101” because they were not “tangible articles or commodities”). Although the Federal Circuit attempted to distinguish design patent from utility patent subject matter in *Nuijten*, see *id.* at 1357 n.9, that attempt was altogether unpersuasive. See Seymour & Torrance, *supra* note 11, at 199 (dissecting the Federal Circuit’s footnote).

367. SYMONS, *supra* note 47, at 32 (“The attempt has often been made to secure a patent on a device which is not a single, unitary structure, the Patent Office holding that the term ‘article of manufacture’ means such a structure and not one or more parts, although they are joined together.”); *id.* (discussing *Ex parte Brower*, 1873 Dec. Comm’r Pat. 151; *Ex parte Pope*, 1883 Dec. Comm’r Pat. 74; *Ex parte Patitz*, 1883 Dec. Comm’r Pat. 101;

itself for use or for sale.<sup>368</sup> To be “complete” in this sense, the item did not have to be the ultimate product sold or used by the ultimate consumer. For example, a mantel was an article of manufacture even though it was meant to “ultimately becom[e] part of a house.”<sup>369</sup>

Finally, the category of “articles of manufacture” specifically excluded machines and compositions of matter.<sup>370</sup> These exclusions were based on the *expressio unius est exclusio alterius* canon of construction.<sup>371</sup> In the utility patent subject matter provision, Revised Statutes § 4886, Congress listed “art,” “machine,” “manufacture,” and “composition of matter” as the categories of patentable inventions.<sup>372</sup> In the design patent subject matter provision, Revised Statutes § 4929, Congress did not mention any of these categories other than “manufacture.”<sup>373</sup> Accordingly, the Patent Office

*Ex parte* Gérard, 1888 Dec. Comm’r Pat. 37; Haggard, 1897 Dec. Comm’r Pat. 47; *Ex parte* Brand, 1898 Dec. Comm’r Pat. 62); *see also id.* (referring to Brower as “the earliest reported case found bearing on” the question of what constitutes a “unitary structure”).

368. *Ex parte* Blanchard, 1870 Dec. Comm’r Pat. 59, 59; *see also Ex parte* Campbell, 1872 Dec. Comm’r Pat. 228, 228; *Wilson v. Rousseau*, 30 F. Cas. 162, 211–12 (C.C.N.D.N.Y. 1845).

369. *Ex parte* Lewis, 1891 Dec. Comm’r Pat. 61, 63; *see also Ex parte* Wiessner, 1898 Dec. Comm’r Pat. 236, 238 (noting that the examiner stated—without any apparent dispute from the applicant—that a bed headboard and footboard are “separate and distinct articles of manufacture” from the bedstead itself).

370. *See, e.g., Ex parte* Smith, 1897 Dec. Comm’r Pat. 170, 170; CURTIS, *supra* note 155, at § 27, 20 n.2 (defining “manufacture” to exclude machines); PETTIT, *supra* note 166, at 35–36 (“Manufacture.—This is a very broad term, as broad almost as its derivation implies, *not including, however, machines* or compositions of matter.” (emphasis added)); HOWSON & HOWSON, *supra* note 173, at 34 (“It would seem that the word ‘manufacture’ is used here in the sense of an article of manufacture, a ‘thing’ made or manufactured by hand or by machine, *and not itself a ‘machine’* or a ‘composition of matter’” (emphasis added)); *see also supra* Section IV.A.1. The Patent Office ruled that, while an entire machine could never be an “article of manufacture,” parts of machines could be. *See, e.g., Ex parte* Smith, 1897 Dec. Comm’r Pat. 170. However, at least one court expressed skepticism that machine parts could ever be articles of manufacture. *See Westinghouse Elec. & Mfg. Co. v. Triumph Elec. Co.*, 97 F. 99, 102 (6th Cir. 1899).

371. *See generally* *Russello v. United States*, 464 U.S. 16, 23 (1983) (“Where Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.” (quoting *United States v. Wong Kim Bo*, 472 F.2d 720, 722 (5th Cir. 1972))).

372. 1 REVISED STATUTES OF THE UNITED STATES 946 (2d ed. 1878) (reproducing Rev. Stat. § 4886, as then in force). These were all considered to be independent, separate categories of invention. *See, e.g., Ex parte* Blythe, 1885 Dec. Comm’r Pat. 82, 86.

373. REVISED STATUTES OF THE UNITED STATES 962 (1st ed. 1875) (reproducing Rev. Stat. § 4929, as enacted) (referring to a “design for a manufacture” and designs for “any article of manufacture,” among other categories, as statutory subject matter). By that point,

repeatedly stated that designs for machines did not constitute proper statutory subject matter.<sup>374</sup> However, the Patent Office allowed design patents for parts of machines if those parts otherwise qualified as articles of manufacture.<sup>375</sup>

The fact that “article of manufacture” was a term of art in 1887 should be considered in evaluating arguments about the “plain meaning” of § 289.<sup>376</sup> After all, “[w]hen a term has become such a term of art, it is the traditional use, not the plain meaning, that governs.”<sup>377</sup> And, as discussed above, there is no evidence that Congress meant “article of manufacture” to mean something different in § 289 than it did elsewhere in design and utility patent law.<sup>378</sup>

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“article of manufacture” and “manufacture” were already being used as synonyms. *See supra* note 192.

374. *See, e.g., Ex parte Tallman*, 1898 Dec. Comm’r Pat. 10; *Ex parte Adams*, 1898 Dec. Comm’r Pat. 109; *Ex parte Smith*, 1897 Dec. Comm’r Pat. 170. In 1930, the CCPA rejected this line of cases and concluded that a design for a machine could be the subject of a design patent. *In re Koehring*, 37 F.2d 421, 424 (C.C.P.A. 1930). In *Koehring*, however, the CCPA did not consider the *expressio unius* point, basing its decision mainly on policy grounds and on a rejection of the Patent Office’s “moving parts” reasoning. *See id.* at 423–24.

375. *See, e.g., Ex parte Smith*, 1897 Dec. Comm’r Pat. 170, 171; *see also Ex parte Kapp*, 1898 Dec. Comm’r Pat. 108, 108 (affirming the rejection of a claim for a design of a pair of tongs but indicating that a design for an individual tong could be patented). *But see* *Westinghouse Elec. & Mfg. Co. v. Triumph Elec. Co.*, 97 F. 99, 102 (6th Cir. 1899) (expressing skepticism that even a part of a machine could be an “article of manufacture” but not deciding that issue).

376. *See, e.g.,* Brief of Amicus Curiae American Intellectual Property Law Association in Support of Respondent at 7, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 4268252 (arguing for a “a Plain-Meaning Statutory Construction”); Janis App. Br., *supra* note 357, at 2 (“Section 289 permits design patentees to claim the infringer’s total profits on sales of the infringing products. The statutory language is clear.”).

377. Mark A. Lemley, *Does “Public Use” Mean the Same Thing It Did Last Year?*, 93 TEX. L. REV. 1119, 1127 (2015) (citing *Air Wis. Airlines Corp. v. Hoeper*, 134 S. Ct. 852, 861–62 (2014) (emphasis omitted)).

378. *See supra* Section IV.B.2.

B. IN 1887, THE PHRASE “ARTICLE OF MANUFACTURE” DID NOT HAVE THE MEANING ASCRIBED TO IT BY EITHER THE FEDERAL CIRCUIT OR THE SUPREME COURT

In the past two years, both the Federal Circuit and the Supreme Court have interpreted the phrase “article of manufacture” in § 289.<sup>379</sup> While neither expressly purported to be attempting a historical definition of “article of manufacture,” it is worth noting that these definitions do not reflect the historical meaning of that phrase.

1. *In 1887, “Article of Manufacture” Was Not a Synonym for “Product”*

In *Apple v. Samsung* and *Nordock v. Systems*, the Federal Circuit interpreted the phrase “article of manufacture” in § 289 as a synonym for the infringing product—i.e., as a synonym for whatever the defendant “sold separately . . . to ordinary purchasers.”<sup>380</sup> In *Samsung v. Apple*, the Supreme Court suggested any “end product sold to the consumer” would qualify as an article of manufacture.<sup>381</sup> The historical evidence, however, belies both of these interpretations.

In 1887, the phrase “article of manufacture” was not a synonym for “product.”<sup>382</sup> A “product” is anything “sold by an enterprise to its customers.”<sup>383</sup> Numerous Patent Office decisions illustrate the fact that not all products were considered an “article of manufacture” in 1887.<sup>384</sup> For example, in *Brower*, the inkstand and stopper were deemed to be separate

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379. See *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1001–02 (Fed. Cir. 2015); *Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344 (Fed. Cir. 2015); *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 434 (2016).

380. See *Apple*, 786 F.3d at 1002; *Nordock*, 803 F.3d at 1354–55; see also *supra* Section III.B.1.

381. *Samsung*, 137 S. Ct. at 434 (“The term ‘article of manufacture,’ as used in § 289, encompasses both a product sold to a consumer and a component of that product.”).

382. Even if we ignore history and just look at the contemporary plain meaning of the phrase “article of manufacture,” it is clear that this phrase is not a synonym for “product.” The universe of things that can be “products” clearly includes items, like produce, that we would not normally consider to be “manufactured” in any reasonable sense of that word. Burstein, *The Patented Design*, *supra* note 1 at 208. Multiple “articles”—again, as that word is commonly understood today—are often sold as a single “product.” *Id.*

383. ULRICH & EPPINGER, *supra* note 4, at 2.

384. See, e.g., *Ex parte Kapp*, 1898 Dec. Comm’r Pat. 108, 108 (holding a pair of tongs was not a single “article of manufacture”); see also *Ex parte Sherman*, 1899 Dec. Comm’r Pat. 240, 241 (indicating there was a genuine issue of fact as to whether “inner and outer tubes, forming the fire-walls between the inner and outer flame of a hydrocarbon-burner” were separate “articles of manufacture”).



articles of manufacture,<sup>385</sup> even though each one would have been useless without the other<sup>386</sup> and, presumably, would have been sold together as a single product.<sup>387</sup> Similarly, in *Patitz*, the mirror–frame and sconce were separate “articles of manufacture” even though they were designed to be used together and could be attached together to form a single fixture.<sup>388</sup> And in *Haggard*, the “cradle-supporting frame” and a “cradle body” were ruled to be “two distinct articles of manufacture,” even though they were designed together and were clearly meant to be sold and used together as a single product.<sup>389</sup>

It is true that, in 1887, an article of manufacture had to be a “product” in the sense it had to be complete enough to be sold to someone.<sup>390</sup> But that “someone” did not have to be the ultimate or end consumer. It could be another manufacturer or artisan.<sup>391</sup>

Additionally, there is no evidence that, in or around 1887, the determination of whether something was an “article of manufacture” was a context–specific inquiry. An item either was an “article of manufacture” or it was not. In particular, there is no evidence the determination of whether something was an “article of manufacture” depended on the actual commercial practices of any of the parties to a particular patent dispute. While an item had to be capable of being sold separately in order to be an article of manufacture, it did not have to actually be sold separately by either

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385. See *Ex parte Brower*, 1873 Dec. Comm’r Pat. 151, 151. Granted, Brower did not dispute the examiner’s finding that the inkstand and stopper were separate articles of manufacture. See *id.* But one would have expected Brower to raise that issue before the Commissioner if “article of manufacture” had been understood to be a synonym for “product.”

386. Specifically, the products would have been useless for their intended purposes. In theory, of course, someone could buy the stopper for use as a paperweight or the inkstand for use as a bud–vase.

387. The products would likely be sold in the normal course of first purchase. Of course, either piece might be separately sold as a replacement part.

388. See *Ex parte Patitz*, 1883 Dec. Comm’r Pat. 101, 102.

389. See *Ex parte Haggard*, 1897 Dec. Comm’r Pat. 47, 48.

390. See *supra* notes 179–181 and accompanying text.

391. See *SIMONDS*, *supra* note 172, at 19. Historically speaking, the Supreme Court was correct to say that “reading ‘article of manufacture’ in § 289 to cover only an end product sold to a consumer gives too narrow a meaning to the phrase.” *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 436 (2016). At least one later case suggested that being sold separately might not even be required as long as the item was manufactured separately. *Pullman Couch Co., Inc. v. Union*, 39 U.S.P.Q. 100 (D. Md. 1938) (indicating a furniture post that was “produced separate and distinct from the complete article of furniture” could be a separate “article of manufacture” even though it was “not sold, and can not profitably be sold, as a separate article” in commerce).

the patentee or the accused infringer. For example, in *Simpson v. Davis*, the court suggested that a newel cap could be an “article of manufacture” if it were “manufactured by itself,” even if the cap was “never used except in connection with other parts . . . to make up” a complete newel post.<sup>392</sup> Notably, the court’s analysis did not depend on whether or not the defendant (or the patent owner) actually manufactured or sold caps separately. Instead, the court focused on whether caps were made—and thus, presumably, could be sold—separately.<sup>393</sup>

Thus, in 1887, an article of manufacture had to be a vendible item.<sup>394</sup> But not all vendible items were articles of manufacture. For example, machines were unquestionably vendible items. Nonetheless, machines were not considered articles of manufacture.<sup>395</sup> Additionally, packaging could, in some sense, be considered a vendible item. However, at least one case indicated an “article of manufacture” must be something actually used by the purchaser beyond the point of sale, not mere packaging.<sup>396</sup>

So, in 1887, an “article of manufacture” was not a synonym for “product” and not every “end product sold to the consumer” qualified as an “article of manufacture.”<sup>397</sup> Nor was the “article of manufacture” determination based on what any particular party actually “sold separately . . . to ordinary purchasers.”<sup>398</sup> Therefore, in 1887 “article of manufacture” was not a synonym for “product”—let alone for any “end product sold to the consumer” or for “the infringing product.”

## 2. *In 1887, An “Article of Manufacture” Did Not Mean Any “Thing Made by Hand or Machine”*

In *Samsung v. Apple*, the Supreme Court stated that the phrase “article of manufacture” in 35 U.S.C. § 289 “is simply a thing made by hand or

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392. See *Simpson v. Davis*, 12 F. 144, 145–46 (C.C.E.D.N.Y. 1882).

393. See *id.*; see also *Ex parte Campbell*, 1872 Dec. Comm’r Pat. 228, 228 (deciding that the applicant’s invention was not an “article of manufacture” because it was “not a device or article that he can offer to the public as complete for their use”); *Wilson v. Rousseau*, 30 F. Cas. 162, 211–12 (C.C.N.D.N.Y. 1845) (suggesting that something that “may be” used separately constitutes a “separate and distinct” manufacture).

394. See *supra* note 176 and accompanying text.

395. See *supra* Section V.A.

396. See *Pratt v. Rosenfeld*, 3 F. 335, 337 (C.C.S.D.N.Y. 1880).

397. See *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 434 (2016). To the extent that the Court was merely saying an “end product” *could* be an article of manufacture, however, that would be consistent with the historical evidence.

398. See *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1002 (Fed. Cir. 2015); *Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344, 1354–55 (Fed. Cir. 2015).

machine.”<sup>399</sup> The historical evidence shows that not all “thing[s] made by hand or machine” were considered “articles of manufacture” in 1887.

As discussed above, machines were not considered articles of manufacture.<sup>400</sup> But machines are “thing[s] made by hand or machine,” and would, therefore, fall under the Supreme Court’s definition.<sup>401</sup> Product packaging is certainly “made by hand or machine” but at least one case indicates that packaging was not considered an “article of manufacture.”<sup>402</sup> Even in *Lewis*, where the Commissioner defined “manufacture” as “articles made by hand, machinery, or art, from raw or prepared materials,” he also ruled that this seemingly very broad definition did not include houses.<sup>403</sup> Therefore, in 1887, the phrase “article of manufacture” did not include any and all “thing[s] made by hand or machine.”<sup>404</sup>

### 3. In 1887, Not All “Components” Were Articles of Manufacture

In *Samsung v. Apple*, the Supreme Court held that “[t]he term ‘article of manufacture,’ as used in § 289, encompasses both a product sold to a consumer and a component of that product.”<sup>405</sup> This statement might be read as suggesting that any “component” can be an “article of manufacture” for the purposes of § 289.<sup>406</sup>

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399. See *Samsung*, 137 S. Ct. at 435 (“An article of manufacture, then, is simply a thing made by hand or machine.”).

400. See *supra* Section V.A.

401. See *Samsung*, 137 S. Ct. at 435; see also Mueller, *supra* note 73, at 7 n.21 (“[W]hile Professor Robinson’s definition of ‘manufacture’ . . . includes the parts of a machine, it excludes the ‘machine itself,’ contrary to the Supreme Court’s definition of ‘article of manufacture’ in *Samsung Elecs.*”).

402. *Pratt v. Rosenfeld*, 3 F. 335, 337 (C.C.S.D.N.Y. 1880).

403. *Ex parte Lewis*, 1891 Dec. Comm’r Pat. 61, 63.

404. See *Samsung*, 137 S. Ct. at 435 (interpreting the phrase “article of manufacture” in 35 U.S.C. § 289 to mean “simply a thing made by hand or machine”). Nor did it mean—as Apple, Samsung, and the Government argued in the Supreme Court—“any item that is made by human labor.” See Gov’t Brief, *supra* note 87, at 17; Apple Merits Br., *supra* note 98, at 36 (citing Gov’t Brief, *supra* note 87, at 17); Reply Brief for Petitioners at 2–3, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 4524542 (quoting Gov’t Brief, *supra* note 87, at 17).

405. *Samsung*, 137 S. Ct. at 434 (2016).

406. See Michael Risch, *Samsung v. Apple: Drilling Down on Profit Calculations*, WRITTEN DESCRIPTION (Dec. 6, 2016), <http://writtendescription.blogspot.com/2016/12/samsung-v-apple-drilling-down-on-profit.html> (apparently interpreting the decision this way).

In 1887, a component of a larger product could be an “article of manufacture.”<sup>407</sup> But not all “components” were articles of manufacture—at least not in the sense that we understand the word “component” today. Today, a “component” can be “any part of a larger whole,”<sup>408</sup> including intangible characteristics and incomplete fragments of a product. Today, we might describe the pile yarn as a “component” of a carpet.<sup>409</sup> Or we might consider the “front” of a carpet and its “backing” as separate components.<sup>410</sup> We might even describe color or the type of fibers used as “components” of a particular carpet.<sup>411</sup> Of these things, the only ones that might have qualified as being “articles of manufacture” in 1887 were the yarn and the backing fabric.<sup>412</sup> If one were to just cut off the “front” of a rug—i.e., to

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407. See, e.g., *Ex parte* Brower, 1873 Dec. Comm’r Pat. 151, 152 (holding that the applicant could not claim designs for an inkstand and stopper in a single application because they did not constitute “a single unitary design for an article of manufacture”); *Ex parte* Wiessner, 1898 Dec. Comm’r Pat. 236, 237 (affirming the examiner’s requirement of a division because, *inter alia*, the headboard and footboard were “separate and distinct articles of manufacture,” even though they were “parts or elements of the entire bedstead”); see also *Simpson v. Davis*, 12 F. 144, 145–46 (C.C.E.D.N.Y. 1882) (suggesting, though not deciding, a cap for a newel post could be a separate “manufacture” because the cap was “often manufactured by itself,” even though it was “never used except in connection with other parts . . . to make up what is known as a newel post”); *Ex parte* Lewis, 1891 Dec. Comm’r Pat. 61, 63 (stating that “articles, such as mantels,” which “are manufactured and sold with reference to ultimately becoming part of a house” were articles of manufacture, even though the house was not).

408. CONCISE OXFORD ENGLISH DICTIONARY 293 (11th ed., rev’d 2008) (Catherine Soanes & Angus Stevenson, eds.) (defining “component,” in relevant part, as: “a part or element of a larger whole, especially a part of a machine or vehicle”); see also THE AMERICAN HERITAGE COLLEGE WRITER’S DICTIONARY 203 (2013) (defining the noun “component” as “[o]ne of the parts that makes up a whole”); A.S. HORNBY, OXFORD ADVANCED LEARNER’S DICTIONARY OF CURRENT ENGLISH 306 (8th ed. 2010) (Joanna Turnbull, ed.) (defining the noun “component” as “one of several parts of which [something] is made”).

409. CORKY BINGGELI, INTERIOR GRAPHIC STANDARDS: STUDENT EDITION 210 (2011) (“Pile yarn is the most expensive component in carpet manufacturing.” (emphasis omitted)).

410. See Risch, *supra* note 406 (stating, in *Dobson*, the carpet “had a design on the front, but also had an unpatented backing, etc.” and arguing that “[a]lthough there were at least two components, no one at the time Congress passed the law thought for a second that the profits for each component should be considered separately”).

411. See DONALD A. BURNS & EMIL W. CIURCZAK, HANDBOOK OF NEAR-INFRARED ANALYSIS 509 (3d ed. 2007) (“The carpet components evaluated were fiber type, color, carpet and yarn construction, and dyeing/coloration method”).

412. See generally CURTIS, *supra* note 155, at § 9 (describing “fabrics or substances made by the art or industry of man” as examples of manufactures). But see *Ex parte* Sellers, 1872 Dec. Comm’r Pat. 197, 198 (stating that an “article of manufacture” must be

sever the loops of fabric—that would not result in a complete, tangible and vendible item. And a color or fiber type certainly would not qualify. Therefore, not everything that we might think of today as a “component” of a product would have qualified as an “article of manufacture” in 1887.

C. THE HISTORICAL EVIDENCE SHEDS NEW LIGHT ON THE ORIGINAL CONGRESSIONAL INTENT

Over the course of the *Apple* and *Nordock* cases, many arguments have been made regarding the original congressional intent. This Section explains what the 45th Congress apparently did and did not intend when it passed the 1887 Act.

1. *What the 45th Congress Did Intend*

The legislative history shows Congress did intend to change the result in *Dobson*.<sup>413</sup> Specifically, Congress intended to eliminate the possibility that a design patent owner would receive only nominal damages in cases of commercial infringement.<sup>414</sup> To this end, Congress provided for an automatic penalty of \$250 for any violation of the statute, regardless of whether the patent owner could prove it was entitled to any profits or damages.<sup>415</sup> Congress also provided that, where the patent owner could prove the infringer made over \$250 in “total profit . . . from the manufacture or sale . . . of the article or articles to which the design, or colorable imitation thereof, has been applied,” the patent owner could recover those additional profits.<sup>416</sup>

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“complete in itself *for some special use*, and not to be applied to general purposes like pipes or tubes” (emphasis added)).

413. It is not clear Congress intended to completely overrule *Dobson* in every respect. See, e.g., S. REP. NO. 49-206, at 2 (1886) (appearing to contemplate at least some of “the technical rules of the law as laid down by the Supreme Court” in *Dobson* would continue in effect, thus necessitating the provision of the \$250 penalty).

414. Specifically, Congress was concerned about cases where the defendant “appl[ied] the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale” without authorization or where the defendant sold or “expose[d] for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied.” See Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387.

415. See *supra* Section IV.B.2.

416. Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387; see also FENTON, *supra* note 186, at 188 (stating the 1887 Act would “have no operation” in a case where the plaintiff could “offer such proof of actual damages or profits as would warrant a verdict of a jury or a finding of a master, for a sum exceeding two hundred and fifty dollars.”).

By using the phrase “total profit,” the 45th Congress apparently intended to avoid the type of apportionment required by *Dobson*—i.e., apportionment between the profits attributable to the ornamentation and/or configuration of the article and the profits attributable to the “intrinsic merits of quality and structure” of the article itself.<sup>417</sup> But the legislative history provides no indication Congress intended this “total profits” option to be the default remedy. Nor is there any indication Congress intended for a “total profits” award to be available—or easy to prove—in any and all cases of infringement.<sup>418</sup> There is also no indication Congress meant to change or affect the parties’ burdens of proof with respect to patent damages.<sup>419</sup> To the contrary, both the House and Senate reports expressly contemplate that the patentee would continue to bear the burden of proving its entitlement to profits or damages.<sup>420</sup>

Additionally, the phrase “total profit” was qualified; the plaintiff was not entitled to recover the “total profit” of the defendant’s entire commercial enterprise. Instead, the plaintiff was entitled to recover the “total profit” the defendant made “from the manufacture or sale . . . of the article or articles [of manufacture] to which the design, or colorable imitation thereof, has been applied.”<sup>421</sup> As used in this passage, “the design” refers to the patented design—i.e., “the design secured by such letters patent.”<sup>422</sup> Therefore, to determine the relevant article (or articles) for the purposes of the 1887 Act, one has to consider the nature of what constituted a patentable “design” in 1887.

Section 4929 of the Revised Statutes was interpreted as covering two different classes of design—“configuration” and “surface ornamentation.”<sup>423</sup> A patentable configuration design had to “relate to the outward form or contour” of an article of manufacture, while “surface

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417. See *Dobson v. Hartford Carpet Co.*, 114 U.S. 439, 445–46 (1885).

418. Indeed, to the extent that the legislative history speaks to these issues at all, it indicates the opposite.

419. By 1887, it was well-established “[t]he burden of proving damages for the infringement of a patent is upon the plaintiff, and he must establish his damages by competent evidence . . . .” *Hunt Bros. Fruit Packing Co. v. Cassidy*, 53 F. 257, 261–62 (9th Cir. 1892) (citing *Garretson v. Clark*, 111 U.S. 120, 121 (1884); *Blake v. Robertson*, 94 U.S. 728, 733 (1876)).

420. See H.R. REP. NO. 49-1966, at 3 (1886); S. REP. NO. 49-206, at 2 (1886).

421. Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387. As noted above, the Federal Circuit has read this qualifier into § 289. See *supra* note 350.

422. See Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387.

423. See *Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37, 40.

ornamentation relate[d] to illustrations and delineations that are printed or impressed upon or woven into it.”<sup>424</sup>

Although there is no case law directly on point, it appears clear the relevant article of manufacture for a configuration design (or a design consisting of both a configuration and surface ornamentation) for the purposes of the 1887 Act would be the article of manufacture for which the design was created.<sup>425</sup> This would be true even if that article were later incorporated into a larger article. In the case of a design patent for the configuration of a casket–screw, the relevant article of manufacture would be the casket–screw, not the casket.<sup>426</sup> Of course, if the defendant only sold caskets, not casket–screws, it would be difficult to prove what profits the defendants received just from the screws. But there is no indication that the 1887 Act was meant to make it easy for plaintiffs to prove “total profits” in every case.<sup>427</sup> Indeed, this appears to be one of the very situations that the \$250 minimum penalty was designed for.<sup>428</sup>

There is some indication that some design patents for surface design might have had more than one relevant “article of manufacture” for the purposes of the 1887 Act. For example, in *Amberg*, although the Patent Office would not let the applicant claim its design by reference to any articles other than those to which the applicant had already applied the design, the decision suggested that applying the design to other articles might, in appropriate circumstances, constitute an act of infringement.<sup>429</sup>

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424. *See id.*

425. *See id.* (referring to “the outward form or contour,” singular (emphasis added)); *see also* Rev. Stat. § 4929 (providing for design patents for “any new, useful, and original shape or configuration of any article of manufacture,” again suggesting any given article only had one shape or configuration (emphasis added)).

426. *See generally* Apple Merits Br., *supra* note 98, at 37 (“[M]any design patents covered designs of coffin parts - several issued in 1884 alone - such that it was conceivable that a single casket could incorporate four different patented designs. *E.g.*, D15,033 (casket handle); D15,014 (casket knob); D15,043 (coffin screw); D14,641 (casket plate).”). As discussed in more detail below, in 1887, a design for the configuration of a part was not considered a design for a larger composite whole. *See infra* Section V.C.2.b).

427. *See id.*

428. *See* S. REP. NO. 49-206, at 2 (1886) (noting the \$250 minimum penalty was meant to apply where the plaintiff could not prove “the exact profit in dollars and cents”); *see also* *See Young v. Grand Rapids Refrigerator Co.*, 268 F. 966, 974 (6th Cir. 1920) (“Any segregation of the profits due to the use of this particular design of latch casing is obviously impossible. The statute was passed, we think, to provide for cases of this character, and to prevent the otherwise inevitable result of a recovery of merely nominal damages.”).

429. *See Ex parte Amberg*, 1898 Dec. Comm’r Pat. 117; *see also In re Schnell*, 46 F.2d 203, 209 (C.C.P.A. 1931).

Therefore, in the case of a design patent claiming a design for surface ornamentation, it might be possible for the defendant “to apply the design secured by such letters patent”<sup>430</sup> to articles other than the ones “invented and produced” by the patentee.<sup>431</sup> In any case, the result in cases like *Dobson* would have been very different following the enactment of the 1887 Act. The carpet-makers who sued the Dobsons would have been able to recover at least \$250 per design patent—and more if they could prove the Dobsons’ total profit on the infringing carpets.

Thus, different rules applied to surface ornamentation designs, on the one hand, and configuration and combination design, on the other. This is neither particularly surprising nor problematic because these types of designs are, by their very nature, different—a fact that was recognized in nineteenth century design patent law.<sup>432</sup>

This distinction also comports with the House Report’s stated justification for allowing an award of “the entire profit on the article.”<sup>433</sup> The House Report stated this type of award was “just” because “it is the design that sells the article, and so that makes it possible to realize any profit at all.”<sup>434</sup> It is plausible—or at least, not absurd—to think that, when a consumer chooses between two otherwise similar articles and selects one with surface ornamentation, that ornamentation is material to the purchasing decision.<sup>435</sup> If a consumer decides to buy a carpet with one particular scheme of surface decoration over another carpet that has no decoration or a different scheme of decoration, it makes sense to surmise that the design

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430. See Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387.

431. *Ex parte Amberg*, 1898 Dec. Comm’r Pat. 117, 118.

432. See generally *supra* Section II.A.2.

433. H.R. REP. NO. 49-1966, at 3 (1886).

434. See *id.*

435. And back then, “ornamentation” actually meant “ornamentation”—not “indicia” or “treatment” or “anything not strictly required for utility.” Compare *Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37, 40 (“Shape must relate to the outward form or contour, while the surface ornamentation relates to illustrations and delineations that are printed or impressed upon or woven into it.”), and Rev. Stat. § 4929 (providing for design patents for “any new and original impression, ornament, [pattern], print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture”), with, e.g., MPEP, *supra* note 21, at § 1503.02(IV) (“The ornamental appearance of a design for an article includes its shape and configuration as well as any indicia, contrasting color or materials, graphic representations, or other ornamentation applied to the article (‘surface treatment’)); see also Burstein, *supra* note 28, at 1457–58 (explaining how the Federal Circuit has interpreted the term “ornamental” in 35 U.S.C. § 171).



is “sell[ing] the article.”<sup>436</sup> The same is true for a consumer who selects chairs with a particular shape over other chairs. But it strains credulity to suggest that every time an article of manufacture is incorporated into a larger article of manufacture, the shape of the part necessarily “sells” the larger article. While the shape of a casket–screw might “sell the article” to the casket–maker, it is unlikely that the shape would drive sales of the finished casket. In that scenario, the owner of a design patent for a casket–screw could, upon proper proofs, recover the “total profits” of the person who sold the screws to the casket–maker. But they would only be able to recover \$250 from the casket–maker, unless they could prove what portion of the casket profits were attributable to the screws.

This analysis is consistent with the results, if not the stated reasoning, in cases decided under the 1887 Act. In *Bush & Lane Piano Co. v. Becker Bros.*, the court awarded \$250 when the plaintiff could not prove “the profits made by the defendant . . . upon the sale of the [piano] case which alone is the sole subject of the patent.”<sup>437</sup> Similarly, in *Young v. Grand Rapids Refrigerator Co.*, the court awarded \$250 because it was too difficult to “determine what profits have been made by a sale of the article,” which consisted of a part of a refrigerator latch.<sup>438</sup> And in *Untermeyer v. Freund*, where the design patent–in–suit claimed a design for watch cases, the court awarded the profits for the infringing cases—not for completed watches.<sup>439</sup>

## 2. Congress Did Not Intend the Results in *Apple* and *Nordock*

In *Apple* and *Nordock*, the Federal Circuit ruled that the patentees were entitled to recover the “total profit” from the infringing products, even though the asserted patents only claimed designs for portions of those products.<sup>440</sup> Defenders of those rulings argue that the *Apple/Nordock* rule

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436. H.R. REP. NO. 49-1966, at 3 (1886). This is true regardless of whether the “ornamented” part covers less than the entire surface of a particular article. Some designs for surface ornamentation are meant to cover an entire surface; others are not. And of course, a piece of carpet would have clearly qualified as an “article of manufacture.” See *supra* Section V.A.

437. See 222 F. 902, 903 (2d Cir. 1915).

438. See 268 F. 966, 973–74 (6th Cir. 1920).

439. See 50 F. 77, 77–78 (C.C.S.D.N.Y. 1892). Even though the Second Circuit decision makes reference to infringing “watches,” see, e.g., *Untermeyer v. Freund*, 58 F. 205, 209 (2d Cir. 1893), it is clear from the decision below that the master’s recommendation is actually based on sales of infringing watch cases. See *Untermeyer v. Freund*, 50 F. 77, 77–78 (C.C.S.D.N.Y. 1892).

440. See *supra* Section III.B.1. Although a full discussion of these issues is beyond the scope of this Article, it’s worth noting the rules for design patent claiming—and the effect of design patent claims upon the ultimate patent scope—were very different in 1887 than

reflected the original congressional intent.<sup>441</sup> However, the historical evidence indicates that Congress did not intend for Apple to recover the total profit from the infringing Samsung smartphones or for Nordock to recover the total profit from the infringing Systems dock levelers.

a) Smartphones and Dock Levelers Would Not Have Been Considered “Articles of Manufacture” in 1887

In *Apple*, the infringing products were smartphones.<sup>442</sup> A smartphone is a computer.<sup>443</sup> “Computers are machines.”<sup>444</sup> And machines were not considered articles of manufacture.<sup>445</sup> Therefore, the infringing smartphones would not have been considered “articles of manufacture” in 1887.<sup>446</sup> Any parts that were complete in and of themselves and

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they are today. *See, e.g., Ex parte Pope*, 1883 Dec. Comm’r Pat. 74; *Ex parte Gérard*, 1888 Dec. Comm’r Pat. 37.

441. Brief of Amicus Curiae American Intellectual Property Law Association in Support of Respondent at 2, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 4268252 (“The legislative history of Section 289 supports the plain meaning of the statutory language and demonstrates the policy decision Congress made in providing this remedy to design patent owners.”); Brief of Amicus Curiae Crocs, Inc. in Support of Affirmance at 29, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 4239196 (“Congress’s decision to protect design through the total-profits remedy is working as intended, and there is no sound basis to change it.”).

442. *See supra* Section III.B.1.a).

443. Matt Buchanan, *Giz Explains: How Multitasking Works on a Phone*, GIZMODO (Apr. 29, 2010), <http://gizmodo.com/5527407/giz-explains-how-multitasking-works-on-a-phone> (“A smartphone is a computer that fits in your pocket . . . .”); *see also generally* MICHAEL JUNTAO YUAN, *NOKIA SMARTPHONE HACKS: TIPS & TOOLS FOR YOUR SMALLEST COMPUTER* xvi (2005) (“A Nokia smartphone is not only a voice communications device, but also a fully featured computer capable of running third-party software.”).

444. *CLS Bank Int’l v. Alice Corp.*, 717 F.3d 1269, 1305 (Fed. Cir. 2013), *aff’d*, 134 S. Ct. 2347 (2014) (internal quotation marks omitted); *see also* *Wireless Media Innovations, LLC v. Maher Terminals, LLC*, 100 F. Supp. 3d 405, 414 (D.N.J. 2015), *aff’d*, 636 F. App’x 1014 (Fed. Cir. 2016) (quoting *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2358–59 (2014)) (“There is no dispute that a computer is a tangible system (in § 101 terms, a ‘machine’) . . . .”). The fact that a smartphone lacks visibly moving parts while in operation does not change this analysis. Although some nineteenth-century Patent Office decisions seemed to conflate the “machine” issue with the moving parts issue, these were in fact separate inquiries. *See Ex parte Steck*, 1902 Dec. Comm’r Pat. 9, 13. And moving parts was never a universal requirement for “machines,” though some commentators did seem to use movement as a proxy for machinery. *See supra* notes 169–172 and accompanying text.

445. *See* SYMONS, *supra* note 47, at 28 (citing *Ex parte Adams*, 1898 Dec. Comm’r Pat. 115; *Ex parte Steck*, 1902 Dec. Comm’r Pat. 9).

446. As noted above, there is no indication the 45th Congress meant the phrase “article of manufacture” to mean something different in the 1887 Act than it did in Rev. Stat. §

manufactured separately could have qualified as articles of manufacture. Design patents claiming designs for such parts would have been allowable but a design for the product as a whole would not have been. Thus, in 1887, Apple could not have gotten a patent for the design of an entire smartphone because a smartphone would not have been considered an “article of manufacture.” As discussed above, there is no indication that Congress meant the phrase “article of manufacture” to mean something different in the Act of 1887 than it did in the existing design patent subject matter provision.<sup>447</sup> It strains credulity to imagine that Congress intended courts to treat the entire smartphone as the relevant “article of manufacture” for the purposes of the “total profit” remedy when it would not have been considered an “article of manufacture” at all.<sup>448</sup>

Similarly, in *Nordock*, the infringing products were dock levelers.<sup>449</sup> By any definition of the term, a dock leveler would have qualified as a “machine” in 1887.<sup>450</sup> So a design for an entire dock leveler would not have been patentable, even if the “lip and hinge plate” would have been. Because machines were excluded from the category of “articles of manufacture,” a dock leveler simply could not have been the article of manufacture “to which the design . . . has been applied.”<sup>451</sup>

b) In 1887, a Design for the Configuration of a Part Was Not Considered a Design for the Larger Composite Whole

The historical evidence indicates that in 1887, a design for a configuration of an article of manufacture that formed part of a larger article was considered distinct from a design for the configuration of that larger article. For example, in *Wiessner*, the configuration of a bedstead headboard

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4929 or to make any other changes to the existing design patent law. *See supra* Section IV.B.2.

447. *See supra* Section IV.B.2.

448. *Cf.* Brief for The Internet Association et al. as Amici Curiae Supporting Petitioners at 18, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 3194217 [hereinafter *Internet Ass’n Br.*] (“If Congress would not have thought that a complex device was an ‘article of manufacture’ for purposes of patentability, it surely did not intend for such a device to be the relevant ‘article of manufacture’ in the ‘total profit’ provision.”).

449. *See supra* Section III.B.1.b).

450. *See supra* Section IV.A.1.a).

451. Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387 (“Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale . . . of the article or articles to which the design . . . has been applied) (emphasis added).

was considered distinct from the configuration of the entire bedstead.<sup>452</sup> They were different designs for different articles of manufacture—even though one was ultimately used to construct the other.<sup>453</sup> The article of manufacture to which a design for the configuration of a headboard was “applied” would be the headboard—not the entire bedstead.<sup>454</sup>

In *Apple*, none of the infringed patents claimed a design for the configuration of a smartphone. But two of them claimed designs for the configurations of different parts of a smartphone. The D’677 patent claimed a design for the configuration and color of the iPhone screen.<sup>455</sup> The screen is manufactured separately and could be sold separately, either to another manufacturer or as a replacement part; therefore, the screen would be the relevant “article of manufacture” in 1887. The D’087 patent claimed a design for the configuration of the front screen and the bezel.<sup>456</sup> The screen and bezel could have been considered separate articles of manufacture in 1887.<sup>457</sup> If they were considered separate articles of manufacture, this claim would not have been allowed in 1887.<sup>458</sup> But if it were, the relevant article of manufacture would have been the bezel and the screen conglomeration, not the completed smartphone.

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452. See *Ex parte Wiessner*, 1898 Dec. Comm’r Pat. 236.

453. See *id.* at 238 (“That the designs covered by claims 1 and 2, viz., the headboard and the footboard, are separate and distinct articles of manufacture, is well recognized in the art.” (quoting the examiner)); *id.* at 242 (“The fact that these articles may be united and form still another article of manufacture furnishes no reason for allowing them in one case.”); see also generally *Ex parte Patitz*, 1883 Dec. Comm’r Pat. 101, 102; *Ex parte Brand*, 1898 Dec. Comm’r Pat. 62, 63.

454. See Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387 (providing for the disgorgement of the defendant’s “total profit made by him from the manufacture or sale . . . of the article or articles to which the design . . . has been applied”).

455. See *supra* note 92 and accompanying text.

456. See *supra* note 94 and accompanying text.

457. See, e.g., *Ex parte Brand*, 1898 Dec. Comm’r Pat. 62, 63 (affirming the rejection of a design patent application “for the parts of a joint for bedstead-rails” even though they were “adapted to interlock”). Also, it is questionable whether a freestanding bezel-and-screen combination would have been considered sufficiently “complete” on its own. See *Ex parte Blanchard*, 1870 Dec. Comm’r Pat. 59, 59 (“[T]he word ‘manufacture,’ as used in the patent act . . . fairly covers only such manufactured articles or products as are complete in themselves, or, if parts of a whole, are so far complete as to be the subject of separate manufacture and sale.”). It might have also been considered “a mere fraction of a machine.” See *id.*

458. See, e.g., *Ex parte Patitz*, 1883 Dec. Comm’r Pat. 101; *Ex parte Wiessner*, 1898 Dec. Comm’r Pat. 236.

Similarly, in *Nordock*, the D’754 claimed a design for the configuration of a “lip and hinge plate” for a dock leveler.<sup>459</sup> Based on the reported decisions in *Nordock*, it is not clear whether the lip and hinge plate was manufactured separately or whether it had a unitary structure. If it was not, the plate would not have been considered an article of manufacture and the configuration claimed in the D’754 patent would not have been patentable in 1887. Assuming the plate would have qualified as an article of manufacture, it is clear that the plate—not the dock leveler—would have been the relevant article.

Therefore, even if smartphones and dock levelers would have been considered “articles of manufacture” in 1887, they would not have been the relevant articles of manufacture for the design patents at issue in *Apple* and *Nordock*.<sup>460</sup>

c) In 1887, GUI Designs Were Not Even on the Horizon

The third patent infringed in *Apple*, the D’305 patent, claimed a design for a GUI.<sup>461</sup> Of course, GUI designs did not exist—and could not have been anticipated—by the 45th Congress.<sup>462</sup> Thus, the 45th Congress did not actually intend for the owner of a GUI design patent to recover the “total profit” from an entire smartphone.

It could be argued that GUIs are surface ornamentation<sup>463</sup> and that, therefore, the 45th Congress could have fairly anticipated and did intend this kind of result. However, it is difficult to fairly analogize GUI designs to anything that was considered design patentable subject matter in 1887. In 1887, the category referred to as “surface ornamentation” was more specifically described in the statute as “any new and original impression, ornament, [pattern], print, or picture to be printed, painted, cast, or

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459. See *supra* notes 116–118 and accompanying text.

460. In 1930, the CCPA decided that there was no reason a design for a machine could not be the subject of a design patent. *In re Koehring*, 37 F.2d 421, 424 (C.C.P.A. 1930). As discussed above the reasoning in *Koehring* was quite thin and did not address the *expressio unius* issue. See *supra* note 374. Nonetheless, some may argue that Congress tacitly approved and adopted *Koehring* when it enacted the Patent Act of 1952.

461. See *supra* note 96 and accompanying text.

462. And, as noted above, the legitimacy of this type of design patent is both highly debatable and untested. See *supra* notes 78–79 and accompanying text.

463. The USPTO considers GUIs to be “surface ornamentation.” MPEP, *supra* note 21, at § 1504.01(a)(I)(A) (“Computer-generated icons, such as full screen displays and individual icons, are 2-dimensional images which alone are surface ornamentation”) (citing *Ex parte Strijland*, 26 U.S.P.Q.2d (BNA) 1259 (Bd. Pat. App. & Int. 1992)). This is highly questionable; however, a full discussion of this issue is beyond the scope of this Article.

otherwise placed on or worked into any article of manufacture. . . .”<sup>464</sup> Perhaps some GUI designs—or portions thereof, such as icon designs—could be considered “patterns” or “pictures.”<sup>465</sup> But in 1887, a protectable surface ornamentation design had to be “printed, painted, cast, or otherwise placed on or worked into [the relevant] article of manufacture.”<sup>466</sup> It is difficult to argue that a GUI design is “placed *on* or worked *into*” a smartphone in any meaningful sense of those phrases.<sup>467</sup> Indeed, if a GUI design is “placed on or worked into” anything, it is “placed on or worked into” the smartphone screen—not the smartphone as a whole.<sup>468</sup> The relevant article of manufacture, if any, would have to be the screen, not the entire smartphone. That would entitle Apple to \$250 or the profits from just the screen, if Apple chose to seek monetary relief under § 289.<sup>469</sup>

## VI. POTENTIAL OBJECTIONS

This analysis of the historical evidence may draw several objections. This Section discusses the most serious of those potential objections.

### A. THIS CANNOT BE RIGHT BECAUSE CONGRESS INTENDED TO ELIMINATE APPORTIONMENT

It may be argued that the conclusions drawn in this Article must be incorrect because Congress intended to eliminate any and all

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464. 1 REVISED STATUTES OF THE UNITED STATES 954 (2d ed. 1878) (reproducing Rev. Stat. § 4929, as then in force); *see also* WALKER, *supra* note 156, § 20 (explaining that the word “patent” in the phrase “impression, ornament, patent, print, or picture” appeared to be a typo).

465. This is highly questionable. However, a full discussion of this issue is beyond the scope of this Article.

466. 1 REVISED STATUTES OF THE UNITED STATES 954 (2d ed. 1878).

467. *See* Seymour & Torrance, *supra* note 11, at 208–14 (arguing that computer-generated imagery “is not fixed within or worked into displays”). And, of course, as discussed above, a smartphone would not have been considered an “article of manufacture” in 1887. *See supra* Section V.C.2.a).

468. *See supra* Section III.A.3 (noting that, according to the USPTO, the relevant “article of manufacture” for a GUI design patent is the screen itself, not the device in which the screen is incorporated or embedded). It’s also worth noting that the D’305 patent is entitled “Graphical User Interface *for a Display Screen or Portion Thereof*.” U.S. Patent No. D604,305 fig.2 (issued Nov. 17, 2009) (emphasis added). However, a contemporary patent’s title and the patentee’s intent should not be dispositive because, today, the USPTO lets applicants name their patents pretty much whatever they want. *See* MPEP, *supra* note 21, at § 1503.01(I).

469. Of course, there are other remedies available. *See* Burstein, *Costly Designs*, *supra* note 1, at 118–19.

“apportionment.”<sup>470</sup> It is true that the 45th Congress was concerned with “apportionment” but only in one particular sense—namely, apportionment between the profits attributable to the *design itself* and those attributable to the “intrinsic merits of quality and structure” of *the article itself*.<sup>471</sup> In other words, Congress meant to foreclose any apportionment between the profits from the configuration or surface ornamentation and the other, non-aesthetic characteristics of the article to which that configuration or surface ornamentation was applied. But Congress expressly disavowed any intention to change the design patent law in any other way.<sup>472</sup> Nothing in the 1887 Act changed the meaning of the well-established term of art “article of manufacture.” Nor did it change the well-settled understanding of what constituted a patentable “design.”

This Article’s interpretation of the text of the 1887 Act and its legislative history would not require any differentiation between the profits attributable to the configuration of a casket-screw and the underlying intrinsic merits of a screw to which that design was applied. Accordingly, this reading does not “reinstitute the apportionment rule from the *Dobson* cases.”<sup>473</sup> Instead, it merely recognizes that the screw itself was a separate “article of manufacture” and that the configuration of a casket-screw is not the same thing as the configuration of a casket.<sup>474</sup>

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470. See Mueller, *supra* note 73, at 1 (arguing that, by recognizing that a component can be an article of manufacture, the Supreme Court “reinstitute[d] apportionment”); see also Brief of Amici Curiae On Behalf of Intellectual Property Professors in Support of Respondent at 27, *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 4239412 [hereinafter Janis S. Ct. Br.] (arguing “that Congress slammed the door on apportionment by using the term ‘total’”); *id.* at 26 (“The Phrase ‘Article of Manufacture’ Does Not Authorize a Back-Door, Quasi-Appportionment Analysis.”).

471. See *supra* note 335 and accompanying text; see also *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1001 (Fed. Cir. 2015), *rev’d and remanded*, 137 S. Ct. 429 (2016) (“Apportionment required [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*. The Act of 1887, specific to design patents, removed the apportionment requirement.” (quoting *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1441 (Fed. Cir. 1998)) (alteration in original)).

472. See S. REP. NO. 49-206, at 2 (1886); H.R. REP. NO. 49-1966 at 4 (1886).

473. See Janis S. Ct. Br., *supra* note 470, at 8 (arguing, in *Samsung*, the Court was “being asked to reinstitute the apportionment rule from the *Dobson* cases”).

474. See *supra* Section V.C.2.b).

B. THE STATUTE SAYS “ANY ARTICLE,” SO CONGRESS MUST HAVE MEANT FOR THE RELEVANT “ARTICLE” TO BE THE WHOLE INFRINGER’S PRODUCT

It has been argued that, because § 289 refers to “any article of manufacture,” “the infringer’s product may be anything that bears the design.”<sup>475</sup> A similar argument could be made based on the text of the 1887 Act.<sup>476</sup> This argument appears to be based on an unstated assumption that design patents do—or should—protect designs per se.<sup>477</sup> There are no cases that support that proposition; indeed, the only reported cases are to the contrary.<sup>478</sup> It is true that, in the nineteenth and early twentieth centuries, some cases and Patent Office decisions left open the possibility that design patents for surface ornamentation could be infringed by use of the design on articles other than the ones “invented and produced” by the patentee.<sup>479</sup> It is not clear how often, if ever, courts actually found that a surface ornamentation design for one article was infringed by the use of the design on a different type of article.<sup>480</sup> But, in any case, this was not the rule for configuration designs. Configuration designs are, by their very nature, are inextricably intertwined with their respective articles.<sup>481</sup> Moreover, this argument seems to assume that “article of manufacture” is a synonym for “product.” As discussed above, that was not true in 1887.<sup>482</sup>

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475. See Janis S. Ct. Br., *supra* note 470, at 26–27.

476. See Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387 (also referring to “any article”).

477. See generally Burstein, *The Patented Design*, *supra* note 1.

478. See *id.*

479. See *supra* note 429 and accompanying text.

480. Prior commentators have said that “surface ornamentation cases—such as those involving sheet material— . . . often result[ed] in infringement findings, even when the design is applied to an altogether different article, such as a carpet, rug, wall-paper, garment, or oil cloth.” Jason J. Du Mont & Mark D. Janis, *Design Patent Remedies* at 6–50, in *AMERICAN DESIGN PATENT LAW: A LEGAL HISTORY* (forthcoming), <http://ssrn.com/abstract=2784746>. They do not, however, cite any such cases. See *id.* To date, the author has been unable to find any.

481. It may be argued this conflates the protected “design” with the underlying article itself. See generally Mueller, *supra* note 73, at 6 n.19. But that is not the case. There is nothing inconsistent about saying a design—*i.e.*, the patented invention—is distinct from the article itself while acknowledging that a configuration design is inextricably tied to the nature of the article. For example, the configuration of a shoe would simply not work as a configuration for a fork.

482. See *supra* Section V.B.1.



## C. NOT ALL ISSUED PATENTS FIT THIS INTERPRETATION

Some design patents issued prior to 1887 may not seem to fit this interpretation of “article of manufacture.” However, the mere existence of such patents does not negate the conclusions drawn here. The Patent Office was notoriously lax in granting design patents in the nineteenth century.<sup>483</sup> It appears that the Patent Office did not start taking design patents seriously until sometime around 1870.<sup>484</sup> And of course, in any age, human institutions are prone to human error. A nineteenth-century design patent examiner could make a mistake as easily as a twenty-first-century design patent examiner.<sup>485</sup> Thus, nineteenth-century design patents are not particularly reliable sources for discerning principles of nineteenth-century patent law or Patent Office policy. The latter is especially true in instances where a granted patent conflicts with an express statement of Patent Office policy. It would not be surprising to find design patents, especially those issued before 1870, that claimed—or appeared to claim—designs for items that do not appear to meet the definition of “article of manufacture” discussed in this Article. But that does not mean the definition is incorrect.

Additionally, some nineteenth-century design patents may claim designs for items that do not appear, at least to a modern reader, to be separately-vendible items. For example, there were a number of design patents granted in the nineteenth century for chair-backs.<sup>486</sup> That might not immediately seem like a separately-vendible item.<sup>487</sup> However, in the nineteenth century, chair backs were often manufactured separately.<sup>488</sup>

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483. See SYMONS, *supra* note 47, at 1–2.

484. SIMONDS, *supra* note 172, at 182; see also *Ex parte Bartholemew*, 1869 Dec. Comm’r Pat. 103, 103 (discussing a recent uptick in interest in design patents).

485. And of course, the mere fact that the Patent Office made a mistake once does not mean it should be compelled to repeat it. See generally *Ex parte Adams*, 1898 Dec. Comm’r Pat. 115, 117 (“It is immaterial whether design patents of this kind have or have not heretofore been granted, since a practice not well founded in law should not be followed.”).

486. See e.g., *Pattern for Chair Backs*, U.S. Patent No. D22,328 (issued Apr. 4, 1893).

487. See, e.g., *Du Mont & Janis*, *supra* note 480, at 6–50 (stating that, in the nineteenth century, “patents were . . . regularly granted for the components of (three dimensional) shapes or configurations that were not likely sold as completed products, protecting designs for things like the back of a chair . . .”).

488. See, e.g., PARVIZ NAVI & DICK SANDBERG, *THERMO-HYDRO-MECHANICAL PROCESSING OF WOOD* 45 (2012) (discussing U.S. Patent No. 19405 (issued Feb. 23, 1858) for a method of mass-producing chair-backs); see also ALBERT JACKSON & DAVID DAY, *CARE & REPAIR OF FURNITURE* 46 (1995) (stating the three main methods of chair construction are “frame construction, stick construction, and bentwood”); *id.* at 46–47 (showing one component of a frame chair is the cresting rail, which is “[s]awn and shaped from one piece of wood”); *id.* at 48 (showing cresting rails could also be used with stick

Thus, they could have been sold separately to other manufacturers.<sup>489</sup> The fact that these pieces were meant to be incorporated into chairs would not have excluded them from the category of “articles of manufacture.”<sup>490</sup> Indeed, *Simpson v. Davis* suggests that merely being manufactured as a separate piece might be enough to make something a separate “article of manufacture.”<sup>491</sup>

Sometimes it is not clear from the face of a design patent whether an item was manufactured—let alone sold—separately.<sup>492</sup> Modern readers, like the original patent examiners, have to rely to some extent on the patentee’s own disclosures. In any particular instance, an examiner might have missed—or an applicant might have intentionally obscured—some defect with respect to statutory subject matter. And nineteenth century patent applicants, like patent applicants today, were capable of strategic drafting. For example, after an initial rejection, the applicant in *Ex parte Sherman* attempted to amend the claims to omit any reference to the fact that the product to which its design was directed was actually made up of two separate pieces.<sup>493</sup>

Additionally, while some nineteenth-century design patents might appear to claim designs for “machines,” that does not undermine the general principle that, in 1887, designs for “machines” were not considered to be design patentable subject matter. While it was clear that that designs for machines (at least, for full machines) could not be patented, the line between “machines” and “manufactures” was less clear.<sup>494</sup> As discussed above, there was disagreement over how to classify various tools and even pianos.<sup>495</sup> If a particular nineteenth-century design patent appears to modern eyes to fall

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chairs); *id.* at 49 (stating the frames of late nineteenth-century bentwood chairs, like the one shown in U.S. Patent No. D17,448, “were made up from separate bent-wood units, usually screwed and bolted together” and that these chairs “were often shipped in parts for assembly by the purchaser”).

489. See *supra* note 180.

490. See, e.g., *Ex parte Lewis*, 1891 Dec. Comm’r Pat. 61, 63.

491. *Simpson v. Davis*, 12 F. 144, 145–46 (C.C.E.D.N.Y. 1882).

492. See, e.g., *Handle for Pokers and Like Instruments*, U.S. Patent No. D16,786 (issued July 13, 1886).

493. *Ex parte Sherman*, 1899 Dec. Comm’r Pat. 240, 242 (noting, after having their application rejected for being composed of two separate and distinct articles of manufacture, the applicants amended their application to “disclos[e] the two tubes only in the position which they occupy when in use and containing no statement or indication that they can be separated.”).

494. See *supra* Section IV.A.1.a).

495. See *id.*

on the “machine” side of the line, that may merely be the result of an honest difference of opinion.<sup>496</sup>

## VII. CONCLUSION

A close examination of the relevant statutory text, late nineteenth-century patent treatises, Patent Office decisions, and court cases shows that, in 1887, “article of manufacture” was a term of art referring 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. Therefore, in 1887, “article of manufacture” did not mean any “thing made by hand or machine.”<sup>497</sup> Nor was “article of manufacture” a synonym for “product”—let alone a synonym for “the infringing product.”<sup>498</sup> And while, in 1887, a component of a larger product could be an “article of manufacture,” not all “components” were articles of manufacture.<sup>499</sup> Determining the relevant “article of manufacture” under the 1887 Act would not have been terribly difficult. For configuration or combination (configuration and ornamentation) designs, the article would have been the article identified in the patent.<sup>500</sup> For surface ornamentation designs, the infringing article could—in appropriate circumstances—be something other than what the patentee “invented and produced.”<sup>501</sup> Additionally, while an article of manufacture had to be “vendible” in the sense that it had to be complete enough to be sold separately to someone—it did not have to actually be sold separately by any party to a particular patent dispute.<sup>502</sup> If the patentee could prove what profits the defendant made from the relevant

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496. See generally SYMONS, *supra* note 47, at 28 (“There are some cases in which the question [of] whether a device is a manufacture or a machine is a close one.”).

497. Compare *supra* Section V.B.2, with *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 435 (2016).

498. Compare *supra* Section V.B.1, with *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1002 (Fed. Cir. 2015) (interpreting “article of manufacture” to mean whatever the defendant “sold separately . . . to ordinary purchasers”), and *Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344, 1354–55 (Fed. Cir. 2015) (same). It also did not include any “sold to the consumer.” Compare *supra* Section V.B.1, with *Samsung*, 137 S. Ct. at 434 (“The term ‘article of manufacture,’ as used in § 289, encompasses both a product sold to a consumer and a component of that product.”).

499. Compare *supra* Section V.B.3, with *Samsung*, 137 S. Ct. at 434 (“The term ‘article of manufacture,’ as used in § 289, encompasses both a product sold to a consumer and a component of that product.”).

500. See *supra* Section V.C.1 (discussing the nature of configuration designs, as understood in the late nineteenth century).

501. See *id.*

502. See *supra* Section V.B.1.

article, they would be entitled to the “total profit” from that article. If not, they would still be able to recover the \$250 penalty.<sup>503</sup>

The historical evidence also provides support for at least part of the Supreme Court’s decision in *Samsung v. Apple*. To the extent that the Court’s decision in *Samsung* is read as ruling that the phrase “article of manufacture” could, at the time the special remedy was enacted, refer to a component of a larger product,<sup>504</sup> that reading is supported by the historical evidence.<sup>505</sup> On the other hand, to the extent the Court’s decision can be read as ruling that in 1887, “article of manufacture” meant any “thing made by hand or machine,”<sup>506</sup> that would not be supported by the historical evidence.<sup>507</sup> Similarly, to the extent the Court’s decision can be read as suggesting that in 1887, all “components” could be “articles of manufacture,”<sup>508</sup> that would not be supported by the historical evidence.<sup>509</sup>

This historical evidence also provides context for evaluating the Federal Circuit’s initial interpretation of 35 U.S.C. § 289. In *Apple* and *Nordock*, the Federal Circuit interpreted the phrase “article of manufacture” in § 289 as a synonym for “the infringing product.”<sup>510</sup> However, this interpretation ignores the fact that “article of manufacture” was a term of art in 1887, when the predecessor to § 289 was enacted. As discussed above, in 1887, “article of manufacture” did not mean “product” or “the infringing product.”<sup>511</sup> And there is no indication that Congress intended to change the meaning of this phrase when it enacted the current version of § 289 when the Patent Act was

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503. It may be that the statutory minimum of \$250 should be increased to reflect inflation. But that is, of course, a question for Congress. It is also worth noting that § 289 is not the only provision under which a design patent owner can seek monetary relief. Like other patent owners, a design patent owner is free to seek relief, including treble damages, under 35 U.S.C. § 284. See Burstein, *Costly Designs*, *supra* note 1, at 118–19.

504. See *Samsung*, 137 S. Ct. at 434 (addressing the issue of “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”); *id.* at 435 (relying in part on a dictionary from 1885 in deciding “the term ‘article of manufacture’ is broad enough to encompass both a product sold to a consumer as well as a component of that product”).

505. See *supra* Section V.B.1.

506. See *Samsung*, 137 S. Ct. at 435.

507. See *supra* Section V.B.2.

508. See *Samsung*, 137 S. Ct. at 435.

509. See *supra* Section V.B.3.

510. See *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1001–02 (Fed. Cir. 2015); *Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344 (Fed. Cir. 2015).

511. See *supra* Section V.B.1.

overhauled in 1952.<sup>512</sup> Therefore, the Federal Circuit’s interpretation did not reflect the “plain meaning” of the statute.<sup>513</sup>

The historical evidence also demonstrates that the 45th Congress did not intend the results in *Apple* and *Nordock*. Because the term “article of manufacture” was understood in 1887 to exclude machines, neither a smartphone nor a dock leveler could have been the relevant “article of manufacture.”<sup>514</sup> And even if those items would not have been considered machines, they would not have been considered the relevant articles of manufacture; instead, the relevant articles would have been the separately-manufactured pieces for which the asserted designs were intended.<sup>515</sup> Therefore, the historical evidence indicates that the Federal Circuit’s original interpretation of § 289 did not reflect either the “plain meaning” of the statute or the original congressional intent.

This historical evidence, therefore, provides important context for evaluating the history and meaning of § 289. As lower courts grapple with the question of how to interpret this provision, they should take this historical evidence into account.

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512. *See supra* note 87.

513. *See* Lemley, *supra* note 377, at 1127.

514. *See supra* Section V.C.2.a).

515. *See id.*

