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# *Samsung v. Apple*: Taking a Bite Out of the Design Patent “Article of Manufacture” Controversy

Elizabeth M. Gil

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# *Samsung v. Apple*: Taking a Bite Out of the Design Patent “Article of Manufacture” Controversy

Elizabeth M. Gil\*

*Smartphones have become a universal item. A smartphone is comprised of hundreds of thousands of patented inventions, many of which are design patents. It is these design patents that are at the center of the highly-contested case of Samsung Electronics Co., Ltd. v. Apple Inc., which involves three of the design patents within Apple’s iPhone. Beginning in 2011, Apple and Samsung have been in a seemingly never-ending litigious battle over these design patents with the case commencing in the district court, climbing up to the Supreme Court of the United States, and returning to the district court. It is this case that brought design patents back into the limelight after more than one-hundred years. It shed light on 35 U.S.C. § 289, an 1887 statute involving design patent infringement remedies, which allows design patent owners to recover from the infringer’s “total profit” from a useful “article of manufacture” that contains the infringing design. But how is a court to define “article of manufacture” when the patented design is a smartphone—an item that contains multiple components? This Note analyzes the scope of the term “article of manufacture” as applied to a multi-component product and proposes a test for the first step of the § 289 damages inquiry.*

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<sup>1</sup> Evan Engstrom, *So How Many Patents Are In A Smartphone?*, ENGINE (Jan. 19, 2017), <http://www.engine.is/news/category/so-how-many-patents-are-in-a-smartphone>.

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## I. INTRODUCTION

For most people nowadays, it is hard to remember a time when smartphones<sup>2</sup> did not exist. Ten years ago, smartphones were still a relatively new concept. That all changed in 2007 when Apple, Inc. (“Apple”) released its first iPhone and launched smartphones into the mainstream, thanks to the device’s attractive design and intuitive user interface.<sup>3</sup> To protect its intellectual property, Apple filed design patent applications just six days before iPhones were first sold in June 2007.<sup>4</sup>

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<sup>2</sup> Riley v. California, 134 S. Ct. 2473, 2480 (2014) (defining “smartphones” as “cell phone[s] with a broad range of other functions based on advanced computing capability, large storage capacity, and Internet connectivity.”).

<sup>3</sup> *Apple Reinvents the Phone with iPhone*, APPLE (Jan. 9, 2007), <http://www.apple.com/pr/library/2007/01/09Apple-Reinvents-the-Phone-with-iPhone.html>; see also *20 years of the smartphone: an evolution in pictures*, THE TELEGRAPH, <http://www.telegraph.co.uk/technology/mobile-phones/11037225/20-years-of-the-smartphone-an-evolution-in-pictures.html?frame=3007865> (last visited Apr. 2017).

<sup>4</sup> Abby J. Queale, *Transcript of Presentation—The Design Patent: A Sleeping Giant?*, 16 FLA. COASTAL L. REV. 139, 143 (2014).

These design patents became especially relevant on April 15, 2011 when Apple sued its mobile phone market competitor Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively “Samsung”) for infringing on three of its iPhone design patents.<sup>5</sup>

In recent history, design patents have increased in importance, particularly because of the role they play in protecting aspects of smartphones and tablets.<sup>6</sup> These design patents, though, only cover a small portion of smartphones, “which include hundreds if not thousands of electronic components, many of which are themselves protected by utility patents and are arguably irrelevant to the external look and feel of the device that the design patents protect.”<sup>7</sup> Now, because of *Samsung Electronics Co., Ltd. v. Apple Inc.*,<sup>8</sup> design patents have taken center stage.<sup>9</sup> The case is part of a long-running patent fight between Apple and Samsung over the meaning of 35 U.S.C. § 289, which is an 1887 statute that allows design patent owners to recover from the infringer’s “total profit” from a useful “article of manufacture” that contains the infringing design.<sup>10</sup> It is the technical term “article of manufacture” that causes trouble for the courts, the parties involved in this case, patent attorneys, and companies. The main question these courts face is whether the “article of manufacture” as applied to a multi-component product (such as a smartphone) is necessarily the phone itself or just the case and screen to which the design patents relate.

This Note proceeds in four parts. Part II describes design patents and the article of manufacture requirement. Part III details the procedural

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<sup>5</sup> See generally Complaint for Patent Infringement, Federal False Designation of Origin and Unfair Competition, Federal Trademark Infringement, State Unfair Competition, Common Law Trademark Infringement, and Unjust Enrichment, *Apple, Inc., v. Samsung Elecs. Co., Ltd.*, 909 F. Supp. 2d 1147 (N.D. Cal. 2012) (No. CV 11 1846) [hereinafter Initial Complaint].

<sup>6</sup> Peter Lee & Madhavi Sunder, *Design Patents: Law Without Design*, 17 STAN. TECH. L. REV. 277, 284 (2013).

<sup>7</sup> Ronald Mann, *Opinion analysis: Justices tread narrow path in rejecting \$400 million award for Samsung’s infringement of Apple’s cellphone design patents*, SCOTUSBLOG (Dec. 6, 2016, 4:09 PM), <http://www.scotusblog.com/2016/12/opinion-analysis-justices-tread-narrow-path-in-rejecting-400-million-award-for-samsungs-infringement-of-apples-cellphone-design-patents/> [hereinafter Mann, *Opinion analysis*].

<sup>8</sup> *Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429 (2016).

<sup>9</sup> See generally Christopher V. Carani, *Apple v. Samsung: Design Patents Take Center Stage?*, 5 LANDSLIDE, no. 3, Jan./ Feb. 2013, at 1, available at [http://www.americanbar.org/content/dam/aba/administrative/litigation/materials/aba-annual-2013/written\\_materials/2\\_1\\_apple\\_vs\\_samsung\\_FN.authcheckdam.pdf](http://www.americanbar.org/content/dam/aba/administrative/litigation/materials/aba-annual-2013/written_materials/2_1_apple_vs_samsung_FN.authcheckdam.pdf).

<sup>10</sup> J. Michael Jakes, *Design Patents Take Center Stage*, 23 WESTLAW J. INTELL. PROP., no. 15, Nov. 16, 2016, at 1, available at <http://www.finnegan.com/resources/articles/articledetail.aspx?news=5620171a-cf8b-49f4-8b7a-8fb6a5278848>.

history of how the design patent case came “full-circle” from its inception in the district court, up to the Supreme Court of the United States, and back down to the district court once again. Part IV proposes a test for the first step of the § 289 damages inquiry to define what is the proper “article of manufacture” and explains why that is the best solution. Part V offers a final reflection.

## II. DESIGN PATENTS

### A. *Obtaining Protection*

A patent for an invention is an intellectual property right granted to the patentee by the United States Patent and Trademark Office (“USPTO”).<sup>11</sup> This right is granted to “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof . . . .”<sup>12</sup> Once this right has been granted, the patentee can “exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States.”<sup>13</sup> The purpose of the patent system is to “promote the Progress of Science and useful Arts.”<sup>14</sup>

There are three types of patents: utility patents, plant patents, and design patents.<sup>15</sup> Design patents are centered entirely on the visual, which contrasts with copyright,<sup>16</sup> trademark,<sup>17</sup> trade secret,<sup>18</sup> utility patent,<sup>19</sup> or other various protections that have been enacted for specific types of

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<sup>11</sup> *General information concerning patents*, UNITED STATES PATENT AND TRADEMARK OFFICE (Oct. 2015), <https://www.uspto.gov/patents-getting-started/general-information-concerning-patents#heading-2> [hereinafter *Information*].

<sup>12</sup> 35 U.S.C. § 101.

<sup>13</sup> 35 U.S.C. § 154(a)(1).

<sup>14</sup> U.S. Const. art. I, § 8, cl. 8; *see also Information*, *supra* note 11.

<sup>15</sup> *Information*, *supra* note 11.

<sup>16</sup> Gregory N. Mandel, *The Public Perception of Intellectual Property*, 66 FLA. L. REV. 261, 266 (2014) (“Copyright law protects original works of authorship, including literary, dramatic, musical, and artistic work.”).

<sup>17</sup> Xuan-Thao Nguyen & Jeffrey A. Maine, *Equity and Efficiency in Intellectual Property Taxation*, 76 BROOK. L. REV. 1, 12 (2010) (“[T]rademark laws prevent competitors from copying source-identifying marks and minimizing the likelihood of consumer confusion.”).

<sup>18</sup> *Id.* at 45 (“[T]rade secret law was designed to foster innovation and promote responsible business conduct. To that end, trade secrets are treated as property, and courts have thus held that regulations forcing trade secret disclosure amount to a governmental taking of property for which the trade secret owner must be justly compensated.”).

<sup>19</sup> Queale, *supra* note 4, at 139 (“Utilitarian features are protected by a utility patent.”).

innovation.<sup>20</sup> In 1842, Congress enacted the first design patent statute based on a perceived lack of protection for ornamental designs.<sup>21</sup> When Congress introduced this statute, design patents were the only form of intellectual property protection available for designs.<sup>22</sup>

A design patent is granted to “[w]hoever invents any new, original and ornamental design for an *article of manufacture*.”<sup>23</sup> Section 171 of the Patent Act has been interpreted as requiring that a claimed design must be (1) “new [and] original,”<sup>24</sup> (2) “ornamental,”<sup>25</sup> and (3) “for an *article of manufacture*.”<sup>26</sup> The scope of protection of a design patent is defined by a single claim, which is often expressed as a short phrase and one or more drawings.<sup>27</sup> A design patent issued *prior* to May 13, 2015 has a term of fourteen years from grant.<sup>28</sup> Those design patents issued *after* May 13, 2015 are for a term of fifteen years from the date of patent grant.<sup>29</sup>

## B. *The Article of Manufacture*

### i. The Fixation Requirement

The design patent “article of manufacture” requirement has existed in design patent law from the very beginning.<sup>30</sup> Although the phrase “article of manufacture” is not statutorily defined, it has been explained through case law.<sup>31</sup> The Supreme Court defined “article of manufacture” as “the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether

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<sup>20</sup> Rebecca Tushnet, *The Eye Alone Is the Judge: Images and Design Patents*, 19 J. INTELL. PROP. L. 409 (2012).

<sup>21</sup> Lee & Sunder, *supra* note 6, at 280.

<sup>22</sup> *Id.*

<sup>23</sup> 35 U.S.C. § 171(a) (emphasis added).

<sup>24</sup> 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, 186–87 (2013) (“The statutory provisions ‘new’ and ‘original’ have not generally been interpreted as requirements endemic to design patent law. Instead, they have usually been construed as corresponding to the newness, novelty, and nonobviousness requirements found in 35 U.S.C. §§ 101, 102, and 103, respectively.”).

<sup>25</sup> *Gorham Co. v. White*, 81 U.S. 511, 524 (1871) (finding design protection encompasses “not so much utility as appearance”).

<sup>26</sup> 35 U.S.C. § 171(a) (emphasis added); *see also* Seymour & Torrance, *supra* note 24, at 186. See discussion *infra* Part II (B).

<sup>27</sup> Lee & Sunder, *supra* note 6, at 281.

<sup>28</sup> *Information*, *supra* note 11 (emphasis added).

<sup>29</sup> *Id.* (emphasis added).

<sup>30</sup> Seymour & Torrance, *supra* note 24, at 190.

<sup>31</sup> Andrew Beckerman-Rodau, *Design Patent Evolution: From Obscurity to Center Stage*, 32 SANTA CLARA HIGH TECH. L. J. 53, 58 (2015).

by hand-labor or by machinery.”<sup>32</sup> Almost any tangible object or article satisfies this requirement.<sup>33</sup>

When Congress enacted the first design patent statute in 1842, it provided protection for designs and configurations for articles of manufacture generally.<sup>34</sup> It also outlined specific categories of protected articles of manufacture, including textiles, statues, and ornaments, as well as patterns, prints, and pictures “worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture.”<sup>35</sup> Since its inception, the design patent statute expressly provided that design patents were only intended to cover designs that either comprised the article of manufacture itself, or designs that formed a permanent part of the underlying article of manufacture (i.e., fixed within or worked into its overall physical structure).<sup>36</sup> Subsequent amendments to the design patent statute consistently preserved the article of manufacture requirement.<sup>37</sup>

Under every amended version of the design patent statute, a fixation requirement has been strictly enforced.<sup>38</sup> All versions of the design patent statute have maintained that mere proximity of a design to an article of manufacture is insufficient.<sup>39</sup> Although Congress omitted an express fixation requirement in the Patent Act of 1902, courts nevertheless have interpreted it to still require that a claimed design, in order to be patentable, must either comprise the article of manufacture itself or be physically worked into its structure.<sup>40</sup>

## ii. The Article of Manufacture Requirement

In addition to the fixation requirement, the subject of the design patent must qualify as an article of manufacture.<sup>41</sup> In the early days of design patent law, there was little doubt as to what constituted an article of manufacture because manufactured goods at the time consisted almost exclusively of hand-made, tangible items.<sup>42</sup> Courts have analyzed this

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<sup>32</sup> *Id.*; see also *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980) (quoting *Am. Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931)).

<sup>33</sup> *Id.* at 58–59.

<sup>34</sup> *Seymour & Torrance*, *supra* note 24, at 190.

<sup>35</sup> *Id.*; see also Patent Act of 1842, ch. 263, § 3, 5 Stat. 543.

<sup>36</sup> *Id.* at 190–91.

<sup>37</sup> *Id.* at 191.

<sup>38</sup> *Id.*

<sup>39</sup> *Id.*

<sup>40</sup> *Id.* at 193; see e.g., *Pioneer Photo Albums, Inc. v. Holson Co.*, 654 F. Supp. 87, 88 (C.D. Cal. 1987) (holding invalid a design patent for a greeting card which contained two internal flaps for holding personal photographs because the surface ornamentation was merely placed on the card and was not integral to the card).

<sup>41</sup> *Seymour & Torrance*, *supra* note 24, at 194.

<sup>42</sup> *Id.*

requirement and set forth a few general principles. First, it is “well settled that the term ‘an article of manufacture’ does not include *every* article of manufacture . . . [A]rticles which are more or less hidden from view when in use are not the proper subject-matter for design patents.”<sup>43</sup> Also, design patent protection is unavailable for articles of manufacture, which “owing to their nature, could be a matter of concern to no one.”<sup>44</sup> A design patent applicant may only claim a design for a portion of an article of manufacture.<sup>45</sup> Last, a design may be applicable to more than one article of manufacture.<sup>46</sup>

Apart from these general limitations, the article of manufacture requirement has been construed broadly.<sup>47</sup> As the Supreme Court noted in *Tide-Water Oil Co. v. United States*:

The primary meaning of the word “manufacture” is something made by hand, as distinguished from a natural growth; but, as machinery has largely supplanted this primitive method, the word is now ordinarily used to denote an article upon the material of which labor has been expended to make the finished product.<sup>48</sup>

As technology has advanced and as innovation moves further away from traditional, human-made, tangible objects, the definition of what constitutes an article of manufacture becomes more challenging.<sup>49</sup>

### C. *Enforcement*

#### i. *Infringement*

A patent is infringed when someone, without authority, “makes, uses, offers to sell or sells” a product containing a design that is substantially similar to the patented design.<sup>50</sup> Specifically, a design patent is infringed when any person without authority “(1) applies the patented design, or any

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<sup>43</sup> *Id.*

<sup>44</sup> *Id.*

<sup>45</sup> *Id.*

<sup>46</sup> *Id.*

<sup>47</sup> *Id.*; see, e.g., *In re Hadden*, 20 F.2d 275 (D.C. Cir. 1927).

<sup>48</sup> *Id.* at 195 (quoting *Tide-Water Oil Co. v. United States*, 171 U.S. 210, 216 (1898)); see also *Am. Patents Dev. Corp. v. Carbice Corp. of Am.*, 38 F.2d 62, 64 (2d Cir. 1930) (“In thinking of an article of manufacture, one naturally thinks of a permanent contrivance, which does not operate upon a subject that is part of itself.”).

<sup>49</sup> *Id.* at 196.

<sup>50</sup> *Jakes*, *supra* note 10, at 2; see 35 U.S.C. §§ 171(b); see also *Gorham Co. v. White*, 81 U.S. 511, 524 (1871); *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 667–78 (Fed. Cir. 2008) (en banc).

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 . . . .”<sup>51</sup> In 1871, the Supreme Court interpreted the standard of infringement in *Gorham Co. v. White* stating,

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.<sup>52</sup>

“An owner of a valid design patent can bring an action when he or she believes that the patent has been infringed.”<sup>53</sup>

## ii. Remedies

If a patent owner proves infringement in a design patent case, he or she has a choice of remedies.<sup>54</sup> Damages for design patents can be obtained under 35 U.S.C. § 284 or § 289.<sup>55</sup> Under § 284, which applies to both utility and design patents, the patent owner can collect “damages adequate to compensate for infringement, but in no event less than a reasonable royalty” for the use of the invention or design.<sup>56</sup> The damages are analyzed under “but for” causation.<sup>57</sup>

Design patent owners also have an alternative remedy that is unavailable for utility patents.<sup>58</sup> Under § 289, the damages are more of a property rule, whereby the defendant’s *total profits* without apportionment to the article of manufacture to which the design is applied is awarded.<sup>59</sup> Section 289 states,

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<sup>51</sup> 35 U.S.C. § 289 (emphasis added).

<sup>52</sup> *Gorham*, 81 U.S. at 528.

<sup>53</sup> Michelle L. Evans, *Establishing Infringement of a Design Patent*, 105 AM. JUR. 3D *Proof of Facts* § 4 (2009).

<sup>54</sup> Jakes, *supra* note 10, at 2.

<sup>55</sup> Dennis M. White, *Inefficiencies in Overcompensating Design Patent Damages Under 35 U.S.C. § 289 in Complex Technologies*, 95 J. PAT. & TRADEMARK OFF. SOC’Y 444, 445 (2013).

<sup>56</sup> 35 U.S.C. § 284; *see also* Jakes, *supra* note 10, at 2.

<sup>57</sup> White, *supra* note 55, at 445; *see also* 35 U.S.C. § 284; *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 507 (1964) (citing *Livesay Window Co. v. Livesay Indus., Inc.*, 251 F.2d 469, 471 (5th Cir. 1958)) (“The question to be asked in determining damages is . . . had the Infringer not infringed, what would Patent Holder-Licensee have made?”).

<sup>58</sup> Jakes, *supra* note 10, at 2.

<sup>59</sup> White, *supra* note 55, at 445 (emphasis added).

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>60</sup>

This disgorgement of total profits takes on attributes of a property rule when the alleged infringing product is a complex, multi-component product and the ornamental design is only a small feature incorporated in the entire product.<sup>61</sup> In 1887, Congress added § 289 to U.S. patent law in response to Supreme Court decisions that severely limited recovery in a design patent case.<sup>62</sup> Before the Design Patent Act of 1887, a design patent owner could only recover the proportionate amount of profits that were proven to be attributable to the patented feature.<sup>63</sup> It is § 289 and its implications on multi-component articles of manufacture that is at issue in the *Samsung v. Apple* case.

### III. SAMSUNG V. APPLE: A CASE ANALYSIS

Beginning in 2011, Apple has faced Samsung in a series of legal battles that spanned ten countries and four continents.<sup>64</sup> Within the United States alone, these conflicts have transpired in three main jurisdictions: the Federal Courts, the International Trade Commission (“ITC”), and the USPTO.<sup>65</sup> Specifically in the Federal Court system, this case has had an extensive journey—traveling all the way up to the Supreme Court of the United States and back down to the District Court. The following paragraphs explain in detail the journey at each stage.

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<sup>60</sup> 35 U.S.C. § 289 (emphasis added).

<sup>61</sup> White, *supra* note 55, at 445.

<sup>62</sup> Jakes, *supra* note 10, at 2.

<sup>63</sup> *See id.* at 2.

<sup>64</sup> Britten D. Sessions & Wei Y. Lu, *Goliath v. Goliath Fallout: Repercussions of Apple v. Samsung*, 40/41 LINCOLN L. REV. 1, 2 (2014).

<sup>65</sup> *Id.* This Note will focus solely on the litigation in the Federal Courts.

A. *District Court*

On April 15, 2011, Apple sued Samsung asserting, among other claims, that Samsung's smartphones infringed upon several of Apple's design patents embodied in its 2007 iPhone.<sup>66</sup> On June 16, 2011, Apple amended its original complaint to include the three design patents in question.<sup>67</sup> Apple accused Samsung of infringing three of its design patents including U.S. Design Patent Nos. D618,677 ("D'677 patent"), D593,087 ("D'087 patent"), and D604,305 ("D'305 patent").<sup>68</sup> These design patents protect: (1) the minimalistic face of an iPhone, the front speaker slot, and edge-to-edge glass of the front display; (2) the minimalistic face of an iPhone, home button, and rounded corners; and (3) the layout of Apple's graphical user interface, including a grid of sixteen home screen icons on a black screen with a band of "permanent" apps at the bottom.<sup>69</sup> Representative images of the three asserted design patents are set forth below.

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<sup>66</sup> See generally Initial Complaint, *supra* note 5; see also Brief for the United States as Amicus Curiae Supporting Neither Party at 5, Samsung Elecs. Co., Ltd. v. Apple Inc., 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 3194218, at \*5 [hereinafter Amicus Brief].

<sup>67</sup> See Amended Complaint for Federal False Designation of Origin and Unfair Competition, Federal Trademark Infringement, Federal Trade Dress Dilution, State Unfair Business Practices, Common Law Trademark Infringement, Unjust Enrichment, and Patent Infringement, Apple, Inc., v. Samsung Elecs. Co., Ltd., 909 F. Supp. 2d 1147 (N.D. Cal. Dec. 17, 2012) (No. CV 11 1846) [hereinafter Amended Complaint].

<sup>68</sup> Apple Inc. v. Samsung Elecs. Co., Ltd., 786 F.3d 983, 989 (Fed. Cir. 2015).

<sup>69</sup> Lee & Sunder, *supra* note 6, at 284; see also Amicus Brief, *supra* note 66, at 5.

The first patent, the D'677 patent, discloses a single embodiment directed to the appearance of a front face of a device.<sup>70</sup>

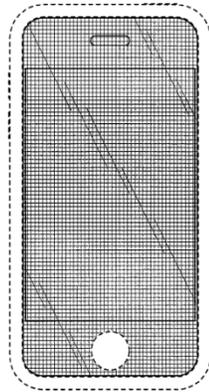


FIG. 3

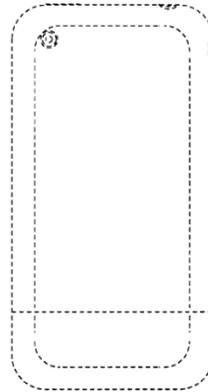


FIG. 4

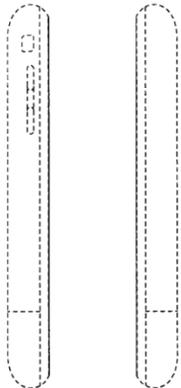


FIG. 7

FIG. 8

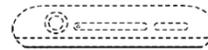


FIG. 5

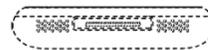


FIG. 6

<sup>70</sup> Carani, *supra* note 9, at 26; *see also* U.S. Patent No. D618,677 fig. 3-8 (filed Nov. 18, 2008).

The second patent, the D'087 patent, discloses six different embodiments all directed at a front face with an outer bezel for an electronic device.<sup>71</sup>

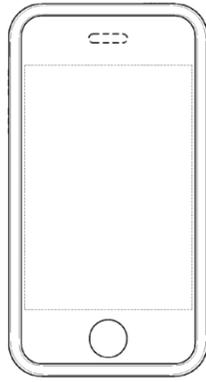


FIG. 3

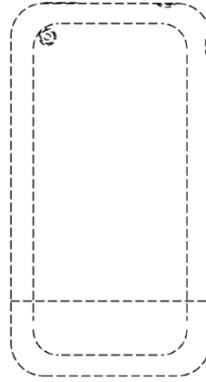


FIG. 4

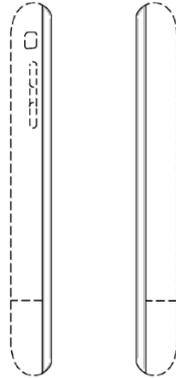


FIG. 7

FIG. 8



FIG. 5

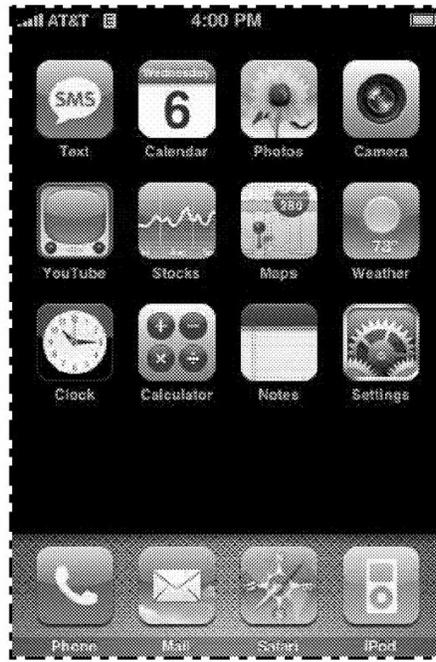


FIG. 6

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<sup>71</sup> Carani, *supra* note 9, at 26; *see also* U.S. Patent No. D593,087 fig. 3-8 (filed Jul. 30, 2007).

The last patent, the D'305 patent, is directed to the appearance of a graphic user interface (“GUI”).<sup>72</sup>



**FIG. 1**

Invoking § 289, Apple sought an award of Samsung’s “total profits” from the sale of the infringing phones.<sup>73</sup> Samsung asserted two objections to the measure of relief.<sup>74</sup> First, Samsung argued that, under “basic causation principles,” they should be liable only for profits attributable to the infringing design, as opposed to other attributes of the phones.<sup>75</sup> Second, Samsung argued that “profits disgorgement [must] be limited to the ‘article of manufacture’ to which a patented design is applied,” and

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<sup>72</sup> Carani, *supra* note 9, at 27; *see also* U.S. Patent No. D604,305 fig. 1 (filed Jun. 23, 2007).

<sup>73</sup> *See* Amicus Brief, *supra* note 66, at 5.

<sup>74</sup> *Id.* at 5–6.

<sup>75</sup> *Id.* at 6.

that the relevant “article[s] of manufacture” in the case at hand were components of the phones, instead of the phones themselves.<sup>76</sup>

The United States District Court for the Northern District of California rejected Samsung’s proposed jury instructions embodying those principles on the grounds that there is no apportionment for profits in design patents cases.<sup>77</sup> On August 24, 2012, the first jury reached a verdict that a number of Samsung products infringed Apple’s aforementioned design patents.<sup>78</sup> The jury awarded Apple all the profits that Samsung had received on sales of the infringing phones.<sup>79</sup> After a partial retrial on damages, the district court entered final judgment awarding Apple nearly \$1 billion in damages for, among other things, design patent infringement.<sup>80</sup> In 2013, the judge that presided over the first case found that the damages Samsung had to pay were calculated incorrectly.<sup>81</sup> Around \$450 million of the \$1 billion was invalidated and a retrial commenced later that year.<sup>82</sup> In the retrial, Apple earned an additional \$290 million in damages, bringing the grand total Samsung owed Apple to \$929 million, a total just shy of the original \$1 billion.<sup>83</sup> Subsequently, Samsung filed a notice of appeal.<sup>84</sup>

### B. *Court of Appeals*

On March 18, 2015, the United States Court of Appeals for the Federal Circuit affirmed the jury’s finding of design patent infringement and the award of Samsung’s total profit on the infringing phones.<sup>85</sup> In reaching this decision, the court rejected Samsung’s argument that the award under § 289 should have been limited to profits attributable to the infringement, holding that “[t]he clear statutory language [of § 289] prevents us from adopting a ‘causation’ rule as Samsung urges.”<sup>86</sup> The court also rejected Samsung’s argument that, for purposes of calculating the appropriate award under § 289, the infringing “article[s] of manufacture” were the phones’ exterior cases and the array of icons displayed on the phones’

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<sup>76</sup> *Id.*

<sup>77</sup> *Id.*

<sup>78</sup> Timothy Coughlin, *Apple, Inc. v. Samsung Electronics Co.: Economics of Design Patent Trolling*, 35 CARDOZO ARTS & ENT. L. J. 209, 225 (2016).

<sup>79</sup> Amicus Brief, *supra* note 66, at 6.

<sup>80</sup> *Id.*; *see also* Coughlin, *supra* note 78, at 225.

<sup>81</sup> Julian Chokkattu, *U.S. Court of Appeals Officially Reopens the Apple vs. Samsung Patent Case*, DIGITALTRENDS (Jan. 13, 2017, 2:09 PM), <http://www.digitaltrends.com/mobile/apple-vs-samsung-supreme-court/>.

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*

<sup>84</sup> Coughlin, *supra* note 78, at 225.

<sup>85</sup> *Apple Inc. v. Samsung Elecs. Co., Ltd.*, 786 F.3d 983, 1002 (Fed. Cir. 2015).

<sup>86</sup> *Id.*

screens rather than the phones as sold to the public.<sup>87</sup> The court concluded that “the *entire* smartphone [was] the only permissible “article of manufacture” for the purpose of calculating § 289 damages because consumers could not separately purchase components of the smartphones.”<sup>88</sup> As a result, the court affirmed the district court and held that Apple was entitled to Samsung’s total profits from the infringing phones.<sup>89</sup> On December 14, 2015, Samsung petitioned for a writ of certiorari, which was granted on March 21, 2016.<sup>90</sup>

### C. *Supreme Court*

On October 11, 2016, the Supreme Court of the United States heard oral argument from counsel for Apple, Samsung, and the United States as a “friend of the court.”<sup>91</sup> The question before the Court was whether the “article of manufacture” to which the infringing design feature has been applied is the cellphone itself, as the court of appeals found, or a particular smartphone component.<sup>92</sup> All parties agreed that Apple was entitled to all profits from the “article of manufacture”—whatever that might be.<sup>93</sup> The oral arguments also confirmed that all parties agreed to two points.<sup>94</sup> First, the court of appeals erred in adopting a blanket rule that the “article of manufacture” is the object sold to consumers. Second, the issue is ultimately a question of fact.<sup>95</sup> That left open the problem of defining the “article” to which the design is applied if it is something less than the article that is sold to consumers.<sup>96</sup>

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<sup>87</sup> *See id.* (rejecting Samsung’s argument for limiting the profits awarded to “the portion of the product as sold that incorporates or embodies the subject matter of the patent.”).

<sup>88</sup> *Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429, 432 (2016) (emphasis added); *see also* *Apple Inc.*, 786 F.3d at 1002 (“The innards of Samsung’s smartphones were not sold separately from their shells as distinct articles of manufacture to ordinary purchasers.”).

<sup>89</sup> *Apple Inc.*, 786 F.3d at 1002.

<sup>90</sup> *See generally* *Petition for Writ of Certiorari, Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777), 2015 WL 10013702.

<sup>91</sup> *See* Ronald Mann, *Argument analysis: Justices cautious about resolving Samsung-Apple dispute over design of cell phones*, SCOTUSBLOG (Oct. 13, 2016, 11:17 AM), <http://www.scotusblog.com/2016/10/argument-analysis-justices-cautious-about-resolving-samsung-apple-dispute-over-design-of-cell-phones/> [hereinafter Mann, *Argument analysis*].

<sup>92</sup> *Id.*; *see also* *Petition for Writ of Certiorari, supra* note 90, at (i) (“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>93</sup> Mann, *Argument analysis, supra* note 91.

<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> *Id.*

On December 6, 2016, in a unanimous decision, the Supreme Court of the United States declined to solve the problem of defining what is an “article of manufacture.”<sup>97</sup> The Court did, however, reject the \$400 million verdict Apple had won.<sup>98</sup> In essence, the Court reversed the United States Court of Appeals for the Federal Circuit’s decision to uphold a jury verdict and sent the case back to the Federal Circuit to define the appropriate legal standard for what is an “article of manufacture.”<sup>99</sup> The Court barely discussed the purposes or goals of the design-patent statute.<sup>100</sup> Instead, it took the position that the text of the statute compels rejection of the Federal Circuit’s end-product rule.<sup>101</sup>

The Court relied heavily on the idea that, according to its dictionary definition, an “article of manufacture” is “simply a thing made by hand or machine.”<sup>102</sup> In connection to that definition, the Court found that an article of manufacture is “broad enough to encompass both a product sold to a consumer as well as a component of that product.”<sup>103</sup> According to Justice Sotomayor, “[t]hat a component may be integrated into a larger product . . . does not put it outside the category of articles of manufacture.”<sup>104</sup>

The narrow holding offers no guidance on how to distinguish the “article of manufacture” of relevance from the actual cellphones at issue.<sup>105</sup> The opinion also failed to instruct the Federal Circuit definitively to reject the entire cellphone as the article of manufacture.<sup>106</sup> What the Federal Circuit was explicitly instructed to do is to define a test under which it would be possible that components of a smartphone could be treated as articles of manufacture.<sup>107</sup> As a result, the Supreme Court left the problem of defining and applying the appropriate standard for the Federal Circuit to resolve.<sup>108</sup>

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<sup>97</sup> *Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429, 436 (2016) (“We decline to lay out a test for the first step of the § 289 damages inquiry in the absence of adequate briefing by the parties.”).

<sup>98</sup> *See id.*

<sup>99</sup> Mann, *Opinion analysis*, *supra* note 7.

<sup>100</sup> *Id.*

<sup>101</sup> *Id.*

<sup>102</sup> *Id.*; *see also* *Samsung Elecs. Co., Ltd.*, 137 S. Ct. at 435.

<sup>103</sup> *Id.* at 435.

<sup>104</sup> *Id.*

<sup>105</sup> Mann, *Opinion analysis*, *supra* note 7.

<sup>106</sup> *Id.*

<sup>107</sup> *Id.*

<sup>108</sup> *Id.*

#### D. *Court of Appeals*

About a month later, the United States Court of Appeals for the Federal Circuit reopened the patent fight between Apple and Samsung.<sup>109</sup> On February 7, 2017, the court in a non-precedential decision, also refused to decide the issue but instead remanded the case back to the district court for reconsideration, “which may or may not include a new damages trial.”<sup>110</sup> The court commented that “[t]he Supreme Court clarified that a damages award under § 289 involves two steps: (1) ‘identify the ‘article of manufacture’ to which the infringed design has been applied;’ and (2) ‘calculate the infringer’s total profit made on that article of manufacture.’”<sup>111</sup> On remand, the district court will have to consider the parties’ arguments in light of the trial court record and determine whether a new damages trial is necessary based upon more detailed jury instructions.<sup>112</sup>

### IV. A TEST FOR THE FIRST STEP OF THE § 289 DAMAGES INQUIRY

#### A. *The Problem*

The legal dispute between Samsung and Apple has come full circle—commencing in the district court, rising all the way up to the highest court in the land, and back down to the district court where it all began. The Supreme Court concluded that the “article of manufacture” for purposes of design patent damages could be something less than the end-product consumers buy.<sup>113</sup> So what is wrong with the Supreme Court “passing the apple” on the task of defining article of manufacture? The problem is that the Court did not say anything about *how* a court is supposed to figure out what the “article of manufacture” is; instead it sent the case back to the Federal Circuit to devise a test. The Federal Circuit followed suit and avoided devising a test.<sup>114</sup> Instead, it instructed the district court to address

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<sup>109</sup> Apple Inc. v. Samsung Elecs. Co., Ltd., 2017 WL 490419, at \*1 (Fed. Cir. 2017); *see also* Matthew Bultman, *Fed. Cir. Reopens Apple-Samsung Patent Damages Row*, LAW360 (Jan. 12, 2017, 6:59 PM), <https://www.law360.com/articles/880239/fed-circ-reopens-apple-samsung-patent-damages-row>.

<sup>110</sup> Apple Inc., 2017 WL 490419, at \*1; *see also* Dennis Crouch, *Apple Samsung: Federal Circuit Remands Design Patent Damages Decision to District Court*, PATENTLYO (Feb. 7, 2017), <https://patentlyo.com/patent/2017/02/remands-decision-district.html>.

<sup>111</sup> *Id.* (citing Samsung Elecs. Co., Ltd. v. Apple Inc., 137 S. Ct. 429, 434 (2016)).

<sup>112</sup> *Id.* at \*2.

<sup>113</sup> Samsung Elecs. Co., Ltd., 137 S. Ct. at 436.

<sup>114</sup> *See* Apple Inc., 2017 WL 490419, at \*1.

the problem.<sup>115</sup> As a result, despite this lengthy and continuous litigation, the issue of defining the terms “article of manufacture” and “applied” in 35 U.S.C. § 289 remains unresolved.<sup>116</sup>

There is little guidance as to where the “article of manufacture” starts or ends, especially when it involves smartphones.<sup>117</sup> Defining the article of manufacture for single-part products is not a difficult task. However, as products become more complex with multiple parts, the patented design may be attributable to other patented or non-patented features and may be more difficult to define.<sup>118</sup> Design patents cover only a small part of the smartphones, which include hundreds if not thousands of electronic components, many of which are themselves protected by utility patents and are arguably irrelevant to the external look and feel of the device that the design patents protect.<sup>119</sup>

### *B. The Proposed Test*

Prior to the Supreme Court hearing oral argument, the Department of Justice, as represented by the Solicitor General on behalf of the federal government of the United States, weighed in as *amicus curiae*.<sup>120</sup> In its brief, the United States put forth a test to aid the factfinder in identifying the “article of manufacture” to which the infringing design has been applied.<sup>121</sup> The United States agreed with Samsung that “the relevant ‘article of manufacture’ need not always be the finished product as sold to end-users.”<sup>122</sup> It reasoned that nothing in § 289’s text or history suggests that the relevant “article of manufacture” must invariably be the product as sold.<sup>123</sup> Instead, the term “article of manufacture” literally incorporates all manufactured objects—both complete products and components—and it has historically been understood to include both.<sup>124</sup> “When the plaintiff’s patented design is applied to a component of a multi-component product, the award will turn substantially on the scope and profitability of *other* components as to which no infringement occurred.”<sup>125</sup>

Section 289’s “total profit” standard, which prohibits any inquiry into what portion of the profits on a particular “article of manufacture” are

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<sup>115</sup> *Id.*

<sup>116</sup> White, *supra* note 55, at 449.

<sup>117</sup> *Id.* at 451.

<sup>118</sup> *Id.* at 455.

<sup>119</sup> Mann, *Opinion analysis*, *supra* note 7.

<sup>120</sup> Jakes, *supra* note 10, at 3; *see also* Amicus Brief, *supra* note 66.

<sup>121</sup> *See generally id.*

<sup>122</sup> *Id.* at 10.

<sup>123</sup> *Id.* at 16.

<sup>124</sup> *Id.*

<sup>125</sup> *Id.* at 8.

attributable to the infringing design, “may sometimes produce awards that exceed the commercial benefit that the infringer derived by appropriating the patented design.”<sup>126</sup> By adopting an overbroad reading of the term “article of manufacture,” the court would only exacerbate those effects, which inevitably follow from the unambiguous statutory text.<sup>127</sup> A broad definition of “article of manufacture” would also provide the patentee with rights beyond the scope of the invented idea.<sup>128</sup> However, it is unlikely that the article of manufacture would be interpreted too narrowly given that the ornamental design is depicted in solid lines that at least incorporates a portion of the smartphone being sold.<sup>129</sup> When the relevant “article of manufacture” is a component or portion of a multi-component product, the infringer’s “total profit” for that “article” may be less than its profit for the finished item of sale.<sup>130</sup>

According to the United States, identifying the relevant “article of manufacture” involves a case-by-case specific analysis of “the relationship among the design, the product and any components.”<sup>131</sup> The factfinder should identify the article in which the design is prominently featured, and that most fairly may be said to embody the defendant’s appropriation of the plaintiff’s patented innovation.<sup>132</sup> “When the product whose sale gives rise to infringement liability is made up of multiple components, the factfinder must determine whether the ‘article of manufacture’ to which the defendant has applied the patented design is the entire product as sold, or a component of that product.”<sup>133</sup>

The United States’ brief also identified a four-factor test for determining what is the relevant “article of manufacture.”<sup>134</sup> First, the scope of the design patent claimed in the plaintiff’s patent, including the drawing and written description, provides insight into which portions of the underlying product the design is intended to cover as well as how the design relates to the product as a whole.<sup>135</sup> Second, the factfinder should examine the relative prominence of the design within the product as a whole.<sup>136</sup> Third, the factfinder should consider whether the design is conceptually distinct from the product as a whole.<sup>137</sup> Fourth, the physical

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<sup>126</sup> *Id.*

<sup>127</sup> *Id.*

<sup>128</sup> White, *supra* note 55, at 449.

<sup>129</sup> *Id.*

<sup>130</sup> Amicus Brief, *supra* note 66, at 10.

<sup>131</sup> *Id.* at 9.

<sup>132</sup> *Id.*

<sup>133</sup> *Id.* at 16.

<sup>134</sup> *Id.* at 27–29.

<sup>135</sup> *Id.*

<sup>136</sup> *Id.* at 28.

<sup>137</sup> *Id.* at 28–29.

relationship between the patented design and the rest of the product may reveal that the design adheres only to a component of the product.<sup>138</sup>

The undertaking of identifying the relevant article of manufacture is properly assigned to the factfinder because context-specific judgments about the relationship of the design to the article as a whole—the design’s effect on the product’s appearance, the component’s physical separability, and how the components are manufactured—are essentially factual in nature.<sup>139</sup> Moreover, treating the identification of the relevant “article of manufacture” as a jury question is consistent with the jury’s function in determining design-patent infringement.<sup>140</sup> The plaintiff bears the ultimate burden of establishing the infringer’s total profit.<sup>141</sup> However, the defendant, as the manufacturer or seller of the product in question, should bear the burden of identifying any component that it views as the relevant article of manufacture.<sup>142</sup>

An essential part of the United States’ approach is giving the jury the appropriate jury instructions so that they, as the factfinders, can determine what is the article of manufacture.<sup>143</sup> As the United States explained in its brief, the district court’s jury instruction below was erroneous because it equated the relevant “article of manufacture” with the accused phones as a whole, rather than permitting the jury to determine whether the phone itself or a portion of the phone was the “article of manufacture” to which the patented design had been applied.<sup>144</sup> Instead, the jury should be given instructions that make it clear that the article of manufacture can be something less than the entire smartphone.

### C. *Benefits of the Test*

The author of this Note proposes that the suggested test of the United States as *amicus curiae* would be the best solution for the first step of the § 289 damages inquiry. This test would be beneficial because currently, without the factors, there is no clear, workable way to decide what is the article of manufacture in a design patent.<sup>145</sup> Judges, patent lawyers, and clients like clear rules.<sup>146</sup> Therefore, a list of factors, as suggested by the United States as *amicus curiae*, would assist legal professionals in their

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<sup>138</sup> *Id.* at 29.

<sup>139</sup> *Id.*

<sup>140</sup> *Id.* at 30.

<sup>141</sup> *Id.*

<sup>142</sup> *Id.* at 30.

<sup>143</sup> *Id.* at 31–32.

<sup>144</sup> *Id.* at 31–32.

<sup>145</sup> *See Jakes, supra* note 10, at 4.

<sup>146</sup> *See id.*

task of determining the appropriate legal remedy for design patent infringement.<sup>147</sup>

Moreover, the test proposes a case-by-case analysis of the relationship among the design, the product, and any components.<sup>148</sup> This approach would anchor the inquiry in § 289's purpose, which is to provide the patentee with a remedy and to prevent the infringer from profiting from the unlawful appropriation of the patented design.<sup>149</sup> It would also encourage the factfinder to keep in mind the scope of the plaintiff's innovation by identifying the article in which the patented design prominently features, without unnecessarily including aspects of the product that are unrelated to the protected design.<sup>150</sup> As a result, the chances of the plaintiff being overly compensated for the article of manufacture that was not infringed is greatly diminished.

## V. CONCLUSION

Apple and Samsung are both giants in the high-tech industry that have created smartphone devices that are essentially ubiquitous.<sup>151</sup> Both have made billions of dollars in profits from their individual ventures and account for over 35% of the global smartphone market share combined.<sup>152</sup> Each company is determined to take down the other.<sup>153</sup> Given these circumstances, it is no wonder why these companies have fought to fiercely protect their intellectual property, especially their coveted design patents.

It is this fierce fight over design patents that brought the case of *Samsung v. Apple* to the limelight and all the way up to the highest court in the land. And by doing so, these technology titans have shined a spotlight on design patents by making it clear that this form of intellectual property occupies a prominent role in protecting commercial products, including sophisticated ones like smartphones.<sup>154</sup> However, this case also brought attention to another puzzling issue in the design patent world: remedies for design patent infringement.

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<sup>147</sup> *Id.*

<sup>148</sup> Amicus Brief, *supra* note 66, at 27.

<sup>149</sup> *Id.* at 26.

<sup>150</sup> *Id.*

<sup>151</sup> Sessions & Lu, *supra* note 64, at 1.

<sup>152</sup> *Id.*; Anita Balakrishnan, *Apple is back on top in the smartphone wars with a razor-thin lead*, CNBC (Feb. 15, 2017, 1:06 P.M.) <http://www.cnbc.com/2017/02/15/gartner-apple-beats-samsung-global-smartphone-shipments-q4-2016.html> (“Apple has 17.9 percent of the global smartphone market share, narrowly above Samsung’s 17.8 percent.”).

<sup>153</sup> Sessions & Lu, *supra* note 64, at 2.

<sup>154</sup> *See* Jakes, *supra* note 10, at 4.

The *Samsung v. Apple* case has been a part of a long-running fight between Apple and Samsung over the meaning of 35 U.S.C. § 289.<sup>155</sup> Particularly, the companies have debated the meaning over the technical term “article of manufacture” and how that term should be applied as to multi-component products when determining remedies for design patent infringement. However, on appeal, the Supreme Court of the United States only answered a very narrow question: whether the term “article of manufacture” constitutes the entire product or only a component.<sup>156</sup> It did not give guidance on how a court is supposed to figure out what the “article of manufacture” is.<sup>157</sup>

Indeed, the Supreme Court struggled to devise a test for determining what is the “article of manufacture.”<sup>158</sup> As Justice Anthony M. Kennedy said to Samsung’s counsel during oral argument: “[t]he problem is, is how to instruct the jury on that point. Both parties, not the government, both parties kind of leave it up and say, oh, give it to the juror. If I were the juror, I simply wouldn’t know what to do under your . . . test.”<sup>159</sup> As a result, the Supreme Court did not provide a test for determining the first step of the § 289 inquiry.<sup>160</sup> Instead, it left that problem for the lower court to solve.<sup>161</sup>

The United States as amicus curiae did, however, attempt to solve the problem by submitting factors that courts should consider when determining what is the article of manufacture of a design patent.<sup>162</sup> Courts should adopt these factors because it would provide clear guidance going forward for patent attorneys, their clients, jurors, and judges. In the meantime, it remains to be seen whether courts will take a bite out of the design patent “article of manufacture” controversy by adopting such a test.

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<sup>155</sup> Jakes, *supra* note 10, at 1.

<sup>156</sup> See Gene Quinn & Steve Brachmann, *Supreme Court overturns \$400 million Apple verdict against Samsung in smartphone design patent infringement case*, IPWATCHDOG (Dec. 6, 2016), <http://www.ipwatchdog.com/2016/12/06/supreme-court-apple-samsung-is-smartphone-design-patent/id=75434/>.

<sup>157</sup> *Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429, 436 (2016).

<sup>158</sup> *Id.*

<sup>159</sup> Transcript of Oral Argument at 4, *Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429 (2016) (No. 15-777).

<sup>160</sup> *Samsung Elecs. Co., Ltd.*, 137 S. Ct. at 436.

<sup>161</sup> *Id.*

<sup>162</sup> See generally Amicus Brief, *supra* note 66.