

ARTICLE OF MANUFACTURE – DISTRICT COURT UPDATE



BY ERIK S. MAURER AND AUDRA C. EIDEM HEINZE

In December 2016, the Supreme Court addressed the scope of the term “article of manufacture” under 35 U.S.C. § 289 for purposes of awarding a design patent infringer’s “total profit” from sales of “article[s] of manufacture” to which a patented design had been applied.¹ However, the Supreme Court did not identify the “article of manufacture” in the case before it.² Instead, the Court remanded, noting that the United States as *amicus curiae* suggested a test for making this determination.³

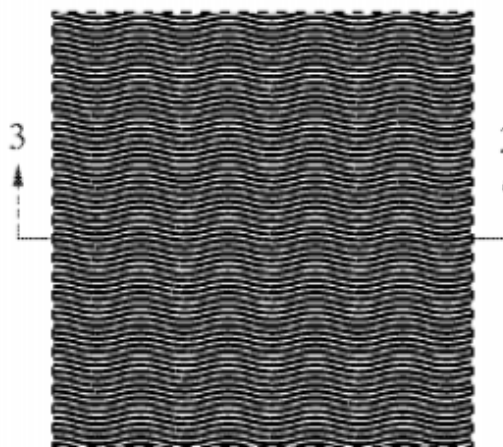
The United States identified four “considerations [] relevant to the inquiry:”⁴

1. The “scope of the design claimed in the plaintiff’s patent, including the drawing and written description.”
2. The “relative prominence of the design within the product as a whole.”
3. Whether “the design is conceptually distinct from the product as a whole.”
4. The “physical relationship between the patented design and the rest of the product.”

Here, we provide updates as to how district courts have addressed “article of manufacture” following the Supreme Court’s remand.

COLUMBIA SPORTSWEAR NORTH AMERICA, INC. V. SEIRUS INNOVATIVE ACCESSORIES, NO. 3:17-CV-01781 (S.D. CAL.)

Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories was one of the first cases to set forth an article of manufacture test in the wake of the Supreme Court’s *Samsung* decision.⁵ Columbia accused Seirus of infringing its design patent titled “Heat Reflective Material,” including the claim figure below.⁶ Judge Hernandez entered judgment that Columbia’s claimed design was valid and infringed.⁷



“Heat Reflective Material”

Illustration 1: Figure from Columbia’s Asserted Design Patent

After the parties submitted competing proposals to identify the article of manufacture

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under § 289, Judge Hernandez issued jury instructions that generally tracked the United States' proposed four-factor test.⁸ In particular, if "the product as sold to consumers is a single-component product then that product is the relevant article of manufacture."⁹ However, "[i]f the product as sold to consumer[s] is a multi-component product," then the court directed the jury to consider factors similar to those proposed by the United States' *amicus* brief in *Samsung*.¹⁰ Columbia bore the burden to show that Seirus applied the patented design to a product that was sold and to prove Seirus's total profit; it was up to Seirus to prove the "article of manufacture is something less than the entire product" and to prove any deductible expenses.¹¹

After trial, the jury awarded more than \$3 million, reflecting Seirus's "total profit from sales of the relevant article of manufacture that Columbia is entitled to receive for Seirus's infringement."¹² Judge Hernandez also

awarded Columbia pre-judgment interest over Seirus's objection.¹³ Seirus argued that prejudgment interest was unavailable because it can only be recovered under 35 U.S.C. § 284.¹⁴ Judge Hernandez found Seirus's position to be "without legal support and at odds with cases that have applied prejudgment interest" to awards under § 289.¹⁵

APPLE INC. V. SAMSUNG ELECTRONICS CO., NO. 11-CV-01846 (N.D. CAL.)

On remand from the Supreme Court and Federal Circuit, and less than two months after Judge Hernandez issued his jury instructions in *Columbia*, Judge Koh addressed article of manufacture in *Apple Inc. v. Samsung Electronics Co.*¹⁶ At issue were three Apple design patents infringed by Samsung titled "Electronic Device," "Electronic Device," and "Graphical User Interface for a Display Screen or Portion Thereof," including the claim figures below.¹⁷

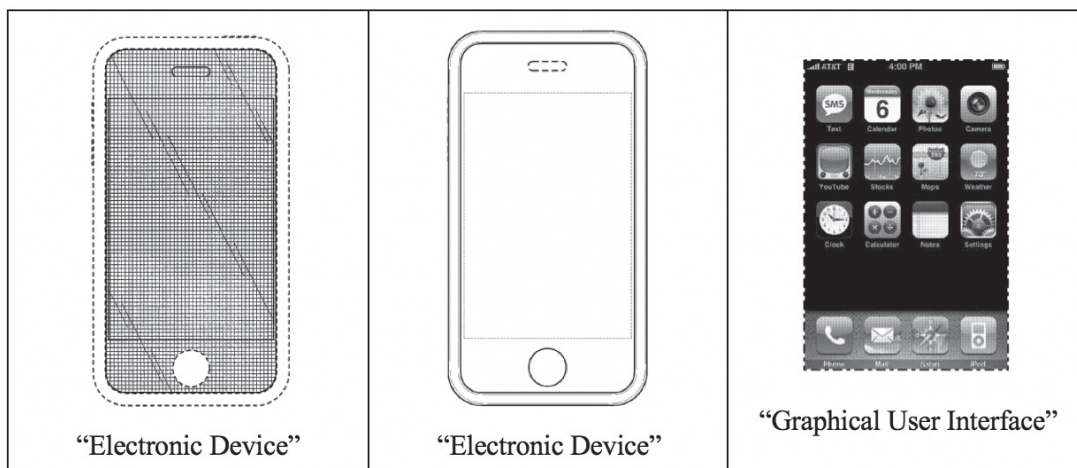


Illustration 2: Figure from Each of Apple's Asserted Design Patents

Judge Koh largely adopted the United States' proposed four-factor test, observing that both parties generally endorsed the United States' test before the Supreme Court, but advocated for different tests on remand.¹⁸ In granting a new trial and ruling on various *Daubert* motions, Judge Koh addressed the parties' arguments about how to identify the article of manufacture.¹⁹

Regarding the first factor, scope of the claimed design, Judge Koh agreed with Apple that the "relevant article of manufacture may extend beyond the scope of the claimed design," though she found that the scope of the design patent must be a consideration even though that "is not alone dispositive."²⁰ Regarding the second factor, relative prominence of the design, Judge Koh observed that the United States identified "two alternative approaches," likening it to the reasonable royalty context where the Federal Circuit has recognized there may be more than one reliable method.²¹ Here, she rejected Samsung's argument that inquiries into this factor "necessarily include a comparison to 'other components unaffected by the design,'" finding instead that "in some scenarios, a design may so dominate the product that comparison to other features of the product would add little value to the inquiry."²² Judge Koh ruled that evidence of "marketing . . . views of the iPhone that featured the patented designs, evidence of and opinions related to the iPhones' 'look and feel,' and evidence that consumers associated the patented designs with iPhones are relevant to the . . . prominence of the design within the

article as a whole."²³ She also found that "evidence of and opinions about copying are relevant" to determining the relative prominence of the design.²⁴

Turning to the third factor, Judge Koh observed that there may be various ways "in which conceptual distinctness can be assessed."²⁵

Finally, in connection with the fourth factor, physical relationship between the patented design and the rest of the product, Judge Koh found that, although it rejected a *per se* rule, the Supreme Court did not prohibit consideration of "how the product is sold" in identifying the article of manufacture.²⁶ Accordingly, she concluded that consideration of this factor may include "whether the design pertains to a component that a user or seller can physically separate from the product as a whole, and whether the design is embodied in a component that is manufactured separately from the rest of the product, or if the component can be sold separately."²⁷

Analyzing the four factors, Judge Koh held that the plaintiff bears the burden of persuasion and the initial burden of production to identify the article of manufacture and total profits.²⁸ Then, "the burden of production shifts to the defendant to come forward with evidence to support any alternative article of manufacture and to prove any deductible expenses."²⁹ She also noted the parties' agreement that determining the relevant article of manufacture under § 289 "is a question of fact that a jury decides when there is a material factual dispute."³⁰

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Judge Koh also found that there was no basis for importing the perspectives of a “designer of ordinary skill in the art” and an “ordinary observer”—used in the validity and infringement contexts—into the article of manufacture inquiry.³¹ However, Judge Koh allowed Apple’s experts to “offer their own perspectives as experts” on the article of manufacture, including “opinions on how a consumer would view and interact with the phones at issue.”³²

NORDOCK, INC. V. SYSTEMS, INC., NO. 11-CV-118 (D. WIS.)

Magistrate Judge Duffin addressed the article of manufacture issue on remand from the Supreme Court and the Federal Circuit in *Nordock, Inc. v. Systems, Inc.*, less than a month after Judge Koh set forth a test in *Apple*.³³ A jury found that Systems infringed Nordock’s asserted design patent titled “Lip and Hinge Plate for a Dock Leveler,” including the claim figure shown below.³⁴

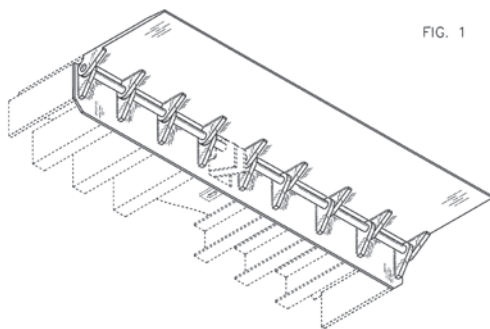


Illustration 3: Figure from Nordock’s Asserted Design Patent

In ruling on the parties’ competing summary judgment motions, Magistrate Judge Duffin found the United States’ four-factor test “appropriate, consistent with the relevant statutory law, and supported by the case law,”³⁵ further noting the four factors may not “always be the *only* factors relevant to determining the article of manufacture.”³⁶ To that end, he identified a fifth factor directed to “how a product is manufactured,” but acknowledged the United States may have intended this to be encompassed within its fourth factor.³⁷ After reviewing the evidence, Judge Duffin determined the issue was a jury question and denied summary judgment.³⁸

Judge Duffin also adopted Judge Koh’s approach to burdens of proof.³⁹ He rejected Nordock’s contention that the article of manufacture analysis “should begin with a presumption that the article of manufacture is the entire product sold by the infringer,” and that a factor-by-factor analysis should apply “only if certain threshold questions indicate that it is appropriate.”⁴⁰

Shortly after Judge Duffin denied Nordock’s request to certify for immediate appeal his article of manufacture decision,⁴¹ the parties settled the case.⁴²

CONCLUSION

The three decisions addressing “article of manufacture” under § 289 following the Supreme Court’s *Samsung* decision have generally followed the United States’ four-factor

test. Nevertheless, with the relevant burdens and evidentiary proofs continuing to be fleshed out, it will be important to continue monitoring this aspect of design patent litigation. ■

- ¹ *Samsung Electronics Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429 (2016).
- ² *Id.* at 436.
- ³ *Id.*
- ⁴ Brief for the United States as Amicus Curiae Supporting Neither Party at 27–29, *Samsung*, No. 15-777 (June 8, 2016).
- ⁵ Jury Instructions at 15–16, 3:17-cv-01781 (S.D. Cal. Sept. 9, 2017), ECF No. 378.
- ⁶ 202 F. Supp. 3d 1186 (D. Or. 2016); U.S. Patent No. D657,093.
- ⁷ Judgment of Validity of U.S. Patent D657,093, 3:17-cv-01781 (S.D. Cal. March 17, 2016), ECF No. 81; 202 F. Supp. 3d 1186 (summary judgment of infringement). Judge Hernandez transferred the Columbia case from the District of Oregon to the Southern District of California, 265 F. Supp. 3d 1196 (D. Or. 2017), but presided over the case through trial, 3:17-cv-01781 (S.D. Cal.), ECF No. 372.
- ⁸ Jury Instructions at 15–16, 3:17-cv-01781 (S.D. Cal.), ECF No. 378.
- ⁹ *Id.*
- ¹⁰ *Id.*
- ¹¹ *Id.* at 15, 17.
- ¹² Jury Verdict at 2, 3:17-cv-01781 (S.D. Cal. Sept. 29, 2017), ECF No. 377.
- ¹³ 3:17-cv-1781, 2018 WL 1805102, at *1 (S.D. Cal. Apr. 17, 2018).
- ¹⁴ *Id.* Section 284 of the Patent Act provides damages for infringement, in no event less than a reasonable royalty.
- ¹⁵ *Id.*
- ¹⁶ No. 11-cv-1846, 2017 WL 4776443 (N.D. Cal. Oct. 22, 2017).
- ¹⁷ *Id.* at *3–4; U.S. Patent Nos. D618,677, D593,087, D604,305.
- ¹⁸ 2017 WL 4776443, at *8, 11–12.
- ¹⁹ See generally *id.*; 2018 WL 1586276 (N.D. Cal. Apr. 2, 2018).
- ²⁰ 2017 WL 4776443, at *10, *12. Judge Koh denied Samsung’s motion to exclude the testimony of Apple’s experts as to the first factor, concluding they did not misapply the law “insofar as they consider unclaimed subject matter in their analysis of the first factor.” 2018 WL 1586276, at *5.
- ²¹ *Id.* at *6.
- ²² *Id.*
- ²³ *Id.* at *12.
- ²⁴ *Id.* at *10.
- ²⁵ *Id.* at *8.
- ²⁶ *Id.* at *9.
- ²⁷ *Id.* at *4; 2017 WL 4776443, at *19.
- ²⁸ 2017 WL 4776443, at *13–15.
- ²⁹ *Id.* at *14–15.
- ³⁰ *Id.* at *7 n.2.
- ³¹ 2018 WL 1586276, at *11–12.
- ³² *Id.* at *12.
- ³³ No. 11-cv-118, 2017 WL 5633114 (E.D. Wis. Nov. 21, 2017).
- ³⁴ *Id.* at *1; U.S. Patent No. D579,754.
- ³⁵ 2017 WL 5633114, at *6.
- ³⁶ *Id.*
- ³⁷ *Id.* at *6–7.
- ³⁸ *Id.* at *8.
- ³⁹ *Id.* at *4.
- ⁴⁰ *Id.*
- ⁴¹ Order, No. 11-cv-0118 (Dec. 19, 2017), ECF No. 277.
- ⁴² Stipulation for Dismissal Pursuant to Rule 41(a), No. 11-cv-0118 (Mar. 30, 2018), ECF No. 286.

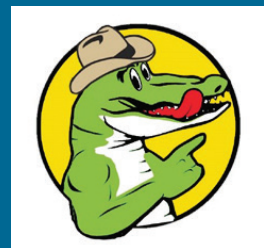
BANNER & WITCOFF ENFORCES BUC-EE’S FAMOUS LOGO WITH JURY VERDICT ON ALL COUNTS

Banner & Witcoff secured a jury verdict for client, Buc-ee’s, against a chain of travel centers in Texas. The 12-person jury returned a unanimous verdict that Buc-ee’s logo is famous and that the Defendants violated the law by using logos that were confusingly similar and likely to cause dilution of Buc-ee’s famous logo. The Houston jury found in favor of Buc-ee’s on all counts, including trademark infringement, trademark dilution, unfair competition, and unjust enrichment. The jury verdict was significant for Buc-ee’s and all famous brands.

Buc-ee’s and its popular Texas travel centers are represented by Joseph J. Berghammer, Janice V. Mitrius, Timothy J. Rechten, Eric J. Hamp, Katie Laatsch Fink, and Kevin Dam of Banner & Witcoff. The case is *Buc-ee’s Ltd. v. Shepherd Retail, Inc., et al.*, case number 4:15-cv-03704, in the U.S. District Court for the Southern District of Texas.



Buc-ee’s Famous Logo



Defendants’ Infringing Logo