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Addressing the Question of How to Determine an Infringer's "Article of Manufacture" under 35 U.S.C. § 289

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Just when it seemed that we might have finally reached the end of the epic battle between Apple and Samsung in what was once called the "patent trial of the century," the District Court for the Northern District of California has set June 1, 2018 as the start date of a five-day trial on the issue of the amount of damages Samsung must pay Apple for infringement of three design patents. In remanding the case to the Court of Appeals for the Federal Circuit, which in turn remanded to the district court, the Supreme Court left open the critical question of how to determine an infringer's "article of manufacture" under 35 U.S.C. § 289 when calculating the total profit to be disgorged by the infringer. The Honorable Judge Lucy Koh found on July 28, that Samsung had preserved the "article of manufacture" issue and initially deferred determination of whether a new trial was warranted until after the Court resolved other outstanding issues, including establishment of a test for identifying the relevant article of manufacture for purposes of § 289. In a hearing five days later, apparently convinced a trial was inevitable, the court set the trial date. The July 28 ruling also requested further briefing that addresses the following issues:

- (1) What is the test for identifying the article of manufacture for purposes of § 289?;
- (2) Is the identification of an article of manufacture a factual question, a legal question, or a mixed question of law and fact? What issues should be decided by a jury? What issues should be decided by the Court?;
- (3) Who bears the burden of proof to identify the relevant article of manufacture for purposes of § 289?;
- (4) Who bears the burden of proof to demonstrate total profits on an article of manufacture for purposes of § 289?;
- (5) Identify the relevant article of manufacture for the D'677 patent, D'087 patent, and D'305 patent;

(6) Identify evidence in the record supporting each party's asserted article of manufacture for the D'677 patent, D'087 patent, and D'305 patent; and

(7) Identify evidence in the record supporting the total profit for each party's asserted article of manufacture for the D'677 patent, D'087 patent, and D'305 patent.

While other district courts are currently considering what the "article of manufacture" means in § 289 and fashioning their own tests, given the high profile nature of this case to date, what the Court does here will no doubt be carefully watched. Many interested third parties are offering their views on factors to be considered in a test and the test itself. I have co-authored the article "Determining the "Article of Manufacture" Under 35 U.S.C. 289" that is posted on SSRN. My co-authors, a small group of design patent specialists, and I propose a test for determining the relevant "article of manufacture" in any given case and suggest considerations for determining the total profit once the relevant article of manufacture has been identified. Read it here: <http://bit.ly/2v2H1tW>

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