289 District Court Litigation

DOJ Test

Determining the relevant article of manufacture entails a case-specific analysis of the relationship among the [patented] design, the product, and any components, and that the fact-finder should identify the article in which the design prominently features and that most fairly may be said to embody the defendant's appropriation of the plaintiff's innovation. The DOJ proposed four relevant considerations:

(1) **The scope of the patented design.**

"… which provides insight into which portions of the underlying product the design is intended to cover."

(2) **The relative prominence of the design within the product as a whole.**

"If the design is a minor component of the product or if the product has many other components unaffected by the design, that fact suggests that the article should be the component embodying the design. Conversely, if the design is a significant attribute of the entire product, affecting the appearance of the product as a whole, that fact might suggest that the article should be the product."

(3) **Whether the design is conceptually distinct from the product as a whole.**

"If the product contains other components that embody conceptually distinct innovations, it may be appropriate to conclude that a component is the relevant article.

(4) The physical relationship between the patented design and the rest of the product.

"If the design pertains to a component that a user or seller can physically separate from the product as a whole, that fact suggests that the design has been applied to the component alone rather than to the complete product."

289 District Court Litigation

TEST	Apple v. Samsung	Nordock v. Systems	Columbia v. Seirus
Plaintiff	U3 4 factors	U2 3 threshold questions	U1 3 threshold questions
Defendant	U4 Commensurate with Claim	DOJ	DOJ

289 District Court Litigation

BURDEN	Apple v. Samsung	Nordock v. Systems	Columbia v. Seirus
Plaintiff	P → D	D	D
Defendant	P	P	P

289 District Court Litigation

Columbia v. Seirus
3:15-cv-00064 (D. Oregon)

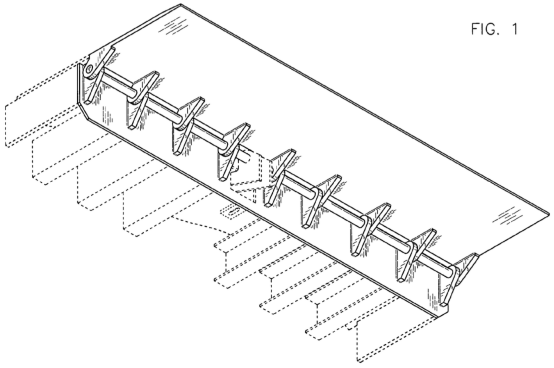
Columbia argues that regardless of test under 289, the same evidence will be presented to the jury to determine a reasonable royalty under 284 as for disgorgement: profits and costs; relationship between fabric and gloves as a whole; evidence about how defendant uses patented design to drive demand for accused products.

Columbia proposes that the jury will determine infringement and validity of the utility patent, a reasonable royalty based on both utility and design patents, and willfulness and that the Court should decide all issues arising under 289 (as an equitable remedy for which there is no 7th amendment right to a jury trial).

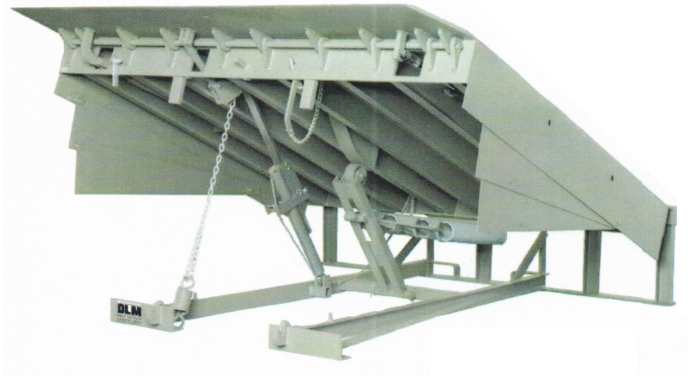
289 District Court Litigation

Nordock v. Systems
11-CV-0118 (E.D. Wisc.)

LIP AND HINGE PLATE FOR A DOCK LEVELER



D579,754



Accused

289 District Court Litigation

Nordock v. Systems
11-CV-0118 (E.D. Wisc.)

Nordock's Test:

- Identifying AOM to which the infringed design has been applied is relatively simple for products that do not perform a broad range of functions
- The article is presumed to be the entire infringing product sold for a profit unless the infringer proves otherwise
- When the presumption is challenged, if the answer to any of 3 threshold questions is yes, a totality of the circumstances test should be preformed

1. Does the patent fail to identify the article of manufacture to which the claimed design is applied by the name generally known and used by the public?
2. Is the patented design applied to a component sold separately from the infringing product as a complete unit?
3. Is the patented design applied to a product with an intended purpose, which also performs a broad range of other functions?

289 District Court Litigation

Nordock v. Systems
11-CV-0118 (E.D. Wisc.)

Nordock's Totality of Circumstances Factors:

1. Does the patent identify the product to which the patented design is applied?
2. Is the accused product sold as a complete product?
3. Is the patented design applied to a portion of the infringing product that is seen together with other portions/components when offered for sale?
4. Do defendant's brochures prominently display the patented design
5. Is the portion of the product to which the patented design is applied necessary to perform the intended purpose of the product?
6. Is the patented design applied to a product that has an intended purpose which also performs a broad range of other functions?
7. Did defendant sell the patented design separately from the accused product?

289 District Court Litigation

Nordock v. Systems
11-CV-0118 (E.D. Wisc.)

Nordock's Totality of Circumstances Factors:

8. Do the cited references indicate that the design is applied to the accused product? (51 of 53 cited reference show entire dock leveler.)
9. Is the design patent a continuing application of a utility patent disclosing and claiming the accused product?
10. Would a designer need to consider the look of the entire product to design the patented design?
11. Was defendant aware of the patented design?
12. Can total profit on the accused product be calculated from defendant's accounting records?
13. Can profit on the patented portion be determined from defendant's accounting records?

289 District Court Litigation

Nordock v. Systems
11-CV-0118 (E.D. Wisc.)

Systems' Application of DOJ Test:

Fair reading of the title / claim (Lip and hinge plate for a dock leveler) indicates that the design is applied to the lip and hinge plate, not an entire dock leveler.

TITLE IDENTIFIES SUBCOMPONENT

Lip and hinge plate are separately identifiable components that are intended for a dock leveler and do not constitute the entire dock leveler itself.

An entire dock leveler is not shown in the patent, and the small portion shown in broken lines is expressly disclaimed.

The claimed design is not prominent in the dock leveler as a whole.

289 District Court Litigation

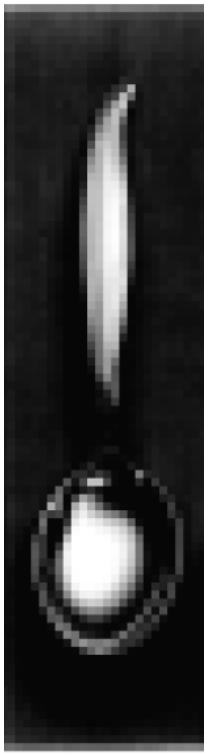
Nordock v. Systems
11-cv-0118 (E.D. Wisc.)

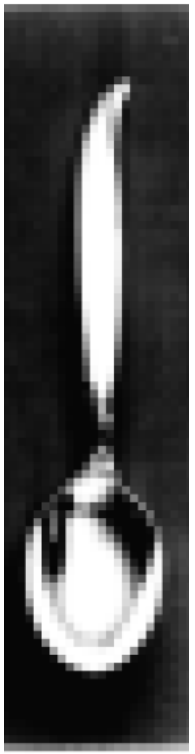
Case	Design Patent Title	Design Patent Covers	Product for which profit was	Year
Nike	Shoe Upper	Upper portion of Shoe	Entire shoe	1998
Victor Stanley	End Frame for Bench	End frame portions of bench	Entire bench	2011
Fisher-Price	Children's Play Space	Upper portion of play bassinet	Entire play bassinet	2003
John O. Butler	Holder for Interproximal Brushes	Handle for dental cleaning	Entire dental brush	1985
Untermeyer	Watch Case	Watch case	Entire watch	1893

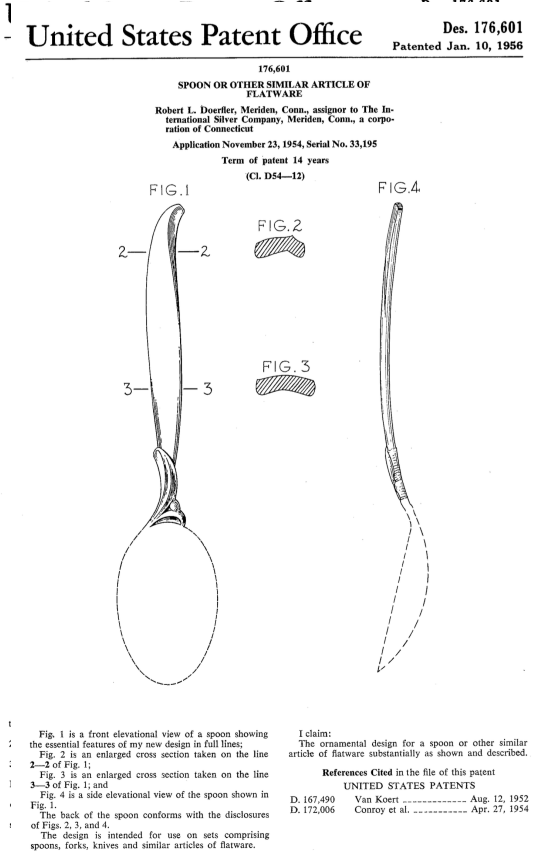
289 District Court Litigation

International Silver Co. v. Julie Pomerantz, Inc.
271 F.2d 69 (2nd Cir. 1959)

SPOON OR OTHER SIMILAR ARTICLE OF FLATWARE







United States Patent Office — Des. 176,601 — Patented Jan. 10, 1956

176,601

SPOON OR OTHER SIMILAR ARTICLE OF FLATWARE

Robert L. Doerfler, Meriden, Conn., assignor to The International Silver Company, Meriden, Conn., a corporation of Connecticut

Application November 23, 1954, Serial No. 33,195

Term of patent 14 years

(Cl. D54—12)

FIG. 1 FIG. 2 FIG. 3 FIG. 4

Fig. 1 is a front elevational view of a spoon showing the essential features of my new design in full lines;

Fig. 2 is an enlarged cross section taken on the line 2—2 of Fig. 1;

Fig. 3 is an enlarged cross section taken on the line 3—3 of Fig. 1; and

Fig. 4 is a side elevational view of the spoon shown in Fig. 1.

The back of the spoon conforms with the disclosures of Figs. 2, 3, and 4.

The design is intended for use on sets comprising spoons, forks, knives and similar articles of flatware.

I claim:

The ornamental design for a spoon or other similar article of flatware substantially as shown and described.

References Cited in the file of this patent

UNITED STATES PATENTS

D. 167,490	Van Koert	Aug. 12, 1952
D. 172,006	Conroy et al.	Apr. 27, 1954

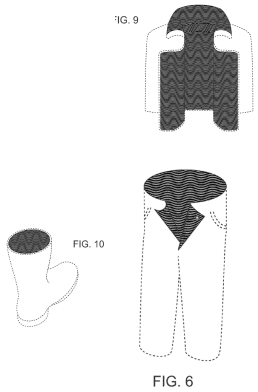
Accused

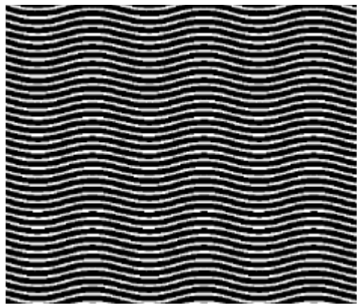
Patented

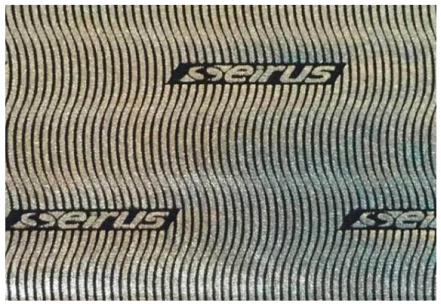
289 District Court Litigation

Columbia v. Seirus
3:15-cv-00064 (D. Oregon)

HEAT REFLECTIVE MATERIAL







D657,093

Accused

289 District Court Litigation

Columbia v. Seirus
3:15-cv-00064 (D. Oregon)

Columbia's Test: where the infringing product bearing the patented design as sold to the consumer is the relevant article of manufacture if any one of the conditions is met:

(1) The product is a single component product; or

(2) The product is a multicomponent product and the patented design is applied to all or a material part of all of the components; or

(3) The product is a multicomponent product and the component or components to which the patented design is applied creates the basis for the consumer's demand for the product, or substantially creates the value of the other component parts of the product.

If one of these conditions is not met, the relevant article of manufacture for calculating disgorgement of profits is the portion of the product to which the design has been applied.

289 District Court Litigation

Apple v. Samsung
5:11-cv-01846 (N.D. Cal.)

Apple's 4 Factor Test:

1. How the defendant sells its infringing product and accounts for its profits on those sales, including whether the defendant typically sells its asserted article of manufacture as part of a unified product or separately;

2. The visual contribution of the patented design to the product as a whole, including whether the claimed design gives distinctive appearance to the product as a whole or only to the asserted article of manufacture;

3. The degree to which the asserted article of manufacture is physically and conceptually distinct form the product as sold;

4. The defendant's reason from appropriating the patented design, including whether the defendant did so in an effort to replicate a product as a whole.

289 District Court Litigation

Apple v. Samsung
5:11-cv-01846 (N.D. Cal.)

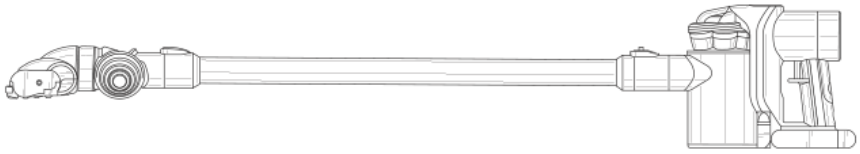
Samsung's Test:

The relevant article of manufacture is the specific part, portion or component of a product to which the patented design is applied. The article is identified by comparing the claimed attributes of the design patent to the accused product to identify the specific part, portion, or component of the product that corresponds to the patent's claim. The relevant article of manufacture does not include any part, portion, or component of a product that is disclaimed by the patent or that does not correspond to the claimed attributes of the patented design, including any part, portion, or component of a product that is not considered when determining infringement.

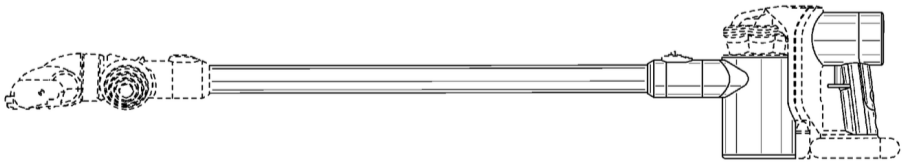
PATENTEE'S OTHER PATENTS

289 District Court Litigation

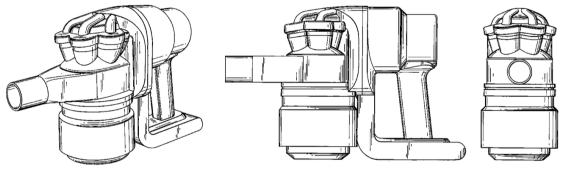
Dyson v. Shark Ninja
1:14-cv-000779 (N.D. Ill.)



D668,010 - VACUUM CLEANER



D668,823 - VACUUM CLEANER



D577,163 - CLEANING APPLIANCE

Accused

289 District Court Litigation

Saidman, Ferrill, Neagle & Durkin, 99 JPTOS 349 (2017)

The fact-finder shall determine the relevant article of manufacture for a given case in light of the following factors:

1. The visual contribution made by the patented design to the overall appearance of the end product sold by the infringer, in the eye of the ordinary observer;
2. Whether at the time of the infringement, the patentee or infringer separately sold its preferred articles of manufacture;
3. The intent of the infringer in appropriating the patented design; and
4. The degree of difficulty in calculating total profit of the proffered articles of manufacture.