# How Design Patent Law Lost Its Shape

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Under U.S. law, patents are available for “any new, original and ornamental design for an article of manufacture.”1 Today, the U.S. Patent and Trademark Office (USPTO) allows applicants to claim any “visual characteristic[] embodied in or applied to an article” as a separate “design.”2 The foundation of this “anything goes” regime is a 1980 decision from the U.S. Court of Customs & Patent Appeals (CCPA), In re Zahn.3

Although design patent practitioners recognize Zahn as a “major change in [the] law,”4 the decision has received little attention in the

3 In re Zahn, 617 F.2d 261, 268 (C.C.P.A. 1980).
academic literature. When it does get mentioned in the literature, Zahn is often cited with approval or treated as if it were no big deal. A reader might be left with the impression that Zahn provides a strong, unassailable foundation for contemporary design patent law and practice. But in reality, Zahn is a flawed decision built on poor logic, mis-framed issues, and ipse dixit.

While other recent scholarship has discussed some of the problems with the contemporary uses of dotted-line claiming in design patents,
none has deeply analyzed or critiqued the underlying bases of those claiming practices.

This Article is the first to closely and critically analyze the CCPA’s majority decision in In re Zahn. This examination reveals that Zahn’s interpretation of the key statutory phase, “design for an article of manufacture,” is unsupported and contrary to the plain text of the statute. The Zahn majority wrought major changes in U.S. design patent law without acknowledging they were doing so.

This Article proceeds in five Parts. Part I provides a brief background on U.S. design patent law. In order to elucidate and explain some of the changes wrought by Zahn, Part II introduces a new taxonomy for use in discussions of “parts” or “portions” of “articles” or “products.” It argues that we should distinguish between:

- A simple article – an article that is manufactured as one solid piece;
- A composite article – an article that is made from physically joining together one or more smaller articles;
- A component – an article that is joined with one or more others to form a composite article;
- An end product – a composite article (or machine) that is sold separately as a complete product; and
- A fragment – any physical part of an article that is not, and was not manufactured as, a complete article.

Part III traces the litigation history and critically evaluates the CCPA’s decision in Zahn. Part IV discusses some of the important implications of the Zahn rule on design patent law. Part V argues that the majority’s decision in Zahn was flawed and contrary to the plain text of 35 U.S.C. § 171. It concludes that Zahn should be overruled and the

design the plaintiff actually implemented rather than the idealized one drawn by her lawyers. Doing so would require more similarity between the plaintiff’s design and the defendant’s product before the plaintiff could prove infringement.

* Compare Zahn, 617 F.2d at 267, with 35 U.S.C. § 171.
* See infra Part II. This Article is the first in an anticipated series of papers on the topic of design patentable subject matter. In future work, I plan to set forth my own detailed proposal for how courts should interpret the phrase “design for an article of manufacture” and, in particular, explain what a regime that only protects “whole designs” might look like.
phrase "design for an article of manufacture" should be given its plain English meaning.

I. BACKGROUND

A. Sources of Design Patent Law

The U.S. Constitution gives Congress the power—but does not require it—to issue patents.10 Congress has used this power to enact various patent statutes over the years; the most recent major enactment was the Patent Act of 1952.11 The Patent Act, as amended, still governs U.S. patent law today.

The Patent Act provides for three different types of patents—utility patents, plant patents, and design patents.12 To obtain a patent, an applicant must file an application with the USPTO.13 A patent will be issued only following substantive examination.14 The USPTO does not, however, have “robust substantive rule-making authority and receives no

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10 See U.S. CONST. art. 1, § 8, cl. 8.
12 See 35 U.S.C. §§ 101, 161, 171; see also MPEP, supra note 2, § 201 (listing the three types). Because § 161 and § 171 refer to “patents for plants” and “patents for designs,” respectively, and § 101 refers only to “patent[s],” some people have wondered if § 101 applies to all patents. See generally Sarah Burstein, Does § 101 Apply to Design Patents?, PATENTLYO (Apr. 24, 2019), https://patentlyo.com/patent/2019/04/%C2%A7-design-patents.html [https://perma.cc/98YC-8AVS]. It does not. See In re Finch, 535 F.2d 70, 71 (C.C.P.A. 1976). It appears that the only reason § 101 still refers to “patent[s]” and not “patents for useful inventions” or “utility patents” is merely a matter of legislative inertia; the language of the utility patent statutory subject matter provision hasn’t changed much since 1790, when utility patents were the only type of patents. Sarah Burstein, The “Article of Manufacture” in 1887, 32 BERKELEY TECH. L.J. 1, 27 (2017) [hereinafter Burstein, The "Article of Manufacture" in 1887] (tracing the history of this statutory language). Design patents were added in 1842 and plant patents in 1930. Id. at 32 (“Congress enacted the first U.S. design patent act in 1842.” (citing Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44)); 8 DONALD S. CHISUM, CHISUM ON PATENTS § 24.02 (2019) (“In 1930, Congress provided for the first time for the issuance of patents on plants.” (citing Act of May 23, 1930, ch. 312, 46 Stat. 376)).
13 See 35 U.S.C. § 131 (2012) (“The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.”).
14 Id.
judicial deference for its legal interpretations of the Patent Act.”\textsuperscript{15} Accordingly, “[a] district court is not bound by the practices of the Patent and Trademark Office. Decisions of the Commissioner are not binding on the federal courts . . . .”\textsuperscript{16} Indeed, “the Commissioner is not bound by his own prior decisions.”\textsuperscript{17} And, importantly, “[t]he issuance of a patent does not have any significant precedential value.”\textsuperscript{18}

Thus, “the most important expositor of the substantive law of patents in the United States” may be the U.S. Court of Appeals for the Federal Circuit (Federal Circuit).\textsuperscript{19} The Federal Circuit has exclusive appellate jurisdiction over Patent Office appeals and over cases involving

\begin{footnotes}


\footnote{\textsuperscript{17} Id. (citing Eli Lilly & Co. v. Brenner, 248 F. Supp. 402, 147 (D.D.C. 1965), judgment rev’d on other grounds, 375 F.2d 599 (D.C. Cir. 1967)).}

\footnote{\textsuperscript{18} Id. (citing Ex Parte Donoghue, 26 U.S.P.Q.2d (BNA) 1266, 1269, 1992 WL 470728 (B.P.A.I. 1992)); see also Ex Parte Donoghue, 26 U.S.P.Q.2d 1266, 1266 (B.P.A.I. 1992) (“To the extent any error has been made in the rejection or issuance of claims in a particular application, PTO and its examiners are not bound to repeat that error in subsequent applications.” (first citing In re Cooper, 254 F.2d 611, 617 (C.C.P.A. 1958); and then citing In re Zahn, 617 F.2d 261, 267 (C.C.P.A 1980))); Iver P. Cooper, Biotechnology and the Law § 1:8 (June 2019 update) (“The Patent Office has steadfastly refused to regard issued patents as ‘decisions’ with precedential value.” (first citing, inter alia, In re Fischer, 47 F.2d 794 (C.C.P.A. 1931); and then citing In re Rutledge, 47 F.2d 797 (C.C.P.A. 1931))).}

\footnote{\textsuperscript{19} See Wasserman, supra note 15, at 1962–63 (stating that, because the USPTO “receives no judicial deference,” the Federal Circuit is largely perceived to be “the most important expositor of the substantive law of patents in the United States” (quoting Michael J. Burstein, Rules for Patents, 52 WM. & MARY L. REV. 1747, 1757 (2011))); see also Sarah Tran, Patent Powers, 25 HARV. J.L. & TECH. 609, 611 (2012) (“Over the years, the Federal Circuit has assumed primary responsibility for interpreting the Patent Act and crafted limitations on the USPTO’s authority that have limited the Agency to a rubberstamping, ministerial role rather than a policy-setting or substantive rulemaking role.” (first citing Koninklijke Philips Elecns. N.V. v. Cardiac Sci., 590 F.3d 1326, 1336 (Fed. Cir. 2010); then citing Tafas v. Doll, 559 F.3d 1345, 1352 (Fed. Cir. 2009), reh’g en banc granted, 328 F. App’x 658 (Fed. Cir. 2009), appeal dismissed, 586 F.3d 1369, 1371 (Fed. Cir. 2009); then citing Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336 (Fed. Cir. 2008); and then citing Merck & Co. v. Kessler, 80 F.3d 1543, 1549–50 (Fed. Cir. 1996))).}
patent claims.20 Prior to the Federal Circuit’s creation in 1982,21 Patent Office appeals went to the CCPA or the U.S. Court of Appeals for the District of Columbia Circuit.22 In its first decision, the Federal Circuit adopted the holdings of the CCPA as its own precedent.23 Thus, unless overruled by the en banc Federal Circuit, those holdings remain binding authority to this day.

B. Design Patentable Subject Matter

U.S. design patents are available for “any new, original and ornamental design for an article of manufacture.”24 The words “new” and “original” have not been given independent significance in the case law.25 Thus, to satisfy the statutory requirements, an application must claim an: (1) “ornamental;” (2) “design;” (3) “for an article of manufacture.”

1. “Ornamental”

The Federal Circuit will deem a design “ornamental” unless “(1) there are no alternative designs with the same or similar functional

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22 Sean B. Seymore, The Presumption of Patentability, 97 MINN. L. REV. 990, 1005 n.100 (2013) (“Beginning in 1927, an applicant whose claims had been rejected by the examiner could appeal to an intraoffice tribunal known as the Board of Appeals. The U.S. Court of Appeals for the District of Columbia Circuit exercised exclusive jurisdiction over ex parte appeals from the Patent Office until 1929. At that time, jurisdiction was transferred to the C.C.P.A. Alternatively, a disgruntled applicant who wanted to introduce additional evidence could file a civil action with the U.S. District Court for the District of Columbia.”) (citations omitted). “[D]ecisions of the Court of Customs & Patent Appeals were not considered by the District Court for the District of Columbia to be binding on it or on the Court of Appeals for the District of Columbia Circuit in proceedings under 35 U.S.C.A. § 145 or 35 U.S.C.A. § 14637 and vice versa . . . .” GLADSTONE MILLS III ET AL., supra note 16.
23 South Corp. v. United States, 690 F.2d 1368, 1369 (Fed. Cir. 1982).
24 35 U.S.C. § 171(a) (Supp. I 2013). In 2013, § 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), as amended by Pub. L. No. 112-211, 126 Stat. 1527, 1535 (2012).
capabilities; or (2) the design is concealed during the entire lifetime of the completed product.”26 Because these conditions are rarely satisfied, this requirement does not currently pose a serious obstacle to patentability—no matter how “functional” a design might seem in the normal English sense of that word.27

2. “Article of Manufacture”

A patentable design must be “for an article of manufacture.”28 The USPTO requires that an applicant “identif[y] the article in which the design is embodied” in both the title and verbal portion of the claim.29 But it instructs examiners to “afford the applicant substantial latitude in the language of the title/claim.”30 And although the statutory language appears, on its face, to indicate that the design must be directed to a single article, the USPTO has interpreted the phrase “for an article of manufacture” in § 171 to cover designs that “encompass multiple articles or multiple parts within that article.”31

3. “Design”

As to what constitutes a protectable “design,” it has long been held that applicants can claim three types of “designs:” (1) designs for “surface ornamentation applied to an article;” (2) designs for “the configuration or shape of an article;” or (3) a combination of both.32 As to the first type, the USPTO interprets this category as including not just surface

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26 Id. at 7 (internal quotation marks omitted); see also Sarah Burstein, Faux Amis in Design Law, 105 TRADEMARK REP. 1455, 1456–57 (2015) [hereinafter Burstein, Faux Amis] (referring to cases including Ethicon Endo-Surgery, Inc. v. Covidien, Inc., 796 F.3d 1312, 1331 (Fed. Cir. 2015), and In re Webb, 916 F.2d 1553, 1557 (Fed. Cir. 1990)).


28 35 U.S.C. § 171(a). For more on the meaning of this statutory phrase, see infra Part II.

29 MPEP, supra note 2, § 1503.01(I).

30 Id.

31 Id. § 1504.01(b) (citing Ex parte Gibson, 20 U.S.P.Q. 249 (Pat. Off. Bd. App. 1933)).

32 Burstein, The “Article of Manufacture” in 1887, supra note 12, at 8 (internal quotation marks omitted).
ornamentation but also “any indicia, contrasting color or materials, graphic representations, . . . applied to the article,” a category of designs the USPTO refers to as “surface treatment.”33 As to the second type, the terms “configuration” and “shape” are generally used as synonyms in U.S. design law.34 Therefore, they will be used as synonyms here.35

C. Design Patent Infringement

The current test for design patent infringement provides that 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.” In this context, “the patented design” means “the claimed design”:

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. If the relevant portion looks “the same,” in light of the prior art, the patent is infringed.37

Although the cases sometimes use the phrase “substantially similar” in discussing design patent infringement, which sounds a bit like the “substantial similarity” test used for copyright infringement, the two tests are not the same. In design patents, “the proper inquiry” is “whether the accused design has appropriated the claimed design as a whole.”40 In other words, there is no doctrine of “fragmented literal similarity” in design patent law. Accordingly, the question of what can be claimed as a separate “whole” is very important.42

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36 Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 672 (Fed. Cir. 2008) (en banc) (indicating that this test should involve a comparison between “the claimed and accused designs” (emphasis added)).


38 See, e.g., Int’l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1243 (Fed. Cir. 2009) (“Because we cannot say that these differences are insignificant as a matter of law, a genuine issue of material fact exists as to whether the designs would be viewed as substantially similar in the eyes of the ordinary observer armed with the knowledge of the prior art.”).

39 See, e.g., Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., 602 F.3d 57, 63 (2d Cir. 2010) (“In order to establish a claim of copyright infringement, a plaintiff with a valid copyright must demonstrate that: (1) the defendant has actually copied the plaintiff’s work; and (2) the copying is illegal because a substantial similarity exists between the defendant’s work and the protectible elements of plaintiff’s.”) (internal quotation marks omitted).

40 Egyptian Goddess, 543 F.3d at 677.

41 Cf. Olufunmilayo B. Arewa, From J.C. Bach to Hip Hop: Musical Borrowing, Copyright and Cultural Context, 84 N.C. L. REV. 547, 570 (2006) (noting that, in copyright law, “[f]ragmented literal similarity is the test of substantial similarity in cases where only a portion of a work is copied, without copying of the work’s overall essence or structure”).

42 Sarah Burstein, Intelligent Design & Egyptian Goddess: A Response to Professors Buccafusco, Lemley & Masur, 68 DUKE L.J. ONLINE 94, 117 (2019) [hereinafter Burstein, Intelligent Design & Egyptian Goddess] (”[A] design patent protects the visual appearance of the claimed design as a whole. So the question of what can be claimed as a separate ‘whole’ is really
D. Design Patent Claiming

As noted above, the current test for design patent infringement compares the accused product to whatever is claimed in the patent. Today, a design patent applicant can claim basically any “visual characteristics embodied in or applied to an article” as a separate “design.”43 The claim covers whatever is shown in solid lines in the design patent drawings.44 If photographs are used, the claim covers whatever is shown in the photographs.45 Broken lines can be used to disclaim portions of a design, to illustrate “the environment in which the design is associated,” or “to define the bounds of a claimed design . . . when a boundary does not exist in reality in the article embodying the design.”46 In the latter case, “the claimed design extends to the boundary but does not include the boundary.”47

II. ARTICLES & PORTIONS THEREOF

In Zahn, the court and parties discuss the relevant issues in terms of “parts” or “portions” of “articles.”48 To understand the issues raised in
and by Zahn, as well as the historical precedents, it is helpful to first clarify what we mean by “article” as well as to distinguish between potentially relevant types of “parts” or “portions” thereof.

As used in Zahn, the word “article” is used as a shorthand for the statutory phrase “article of manufacture.”49 This Article will do so as well, unless otherwise specified. “Article of manufacture” is a term of art in patent law. Historically, 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.50 To aid the discussion here, this Article will adopt that historical definition, with the caveat that designs for machines are currently considered to be design-patentable subject matter.51 Whether one believes that designs for machines are (or should be considered) articles of manufacture, the basic concept—that an article is something made by humans in a single articles having been regularly patented where the designs have been so described.”) (emphasis added); see also, e.g., Appellant’s Brief at 1, No. 79-560, In re Zahn (Fed. Cir. July 13, 1979) (framing the discussion in terms of “portion[s] of the article”); Brief for the Comm’r of Patents and Trademarks at 2, No. 79-560, In re Zahn (Fed. Cir. Aug. 9, 1979) (same).

v See, e.g., Zahn, 617 F.2d at 267 (using “article” and “article of manufacture” interchangeably).

vi See Burstein, The “Article of Manufacture” in 1887, supra note 12, at 5. Notably, though, the person to whom the product was (or could be) sold did not have to be the end user—it could be another manufacturer or artisan. See id. at 65 (“[I]n 1887, an article of manufacture had to be a ‘product’ in the sense it had to be complete enough to be sold to someone. But that ‘someone’ did not have to be the ultimate or end consumer. It could be another manufacturer or artisan.”) (internal citations omitted).

vii This change can be traced back to the CCPA’s decision in In re Koehring, 37 F.2d 421, 424 (C.C.P.A. 1930) (ruling that a design for a “truck body and frame” was “a proper subject-matter for a design patent,” despite prior Patent Office decisions that read the statute to exclude designs for machines). However, “the reasoning in Koehring was quite thin and did not address [an important] expressio unius issue.” Burstein, The “Article of Manufacture” in 1887, supra note 12, at 77 n.460; see also id. at 63 n.374 (noting that, in Koehring, the CCPA based “its decision mainly on policy grounds and on a rejection of the Patent Office’s ‘moving parts’ reasoning”). Prior to that, the Patent Office would issue design patents for designs for machine parts but not for designs for machines qua machines. Id. at 62–63 (“[T]he Patent Office repeatedly stated that designs for machines did not constitute proper statutory subject matter. However, the Patent Office allowed design patents for parts of machines if those parts otherwise qualified as articles of manufacture.”) (footnote omitted). For an argument that courts should readopt the historical definition of “article of manufacture,” including the exclusion of designs for machines, see Sarah Burstein, The “Article of Manufacture” Today, 31 HARV. J.L. & TECH. 781 (2018) [hereinafter Burstein, The “Article of Manufacture” Today].
physical unit that is complete enough that it could be used or sold separately—is still helpful, and may be essential to understanding the legal context in which older design patents were issued and older design patent decisions were made. This definition also appears to be consistent with the position taken by the Patent Office in Zahn and may, therefore, be helpful in understanding the arguments made in that case.

Defined this way, an “article” can be distinguished from a “product.” This Article will use the word “product” to mean “something sold by an enterprise to its customers.” Under this definition, all articles are (or can be) products, but not all products are articles. An article may be a simple article, consisting of a single article manufactured as one solid piece, or it may be a composite article, one that is made from physically joining together one or more smaller articles. Those smaller articles will be

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52 It is also worth noting that this definition is also not inconsistent with the definitions of “article of manufacture” put forth by the CCPA and the Supreme Court in Hruby and Samsung, respectively. In Hruby, the CCPA suggested that anything “made by man” would qualify as an “article of manufacture” under § 171. See In re Hruby, 373 F.2d 997, 1000 (C.C.P.A. 1967). In Samsung, the Supreme Court ruled that, as used in 35 U.S.C. § 289, “[a]n article of manufacture . . . is simply a thing made by hand or machine.” Samsung Elecs. Co. v. Apple Inc., 137 S. Ct. 429, 435 (2016). Both of those cases leave open the question of what the thing made by “man” or by “hand or machine” is. See generally Michael J. Madison, Law As Design: Objects, Concepts, and Digital Things, 56 CASE W. RES. L. REV. 381 (2005) (exploring the concept of “things” in the law). Thus, while some might argue that the Hruby or Samsung definitions are broad enough to include fragments (as I define them below) as “articles,” neither of them has to be read that way—nor should they be. Additionally, while the definitions adopted in Hruby and Samsung may appear, on their faces, to be broad enough to include machines, the machine issue was not before either court. And while the Hruby court was bound by the CCPA’s precedent in Koehring, the Supreme Court, of course, was not.

53 See Brief for the Comm’r of Patents and Trademarks at 6, No. 79-560, In re Zahn (Fed. Cir. Aug. 9, 1979) (“Since the shank portion of the tool is not manufactured and sold as a separate article of manufacture, it is not an article of manufacture.”) (internal citation omitted). The “machine” issue was not before the USPTO or the court. See infra Section III.B.1 (describing the claim in Zahn).


55 See Sarah Burstain, The Patented Design, 83 TENN. L. REV. 161, 208 (2015) (“For example, naturally-occurring items such as berries could be sold as a ‘product’ but they would not fall under any reasonable interpretation of the statutory phrase ‘article of manufacture.’ And multiple articles of manufacture can be sold as a single product—for example, a set of flatware containing a spoon, a knife, and a fork.”).
referred to here as components.\textsuperscript{56} An \textit{end product} is a composite article (or machine) that is sold separately as a complete product.\textsuperscript{57} So, for example, a chair could be a composite article made up of several separately-manufactured components.\textsuperscript{58} If sold on its own, the chair would also be an end product.

It is also helpful to distinguish whole articles from fragments thereof. As used here, a \textit{fragment} is a physical part of an article that is less than a complete article.\textsuperscript{59} It is a portion that is not designed to be (or generally capable of being) used or sold as a physically-separate piece.\textsuperscript{60} The key

\begin{itemize}
  \item To be clear, this definition of component would only apply to items that independently satisfy the definition of an "article"—not to anything that might be deemed a "component" in contemporary, everyday English. \textit{See generally} Burstein, \textit{The "Article of Manufacture" in 1887}, \textit{supra} note 12, at 68–69 ("Today, we might describe the pile yarn as a 'component' of a carpet. Or we might consider the 'front' of a carpet and its 'backing' as separate components. We might even describe color or the type of fibers used as 'components' of a particular carpet. Of these things, the only ones that might have qualified as being 'articles of manufacture' in 1887 were the yarn and the backing fabric.") (footnotes omitted). I have argued before that "the word 'component' itself is not particularly helpful in answering any of the questions raised by the Court in \textit{Samsung}," especially because of the confusion it might cause with judges and juries. Burstein, \textit{The "Article of Manufacture" Today}, \textit{supra} note 51, at 833 n.290. But it may still be helpful to this discussion of statutory subject matter. And if "component" is used in the \$ 289 context, the same definition should be used there. \textit{See id.} ("The best way to read \textit{Samsung} is to assume that, where the Court said 'component,' it was referring to an 'article of manufacture' that is incorporated into a larger product.").
  \item A composite article may itself be a component of a larger article.
  \item \textit{See generally} Burstein, \textit{The "Article of Manufacture" in 1887}, \textit{supra} note 12, at 81–82 (discussing the construction of chair-backs and chairs and how that fits with the historical definition of "article of manufacture"). And by "separately manufactured," I mean manufactured in separate physical pieces, not necessarily manufactured by separate people or in separate locations.
  \item By this definition, many product surfaces would qualify as fragments of their respective products. Some people may take this to mean that designs for the shapes of fragments are analogous \textit{(or even the same as)} the historical category of surface ornamentation designs. While a full discussion of that issue is beyond the scope of this Article, it's worth noting that shape-fragment designs and surface ornamentation designs raise very different policy issues and should not be lumped together without considering the theoretical and practical differences.
  \item That's not to say that fragments of articles can never be sold or used separately. For example, some vendors sell broken tile pieces for use in crafting. In that situation, the fragments become the products. But the actual shapes of those fragments were not "designed" by the tile maker—and perhaps by no one \textit{(if, for example, the pieces are broken by randomly striking at the tiles with a hammer)}. \textit{Cf.} MPEP, \textit{supra} note 2, \$ 1502 (stating that a design "must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method"); In \textit{re Stirling}, 47 F.2d 809, 810 (C.C.P.A. 1931) (finding no "invention" in a surface design that was
difference between a fragment and a component is physical separateness in manufacturing.61 In other words, an article may (or may not be) composed of other articles. But not all article “parts” or “portions” are, themselves, “articles of manufacture.”62

For example, a chair-back might be carved out of a single piece of wood and exist, at least for a time, as a separate article.63 Therefore, it qualifies as a component. Any physical part of that chair-back that did not exist separately during the carving process—for example, one of the corners—would be a fragment, but not a component. It wouldn’t exist as a physically separate piece while the chair is being manufactured (or assembled) and wouldn’t exist as a physically separate piece at all, but for some post-manufacture intervention—such as the application of a machine saw to the chair-back.

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61 This may strike some readers as an arbitrary distinction. However, it is important in light of the historical definition of “article of manufacture.” See Burstein, The “Article of Manufacture” in 1887, supra note 12, at 63. It may also be relevant to issues such as public notice and written description, though a full discussion of those issues is beyond the scope of this Article.

62 It is true that some commentators have read Zahn as redefining the phrase “article of manufacture” to include (what this Article calls) fragments. See infra note 274 and accompanying text.

63 See Burstein, The “Article of Manufacture” in 1887, supra note 12, at 81–82 (“In the nineteenth century, chair backs were often manufactured separately. Thus, they could have been sold separately to other manufacturers.”) (footnote omitted).
Another example would be the ear of this chocolate Easter bunny:\(^6^4\)

![Fig. 1](image)

It appears that this confection would have been molded in a single piece. If that’s correct, then the bunny itself would be a simple article. The ear would be a fragment, not a component, because it would not have existed as a physically separate piece during the manufacturing process. Of course, someone could bite or break the ear off later. But the question is not whether the part can (or even is intended to be) physically separated post-manufacture; the question is how it is manufactured.\(^6^5\)


\(^6^5\) Some might question whether, as a policy matter, it makes sense to draw any distinctions at all based on how a product or article is manufactured, since design patents protect how things look, not how they’re made. See Gorham Co. v. White, 81 U.S. 511, 525 (1871) ("As the acts of Congress embrace only designs applied, or to be applied, they must refer to finished products of invention rather than to the process of finishing them, or to the agencies by which they are developed."). While a full discussion of whether the “article of manufacture” is a good base unit for a design-protection regime is beyond the scope of this Article, the issue of what qualifies as an "article of manufacture" is inextricably tied to the question of what is a "design for an article of manufacture." See 35 U.S.C. § 171(a) (Supp. I 2013). The point for now is that not all "parts" or "portions" of articles of manufacture are, themselves, "articles of manufacture"—or, at least, should not be considered as such.
III.  *In re Zahn* (1980)

A.  The Precedents

In *Zahn*, the parties and the court discuss two prior decisions, *Ex parte Northup* and *In re Blum*. This Section will briefly review those decisions in order to better contextualize the arguments and to provide insight into the court’s decision in *Zahn*.


In *Northup*, the applicant attempted to claim a design for just the “forward corner of an automobile body.” From the Board’s description, it appears this claim was directed to a fragment (the corner) of an article (the automobile body). The examiner rejected the claim because it did not “cover a complete article of manufacture” and the Board affirmed the examiner’s decision. The Board noted that “[t]he front corner of the automobile body is never manufactured and sold as a separate article of manufacture” and stated that “[i]n considering a design[,] the appearance of the entire article must be taken into consideration.”

The applicant tried to amend his application by adding a Figure 4, which showed “a body similar to that shown in applicant’s copending application, Serial No. 42,895” and by stating that the application was a division of a copending application that had already been allowed. Those amendments did not, in the Board’s opinion, cure the deficiency because the applicant’s claim was still directed at just the shape of the corner.
According to the Board, “a claim in a design patent covers all and nothing more than what is disclosed in the drawing” and “[i]n considering a design the appearance of the entire article must be taken into consideration.”73 Thus, the drawing had to disclose the appearance of a complete article.74 The court noted that even if the same corner shape was used, the overall appearance of an automobile body could still vary greatly:

Applicant urges that he is here attempting to claim that portion of the article which he has modified and that the body except for the modified front corner may be of any conventional shape. It is apparent, however, that the rounded front corner of the application might have a materially different effect when incorporated in one old configuration of body from what it would have when incorporated in another old configuration of body. . . . The rounded front corner when taken in connection with a rounded rear corner as shown in the added view of Fig. 4 may well have a more pronounced effect than it would have if incorporated in a sedan body of the old square cornered type. In other words, in the complete design the configuration of the rounded corner to a greater or less extent blends and harmonizes with the configurations of the other portions of the body. Therefore, applicant does not have the same design when his front corner is incorporated in a body of one configuration as when it is incorporated in a body of another configuration.75

The Board recognized that the applicant was really trying to claim multiple, undisclosed designs (i.e., the configurations of all the possible automobile bodies that might use the same corner shape) by formally directing his claim to a mere fragment of the shape of an article.76 This decision also indicates that even if the applicant considered the corner to

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73 Id.
74 Id.
75 Id.
76 Id. Without the actual drawings, it’s difficult to know whether the design was actually directed to a fragment, as that term is used here. See supra text accompanying note 68.
be what he “designed,” that did not mean that the corner actually constituted a single, patentable “design.”

2. *In re Blum* (C.C.P.A. 1967)

In *Blum*, the applicant sought a design patent for the configuration of a “handrail unit.” The drawings appeared to show a composite article (i.e., “a handrail unit” including “a handrail, a post, and a connecting bracket”) with one of the components—the rail—shown in solid lines and the rest shown in dotted lines.

The Patent Office rejected the claim as obvious and, in a decision written by Judge Rich, the CCPA affirmed. In its decision, the court stated that there had been some “internal Patent Office disagreement” over whether the applicant was claiming the shape of the entire composite

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77 Thus, the Board seemed to view a configuration design as one directed to the configuration of an entire article. See Northup, 1932 WL 27333, at *1.
78 *In re Blum*, 374 F.2d 904, 905 (C.C.P.A. 1967). It is interesting that Judge Rich referred to the claimed design as one for “the configuration of the goods,” a phrase from trademark law, not a “configuration,” as would have been more standard in design patent law. Id. He used similar terminology in Zahn. See infra note 163.
79 See *Blum*, 374 F.2d at 906.
80 *Id. at* 905.
81 See *id. at* 908.
article or just the shape of the rail. The court stated that the exact scope of the claim could “make no difference to the outcome” of the case because “all of the supporting structure is disclosed in the reference relied on.”

Nonetheless, the court opined on the use of dotted lines in design patent drawings, stating that “if the Patent Office does not more rigorously enforce some sort of standardization about the meanings of drawings in design cases, chaos will result.” As part of this discussion, the court stated that “[d]otted and broken lines may mean different things in different circumstances and all we wish to say here is that in each case it must be made entirely clear what they do mean.”

At the time Blum was decided, the Manual of Patent Examining Procedure’s rule for design patent drawing stated, inter alia:

Dotted or broken line showing is also employed to show such portions of the article claimed which are not important. Such a showing should be explained in the specification by a statement that the dominant features of the design reside in the portions shown in full lines. In every case dotted line showing is notice that the portion so shown is an immaterial part of the design.

The court criticized this “dominant feature” practice, noting that such statements were “not calculated” to obtain the level of definiteness required for design patent claims. The court also criticized this rule on
the basis that “there are no portions of a design which are ‘immaterial’ or ‘not important.’”88 According to the court, “[a] design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design.”89

In these extended dicta on design patent drawings, the court also stated:

There is a distinction to be observed between parts of the total article illustrated, in which a new design is embodied, and parts of that article which embody none of the design. Such a part is, presumably, what the Manual means by the reference to “an immaterial part of the design.” Actually, it is no part of the design but a part of the article unrelated thereto. It is environment only. The distinction should also be maintained between the design and its environment.90

The court did not provide any citations or support for these propositions, making them not only dicta but ipse dixit.91

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88 Id.
89 Id.
90 See In re Zahn, 617 F.2d 261, 269 (C.C.P.A. 1980) (“What Blum involved . . . was primarily the problem of identifying what, exactly, was being claimed—a problem of indefiniteness of claim due to an ambiguous use of dotted or broken lines.”).
91 See Blum, 374 F.2d at 907. Although a full exploration of the history of design patent drawings and claiming conventions is beyond the scope of this Article, it is worth noting that Judge Rich’s speculation about what that the USPTO meant by “immaterial features” is not obviously correct. Elsewhere in its decision, the court referred to its previous decision in In re Wise and stated that, in that case, “we held that dotted lines showings are not part of the claimed design.” Id. at 907 (referring to In re Wise, 340 F.2d 982 (C.C.P.A. 1965)). That does not, however, appear to be an accurate description of Wise. In Wise, the CCPA first decided that the claimed teardrop-shaped advertising display device was obvious in light of previous “display devices inside of [round] hollow transparent containers.” Wise, 340 F.2d at 937. Later, the court stated:

[A]ppellant . . . stated in her specification that “The dominant features of the design are those shown in full lines,” and considered the portion shown in dotted lines as, in the language of the cited section of the Manual, “an immaterial part of the design.” As did the board, we so regard the “dotted line” phase of this case.

Id. That was in response to the applicant’s argument that:

[S]he has gone a step forward by adding an advertising object within the hollow interior of the teardrop shape and that the fact that the interior object is shown in broken lines does not mean that it has no significance in determining design patentability.
Following *Blum*, the USPTO revised the MPEP to say that “[d]otted lines for the purpose of indicating unimportant or immaterial features of the designed article are not permitted. There are no portions of a claimed design which are immaterial or unimportant.”92

**B. The Proceedings at the USPTO**

1. The Application

In *Zahn*, the applicant claimed an “ornamental design for a Shank of a Drill Bit.”93 The application included the following drawings:94

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93 Design Application of Hajo Zahn, App. No. 611,034 (filed Sept. 8, 1975), in Transcript of Record at 5, No. 79-560, *In re Zahn* (C.C.P.A. June 4, 1979); see also id. at 4 (“Be it known that I, Hajo Zahn have invented a new, original and ornamental design for the Shank of a Drill Bit . . . .”). The application was actually prosecuted by Zahn’s assignee, the Olin Corporation of New Haven, Connecticut. See id. at 6 (appointing two “attorneys . . . . of Olin Corporation, 275 Winchester Avenue, New Haven, Connecticut” as his representatives for the prosecution); see also *Drill Tool or the Like*, U.S. Patent No. D257,511 (issued Nov. 11, 1980) (listing Olin Corp. as assignee).

94 *Drill Tool or the Like*, U.S. Patent No. D257,511 (issued Nov. 11, 1980) (the patent that eventually issued to Zahn); see also Design Application of Hajo Zahn, App. No. 611,034 (filed
The application described the drawings as follows:

FIGURE 1 is a side elevational view of the shank of a drill bit illustrating one embodiment of the new design and showing the cutting portion of the drill bit in phantom;

FIGURE 2 is a top end view of the shank of FIGURE 1;

FIGURE 3 is a sectional view taken along the lines 3-3 of FIGURE 1;

FIGURE 4 is a partial elevational view of the right side of the drill bit of FIGURE 1;

FIGURE 5 is a side elevational view of the shank of a drill bit illustrating a second embodiment of the new design and showing the cutting portion of the drill bit of the type shown in FIGURE 1 partially in phantom;

FIGURE 6 is a top end view of the shank of FIGURE 5;

FIGURE 7 is a sectional view taken along the line 7-7 of FIGURE 5; and

FIGURE 8 is a partial elevational view of the left side of the shank of FIGURE 5.

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Sept. 8, 1975, in Transcript of Record at 8, No. 79-560, In re Zahn (C.C.P.A. June 4, 1979) (reproducing the drawing as filed).
The phantom representation of the cutting portion of the drill bit is made in the drawings merely for the purpose of illustrating the type of cutting portion that may be formed integral with the shank portion to form the drill bit.95

Thus, the applicant was claiming the shape of a fragment (the shank portion of the drill bit) of an article (a drill bit) as its “design.” This could be referred to as a “fragment claim.”96 We might also refer to what Zahn claimed as “fragment design.”97

The examiner rejected the claim under 35 U.S.C. § 112.98 The rationale for the rejection read, in full: “Appearance of claimed article indefinite as a result of the failure to disclose a complete article of manufacture in full lines. Broken line disclosure is not claimed, note M.P.E.P. 1503.02 and In re Blum, 153 U.S.P.Q. 177.”99 At that time, section 1503.02 of the MPEP read as follows:

The ornamental design which is being claimed must be shown in solid lines in the drawing. Dotted lines for the purpose of indicating unimportant or immaterial features of the designed article are not permitted. There are no portions of a claimed

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95 Design Application of Hajo Zahn, App. No. 611,034 (filed Sept. 8, 1975), in Transcript of Record at 4–5, No. 79-560, In re Zahn (C.C.P.A. June 4, 1979). The USPTO did not raise the “embodiments” issue, so the court did not engage with it. See Zahn, 617 F.2d at 262 n.1 (C.C.P.A. 1980) (“There are 4 other figures showing a ‘second embodiment’ which are not germane to the issues here. The PTO has said nothing about them.”).

96 Whether one views this as a claim for a complete design for a fragment of an article or a claim for a fragment of a design for a complete article, “fragment claim” appears to be a fair and accurate descriptor.

97 Again, whether the design is considered, conceptually, to be a complete design for a fragment of an article or a fragment of a design for a complete article, “fragment design” seems to fairly capture the “design” claimed here.


99 Id. The examiner also cited three utility patents as references but stated that “[i]n view of the nature of the above rejection, the cited art is not applied against the claim.” Id. at 11–12 (first citing Tap, U.S. Patent No. 2,390,950 (issued Dec. 11, 1945); then citing Drill Bit Having File Teeth, U.S. Patent No. 2,570,945 (issued Oct. 9, 1951); and then citing Rotary Metal Cutting Tool Having a Locally Annealed Shank Portion, U.S. Patent No. 2,740,974 (issued Apr. 10, 1956)).
design which are immaterial or unimportant. In re Blum, 852 O. G. 1045; 153 USPQ 177.100

In response, the applicant amended the application to delete the phrase “type of cutting portion that be formed integral with the shank portion to form the drill bit” from the description of the drawings and replace it with the phrase: “environment in which this invention is used. The structure shown in broken lines is not part of the design sought to be patented.”101

The applicant argued that “the drilling or cutting part of the article shown is functional and does not embody the design. Therefore, it is the environment in which the design is used. Thus it is shown in dotted lines.”102 The applicant argued these amendments were “in accordance with” the CCPA’s decision in In re Blum:

In Blum the Court recognizes that part of a total article illustrated in a design patent application drawing may embody none of the design. Such parts of the article are labeled by the Court as being environment (153 USPQ 180). MPEP 1503.02


101 Amendment, App. No. 611,034 (Apr. 8, 1976), in Transcript of Record at 15, No. 79-560, In re Zahn (C.C.P.A. June 4, 1979). The applicant’s remarks state that it also wished to amend the claim language “to correct a typographical error” but it’s not clear from the transcript of the record what that proposed correction might have been. See id. at 16 (stating: “IN THE CLAIM: * * *”). The applicant later told the CCPA that this first amendment “clarified the specification and corrected a typographical error in the claim relating to the spelling of ‘ornamental.’” Appellant’s Reply Brief at 3, No. 79-560, In re Zahn (C.C.P.A. Aug. 27, 1979) (internal citation omitted).

102 Amendment, App. No. 611,034 (Apr. 8, 1976), in Transcript of Record at 16, No. 79-560, In re Zahn (C.C.P.A. June 4, 1979). The applicant’s suggestion that the disclaimed parts are functional and the claimed parts are not is questionable, to say the least. See Basic Hand Tools, Bureau of Naval Personnel Navy Training Course, NAVPERS 10085-A (Rev. 1963), Attachment to Examiner’s Answer, App. No. 611,034 (Dec. 2, 1977), in Transcript of Record at 52, No. 79-560, In re Zahn (C.C.P.A. June 4, 1979) (“The most common tool for making holes in metal is the twist drill. It consists of a cylindrical piece of steel with spiral grooves. One end of the cylinder is pointed while the other end is shaped so that it may be attached to a drilling machine.”).
permits the use of broken lines to show environmental structure.103

The examiner disagreed.104 This time, the examiner rejected the claim under 35 U.S.C. § 171, writing:

Claim rejected as failing to be directed to discrete article of manufacture. Twist drills are one article of manufacture having shank portions and cutting portions, which are not separate elements, separately protectable as articles of manufacture. Situation here is generally analogous to a screwdriver having a blade and a shank portion.105

The applicant again amended the claim.106 This time, the applicant sought to change the title to delete the phrase “shank of a drill bit” and insert “drill tool or the like” and to make various conforming amendments to the descriptions of the drawings.107 The applicant argued that its application, as amended, should be granted because “[t]he title, specification and claim have been amended to recite a complete article of manufacture rather than merely a portion thereof.”108

The examiner remained unpersuaded.109 In a final rejection, the examiner stated:

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103 Amendment, App. No. 611,034 (Apr. 8, 1976), in Transcript of Record at 16, No. 79-560, In re Zahn (C.C.P.A. June 4, 1979) (citing In re Blum, 374 F.2d 904, 907 (C.C.P.A. 1967)) (internal citation omitted).
105 Id. at 22. The examiner did not cite any art this time. Id.
107 Id. For example, the applicant sought to change the phrase “shank of a drill bit” to “tool” in line 5 of the specification. See id. at 23. The applicant also sought to change the claim language, but the exact nature of the proposed amendment is not clear from the record. See id. at 24 (stating: “IN THE CLAIMS: * * **”). The applicant later told the CCPA that this second amendment “amended the specification and claim so as to claim the invention as follows: ‘I claim: The ornamental design for a Drill Tool or the Like as shown and described.’” Appellant’s Reply Brief at 3, No. 79-560, In re Zahn (C.C.P.A. Aug. 27, 1979) (internal citation omitted).
Careful reconsideration has been given the claim in the light of applicant’s communication of August 18, 1976 with the following results. The rejection of the claim as failing to be directed to a discrete article of manufacture under 35 U.S.C. 171 has not been shown to be in error and is consequently repeated and made final.

Applicant has amended the title of the claim to “drill tool or the like”, but has not avoided the facts expressed in the rejection, . . . which facts were and, until successfully proven to be in error, continue to be the basis for the instant rejection.110

The applicant filed a request for reconsideration.111 In it, the applicant argued the amended application should be allowed because it “relates to a 'drill tool', which is a discrete article of manufacture.”112 That request was apparently denied because the next document in the transcript is a brief appealing the rejection to the Patent Office Board of Appeals (the Board).113

2. The Board Appeal

On appeal to the Board, the applicant stated that “the Claim has been rejected as failing to be directed to a discrete article of manufacture. The Examiner states that twist drills are a discrete article of manufacture with cutting portions and shank portions which are not separate elements.”114

The applicant argued that the rejection was erroneous because “the application, as presently amended, relates to a ‘drill tool’, which is a discrete article of manufacture.”115 According to the applicant:

In effect the Examiner has rejected the claim, which covers a “drill tool”, by restating that the claim is not directed to a

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110 Id. at 26.
112 Id. at 28.
114 Id. at 46.
115 Id. at 47.
discrete article of manufacture. The Examiner has not, however, said in the rejection . . . that a “drill tool” is not a discrete article of manufacture. It is submitted that a “drill tool” is in fact a discrete article of manufacture. In summary, the “facts expressed in the rejection” . . . do not apply to the claim in its present form, unless the Examiner advances cogent arguments which would tend to show that a “drill tool” is not a discrete article of manufacture.\textsuperscript{116}

In his answer, the examiner stated that “[t]he claim was originally rejected . . . as being directed to a non-segregable and therefore incomplete article of manufacture.”\textsuperscript{117} According to the examiner, “[i]t has been the law, since Ex Parte Northup, 24 USPQ 63, that a portion of an article of manufacture is not susceptible of protection under the prevailing design statutes.”\textsuperscript{118} The examiner then noted that while the applicant amended its application to refer to a “drill tool or the like,” as opposed to referring to a “shank” thereof, the applicant had not made any changes to the drawings, which were incorporated by reference.\textsuperscript{119} Thus, according to the examiner, the amended claim “was in fact the same claim as originally filed.”\textsuperscript{120} In other words, the examiner’s view was that, despite the changes to the application’s description of the relevant article, the application was still claiming the same design.\textsuperscript{121}

In reply, the applicant agreed “[i]t has been the law, since Ex Parte Northup, 24 USPQ 63, that a portion of an article of manufacture is not susceptible of protection under the prevailing design statutes.”\textsuperscript{122} However, the applicant insisted that principle was “not applicable to the

\textsuperscript{116} Id. at 47–48.
\textsuperscript{118} Id. at 49–50.
\textsuperscript{119} Id. at 50.
\textsuperscript{120} Id.
\textsuperscript{121} See id.; see also id. ("[T]he claim, which is the drawing—no more and no less—being properly rejectable when termed the shank of a drill bit, is properly rejectable when termed a drill tool.").
facts in the instant application.” 123 The applicant argued that the amended application was, in fact, claiming a design for a complete article because it referred to “a drill tool or the like.” 124 According to the applicant, “[c]onfusion has arisen because the design encompasses only a portion of the drill tool, namely the tool shank.” 125 The applicant also revived its suggestion that it had merely disclaimed the “functional” parts of the design. 126

The applicant also argued that the CCPA’s decision in In re Blum “clearly allows for the possibility that a protectable design may validly reside in a portion only of an article.” 127 The applicant further argued that Northup supported its position because when it said “[i]n considering a design the appearance of the entire article must be taken into consideration,” it “impl[ied] that a design may encompass less than all of an article of manufacture.” 128

Finally, the applicant doubled down on its semantic argument. The applicant argued that the amended claim was, in substance, the same as the originally-filed claim because “[t]he original claim was directed to a ‘shank of a drill bit’” while “[t]he present claim is directed to a ‘drill tool or the like.’” 129

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123 Id.
124 Id. at 56 ("By means of the amended application, design patent protection is sought for a ‘drill tool or the like’—a complete article of manufacture.").
125 Id.
126 Id. (arguing that “the remainder of the tool, being of a purely [] functional design, comprises mere environment and is shown in the drawings in broken lines”). This argument was no more persuasive this time around. See MPEP 3d ed., supra note 92 and accompanying text.
128 Id. at 56–57. This reading is strained, to say the least. The applicant also cited two other cases that didn’t clearly support its arguments. See id. at 57 (first citing Ex Parte Sweeney, 123 U.S.P.Q. 506 (Pat. Off. Bd. App. 1959); and then citing Philco Corp. v. Admiral Corp., 131 U.S.P.Q. 418 (D. Del. 1961)). The applicant apparently dropped those arguments on appeal. See Appellant’s Brief at ii, No. 79-560, In re Zahn (C.C.P.A. July 13, 1979) (not mentioning either case); Appellant’s Reply Brief at 4, No. 79-560, In re Zahn (C.C.P.A. Aug. 27, 1979) (same).
129 Reply Brief, App. No. 611,034 (Dec. 12, 1977), in Transcript of Record at 57–58, No. 79-560, In re Zahn (C.C.P.A. June 4, 1979); see also id. at 58 ("It is the appearance, not the structure, which is . . . disclaimed. The claim is directed to a drill tool or the like where the entire design resides in the shank portion.").
3. The Board’s Decision

The Board affirmed the rejection of the applicant’s claim under § 171 “because it is apparent appellant has disclaimed the cutting portion of the claimed drill tool or the like.” The Board stated that it felt “constrained by Blum to hold that a design patent cannot properly be granted for the ornamental design of a portion only of an article of manufacture.”

The applicant filed a request for reconsideration, arguing that the Board’s decision on § 171 was not supported by Blum. The applicant argued that “in properly interpreting Blum, that a distinction be maintained between the terms ‘design’ and ‘article’. To use these terms interchangeably obfuscates the meaning and guidance which Blum provides.” According to the applicant, the Board had misinterpreted Blum in MPEP section 1503.02 because it referred to a “designed article” instead of a “design.” The applicant further argued that:

[In Blum, the CCPA explicitly recognizes that an article illustrated in a design patent can have parts thereof in which the new design is embodied, and other parts thereof which embody none of the new design, the latter of which are termed “environment”. Further, the CCPA states that a distinction must

130 Opinion and Decision of the Board of Appeals, App. No. 611,034 (Dec. 21, 1978), in Transcript of Record at 66, No. 79-560, In re Zahn (C.C.P.A. June 4, 1979) (capitalization changed). The Board also rejected the claim “under 35 U.S.C. 112, second paragraph, as failing to claim the subject matter appellant [] regards as his invention.” Id. (citing In re Conley et al., 490 F.2d 972 (C.C.P.A. 1974)). Because this Article is focused on the question of statutory subject matter, it will leave any § 112 issues raised in Zahn for another day.

131 Id. (citing In re Blum, 374 F.2d 904 (C.C.P.A. 1967)) (internal citation omitted). The Board did not specify at this point which part(s) of Blum, in particular, it felt so “constrained” by, though presumably it meant the parts it had quoted earlier in its decision. See id. at 63–64.

132 Request for Reconsideration, App. No. 611,034 (Jan. 8, 1979), in Transcript of Record at 70, No. 79-560, In re Zahn (C.C.P.A. June 4, 1979) (interpreting the Board’s decision as “tantamount to holding that a design patent cannot properly be granted for an article of manufacture wherein the ornamental design resides in only a portion of the claimed article of manufacture”).

133 Id. at 71.

134 Id.
be maintained in the patent between the design part of the article and the environment part of the article for proper clarity.135

The applicant also insisted that its position was “supported by the existence of Design Patent No. D-89,448,” the patent that issued from the copending application mentioned in *Northup*.136 The applicant suggested the D’448 patent was analogous to its own because the drawings showed an article “mostly in broken lines” with “the patented design, appearing in solid lines” while the claim was “directed to” the article as a whole.137

The Board refused to change its decision, stating that “[t]he points of argument are essentially those which [the Board] considered” the first time around.138 The Board again noted that the applicant sought “to establish an exclusive property right in the appearance of merely the shank portion of the entire article of manufacture.”139 As the Board observed, despite the language of the claim and the title, the claim was intended to “cover all sorts of undisclosed drill tool appearances, no matter what relation the diameter and length the cutting portion might have to the shank portion, and no matter what the effect on the appearance of the drill tool as a whole would be.”140 According to the

135 *Id.* at 72. Of course, as discussed above, that part of *Blum* was dicta. See sources cited *supra* note 90 and accompanying text.

136 Request for Reconsideration, App. No. 611,034 (Jan. 8, 1979), *in Transcript of Record at 74, No. 79-560, In re Zahn* (C.C.P.A. June 4, 1979); see also sources cited *supra* note 71 and accompanying text. The applicant also argued the examiner’s position was “illogical and unfair.” See Request for Reconsideration, App. No. 611,034 (Jan. 8, 1979), *in Transcript of Record at 74, No. 79-560, In re Zahn* (C.C.P.A. June 4, 1979). The CCPA noted that argument but did not adopt that rationale as a justification for its decision. See *In re Zahn*, 617 F.2d 261, 266 (C.C.P.A. 1980).

137 Request for Reconsideration, App. No. 611,034 (Jan. 8, 1979), *in Transcript of Record at 74, No. 79-560, In re Zahn* (C.C.P.A. June 4, 1979) (referring to “the precedent set by *Northup ’448*”). It is not at all obvious, however, that the Patent Office viewed the D’488 patent in the same way the applicant in *Zahn* did. See *infra* Section III.A.1.


139 See *id.* at 80.

140 *Id.* at 67. Notably, in its CCPA brief, the appellant confirmed that this was, in fact, what he wanted, even going to far as to suggest it should be entitled to a patent that would cover “a potentially infinite number of” drill shapes. See Appellant’s Brief at 5–6, No. 79-560 (Fed. Cir. July 13, 1979) (“If this position were upheld, appellant would be forced, in the present instance, to file patent applications showing the drill tool shank in combination with every conceivable twist or cutting portion, a potentially infinite number of applications.”).
Board, what the applicant claimed did not constitute a single, complete “design for an article of manufacture.”

C. The Appeal

1. The Arguments on Appeal

The applicant appealed the Board’s decision to the CCPA. In the opening brief, the applicant framed the § 171 issue as follows: “A design patent may properly be granted for an ornamental design for an article of manufacture wherein the design resides in only a portion of the article.” The applicant again suggested that the shanked portion was the only “designed . . . portion,” arguing that the disclaimed portions of the drill bit shape were “of a purely functional and undesigned nature.”

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141 See Opinion and Decision of the Board of Appeals, App. No. 611,034 (Feb. 16, 1979), in Transcript of Record at 80, No. 79-560, In re Zahn (C.C.P.A. June 4, 1979) (“A claim limited to just the design appearance of the shank portion would not be to the design appearance of an article of manufacture.”).
143 See id. at 1.
144 Id. at 2 (stating that “the designed shank portion is shown in solid lines and the nondesigned twist portion is shown in broken lines”).
145 The applicant also argued that its broken-line usage wasn’t actually a “disclaimer,” but that is the customary terminology today. See id. at 2–3; see also, e.g., Christopher V. Carani, The New “Extra-Ordinary” Observer Test for Design Patent Infringement—on a Crash Course with the Supreme Court’s Precedent in Gorham v. White, 8 J. MARSHALL REV. INTELL. PROP. L. 354, 368 n.101 (2009) (noting that “applicants routinely only claim a portion of the article of manufacture by using dotted lines to disclaim immaterial, unimportant, or simply unwanted aspects of the design”); Perry J. Saidman & Kerry W. Leonard, Describing A Design—When Enough Is Enough! Clarifying the 35 U.S.C. § 112 Written Description Requirement for Design Patents, 97 J. PAT. & TRADEMARK OFF. SOC’Y 256, 262 (2015) (“The concept of disclaiming features of an ornamental design by introducing broken lines is well understood and is common practice in the design patent field.”). This Article will use the contemporary terminology on this point.
146 See Appellant’s Brief at 2, No. 79-560 (Fed. Cir. July 13, 1979); see also id. (referring to the disclaimed part as “the nondesigned twist portion [] shown in broken lines”). The suggestion that the claimed part is “nonfunctional” was no more persuasive the third time around. See sources cited supra notes 102, 126 and accompanying text. That is especially true in light of the appellant’s own definition of “design” as a “decorative pattern.” See Appellant’s Brief at 4, No. 79-560 (Fed. Cir. July 13, 1979). Moreover, the applicant offered no principled dividing line between what is the “designed” and “undesigned” portion of an overall configuration design other than the applicant’s own say-so.
The applicant also argued that the Patent Office had failed "to maintain the distinction between the design and the designed article" and again insisted that the Northup D’448 patent was a "precedent" the court should follow.147 The applicant further argued that the text of § 171 supported its position:

Nor is there any language in 35 U.S.C. 171 which requires that the claimed ornamental design encompass an entire article of manufacture. The statute merely requires that the design be "for" an article of manufacture. It is submitted that, had the framers of the statute wished to preclude patent protection for designs encompassed in a portion only of an article of manufacture, the statute would have been drafted to so state.148

Thus, the applicant appears to have recognized that the key statutory interpretation issue was what constitutes a "design for an article of manufacture," but nonetheless attempted to frame the issue in terms of how a design was "encompassed in" the relevant article.149 It is not clear where the applicant got this "encompassed in" concept from, or whether it was an invention of its own.150

In response, the Patent Office argued that "a design patent cannot properly be granted on a claim for an ornamental design of a portion only of an article of manufacture."151 In its arguments, the Patent Office made it clear that they were interpreting the statutory language "design for an
article of manufacture,” at least with regard to configuration claims, as a
design for the shape of an entire article of manufacture.152 Thus, by
claiming “a design for a portion of an article,” the Patent Office viewed
the claim as “drawn to an incomplete design.”153 The Patent Office also
noted that the facts in Blum were different because that applicant claimed
a component, not a fragment design.154

In its reply, the applicant insisted that its claim was allowable
because “[t]he entire article is shown in the drawings and a complete
article is recited in the specification and claim.”155 The applicant also
argued that “[t]he subject matter shown in broken lines in the drawing”
was, in fact, “part of the subject matter sought to be patented,”156
apparently in an attempt to distinguish between the “subject matter” of
the patent and the formal claim.

2. The CCPA’s Decision

   i. The Majority

The CCPA reversed.157 The court, in a majority decision written by
Judge Rich, summarized what it saw as the relevant issues as follows:

152 See Brief for the Comm’r of Patents and Trademarks at 4, No. 79-560, In re Zahn (Fed. Cir.
Aug. 9, 1979) (“The characterization of the broken lines as depicting environment does not alter
the fact that the cutting portion contributes to the appearance which constitutes the design since
the two portions constitute an integral tool.”).
153 Id.
154 Id. (“In Blum, three integral articles of manufacture, a handrail and two support structures,
were combined into another article of manufacture.”).
155 Appellant’s Reply Brief at 4, No. 79-560, In re Zahn (Fed. Cir. Aug. 27, 1979); see also id.
(“The changes made in the specification and claim language did, in fact, change what was being
claimed, from a portion of an article of manufacture, to what is being claimed, an entire article
of manufacture.”); id. at 3 (arguing that the applicant was allowable because the application had
been amended to refer to “a drill tool or the like” instead of “merely the shank of a drill bit” and
because a whole drill bit “was shown in the drawings in the combination of solid and broken
lines”). Notably, the CCPA did not adopt this rule or rationale. See In re Zahn, 617 F.2d 261
(C.C.P.A. 1980).
156 Appellant’s Reply Brief at 1, No. 79-560, In re Zahn (Fed. Cir. Aug. 27, 1979); see also id.
(“Both the title of the invention and appellant’s arguments clearly identify the subject matter he
regards as his invention.”).
157 Zahn, 617 F.2d at 262. Judge Baldwin wrote a dissenting opinion, which Judge Watson
joined. Id. at 269 (Baldwin, J., dissenting).
Involved here are the propriety of using dotted or broken lines in design patent drawings, section 1503.02 of the Manual of Patent Examining Procedure (MPEP) as amended, supposedly to comply with statements this court made in In re Blum, 374 F.2d 904, 54 CCPA 1231, 153 USPQ 177 (1967), other sections of Chapter 1500 of the MPEP, the construction of 35 U.S.C. § 171, and the distinction, largely disregarded by the PTO in this case, between a design for an article of manufacture and the article itself.\textsuperscript{158}

As to the § 171 issue, the court described the Patent Office’s § 171 refusal as follows:

 Turning to the examiner’s final rejection based on non-compliance with § 171, affirmed by the board, the gist of it is that a claim to 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 is not permitted by the provision of § 171 authorizing a patent for “any new, original and ornamental design for an article of manufacture.”\textsuperscript{159}

This passage does not, however, fairly capture “the gist” of either the examiner’s rejections or the Board’s decision.\textsuperscript{160} Instead, it reframes the ultimate issue of the case in a way that begs the question.

The ultimate issue in \textit{Zahn} was whether the thing that Zahn claimed constituted a “design for an article of manufacture” or, in other words, whether it was a protectable type of “design.” In describing the issue as whether “a design which is embodied in less than all of an article of manufacture” constitutes patentable subject matter, the court assumed that what Zahn claimed was, in fact, a protectable type of “design” and suggested, without citation or explanation, that it was protectable as long as it was “embodied in” an article in some way.\textsuperscript{161}

\textsuperscript{158} \textit{Id.} at 262. This Article will focus on the § 171 issues and not the § 112 discussion or issues, except to the extent the latter may impact the former.

\textsuperscript{159} \textit{Id.} at 267.

\textsuperscript{160} See \textit{supra} Section III.B.

\textsuperscript{161} \textit{Zahn}, 617 F.2d at 267; \textit{see also id.} at 268 (“Here the design is embodied in the shank portion of a drill and a drill is unquestionably an article of manufacture. It is thus applied design as distinguished from abstract design.”); \textit{id.} (“Section 171 authorizes patents on ornamental designs
With the issue thus reframed, the Zahn court quickly disposed of it. The court declared that it knew “of no reason for putting such a limited construction on that statute” and held that “a design for an article of manufacture may be embodied in less than all of an article of manufacture.” Instead of grappling with the question of what constitutes a “design for an article of manufacture,” the court merely decreed that § 171 “is inclusive of ornamental designs of all kinds for articles of manufacture. While the design must be embodied in some articles. . . . No sound authority has been cited for any limitation on how a design is to be embodied in an article of manufacture.”). The court did not specific what, precisely, “embodied in” might mean in this context. While this phrase is common enough in utility patent parlance, see, e.g., In re Diehr, 602 F.2d 982, 988 (C.C.P.A. 1979), aff’d sub nom. Diamond v. Diehr, 450 U.S. 175 (1981) (“The formula, as an embodiment of a scientific principle, must be applied in some useful manner in a method or process . . . or be embodied in the design of some useful structure, machine or apparatus . . . .”) (internal citations omitted), it is rarely (if ever) useful or productive to simply transpose utility patent labels or concepts to design patent contexts without at least thinking about—and explaining—how they might translate to these very different types of inventions. See generally Sarah Burstein, Visual Invention, 16 LEWIS & CLARK L. REV. 169, 174 (2012) ("[W]hile the engineer is engaged in technical invention, the designer’s process may be referred to as ‘visual invention.’"). In any case, it is more common—and perhaps ultimately more helpful—to talk about a design being “applied to” an article. See, e.g., 35 U.S.C. § 289 (2012) ("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 . . . ."); Gorham Co. v. White, 81 U.S. 511, 525 (1871) ("As the acts of Congress embrace only designs applied, or to be applied, they must refer to finished products of invention rather than to the process of finishing them . . . ."). Some prior CCPA cases do seem to have used the phrase “embodied in” to the sense of a design being “applied to” an article, see, e.g., Dieterich v. Leaf, 89 F.2d 226, 229 (C.C.P.A. 1937) ("We shall not here undertake to say that with reference to certain class of designs having only two dimensions, such as wall-paper, or the like, a mere drawing of the design upon suitable material may not be sufficient to constitute reduction to practice without the design being embodied in an article of manufacture.")., though it’s not clear that usage was consistent or universal. See, e.g., In re Ferguson, 208 F.2d 366, 367 (C.C.P.A. 1953) (referring to "[t]he designs embodied in the three applications of the appeals"). This isn’t just an academic question; a broader range of designs might be deemed to be "embodied in" than those "applied to" articles. For example, a design for a computer icon may be considered to be "embodied in" the computer in some sense, but it’s not really "applied to" the screen or the computer in any normal sense of those words. For more on computer icons as statutory subject matter, see infra note 169.

\textsuperscript{162} Zahn, 617 F.2d at 267. The court later stated that: "No sound authority has been cited for any limitation on how a design is to be embodied in an article of manufacture." Id. at 268. Of course, this is not surprising because the court had just invented this "embodied in" framing. See generally supra note 161.
including surface ornamentation as well as configuration of goods.” The court did not explain how it reached that conclusion or how, precisely, it was defining “design.”

The court’s assertion that the statute protects designs “of all kinds” deserves further attention. The court suggests that because design patent law previously recognized two different kinds of designs—surface designs and configuration designs—it must necessarily protect any “kind” of designs. It is true that courts and the USPTO have long recognized two different “classes of invention” in design patents: shape (also known as “configuration”) and surface ornamentation. And at least since

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163 Zahn, 617 F.2d at 267–68. The court’s use of the phrase “configuration of goods” is interesting, as that phrase actually comes from the Lanham Act, not from design patent law. See 15 U.S.C. § 1091(c) (2018) (“For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing . . . .” (emphasis added)).

164 The court did suggest—without any further explanation or elaboration—that its prior decision in Hruby (also written by Judge Rich) was “indicative of a liberal construction of § 171.” Zahn, 617 F.2d at 268 (citing In re Hruby, 373 F.2d 997 (C.C.P.A. 1967)). Hruby, however, was a case about what constitutes an “article of manufacture,” not what constitutes a “design.” See Hruby, 373 F.2d at 997 (“The appeals of the four applications were argued as one, before both the board and this court, and the single issue in each is the same: is the subject matter sought to be patented within the statutory subject matter designated in 35 U.S.C. 171, namely, ‘an article of manufacture’?”). Therefore, it’s unclear how, precisely, the court thought Hruby supported its decision in Zahn. It is also worth noting that the legal reasoning in Hruby is not beyond reproach, though a full discussion of the problems with that decision is beyond the scope of this Article.

165 The word “design” itself is mercurial and not self-defining. See Burstein, The Patented Design, supra note 55, at 166–67. Additionally, the court’s apparent definition does not comport with the way contemporary designers conceptualize a “design.” See, e.g., Brief of 26 Design Educators as Amici Curiae in Support of Appellee Apple Inc. at 17, Apple Inc. v. Samsung Elecs. Co., No. 5:11-cv-01846 (Fed. Cir. Aug. 4, 2014), 2014 WL 4079446, at *17 (stating that designers view a “design” as “a cohesive and integrated whole that connects all of the product’s parts in a meaningful way,” as opposed to “a hodgepodge of discrete elements”).

166 Zahn, 617 F.2d at 268. And it certainly does not follow that anything that might be called a “design” must also be considered a “design for an article of manufacture” under § 171.

167 See Ex parte Gérard, 1888 Dec. Comm’r Pat. 37, 40 (describing “the two classes of invention” in design patents as “shape and ornamentation”). The USPTO conceptualizes the category long known as “surface ornamentation” as including all “surface treatment,” i.e., “any indicia, contrasting color or materials, graphic representations, or other ornamentation applied to the article.” MPEP, supra note 2, § 1503.02(IV). According to the USPTO, this category also includes designs for graphical user interfaces and computer-generated icons. Id. § 1504.01(a). But see Burstein, The “Article of Manufacture” in 1887, supra note 12, at 14 (noting that “[t]his interpretation of the statute is based on questionable logic and has not been tested in litigation or ratified by any court”) (footnote omitted).
Gorham, design patent applicants have been able to claim three types of designs: shape, ornamentation, or a combination of both. But just because design patent law recognized these two (or three, depending on how you count) kinds of designs prior to Zahn, it does not follow that there must be more kinds of protectable designs—let alone an undefined and open set of such designs.

Even if we accept the premise that § 171 protects “all kinds of . . . designs,” two important questions still remain. First, what is a “kind of” design? The court offered no clear answer but seemed to suggest that anything that might be, in any sense, called a “design” would count. Second, even if we accept the “all kinds” premise, what is a complete “design”? Is what Zahn claimed a whole design or merely part of one? By taking for granted that what Zahn claimed was, in fact, a complete design and imposing no other express or implied limits on what might be claimed in future cases, the court’s answer seems to be: “The ‘design’ is whatever the applicant says it is.”

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168 Gorham Co. v. White, 81 U.S. 511, 525 (1871) ("The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but, in whatever way produced, it is the new thing, or product, which the patent law regards.").

169 Whether or not there are (or should be) other protectable “kinds” of designs is a question for another day.

170 We might also think of what Zahn claimed as a “design element,” as opposed to a complete “design.”

171 See, e.g., In re Zahn, 617 F.2d 261, 268 (C.C.P.A. 1980) ("Here the design is embodied in the shank portion of a drill and a drill is unquestionably an article of manufacture."). The court’s lack of analytical clarity on this point has, quite understandably, led some commentators to read Zahn as redefining “article of manufacture,” not as a case about what it means to be a “design.” See Burstein, The “Article of Manufacture” in 1887, supra note 12, at 13 ("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.’").

172 See Zahn, 617 F.2d at 268.

173 Although the court did not justify its decision on the basis that it is consistent with utility patent law or practice, see id., the proposition that the “invention” is whatever the applicant claims may strike those trained in contemporary U.S. utility patent law as unsurprising or even incontrovertible. However, that is not how utility patent law always conceived of “the invention” and it’s certainly not the only way to do so. See generally Oskar Liivak, Rescuing the Invention from the Cult of the Claim, 42 SETON HALL L. REV. 1, 5 (2012) (arguing that, in utility patents, “the invention is not simply a shorthand reference for the claimed subject matter”). But even if
ii. The Dissent

Judge Baldwin wrote a dissenting opinion, which Judge Watson joined.\textsuperscript{174} The dissent started by refuting the majority’s framing of the case, recognizing that the actual issue raised by Zahn was “the construction to be given ‘design for an article of manufacture’ as provided in § 171.”\textsuperscript{175}

The dissenting judges agreed with the majority that, at least in theory, a design could “be embodied in less than all of an article of manufacture.”\textsuperscript{176} But they found “ample judicial and administrative precedent to support a construction of § 171 providing patent protection treating the claim as the invention makes sense for utility patents, designs patents are different. They cover different subject matter, use a different claim format, and even have a different purpose. Compare Gorham Co. v. White, 81 U.S. 511, 524 (1871) (“The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts.”), with Graham v. John Deere Co., 383 U.S. 1, 5 (1966) (stating that Congress’s power to grant utility patents is a “qualified authority” that “is limited to the promotion of advances in the ‘useful arts’” (citing U.S. CONST. art. 1, § 8, cl. 8)); see also infra notes 276–277 and accompanying text. We should not automatically assume that utility patent principles do or must transfer to the design patent space, even when and if courts refer to utility patents as just “patents.”

\textsuperscript{174} Zahn, 617 F.2d at 269 (Baldwin, J., dissenting).

\textsuperscript{175} Id. (“I disagree that the question before the court is in any way related to the presence or absence of the dotted lines found in the drawings of appellant’s claims. I suggest that the problem is much more closely tied to the very foundation of design patent law. . . . My dissent rests on the construction to be given ‘design for an article of manufacture’ as provided in § 171.”). The dissent also expressed concern that the majority decision would protect “abstract designs.” See id. Although it’s not entirely clear that the dissent was getting at what I have referred to in the past as “designs per se”—i.e., a design that is conceptualized as being untethered from any connection with any particular article. See id. at 270 (“Gorham cannot be read to extend the protection of § 171 to designs which are . . . in the abstract and are only to be applied to ‘articles of manufacture . . . .’”); Burstein, The Patented Design, supra note 55, at 163–64 (“To infringe a design patent, a defendant must make, use, sell, offer to sell, or import the claimed invention, which will be referred to in this Article as ‘the patented design.’ But it is not at all clear what ‘the patented design’ actually is. Based on the statutory language alone, it could be anything from a ‘design per se’—i.e., something akin to a ‘work’ in copyright law—to a particular design embodied in the particular product as sold in a particular market.”) (footnote omitted). But despite the dissent’s concerns, the majority decision in Zahn does not mandate the protection of designs per se. It does, however, change various other aspects of design patent law. See infra Part IV. And the dissent was correct to worry about the majority cherry-picking the word “design” out of the phrase “design for an article of manufacture.” See supra Section III.C.2.i.

\textsuperscript{176} Zahn, 617 F.2d at 269 (Baldwin, J., dissenting).
only for the overall visual appearance of the article in which the design is embodied.”

According to the dissent, “[t]he majority decision makes wholesale changes to a century of practice which has required disclosure of the article to which a design is applied.”

The precedent cited by the dissent included “judicial decisions with respect to infringement, this court’s decision with regard to determination of obviousness, and the [Patent Office’s] long-standing rules of practice.” The dissent pointed out that the Gorham test for infringement, as reaffirmed by the Supreme Court in Whitman Saddle, contemplates a visual evaluation of the entire appearance of “the article upon which the design has been placed.” The court also quoted this “frequently cited passage” from Pelouze Scale & Mfg. Co. v. American Cutlery Co., which emphasized the gestalt nature of design:

Design, in the view of the patent law, is that characteristic of a physical substance which, by means of lines, images, configuration, and the like, taken as a whole, makes an impression, through the eye, upon the mind of the observer. The essence of a design resides, not in the elements individually, nor in their method of arrangement, but in the tout ensemble—in that indefinable whole that awakens some sensation in the observer’s mind. Impressions thus imparted may be complex or simple; in one a mingled impression of gracefulness and strength, in another the impression of strength alone. But whatever the impression, there is attached in the mind of the

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177 Id. at 269–70.
178 Id. at 269.
179 Id. at 272 (“The judicial decisions with respect to infringement, this court’s decision with regard to determination of obviousness, and the long-standing rules of practice support a construction of § 171 that ‘design for an article of manufacture’ refers to the overall visual appearance of the article in which the design has been embodied.”). The majority did not respond to all of these arguments or contend with most of the dissent’s cited authorities, mentioning only the dissent’s citation to Northup. See id. at 269 (“The dissenting opinion relies heavily on a presumed ‘uniform, consistent, long-standing view of the PTO,’ citing in support Ex parte Northup, supra, a 1932 board decision . . . .”).
180 See id. at 270 (citing Smith v. Whitman Saddle Co., 148 U.S. 674, 679 (1893)).
observer, to the object observed, a sense of uniqueness and character.\textsuperscript{181}

The dissent also pointed out that, in \textit{In re Laverne}, the CCPA had described the nonobviousness test for designs as “inherently a visual test, for the design is nothing more than appearance, and the appearance is that of the article as a whole.”\textsuperscript{182} According to the dissent, those cases demonstrated “that the overall appearance of the article is considered in questioning infringement or validity of issued design patents as well as the nonobviousness of claims in design applications” and concluded that, therefore, “[t]he quantum of disclosure must include [the whole] article.”\textsuperscript{183}

The dissent also stated that “the administrative practice of the PTO has amply reflected a construction that § 171 refers to the overall visual impression of the article as a whole,” citing a number of old Patent Office rules and noting the Board’s decision in \textit{Northup}.\textsuperscript{184} According to the dissent, the majority was wrong to “dismiss[] \textit{Northup} as ‘[o]ne board decision . . . not binding on the construction of a statute.’”\textsuperscript{185} The dissenting judges concluded that, in light of “the Rules of Practice dating back to 1904 together with the earlier judicial precedents” cited, they were “inclined to agree with the solicitor that the \textit{Northup} view represents a uniform, consistent, long-standing view of the PTO and as such must be given consideration as an indicator of the meaning of the law.”\textsuperscript{186}

\textsuperscript{181} \textit{Id.} (citing Pelouze Scale & Mfg. Co. v. Am. Cutlery Co., 102 F. 916, 918 (7th Cir. 1900)). Of course, this passage might read differently to a contemporary reader wearing Zahn-colored glasses, who could read “the design” as “whatever is claimed.”

\textsuperscript{182} \textit{Id.} (quoting \textit{In re Laverne}, 356 F.2d 1003, 1006 (C.C.P.A. 1966)).

\textsuperscript{183} \textit{Id.} at 271. Or at least enough “to allow an observer to evaluate the overall visual impression of that article.” \textit{See id.} at 269.

\textsuperscript{184} \textit{Id.} at 271 (first citing 37 C.F.R. §§ 1.152, 1.153, and then citing prior PTO Rules of Practice, rules 81 and 84).

\textsuperscript{185} \textit{Id.} (alteration in original).

\textsuperscript{186} \textit{Id.} The dissent did not respond to or acknowledge any of these precedents save for \textit{Northup}. \textit{See id.} at 269. If it had, the majority may have accused the dissent, the courts, and the Patent Office of conflating the concept of a protectable “design” with the “article” to which it is applied. \textit{See id.} at 262 (stating that the case involved, inter alia, “the distinction, largely disregarded by the PTO in this case, between a design for an article of manufacture and the article itself”). But these cases are evidence that, prior to \textit{Zahn}, the Patent Office and at least some courts conceptualized the patentable design as a design for a whole article.
IV. DESIGN PATENT LAW IN A ZAHN WORLD

The holding and reasoning in Zahn have several important implications for U.S. design patent law. This Section will discuss some of those implications.

A. Design Patent Infringement & Validity Under Zahn

The tests for design patent invalidity and infringement have long focused on “the design as a whole.” But what is the “whole” design? If, as the Zahn majority ruled, the whole design is whatever the applicant claims, then infringement and validity must be determined by comparing the claimed portion to the corresponding portion of the accused article or product, not the appearance of the accused product or article as a whole. Indeed, that is exactly what the applicant in Zahn wanted. And that is how the courts apply these principles post-Zahn.

In the post-Zahn world, a fragment claim is infringed whenever the relevant portion looks “the same”—even when the accused product looks

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187 See, e.g., Gorham Co. v. White, 81 U.S. 511, 530 (1871) (“[T]hough variances in the ornament are discoverable, the question remains, is the effect of the whole design substantially the same?” (emphasis added)); In re Miller, 194 F.2d 106, 108 (C.C.P.A. 1952) (“[E]ven if each element in a claimed design is old, that fact of itself does not negative invention, for patentability may reside in the manner in which the elements are combined. The design as a whole, and the impression it makes on the eye must be considered.” (citing In re Park, 181 F.2d 255, 255 (C.C.P.A. 1950) (emphasis added))); Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 677 (Fed. Cir. 2008) (en banc) (stating that “the proper inquiry” for design patent infringement is “whether the accused design has appropriated the claimed design as a whole” (first citing Amini Innovation Corp. v. Anthony Cal., Inc., 439 F.3d 1365, 1370–71 (Fed. Cir. 2006); then citing KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc., 997 F.2d 1444, 1450 (Fed. Cir. 1993); and then citing Braun, Inc. v. Dynamics Corp. of Am., 975 F.2d 815, 820 (Fed. Cir. 1992))); see also Zahn, 617 F.2d at 271 (Baldwin, J., dissenting) (citing cases demonstrating “that the overall appearance of the article is considered in questioning infringement or validity of issued design patents as well as the nonobviousness of claims in design applications”).

188 See generally Burstein, The “Article of Manufacture” in 1887, supra note 12, at 11 (discussing the contemporary test for design patent infringement).

189 See Appellant’s Brief at 5–6, No. 79-560 (Fed. Cir. July 13, 1979) (“If this position were upheld, appellant would be forced, in the present instance, to file patent applications showing the drill tool shank in combination with every conceivable twist or cutting portion, a potentially infinite number of applications.”).
very different, as a whole, from the patentee’s own product (if any).\footnote{There is no working requirement in the United States, so a design patent owner is not required to make, sell, or license its own product. See Cont’l Paper Bag Co. v. E. Paper Bag Co., 210 U.S. 405, 429 (1908) (noting that the working requirement was repealed in 1836).} A well-crafted fragment claim will, therefore, give its owner the ability to exclude others from making, using, selling, offering to sell, or importing a broad range of whole-article shapes—regardless of how many of those overall shapes the patentee actually invented or produced.\footnote{See 35 U.S.C. § 271 (2012) (setting forth the acts that constitute infringement). To those steeped in contemporary utility patent law, the idea that a patentee could exercise domination over much more than what they actually invented may sound like a perfectly normal—or perhaps even necessary—state of affairs. But there is no reason why the pathologies of utility patent law must be imported to design patent law. The two regimes protect fundamentally different types of inventions, and the justifications for contemporary utility-patent claiming rules (e.g., the difficulty of describing a useful invention in words) do not apply to the design arena.}

For example, this design patent appears to claim just one set of the speaker holes in some version of the iPad:\footnote{Electronic Device, U.S. Patent No. D771,622, figs. 2, 9 (issued Nov. 15, 2016).}
Under contemporary design patent law, this patent would be infringed if this configuration of speaker holes were used in the same location on any tablet computer—and possibly other types of electronic devices—of any shape, even if the devices did not look the same overall.\textsuperscript{193}

By allowing applicants to make such broad claims,\textsuperscript{194} the Zahn definition of a patentable design can create anti-competitive barriers to

\textsuperscript{193} This design patent, like many issued post-Zahn, also involves some potential ambiguity regarding the placement of the speaker holes. There’s no case law that clearly indicates whether this design patent would be infringed if, for example, the holes were located in other positions or if their relative size were much larger compared to the rest of the device. In other words, what does it really mean for something to be “not part of the claimed design”? See, e.g., MPEP, supra note 2, § 1503.02(III) (“Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is associated, may be represented in the drawing by broken lines.”). In theory, the dotted lines could be “not part of the claimed design” but still provide relevant information about the location, proportion, and placement of the claimed parts. Moreover, noting in Zahn says that the USPTO or the courts must approve any and all uses of dotted lines; the CCPA merely ruled that what Zahn was claiming was sufficiently clear. See In re Zahn, 617 F.2d 261, 266 (C.C.P.A. 1980).

\textsuperscript{194} This allusion to real property is meant to be figurative only. Whether intellectual property is, in fact, a form of “property” is a matter of considerable debate. Compare, e.g., Adam Mossoff, Intellectual Property and Property Rights, in INTELLECTUAL PROPERTY AND PROPERTY RIGHTS 14–31 (Edward Elgar, 2013), http://ssrn.com/abstract=2466479 [https://perma.cc/5XR5-7JYW], with Mark A. Lemley, Property, Intellectual Property, and Free Riding, 83 TEX. L. REV. 1031 (2005).
entry, especially for small and medium-sized entities.\textsuperscript{195} It also encourages rent-seeking and undermines incentives for others to create new and improved designs by locking up design elements for at least fifteen years without providing any countervailing benefit to the public.\textsuperscript{196} Even if these patents are never asserted in court, they can give their owners significant in terrem power over their competitors.\textsuperscript{197} The patents can also block important and valuable innovation by stopping or scaring competitors from creating products that might visually match one small part of the patentee’s product but that look different overall.\textsuperscript{198} Whether we should allow design patent owners to obtain such broad coverage using fragment claiming is, thus, an important policy question. It deserves to be discussed and deliberated, not simply assumed as the majority did in \textit{Zahn}.

In theory, one inherent limit on the breadth of design patent principles might be the symmetry principle—i.e., “[t]hat which infringes, if later, would anticipate, if earlier.”\textsuperscript{199} Theoretically, \textit{Zahn}-style fragment claims should be easier to invalidate (or for the USPTO to reject) than

\begin{footnotesize}
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\item[\textsuperscript{195}] Of course, the concern that overbroad patent claims will deter innovation isn’t limited to design patents. Similar concerns have been raised frequently in the literature on utility patents. \textit{See, e.g.,} Tun-Jen Chiang, \textit{Forcing Patent Claims}, 113 MICH. L. REV. 513, 514 (2015) (“Because the patent claim defines the scope of the monopoly, patentees have a strong incentive to subtly slant the claim’s language in a way that aggrandizes their rights to the detriment of the public.”) (footnote omitted). However, the rationales that support the utility patent claiming regime don’t apply to design patents. \textit{See supra} note 65.
\item[\textsuperscript{196}] \textit{See generally} Sarah Burstein, \textit{Costly Designs}, 77 OHIO ST. L.J. 107, 138 (2016). Some may claim that, without the availability of fragment claiming, companies won’t create new designs. That seems implausible, at best.
\item[\textsuperscript{197}] This is due largely to the special design patent remedy codified in 35 U.S.C. § 289 (2012). For more on this remedy, \textit{see infra} Section IV.C. Of course, regardless of how the system is designed, some patent owners will assert extremely weak—or even frivolous—claims of infringement. But the \textit{status quo} makes it much easier for them to bring \textit{colorable} claims, even when the parties’ products look unalike as a whole. And “[c]ompetition is deterred [] not merely by successful suit but by the plausible threat of successful suit . . . .” \textit{Wal-Mart Stores, Inc. v. Samara Bros.}, 529 U.S. 205, 214 (2000).
\item[\textsuperscript{198}] This is particularly true when the partial claiming is done \textit{ex ante}, through the daisy-chaining technique discussed \textit{supra} Section IV.B.
\item[\textsuperscript{199}] \textit{See Int’l Seaway Trading Corp. v. Walgreens Corp.}, 589 F.3d 1233, 1239 (Fed. Cir. 2009) (noting this principle applies to design patents and quoting Peters v. Active Mfg. Co., 129 U.S. 530, 537 (1889)).
\end{itemize}
\end{footnotesize}
full-article claims because, presumably, there is a wider range of relevant prior art. This could, again in theory, discourage applicants from filing very broad claims. But in practice, it does not appear that fragment claims are especially vulnerable to invalidation or rejection. The Federal Circuit has lowered the substantive requirements for design patentability to the point where it is difficult for the USPTO to reject design patent applications on the merits or for courts to invalidate issued design patents, regardless of the breadth of the claim.

Even if the substantive requirements were strengthened, fragment claims would still present particular, if not unique, problems for prior art searching and comparisons. It is hard enough to find relevant prior art for whole-article designs. Finding prior art with a sufficient level of visual detail to invalidate a fragment claim would, at least in theory, be even harder.

Today, many design patent attorneys use Google Image Search to find prior art. If an attorney’s client has been accused of infringing a design of a pool float shaped like a unicorn, they may be able to use that Google search function to find pictures of designs that look the same as a whole. But if the asserted claim covers only a fragment of that design, the search would be much harder to articulate verbally. And even if a proper search could be formulated, there’s no guarantee that references will clearly show the relevant fragment(s), which might, for example, be obscured by shade in a photo. Or the patentee might argue that if a reference doesn’t disclose six clear views of the fragment, then the reference is insufficient to disprove patentability. Therefore, it may well

200 For example, on the facts of Zahn, the claim could have been invalidated by any drill bit with the same shank shape, regardless of how different the other drill bit looked overall.

201 See Sarah Burstein, Is Design Patent Examination Too Lax?, 33 BERKELEY TECH. L.J. 607, 624 (2018) (explaining the current standards in more detail and providing more examples). Because design patent applications (other than those filed using the Hague System) are not published, we don’t know exactly how many of them are actually rejected on substantive grounds. But we do know the percentage of all applications rejected or abandoned is small. See Dennis D. Crouch, A Trademark Justification for Design Patent Rights 18 (Aug. 10, 2010) (unpublished manuscript) (available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1656590 [https://perma.cc/8BD6-5PGS]) (“For the past decade, the allowance rate for design patent applications has remained over 90%.”).

202 Cf. MPEP, supra note 2, § 1503.02 (“The drawings or photographs should contain a sufficient number of views to disclose the complete appearance of the design claimed, which may include the front, rear, top, bottom and sides. Perspective views are suggested and may be
be that fragment claims give their owners broader scope than whole-article claims without running the practical risk of invalidity that should theoretically accompany a much broader claim.

B. Design Patent Prosecution Under Zahn

Based on the facts of Zahn, it appears that the court was implicitly defining a patentable “design” as any visual portion or portions of the shape and/or surface design of an article. Indeed, that is how the USPTO appears to view the universe of patentable designs today. Just as Zahn set no limits on the size or importance of a claimable “portion,” neither does the USPTO. There is no requirement that the portion (or portions) claimed “represent an important, distinctive or otherwise salient design feature.” An applicant can claim basically any random bit (or bits) of the visual appearance of a product as a freestanding “design.”

As discussed above, this means that an applicant can use fragment claiming to obtain protection that far exceeds the value of their submitted to clearly show the appearance of three dimensional designs.”). To the author’s knowledge, this theory has not been tested in court.

203 I say “visual” instead of “ornamental” because it appears that the Zahn court did not actually think that what Zahn claimed was “ornamental.” See In re Zahn, 617 F.2d 261, 269 (C.C.P.A. 1980) (“We have in mind questions on which we can express no opinion because we are a court of review and do not pass on issues not raised, such as whether the shank is ‘ornamental’ or dictated by function or is substantially concealed or obscured while the shank is in normal use.” (citing In re Stevens, 173 F.2d 1015, 1016 (C.C.P.A. 1949))). Of course, this comment is dicta because the issue was not before the court. But it does suggest that the court (quite properly) recognized that some things might be “designs” without also being “ornamental.”

204 See MPEP, supra note 2, § 1502 (“The design for an article consists of the visual characteristics embodied in or applied to an article.”).

205 See Burstein, Costly Designs, supra note 196, at 116 (discussing continuation and divisional applications but the principles apply to original applications); see also MPEP, supra note 2, § 1502 (not setting any such limits).

206 Just as “there is no requirement that the smaller portion or portions claimed in a continuation (or divisional) represent an important, distinctive or otherwise salient design feature,” there is no such requirement for original design patent applications. See Burstein, Costly Designs, supra note 196, at 116.
contribution to the decorative arts.\textsuperscript{207} And while a design patent can only contain one claim,\textsuperscript{208} there is nothing stopping applicants from filing multiple design patent applications, each claiming various fragments of the shape of a particular article.\textsuperscript{209} This can be done all at once, as Apple did with some designs relating to the original iPhone. A few days before it announced the creation of the original iPhone, Apple filed at least four independent design patent applications, each claiming various aspects of the original iPhone design.\textsuperscript{210} But an applicant need not file all of its claims at once. Following disclosure of its design, an applicant has up to a year to file freestanding design patent applications.\textsuperscript{211} And even after that first year, an applicant can file new “continuation” or “divisional”

\textsuperscript{207} According to the Supreme Court, “[t]he acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts.” Gorham Co. v. White, 81 U.S. 511, 524 (1871). Although the concept of “giv[ing] encouragement to the decorative arts”—as well as the normative basis for design patents and similar rights more generally—is undertheorized, it is difficult to think of any need to protect the full range of “designs” that are deemed patentable by Zahn. See generally Burstein, \textit{Costly Designs}, supra note 196.

\textsuperscript{208} MPEP, \textit{supra} note 2, § 1504.05. The single claim may cover more than one embodiment but “such embodiments may be presented only if they involve a single inventive concept according to the obviousness-type double patenting practice for designs.” \textit{Id.}

\textsuperscript{209} For example, in a recently litigated case, the patentee alleged infringement of two design patents that were granted on the same day from applications filed the same day. See Complaint, D&S Hunts, LLC v. Hunter’s Edge, LLC, No. 4:16-cv-00061-CRW-CFB (S.D. Iowa Mar. 7, 2016), ECF No. 1 (alleging infringement of U.S. Patent No. D560,745 (issued Jan. 29, 2008) and U.S. Patent No. D560,746 (issued Jan. 29, 2008)).


\textsuperscript{211} See 35 U.S.C. § 102(b)(1)(A) (2012) (“A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if . . . the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor . . . .”).
applications that claim priority to pending design patent or (nonprovisional) utility patent applications.\(^{212}\)

One limit on continuation and divisional applications is that they are not supposed to contain any “new matter.”\(^{213}\) According to the USPTO, changing a solid line to a broken line or vice versa in a design patent drawing does not constitute the addition of “new matter.”\(^{214}\) Therefore, an applicant can significantly alter the scope of their claims over time by filing a string of related applications with different lines—or parts thereof—shown in solid and broken lines.\(^{215}\) This “daisy-chain” technique\(^{216}\) allows design patent applicants to claim basically whatever they want, whenever they want.\(^{217}\) They can even “go back to the

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\(^{212}\) See generally MPEP, supra note 2, § 1504.20; see also In re Daniels, 144 F.3d 1452, 1456 (Fed. Cir. 1998) ("[D]esign and utility patents are each entitled to claim priority from the other.") (citing Racing Strollers, Inc. v. TRI Indus., Inc., 878 F.2d 1418, 1418 (Fed. Cir. 1989)); MPEP, supra note 2, § 1504.10 (“Design applications may not make a claim for priority of a provisional application under 35 U.S.C. 119(e).”).

\(^{213}\) See MPEP, supra note 2, § 1504.04.

\(^{214}\) MPEP, supra note 2, § 1504(I)(B) ("[A]n amendment that changes the scope of a design by either converting originally-disclosed solid line structure to broken lines or converting originally-disclosed broken line structure to solid lines would not introduce new matter . . . .").

To the author’s knowledge, this rule has never been blessed by a court. But it’s hard to see how this rule could be successfully challenged post-Zahn, since each of the delineated portions could each qualify as a separate "design." This is another implication of Zahn that deserves discussion and debate; however, a full discussion of that issue is beyond the scope of this Article.

\(^{215}\) See Burstein, Costly Designs, supra note 196, at 115–16 (discussing this "keep [one] in the oven" strategy in more detail) (internal quotation marks omitted); see also id. at 116 n.59 (arguing that this strategy should be limited by the recent Federal Circuit decision in In re Owens but noting that the USPTO “has interpreted Owens quite (and probably unduly) narrowly” (referring to In re Owens, 710 F.3d 1362, 1368 (Fed. Cir. 2013))). Although the practice of changing claim scope by filing related applications has enjoyed “long acceptance in the PTO and in the courts, [it] . . . has been criticized in the utility patent literature for inviting abuse and making a patent claim akin to ‘a fence that will be redrawn after the fact’” and “there are reasons to be particularly concerned about this type of ex post claiming in the design patent context.” Id. at 116–117 (internal footnotes omitted).

\(^{216}\) See generally Michael A. Epstein, Modern Intellectual Property § 5.03[a][4], at 5-33–5-34 (3d ed. Supp. 1998) (“If the parent application is still pending at the time the continuation application is filed, the effective filing date is the effective filing date of the parent application. Implicit in this doctrine is the concept that applications may be ‘daisy-chained’ insofar as their effective filing dates are concerned.”).

\(^{217}\) See Burstein, Costly Designs, supra note 196, at 115–16 ("[T]his strategy allows a design patent applicant to go back to the PTO and capture competing products that were introduced after the first design patent application was filed—even if those competing products did not infringe the original patent claim."). This technique also allows applicants to extend the term of
and capture competing products that were introduced after the first design patent application was filed—even if those competing products did not infringe the original patent claim.”

Accordingly, it has become “common to file a parent application that narrowly claims most or all of the design by rendering it in solid lines, and later file continuations that more broadly claim only distinct portions of the overall design.” But an applicant is not required to start with—or ever make—an all-solid-line claim. Consider, for example, this fairly simple family of design patents. The parent claims a design for the shape of a camera hole in a smartphone case:

(electronic device case with an asymmetric housing cut-out, U.S. Patent No. D728,547 (issued May 5, 2015)).
This patent, unlike its parent, would be infringed by a smartphone case with the same outer shape, regardless of the shape (and perhaps, regardless of the existence) of the camera hole.222

The other child patent claims just the shape of the corners of the camera hole:223

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222 For more on the ambiguity that has arisen in some contemporary dotted-line claims, see supra note 193.

223 Electronic Device Case with Cut-Out Having Asymmetric Corners, U.S. Patent No. D728,550, figs.4–7 (issued May 5, 2015). The drawings are very degraded in the issued D’550 patent; these images were downloaded from Public PAIR, records for U.S. Patent No. D728,550, on March 2, 2018. According to Public PAIR, these are the replacement drawings the applicant filed on May 5, 2014.
This patent, unlike its parent, would be infringed by a smartphone case with a different-shaped hole and different-shaped case, as long as the shapes of the corners were the same.224

That is just one fairly small, simple design patent family. Others are much larger. Consider the family that began with U.S. Design Patent Application 29/270,887. That application, which was filed by Apple Inc. on January 5, 2007, claimed what appears to be the shape of the original iPhone:225

224 See supra Section I.C (discussing the current test for design patent infringement).

225 See Electronic Device, U.S. Patent No. D580,387 figs.3–4 (issued Nov. 11, 2008). As noted above, this application was only one of at least four filed by Apple that day. See supra note 210 and accompanying text.
This application matured into U.S. Patent No. D580,387, which was issued in 2008. As of March 18, 2019, eight of its children have matured into design patents. One child application is still pending; therefore, even though it has been over twelve years after the launch of the original iPhone, Apple can still go back to the USPTO and claim some smaller part of that design as a “new” design. Because regular design patent applications aren’t published unless and until they mature into design patents and because Apple can keep changing solid lines to dotted lines and vice versa at will, neither competitors nor members of the public can know what part or parts of the original iPhone design Apple might claim next—or has already claimed. And if it chooses to spend the time and money, Apple could keep this going for years, ultimately giving it far more than fourteen to fifteen years of design patent protection.

Of course, continuation and divisional applications existed pre-Zahn. And it may be that some (or all) of these USPTO rules deserve reconsideration for their own sake. But the Zahn regime of fragment claiming expands the range of available prosecution gamesmanship exponentially. If Apple were limited to claims for a whole iPhone and its components, that would allow them much less leeway for ex post

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226 This is according to Public PAIR’s continuity data for U.S. Design Patent Application 29/270,887. A ninth child application, U.S. Design Patent App. No. 29/386,066, was approved by the examiner but Apple filed a Petition to Withdraw from Issue and that application is now designated “abandoned.”


228 See supra note 179 and accompanying text. To be more specific, applicants can change broken disclaimer lines to solid lines and vice versa. Broken lines denoting boundaries are subject to somewhat more limiting rules. See In re Owens, 710 F.3d 1362, 1368 (Fed. Cir. 2013).

229 For more on this “keep [one] in the oven” strategy, see Burstein, Costly Designs, supra note 196, at 115–17.

230 See Burstein, Costly Designs, supra note 196, at 130–31 (“Even though a single design patent lasts for only 14-15 years, savvy design patent practitioners can use the PTO’s continuation rules to ‘evergreen’ design patent protection for a particular product for 30 or even 40 years by filing multiple applications covering different aspects of a product design.”) (footnote omitted). In theory, the rules against double patenting could ameliorate this. See generally MPEP, supra note 2, § 1504.06. But since, under Zahn, any fragment can be a completely different “design,” this does not appear to be much of a difficulty in practice. Again, these rules and principles probably could stand greater scrutiny for their own sake. But the Zahn rule seems to exacerbate the inherent difficulty of finding principled standards and rules in this space.
manipulation than they have under the present regime. Whether we should allow this type of manipulation and gamesmanship is an important policy issue that deserves discussion and debate. But in a Zahn world, it’s difficult to see many avenues for reform, if one believes reform is needed.231

C. Design Patent “Total Profits” Under Zahn

For certain acts of infringement, a design patent owner can elect to recover monetary relief under 35 U.S.C. § 289.232 That section provides:

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.233

Under this provision, a design patent owner is entitled to recover the “total profit” for “the ‘article of manufacture’ to which the infringed design has been applied.”234 At the moment, the question of how to

231 In theory, one could imagine courts giving the "new" in § 171 some independent meaning that would set some kind of time limit on how long a patent applicant could claim new fragments (or even components). But a full discussion of these issues is beyond the scope of this Article.

232 Burstein, Costly Designs, supra note 196, at 118 n.74 (“By its plain terms, it applies only to certain actions taken in the commercial context.”).


234 Samsung Elecs. Co. v. Apple Inc., 137 S. Ct. 429, 434 (2016) (“Arriving 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.”). For more on the remedies available for design patent infringement and the interplay between them, see Burstein, The "Article of Manufacture" Today, supra note 51.
determine this “relevant article” is unsettled. But it’s worth noting that the \textit{Zahn} fragment-claiming regime appears to have affected the arguments about—and potential effect of—this “total profit” provision in at least two ways.

1. “Total Profits” for Fragments

When this special remedy was enacted in 1887, there was no \textit{Zahn}-style fragment claiming. \textit{Zahn}’s introduction of fragment claiming distorted the presumptive effect of—and justification for—this special remedy. It is one thing to say that a patent owner should be entitled to an infringer’s total profits when, for example, the infringer has sold pieces of carpet with the same surface designs as the pieces of carpet sold by the patent owner. It’s quite another thing to say that the patent owner

\begin{footnotes}
235 Samsung, 137 S. Ct. at 436 (“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.”); see also Burstein, \textit{The “Article of Manufacture” Today, supra} note 51, at 791–94 (discussing recent litigation on this issue). At present, it is unclear when this issue will reach the Federal Circuit.

236 See Burstein, \textit{The “Article of Manufacture” Today, supra} note 51, at 836–37 (“[T]he very concept of what constitutes a protectable ‘design’ has changed dramatically since 1887. Today, a design patent applicant can claim a ‘design’ for the configuration or surface ornamentation of only a fragment of an article—i.e., a part of an article that isn’t manufactured (and cannot be sold) separately.”) (footnote omitted); see also Burstein, \textit{The “Article of Manufacture” in 1887, supra} note 12, at 8 (“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 . . . .”) (footnote omitted).

237 These are the facts of the “Carpet Cases,” which were the stated impetus for the enactment of the “total profits” remedy. For more on those cases and the legislative history of the 1887 Act, see Burstein, \textit{The “Article of Manufacture” in 1887, supra} note 12, at 54–61 (discussing Dobson v. Hartford Carpet Co., 114 U.S. 439, 440 (1885)). Although the law at that time protected configuration, combination, and surface-ornamentation designs, the legislative history focuses on the latter. See, e.g., H. R. REP. NO. 49-1966, at 3 (1886) (“So far as the consumers are concerned, the effect of design patent laws that are respected is to give them more beautiful carpets and wall-papers and oil-cloths . . . .”); 18 CONG. REC. 834 (1887) (“Mr. ANDERSON, of Kansas. To what particular kind of designs does this bill apply? Mr. MARTIN. It applies to designs for carpets, oil-cloth, wall-paper, &c.”) (emphasis added); id. at 835 (“The object [of S. 1813] is simply that, after manufacturers have expended their money in getting artists to furnish these \textit{designs which add value to carpeting, oil-cloths, wall-paper, and things of that sort}, the advantages to which the manufacturers are entitled by reason of securing these designs, shall not be taken from them by infringements.”) (emphasis added) (statement of Rep. Martin). This may be because design
should be entitled to the total profits from those carpet pieces if only a small part looks the same.\footnote{238} By allowing patent applicants to claim such small parts as a separate “design,” the current regime has fundamentally altered this special design patent remedy by opening the door for damages awards far in excess of what was originally intended by Congress and far beyond any economic justification.\footnote{239}

See HECTOR T. FENTON, THE LAW OF PATENTS FOR DESIGNS 13 (1889) (stating that, as of 1889, “[t]he most common subject of designs [i.e., design patents] is surface ornamentation”). Or it may be because these were the types of designs the sponsors were the most interested in. See Burstein, The “Article of Manufacture” in 1887, supra note 12, at 56–57 (“At that time, the chairs of the U.S. Senate and U.S. House Committees on Patents were both from Connecticut. Textile manufacturing was a major industry in Connecticut.”) (footnotes omitted). For an alternate hypothesis, see Jason J. Du Mont & Mark D. Janis, Design Patent Remedies, in AMERICAN DESIGN PATENT LAW: A LEGAL HISTORY 6-1, 6-37 (forthcoming), http://ssrn.com/abstract=2784746 [https://perma.cc/77H4-DMUY] (“While the House and Senate Reports both recited the idea that design enhanced the value of manufactured products, only the House Report intimated that it might be the central driver of consumer demand for the types of products protected by the design patent regime (i.e., ‘the design that sells the article’). Presumably, the drafters of the House Report thought that this crucial role for design was best exemplified by the carpets, wall-papers, and oil cloths also mentioned elsewhere in the House Report.”).

\footnote{238} See supra Part I (discussing the contemporary test for infringement). For a discussion of the differences between the design patent infringement test today and in 1887, see Burstein, The “Article of Manufacture” in 1887, supra note 12, at 11 n.64. And, [w]hile some nineteenth-century design patents may appear to claim only part of a configuration or surface design, the Patent Office understood those claims to be something akin to advisory opinions as to which part or parts of the design, if replicated, would result in a product that looked so similar overall as to infringe.

Burstein, The “Article of Manufacture” Today, supra note 51, at 788 n.37 (citing Cont’l Paper Bag Co. v. E. Paper Bag Co., 210 U.S. 405, 429 (1908)). Indeed, it appears that similar concerns motivated the abolition of profit disgorgement as a remedy for utility patent infringement. See, e.g., Josh Landau, Smartphones, Diapers, and Design Patents, PATENT PROGRESS (May 17, 2018), https://www.patentprogress.org/2018/05/17/smartphones-diapers-and-design-patents [https://perma.cc/YZD5-5YTT] (quoting a 1929 letter “written by one Mr. Fish to one Mr. Howson and read into the record by an esteemed Congressman, discussing the state of patent law”).

\footnote{239} For economic critiques of § 289, see infra note 248. The way courts interpret the phrase “article of manufacture” has also changed since 1887. See Burstein, The “Article of Manufacture” in 1887, supra note 12. But even if courts readopted the historical meaning of that phrase, the current “anything goes” concept of what constitutes a protectable “design” would still completely...
For example, a district judge recently ruled that Microsoft was entitled to recover Corel’s total profits from sales of software that infringed design patents for small parts of a word-processing graphical user interface. Here is one of the patents-in-suit, along with an illustration of one of the infringing products with the relevant portion circled:

See Burstein, *The “Article of Manufacture” Today*, supra note 51, at 812 (arguing that “courts should, to the extent that they can, readopt the historical meaning of ‘article of manufacture’”) (capitalization changed); id. at 836–37 (“Today, a design patent applicant can claim a ‘design’ for the configuration or surface ornamentation of only a fragment of an article—i.e., a part of an article that isn’t manufactured (and cannot be sold) separately. In these instances of fragment claiming, the approach proposed by this Article will, admittedly, result in a windfall to the patent owner.”) (footnotes omitted).

240 See Order Regarding Post-Trial Motions at 7–8, Microsoft Corp. v. Corel Corp., No. 5:15-cv-05836-EJD (N.D. Cal. May 8, 2018), ECF No. 357; Complaint at 26–36, Microsoft Corp. v. Corel Corp., No. 5:15-cv-05836 (N.D. Cal. Dec. 18, 2015), ECF No. 1 (setting forth Microsoft’s design patent claims, including illustrations).

In this case, the overall appearance of the defendant’s graphical user interface was similar to the overall appearance of the plaintiff’s graphical user interface. However, under contemporary design patent law, there is no requirement that it had to be; if the slider portion looked the same, the entire interface would infringe. That is difficult to square with the original intent of this remedy—and with any concept of proportionality. The fact that such disproportionate damages awards

242 See supra Part I (discussing the contemporary test for infringement). Notably, the reasoning in this decision would have compelled the same amount of damages even if Corel had only infringed one of the design-patents-in-suit. It is also questionable whether software should, in fact, be considered an “article of manufacture” and whether graphical user interface designs constitute proper statutory subject matter. See Sarah Burstein, Microsoft, Corel, and the “Article of Manufacture,” PATENTLYO (May 16, 2018), https://patentlyo.com/patent/2018/05/microsoft-article-manufacture.html [https://perma.cc/L88P-R5YN]; see also Burstein, The “Article of Manufacture” in 1887, supra note 12, at 14 (“In the mid-1990s, the USPTO decided that graphical user interface (‘GUI’) designs constitute proper statutory subject matter for design patents. . . . This interpretation of the statute is based on questionable logic and has not been tested in litigation or ratified by any court.”) (footnotes omitted). However, those issues are beyond the scope of this Article and Microsoft v. Corel still serves as a good example of the application of the current law.

243 In the Supreme Court, Apple’s counsel seemed to recognize that the Justices would be troubled by this general rule and “argued that it deserved the total profits from all of the infringing phones because the three patents, when considered as a group, covered ‘the overall look-and-feel of the iPhone.’” Burstein, The “Article of Manufacture” Today, supra note 51, at 801 (quoting Brief in Opposition to Petition for Certiorari at 31, Apple Inc. v. Samsung Elecs. Co., No. 15-777 (U.S. Feb. 3, 2016), 2016 WL 6599923). That was not, however, an accurate description. See Sarah Burstein, The Apple v. Samsung Retrial: Breaking Down Apple’s Design Patent Claims, COMPARATIVE PATENT REMEDIES (May 15, 2018), http://comparativepatentremedies.blogspot.com/2018/05/the-apple-v-samsung-retial-breaking.html [https://perma.cc/GQX5-SXSE].
are available "raises a potential for substantial overcompensation and overheating" and increases the likelihood that legitimate competition and innovation will be chilled.

Section 289 damages are available even where some piece of a larger whole was not claimed as a separate "design" until after a competitor began selling (what began as) a non-infringing competing product. At that point, the competitor would have to decide whether to change its product, giving the new patent owner a de facto injunction and incurring potentially high redesign and retooling costs, or risk an expensive and time-consuming patent lawsuit. In such cases, the application of the


245 This is true even though these types of patents are never asserted in litigation. Cf. Burstein, Costly Designs, supra note 196, at 143 (noting that even weak design patent infringement claims can have "significant nuisance value"); Buccafusco, Intelligent Design, supra note 7, at 108 ("Even weak design patents can be used to file nuisance lawsuits and extract settlements.").

246 The facts of Nordock v. Systems provide a good example. In that case, "Systems' began selling the accused levelers in October 2005." Nordock applied for the D'754 patent on May 31, 2007, as a continuation of an unsuccessful utility patent application. The D'754 patent was issued on November 4, 2008. Nordock sued Systems in 2011. See Burstein, The "Article of Manufacture" in 1887, supra note 12, at 22 (discussing Nordock, Inc. v. Sys. Inc., 803 F.3d 1344, 1356 (Fed. Cir. 2015), cert. granted, judgment vacated, 137 S. Ct. 589 (2016)) (footnotes omitted). This makes § 289 damages very different from statutory damages in copyright. See 17 U.S.C. § 412 (2012) ("[N]o award of statutory damages . . . shall be made for—(1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or (2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration . . . ."). Of course, the patentee would not be able to recover any profits earned by prior to the issuance of the patent and prior to giving the defendant notice of that patent, but the available profits can still be substantial. See, e.g., Nordock, 803 F.3d at 1356 ("[T]he evidence showed that Systems' profits were over $630,000 . . . .").

247 One irony here is that, following Apple v. Samsung, it's more difficult—or, at least, is perceived by some commentators as being more difficult—to get an injunction based on design patents for product components or fragments. See Apple Inc. v. Samsung Elecs. Co., 735 F.3d 1352, 1366 (Fed. Cir. 2013) (affirming the district court's denial of an injunction where "Apple ha[d] presented evidence that design, as a general matter, is important to consumers" but had "not established a sufficient causal nexus between infringement of [the actual designs claimed in] its design patents and irreparable harm") (quoting Apple Inc. v. Samsung Elecs. Co., 909 F. Supp. 2d 1147, 1154–55 (N.D. Cal. 2012)) (internal quotation marks omitted); see also, e.g., Daniel Harris Brean, Will the "Nexus" Requirement of Apple v. Samsung Preclude Injunctive Relief in the Majority of Patent Cases?: Echoes of the Entire Market Value Rule, 51 SAN DIEGO L. REV. 153, 188 (2014) ("Requiring each infringing feature to independently drive demand for the accused products would be difficult—if not impossible—to show for products embodying multiple patented features . . . .").
“total profits” remedy seems particularly difficult to justify—in economic, historical, or any terms. But regardless of what one thinks about the merits of § 289 as a policy matter, the way it is applied today looks very different than Congress could have imagined when it enacted this special design patent remedy.

2. Semantic Gymnastics

Second, Zahn’s semantic conceit—i.e., the idea that a design for a fragment is really a design “for” the whole article—appears to have affected many of the arguments made about § 289 in a subtler and perhaps less appreciated way. As noted above, § 289 applies to someone who “applies” a patented design “to any article of manufacture” in certain commercial circumstances. Many recent arguments about the meaning and effect of § 289 revolve around the question of what article a particular design has been “applied” to. Indeed, the question of how to identify

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248 Of course, there are those who would likely argue that § 289 is not economically justified, regardless of how the statutory “design” is defined because § 289 does not require apportionment between the utilitarian and aesthetic aspects of an article. See, e.g., Buccafusco, Intelligent Design, supra note 7, at 133 (arguing that “a rule that doesn’t consider the relative value of the design patent and other features of a product is absurd”); Cotter, Reining in Remedies, supra note 244, at 20 (“[T]he non-apportionment rule has . . . from an economic perspective, too much bite, assuming that the profits Samsung earned from the sales of its devices were attributable in part to other, noninfringing features of the Samsung devices. In this regard, U.S. design patent law arguably raises a potential for substantial overcompensation and overdeterrence.”); Mark A. Lemley, A Rational System of Design Patent Remedies, 17 STAN. TECH. L. REV. 219, 221 (2013) (arguing that § 289 “makes no sense” and “has to go”). A full discussion of the whether, on balance, § 289 represents good policy is beyond the scope of this Article.


250 See, e.g., Brief for the United States as Amicus Curiae Supporting Neither Party at 27, Samsung Elecs. Co., Ltd v. Apple Inc., 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 3194218 (arguing that the factfinder should weigh multiple factors to determine which “article” the design has been “applied” to in a particular case). For a critique of the Government’s proposed approach, see Burstein, The “Article of Manufacture” Today, supra note 51, at 793–812.
this “relevant article” is one of the questions left open by the Supreme Court in *Samsung Electronics Co. v. Apple Inc.*

It appears that, in 1887, it would not have been very difficult to determine the relevant article. But in a world where a design for a drill shank can be considered a design “for” the whole drill bit, why couldn’t it also be considered a design “for” a complete drill? And if it can be considered a design “for” a complete drill, it’s not too far of a stretch to argue that the design for the shape of just the drill bit’s shank could be viewed as “applied” to the complete drill. That’s not to say this is a good or proper reading of the relevant statutory language. But it does help explain why those kinds of arguments might make sense to lawyers who’ve spent their careers practicing under *Zahn*.

V. **The Shaky Logical and Legal Foundations of Zahn**

Regardless of whether one likes all of the aforementioned implications of *Zahn*, but perhaps especially to those who find some or all of them troubling, the question remains: Are we stuck with it? In support of its conclusion that fragment claims constitute design patentable subject matter, the majority in *Zahn* relied heavily on its own interpretation of the text of § 171. The majority also suggested

251 See Burstein, *The “Article of Manufacture” Today*, supra note 51, at 793 (“[I]n *Samsung*, the Court squarely rejected the Apple/Nordock rule but refused ‘to set out a test for identifying the relevant article of manufacture’—i.e., for identifying ‘the article of manufacture’ to which the infringed design has been applied.’ The Court left that task for the lower courts.” (referring to Samsung Elecs. Co. v. Apple Inc., 137 S. Ct. 429 (2016))).  
252 Burstein, *The “Article of Manufacture” in 1887*, supra note 12, at 83 (“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. For surface ornamentation designs, the infringing article could—in appropriate circumstances—be something other than what the patentee ‘invented and produced.’”) (footnotes omitted).  
253 In re *Zahn*, 617 F.2d 261, 267 (C.C.P.A. 1980). The court later stated that: “No sound authority has been cited for any limitation on how a design is to be embodied in an article of manufacture.” Id. at 268. Of course, this is not surprising because the court had literally just invented this “embodied in” framing. See generally *supra* note 161 and accompanying text.
254 *Zahn*, 617 F.2d at 268.
that its decision was “not . . . inconsistent” with past USPTO practice.\textsuperscript{255}
This Section examines each of these rationales and explains why they are flawed.

\textbf{A. Statutory Text}

The majority in \textit{Zahn} purported to ground its decision in the text of the statute.\textsuperscript{256} However, its reasoning is flawed, and the court’s conclusion is contrary to the plain language of the statute. The key language in § 171 provides that: “Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.”\textsuperscript{257}

In plain English, when we refer to a thing, we usually mean the whole thing unless otherwise specified. It’s not necessary to add the word “whole” (or “complete” or the like) because the “whole” is implied. If someone says, “I ate an orange,” we would understand them to mean they ate the whole orange, not just a piece of one. Similarly, if someone says they will be “gone for a week,” we would most naturally understand that to mean a whole week, not just a few days.\textsuperscript{258}

Thus, in plain English, the phrase “design for an article of manufacture” would most naturally refer to a whole “design for an article of manufacture.” Indeed, the implied “whole” would, in theory, attach to both nouns, indicating that protection is available for any \textit{whole} design for any \textit{whole} article of manufacture.

This leads to two new questions: (1) what is a “whole” design?; and (2) what is a “whole” article of manufacture? Those are important questions that deserve further study and debate, but, for the time being, it is worth acknowledging how far the majority’s conclusion in \textit{Zahn} strays from the plain text of the statute, which suggests not only that patentable “designs” are designs for whole articles, but also that there is such a thing as a whole “design.”

\textsuperscript{255} \textit{Id.} at 269 ("The cited PTO rules, ancient and modern, are not seen to be inconsistent with this opinion.").

\textsuperscript{256} \textit{Id.} at 268.


\textsuperscript{258} In some cases, people might round to the nearest full unit by, for example, saying they’ll be “gone for a week” when they’ll only be gone six days. But it would be quite strange for someone to say they’ll be “gone for a week” if they were taking a two-day trip.
None of the majority’s arguments compel a different reading. According to the majority:

Section 171 authorizes patents on ornamental designs for articles of manufacture. While the design must be embodied in some articles, the statute is not limited to designs for complete articles, or “discrete” articles, and certainly not to articles separately sold, as implied in the Northup board opinion. No sound authority has been cited for any limitation on how a design is to be embodied in an article of manufacture. . . . Referring to the express words of § 171, we are of the opinion that the word “therefor” in the phrase “may obtain a patent therefor” refers back to “design,” not to “article of manufacture.” We note also that § 171 refers, not to the design of an article, but to a design for an article, and is inclusive of ornamental designs of all kinds including surface ornamentation as well as configuration of goods. This Section will discuss these arguments in turn.

First, it is true that § 171 does not explicitly say that a patentable design must be “for complete articles, or ‘discrete’ articles.” But in light of the principles of ordinary English discussed above, it would have been

259 Zahn, 617 F.2d at 268. In this passage, the majority also stated that its prior decision In re Hruby supported “a liberal construction of § 171.” Id. (“In In re Hruby, 373 F.2d 997, 54 CCPA 1196, 153 USPQ 61 (1967), the apparent visual shape of the streams of a water fountain was held proper design patent subject matter, indicative of a liberal construction of § 171.”). However, Hruby does not clearly support the Zahn majority’s approach. It is true that the Hruby majority framed the issue before it as “whether that portion of a water fountain which is composed entirely of water in motion is within the statutory term ‘article of manufacture.’” Hruby, 373 F.2d at 998. But the issue of the propriety of claiming that “portion” alone—as opposed to claiming the design for the entire fountain—was not before the court, at least in the view of the majority. See id. at 999 (“Nevertheless the board majority concluded that the water display itself is not ‘an article of manufacture.’ The only reasons we can perceive for this conclusion in the board’s opinion are that ‘the pattern created is wholly a fleeting product of nozzle arrangements and control of operating pressure or pressures’ and that ‘the pattern exists only as a product or ‘effect’ of the mechanical organization during its continued operation . . .’”) (omission in original).

260 See Zahn, 617 F.2d at 268 (“[T]he statute is not limited to designs for complete articles, or ‘discrete’ articles, and certainly not to articles separately sold, as implied in the Northup board opinion.”). As to the “separately sold” point, that relates back to the meaning of “article of manufacture.”
odd if the statute had done so. The “whole” is implied.\textsuperscript{261} The fact that Congress chose not to add a superfluous adjective does not change the text’s plain meaning.\textsuperscript{262}

Second, the \textit{Zahn} majority stated that “[n]o sound authority has been cited for any limitation on how a design is to be embodied in an article of manufacture.”\textsuperscript{263} But that is not surprising in light of the fact that the \textit{Zahn} majority apparently invented the method-of-embodiment framing out of whole cloth.\textsuperscript{264} It would also not be surprising to find no authority on that point if, as the USPTO and the dissent claimed, the prior practice (or at least understanding) was that a “configuration design” was a design for the configuration of an entire article of manufacture.\textsuperscript{265}

Third, the \textit{Zahn} majority stated that, in § 171, “the word ‘therefor’ in the phrase ‘may obtain a patent therefor’ refers back to ‘design,’ not to ‘article of manufacture.’”\textsuperscript{266} This is true that design patents protect designs, not articles qua articles.\textsuperscript{267} But the statute does not protect “any design.” It protects “any design for an article of manufacture.” The key issue raised by \textit{Zahn} is what that means. The phrase “for an article of

\begin{footnotesize}
\begin{itemize}
\item This may seem more intuitive for configuration and combination designs than for surface-ornamentation designs. Although a full discussion of this issue is beyond the scope of this Article, it’s worth noting that in visual design theory, both worked and unworked areas are essential parts of a complete design. Indeed, “unworked areas are as active as anything else; they just happen to be made of the surface with which the designer started.” ZELANSKI & FISHER, \textit{supra} note 35, at 69. For example, consider a rose motif painted on a teapot. In that case, the painting would be the worked area and the surrounding unpainted porcelain would be the unworked area.

\item It may be that the majority is reading the statute the way a patent attorney (like Judge Rich was before he joined the court) would read a patent. That is, they may be assuming that words are not limited by their plain English meaning unless such limits are made explicit.

\item \textit{Zahn}, 617 F.2d at 268.

\item \textit{See supra} note 161 and accompanying text.

\item Although a full exploration of the history of surface designs is beyond the scope of this Article, it’s worth noting that, prior to \textit{Zahn}, the entire concept of what constitutes a design for “surface ornamentation” seems to have been less developed than the concept of what constitutes a “configuration.” Today, the USPTO has expanded the former category even further, to include all “surface treatment.” But those are issues for another article.

\item \textit{Zahn}, 617 F.2d at 268.

\item That is to say, design patent claims are not like “manufacture” claims in utility patent law in that they do not give their owners the right to exclude others from making a certain \textit{thing}. Instead, a design patent gives its owner the right to exclude others from making a certain thing that looks a certain way. See Curver Luxembourg, SARL v. Home Expressions Inc., 938 F.3d 1334 (Fed. Cir. 2019) (refusing to construe a design patent that claimed a surface design “for a chair” as covering the same surface design applied to a basket).
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“manufacture” is not some throwaway line; it is a key part of the description of the statutory subject matter. By cherry-picking the word “design” out of context, the majority erases that issue and distorts the plain meaning of the statute.

Finally, the majority relies heavily on the fact that § 171 “refers, not to the design of an article, but to a design for an article.” The majority does not elaborate on this point, but was apparently trying to suggest that if Congress actually meant to protect whole designs for whole articles, it would have used the word “of” instead of “for.” But that is far from clear, especially in light of the plain-English principles discussed above. Moreover, from a design perspective:

[I]f there is any meaningful distinction between a design “of” and “for” an article of manufacture, it would seem to relate most naturally to whether or not the article has actually been manufactured. If an industrial designer is hired (or assigned) to design a new shoe, it would be natural to say that the designer has been engaged to create a new design “for” a shoe. And while the designer is working, we would say that she is working on a design “for” a shoe. We would not normally refer to the designer’s work as a design “of” a shoe until after the shoe is actually produced.

And the mere fact that Congress might hypothetically have used a different preposition doesn’t change the plain meaning of the statute as it was actually written.

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268 Zahn, 617 F.2d at 268.
269 See generally Du Mont & Janis, Virtual Designs, supra note 5, at 115 (discussing this argument with approval).
Indeed, some later interpretations of *Zahn* actually support this plain English reading. Some commentators have read *Zahn* as redefining the phrase “article of manufacture” to include “part of an article of manufacture.”272 Although *Zahn* was not, on its own terms, an “article of manufacture” case, this interpretation is understandable if these commentators were reading “design for an article of manufacture” to mean “design for a whole article of manufacture.” If one reads the statute that way and sees that *Zahn* allowed fragment claims, it would be natural to assume that *Zahn* ruled that the fragment was the “article.”

Some may argue that design patent fragment claiming should (or even must) be allowed because utility patent applicants are allowed to claim parts as separate “inventions.” This argument fails for at least two reasons. First, the mere fact that something is allowed in utility patent law or practice does not mean it should be imported into the design patent regime.273 Second, utility patent claims directed to something less than an entire “process, machine, manufacture, or composition of matter” can still qualify as utility patentable subject matter as “improvement[s]” thereto.274 Section 171, unlike § 101, does not authorize the issuance of say, hide elephants in mouseholes.” (first citing MCI Telecomms. Corp. v. Am. Telephone & Telegraph Co., 512 U.S. 218, 231 (1994); and then citing FDA v. Brown & Williamson Tobacco Corp., 529 U.S. 120, 159–160 (2000)). Of course, in other contexts, the phrase “for” may be used to refer to a physically separate article, e.g., a “patch for a jacket.” In that context, the phrase “a jacket” is really being used as a shorthand for “a hole in a jacket.” There is no evidence that in enacting the current language, Congress used the phrase “article of manufacture” to mean “part of an article of manufacture” or “design” to mean “part of a design.” To the contrary, according to the author’s research to date, reading this language to refer to whole design is perfectly consistent with the law and practice at the time that language was added to the statute in 1902. See generally infra note 271. It also appears to be consistent with USPTO practice at the time of the 1952 Act. See, e.g., *Ex parte Mars Signal-Light Co.*, 85 U.S.P.Q. 173 (Comm’r Pat. & Trademarks Apr. 25, 1950) (interpreting the phrase “configuration of goods” in Section 23 of the Lanham Act to refer “only the configuration of characteristic feature rather than the [shape of the whole] article itself” because the latter was design patentable subject matter).


273 For more on this point, see *supra* note 173.

274 See 35 U.S.C. § 101 (2012) (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”).
patents for “improvement[s].” This textual difference provides another reason to read § 171 as covering whole designs.

B. The Dicta from Blum

In its decision, the Zahn majority repeatedly berated the Patent Office for misunderstanding its “guidance” in Blum and “disregard[ing]” “the distinction . . . between a design for an article of manufacture and the article itself.” The majority stated that the Patent Office misinterpreted Blum when it revised the MPEP to say that “[d]otted lines for the purpose of indicating unimportant or immaterial features of the designed article are not permitted. There are no portions of a claimed design which are immaterial or unimportant.” According to the majority, Blum “did not . . . speak of a ‘designed article’ but of a design.” The majority also insisted, without any further citation or support, that “[a]n article may well have portions which are immaterial to the design claimed.”

It is true that Blum did not use the phrase “designed article.” And it is true that the dicta in Blum does appear to be trying to lay the

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276 See In re Zahn, 617 F.2d 261, 265 (C.C.P.A. 1980). Technically, this passage was presented as a summary of the applicant’s arguments, but it also seems to fairly capture the opinion of the Zahn majority.
277 Id. at 262. The majority also suggested that the applicant, who relied on Blum, didn’t really understand Blum. Id. at 265 n.5 (“Even appellant has had some difficulty, before us as well as before the board, in following his own insight at times as when, for example, he speaks of granting a design patent for an article of manufacture, or of claiming a ‘drill tool.’ A design patent is, in every case, for a design.”). Perhaps whatever Judge Rich meant to say in Blum was not as easily understandable as he seemed to think it was in Zahn.
278 See id. at 265 n.4, 267 (“Blum does not support the present MPEP language.” (referring to MPEP 3d ed. § 1503.02)). The Zahn majority also insisted that it could not understand why the Board “felt constrained” to reject Zahn’s claim in light of Blum but insisted that it had no idea why the Board felt that way. See id. at 268 (“The board 'felt constrained' to make its holding by our 1967 Blum opinion but did not say why. Nor do we see why.”). But the Board’s view in Zahn—like the Patent Office’s revision of the MPEP post-Blum—makes perfect sense if the Patent Office had, in fact, understood a configuration “design” to be a design for the configuration of an entire article.
279 See id. at 267 (referring to In re Blum, 374 F.2d 904, 907 (C.C.P.A. 1967)).
280 Id.
281 Blum, 374 F.2d at 907.
foundation for a decision like Zahn. But that part of Blum was unsupported ipse dixit in addition to being dicta. As such, it is hardly compelling evidence in favor of the majority’s decision in Zahn.

And, as noted above, it is true that the statute protects “designs for articles” and not “articles” qua articles. And we should distinguish between the concept of a “design” and the concept of an “article.” But the fact that those concepts are analytically distinct does not mean that fragment designs must be considered design patentable subject matter. In other words, there is no reason why a court could not rationally interpret “design for an article of manufacture” as a “design for a whole article of manufacture.” And even if we accept the premise that “[a]n article may . . . have portions which are immaterial to the design claimed,” it does not follow that any and all portions must be equally capable of being deemed “immaterial,” let alone that the decision of materiality must be left to the sole discretion of the patent applicant.

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282 See id.

283 See id. In Blum, Judge Rich suggested that this distinction was supported by some language in the MPEP. See id. (“There is a distinction to be observed between parts of the total article illustrated, in which a new design is embodied, and parts of that article which embody none of the design. Such a part is, presumably, what the Manual means by the reference to ‘an immaterial part of the design.’”). However, this presumption is questionable, to say the least. See supra note 91.

284 The dissenting judges in Zahn also took this view. See Zahn, 617 F.2d at 272 (Baldwin, J., dissenting) (“The dicta of Blum made the distinction between a design for an article and an article in which a design is embodied. I hesitate to regard that dicta as a sufficient basis for extending the scope of § 171 to provide protection for a design for a portion of an article when the drawing is incapable of reflecting the overall visual effect of the entire article.”).

285 See supra note 267 and accompanying text.

286 See, e.g., Sections I.B.2 and I.B.3, supra.

287 Indeed, as discussed above, that is the most natural plain English reading of that phrase. See supra Section V.A.

288 See Zahn, 617 F.2d at 267.

289 For example, a rational design patent system might deem parts of an article that are not visible in everyday use to be “immaterial.” See infra note 349.
C. Historical Practice

The majority also averred that its ruling was “not inconsistent” with past USPTO practice. This point appears to have been made in response to the dissenting judges, who were “inclined to agree with the solicitor that the Northup view represents a uniform, consistent, long-standing view of the PTO and as such must be given consideration as an indicator of the meaning of the law.” Whether or not one is inclined to view past USPTO practice as persuasive—let alone binding—authority on any point of law, it is worth noting how weak the Zahn majority’s purported historical justifications really are.

The majority suggests that its ruling is consistent with historical practice by pointing to the copending Northup application and “a casual inspection of currently issued design patents in the 1979 Official Gazette” which, according to the majority, showed that the USPTO “regularly” granted “designs for parts of articles.” Elsewhere in its decision, the majority also invokes the Supreme Court’s decision in Gorham v. White as precedent, presumably as evidence of past historical practices. This Section will discuss each of those items in the order the majority raised them and will explain why none of them provide much, if any, evidence in support of the majority’s ruling.

1. Northup Copending Application

Faced with the non-binding but highly analogous decision of the Board in Northup, the majority dismissed it as “a ‘one swallow does not
make a summer’ situation” and also attempted to undermine its reasoning as “inconsistent with the contemporaneous act of the PTO in issuing Northup patent No. D-89,448, referred to in the opinion in that case.” According to the majority:

Patent D-89,448, as here, has a claim referring to a complete article, namely, “an automobile body” but when the claim is read, as it must be, in conjunction with the specification and drawing, it is clear that the claim is for the design of the windshield portion only, which is shown in solid lines in the drawing, all the rest of the body being in dotted or broken lines.

The majority was correct in noting that the D’448 patent, which was issued the year after the Board’s decision in *Northup*, used dotted lines in its drawings:

![Diagram of an automobile with solid and dotted lines indicating the design of the windshield portion.]

However, it was by no means “clear” that its “claim is for the design of the windshield portion only.” Both the claim and the title of the

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295 Id. at 269. The majority was, of course, correct that “[o]ne board decision is not binding on the construction of a statute . . . .” Id. at 267. But curiously, while the majority insisted that it was “not saying the issuance of one patent is a precedent of much moment,” the majority did seem to put quite a bit of weight on the issuance of D’448 patent. See id.

296 See id. at 267.

297 Id.


299 See Zahn, 617 F.2d at 267.
D’448 patent referred to an “automobile body,” not merely a part thereof.300 In describing the drawings, the specification referred to the portion shown in full lines as “[t]he dominant feature of [the] new design,” not “the design” itself.301 According to the specification, “said dominant feature may be employed and embodied without substantial change, in the following conventional types of closed automobile bodies: coupés, four-door sedans, coaches or two-door sedans and victorias.”302 But this does not mean that the claim itself was actually limited to the part shown in solid lines—or that the Patent Office thought the “design” consisted solely of the windshield portion.303 Indeed, in *Northup* itself, the Board referred to the D’448 patent as containing “a claim to the complete body.”304

Although a full history of the “dominant feature” claiming convention is beyond the scope of this Article, a few points are worth mentioning. First, calling something a “dominant feature” implies that the thing is not, in fact, “the design” but merely a feature thereof.305 And while it’s not clear that there was one consistent

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301 Id. col. 1 l. 15.
302 Id. col. 2 ll. 7–12.
303 It could mean, for example, that the USPTO thought the windshield portion was so distinctive that, if replicated, would necessarily result in an automobile body that, on the whole, looked “the same” as the complete automobile body shown in the D’448 patent. *See generally Burstein, The “Article of Manufacture” Today, supra* note 51, at 787 n.29 (*While some nineteenth-century design patents may appear to claim only part of a configuration or surface design, the Patent Office understood those claims to be something akin to advisory opinions as to which part or parts of the design, if replicated, would result in a product that looked so similar overall as to infringe.* (first citing Jennings v. Kibbe, 10 F. 669, 670–71 (C.C.S.D.N.Y. 1882); and then citing *Ex parte* Gérard, 1888 Dec. Comm’r Pat. 37, 45)). Even if this is the case, and mere duplication of the windshield was all that was, in fact, required for a court to find infringement, that is an *issue of scope* and is very different from saying that the windshield portion alone was “the design.”
305 This is also consistent with how the phrase “dominant feature” is—and was—used in trademark practice. *See, e.g.,* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:42 (5th ed. 2019) (*Although it is not proper to dissect a mark, one feature of a mark may be more significant and it is proper to give greater force and effect to that dominant feature.*); Gen. Baking Co. v. Gorman, 295 F. 168, 172 (D.R.I. 1924), aff’d, 3 F.2d 891 (1st Cir. 1925) (*It is true that a part of a trade-mark may become so significant or conspicuous
interpretation given to these “dominant feature” statements by either the USPTO or the courts, it appears that at least one point, the USPTO regarded a “dominant feature” statement as a “point of novelty” designation. According to the original MPEP:

Where there is more than one feature of novelty in a case, the principal feature may be emphasized in the description by a “dominant feature” clause. Likewise, if prior art has been cited which bears a general resemblance to the design under examination, it is permissible to emphasize some specific point of novelty as a “characteristic” or an “important” or an “essential” part of the design, or as “the dominant feature.”

At least under this MPEP, it appears that “dominant feature” statements were intended to emphasize certain parts of a claimed design, not to distinguish between claimed and unclaimed portions of a design. Granted this MPEP came out after Northup and is not, in and of itself, conclusive evidence on the issue of how the USPTO viewed the D’448 patent when it was issued. But it is a good reminder that drawing and claiming conventions have changed over time and contemporary readers should not assume that the dotted lines in an old design patent mean the same as they would in a contemporary design patent.

This leads to a larger difficulty in understanding and interpreting older design patent claims. In contemporary law and practice, a number of conceptually distinct concepts—statutory subject matter, disclosure, claim, and scope—have all basically collapsed in on top of each other. In the wake of Zahn, the “design” (statutory subject matter) is whatever is claimed, claiming is done mostly through drawings, and the patent is given scope commensurate to what is claimed. To oversimplify a bit,

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306 As noted above, one Commissioner’s view was not binding on others. See supra Section I.A. And, at the time the Patent Office used this “dominant feature” convention, there was the possibility of circuit splits in scope determinations as well as differences between the D.C. Circuit and CCPA on Patent Office appeals. See supra Section I.A.

307 MANUAL OF PATENT EXAMINING PROCEDURE § 17-4 (1948), http://www.uspto.gov/web/offices/pac/mpep/old/mpep_E0R0.htm [https://perma.cc/TY5T-QCXU].

308 For more on the contemporary test for design patent infringement, see Burstein, Intelligent Design & Egyptian Goddess, supra note 42.
under contemporary law, the design, the claim, and the scope is whatever is shown in the drawings. 309 But it has not always been that way. The USPTO’s rules for how designs can be claimed and how they have to be disclosed (including, but not limited to the rules for drawings) have changed over time. 310 And there appears to have been some variation, at least at some points, in how different courts interpreted and applied various design patent claiming conventions. Therefore, in evaluating pre-Zahn design patents, one cannot simply assume that any particular claiming convention (e.g., dotted lines) would have had the same

309 Design patent claims actually contain two parts: (1) a short verbal claim; and (2) one or more drawings. See MPEP, supra note 2, § 1503.01(III). There is a line of Federal Circuit cases, starting with In re Mann, which include statements to the effect that the claim “is limited to what is shown in the application drawings.” In re Mann, 861 F.2d 1581, 1582 (Fed. Cir. 1988) (not citing any precedents or other form of legal support). But none of these cases actually say that a court should—let alone must—ignore the verbal portion of the claim. See Curver Luxembourg, SARL v. Home Expressions Inc., 938 F.3d 1334, 1340 (Fed. Cir. 2019) (“[W]e hold that claim language can limit the scope of a design patent where the claim language supplies the only instance of an article of manufacture that appears nowhere in the figures.”).

310 For example, the rules about whether designs had to be claimed using words, drawings, or both, have changed over time. See, e.g., In re Mygatt, 26 App. D.C. 366 (D.C. Cir. 1905) (tracing some of the history of design patent claiming to that point and holding that the Patent Office could not categorically bar all design patent applicants from verbally describing their claims). The Patent Office’s rules about the use and meaning of broken lines have also changed. Compare, e.g., MANUAL OF PATENT EXAMINING PROCEDURE § 17-5 (1948) (the original MPEP stated that “[d]otted or broken line showing is . . . employed to show such portions of the article claimed which are not important”), with MPEP, supra note 2, § 1503.02(III) (now, “broken lines are not permitted for the purpose of indicating that a portion of an article is of less importance in the design” (citing In re Blum, 374 F.2d 904 (C.C.P.A. 1967))).

311 Compare, e.g., Ashley v. Weeks-Numan Co., 220 F. 899, 903 (2d Cir. 1915) (“The patentee having a patent with written specifications relating to an entirely new form of inkstand, he is entitled, not only to the exact design shown in his drawing of the patent, but also to the protection of the court against the making and marketing of inkstands which contain the dominant features of the design described in the specification.”), with In re Fee, 397 F.2d 329, 331 (C.C.P.A. 1968) (“Appellants contend that the showing of the ball and tee portion of the article in dotted lines with a ‘dominant feature’ clause in the patent specification limits the design claimed there to the base portion of the illustrated sprinkler. However . . . [t]he patent claim is not directed to the ornamental design for a base for a lawn sprinkler. It seems to us impossible to have a ‘lawn sprinkler’ sans the ball and tee features which constitute the sprinkler head or operating portion of the sprinkler.”). Judge Rich also seemed much less confident about the meaning of dotted lines in Fee than he was in Blum. See Fee, 397 F.2d at 332 (Rich, J., concurring) (“[D]ue to the dotted lines and the ‘dominant feature’ clause in the patent, I am not sure what is claimed therein. I think the attempt was to claim the base alone, without the ball and tee, but who would know?”).
meaning and effect that it does today.\footnote{\textit{See also supra Section V.C.2.} Similarly, contemporary readers should be careful to avoid reading older design patent cases with “\textit{Zahn goggles}”—i.e., assuming that phrases like “the claimed design” meant the same thing then that they do now.} It requires much more than simply reading a particular pre-\textit{Zahn} design patent to determine its actual scope and effect.

2. \textit{Gorham v. White}

After noting that neither \textit{Northup} nor the D’448 were binding and calling them “no more than food for thought,” the majority stated that it would “turn for guidance to a higher authority.”\footnote{\textit{In re Zahn}, 617 F.2d 261, 267 (C.C.P.A. 1980).} It then stated:

In the Supreme Court case of \textit{Gorham Co. v. White}, 81 U.S. (14 Wall.) 511, 20 L.Ed. 731 (1871), the design patent in suit was for a “new design for the handles of table-spoons and forks.” The drawing appears at 81 U.S. 521 and shows a design embodied in the handle of what appears to be a spoon, but could be a fork, the bowl or tine portion simply being omitted. The patent issued July 16, 1861, to Lewis Dexter, Jr. (see Circuit Court opinion, Fed.Cas. 5627). The law in effect at the time appears to have been § 11 of the act [sic] of March 2, 1861, 12 Stat. 248, which provided for patents on designs for, inter alia, “any new and original shape or configuration of any article of manufacture,” and thus had the same reference to “article of manufacture” found in the present statute, so far as configuration-of-goods designs are concerned. While \textit{Gorham} involved only the issue of infringement, validity not having been contested (81 U.S. at 512), the Supreme Court sustained the patent and reversed the lower court holding of non-infringement. Clearly, the case involved a design for unitary, one-piece articles of manufacture where in the design was embodied in only part of the article, namely, the handle. The claim there was directed to a design for a handle, comparable to appellant’s original attempt here to direct his claim to a design for a shank . . . .\footnote{\textit{Id.} at 267–68.}
It may be true that the Dexter patent315 “involved a design” wherein the design was, in some sense, “embodied” in only a fragment of the article.316 But that does not mean that the claim in the Dexter patent was either valid or actually “comparable” to the claim in Zahn.317

Because, as the majority acknowledged, validity was not at issue in Gorham, that case does not constitute any sort of precedent on the issue of the validity of the Dexter patent or the propriety of whatever practice the Patent Office used in issuing it.318 And even if the Supreme Court had considered the validity of the Dexter patent, the relevant statutory language changed in 1902.319 Therefore, even if Gorham had blessed the Dexter patent, that would not be directly relevant to how the new statutory language should be interpreted.320 Nonetheless, it may be that the majority was attempting to use the Dexter patent as evidence of past Patent Office practice.321 Of course, it could be that the Patent Office erred in granting the Dexter patent.322 But even if the Dexter patent were valid

315 Because the court referred to this as a patent “to Lewis Dexter,” this Article will call it the Dexter patent as well. But the patent actually had two other named inventors, John Gorham and Gorham Thurber. See Spoon and Fork Handle, U.S. Patent No. D1,440 (issued July 16, 1861).
316 Again, the court did not explain what it meant by “embodied in.” See Zahn, 617 F.2d at 267–68.
317 Additionally, as noted above, the “embodied in” language appears to have been invented by the CCPA. See supra note 162.
318 See 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”). Any unspoken suggestion the Supreme Court would have—or should have—raised the issue sua sponte if there were any problem with the patent is fundamentally unsound. See id.; see also U.S. CONST. art. III, § 2 (limiting the jurisdiction of the federal judiciary to actual “cases” or “controversies”).
320 Of course, one might argue that Congress intended to adopt past practice in passing the 1902 Act. But the Zahn majority did not make that argument and that issue is beyond the scope of this Article.
321 See Zahn, 617 F.2d at 267–68.
322 To err, of course, is human and at least some commentators have expressed the view that early design patent practice was not necessarily a model of clarity and consistency. For example, in the view of at least one nineteenth-century Commissioner, the Patent Office’s practices prior to 1869 had “not been uniform, and [...] the true practice [was] still to be adopted and followed.” Ex parte Bartholemew, 1869 Dec. Comm’r Pat. 103, 105; see also id. at 103 (stating that, by 1869,
and representative of past practice, it is far from “clear” that it was actually “comparable” to the claim at issue in Zahn. Here are the drawings in the Dexter patent:

The patent claims a design for “the handles of table spoons and forks.” At least superficially, there do seem to be some similarities between this claim and the claims at issue in Zahn; Dexter claimed “a part” and Zahn claimed “a part.” However, as the dissent in Zahn noted, the disclosure in the Dexter patent was unlike the disclosure in Zahn because “the disclosure [in the former] was clearly sufficient to allow the Court to evaluate the overall visual impression of those utensils.”

“questions have arisen concerning [design patents’s] 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”); William L. Symons, The Law of Patents for Designs 1–2 (1914) (“In 1871, Commissioner Leggett in discussing the intent of the design law stated that:—‘The practice of the office in granting design patents has not only been liberal but lax.’” (quoting Ex parte Parkinson, 1871 Dec. Comm’r Pat. 251)).

See Zahn, 617 F.2d at 267–68.


See id. l. 3.

Zahn, 617 F.2d at 270 (Baldwin, J., dissenting).
Dexter’s handle design was apparently intended to be combined with a limited set of standard spoon-bowl and fork-tine shapes. That is very different than the “potentially infinite number of” drill shapes contemplated by Zahn.

And, as noted before, sufficient disclosure and statutory subject matter are distinct concepts. The nineteenth-century Patent Office could have considered the statutory subject matter to be the appearance of the complete utensils and still accepted illustrations of the handles portions as an adequate visual disclosure. When dealing with utensils, the handles are often the most visually striking feature of the overall visual design. Therefore, it is plausible that the nineteenth-century Patent Office would have considered Dexter’s drawings sufficient to disclose the visual appearance of complete spoons and forks, even though the bowl and tine portions were not actually illustrated. Therefore, the mere issuance of the Dexter patent—the validity of which was, again, not disputed before the Supreme Court—does not mean the nineteenth-century Patent Office necessarily thought “the design” consisted of only the appearance of the handles.

Additionally, *Gorham* itself described an article-level test for infringement, not a test limited to a comparison of whatever was shown in solid lines. It could be that, in allowing the Dexter patent, the

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327 See Spoon and Fork Handle, U.S. Patent No. D1,440 l. 3 (issued July 16, 1861) (specifically claiming a design “for the handles of table spoons and forks”) (capitalization changed).

328 See Appellant’s Brief at 6, No. 79-560, In re Zahn (Fed. Cir. July 13, 1979) (“If this position were upheld, appellant would be forced, in the present instance, to file patent applications showing the drill tool shank in combination with every conceivable twist or cutting portion, a potentially infinite number of applications.”).

329 And of course, it is possible that the Patent Office got this wrong, since validity was not at issue in *Gorham*. See *supra* note 318 and accompanying text.

330 See, e.g., Gorham Co. v. White, 81 U.S. 511, 528 (1871) (“Experts, therefore, are not the persons to be deceived. Much less than that which would be substantial identity in their eyes would be undistinguishable in the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give.”). At least, that is how the test seems to have been understood in the nineteenth century. See, e.g., Jennings v. Kibbe, 10 F. 669, 670 (C.C.S.D.N.Y. 1882) (“In *Gorham* Co. v. White, 14 Wall. 511, the supreme court considered directly the question of identity in regard to a patent for a design. It held that the true test of identity of design is sameness of appearance,— in other words, sameness of effect upon the eye; that it is not necessary that the appearance should be the same to the eye of an expert, and that the test is the eye of an ordinary observer, the eyes of men generally, of observers of ordinary
examiner deemed the handle portion to be so visually striking that any fork or spoon in which it were replicated would necessarily look “the same” as the forks and spoons invented and produced by the patentee.\textsuperscript{331} This suggests the court considered “the design” to be the appearance of the article as a whole, not just appearance of the illustrated parts. Moreover, cutlery might be a type of product where the custom of matched sets is so strong and the application of a particular design to another customary member of that set so obvious that it might make sense to allow this type of design patent claiming.\textsuperscript{332}

But saying that this type of claiming makes sense for cutlery is very different than saying it makes sense for every type of product. And it’s definitely not the same as blessing what the applicant wanted in \textit{Zahn—}

\textsuperscript{331} See, e.g., \textit{Ex parte Gérard}, 1888 Dec. Comm’r Pat. 37, 47 (“Claims for distinctive and segregable parts of a design indicate the skilled judgment of the Office as to what parts and features of the design, if segregated from the whole and applied to an article of manufacture, would accord with the eye of the ordinary observer and preserve the identity of the original and entire design. Evidently such claims should be carefully scrutinized, otherwise the applicant may in the same patent cover a multiplicity of designs.”). \textit{See generally} Burstein, \textit{The “Article of Manufacture” Today}, supra note 51, at 787 n.29 (“While some nineteenth-century design patents may appear to claim only part of a configuration or surface design, the Patent Office understood those claims to be something akin to advisory opinions as to which part or parts of the design, if replicated, would result in a product that looked so similar overall as to infringe.”) (citations omitted).

\textsuperscript{332} \textit{See generally} Burstein, \textit{The Patented Design}, supra note 55, at 217–18 (“It would be possible, for example, to conceptualize a design for the configuration of a utensil handle as a unitary ‘patented design,’ even though it is meant to be applied to multiple articles of manufacture, such as forks and spoons.”); \textit{see also generally} \textit{In re} Schnell, 46 F.2d 203, 208 (C.C.P.A. 1931) (“To say, for example, that one who had invented a design for a tea set could not obtain a patent on the design for a tea set, but must be limited to a design for that particular one of the dishes shown, would be entirely out of harmony with the spirit and terms of the law. Though the patent show the design as applied to a saucer, yet if it be a design the mode and effect of which when applied to a cup or sugarbowl is obvious without further showing or explanation manifestly it would not be reasonable to require the applicant to take a series of patents to cover what is, in fact, one single invention—namely, a design for dishes broadly, not narrowly for a particular dish. The principal value of many of the most beautiful designs resides exactly in the adaptability of the design to several forms of articles.”).
namely, a design patent that would give it control over every bit that would fit a particular drill.333

In any case, the Patent Office’s precise reasoning in granting the Dexter patent in the form that it was granted is not clear. Nonetheless, it is possible to imagine principled reasons why the Patent Office would have allowed the Dexter claim that do not justify—let alone mandate—a regime of unbridled fragment claiming. And of course, the Patent Office could have just been interpreting the 1861 Act incorrectly when it granted the Dexter patent and others like it.334 Therefore, the mere existence of the Dexter patent does not provide any real evidence or support for either the result in Zahn or for the majority’s claims about past Patent Office practice.

3. Selections from the 1979 Official Gazette

The majority also cited “[a] casual inspection of currently issued design patents in the 1979 Official Gazette” as evidence that “designs for parts of articles [were] regularly patented” prior to Zahn.335 According to the majority, this was evidence that Northup did not represent any “uniform, consistent, long-standing view of the PTO.”336

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333 Although the applicant never came out and said so in so many words, it is obvious that this was the goal. See, e.g., Appellant’s Brief at 5–6, No. 79-560, In re Zahn (Fed. Cir. July 13, 1979) (“If this position were upheld, appellant would be forced, in the present instance, to file patent applications showing the drill tool shank in combination with every conceivable twist or cutting portion, a potentially infinite number of applications.”); see also Basic Hand Tools, Bureau of Naval Personnel Navy Training Course, NAVPERS 10085-A (Rev. 1963), Attachment to Examiner’s Answer App. No. 611,034 (Dec. 2, 1977), in Transcript of Record at 52, No. 79-560, In re Zahn (C.C.P.A. June 4, 1979) (noting that the shank portion “is shaped so that it may be attached to a drilling machine”).

334 It does appear that there are other old design patents that use a similar form of claiming/disclosure, suggesting that the Dexter patent was not a one-off. See, e.g., Spoon or Similar Article, U.S. Patent No. D78,097 (issued Mar. 26, 1929) (showing a spoon in all-solid lines with the bowl portion overlaid by a dotted-line depiction of fork tines).

335 In re Zahn, 617 F.2d 261, 269 (C.C.P.A. 1980) (first citing Chair or Similar Article, U.S. Patent No. D251,577 (issued Apr. 17, 1979); then citing Cabinet Which Houses Components Employed in Surgery, U.S. Patent No. D252,282 (issued July 3, 1979); then citing Pair of Automobile Headlamp Lenses, U.S. Patent No. D252,352 (issued July 10, 1979); and then citing Steering Wheel Rim, U.S. Patent No. D252,457 (issued July 24, 1979)).

336 Id. (internal quotations omitted).
While all of the cited patents use dotted lines and could, in some sense, be described as claiming designs for “parts,” they all appear to actually be quite different than the claim at issue in Zahn.337

The first patent identified by the majority is entitled “Chair or Similar Article.”338 Here are some representative drawings from that patent:339

As the Zahn majority noted, this patent shows the “pedestal support in dotted lines.”340 But the claim appears to be directed to a design for a component, not a fragment, of a chair—namely, the seat portion.341 Therefore, this claim is not analogous to the one at issue in Zahn.342

337 As noted above, one must be careful in comparing pre-Zahn design patents to contemporary claims. See supra Section V.C.1. However, it is still worth discussing what these patents appear to show.
338 U.S. Patent No. D251,577 (issued Apr. 17, 1979) (cited by Zahn, 617 F.2d at 269 n.8).
339 Id. figs.1, 2.
340 Zahn, 617 F.2d at 269 n.8.
341 The seat portion would, presumably, be built out of different material and manufactured as a physically-separate piece. While it is not clear from the drawings, the seat may be composed of pieces that would, themselves, also be considered components.
342 It would have been more accurate for the claim to refer to “the seat of a chair” instead of a chair. But it may have been the Patent Office’s practice at that time to give applicants significant
The second patent identified by the majority is entitled “Cabinet Which Houses Components Employed in Surgery.” Here is a representative drawing from that patent:

As the majority noted, this patent shows “3 instrument dials in dotted lines.” Those dials themselves appear to be separate components and the patent appears to be claiming the other components of the cabinet casing—components which, in theory, could be assembled prior to adding the dials, and thus would qualify as a separate “article of manufacture.” Thus, this applicant appears to have been claiming a design for a composite article—not a fragment.

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leeway in the identification of the relevant article. It may also be that the Patent Office thought that the seat portion was so distinctive that, if replicated, it would necessarily result in a chair that, as a whole, looked "the same" as the complete chair shown in the patent drawings. See Ex parte Northup, 24 U.S.P.Q. 63, 1932 WL 27333, at *1 (Pat. Off. Bd. App. 1932).

343 U.S. Patent No. D252,282 (issued July 3, 1979) (cited by Zahn, 617 F.2d at 269 n.8).

344 Id. fig.1.

345 Zahn, 617 F.2d at 269 n.8.
The third patent identified by the majority is entitled “Pair of Automobile Headlamp Lenses.”\textsuperscript{346} Here is a representative drawing from that patent:\textsuperscript{347}

[Diagram of a car's headlamp lenses]

As the majority noted, this patent shows the “whole car body and wheels in dotted lines.”\textsuperscript{348} But the patent does not claim a design “for a car body” or “for a car.” It claims a design for the headlamp lenses. And the patent drawings show the parts of those lenses that would be visible in everyday use.\textsuperscript{349}

\textsuperscript{346} U.S. Patent No. D252,352 (issued July 10, 1979) (cited by Zahn, 617 F.2d at 269 n.8).

\textsuperscript{347} Id. fig.1.

\textsuperscript{348} Zahn, 617 F.2d at 269 n.8.

\textsuperscript{349} Although other parts, like the backsides, might be visible in what the Federal Circuit would later call the “normal and intended use” of the lenses, see \textit{In re} Webb, 916 F.2d 1553, 1557–58 (Fed. Cir. 1990), that does not mean that those other parts would actually matter to consumers. It would be possible (and perhaps desirable, as a policy matter) to interpret the phrase “design for an article of manufacture” as a design for the parts that are visible in everyday use. In other words, the relevant “whole” might be the part or parts that are visible in everyday use. That would be consistent with the view “that design inventions have reference merely to the external appearance of the article and not to its interior construction, and for this reason the illustration should be confined to the external appearance.” \textit{Ex parte} Tucker, 1901 Dec. Comm'r Pat. 140, 141; see also MPEP, supra note 2, § 1503.02(l) (“Sectional views presented solely for the purpose of showing the internal construction or functional/mechanical features are unnecessary and may lead to confusion as to the scope of the claimed design. The examiner should object to such views and require their cancellation.” (first citing \textit{Ex parte} Tucker, 1901 Dec. Comm'r Pat. 140; and then citing \textit{Ex parte} Kohler, 1905 Dec. Comm'r Pat. 192)).
Thus, unlike the claim in *Zahn*, this claim would not cover an undisclosed and unlimited set of lens shapes—at least not as those shapes are seen in their everyday use.350

The fourth patent identified by the majority is entitled “Steering Wheel Rim for Motorcars and Watercraft.”351 Here are the drawings from that patent:

![Fig. 1](image1)

![Fig. 2](image2)

According to the majority, this patent shows an “integral supporting bracket in dotted lines.”353 It is not entirely clear what the majority meant by “integral” in this context. Elsewhere in its decision, the majority used the word “integral” to mean “all in one piece.”354 But the steering wheel disclosed here does not appear to be one that is constructed “all in one piece.”355 Instead, it appears to be directed to one of those steering wheels

350 And perhaps not even as they’re seen in the “normal and intended” use of the headlamps. See *Webb*, 916 F.2d at 1557–58.


352 *Id*. figs. 1, 2.

353 *Zahn*, 617 F.2d at 269 n.8.

354 *Id*. at 263 (“The drill bit is assumed to be integral—all in one piece.”).

355 It appears that the *Zahn* majority was using the word “integral” to describe both (what this Article calls) simple and composite articles. Compare *id*. at 267 (“[A]n article of manufacture—at least in one which is an integral or one-piece article such as a drill, or a screwdriver . . . .”), with *supra* Part II.
composed of multiple materials—e.g., wood and metal. Thus, this claim appears to be directed to the shape of a (complete) component, not a fragment. In any case, this claim is not obviously, on its face, analogous to the fragment claim at issue in Zahn.

Because all of these patents appear to claim designs for the shapes of components—not fragments—they are not actually inconsistent with Northup. Nor are they direct support for the fragment claim at issue in Zahn. If anything, these examples actually support the position taken by the Patent Office and the dissent in Zahn because they all appear to claim designs for the whole shapes (or at least, the whole shapes as seen in everyday use) of items that could, themselves, be considered articles of manufacture.

CONCLUSION

The CCPA’s decision in In re Zahn is fundamentally flawed and should be overruled. The majority’s semantic conceit—i.e., that a design for a part of an article can be a design “for” that article—is contrary to the plain text of 35 U.S.C. § 171. In adopting this conceit, the majority ushered in dramatic changes to U.S. design patent law without justifying (or perhaps even appreciating) the scope of those changes. The question of what constitutes a “design for an article of manufacture” deserves attention and debate, not semantic gymnastics and ipse dixit.

See, e.g., “Rare Vintage Racemark Raid 14” Mahogany Steering Wheel Mark Donohue Porsche, eBay, https://www.ebay.com/itm/Vintage-wood-350mm-Raid-Racemark-steering-wheel-14-Italian-made-Porsche-etc-/273783693873?oid=292774487366 [https://perma.cc/PDQ6-9LND] (copy of previous posting on file with author). While design patents do not cover materials, pieces made of different materials are presumably manufactured as physically separate pieces and would thus qualify as “components,” as that term is used here. See supra Part II.

See supra Section III.A.1.

Some may argue that there are policy or other reasons to treat fragment claims as analogous to (or even the same as) component claims. But, to be persuasive, any such arguments would have to contend with the very real practical and legal differences between component and fragment claims, see generally supra Part IV, and should not rely solely on the mere fact that both types of claims could, in some sense, be described as claims for “parts.”
Even if Zahn is not overruled, we should recognize that the way the CCPA uses the words “portion” and “part” in Zahn is vague and unhelpful. In future discussions of “portions” or “parts” of articles or products, it would be beneficial to distinguish between at least: simple articles, composite articles, components, end products, and fragments. This taxonomy should help avoid confusion and promote conceptual clarity in future discussions of design patentable subject matter.359

359 This taxonomy should work with any definition of “article of manufacture,” except one that counts fragments as articles.