

No. 15-_____

IN THE

Supreme Court of the United States

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG
ELECTRONICS AMERICA, INC., AND SAMSUNG
TELECOMMUNICATIONS AMERICA, LLC,

Petitioners,

v.

APPLE INC.,

Respondent.

**On Petition for a Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit**

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Design patents are limited to “any new, original and ornamental design for an article of manufacture.” 35 U.S.C. 171. A design-patent holder may elect infringer’s profits as a remedy under 35 U.S.C. 289, which provides that one who “applies the patented design ... to any article of manufacture ... shall be liable to the owner to the extent of his total profit, ... but [the owner] shall not twice recover the profit made from the infringement.”

The Federal Circuit held that a district court need not exclude unprotected conceptual or functional features from a design patent’s protected ornamental scope. The court also held that a design-patent holder is entitled to an infringer’s entire profits from sales of any product found to contain a patented design, without any regard to the design’s contribution to that product’s value or sales. The combined effect of these two holdings is to reward design patents far beyond the value of any inventive contribution. The questions presented are:

1. Where a design patent includes unprotected non-ornamental features, should a district court be required to limit that patent to its protected ornamental scope?
2. Where a design patent is applied to only a component of a product, should an award of infringer’s profits be limited to those profits attributable to the component?

(i)

RULE 29.6 STATEMENT

Samsung Electronics America, Inc. (“SEA”) is a wholly-owned subsidiary of Samsung Electronics Co., Ltd. (“SEC”), a publicly held corporation organized under the laws of the Republic of Korea. SEC is not owned by any parent corporation and no other publicly held corporation owns 10% or more of its stock. No other publicly held corporation owns 10% or more of SEA’s stock. Effective January 1, 2015, Samsung Telecommunications America, LLC (“STA”) merged with and into SEA, and therefore STA no longer exists as a separate corporate entity.

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