

United States Court of Appeals for the Federal Circuit

AUTOMOTIVE BODY PARTS ASSOCIATION,

Plaintiff-Appellant,

v.

FORD GLOBAL TECHNOLOGIES, LLC.,

Defendant-Appellee,

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF MICHIGAN IN CASE NO. 2:15-CV-10137
JUDGE LAURIE J. MICHELSON

COMBINED PETITION FOR PANEL REHEARING AND REHEARING EN BANC

Robert G. Oake, Jr.
Texas State Bar No. 15154300
Oake Law Office
700 S. Central Expy., Suite 400
Allen, Texas 75013
(214) 207-9066, rgo@oake.com

Paul M. Kittinger (P72754)
CARDELLI LANFEAR, P.C.
322 W. Lincoln
Royal Oak, MI 48067
(248) 544-1100
pkittinger@cardellilaw.com

Attorneys for ABPA

August 12, 2019

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Automotive Body Parts Association v. Ford Global Technologies, LLC
18-1613

CERTIFICATE OF INTEREST

Counsel for Plaintiff-Appellant certifies the following:

1. The full name of every party or amicus represented by me is:

Automotive Body Parts Association

2. The real name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

None

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

CARDELLI LANFEAR, P.C., Thomas G. Cardelli

5. Pursuant to Federal Circuit Rule 47.5, Appellant states as follows:

(a) A Petition for Writ of Mandamus was filed previously in this case titled *In re: Automotive Body Parts Association, Petitioner*, 2015-156. An order issued November 17, 2015 denying the petition. The composition of the panel was Judge Lourie, Judge Dyk, and Judge Hughes, order by Judge Dyk. The order is nonprecedential and unreported.

(b) The title and number of any case known to counsel to be pending in this or any other court that will directly affect or be directly affected by this court's decision in the pending appeal:

(2) *Ford Global Technologies, LLC v. New World International, Inc., et al.*, case number 2019-1746, pending in the United States Court of Appeals for the Federal Circuit.

August 12, 2019

/s/ Robert G. Oake, Jr.
Robert G. Oake, Jr.
Attorney for ABPA

TABLE OF CONTENTS

	<u>Page</u>
TABLE OF AUTHORITIES	ii
I. COUNSEL’S STATEMENTS IN ACCORDANCE WITH FED. CIR. RULE 35(B)(2)	1
II. POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY A PANEL OF THE COURT	3
III. THE ARGUMENT IN SUPPORT OF A REHEARING	4
A. This Court Misapprehends the Doctrine of Repair	4
1. The Subject Patents do not Claim a Hood and a Headlamp	4
2. The Claiming Test is Unworkable and the Test for Determining the Article of Manufacture for the Repair Doctrine should be the Embodiment Test	7
B. Complementary Functionality	9
1. This Court Misapprehended the Significance of the <i>Best Lock</i> Decision on the Issue of Complementary Functionality	10
2. A Complementary Design lacks a Conscious Design Choice and is not Ornamental when embodied in Repair/Replacement Parts	12
IV. THE ARGUMENT IN SUPPORT OF A REHEARING EN BANC	13
V. CONCLUSION AND RELIEF SOUGHT	17

TABLE OF AUTHORITIES

	<u>Page(s)</u>
<u>CASES</u>	
<i>Aiken v. Manchester Print Works</i> , 1 F. Cas. 245 (C.C.D.N.H. 1865)	9
<i>Amini Innovation Corp. v. Anthony California, Inc.</i> , 439 F.3d 1365 (Fed. Cir. 2006)	1, 17
<i>Apple, Inc. v. Samsung Electronics Co. Ltd.</i> , 11-cv-01846 (N.D. Cal., October 22, 2017)	7
<i>Berry Sterling Corp. v. Prescor Plastics, Inc.</i> , 122 F.3d 1452 (Fed. Cir. 1997)	1, 2, 17
<i>Best Lock Corp. v. Ilco Unican Corp.</i> , 94 F.3d 1563 (Fed Cir. 1996)	1, 3, 10, 11, 12, 13, 16
<i>Egyptian Goddess, Inc. v. Swisa, Inc.</i> , 543 F.3d 665 (Fed. Cir. 2008) (en banc)	4, 14
<i>Ethicon Endo-Surgery, Inc. v. Covidien, Inc.</i> , 796 F.3d 1312 (Fed. Cir. 2015)	1, 17
<i>Impression Products, Inc v. Lexmark International, Inc.</i> , 137 S. Ct. 1523 (2017)	1, 14, 15
<i>In re Carletti</i> , 328 F.2d 1020 (C.C.P.A. 1964)	10
<i>In re Schnell</i> , 46 F.2d 203 (C.C.P.A. 1931)	6
<i>In re Zahn</i> , 617 F.2d 261 (C.C.P.A. 1980)	7
<i>Jazz Photo Corp. v. Int'l Trade Comm.</i> , 264 F.3d 1094 (Fed. Cir. 2001)	13

<i>L.A. Gear, Inc. v. Thom McAn Shoe Co.</i> , 988 F.2d 1117 (Fed. Cir. 1993)	1, 16
<i>Quanta Computer Inc. v. LG Electronics, Inc.</i> , 553 U.S. 617 (2008)	1
<i>Static Control Components v. Lexmark Intern.</i> , 487 F.Supp.2d 830 (E.D. Ky. 2007), <i>affirmed</i> , 697 F.3d 387 (6 th Cir. 2012)	12
<u>CONSTITUTION</u>	
U.S. Constitution, Article 1, Section 8, Clause 8	12
<u>STATUTES AND RULES</u>	
35 U.S.C. § 171	12
35 U.S.C. § 289	7
Fed. Cir. Rule 35(B)(2)	1
<u>OTHER</u>	
MPEP 1504.01(c)	10

I. COUNSEL’S STATEMENTS IN ACCORDANCE WITH FED. CIR. RULE 35(B)(2)

Based on my professional judgment, I believe this appeal requires an answer to the following precedent-setting questions of exceptional importance:

A. Whether under the doctrine of repair as applied to design patents the article of manufacture being repaired is determined by an embodiment test similar to that used for method patents, *see Quanta Computer Inc. v. LG Electronics, Inc.*, 553 U.S. 617 (2008), by a claiming test similar to that used for utility patents, or by some other test, and whether the Panel decision conflicts with the general patent exhaustion principles expressed in *Impression Products, Inc v. Lexmark International, Inc.*, 137 S. Ct. 1523 (2017).

B. Whether in the case of repair/replacement parts, the ornamentality requirement for design patents is determined by the doctrine of complementary functionality, *see Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563 (Fed Cir. 1996), including whether complementary appearance is a factor to be considered.

C. In light of the different and conflicting standards for functionality as set forth in *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993), *Berry Sterling Corp. v. Prescor Plastics, Inc.* 122 F.3d 1452 (Fed. Cir. 1997), *Amini Innovation Corp. v. Anthony California, Inc.*, 439 F.3d 1365, 1371 (Fed. Cir. 2006), *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312 (Fed. Cir. 2015), and this Court’s panel opinion, what is the proper test for the

ornamentality requirement in design patents, and in particular, how does the alternative design test interact with the *Berry Sterling* factors and other factors used to determine functionality?

/s/Robert G. Oake, Jr.

Robert G. Oake, Jr.

Attorney of record for ABPA

II. POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY A PANEL OF THE COURT

A. Regarding the doctrine of repair, this Court misapprehended how its claiming test is improper and unworkable (and misidentified the article to be used in the repair analysis in this case), and failed to apprehend how the ABPA's proposed embodiment test correctly and consistently identifies the article to be used in a repair analysis and is supported by design patent law principles and policies.

B. Regarding invalidity due to lack of ornamentality, this Court misapprehended ABPA's argument on complementary functionality under *Best Lock, supra*, including that appearance can be a factor in a complementary functionality analysis involving repair/replacement parts.

III. THE ARGUMENT IN SUPPORT OF A REHEARING

A. This Court Misapprehends the Doctrine of Repair

This Court's opinion misapprehends design patent law related to doctrine of repair and creates an unworkable test. Like the "point of novelty" test for design patent infringement abandoned in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc), this Court's approach, which selects the article of manufacture based solely on claiming, is unworkable when applied to the many different fact patterns that can exist in design patent cases.

The core issue is what article of manufacture is to be used in the repair doctrine analysis. If it includes the F-150, then the repair doctrine applies and sales of parts embodying the claimed designs do not infringe. If the article is just the hood or headlamp, then the repair doctrine does not apply because the hood or headlamp is being replaced and not repaired.

ABPA's argument is that since the F-150 is the article sold and the claimed designs are embodied in the F-150, the repair doctrine applies under the general approach used for method patents. This Court held that the article used in the repair analysis is determined by how the design patent is claimed. This Court found that the hood and headlamp were claimed - so those should be the articles. As explained below, that is incorrect.

1. The Subject Patents do not Claim a Hood and a Headlamp

This Court states “to determine what repair rights apply, we look to what Ford actually claimed.” (Opinion, p.17). This Court also states “Ford chose to claim designs as applied to portions of particular components, and the law permits it to do so.” *Id.* This sentence does not identify what the “particular components” are. This Court then states “[t]hat the auto-body components *covered by Ford’s patents* may require replacement does not compel a special rule” and “the designs for Ford’s hood and headlamp *are covered by distinct patents....*” *Id.*

It is incorrect to say the hood and headlamp are “covered by Ford’s patents” and “are covered by distinct patents.” The drawings indicate that only *portions* of the hood and headlamp are claimed. In Patent D489,299, broken lines indicate only the top exterior portion of the hood is claimed:

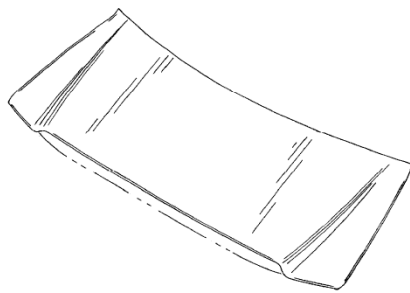


FIG. 1



FIG. 2

In Patent D501,685, broken lines indicate that portions of the headlamp design are disclaimed. The only portions claimed are the dominant and subdominant lamp with bezels and light caps, the reflector, and the side marker:

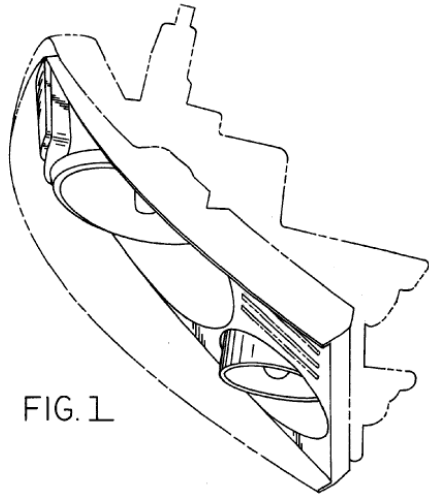


FIG. 1

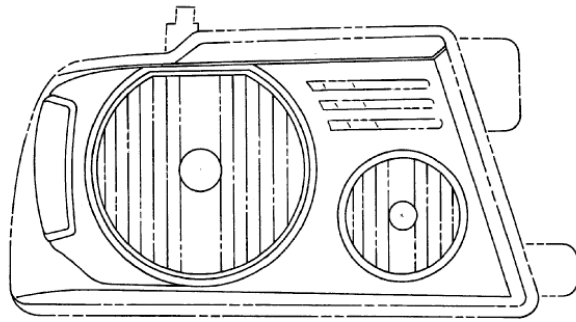


FIG. 2

It also is incorrect to say that a component is covered by a design patent claim. As this Court's predecessor court stated, "[t]he claim is not the article and is not the design PER SE, but is the design APPLIED." *In re Schnell*, 46 F.2d 203, 208 (C.C.P.A. 1931) (quoted citation omitted).

If an article for doctrine of repair purposes is determined by what is claimed, then the articles are not the hood and headlamp, but rather components thereof. However, this Court held that the articles were the hood and headlamp. To reach that conclusion, this Court is not applying a strict "claiming" test, but rather is applying a form of an "embodiment" test - because the claimed designs are embodied in the hood and headlamp. However, if an embodiment test is being used, then a flaw in this Court's reasoning is that the claimed designs also are embodied in the F-150 sold. This Court provides no reason why the F-150 also cannot be considered an embodiment of the claimed designs and an article for doctrine of repair purposes. Indeed, the only rationale provided by this Court is

the claiming test, and as explained above, the claiming test when properly applied does not identify the hood and headlamp as the articles, but rather portions thereof.¹ Since the F-150 is just as much an embodiment of the claimed designs as the hood and headlamp, there is no reason the F-150 cannot be an article used for the doctrine of repair.

2. The Claiming Test is Unworkable and the Test for Determining the Article for the Repair Doctrine should be the Embodiment Test

The claiming test will prove unworkable because a design patent can claim the entire design for an article or just a portion thereof. *See In re Zahn*, 617 F.2d 261, 267 (CCPA 1980). Using the example of a vehicle headlamp, it may be possible to claim just a small corner portion of the outer lens design. If that is what is claimed, and if the outer lens becomes cracked and needs repair, then what is the article for repair doctrine purposes under this Court's claiming test? Is it the smallest component part that embodies the claimed design? In the example above, is it the outer lens?

Under a claiming approach, if only the outer lens of the headlamp design is claimed, then it follows that the outer lens should be the article for a repair

¹ This Court does not state that the patent title is a factor when determining article of manufacture for repair analysis. ABPA therefore will not set forth a full explanation of why a title should not be considered a dispositive factor. ABPA notes, however, that the title of a design patent is not dispositive when determining what the article of manufacture is for purposes of 35 U.S.C. § 289. *See Apple, Inc. v. Samsung Electronics Co. Ltd.*, 11-cv-01846 (N.D. Cal., October 22, 2017).

analysis. However, this Court identifies the headlamp as the article to be used in a repair analysis even though only portions of the headlamp design are claimed. If, using this Court's approach, the headlamp is the article in the outer lens claim example and the outer lens is the only part that is damaged and replaced, then replacing the lens should be allowed under the repair doctrine because the headlamp is the identified article and only a portion of the headlamp is being replaced.

But if this Court's claiming approach is strictly followed and the outer lens is the article under the above example, then replacing the outer lens likely would be impermissible replacement rather than permissible repair. If the outer lens is determined to be the article under a claiming approach and the headlamp is determined to be the article under the same approach but with different portions of components claimed (as in the instant case), then the obvious problem and question is how the claiming approach comes up with such different results. ABPA respectfully suggests that there is no logical explanation or legal justification for the different results, which is an indication that the claiming approach as proposed by this Court is unworkable.²

² An additional problem is determining the article likely will require consideration of how the article is manufactured and whether the article can be replaced without also replacing another component. These factors are independent of claiming, further indicating a claiming approach is unworkable.

The problem with using claiming for determining the article under a repair analysis is that a design can be claimed that is a portion of an article or component part design.³ Portion claiming necessarily means that a claimed design simultaneously may be embodied in a parent article, a component part, a combination of component parts, or portions thereof. And since design portions can be claimed in many different ways that need not follow the contours or boundaries of articles or their components, creating a workable test that reliably and consistently can predict the correct article for repair analysis purposes by using a claiming approach is not achievable.

ABPA respectfully submits that the only test that will consistently and reliably work for determining the article for the repair doctrine is the embodiment test. When that test is used, infringement does not exist in this case.

B. Complementary Functionality

This Court characterized ABPA's argument to be that in a design patent functionality analysis, aesthetic functionality can be substituted for mechanical functionality. But that is not ABPA's argument.

³ This problem does not exist in utility patent law because under statute, the claim is of an article of manufacture, not for an article of manufacture. Therefore, there is no ambiguity as to what the article of manufacture is. For example, in *Aiken v. Manchester Print Works*, 1 F. Cas. 245 (C.C.D.N.H. 1865), it was the actual needle that was claimed and so there was no question but that the article of manufacture was the needle. That is not the case in design patent law, and that is why *Aiken* is not relevant to this case.

Rather, ABPA’s argument is that because the claimed designs are embodied in parts being used for repair/replacement, the complementary functionality doctrine from *Best Lock* applies.⁴ Under this doctrine, the time to analyze whether a design is ornamental is *after* the designs are created and when the sole issue is whether the subject design is the only design that can fulfill the complementary function.⁵ If there is only one design that can do so, then the design is not ornamental because there are no conscious design choices to be made either by the inventor or by the consumer. Under complementary functionality, it does not matter whether the complementary function is due to aesthetics, shape, or mechanics – as explained below.

1. This Court Misapprehended the Significance of the *Best Lock* Decision on the Issue of Complementary Functionality

The ultimate issue when determining ornamentality is whether the design is consciously created for the purposes of ornamenting. *See* MPEP 1504.01(c) (“It is clear that the ornamentality of the article must be the result of a conscious act by the inventor....”) (emphasis added); *see also In re Carletti*, 328 F.2d 1020, 1022

⁴ Judge Newman’s *Best Lock* dissent mentions complementary designs, 94 F.3d at 1569, and ABPA’s counsel argued complementary functionality during oral argument.

⁵ This Court states “ABPA fails to explain” how the District Court’s finding that “the design of an auto-body part is important to consumers at least when they are deciding which car to buy.” (Opinion, p. 10, 11). The finding is not relevant under *Best Lock* because the relevant time to analyze complementary functionality is when the purchaser is buying a repair/replacement part and not when the vehicle is originally purchased.

(CCPA 1964). A design created for the purpose of fulfilling a complementary function is not created for the purpose or ornamenting. Although the *original* design may have been created for the purposes of ornamenting and may be patent eligible if properly claimed, when the design is not claimed as a combination but rather as a complement, it may be invalid under complementary functionality as explained by this Court in the *Best Lock* case.

An explanation of how this Court misunderstood the significance of the *Best Lock* case illustrates these principles. This Court states that “*Best Lock* turned on the admitted fact that no alternatively designed blade would mechanically operate the lock—not that the blade and lock were aesthetically compatible.” (Opinion, pp. 9, 10). However, it was not the mechanical ability of the key to fit in the lock that prevented the key from being patentable. Indeed, many ornamental items have mechanical functions, and this Court implied in *Best Lock* that despite the key’s unique ability key to fit into the lock, the result would have been different had the key and lock been claimed as a combination. The functionality issue arose because the key and lock profiles were designed together as complementary items, and then the key blade profile was claimed by itself.

As Judge Newman stated in her dissent: “[i]n holding that because the key must fit a keyway, the abstract design of the key profile is converted to one solely of function, the court creates an exception to design patent subject matter.” 94

F.3d at 1569. Explaining further, and making ABPA’s point, Judge Newman stated: “[a]n arbitrary design of a useful article is not statutorily excluded from § 171 simply because in use it interacts with an article of complementary design.” *Id.*

When *Best Lock* is understood in terms of complementary functionality, it is consistent with the policies underlying design patent law. If there is not a conscious design choice made, then the underlying purposes of design patent are not served, which are “To Promote the Progress of Science and the useful Arts.” U.S. Constitution, Article 1, Section 8, Clause 8. There are no conscious design choices made by the inventor when producing a replacement part with a complementary design because all design choices were made when the complementary designs originally were created. And a purchaser is not making the same type of purchasing design choice they made when they originally purchased the F-150. The purchaser simply is keeping the original design and can order the repair/replacement part by part number. *See Static Control Components v. Lexmark Intern.*, 487 F.Supp.2d 830, 841 (E.D. Ky. 2007), *affirmed*, 697 F.3d 387 (6th Cir. 2012) (holding printer cartridges functional in part because “customers can purchase replacement cartridges for printers online by model number.”).

2. A Complementary Design lacks a Conscious Design Choice and is not Ornamental when embodied in Repair/Replacement Parts

Under *Best Lock*, it makes no difference that the lack of a conscious design choice is due to aesthetic or appearance reasons, or due to mechanical reasons. Indeed, to restore a vehicle back to its original appearance, which is the only purpose for the parts embodying the claimed design portions, purchasing a part embodying the original design is just as important as getting a replacement key to fit into the original lock. Without the properly designed key, the key won't fit into the lock. Without a part embodying the original claimed design, the vehicle will not be restored to its original appearance. When the holding of the *Best Lock* case is applied to this case, the subject designs are invalid as non-ornamental.

IV. THE ARGUMENT IN SUPPORT OF A REHEARING EN BANC

This petition for rehearing en banc involves three exceptionally important questions. The first, which ABPA believes to be a question of first impression, is how to determine what article of manufacture to use in a doctrine of repair analysis involving design patents. Although this Court has made it clear that the patent exhaustion doctrine and the repair doctrine apply to design patents, *see Jazz Photo Corp. v. Int'l Trade Comm.*, 264 F.3d 1094, 1110 (Fed. Cir. 2001), this Court has not had the opportunity to address how the repair doctrine works and how the article should be selected that is analyzed for repair.

The Panel opinion held that the article should be determined by the way the design patent is claimed. This Court's new claiming test for determining the

article in a repair analysis suffers from the same type problems as the now abandoned “point of novelty” test for design patent infringement: it is difficult to apply when in addition to the article sold, there are numerous article components and portions of article components that embody the claimed design. *See Egyptian Goddess, supra*, at 671 (explaining problems with point of novelty test). The flaws in the claiming approach should be recognized and addressed now, and a proper embodiment test should be adopted for determining the article under the doctrine of repair.

In addition to avoiding the problems inherent in the claiming approach, ABPA’s proposed embodiment test is consistent with general patent exhaustion principles, policy considerations, the doctrine of repair, and the embodiment approach used for method patents. Ford sold, and the purchaser bought, an F-150. The purchaser did not select from and purchase individual component parts and then have them assembled into a truck. The F-150 therefore is the article sold to which patent exhaustion and the right of repair apply.⁶

In *Impression Products, supra*, the Supreme Court stated “[w]e conclude that a patentee’s decision to sell a product exhausts all of its patent rights in that

⁶ In a potentially confusing portion of this Court’s opinion, this Court states “[b]ut exhaustion attaches only to items sold by, or with the authorization of, the patentee,” (Opinion, p. 12) and “ABPA’s members’ sales are not authorized by Ford; it follows that exhaustion does not protect them.” (*Id.* at p.13). ABPA is not arguing that ABPA members’ sales creates patent exhaustion and repair rights, but rather that Ford’s sale of the F-150 creates patent exhaustion and repair rights.

item,” *id.* at 1529, and “[in] sum, patent exhaustion is uniform and automatic.” *Id.* at 1535. Notably, the example chosen by the Supreme Court to illustrate the principle involved repairing cars:

The business works because the shop can rest assured that, so long as those bringing in the cars own them, the shop is free to repair and resell those vehicles. That smooth flow of commerce would sputter if companies that make the thousands of parts that go into a vehicle could keep their patent rights after the first sale.

Id. at 1532. ABPA respectfully submits that the panel decision conflicts with the general principles expressed in *Impression Products*.

The ABPA’s proposed embodiment test also is consistent with the doctrine of repair, which involves an implied license. The scope of an implied license is determined by the circumstances of the sale including the reasonable expectations of the parties. The F-150 is sold as a complete truck and Ford places no restrictions on the implied license granted. There is no evidence that Ford marks the F-150 component parts with patent numbers. Therefore, when a customer purchases an F-150, they have no notice, actual or constructive, that the hood and headlamp are separately patented.⁷ Finally, to the extent a customer may be aware

⁷ This Court states “[e]ven if purchasers are unaware—and ABPA cites no factual support for that assertion—direct infringement does not require knowledge of a patent.” (Opinion, p.17, n.4). The factual support is that there is no evidence that Ford marks its products or gave any actual notice of the patents to purchasers. Further, the lack of constructive and actual notice, while not relevant on the issue of direct infringement, is relevant on the issue of reasonable expectation of the parties and scope of the implied license.

of the subject design patents, the subject patents state the hood and headlamp are “intended for attachment to a vehicle.” Based on this evidence, the reasonable expectation is that a purchaser of the F-150 receives an implied license to repair the F-150 free from any patents claiming portions of the designs.

The test for determining what article is used in a repair analysis is of far-reaching significance because it determines whether manufacturers may use design patents to control the aftermarket for repair/replacement parts. If the Panel decision is allowed to stand, then future cases will reveal the unworkability of the claiming approach. This Court should accept this case en banc to resolve this issue before the case confusion occurs.

The second question involves whether the doctrine of complementary functionality from *Best Lock* should apply to this case and whether appearance is a factor to be used in the complementary functionality analysis. As explained in the Petition for Panel Rehearing, ABPA believes the Panel opinion conflicts with *Best Lock*.

The third question, related to the second, involves what is the proper test for ornamentality? There have been at least three different standards articulated by this Court and it is unclear how these different standards interact. First, there is a “dictated by function” standard, *see L.A. Gear, supra*, where the availability of alternative designs is relevant. Second, there is a list of non-exclusive factors

including “best design,” *see Berry Sterling, supra*. Third, there is a standard that asks whether the design “is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Amini Innovation Corp., supra*, at 1371.

In *Ethicon, supra*, this Court stated that an inquiry into functionality should begin with an inquiry into the existence of alternative designs," and the focus often has been “on the availability of alternative designs as an important – if not dispositive - factor” *Id.* at 1329, 1330. (emphasis added). This Court’s decision in this case appears to change the *Ethicon* standard by stating that the presence or absence of alternative designs is “not dispositive.” (Opinion, p. 6). This Court should accept this case en banc to harmonize the conflicting panel opinions, to explain whether “alternative designs” is dispositive, and to determine whether the *Berry Sterling* factor of “best design” is broad enough to include appearance considerations in the repair/replacement part context. Finally, this Court should decide en banc whether the issue of functionality in the invalidity context is an issue of fact or law. This issue was raised in ABPA’s brief, see Doc. 21, pp. 38, 39, but not reached by the panel decision. (Opinion, p. 5, n. 1).

V. CONCLUSION AND RELIEF SOUGHT

For the foregoing reasons, ABPA respectfully requests that its combined petition for panel rehearing and rehearing en banc be granted as described herein.

August 12, 2019

Respectfully submitted,

/s/ Robert G. Oake, Jr.

Robert G. Oake, Jr.

Texas Bar No. 15154300

Oake Law Office

700 S. Central Expy., Suite 400

Allen, Texas 75013

Telephone: 214.207.9066

rgo@oake.com

Paul M. Kittinger (P72754)

CARDELLI LANFEAR, P.C.

322 W. Lincoln

Royal Oak, MI 48067

(248) 544-1100

pkittinger@cardellilaw.com

Attorneys for ABPA

CERTIFICATE OF COMPLIANCE

1. This Combined Petition complies with the word limitation of Federal Rules of Appellate Procedure 35(b)(2). This Combined Petition contains 3,884 words, excluding the parts of the brief exempted by the Federal Rules of Appellate Procedure 35(c)(2).

2. This brief complies with the typeface requirements of Federal Rules of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rules of Appellate Procedure 32(a)(6). This brief has been prepared in a proportionally spaced typeface using Microsoft Word in 14 point Times New Roman font.

/s/ Robert G. Oake, Jr.
Robert G. Oake, Jr.
Attorney for ABPA
August 12, 2019

ADDENDUM - PANEL DECISION

United States Court of Appeals for the Federal Circuit

AUTOMOTIVE BODY PARTS ASSOCIATION,
Plaintiff-Appellant

v.

FORD GLOBAL TECHNOLOGIES, LLC,
Defendant-Appellee

2018-1613

Appeal from the United States District Court for the Eastern District of Michigan in No. 2:15-cv-10137-LJM-RSW, Judge Laurie J. Michelson.

SEALED OPINION ISSUED: July 11, 2019
PUBLIC OPINION ISSUED: July 23, 2019*

ROBERT GLENN OAKE, JR., Oake Law Office, Allen, TX, argued for plaintiff-appellant. Also represented by PAUL KITTINGER, Cardelli Lanfear PC, Royal Oak, MI.

JESSICA LYNN ELLSWORTH, Hogan Lovells US LLP, Washington, DC, argued for defendant-appellee. Also represented by KATHERINE BOOTH WELLINGTON; FRANK A.

* This opinion was originally filed under seal and has been unsealed in full.

ANGILERI, MARC LORELLI, Brooks Kushman PC, Southfield, MI.

Before HUGHES, SCHALL, and STOLL, *Circuit Judges*.

STOLL, *Circuit Judge*.

This case involves both differences and similarities between design patents and utility patents. A design patent protects a “new, original and ornamental design for an article of manufacture.” 35 U.S.C. § 171(a). While established law bars design patents on primarily functional designs for lack of ornamentality, utility patents must be functional to be patentable. In many other ways though, design and utility patents are similar. Section 171(b) of Title 35 demands as much, directing that the requirements that apply to “patents for inventions shall apply to patents for designs” unless otherwise provided.

Here, we decide what types of functionality invalidate a design patent and determine whether long-standing rules of patent exhaustion and repair rights applicable to utility patents also apply to design patents. Automotive Body Parts Association (ABPA) asks us to hold that the aesthetic appeal—rather than any mechanical or utilitarian aspect—of a patented design may render it functional. And it asks us to expand the doctrines of exhaustion and repair to recognize the “unique nature” of design patents. Both theories invite us to rewrite established law to permit ABPA to evade Ford Global Technologies, LLC’s patent rights. We decline ABPA’s invitation and affirm the district court’s summary judgment.

BACKGROUND

I

Ford’s U.S. Patent No. D489,299 and U.S. Patent No. D501,685 protect designs used in certain models of Ford’s F-150 trucks. The D’299 patent, titled “Exterior of

AUTO. BODY PARTS ASS'N v. FORD GLOB. TECHS., LLC

3

Vehicle Hood,” claims “[t]he ornamental design for exterior of vehicle hood.” Figure 1, below, illustrates the hood.

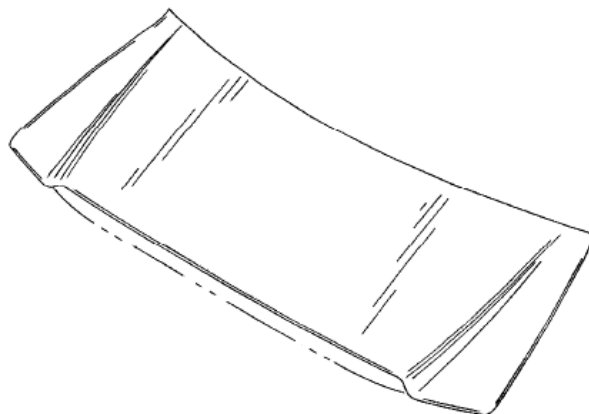


FIG. 1

The D'685 patent, titled “Vehicle Head Lamp,” claims “[t]he ornamental design for a vehicle head lamp,” as shown in Figures 1 and 2, reproduced below.

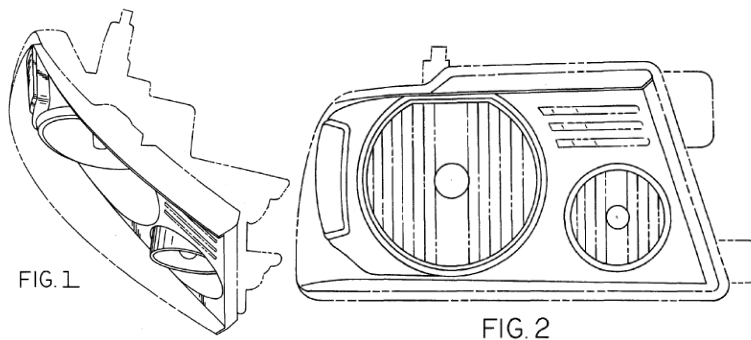


FIG. 1

FIG. 2

The inventors of these designs are artists holding Bachelor of Fine Arts degrees from the College for Creative Studies. In a declaration, one inventor explained that the inventors had “full control and responsibility for the exterior appearance of the . . . Ford F-150 truck,” that “the design team created and selected part designs based on aesthetic appearance,” and that although engineers reviewed the final designs, “[t]here were no changes to the aesthetic

designs of the[] parts based on engineering or functional requirements.” J.A. 2538–39.

II

ABPA, an association of companies that distribute automotive body parts, clashed with Ford at the International Trade Commission when Ford accused a number of ABPA members of infringing the D’299 and D’685 patents, among others. The ITC actions eventually settled, but only after the administrative law judge ruled that “respondents’ [invalidity] defense that the asserted patents do not comply with the ornamentality requirement of 35 U.S.C. § 171 has no basis in the law,” J.A. 256, and that “there is no legal basis for respondents’ assertion of [unenforceability based on] either the patent exhaustion or permissible repair doctrines,” J.A. 242.

Undeterred, ABPA sued Ford in district court, seeking a declaratory judgment of invalidity or unenforceability of the D’299 and D’685 patents. ABPA eventually moved for summary judgment. The district court considered ABPA’s arguments and denied the motion, noting that ABPA “effectively ask[ed] this Court to eliminate design patents on auto-body parts.” *Auto. Body Parts Ass’n v. Ford Glob. Techs., LLC*, 293 F. Supp. 3d 690, 694 (E.D. Mich. 2018). Though Ford had not moved for summary judgment, the district court announced its intention to enter judgment in favor of Ford sua sponte pursuant to Federal Rule of Civil Procedure 56(f)(1). *Id.* at 707. ABPA responded, agreeing that it had not “include[d] any additional argument, authorities, or evidence beyond that which has already been considered by this Court,” and stating that it “d[id] not object to the prompt entry of final judgment so that [it could] file a notice of appeal.” J.A. 2149. The district court entered summary judgment, and ABPA appeals.

AUTO. BODY PARTS ASS'N v. FORD GLOB. TECHS., LLC

5

DISCUSSION

We review the district court's sua sponte grant of summary judgment under the law of the regional circuit. See *Charles Mach. Works, Inc. v. Vermeer Mfg. Co.*, 723 F.3d 1376, 1378 (Fed. Cir. 2013). In the Sixth Circuit, “[t]he substance of the district court’s decision is reviewed de novo under the normal standards for summary judgment.” *Leffman v. Sprint Corp.*, 481 F.3d 428, 430 (6th Cir. 2007) (“The district court’s procedural decision to enter summary judgment sua sponte, however, is reviewed for abuse of discretion.” (quoting *Shelby Cty. Health Care Corp. v. S. Council of Indus. Workers Health & Welfare Trust Fund*, 203 F.3d 926, 931 (6th Cir. 2000))). Accordingly, we determine whether, after weighing all inferences in favor of ABPA, Ford is entitled to judgment as a matter of law.¹ See *Leary v. Daeschner*, 349 F.3d 888, 897 (6th Cir. 2003).

I

We first address ABPA’s invalidity arguments. Section 171 of Title 35 authorizes patents claiming “new, original and *ornamental* design[s] for an article of manufacture.” 35 U.S.C. § 171(a) (emphasis added). Our precedent gives weight to this language, holding that a design patent must claim an “ornamental” design, not one “dictated by function.” See, e.g., *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1315 (Fed. Cir. 2013). We have recognized, however, that a valid design may contain some functional elements. After all, “a design patent’s

¹ Ordinarily, we review a district court’s determination of whether a patented design is invalid due to functionality for clear error. See *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1328 (Fed. Cir. 2015). ABPA invites us to revisit this standard and establish de novo review. Given the de novo standard inherent in review of summary judgment, we do not reach this question.

claim protects an article of manufacture, which ‘necessarily serves a utilitarian purpose.’” *See Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1320 (Fed. Cir. 2016) (quoting *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993)). But a design patent may not claim a “primarily functional” design. *Id.* “If [a] particular design is essential to the use of the article, it can not be the subject of a design patent.” *L.A. Gear*, 988 F.2d at 1123.

While “[w]e have not mandated applying any particular test,” certain considerations assist courts in assessing whether a design is dictated by function. *Ethicon*, 796 F.3d at 1329. These include:

[W]hether the protected design represents the best design; whether alternative designs would adversely affect the utility of the specified article; whether there are any concomitant utility patents; whether the advertising touts particular features of the design as having specific utility; and whether there are any elements in the design or an overall appearance clearly not dictated by function.

Berry Sterling Corp. v. Pescor Plastics, Inc., 122 F.3d 1452, 1456 (Fed. Cir. 1997). We have often emphasized the presence or absence of alternative designs, noting that the existence of “several ways to achieve the function of an article of manufacture,” though not dispositive, increases the likelihood that a design serves a primarily ornamental purpose. *Id.* (quoting *L.A. Gear*, 988 F.2d at 1123); *see also Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344, 1361 (Fed. Cir. 2015) (affirming ornamentality where record showed “alternate designs available achieve the same utilitarian purpose”), *vacated on other grounds*, 137 S. Ct. 589 (2016); *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002) (“[I]f other designs could produce the same or similar functional capabilities, the design of the article in question is likely ornamental, not functional.”).

A

ABPA posits (without record support) that consumers seeking replacement parts prefer hoods and headlamps that restore the original appearance of their vehicles. It concludes that there is a functional benefit to designs that are aesthetically compatible with those vehicles. *See, e.g.*, Appellant's Br. 8–9 (“The function of the claimed designs includes their appearance . . .”). From there, rather than arguing that Ford's designs are functional because they achieve some mechanical or utilitarian goal, ABPA argues that Ford's hood and headlamp designs are functional because they aesthetically match the F-150 truck. But ABPA does not identify, nor can we find, any design patent case ruling aesthetic appeal of this type functional.

We hold that, even in this context of a consumer preference for a particular design to match other parts of a whole, the aesthetic appeal of a design to consumers is inadequate to render that design functional. As the Supreme Court acknowledged almost 150 years ago, “giving certain new and original appearances to a manufactured article may enhance its salable value, [and] may enlarge the demand for it.” *Gorham Mfg. Co. v. White*, 81 U.S. 511, 525 (1871). But regardless of the market advantage conferred by a patented appearance, competitors may not utilize a protected design during the patent's life. *See id.*; *see also* 35 U.S.C. § 289. To hold that designs that derive commercial value from their aesthetic appeal are functional and ineligible for protection, as ABPA asks, would gut these principles. The very “thing . . . for which [the] patent is given, is that which gives a peculiar or distinctive appearance,” its aesthetic. *Gorham*, 81 U.S. at 525. If customers prefer the “peculiar or distinctive appearance” of Ford's designs over that of other designs that perform the same mechanical or utilitarian functions, that is exactly the type of market advantage “manifestly contemplate[d]” by Congress in the laws authorizing design patents. *Id.*

B

ABPA's contrary arguments are unpersuasive. It first asks us to borrow the principle of "aesthetic functionality" from trademark law. In that context, courts have explained that a party cannot use trademark protection to prevent its competitors from using "important product ingredient[s]," *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 170 (1995), or "from making their products as visually entrancing as [its] own," *Pub'ns Int'l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 339 (7th Cir. 1998) (Posner, J.) (explaining that trademark and trade dress protection are unavailable "if consumers derive a value from the fact that a product looks a certain way that is distinct from the value of knowing at a glance who made it"). In *Qualitex*, the Supreme Court permitted a party to trademark a particular color only after explaining that protection might not be available if the "color serve[d] a significant nontrademark function." *Qualitex*, 514 U.S. at 170.

ABPA acknowledges that no court has applied "aesthetic functionality" to design patents, but it asks us to become the first. Appellant's Br. 28–29. We decline. Though trademarks and design patents have certain similarities, *see id.* at 29–30, it does not follow that trademark principles apply equally to design patents. Trademarks and design patents serve different purposes and have different governing law. Trademarks promote competition by permitting a perpetual monopoly over symbols that "distinguish[] a firm's goods and identif[y] their source, without serving any other significant function." *Qualitex*, 514 U.S. at 166. Trademarks ensure that a particular producer reaps the rewards—and bears the risks—of its products' quality and desirability. *See id.* at 163–64. It follows that a company may not indefinitely inhibit competition by trademarking features, whether utilitarian or aesthetic, "that either are not associated with a particular producer or that have value to consumers that is independent of identification." *Pub'ns Int'l*, 164 F.3d at 339; *see also*

Qualitex, 514 U.S. at 164–65 (holding companies may not “inhibit[] legitimate competition” by trademarking desirable features to “put competitors at a significant non-reputation-related disadvantage”). In contrast, design patents expressly grant to their owners exclusive rights to a particular aesthetic for a limited period of time. *See Qualitex*, 514 U.S. at 164; *see also* U.S. Const. art. I, § 8, cl. 8. The considerations that drive the aesthetic functionality doctrine of trademark law simply do not apply to design patents.

ABPA also attempts to justify its functionality argument with reference to our case law, but it misunderstands our precedent. In *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563 (Fed. Cir. 1996), we considered a design patent for a key “blade,” the portion of the key that interacts with a lock to open or close it. *Id.* at 1564. The parties agreed that “the key blade must be designed as shown in order to perform its intended function—to fit into its corresponding lock’s keyway. An attempt to create a key blade with a different design would necessarily fail because no alternative blank key blade would fit the corresponding lock.” *Id.* at 1566. On those facts, we affirmed the district court’s finding that the claimed key blade design was dictated solely by function, and the design patent was invalid. *Id.* ABPA argues that only Ford’s patented designs aesthetically “match” the F-150,² and attempts to analogize *Best Lock* to the instant case. But *Best Lock* turned on the admitted fact that no alternatively designed blade would mechanically operate the lock—not that the blade and lock

² ABPA also briefly suggests that insurers require repair parts to use Ford’s original designs with the F-150 but cites no evidentiary support. ABPA’s own witness explained that insurers simply pay a sum of money for repairs; they do not dictate whether a repair is even made. J.A. 1312.

were aesthetically compatible. *Id.*; see also *Static Control Components, Inc. v. Lexmark Int'l, Inc.*, 697 F.3d 387, 395, 422 (6th Cir. 2012) (holding a printer cartridge design functional where “each company’s cartridges will work with only its brand of printers” and “the design of the printer dictated the exact design of the cartridge”).

Best Lock is distinguished for yet another reason. Ford introduced abundant evidence of alternative headlamp and hood designs that physically fit its trucks. See *Auto. Body Parts*, 293 F. Supp. 3d at 703 (reproducing images); J.A. 2442–43. ABPA’s own witnesses testified to the existence of “performance parts” that have a different “design or shape” than the manufacturer’s parts so that they have “some aesthetic appeal or something like that.” J.A. 940–41; see also J.A. 1312–13 (testifying that customers select performance parts because “[t]hey want [their vehicles] to look different”). And ABPA admitted that a “performance part” “will fit the associated vehicle . . . but may differ in appearance from the original part.” J.A. 1330; see also J.A. 1340 (same). On these facts, *Best Lock* bears little similarity to this case.

Similarly, ABPA urges us to rule that Ford’s designs are not a “matter of concern” to consumers. We have explained that a design is generally not a “matter of concern,” and lacks ornamentality, if it may not be observed or if it is assessed only for functionality. See *In re Webb*, 916 F.2d 1553, 1557–58 (Fed. Cir. 1990). ABPA avers that consumers assess Ford’s designs only to assess their aesthetic compatibility with the F-150. But by definition, if a consumer assesses the aesthetic of a design in considering whether to purchase it, the design *is* a matter of concern. See *id.* Indeed, ABPA and its witnesses admitted that customers select replacement parts from among multiple different designs based on their preferred aesthetic, further undermining ABPA’s position. See J.A. 940–41, 1312–13, 1330, 1340. And regardless, the district court found that “it is beyond reasonable debate that the design of an auto-body

part is important to consumers at least when they are deciding which car to buy.” *Auto. Body Parts*, 293 F. Supp. 3d at 701. ABPA fails to explain how that well-supported finding constitutes error.

Finally, ABPA asks this court to rule, as a matter of policy, that Ford’s design patents may be enforced only in the initial market for sale of the F-150, and not in the market for replacement components. Appellant’s Br. 36. ABPA argues that a market-specific rule is appropriate because customers have different concerns in different contexts. It declares that customers care about design in the initial sales market, but not when they select replacement parts. But ABPA cites no supporting facts. Instead, it ignores abundant record evidence regarding performance parts available as replacements for customers who “want [their vehicles] to look different.” J.A. 1312–13. It cites no patent case to support its argument. And it seeks to sidestep our precedent, which asks “whether *at some point* in the life of the article an occasion (or occasions) arises when the appearance of the article becomes a ‘matter of concern.’” *Webb*, 916 F.2d at 1557 (emphasis added). Finding neither legal nor factual support for ABPA’s argument, we reject it.³ We therefore affirm the district court’s determination that ABPA failed, as a matter of law, to prove Ford’s designs functional by clear and convincing evidence. *See Ethicon*, 796 F.3d at 1328 (discussing burden and standard of proof).

³ A bill seeking to create a market-based analysis specifically for auto-body design patents was introduced in a previous Congress but has not become law. *See PARTS Act*, S. 780, 113th Cong. (2013); J.A. 664. “[I]t is not our job to apply laws that have not yet been written.” *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 456 (1984).

II

We next address ABPA's contention that Ford's patents are unenforceable against its members under the related doctrines of exhaustion and repair.

A

"The franchise which the patent grants, consists altogether in the right to exclude every one from making, using, or vending the thing patented, without the permission of the patentee." *Bloomer v. McQuewan*, 55 U.S. 539, 549 (1852). But when the patentee sells his invention, the thing sold "is no longer within the limits of the monopoly." *Id.*; see also *United States v. Masonite Corp.*, 316 U.S. 265, 277–78 (1942). This "well-established" rule, dubbed exhaustion, "marks the point where patent rights yield to the common law principle against restraints on alienation." *Impression Prods., Inc. v. Lexmark Int'l, Inc.*, 137 S. Ct. 1523, 1531 (2017). An authorized sale compensates the patentee for his invention. After such a sale, the patentee may no longer "'control the use or disposition' of the product." *Id.* (quoting *United States v. Univis Lens Co.*, 316 U.S. 241, 250 (1942)). And the purchaser may use or dispose of that product without incurring liability for infringement. See, e.g., *ExcelStor Tech., Inc. v. Papst Licensing GMBH & Co. KG*, 541 F.3d 1373, 1376 (Fed. Cir. 2008) ("patent exhaustion is a defense to patent infringement").

Ford concedes that when it sells an F-150, its patents are exhausted as to the components actually sold as part of that truck. Oral Arg. at 17:58–18:24, <http://oralarguments.cafc.uscourts.gov/default.aspx?fl=2018-1613.mp3>. ABPA argues that exhaustion extends further, asserting that the sale of an F-150 truck totally exhausts any design patents embodied in the truck and permits use of Ford's designs on replacement parts so long as those parts are intended for use with Ford's trucks. See Appellant's Br. 43–45. But exhaustion attaches only to items sold by, or with the authorization of, the patentee. See *Jazz Photo Corp. v.*

Int'l Trade Comm'n, 264 F.3d 1094, 1105 (Fed. Cir. 2001) (explaining that an authorized sale “exhausts’ the patentee’s right to control further sale and use of *that article*” but does not permit a “second creation of the patented entity” (emphasis added)), *overruled on other grounds by Impression Prod.*, 137 S. Ct. at 1538; *see also Bowman v. Monsanto Co.*, 569 U.S. 278, 286 (2013) (“The exhaustion doctrine is limited to the ‘particular item’ sold . . .”). ABPA’s members’ sales are not authorized by Ford; it follows that exhaustion does not protect them. *See Helferich Patent Licensing, LLC v. N.Y. Times Co.*, 778 F.3d 1293, 1302 (Fed. Cir. 2015) (“[T]he decisions finding exhaustion . . . have done so *only* when . . . *an authorized acquirer* was using the same invention by infringing the asserted claims.” (emphases added)).

ABPA asks us to “adapt[]” this rule for design cases. *See* Appellant’s Br. 49. But we apply the same rules to design and utility patents whenever possible. *See* 35 U.S.C. § 171(b) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”). Accordingly, we have held that principles of prosecution history estoppel, inventorship, anticipation, and obviousness apply to both design patents and utility patents. *See, e.g., Pac. Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 702 (Fed. Cir. 2014) (“The same principles of public notice that underlie prosecution history estoppel apply to design patents as well as utility patents.”); *Hoop v. Hoop*, 279 F.3d 1004, 1007 (Fed. Cir. 2002) (“We apply the same standard of inventorship to design patents that we require for utility patents.”); *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1461 (Fed. Cir. 1997) (“In determining whether a design patent is invalid based on a description in a printed publication, . . . the factual inquiry is the same as that which determines anticipation by prior publication of the subject matter of a utility patent”); *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996) (“Design patents are subject to the

same conditions on patentability as utility patents, including the nonobviousness requirement of 35 U.S.C. § 103.”). We see no persuasive reason to depart from this standard for the exhaustion doctrine.

ABPA points to the Supreme Court’s decision in *Quanta Computer, Inc. v. LG Electronics, Inc.*, 553 U.S. 617 (2008), to assert that we should nevertheless create a design-patent-specific rule for exhaustion. Appellant’s Br. 49. In *Quanta*, the Court rejected an attempt to exempt method claims from exhaustion. *See Quanta*, 553 U.S. at 628. After reviewing the history and purpose of the doctrine, the Court noted that “[o]ur precedents do not differentiate transactions involving embodiments of patented methods or processes from those involving patented apparatuses or materials.” *Id.* at 628–29. It therefore held that like other utility patents, method patents are exhausted by the authorized sale of an item embodying the claimed invention. *Id.* at 638. And accordingly, it determined that the sale of a microprocessor embodying a method patent exhausts that patent. *See id.* It did not, however, hold that purchasers of those microprocessors could make their own, new microprocessors using the patented invention, as ABPA suggests. Far from supporting ABPA’s position, *Quanta* supports our reluctance to establish special rules for design patents—our precedents do not differentiate transactions involving embodiments of patented designs from those involving patented processes or methods. *See, e.g., Jazz Photo*, 264 F.3d at 1110 (“[T]he principle of exhaustion applies to the design patents as well as to the utility patents.”).

B

ABPA’s right of repair argument is equally unpersuasive. The right of use transferred to a purchaser by an authorized sale “include[s] the right to repair the patented article.” *Kendall Co. v. Progressive Med. Tech., Inc.*, 85 F.3d 1570, 1573 (Fed. Cir. 1996). The right of repair

does not, however, permit a complete reconstruction of a patented device or component. See *Helperich*, 778 F.3d at 1303–05 (noting purchaser cannot recreate patented product); *Kendall*, 85 F.3d at 1573–74 (explaining that while a purchaser may not undertake a “complete ‘reconstruction’” of the patented device, he may replace “individual *unpatented* components” of the patented article (emphasis added)). And it does not permit a purchaser to infringe other patents by manufacturing separately patented components of the purchased article. See *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 346 (1961) (“[R]eplacement of a spent, *unpatented element* does not constitute reconstruction. The decisions of this Court require the conclusion that reconstruction of a patented entity, comprised of unpatented elements, is limited to such a true reconstruction of the entity as to ‘in fact make a new article’” (emphasis added) (quoting *United States v. Aluminum Co. of Am.*, 148 F.2d 416, 425 (2d Cir. 1945) (Hand, J.))); *Helperich*, 778 F.3d at 1303–05 (noting prohibition on reconstruction).

ABPA argues that purchasers of Ford’s F-150 trucks are licensed to repair those trucks using replacement parts that embody Ford’s hood and headlamp design patents. But straightforward application of long-standing case law compels the opposite conclusion. Over 150 years ago, a New Hampshire court considered facts similar to those of this case in *Aiken v. Manchester Print Works*, 1 F. Cas. 245 (C.C.D.N.H. 1865). There, the patentee sold a patented knitting machine whose needles wore out on a regular basis. *Id.* at 245–46. Though the needles were covered by a separate patent, the accused infringers argued that they could properly manufacture replacement needles to continue using the knitting machine they had purchased. The court disagreed, holding that “the needle is subject to a patent, and in making and using it they have infringed.” *Id.* at 247. It distinguished an earlier Supreme Court case in which a purchaser had been permitted to replace the

knives used in a patented cutting machine, noting “the cutters and knives, in [*Wilson v. Simpson*, 50 U.S. 109 (1850)], were not subject to a patent.” *Id.* The Supreme Court endorsed *Aiken*’s reasoning in *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U.S. 425, 435–36 (1894), and its reasoning governs here. Ford’s patents claim “[t]he ornamental design for exterior of vehicle hood,” see D’299 patent, Claim, and “[t]he ornamental design for a vehicle head lamp,” see D’685 patent, Claim. The designs may be embodied in the hoods and headlamps that form part of the full F-150 truck or in separate hoods and headlamps. But though a sale of the F-150 truck permits the purchaser to repair the designs as applied to the specific hood and headlamps sold on the truck, the purchaser may not create new hoods and headlamps using Ford’s designs. Like the needles in *Aiken*, such new hoods and headlamps are subject to Ford’s design patents, and manufacturing new copies of those designs constitutes infringement.

ABPA attempts to distinguish *Aiken* and its progeny by asserting that these cases apply only to utility patents. ABPA urges us to adopt a new rule that recognizes the “unique nature” of design patents. See Appellant’s Reply Br. 18. In particular, ABPA claims that the statutory language authorizing design patents dictates such a rule. Unlike 35 U.S.C. § 101, which authorizes utility patents for a “process, machine, manufacture, or composition of matter, or any new and useful improvement thereof,” 35 U.S.C. § 171 permits design patents for a “design for an article of manufacture.” ABPA argues that because “article of manufacture,” is a term broad enough to include both a product component and the product itself, see *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 434 (2016), sale of either the component (i.e., the hood or headlamp) or the whole product (i.e., the F-150) totally exhausts a design patent and permits unlimited repair. See Appellant’s Br. 43–58.

We disagree. In our view, the breadth of the term “article of manufacture” simply means that Ford *could*

properly have claimed its designs as applied to the entire F-150 or as applied to the hood and headlamp. To determine what repair rights apply, we look to what Ford actually claimed. As always, “the name of the game is the claim.” *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1255 n.2 (Fed. Cir. 2011) (quoting Giles S. Rich, *The Extent of the Protection and Interpretation of Claims—American Perspectives*, 21 Int’l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)). Ford chose to claim designs as applied to portions of particular components, and the law permits it to do so. *See, e.g., Samsung*, 137 S. Ct. at 435; *Gorham*, 81 U.S. at 512. That the auto-body components covered by Ford’s patents may require replacement does not compel a special rule. Just as the patentee in *Aiken* could have only claimed the needles in conjunction with the knitting machine, Ford could have only claimed its design as applied to the whole truck. Unfortunately for ABPA, Ford did not do so; the designs for Ford’s hood and headlamp are covered by distinct patents, and to make and use those designs without Ford’s authorization is to infringe. *See Aiken*, 1 F. Cas. at 247.⁴

We thus reject ABPA’s attempts to develop design patent-specific exhaustion and repair rules.⁵ Consequently,

⁴ ABPA asserts that Ford’s purchasers are unaware of the design patents covering the hood and headlamp and suggests that as a result we should permit their use of the patented designs. Appellant’s Br. 56–57. Even if purchasers are unaware—and ABPA cites no factual support for that assertion—direct infringement does not require knowledge of a patent. *See Glob.-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 761 n.2 (2011) (“[A] direct infringer’s knowledge or intent is irrelevant.”).

⁵ As an additional argument for affirmance, Ford asserts that because ABPA and its members are not themselves the purchasers of Ford’s trucks, they cannot benefit

18

AUTO. BODY PARTS ASS'N v. FORD GLOB. TECHS., LLC

we affirm the district court's ruling that ABPA has not shown that Ford's designs for an F-150 hood and headlamp are exhausted when Ford sells an F-150 truck.

CONCLUSION

Having considered the parties' remaining arguments and found them unpersuasive, we affirm the district court.

AFFIRMED

COSTS

Costs to Appellee.

from an implied license to repair the trucks. *See* Appellee's Br. 43–45. For purposes of this opinion, we do not reach this issue.

CERTIFICATE OF SERVICE

I hereby certify that on August 12, 2019, the foregoing was electronically filed through this Court's CM/ECF system, which will send a notice of filing to all registered users.

/s/ Robert G. Oake, Jr.
Robert G. Oake, Jr.

Counsel for ABPA