

19-1746

United States Court of Appeals for the Federal Circuit

FORD GLOBAL TECHNOLOGIES, LLC,

Plaintiff-Appellee,

v.

NEW WORLD INTERNATIONAL, INC., AUTO LIGHTHOUSE PLUS,
LLC, and UNITED COMMERCE CENTERS, INC.,

Defendants-Appellants,

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF TEXAS IN CASE NO. 3:17-CV-03201-N
UNITED STATES DISTRICT JUDGE DAVID C. GODBEY

CORRECTED PETITION FOR REHEARING EN BANC

August 10, 2020

Robert G. Oake, Jr.
Oake Law Office, PLLC
700 S. Central Expy., Suite 400
Allen, Texas 75013
(214) 207-9066
rgo@oake.com

Attorney for Appellants

FORM 9. Certificate of Interest

Form 9 (p. 1)
July 2020

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 19-1746

Short Case Caption Ford Global Technologies, LLC v. New World International, Inc.

Filing Party/Entity Appellants

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 8/10/20

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

Name: Robert G. Oake, Jr.

FORM 9. Certificate of Interest

Form 9 (p. 2)
July 2020

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).	3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. <input checked="" type="checkbox"/> None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. <input checked="" type="checkbox"/> None/Not Applicable
New World International, Inc.		
United Commerce Centers, Inc.		
Auto Lighthouse Plus, LLC		

☐ Additional pages attached

FORM 9. Certificate of Interest

Form 9 (p. 3)
July 2020

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

☐ None/Not Applicable

☐ Additional pages attached

Cardelli Lanfear PC, Paul M. Kittinger, Thomas G. Cardelli	Booth Albanesi Schroeder, PLLC, Peter V. Schroeder	
Glast, Philips & Murray, P.C. Maris & Lanier, Robert Maris		
Tompkins, P.C., George Tompkins		

5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

☒ None/Not Applicable

☐ Additional pages attached

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☒ None/Not Applicable

☐ Additional pages attached

TABLE OF CONTENTS

	<u>Page</u>
Table of Authorities	ii
Counsel’s Statements in accordance with Fed. Cir. Rule 35(b)(2) ...	v
Introduction	1
Argument	1
1. Claim Construction	1
2. Right of Repair	6
3. Indefiniteness	12
4. Infringement	16
5. Damages and Attorney Fees	23
Conclusion and Relief Sought	23
Addendum of Judgment of Affirmance without Opinion	
Certificate of Compliance	
Certificate of Service	

TABLE OF AUTHORITIES

<u>CASES</u>	<u>Page(s)</u>
<i>Apple, Inc. v. Samsung Elecs. Co.</i> , 932 F.Supp.2d 1076 (E.D. Cal. 2013)	5
<i>Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.</i> , 501 F.3d 1314 (Fed. Cir. 2007)	2
<i>Arminak Associates, Inc. v. Saint-Gobain Calmar</i> , 424 F. Supp. 2d 1188 (C.D. Cal. 2006)	22
<i>Automotive Body Parts Association v. Ford Global Techs., LLC</i> , 930 F.3d 1314 (Fed. Cir. 2019)	6, 11, 12
<i>British Telecommunications v. IAC/Interactive Corp.</i> , No. 18-366, (D.C. Del., July 15, 2020)	22
<i>Contessa Food Prods., Inc. v. Conagra, Inc.</i> , 282 F.3d 1370 (Fed. Cir. 2002)	2, 8, 11, 16
<i>Curver Luxembourg v. Home Expressions Inc.</i> , 938 F.3d 1334 (Fed. Cir. 2019)	3
<i>Dobson v. Dornan</i> , 118 U.S. 10 (1886)	2
<i>Egyptian Goddess, Inc. v. Swisa, Inc.</i> , 543 F.3d 665 (Fed. Cir. 2008) (en banc)	1, 2, 5, 7, 16
<i>Feld Motor Sports, Inc. v. Traxxas, L.P.</i> , 861 F.3d 591 (5th Cir. 2017)	15
<i>Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., Inc.</i> , 162 F.3d 1113 (Fed. Cir. 1998)	2
<i>Gorham v. White</i> , 81 U.S. 511 (1871)	16

<i>In re Blum</i> , 374 F.2d 904 (C.C.P.A. 1967)	5
<i>In re Zahn</i> , 617 F.2d 261 (Fed. Cir. 1980)	11
<i>Kuen Hwa Traffic Indus. Co. v. DNA Motor, Inc.</i> , 2:18-cv-05664 (C.D. Cal., August 20, 2019)	19
<i>LKQ Corporation et al. v. GM Global Technology Operations LLC</i> , PGR2020-00062 (PTAB April 16, 2020)	17
<i>Molins PLC v. Textron, Inc.</i> , 48 F.3d 1172 (Fed. Cir. 1995)	23
<i>Nautilus, Inc. v. Biosig Instruments, Inc.</i> , 572 U.S. 898 (2014)	12, 13, 15, 16
<i>O2 Micro International Ltd. v. Monolithic Power Systems, Inc.</i> , 467 F.3d 1355 (Fed. Cir. 2006)	3
<i>Quanta Computer Inc. v. LG Electronics, Inc.</i> , 553 U.S. 617 (2008)	vi
<i>Richardson v. Stanley Works, Inc.</i> , 597 F.3d 1288 (Fed. Cir. 2010)	3
<i>Samsung Electronics Co. v. Apple Inc.</i> , 137 S. Ct. 429 (2016)	12
<i>SanDisk Corp. v. Memorex Products, Inc.</i> , 415 F.3d 1278 (Fed. Cir. 2005)	3
<i>Shockley v. Arcan</i> , 248 F.3d 1349 (Fed. Cir. 2001)	23
<i>Sport Dimension, Inc. v. Coleman Co.</i> , 820 F.3d 1316 (Fed. Cir. 2016)	3

<i>UltimatePointer, L.L.C. v. Nintendo Co.,</i> 816 F.3d 816 (Fed. Cir. 2016)	15
--	----

STATUTES, RULES, AND REGULATIONS

35 U.S.C. § 112 ¶2	12
35 U.S.C. § 271	23
35 U.S.C. § 289	12
Fed. Cir. Rule 36(a)	1
Fed. R. Civ. P. 50	15
37 CFR 1.153	3

MPEP

MPEP § 1503.01, subsection I	12
MPEP § 1503.02, subsection III	4
MPEP § 1504.04	2, 6

MISC.

2016 U.S. S. Ct. Briefs LEXIS 2322 (June 8, 2016).....	12
--	----

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

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States and the precedents of this court:

A. Claim Construction:

Egyptian Goddess, Inc. v. Swisa, Inc.,
543 F.3d 665 (Fed. Cir. 2008) (en banc)

Curver Luxembourg v. Home Expressions Inc.,
938 F.3d 1334 (Fed. Cir. 2019)

B. Doctrine of Repair:

Egyptian Goddess, Inc. v. Swisa, Inc.,
543 F.3d 665 (Fed. Cir. 2008) (en banc)

For the reason that *Egyptian Goddess* stands for the principle that when a legal test does not work over foreseeable design patent claims and fact patterns (like the point of novelty test and the claiming test in this case), the test should be abandoned for a test that does work.

C. Indefiniteness

Nautilus, Inc. v. Biosig Instruments, Inc.,
572 U.S. 898 (2014)

D. Infringement

Gorham v. White,
81 U.S. 511 (1871)

Egyptian Goddess, Inc. v. Swisa, Inc.,
543 F.3d 665 (Fed. Cir. 2008) (en banc)

Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., Inc.,
162 F.3d 1113 (Fed. Cir. 1998)

E. Damages and Attorney Fees

Shockley v. Arcan,
248 F.3d 1349 (Fed. Cir. 2001)

Molins PLC v. Textron, Inc.,
48 F.3d 1172 (Fed. Cir. 1995)

Based on my professional judgment, I believe this appeal requires answers 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 undergoing the repair or reconstruction analysis is determined by a claiming test that demonstrably does not work for some design patent claims, an embodiment test similar to that used for method patents, *see Quanta Computer Inc. v. LG Electronics, Inc.*, 553 U.S. 617 (2008), or by some other multi-factor test.

B. Whether the utility patent indefiniteness standard from *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014) applies to design patents with multiple drawings.

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

Attorney of record for Appellants

Introduction

Appellants respectfully submit that the district court judgment, associated orders, and Federal Circuit Rule 36 Judgment demonstrate a compelling need to establish and maintain uniformity of design patent principles in the areas of claim construction, right of repair, indefiniteness, infringement, and liability for damages.

Argument

1. Claim Construction

Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008) (en banc), granted broad discretion to district courts when construing design patents. The instant case concerns the limits of that discretion and whether a court can change the scope of a design patent claim and nullify an indefiniteness defense by eliminating the phrase “as described” from the claim. In particular, can a court remove language from the claim by construing the claim as “the design as shown in the accompanying drawing(s)” when the design patent claim uses the phrase “as shown and described” and has language that, when not eliminated, changes the scope of the claim and presents a valid indefiniteness defense?

All patents in suit are claimed as “shown and described” and have language. (Appx5745-5811). Despite this, the district court construed the claims as “the design as shown in the accompanying drawing(s).” (Appx71). Manual of Patent Examining Procedure (MPEP) provides that drawings can be supplemented by a

narrative description incorporated into the claim by use of the language “as shown and described.” MPEP § 1504.04. When the district court construed the claims “as shown in the accompanying drawing(s),” it removed the phrase that incorporated the language and thereby eliminated the language from the claims.

The claim construction possibly resulted from a misinterpretation of a statement in *Egyptian Goddess* that design patents “typically are claimed as shown in drawings.” *Id.* at 679. (quoting *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1319 (Fed. Cir. 2007)). Notably, *Arminak* cites *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., Inc.*, 162 F.3d 1113 (Fed. Cir. 1998), where the claim was recognized as “[t]he ornamental design for a tire tread, as shown *and described*” (emphasis added). *Id.* at 1116.

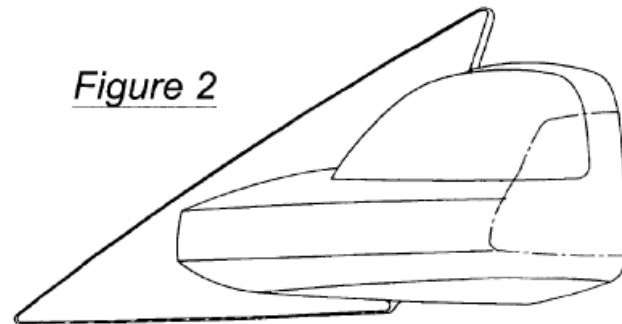
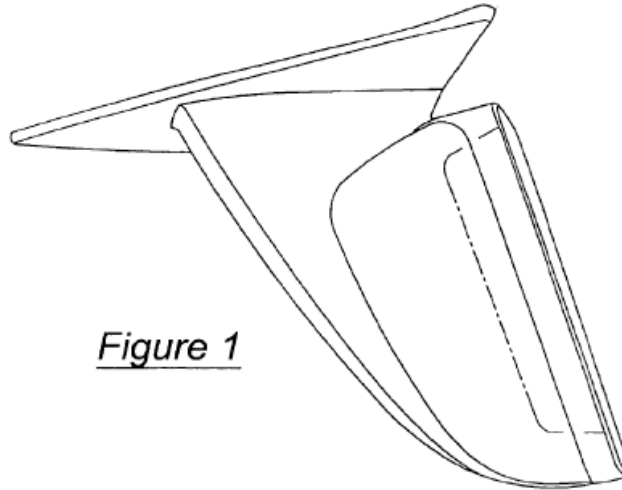
Egyptian Goddess also cites *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002) and *Dobson v. Dornan*, 118 U.S. 10, 14 (1886). In *Contessa*, the design patent had no language beyond a description of the drawing views, *e.g.*, no broken line statement, and in *Dobson*, the design patent (D6,822) had a single drawing, the title “Carpets,” and no written description. Nothing in these cases suggests that a court can remove the “as described” language during claim construction when the claim contains language that affects the scope and validity of the claim.

Appellants respectfully submit that the district court’s claim construction is erroneous¹ and in conflict with this Court’s opinion in *Curver Luxembourg v. Home Expressions Inc.*, 938 F.3d 1334, 1340 (Fed. Cir. 2019). In *Curver*, this Court discussed 37 CFR 1.153, which states in relevant part “[t]he claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described.” This Court stated “[t]his regulation tells us ... the scope of the design claim can be defined either by the figures (‘as shown’) or by a combination of the figures and the language of the design patent (‘as shown and described’).” *Id.* at 1340.

The incorporated language is important for determining the scope of the claim for analyzing indefiniteness and infringement. For example, all the patents have drawings with broken lines that can mean different things (unclaimed environment or boundaries), and without the written descriptions, the meanings of the broken

¹ Claim construction is reviewed *de novo*, see *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010) and will be rejected when it improperly changes claim scope. See *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1321 (Fed. Cir. 2016). Appellants repeatedly argued for a claim construction that included the phrase “as described,” (Doc. 144, pp.2-8; Doc. 208, p. 4), and argued that a claim construction omitting such phrase “erroneously alters the meaning and scope of the putative patents as claimed” including broken line and limitations issues (Doc. 208, p.4-6). Therefore, Appellants’ claim construction arguments are preserved for appeal. See *O2 Micro International Ltd. v. Monolithic Power Systems, Inc.*, 467 F.3d 1355, 1358–59 (Fed. Cir. 2006); *SanDisk Corp. v. Memorex Products, Inc.*, 415 F.3d 1278, 1355 (Fed. Cir. 2005).

lines are unknown. Further, some of the drawings have broken lines that cross solid lines. For example, Figures 1 and 2 of USD500,717 are illustrated below:



(Appx5797).

The MPEP provides that when broken lines are defined as environment, the surface beneath the broken lines *is* part of the claimed design, but when defined as boundaries, the area within the broken lines is *not* part of the claimed design. 1503.02(III). The MPEP states “it is critical that the description of the broken lines

in the specification explicitly identifies their purpose so that the scope of the claim is clear.” *Id.* Here the claims did not.

In *In re Blum*, 374 F.2d 904, 907 (C.C.P.A. 1967), the court stated “[d]otted and broken lines may mean different things in different circumstances” and “in each case it must be made entirely clear what they do mean” to avoid indefiniteness. However, in *Apple, Inc. v. Samsung Elecs. Co.*, 932 F.Supp.2d 1076, 1085-1086 (E.D. Cal. 2013), the court held that after *Egyptian Goddess* there was no *per se* indefiniteness rule on inconsistent use of broken lines and that further description could be provided through claim construction. Regardless of whether the *per se* rule from *Blum* survives *Egyptian Goddess*, the district court eliminated all written description of the broken lines and never provided any additional clarification.

Another example illustrating the problem is that the claim construction changed the scope of USD582,065 (“the ‘065 Patent”) and nullified an indefiniteness defense. The language of the ‘065 Patent states “[t]he ornamental design for a Headlamp as shown and described.” (Appx5808). The description contains language about limitations:

This design is not limited to the exact details shown in the Drawings, since equivalents and colorable imitations thereof will be evident to a person of ordinary skill in the art.

(emphasis added) (Appx5808).

If a description includes vague and nondescriptive words such as “variations” and “equivalents,” or a statement that the claimed design “is not limited to the exact shape and appearance shown in the drawing,” then the claim is indefinite. MPEP 1504.04. When the district court’s claim construction eliminated this language, it insulated the ‘065 Patent from this indefiniteness defense.

Appellants respectfully submit that district courts should not have discretion to remove language from claims by omitting the phrase “and described.” If such judicial discretion is permitted, then language may be inserted that broadens claim scope beyond what is shown in the drawings to create uncertainty and chill competition – only to be safely removed during claim construction.

2. Right of Repair

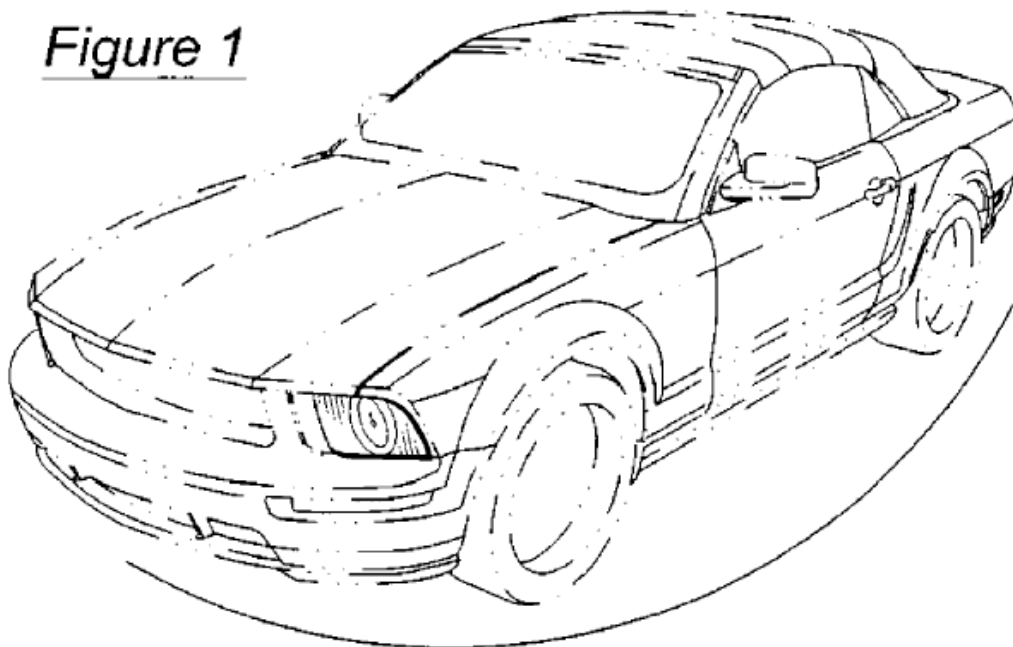
This case presents the issue of how an article should be identified for right of repair analysis when portions of multiple components are claimed in one design patent. In *Automotive Body Parts Association v. Ford Global Techs., LLC*, 930 F.3d 1314 (Fed. Cir. 2019) (*ABPA*), this Court affirmed summary judgment for Ford and held that in the context of the repair doctrine, the article is identified through a claiming test. *Id.* at 1324 (“To determine what repair rights apply, we look to what Ford actually claimed.”). The district court granted summary judgment for Ford for the same reasons set forth by the district court in the *ABPA* case. (Appx72).

On appeal, Appellants explained that the claiming test does not work consistently across the potential range of design patents and therefore should be abandoned in favor of an embodiment test or some other test that does work. (Opening Brief, pp.61-65). Under the embodiment test, if the article sold embodies the claimed design, then it is the article that is used for the repair analysis. Since the article sold by Ford is the vehicle and the claimed designs are embodied in the vehicle, the repair doctrine applies.

Appellants respectfully submit that one problem with this Court's claiming test is similar to the problem that led to abandonment of the point of novelty test in *Egyptian Goddess*. In *Egyptian Goddess*, this Court expressly recognized that although the point of novelty test "proved reasonably easy to apply in simple cases," it was more difficult to apply "where the claimed design has numerous features that can be considered points of novelty, or where multiple prior art references are in issue and the claimed design consists of a combination of features, each of which could be found in one or more of the prior art designs." *Id.* at 671.

Similarly, the claiming test is easy to apply when only one entire component part is claimed. But when portions of multiple components are claimed, the claiming test is unworkable. The point is illustrated by Figure 1 of the '065 Patent:

Figure 1

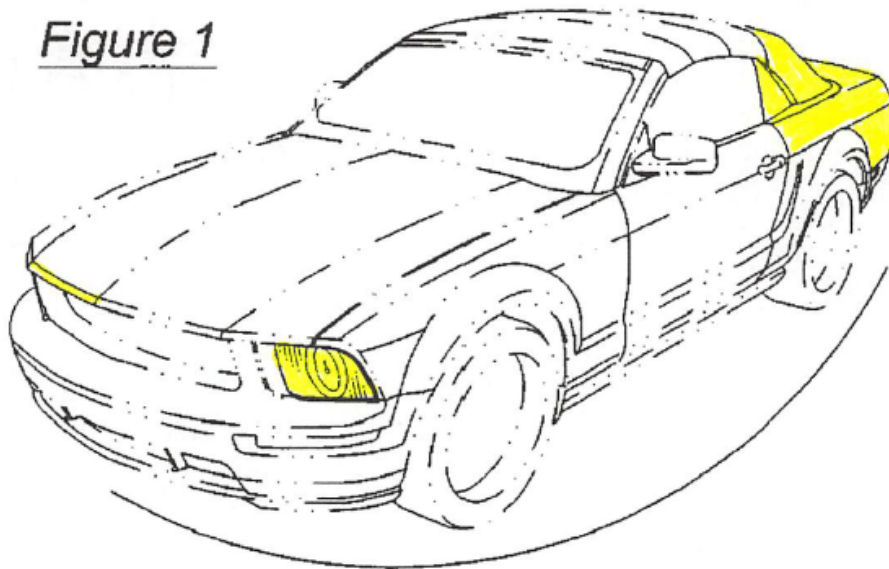


(Appx5809).

This drawing consists of both solid and broken lines. Under the district court's claim construction, the meaning of the broken lines is not known. Even if the written description is not eliminated, it is not clear whether certain lines are environment or boundaries because they are not precisely identified as required by MPEP 1503.02(III).

Putting aside the issue of what the broken lines mean, at a minimum the claimed portions of the drawing are defined by the solid lines, *see Contessa Products* at 1378, which consist of the areas highlighted in yellow below:

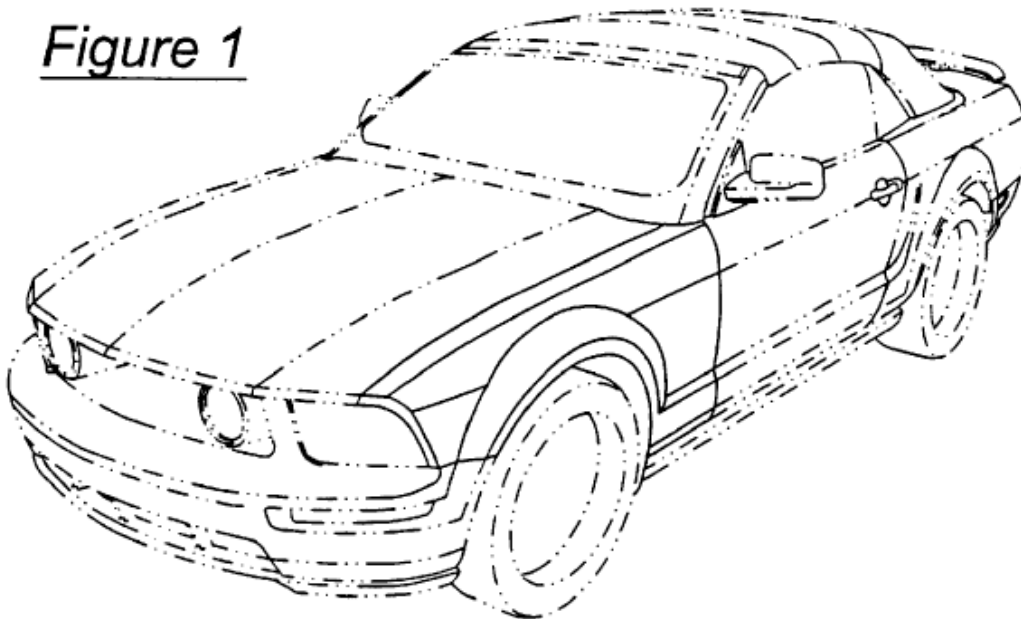
Figure 1



(Appx5809).

These claimed portions are confirmed by comparing the drawing figure with other similar figures in other patents where these areas are shown in broken lines:

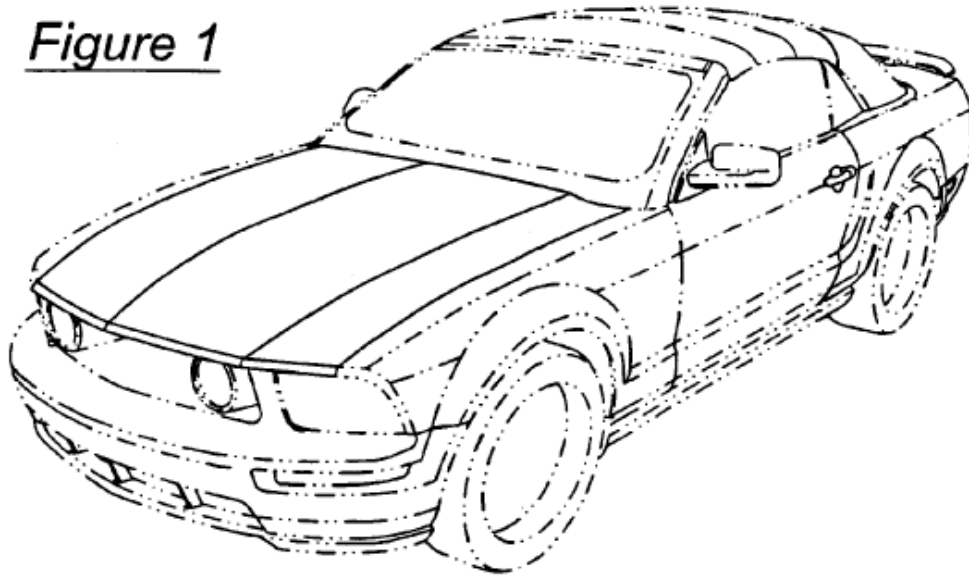
Figure 1



USD508,223

(Appx5806).

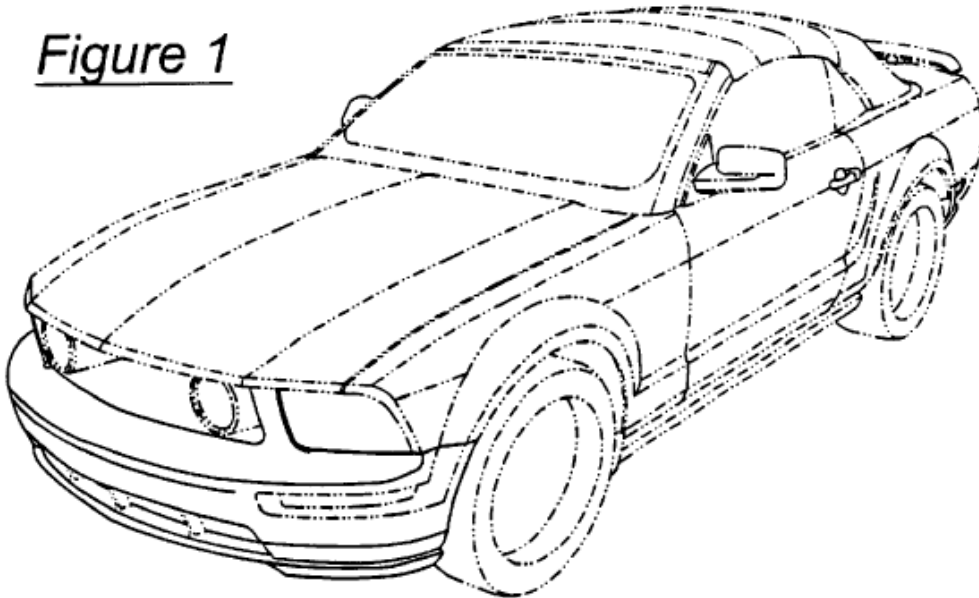
Figure 1



USD510,551

(Appx5782).

Figure 1



USD501,162

(Appx5779).

The claimed areas therefore consist of portions of the front hood, headlamp, rear quarter panel, roof, rear window, and rear hood.² This type of portion claiming is permitted under *In re Zahn*, 617 F.2d 261 (Fed. Cir. 1980).

When only a damaged headlamp is replaced, is the article claimed undergoing permissible repair or prohibited reconstruction? In *ABPA*, even though only portions of components were claimed, the claiming test identified the entire component as the article for right of repair analysis.³ Under that reasoning, the article is the headlamp, front hood, rear quarter panel, roof, rear window, and rear hood. As explained by Appellants (Opening Brief, pp.62-63), the claiming test does not work in this situation because it is not possible to determine whether replacement of a headlamp is repair or reconstruction of a front hood, rear quarter panel, roof, rear window, and rear hood.⁴

² Even if the solid lines not related to the headlamp are suspected to be drafting errors, they cannot be disregarded under *Contessa Products* and are part of the claim. *Id.* at 1378. Further, since such a multi-component portion claim is possible under *In re Zahn*, this patent is representative of the many types of design patent portion claims that will render the claiming test unworkable.

³ This aspect of the claiming test appears flawed because a component may consist of, *e.g.*, five subcomponents. If only one subcomponent of the component part is claimed and that subcomponent can be reused after a collision while the remaining four unclaimed subcomponents must be replaced, right of repair likely would be denied because the repair/reconstruction analysis would focus on the entire component. That improperly grants patent protection to all the unclaimed portions of the headlamp.

⁴ Even if the claiming test is used, at a minimum, there is a question of fact regarding repair/reconstruction and summary judgment is not appropriate.

In *ABPA*, this Court did not consider article title, which is appropriate because a title does not define the claim, *see* MPEP 1503.01(I), and sole consideration of the title would allow improper manipulation. *See Cf.* 2016 U.S. S. Ct. Briefs LEXIS 2322, *46 (June 8, 2016) (*Samsung Elecs. Co. v. Apple Inc.*, 137 S.Ct. 429 (2016)) (article identification in the context of 35 U.S.C. §289). In any event, reference to “Headlamp” in the language of the claim was eliminated by the claim construction that limits the claim to the drawings.

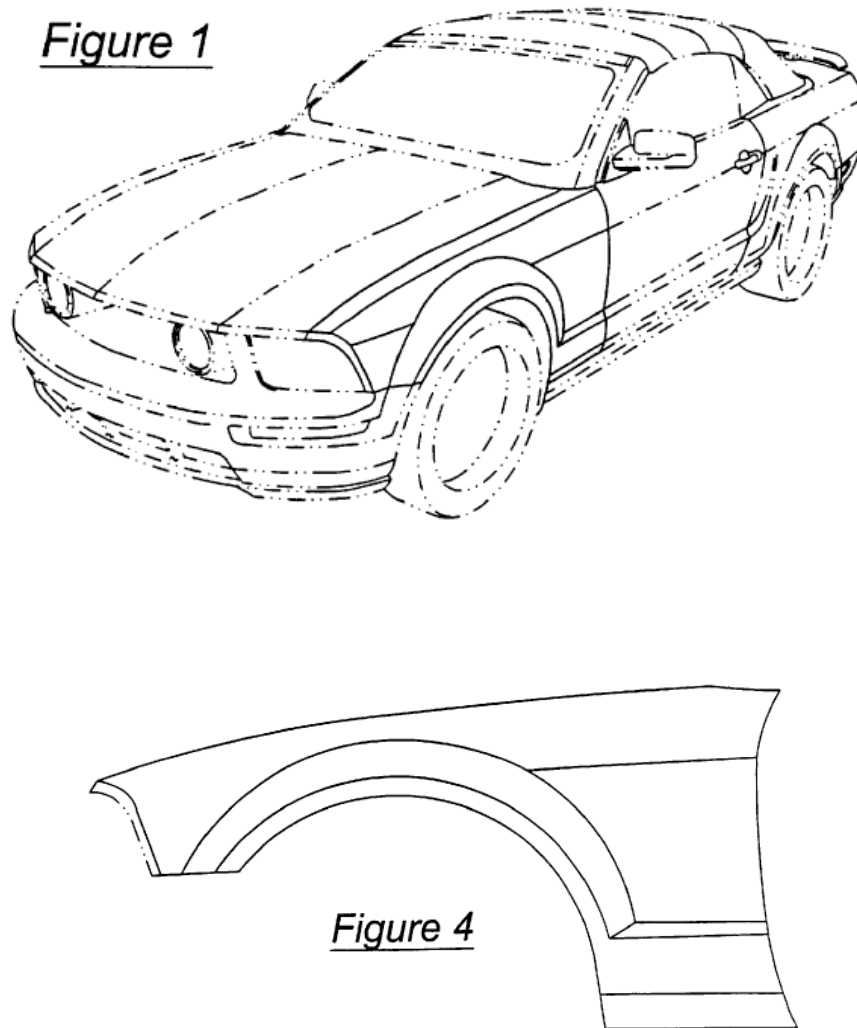
This Court should grant rehearing en banc to determine the proper test for identifying the article for doctrine of repair purposes.

3. Indefiniteness

In *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014), the Supreme Court held 35 U.S.C. 112 ¶2 requires that “a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.” *Id.* at 910. The Court stated “[t]he standard we adopt accords with opinions of this Court stating that the certainty which the law requires in patents is not greater than is reasonable, having regard to their subject matter.” *Id.* at 910.

Proper application of *Nautilus* requires asking what degree of certainty is reasonable in light of the subject matter. For utility patents, *Nautilus* states “the definiteness requirement must take into account the inherent limitations of

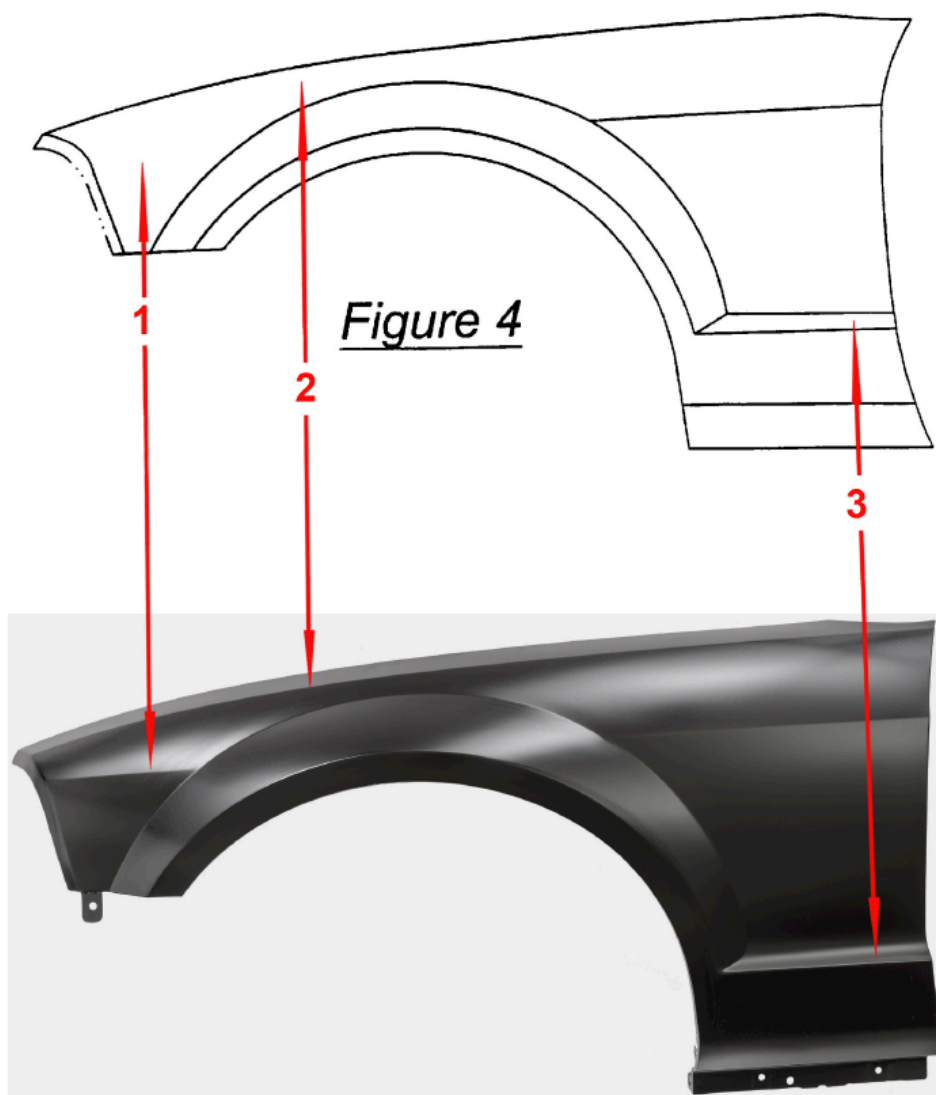
language.” *Id.* at 909. However, when applying *Nautilus* to inconsistencies in design patent drawings, there is no inherent limitation of language. D508,223 (“the ‘223 Patent”) provides an example. Figures 1 and 4 of the ‘223 Patent are as follows:



(Appx5806-5807).

Figures 1 and 4 are orthographic line drawings in perspective and side view, respectively. The solid line drawings are simple. The drawings contain two major inconsistencies, which Appellants submit render them incapable of informing those

skilled in the art about the scope of the invention with reasonable certainty. In Figure 1 there are crease lines on the top of the fender and forward of the wheel flare, and in Figure 4 there are not. There is no “inherent limitation” preventing the drawings from being drawn consistently and the inconsistencies cannot be accounted for by differences in perspective because the crease lines appear in a fender viewed from the side perspective, as indicated by arrows 1 and 2 below:



(Appx5997).

Despite these major inconsistencies, the district court denied Appellants' motion for summary judgment. (Doc. 320).⁵ Appellants respectfully submit the denial resulted from two errors. First, the court did not properly apply the *Nautilus* test and instead relied upon pre-*Nautilus* case law, concluding that "[a]ny alleged inconsistencies do not preclude the overall understanding of the drawings." (Appx85). "Overall understanding" is not the test under *Nautilus* because it is too general and can mean many things absent an expressed degree of measure such as "reasonable certainty." For example, during trial it was clear Appellants' expert interpreted "understand the designs" very broadly and in a way wholly inconsistent with "reasonable certainty." (Appx11197) (158:19-25) (Opening Brief, pp.56-57).

Second, the district court found the expert's ability to make infringement comparisons undercut the argument that the drawings are indefinite. (Appx85). This logic appears flawed because, for example, if side views of the patented and accused designs are plainly dissimilar, it should not matter if the perspective and side views in the patent are inconsistent.

This Court should hold that the *Nautilus* test applies to design patents with multiple drawings and clarify that the standard is "reasonable certainty" rather than

⁵ The summary judgment was based on the intrinsic evidence (patents) and is reviewed *de novo*. See *UltimatePointer, L.L.C. v. Nintendo Co.*, 816 F.3d 816, 826 (Fed. Cir. 2016). The denial of summary judgment was preserved for appeal in Rule 50 motions. (Appx9270-9271; Doc. 355, p.2-20). See *Feld Motor Sports, Inc. v. Traxxas, L.P.*, 861 F.3d 591, 595-96 & n.4 (5th Cir. 2017).

“understand the design.” Under a clarified standard, the ‘223 Patent and all other patents are indefinite.⁶ Indeed, Appellants respectfully submit that if this Court does not hold these design patents indefinite, this Court will be encouraging the type of ambiguity that *Nautilus* prohibits. Design patentees will be encouraged to include drawings with inconsistencies to broaden their claims.

4. Infringement

This case presents the issue of whether a court can overlook the nature of the product sold and how it influences the perceptive abilities of an ordinary observer. *Gorham v. White*, 81 U.S. 511, 528 (1871) held that infringement exists if an ordinary observer, using such care as a purchaser normally gives, considers the patented and accused designs as substantially the same. *Egyptian Goddess* clarified that the comparison is made in light of the prior art. This Court has held that the nature of the product sold influences the perceptive abilities of the ordinary observer, *see Goodyear* at 1117, and that the ordinary observer’s perceptive abilities continue after sale and through use of the product. *See Contessa Products* at 1380-1381.

It is undisputed that all the accused parts are repair parts designed to return a damaged vehicle back to its original appearance. (Appx1126-1127). Ford admitted in an ITC Action that a purchaser of repair parts is highly discerning (Appx6506-

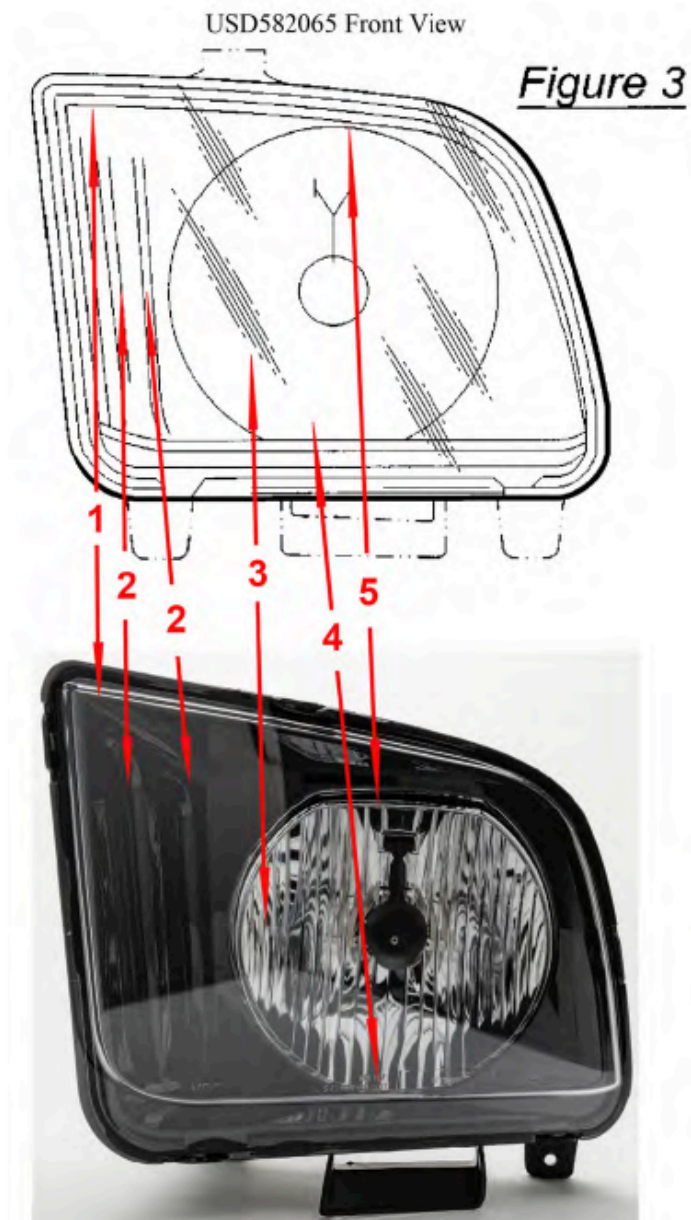
⁶ All thirteen design patents contain substantial inconsistencies between the drawings, or between the drawings and written descriptions or title as shown by the intrinsic evidence alone. (Appx5745-5811).

6507). The PTAB recently found that a purchaser of repair parts is more discerning, *see LKQ Corporation et al. v. GM Global Technology Operations LLC*, PGR2020-00062, Paper 14 at 13-14 (PTAB April 16, 2020), which makes sense because a purchaser trying to return a vehicle back to its original appearance will carefully compare the repair part with the original part's appearance. (Appx5850-5851; Appx5870).

The district court did not consider the nature of the product sold or the effect it had on the perceptive abilities of the ordinary observer. Instead, the court relied upon the testimony of a person of ordinary skill in the art who was not a purchaser, the court's own side-by-side comparison, and an analysis of the prior art. (Appx79-81). If the court had considered the nature of the product sold, at a minimum, questions of fact would exist that would have precluded summary judgment.

Two comparative examples make the point:

Headlamp



(Appx6036).

Appellants submit that a highly discerning ordinary observer, looking for the replacement headlamp pictured above, would not believe the overall design in Figure 3 above is substantially the same in light of, *inter alia*, the difference in the tops of

the reflectors (arrow 5). Indeed, the differences are so obvious that even without an instruction on the highly discerning ordinary observer, the jury sent an unsolicited note stating it believed the headlamp was inconsistent with the design patent. (Appx8615).

In a recent case involving a headlamp, *Kuen Hwa Traffic Indus. Co. v. DNA Motor, Inc.*, 2:18-cv-05664, *2, *7 (C.D. Cal., August 20, 2019), a single major difference in the upper portion of a headlamp design was enough to distinguish the overall appearances of the patented and accused designs and support a finding of no infringement as a matter of law:

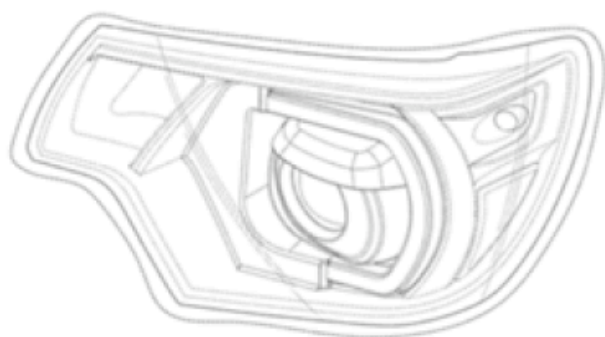


Fig. 1

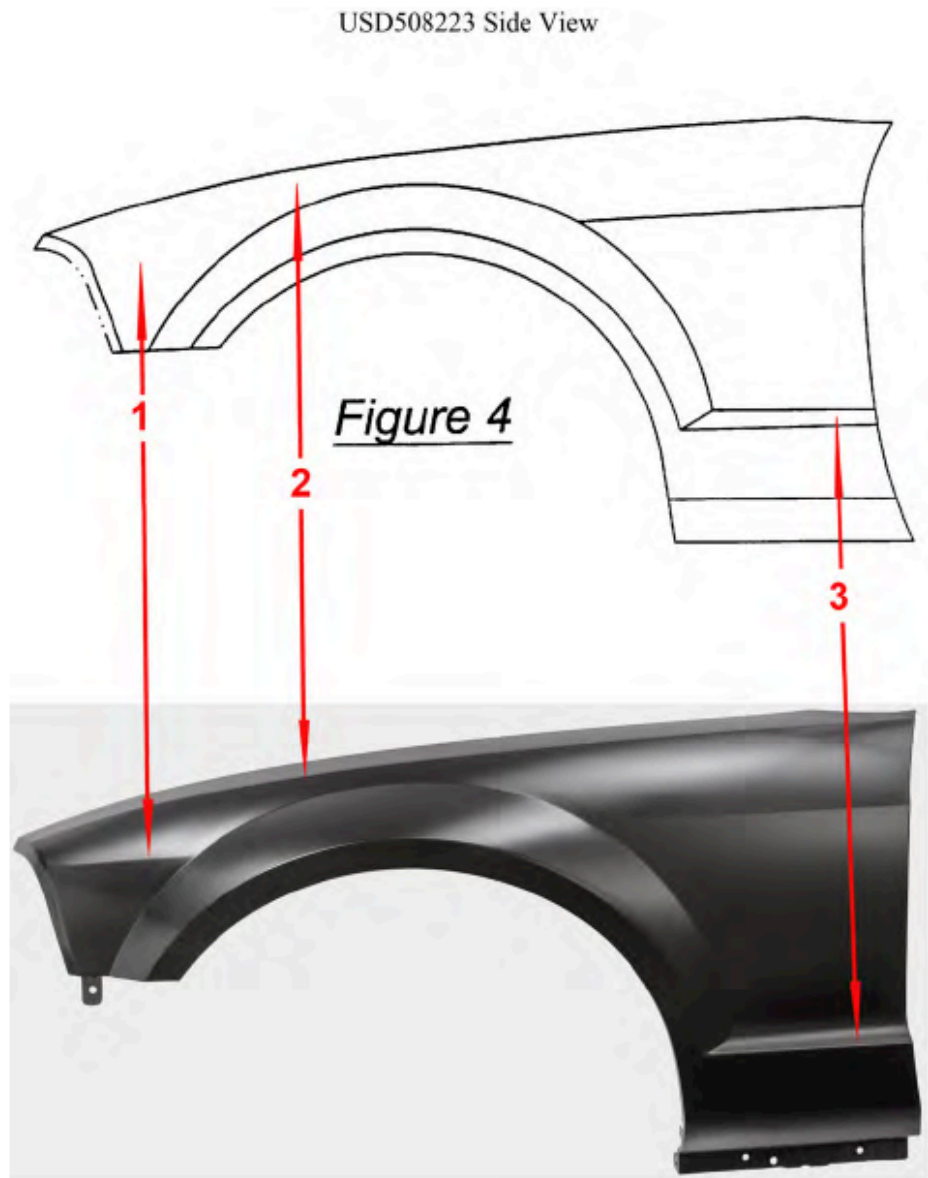
D791,987 Patented Design with “eyelid”



Fig. 2

Accused design

Fender



(Appx5997).

Appellants submit that a highly discerning ordinary observer looking for a replacement fender as shown above would not believe the overall fender appearance in Figure 4 above is substantially the same in light of the differences in the crease lines (Arrows 1 and 2).

Regarding D539,448 (Vehicle Taillamp) (Appx5784-5786), D599,717 (Sideview Mirror) (Appx5796-5798), D508,223 (Fender) (Appx5805-5807), and D582,065 (Headlamp) (Appx5808-5811), the principle that the comparison continues through use is important. These patents claim only the left-side component. However, the right-side components also were alleged to be infringing. If right-side components are purchased under the belief that they are substantially the same in appearance as the left side components (a belief that might be held by a person of ordinary skill in the art who is not a purchaser), that belief certainly no longer will exist in the mind of an ordinary observer *purchaser* upon attempted installation and use.

In light of the many differences between the patented and accused designs in light of the crowded prior art (Appx5858-6042), it is not reasonable to conclude as a matter of law that a highly discerning ordinary observer, seeking to replace an original part, would consider the designs to be substantially the same.

This Court should take this case en banc to clarify the following points regarding the ordinary observer test:

First, when the nature of the product sold increases the level of discernment of the ordinary observer, the nature of the product sold must be considered.

Second, *Gorham's* statement that an expert is not an ordinary observer does not preclude sophisticated purchasers from being ordinary observers with higher

levels of discernment. This point was made by the district court in *Arminak Associates, Inc. v. Saint-Gobain Calmar*, 424 F. Supp. 2d 1188, 1199 (C.D. Cal. 2006). Further, it is improper to merge the ordinary observer standard with the person of ordinary skill standard. That is, even if the court finds that a person of ordinary skill putatively testifies⁷ that the patented and accused designs are substantially the same, such testimony does not establish infringement as a matter of law.⁸ A person of ordinary skill may not be a purchaser as in this case (Appx11511; p.345, 1.18-20), and the nature of the product sold can make the ordinary observer even more discerning than a person of ordinary skill.

Third, although a court may conduct the ordinary observer test by comparing the patented and accused designs, when doing so a court must apply the correct standards, including considering the nature of the product sold.

⁷ Although the testimony was timely corrected under Rule 30(e)(1)(B) (Appx8083-8088; Appx8566-8579), the district court rejected the corrections under an improper analysis. (See Opening Brief, pp.40-44; see also *British Telecommunications v. IAC/Interactive Corp.*, No. 18-366, *2-9 (D.C. Del., July 15, 2020) (note Ford’s summary judgment (Doc. 227) was filed August 20, 2018 with an uncertified transcript (Doc, 228-3) the same day the final deposition transcript was received for review at 8:09 p.m. (Appx8567)). Further, the court’s finding relied upon impermissible inferences and assumptions, relied upon questions and answers not phrased in terms of the ordinary observer test, improperly changed a deposition question without allowing an answer to the changed question, and assumed that “substantial similarity” is equivalent to “substantially the same.” (Opening Brief, pp.40-44).

⁸ Counsel for Ford indicated during oral argument that the expert’s answers should not be treated as judicial admissions. (19-1747; 21:59-22:43).

Fourth, the district court granted summary judgment because the court found “no genuine issue of material fact that New World’s accused parts include the visually dominant aspects of the claimed design as described by the experts and also include the aspects of the claimed design that differ from the prior art.” (Appx81). This Court should clarify that neither of these factors should be outcome determinative because an accused design, while possessing the above, also can include features not in the claimed design but in the prior art, and that render the overall appearance not substantially the same as the claimed design.

5. Damages and Attorney Fees

There is no evidence that defendant United Commerce Centers, Inc. (UCC) made, used, offered to sell, sold, or imported any accused products. The jury verdict on damages and willful infringement was limited to New World, Inc. (Appx8608). The judgment holding UCC jointly and severally liable for damages and attorney fees is contrary to 35 U.S.C. § 271, *Shockley v. Arcan*, 248 F.3d 1349, 1364 (Fed. Cir. 2001), and *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1186 (Fed. Cir. 1995).

Conclusion and Relief Sought

Appellants respectfully request that this Court grant this petition for rehearing en banc and reverse the judgment of the district court.

Respectfully submitted,

/s/ Robert G. Oake, Jr.

Robert G. Oake, Jr.

Oake Law Office, PLLC

700 S. Central Expy., Suite 400

Allen, Texas 75013

(214) 207-9066

rgo@oake.com

Attorney for Appellants

ADDENDUM - JUDGMENT OF AFFIRMANCE WITHOUT OPINION

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

FORD GLOBAL TECHNOLOGIES, LLC,
Plaintiff-Appellee

v.

**NEW WORLD INTERNATIONAL, INC., AUTO
LIGHTHOUSE PLUS, LLC, UNITED COMMERCE
CENTERS, INC.,**
Defendants-Appellants

2019-1746

Appeal from the United States District Court for the
Northern District of Texas in No. 3:17-cv-03201-N, United
States District Judge David C. Godbey.

JUDGMENT

JESSICA LYNN ELLSWORTH, Hogan Lovells US LLP,
Washington, DC, argued for plaintiff-appellee. Also repre-
sented by KIRTI DATLA, REEDY SWANSON; MARC LORELLI,
Brooks Kushman PC, Southfield, MI.

ROBERT GLENN OAKE, JR., Oake Law Office, Allen, TX,
argued for defendants-appellants.

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (NEWMAN, O'MALLEY, and WALLACH,
Circuit Judges).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

June 22, 2020
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

CERTIFICATE OF COMPLIANCE

1. This Petition complies with the type-volume limitations of Federal Rule of Appellate Procedure 35(b)(2)(A). This Petition contains 3,898 words, excluding the parts of the Petition exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b)(2).
2. This Petition 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 Petition 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 Appellants
August 10, 2020

CERTIFICATE OF SERVICE

I hereby certify that on August 10, 2020, 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.

Attorney for Appellants