

AUTOMOTIVE BODY PARTS ASSOCIATION v. FORD GLOBAL TECHNOLOGIES, LLC,
Appeal No. 2018-1613 (Fed. Cir. July 23, 2019). Before Hughes, Schall and Stoll. Appealed
from E.D. Mich. (Judge Michelson).

Background:

Automotive Body Parts Association (ABPA), a trade association for auto parts distributors, brought suit challenging the validity of Ford's design patents after Ford sent cease and desist letters to certain association members. The patents cover designs for hoods and headlamps on the F-150 pickup truck.

At district court, ABPA argued Ford's designs were primarily functional and thus not proper subject matter for design patents under 35 U.S.C. §171, which requires the designs to be ornamental. Specifically, ABPA argued Ford's hoods and headlamps provided a functional benefit because consumers seeking replacement parts would desire parts that were aesthetically compatible with their vehicles. The district court found ABPA's arguments without merit and entered judgment in favor of Ford *sua sponte*. ABPA appealed.

Issue/Holding:

Did the district court err in granting summary judgment of validity? No, affirmed.

Discussion:

On appeal, the Federal Circuit confirmed the lack of merit in ABPA's argument that Ford's designs are functional because they aesthetically match the F-150 truck. The Federal Circuit noted that all patented designs are directed to articles of manufacture and thus serve some utilitarian purpose. There was no basis in the law for ABPA's contention that aesthetic appeal was purely functional. Rather, a design's aesthetic is exactly the type of ornamentality protected by 35 U.S.C. §171.

ABPA then argued that the Federal Circuit should apply the principle of "aesthetic functionality" from trademark law, which denies trademark rights if consumers derive a value from the fact that a product looks a certain way. However, the Federal Circuit declined ABPA's suggestion, explaining that trademarks and design patents serve different purposes, and the "aesthetic functionality" doctrine does not apply to design patent considerations.

ABPA next argued that Ford's patents were unenforceable against ABPA based on the doctrine of exhaustion, with the sale of the F-150 truck totally exhausting any design patents embodied in the truck. The Federal Circuit disagreed, noting that exhaustion only applies to the particularly items sold by, or with the authorization of, the patentee. ABPA's sales were not authorized by Ford, and thus exhaustion did not protect them. Moreover, exhaustion only applies to the item sold, not to a second creation of the item.

ABPA finally attempted to argue their immunity under the doctrine of repair, which conveys to the purchaser of a patented product the right to repair its parts. This argument was likewise unpersuasive because the right to repair does not permit a complete reconstruction of a patented device, and also does not permit a purchaser to infringe other patents by manufacturing separately patented components of the purchased article, like the separately patented hoods and headlamps of the truck at issue. The district court's judgment was affirmed.