

Automotive Body Parts Association (ABPA)

The Honorable Lisa R. Barton
Secretary to the Commission
U.S. International Trade Commission
500 E Street S.W. Room 112A
Washington, D.C. 20436
Re: Inv. No. 337-TA-1291

Dear Secretary Barton,

My name is Edward Salamy, the Executive Director of the Automotive Body Parts Association (ABPA), and I am reaching out to you in response to the Commission's request for public comments in Investigation No. 337-TA-1291.

Articles potentially subject to the exclusion order are automotive repair parts, specifically aftermarket replacement automotive lamps that are used to repair a vehicle involved in a collision. These parts are generally purchased and installed by both vehicle owners and repair shops throughout the country as an alternative to more expensive original equipment manufacturer (OEM) parts.

The exclusion order of these vehicle repair parts would have a tremendous negative impact on the US automotive repair parts supply chain. Consumers rely on these parts to repair their vehicles and bring them to pre-accident condition. The absence of these repair parts would lead to higher motor vehicle repair costs due to lack of competition to the OEMs. Additionally, consumers would face higher automotive insurance costs due to more expensive parts pricing as well as a significant time delay in getting their vehicles repaired due to fewer options in the supply chain. At present time, there is no major aftermarket manufacturing presence of these repair parts in the US which would serve as an alternative to those manufactured overseas. This would leave the OEM manufacturers, most of whom have their lamps manufactured overseas as well, as the only choice for consumers.

The public relies upon proper application of design patent law. Unfortunately, the ALJ overlooks or misapplies several important rules. The ALJ improperly construes claims of passenger-side (PS) lamp designs to include driver-side (DS) lamp designs by overlooking two important rules of claim construction: the drawings and description define the claim and the title and claim must match. Each design patent states “as shown and described.” This means that both the drawings and the written description define the scope of the claim.¹ The drawings include only a design for a PS lamp and nothing in the description indicates a mirror image is claimed. Therefore, the claim does not include a claim to a design embodied in a DS lamp. A second rule of claim construction confirms this conclusion. This rule is that the claim must correspond to the title. *See* MPEP 1503.01(I). The title is important for several reasons. It “helps the public in understanding the nature and use of the article embodying the design after the patent has been issued.” *Id.* Further, as stated in *Curver*, the title defines the scope of the claim. The title to each subject patent contains either the term “Head Lamp” or “Rear Combination Lamp.” Since each term is *singular*, each title indicates to the public that only one side has been claimed. The ALJ’s improper claim construction eliminates the public notice function of design patent law.

If Complainants wanted to claim both sides, it was easy to do so. For example, by (1) seeking two patents (e.g., D489,656 and D493,393), (2) illustrating two embodiments in one patent (e.g., D587,638 and D598,348), or (3) claiming a mirror image embodiment in one patent (e.g., D753,325). Importantly, if two sides are claimed in one patent, then the requirement of MPEP 1503.01(I) must be satisfied, which requires that the title define the two parts as a single entity. For example, as a pair. If the title fails to do so, then a rejection should issue. Kia is aware of this rule. *See* App. No. 35/502,830 (Title “Rear Door Panel for Vehicle” rejected and changed to “Pair

¹ *See Curver Lux., SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1341 (Fed. Cir. 2019).

of Rear Door Panels for Vehicles”); *see also, e.g.*, Apps. 29/284,361, 29/328,234, 29,435,151, 29/290,520, 29/290,522. In short, if a patentee does not do one of (1) through (3) above, and if doing (2) or (3), does not use a title such as “pair of headlamps,” then it is clear the patentee is not seeking protection for the mirror image of the claimed design.

Significantly, under the ALJ’s claim construction that a claim to a PS lamp includes the DS lamp, *all the subject design patents are invalid*. That is because when the title does not match the claim, a design patent is invalid as indefinite under 35 USC §112. In *In re Maatita*, 900 F.3d 1369, 1376 (Fed. Cir. 2018), the Court cites with approval *Eclectic Products., Inc. v. Painters Product, Inc.*, 2015 U.S. Dist. LEXIS 26336 (D. Or. Mar. 2, 2015), where the Court held a design patent claim invalid for indefiniteness when the title of the design patent was “applicator cap,” but the drawings did not show a cap. In short, if the claim is interpreted to include both sides and the title is directed to a single lamp, then the title and claim do not match in violation of 37 CFR 1.153 and the patents are invalid under 35 USC § 112 due to confusion regarding claim scope.

Regarding the ordinary observer test, the ALJ makes two reversible errors in concluding that a DS lamp infringes the claim of the PS lamp. First, the ALJ states the proper inquiry to be “whether the ordinary observer would be induced to purchase a driver-side lamp supposing it to be *the patented design*.” This is not the proper inquiry because it separates the design from the article. Such separation is prohibited. A fundamental principle is that design patents do not cover abstract designs, but rather designs *applied to* articles of manufacture. *See Curver, supra*, at 1336.

In *Curver*, the Court cites *Gorham* and states “[i]n characterizing the invention in a design patent, the Supreme Court focused not only on the distinctiveness of the design pattern itself, *but how the design transformed the appearance of the "article of manufacture" to which the design was applied.*” 938 F.3d at 1340 (emphasis added). When determining infringement in this matter, the

abstract claim to a lamp design cannot be separated from the PS lamp article. Therefore, an ordinary observer would not confuse a DS lamp with a PS lamp embodying the claimed design, particularly because the installation period must be considered in the analysis as explained below. The second error is that the ALJ improperly focuses only on point of purchase. The infringement inquiry occurs over the entire “normal use” of an article.² “Normal use” extends over “a period in the article's life, beginning after completion of manufacture or assembly and ending with the ultimate destruction, loss, or disappearance of the article.”³ Since the period includes when the article embodying the accused design is installed, the proper inquiry includes whether an ordinary observer would be confused that the DS lamp was the PS lamp during installation. Confusion is impossible because proper installation of a DS lamp on the passenger side is impossible.

The ALJ’s finding “that an ordinary observer would give less attention to the rear side of the lamp than the front side of the lamp” is incorrect. The ALJ reasons that “because one must compare the patented and accused designs ‘giving such attention as a purchaser usually gives’” [citing *Gorham*], “[w]hen purchasing a headlamp or taillamp, an ordinary observer would care more about the portion of the lamp that is visible when the lamp is installed in a vehicle.” *Id.* The ALJ concludes that “while I will consider all views of the lamp in my analysis, I will give more weight to the views of the lamp that an ordinary observer would focus on when purchasing a lamp.” *Id.* Nothing in *Gorham* supports the principle that an ordinary observer should give any less weight to features based on visibility after the article is installed. Indeed, when conducting an infringement analysis under the *Gorham* test, “the patented design is viewed in its entirety, as it is claimed.”⁴ In *Contessa, supra*, the district court did not consider the bottom side of a patented design because

² *Contessa Food Prods. v. Conagra, Inc.*, 282 F.3d 1370 (Fed. Cir. 2002).

³ *In re Webb*, 916 F.2d 1553, 1557-58 (Fed. Cir. 1990).

⁴ *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125 (Fed. Cir. 1993).

the bottom was partially obscured at point of sale. The Federal Circuit reversed, stating that “nothing in *Gorham* restricts the comparison between the patented design and the accused product to features visible at the point of purchase.” *Id.* at 1381.

Arguments substantially like the ALJ’s position were rejected in *Tecumseh Prods. Co. v. Briggs & Stratton Corp.*, 295 F. Supp. 2d 902 (E.D. Wis. 2003). Plaintiff’s expert opined the ordinary observer “would primarily view the engines from the downwardly-looking front perspective, without considering the other views in as much detail” and “because the engine would be attached to the deck of the lawnmower, the ordinary purchaser would not be able to see the bottom view at all, and the back view would likely be obscured by the mower bag.” *Id.* at 914. Like the ALJ, plaintiff argued that considering these practical factors “is a proper application of the *Gorham* test, a fact-based conceptual framework of an ordinary observer making a purchasing decision, considering the overall visual impression of the engines, and giving such attention as a purchaser would normally give.” *Id.* The Court rejected the argument, stating “[t]his is not a proper application of the *Contessa* ordinary observer test_[.]” where the Court “made clear that in determining whether an accused design infringes on a patented design the court is to consider ‘all ornamental features visible at any time during normal use of the product,’ not just those visible to a retail purchaser at the time of purchase.” *Id.* (citing *Contessa*, 282 F.3d at 1381).

Finally, the ALJ’s infringement analysis renders the test for anticipation unworkable. The tests for infringement and anticipation must remain the same to prevent inconsistencies from developing between the two analyses.⁵ The test for anticipation requires analysis of prior art, but features from the prior art could not be meaningfully and consistently evaluated if the relative visibility of such prior art features in potentially different installation environments had to be considered.

Sincerely,


Edward Salamy, ABPA

⁵ See *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1237 (Fed. Cir. 2009).