

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-1292

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-1292.

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 the proper and consistent application of design patent law. Unfortunately, the ALJ overlooks or misapplies several important rules. The ALJ states “I find that the ordinary observer includes customers purchasing a new vehicle or a replacement lamp for such a vehicle.” However, when applying the ordinary observer test “the focus is on the actual product that is presented for purchase, and the ordinary purchaser of that product.”¹ Unless there is evidence in the record that the respondents sold accused lamps to someone building new vehicles, then under *Goodyear, supra*, the actual accused product presented for purchase is only a replacement lamp for a vehicle and the ordinary observer is the ordinary purchaser of that replacement product.

The ALJ’s finding “that the ordinary observer would give more attention to the front side of the lamps than the rear side” is contrary to well-established law. The ALJ begins by citing *Gorham* with the parenthetical “(noting that one must compare the patented and accused designs ‘giving such attention as a purchaser usually gives’).” *Id.* The ALJ then states “Hyundai’s expert testified that designers spend more time working on the front of the lamp than on the rear of the lamp, which suggests that the purchasers pay less attention to the rear of the lamps.” *Id.*

Nothing in *Gorham* or subsequent cases supports the principle that the amount of time designers spend on design features determines whether ordinary observers will give those features more or less attention. The ALJ cites no cases, and the authority is to the contrary. Indeed, when conducting an infringement analysis under the *Gorham* test, “the patented design is viewed in its entirety, as it is claimed.” *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125 (Fed. Cir. 1993).

The ALJ then observes “[t]hat is not surprising, given that rear portion of the lamp will not be visible after the lamp is installed on a vehicle.” Again, nothing in *Gorham* or subsequent cases

¹ *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1117 (Fed. Cir. 1998)

supports this principle. When arguments are made that only features visible at certain points in the useful life of a product should be considered, such arguments are rejected. For example, in *Contessa Food Prods. v. Conagra, Inc.*, 282 F.3d 1370 (Fed. Cir. 2002), the district court did not consider the bottom of a patented design because it was partially obscured at point of sale. The Federal Circuit reversed, stating “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.

The ALJ’s rationale appears to be that the phrase in *Gorham* “giving such attention as a purchaser usually gives” means an ordinary observer may give more or less attention to design features based on the various practical criteria mentioned by the ALJ. Arguments substantially similar to the ALJ’s rationale 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).

The ALJ states “Respondents’ expert, Mr. Brian Baker, focused on the front of the lamp, not the rear.” Mr. Baker’s failure to consider the patented design “in its entirety, as it is claimed,” is contrary to law.² A flawed expert approach does not justify a flawed ordinary observer analysis.

The ALJ states “[f]inally, the rear of the lamps illustrated in the Asserted Patents are relatively dark and bland compared to the more visually stimulating appearance of the front face of those lamps” [and] “[c]onsequently, one would expect the ordinary observer to be less interested in the rear of the lamps and to find it more difficult to readily spot distinctive visual features.” 35 U.S.C. § 112 requires the entire claimed design to be described and enabled. If it is not, then the patent is invalid as indefinite. The patent drawings show the configuration of the lamp rears can be observed and considered as part of the entire claimed design. Simply because some portions of the design are what the ALJ considers to be “relatively dark and bland” does not justify them being given less weight than other portions, and there is no authority supporting the ALJ’s position.

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.³ The anticipation test requires analysis of prior art. However, features from the prior art cannot be meaningfully and consistently evaluated when the relative visibility of such prior art features in potentially different installation environments must be considered.

The ALJ makes two critical errors in concluding that a driver-side (DS) lamp infringes the passenger-side (PS) lamp claim. The ALJ states “[t]he relevant question is whether an ordinary observer would ‘believe the accused design to be the same as the patented design.’” Although the ALJ correctly quotes an isolated phrase from *Egyptian Goddess*,⁴ the phrase is not the *entire*

² See, e.g., *L.A. Gear, supra*, at 1125).

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

⁴ *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 682 (Fed. Cir. 2008)

relevant question regarding the mirror image issue because, when taken out of context, the quote improperly separates the design from the article. A fundamental principle is that design patents do not cover abstract designs, but rather designs *applied to* articles. See *Curver Lux., SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1336 (Fed. Cir. 2019). *Egyptian Goddess* recognizes this principle: “The question before this court under the standard we have set forth above is whether an ordinary observer, familiar with the prior art Falley and Nailco designs, would be deceived into believing the *Swisa buffer is the same as the patented buffer.*” *Id.* at 681 (emphasis added).

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 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."⁵ 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. Finally, the ALJ’s ear analogy only becomes relevant if ears are severed and replaced – in which case the victim would not confuse their left and right ear during reattachment. Sincerely,

Edward Salamy
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⁵ *In re Webb*, 916 F.2d 1553, 1557-58 (Fed. Cir. 1990).