BARNES & THORNBURG LLP

ALERTS

Federal Circuit Declines To Include Aesthetic Appeal As A Design Function That Invalidates A Design Patent

July 26, 2019 | Atlanta | Chicago | Columbus | Dallas | Delaware | Elkhart | Grand Rapids | Indianapolis | Los Angeles | Minneapolis | San Diego | South Bend | Washington, D.C.

Design patents protect the ornamental features of an item, rather than the functional features that may be protected by other means, such as utility patents. However, the aesthetic appeal that the item provides to the overall end product does not make that design functional, according to the U.S. Court of Appeals for the Federal Circuit in its recent decision in *Automotive Body Parts Assn. v. Ford Global Technologies, LLC*, Case No. 2018-1613 (Fed. Cir. July 23, 2019).

The court also held that the doctrine of patent exhaustion and right to repair were inapplicable to sales of replacement parts of the complete patented component that were not authorized by the patent owner.

The appeal in this case arose after the Automotive Body Parts Association (ABPA) failed in its attempt to invalidate Ford's design patents for a vehicle hood and a headlamp. The ABPA maintained that consumers of these parts express genuine preference for Ford's hoods and headlamps when restoring F-150 trucks to their original appearance. According to the ABPA in its appeal, this preference in achieving an aesthetic match means that the hood and headlamp designs are, in fact, functional, and not eligible for design patent protection.

In declining to accept the ABPA's argument, the Federal Circuit reiterated that "a valid design may contain some functional elements" to the extent that it protects an article of manufacture that necessarily serves a utilitarian purpose. The court went on to hold that, "even in this context of a consumer preference for a particular design to match other parts of a

RELATED PEOPLE

Kyle A. Forgue
Partner
Chicago

P 312-214-4841
F 312-759-5646
kforgue@btlaw.com

RELATED PRACTICE AREAS

Intellectual Property

whole, the aesthetic appeal of a design to consumers is inadequate to render that design functional." The market advantage conferred by a design patent also does not render the design functional. Indeed, the Federal Circuit stated, to invalidate a design patent based on a conferred market advantage would amount to invalidating a design for "[t]he very 'thing. . . for which [the] patent is given, ... that which gives a peculiar or distinctive appearance,' its aesthetic."

The ABPA further argued that Ford's sale of trucks that include the patented components permits the sale of replacement parts under the doctrine of patent exhaustion. The Federal Circuit affirmed that "exhaustion attaches only to items sold by, or with the authorization of, the patentee" and found that this did not apply to the members of the ABPA that had been alleged to infringe Ford's patents because they were not authorized to sell the patented components. The court went on to explain that even an authorized purchaser of the patented component could not then go out and make their own copies of it.

The authorized sale of a patented item also grants the purchaser a right to repair the item. However, the Federal Circuit noted that Ford patented the individual components of the vehicle, rather than the entire vehicle, and held that replacement of these patented components in the vehicle does not fall within an authorized purchaser's right to repair. "The right of repair does not … permit a complete reconstruction of a patented device or component."

For more information, contact the Barnes & Thornburg attorney with whom you work, or Irina Sullivan at 312-214-8331 or isullivan@btlaw.com or Kyle Forgue at 312-214-4841 or kforgue@btlaw.com.