

Fitch, Even, Tabin & Flannery

FITCH EVEN TABIN & FLANNERY
INTELLECTUAL PROPERTY LAW | EST. IN 1859

***Design Protection
in the United States***

Presented by
Stephen S. Favakeh
John E. Lyhus

Design Protection in the United States

- Protection involving the look of a vehicle
 - Design Patents
 - Trademark rights in product configuration
- Update on litigation involving use of a vehicle manufacturer's trademark
 - Replacement parts
 - Automotive accessories

Design Patents

- Requirements
 - Novelty
 - Non-obviousness
 - Ornamentality
 - Non-functionality
 - Visibility
- Proving Infringement of a Design Patent
 - Ordinary observer test
 - Points of novelty test



US00D501162S

(12) **United States Design Patent Patent No.: US D501,162 S**
Mays et al. (45) **Date of Patent: ** Jan. 25, 2005**

(54) **FRONT BUMPER FASCIA**

(75) Inventors: **J C. Mays**, Dearborn, MI (US); **Larry R. Erickson**, Birmingham, MI (US)

(73) Assignee: **Ford Global Technologies, LLC**, Dearborn, MI (US)

(**) Term: **14 Years**

(21) Appl. No.: **29/194,549**

(22) Filed: **Nov. 26, 2003**

(51) **LOC (7) Cl.** **12-16**

(52) **U.S. Cl.** **D12/169**

(58) **Field of Search** D12/169, 196,
D12/190, 90-92, 171; 296/180.1, 180.2;
293/102, 113, 115, 120

(56) **References Cited**

U.S. PATENT DOCUMENTS

- D349,479 S * 8/1994 Kigoshi et al. D12/169
- D427,553 S * 7/2000 Pfeiffer D12/169
- D447,452 S * 9/2001 Im D12/169
- D474,720 S * 5/2003 Tachibana et al. D12/169
- D483,706 S * 12/2003 Kato D12/169
- D490,032 S * 5/2004 Ikuma et al. D12/169

OTHER PUBLICATIONS

40 Pages—Photographs of Commercial Parts.

* cited by examiner

Primary Examiner—Melody N Brown

(74) *Attorney, Agent, or Firm*—Gigette M. Bejin

(57) **CLAIM**

The ornamental design for a front bumper fascia, as shown and described.

DESCRIPTION

FIG. 1 is a perspective view of a front bumper fascia showing my new design;

FIG. 2 is a top plan view of the front bumper fascia of FIG. 1;

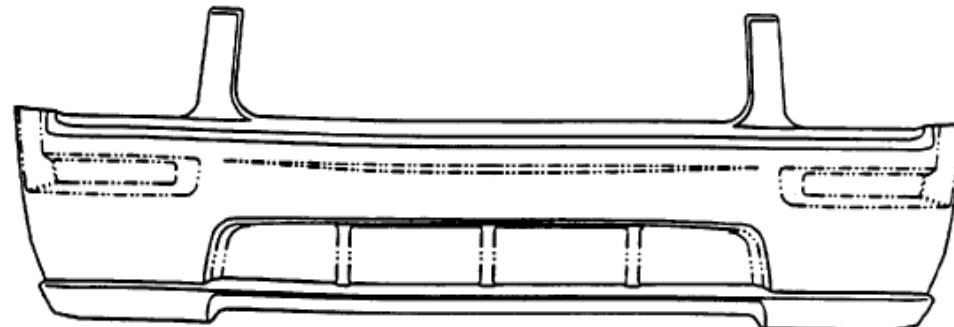
FIG. 3 is a front view of the front bumper fascia of FIG. 1;

FIG. 4 is a first side view of the front bumper fascia of FIG. 1 (the other side elevational view being a mirror image hereof); and,

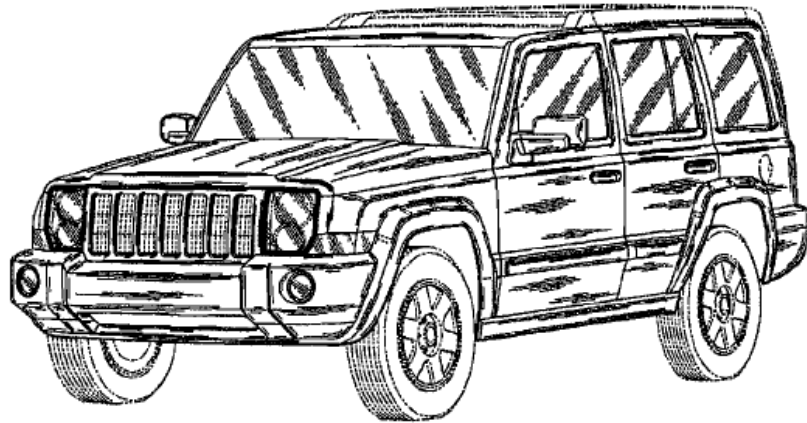
FIG. 5 is a bottom view of the front bumper fascia of FIG. 1.

The vehicle shown in broken lines in FIG. 1 is for illustrative purpose only and form no part of the claimed design.

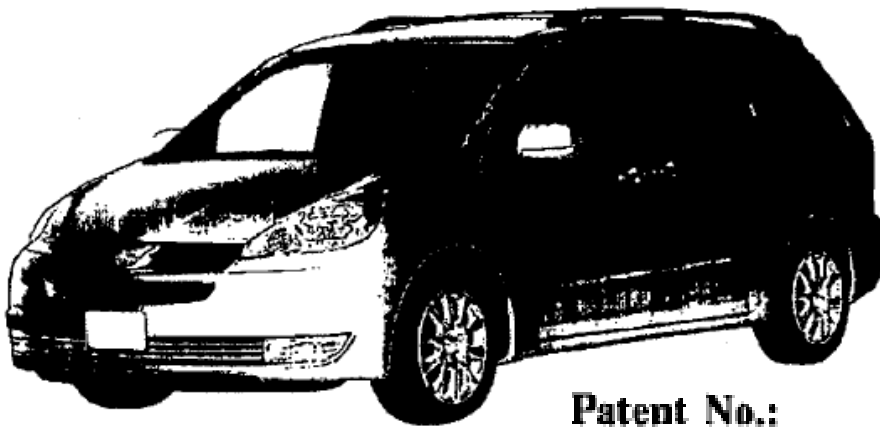
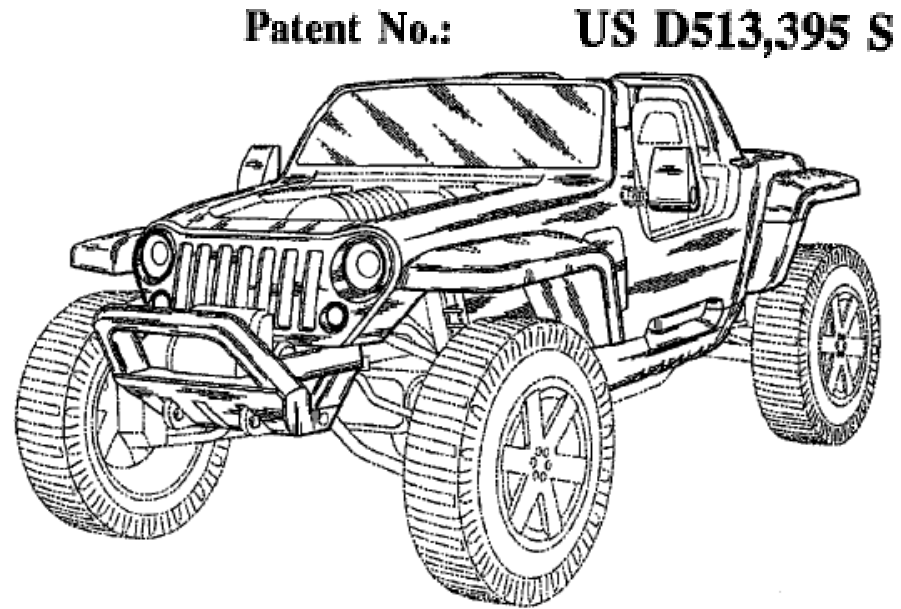
1 Claim, 2 Drawing Sheets



Full Automotive Body Design

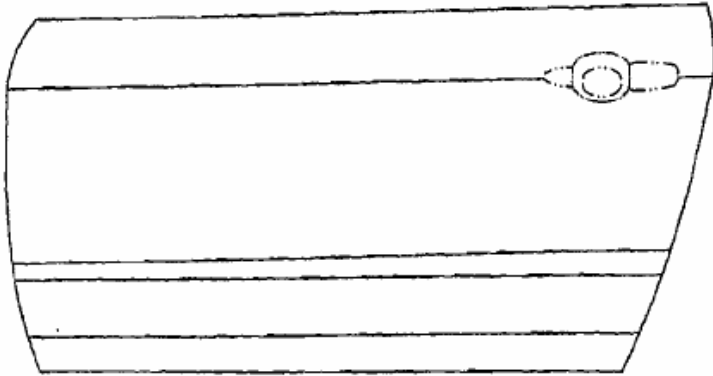


Patent No.: **US D514,983 S**

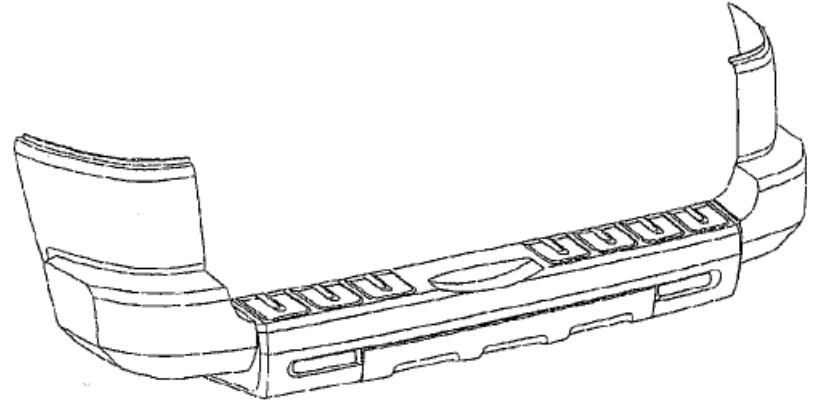


Patent No.: **US D514,024 S**

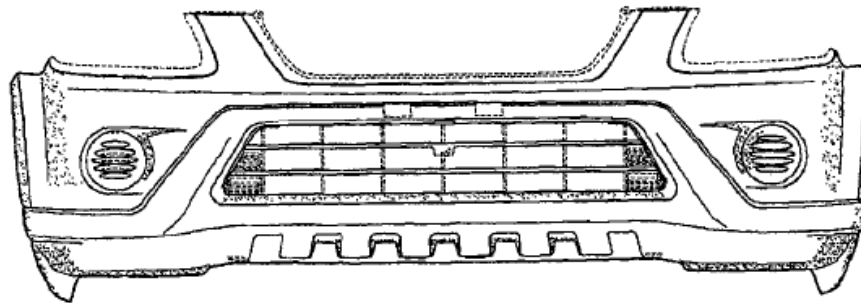
Designs for Individual Body Components



U.S. Pat. D512,948
"Door"

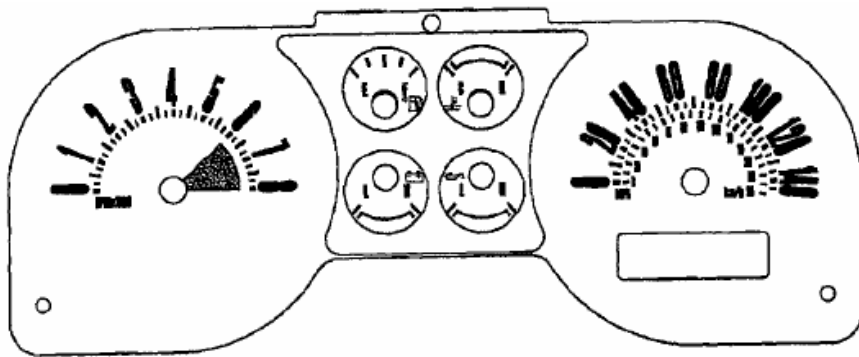


U.S. Pat. D516,476
"Bumper For An Automobile"

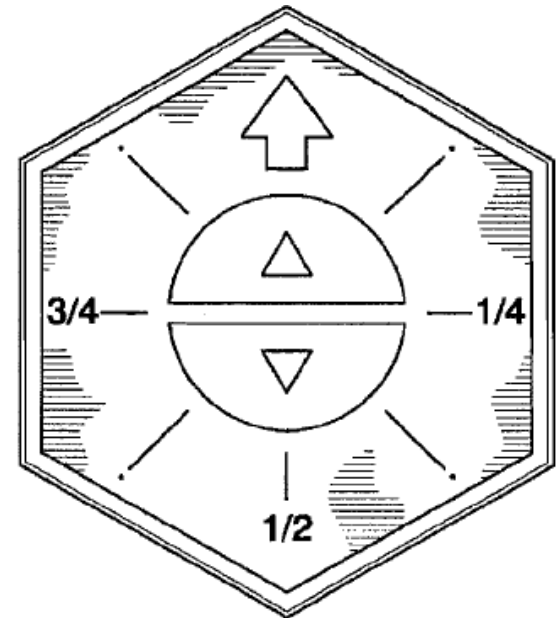


U.S. Pat. D516,474
"Front Bumper For An Automobile"

Designs For Instruments and Gauges

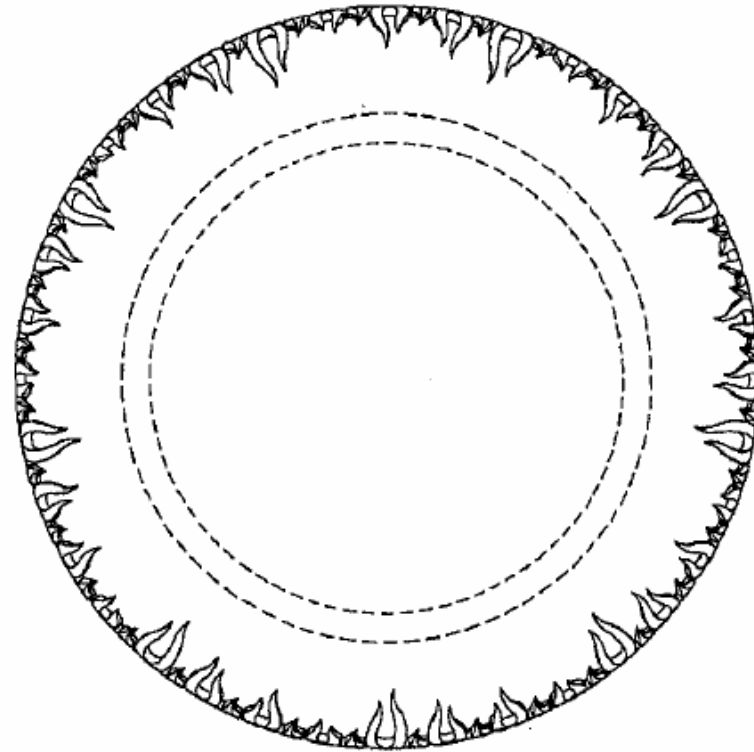
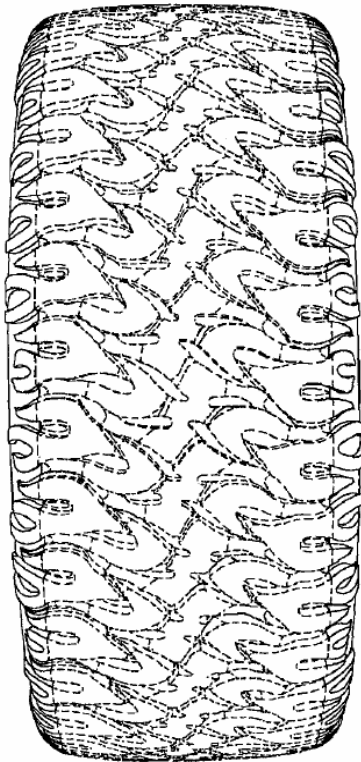


U.S. Pat. D514,996
("Automobile Instrument Gage
Face")



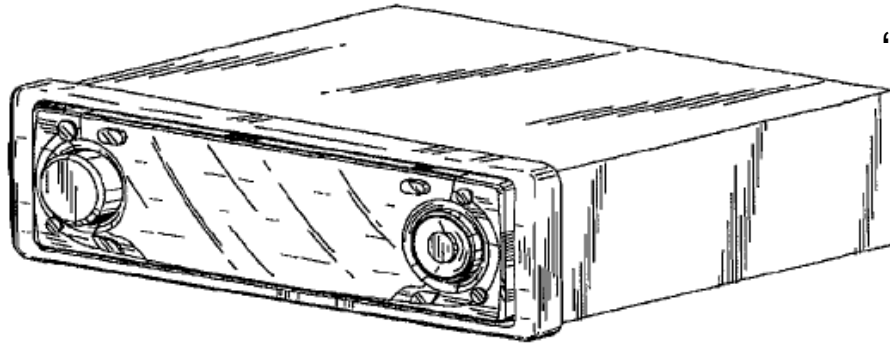
U.S. Pat. D516,045
("Automobile Window
Switch")

Tire Tread Designs

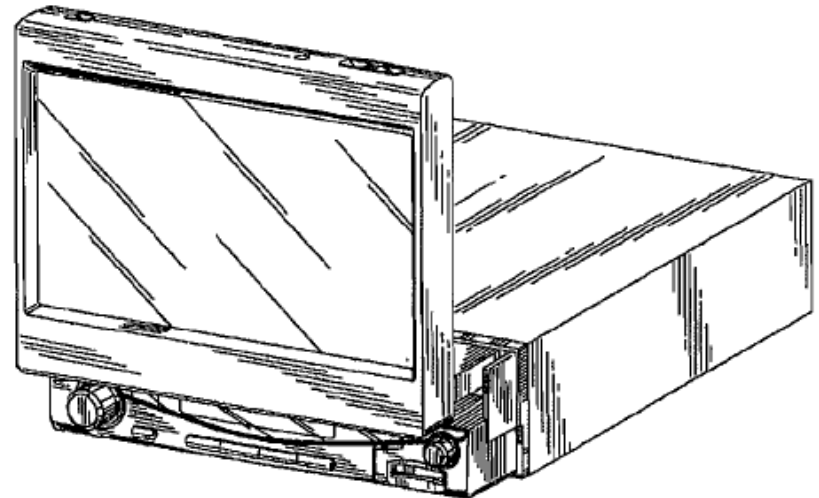


U.S. Pat. D516,016

Accessories for Use in Automobiles



U.S. Pat. D516,536
“Digital Audio Disc Player
For An Automobile”

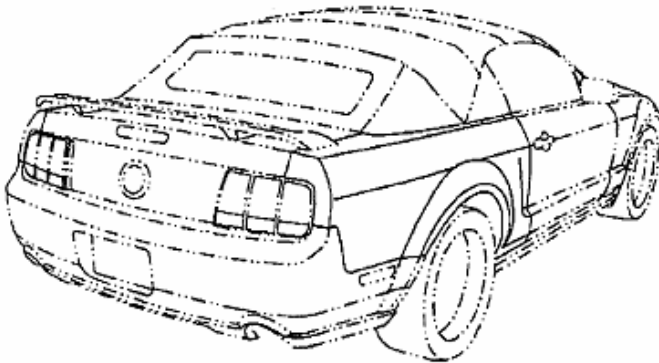
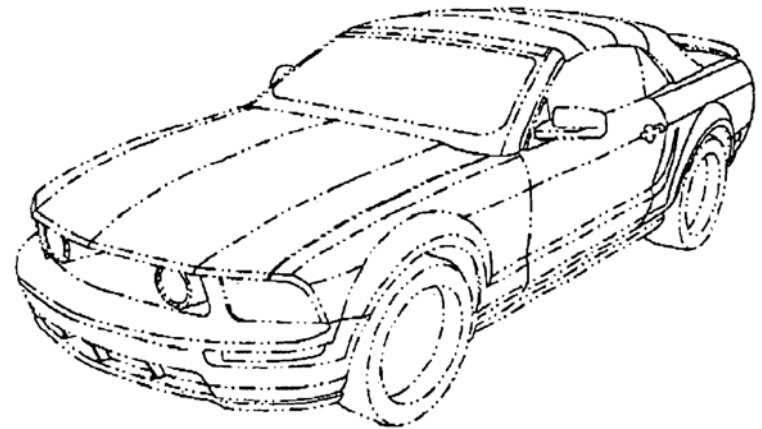


U.S. Pat. D513,609
“Television Receiver
For An Automobile”

Accurately Depicting The Design



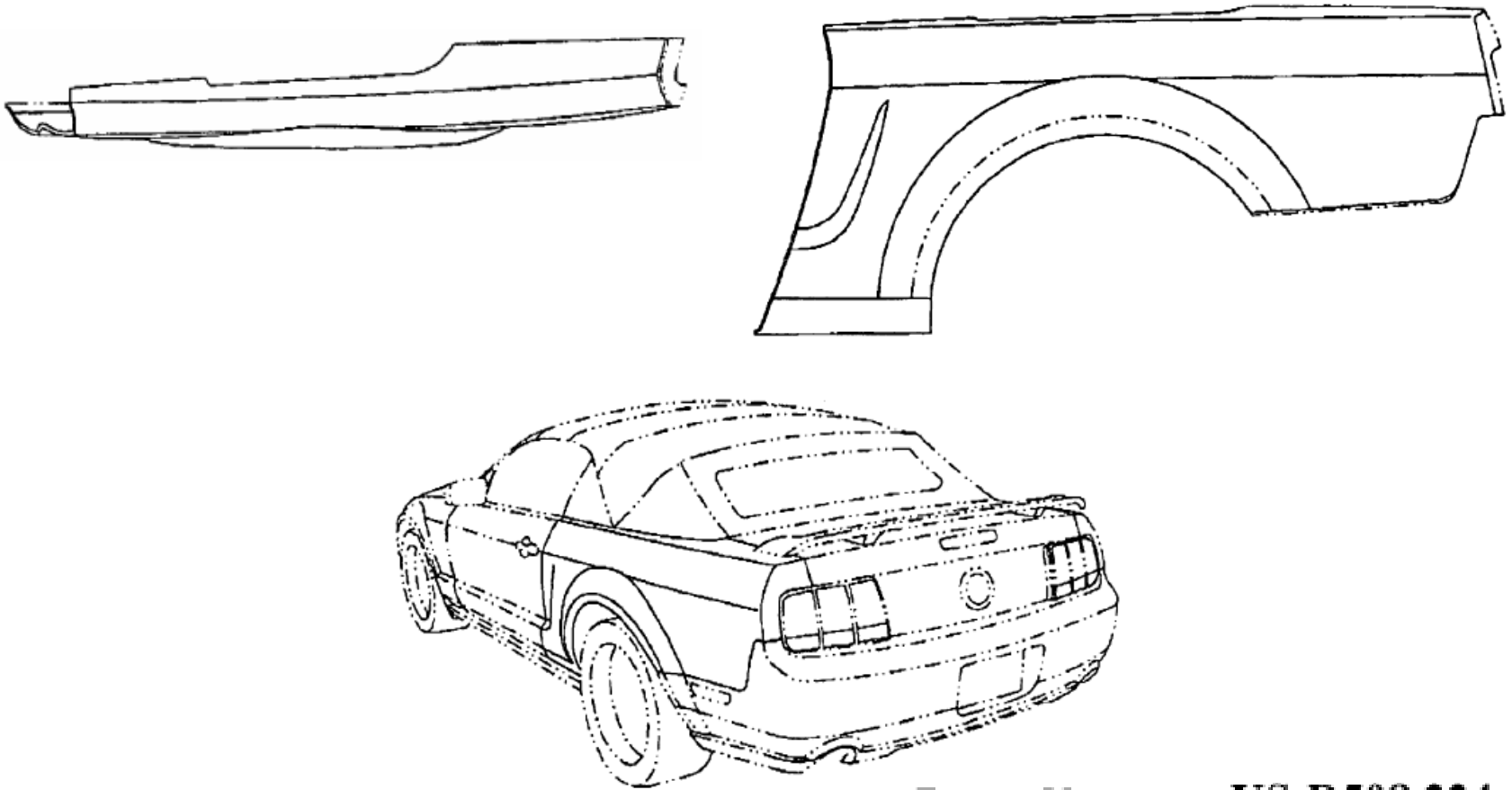
Patent No.: US D508,224 S



Patent No.: US D508,224 S



Depicting A Variety Of Views



Patent No.:

US D508,224 S

Use Of Solid And Broken Lines

Patent No.: US D508,224 S



US00D508224S

(12) **United States Design Patent: VEHICLE QUARTER PANEL D508,224 S**
Mays et al. (45) **Date of Patent: ** Aug. 9, 2005**

(54) **VEHICLE QUARTER PANEL**

(75) **Inventors:** J C. Mays, Bloomfield Hills, MI (US);
Larry R. Erickson, Birmingham, MI (US)

(73) **Assignee:** Ford Global Technologies, LLC,
Dearborn, MI (US)

(***) **Term:** 14 Years

(21) **Appl. No.:** 29/194,545

(22) **Filed:** Nov. 26, 2003

(51) **LOC (8) Cl.** 12-16

(52) **U.S. Cl.** D12/184; D12/196

(58) **Field of Search** D12/196, 184,
D12/190, 90-92; 280/152.1, 847-849, 851;
296/185

(56) **References Cited**

U.S. PATENT DOCUMENTS

D391,911 S * 3/1998 Lagaay et al. D12/196
D416,842 S * 11/1999 Gabath D12/196
D452,469 S * 12/2001 Sacco et al. D12/196
D467,853 S * 12/2002 Warming D12/196
D472,193 S * 3/2003 Sinkwitz D12/196

OTHER PUBLICATIONS

40 pages— Photographs of Commercial Parts.

* cited by examiner

Primary Examiner—Melody N. Brown

(74) *Attorney, Agent, or Firm*—Gigette M. Bejin

(57)

CLAIM

The ornamental design for a vehicle quarter panel, as shown and described.

DESCRIPTION

FIG. 1 is a perspective view of a vehicle quarter fender showing our new design.

FIG. 2 is a top view of the vehicle quarter panel shown in FIG. 1;

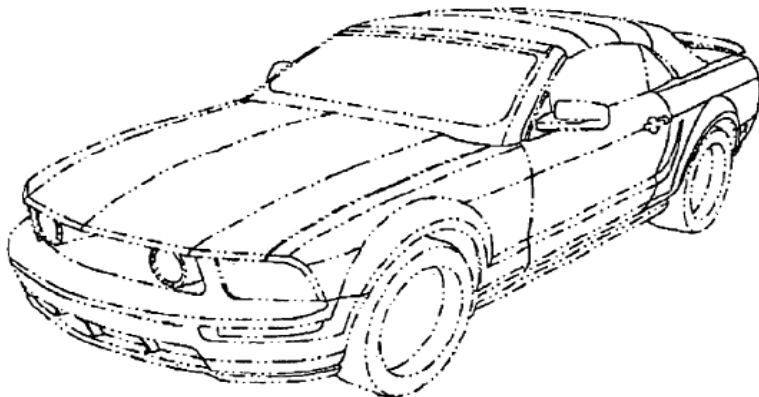
FIG. 3 is a front view of the vehicle quarter panel shown in FIG. 1;

FIG. 4 is a side view of the vehicle quarter panel of FIG. 1; and,

FIG. 5 is another perspective view of the vehicle quarter panel of FIG. 1 attached to the vehicle.

The bottom and rear views of the quarter panel are not part of the claimed design. The broken lines in the drawings of the quarter panel illustrate the environment of the design and are not part of the claimed design.

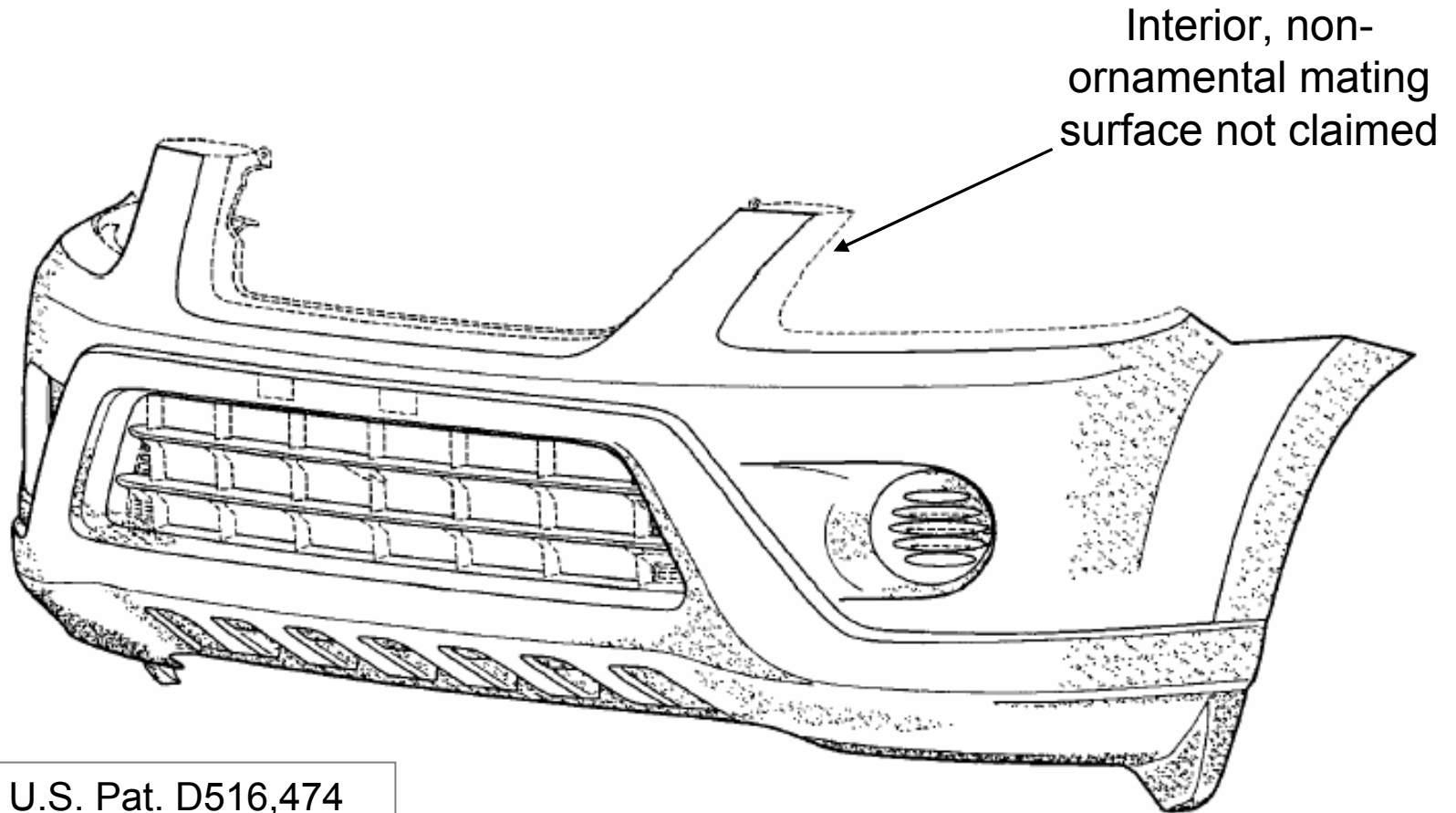
1 Claim, 3 Drawing Sheets



“The bottom and rear views of the quarter panel are not part of the claimed design.”

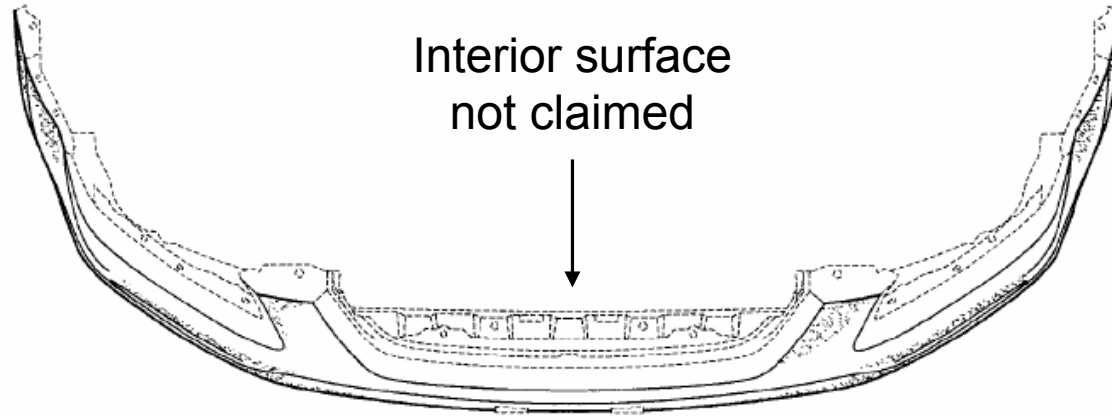
“The broken lines...illustrate the environment of the design and are not part of the claimed design.”

Use Of Solid And Broken Lines

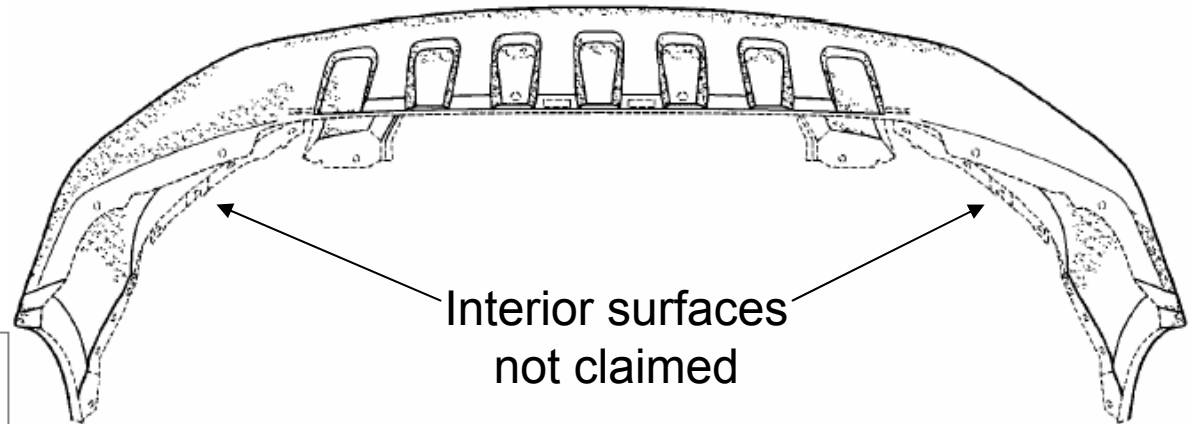


U.S. Pat. D516,474
Fig. 1

Use Of Solid And Broken Lines



U.S. Pat. D516,474
Fig. 5 (top plan view)



U.S. Pat. D516,474
Fig. 6 (bottom plan view)

Similarities:

- Scope of Protection Very Similar

Differences:

- Term (14 yrs in U.S. vs. 25 in Europe)
- No Unregistered Protection In U.S.
- Substantive Examination In U.S.
- Discovery in U.S. litigation is More Comprehensive

Types of Trade Dress

Trade Dress

```
graph TD; A[Trade Dress] --> B["Packaging Designs  
Signage  
Restaurant interior"]; A --> C[Product Configuration]
```

Packaging
Designs
Signage
Restaurant
interior

Product
Configuration

An Example of Product Configuration

Miami Vice Daytona Spider



Ferrari 365 GTS/4 Daytona Spider



Ferrari S.P.A. Esercizio Fabriche Automobili E Corse v. Roberts (6th Cir.1991)

Prosecution Record

- Elements for obtaining registration of product configuration
 - Description of source identifying element
 - Acquired distinctiveness
 - Non-functional



There are three basic types of evidence that may be used to establish acquired distinctiveness under §2(f):

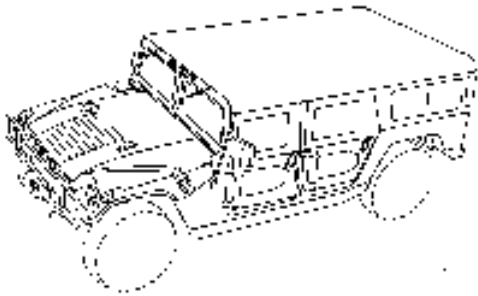
- (1) A claim of ownership of one or more **prior registrations** on the Principal Register of the same mark for goods or services that are the same as or related to those named in the pending application (See 37 C.F.R. §2.41(b); TMEP §§1212.04 *et seq.*);
- (2) A statement verified by applicant that the mark has become **distinctive of applicant's goods or services** by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before the date when the claim of distinctiveness is made (See 37 C.F.R. §2.41(b); TMEP §§1212.05 *et seq.*);
- (3) **Actual evidence of acquired distinctiveness** (See 37 C.F.R. §2.41(a); TMEP §§1212.06 *et seq.*).

Evidence of Acquired Distinctiveness

- “Look for the purple pill” advertising
- Advertising expenditures
- Media recognition
- Declarations of customers
- Surveys of customers
- Long use

Product Configuration Trademarks

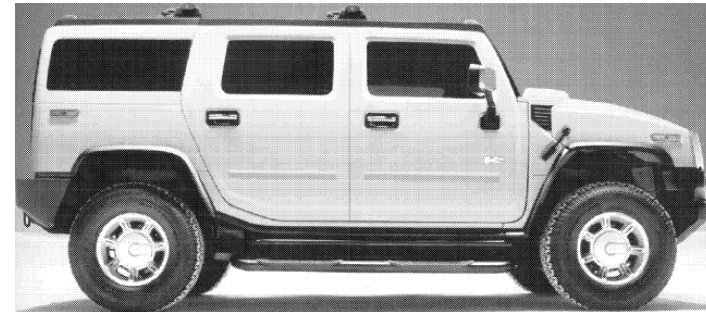
Registration Number
2969972



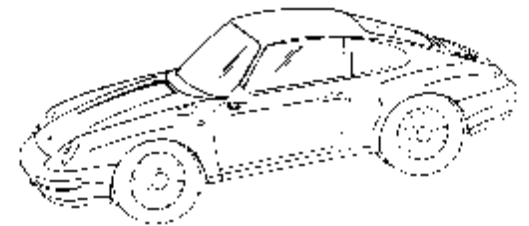
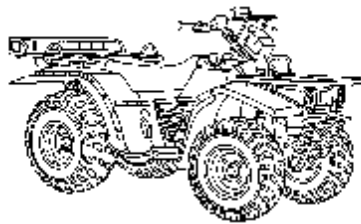
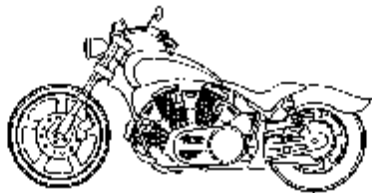
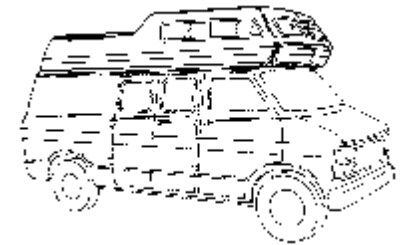
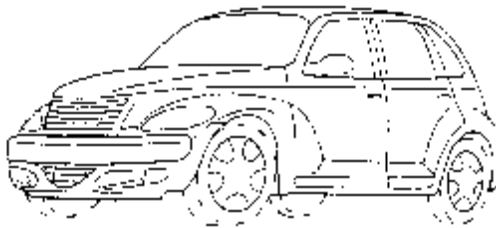
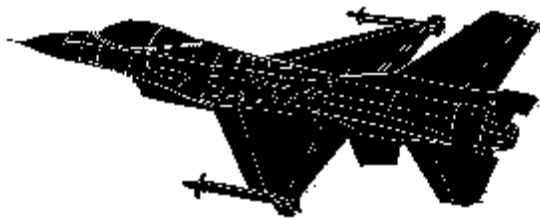
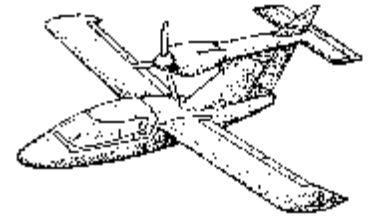
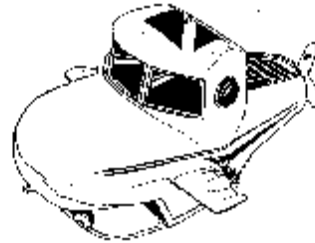
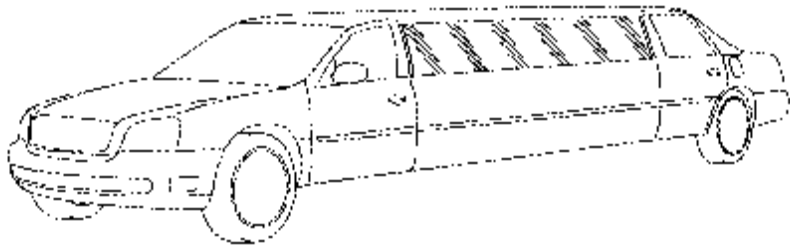
Registration Number
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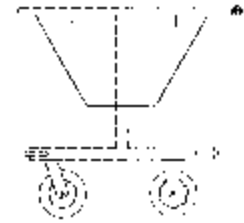
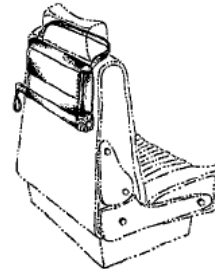
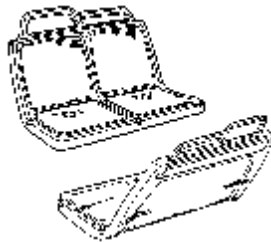
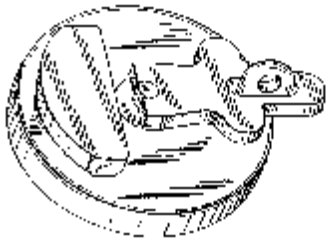
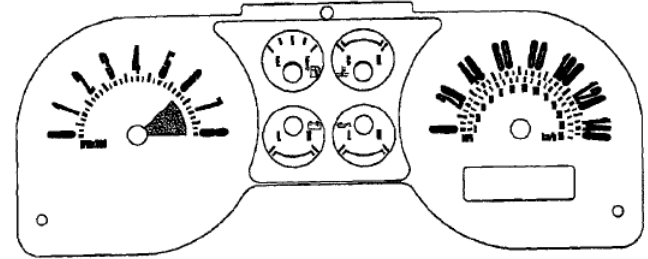
Registration Number
296456



Other Trademark Registrations



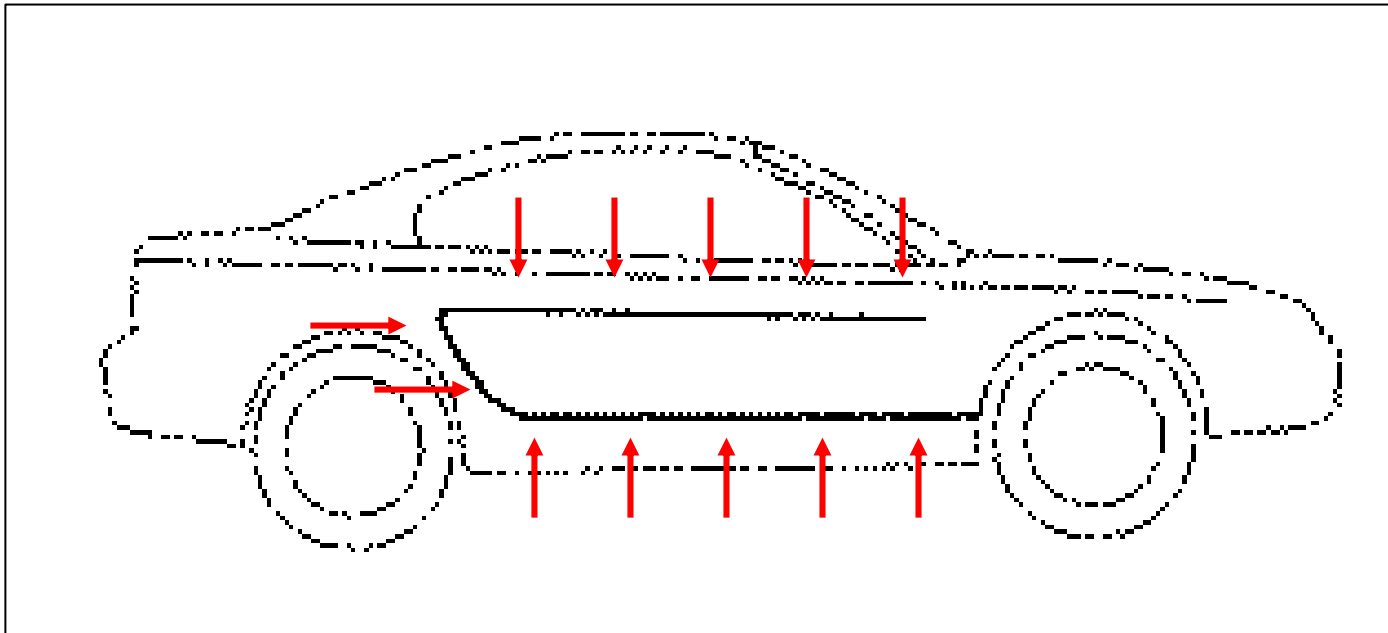
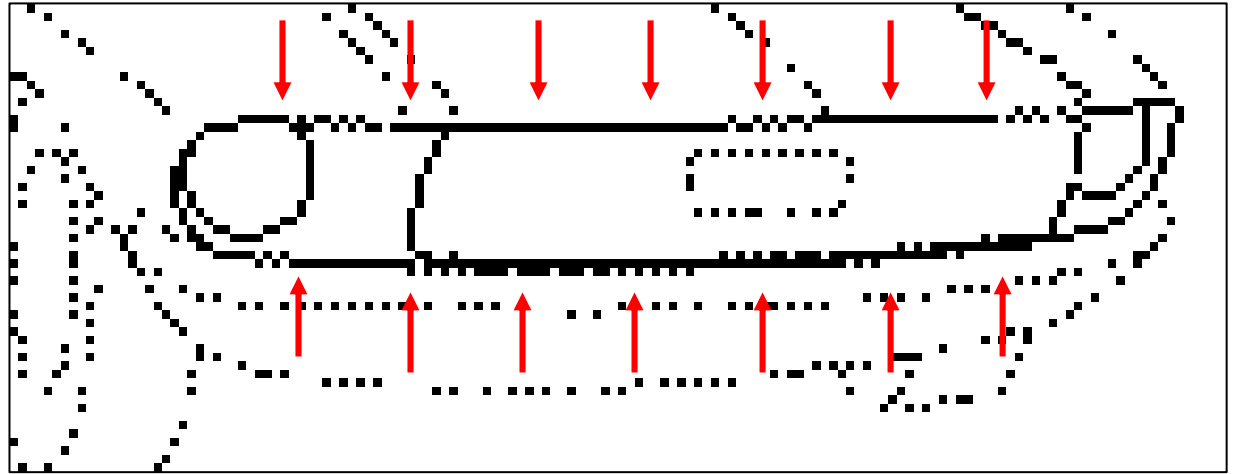
Other Trademark Registrations (cont'd)



Let's Look More Closely At An Example



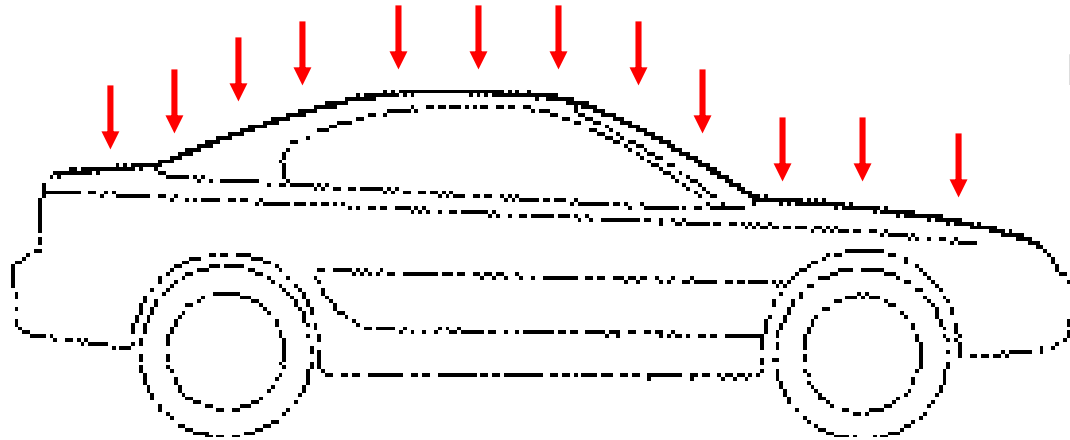
Registration Number 3064774



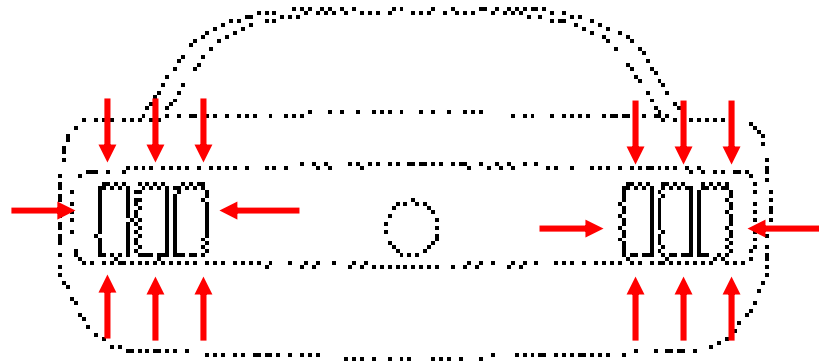
Registration Number
305233

| San Diego

Let's Look More Closely At An Example (cont'd)

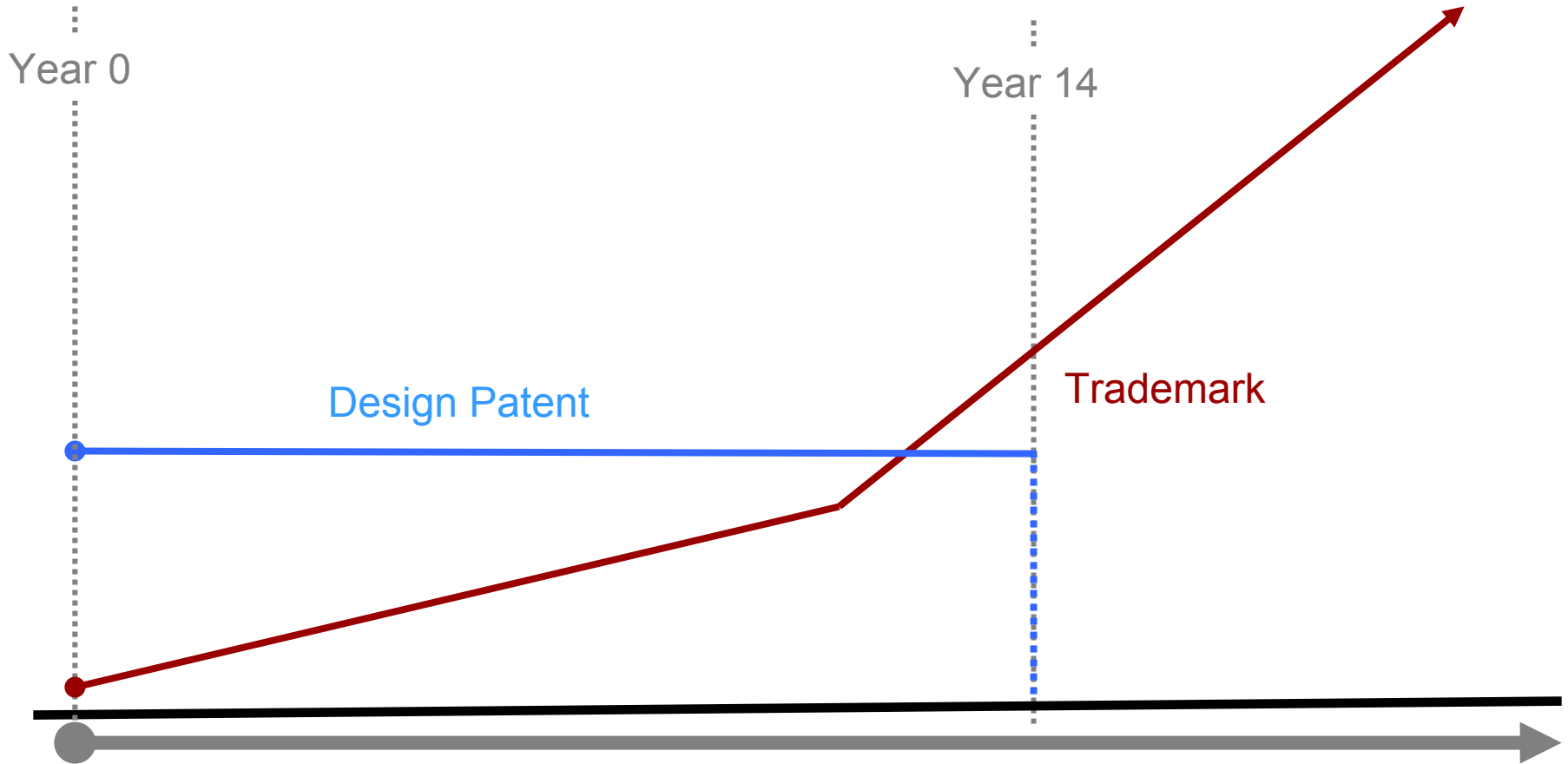


Registration Number
3052330



Registration Number
3052329

General Strategy



- File Trademark on Supplemental Register and later the Principal Register
- File Design Patent

Replacement Parts

- Starting point
- “It is beyond dispute that a manufacturer is entitled to *make* replacement parts for products not manufactured by him, provided, of course those parts are not patented.” Callmann Unfair Competition §22:27 (2004)

Tension between automobile manufacturers and replacement part industry

- Ford Motor Co. v. Keystone Automotive Industries (ED Mich 1992)
- General Motors Corp. v. Keystone Automotive Industries (ED Mich 2005)
- Battles on other fronts
 - Class actions against insurance companies and selection of lower cost replacement parts
 - Trade groups for replacement part manufacturers
 - Public relations campaigns
 - Lobbying for legislation

Ford Motor Co. v. Keystone Automotive Industries (ED Mich 1992)

- Finding of false representations of quality made deliberately to mislead the public
- Permanent injunction against, inter alia, “Keystone parts are high quality OEM specification parts.”
- \$1.8 million attorneys’ fees and costs



Search by part number

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Body Parts

NOTE: Emblems are not included with any products.

LH = Drivers Side, RH = Passengers Side.

Showing 1 to 10 of 13 - [Next](#)

image not available

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Retail Price: \$231.54

Our Discount Price: \$99.66

QTY

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Our Discount Price: \$99.66

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QTY

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Retail Price: \$222.55

Our Discount Price: \$91.12

Availability: [In Stock](#)

QTY

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GM1268103

Questions or Comments
Call: 1-877-777-8857

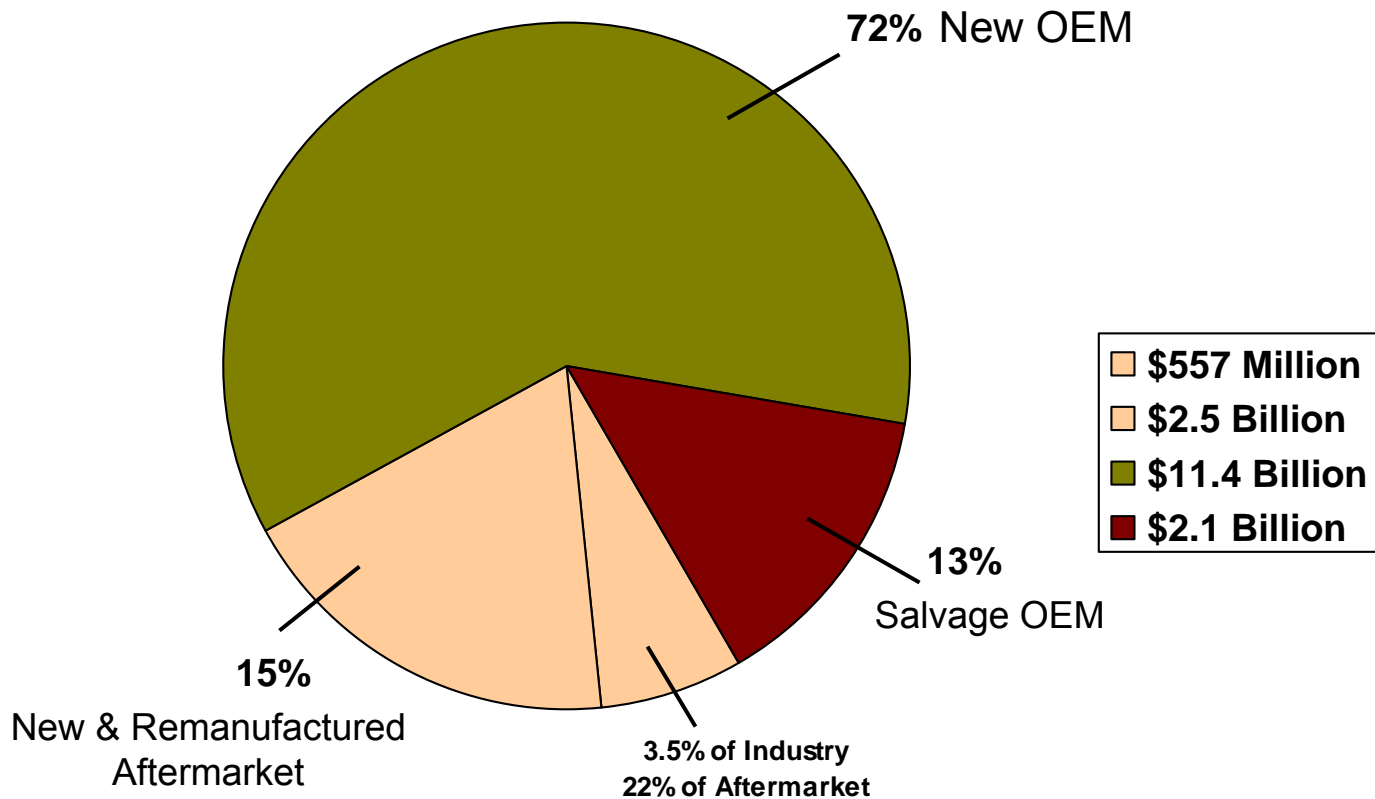
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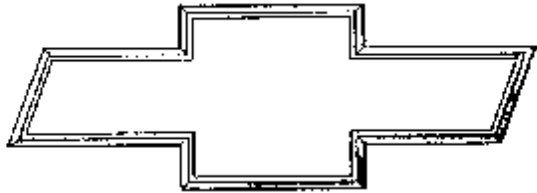
The Replacement Part Industry

\$16 Billion Per Year



Source: Keystone Automotive

General Motors vs. Keystone (ED Mich 2005)

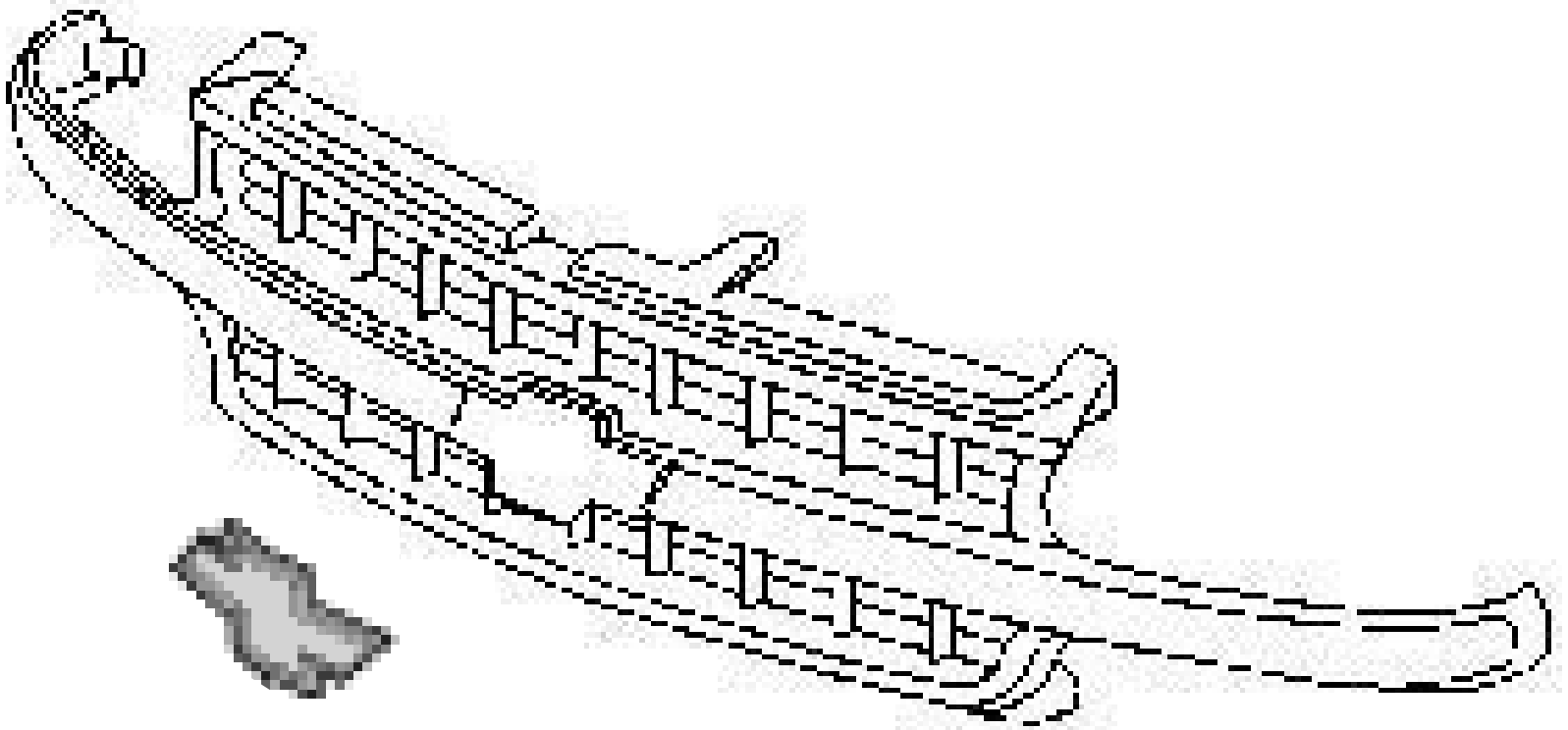


Registration number
0095398



GMC

Registration Number
1569557



Washington, DC | Chicago | Boulder | San Luis Obispo | Los Angeles | San Diego



Washington, DC | Chicago | Boulder | San Luis Obispo | Los Angeles | San Diego



Washington, DC | Chicago | Boulder | San Luis Obispo | Los Angeles | San Diego

District Court Analysis

Likelihood of Confusion factors

- Strength of Plaintiff's marks GM
- Relatedness of the goods GM
- Similarity of the marks GM
- Actual confusion Keystone
- Marketing channels "some overlap"
- Likely degree of purchaser care Keystone
- Intent Keystone
- Likelihood of expansion already national

Conclusion: Keystone Wins

- “[I]t is clear the general public associates the “bow-tie” and “GMC” marks with GM.”
- “This does not imply, however, that the average buyer will assume that every part with a “bow tie” or “GMC” embedded into it was *made by* GM. In some instances, he may only conclude that the part was *made for* a GM vehicle.”

Reasoning

- Keystone made clear that the part was not made by GM
 - “OTN” mark and “Made in Taiwan” molded in grill
 - Packaging indicates “Tong Yang”
 - Invoice disclaims connection to car manufacturer
 - “Fits with” GM vehicles
- GM did not show that the indentations are viewed by relevant audience as a source identifier
- Insufficient evidence of downstream confusion
- No evidence of contributory infringement

Present Status

On Appeal: pending with oral argument
scheduled for April 27, 2006

Automotive Accessories



Washington, DC | Chicago | Boulder | San Luis Obispo | Los Angeles | San Diego

Ford Motor Co. v. Lloyd Design Corp. (ED Mich. 2002)

- Aesthetic functionality defense rejected
 - **Dual purpose of mark**
 - To decorate the interior
 - To identify the source of the goods
 - **Downstream Confusion**
 - Disclaimers ineffective
 - Likelihood of confusion factors
 - Intentional infringement
 - Grant of injunction and attorneys fees
-
-



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"Mopar, the vehicle designs, logos and images used are registered trademarks of Daimler Chrysler Corporation and are used under license to Lloyd Mats."

"GM, the vehicle designs, logos and images used are registered trademarks of General Motors Corporation and are used under license to Lloyd Mats."

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LOGOS AVAILABLE



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CADILLAC

CHEVROLET

CHRYSLER

CORVETTE

DODGE

GENERIC

GMC

HUMMER

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- Drivetrain
- Engine & Cooling
- * Banners *
- * Customer Rides *
- Browse by year

FREE SHIPPING
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Search Mustang Parts
by Model
(This feature is not yet functional)

Year
Model



Home > Mustang Styling > Interior Dressup > Mustang Floor Mats > CDC Mustang Pony Logo Floor Mats



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CDC Mustang Pony Logo Floor Mats

These luxurious MUSTANG PONY Floor mats are custom made for a perfect fit for your Ford vehicle. This set of 4 Mustang Pony Floor Mats is made of "22 ounce" high quality, durable nylon carpeting and a superior, non-slip nibbed backing which keeps these mats firmly in place. Available for 99-04 Mustangs, with embroidery appearing on both driver and passenger front mats. Mustang Pony Floor Mats come in charcoal grey color.

Availability: Usually ships the next business day.

11003 Regular price: \$99.00 Sale price: **\$94.99**

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Registered Items:
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