

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LKQ CORPORATION and
KEYSTONE AUTOMOTIVE INDUSTRIES, INC.,
Petitioner,

v.

GM GLOBAL TECHNOLOGY OPERATIONS LLC,
Patent Owner.

PGR2020-00003
Patent D847,703 S

Before KEN B. BARRETT, SCOTT A. DANIELS, and
ROBERT L. KINDER, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

A. *Background and Summary*

LKQ Corporation and Keystone Automotive Industries, Inc. (collectively, “Petitioner”)¹ filed a Petition requesting post-grant review of U.S. Patent No. D847,703 S (“the ’703 patent,” Ex. 1001). Paper 2 (“Pet.”). The Petition challenges the patentability of the sole design claim of the ’703 patent. GM Global Technology Operations LLC (“Patent Owner”)² filed a Preliminary Response to the Petition. Paper 9 (“Prelim. Resp.”).

A post-grant review may be instituted only if “the information presented in the petition . . . demonstrate[s] that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a) (2018). Having considered the arguments and evidence presented by Petitioner and Patent Owner, we determine, for the reasons set forth below, that Petitioner has failed to demonstrate that it is more likely than not that the challenged claim is unpatentable based on the grounds presented. Therefore, we do not institute a post-grant review of that claim.

B. *Related Proceedings*

One or both parties identify, as matters involving or related to the ’703 patent, Patent Trial and Appeal Board cases IPR2020-00062 (US D811,964 S), IPR2020-00063 (US D828,255 S), IPR2020-00064 (US D823,741 S), IPR2020-00065 (US D813,120 S), PGR2020-00002

¹ Petitioner identifies LKQ Corporation and Keystone Automotive Industries, Inc. as real parties-in-interest. Pet. 4.

² Patent Owner identifies General Motors LLC and GM Global Technology Operations LLC as real parties-in-interest. Paper 4, 2.

(US D847,043 S), PGR2020-00004 (US D840,306 S), and PGR2020-00005 (US D841,532 S). Pet. 4–5; Paper 4, 2.

C. The '703 Patent and the Claim

In a post-grant review requested in a petition filed on or after November 13, 2018, we apply the same claim construction standard used in district courts, namely that articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). See 37 C.F.R. § 42.200(b) (2019). With regard to design patents, it is well-settled that a design is represented better by an illustration than a description. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)). Although preferably a design patent claim is not construed by providing a detailed verbal description, it may be “helpful to point out . . . various features of the claimed design as they relate to the . . . prior art.” *Id.* at 679–80; cf. *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1314–15 (Fed. Cir. 2013) (remanding to the district court, in part, for a “verbal description of the claimed design to evoke a visual image consonant with that design”).

The '703 patent is titled “Vehicle Rear Bumper,” and issued May 7, 2019, from U.S. Application No. 29/609,012, filed June 27, 2017.³ Ex. 1001, codes (21), (22), (45), (54). The claim recites “[t]he ornamental design for a vehicle rear bumper, as shown and described.” *Id.*, code (57). The drawings of the claim depict the claimed bumper mounted on a vehicle

³ Because the earliest possible effective filing date for the '703 patent is after March 16, 2013 (the effective date for the first inventor to file provisions of the America Invents Act) and this petition was filed within 9 months of its issue date, the '703 patent is eligible for post-grant review. See 35 U.S.C. § 321(c).

with the vehicle and certain aspects of the bumper illustrated as unclaimed by broken lines. *See id.* (“The broken lines in the drawings illustrate portions of the vehicle rear bumper that form no part of the claimed design.”). The ’703 patent contains four figures, which are reproduced below.

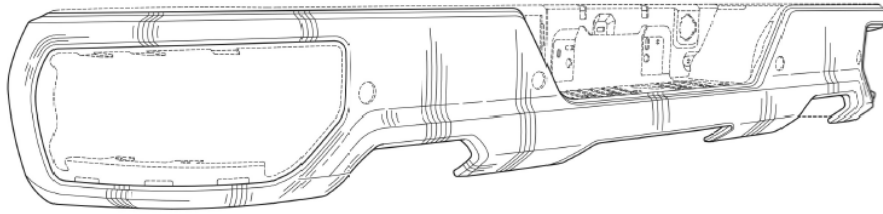


FIG. 1

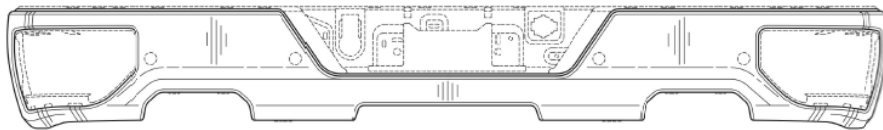


FIG. 2

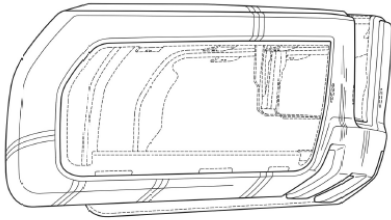


FIG. 3

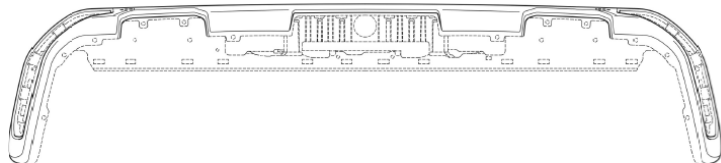


FIG. 4

Ex. 1001. Figures 1–4 above depict, respectively, the following views of the claimed vehicle rear bumper design: a front and left side perspective view, a front view, a left side elevation view, and a bottom view. *Id.*, code (57).

We determine that the following verbal descriptions will be helpful by pointing out “various features of the claimed design as they relate to the . . . prior art.” *Egyptian Goddess*, 543 F.3d at 679–80. The parties each, in offering a proposed claim construction, identify certain features that contribute to the overall appearance of the claimed design. *See* Pet. 12–16; Prelim. Resp. 8–18; *see also* Exs. 1003 ¶¶ 32–36, 1004 ¶¶ 30–34

(Petitioner’s declarants’ opinion testimony). Although the parties identify some of the same features, Patent Owner argues that Petitioner “addresses the design’s claimed features at such a high level of abstraction that it fails to accurately portray the invention[,] . . . focus[es] on design concepts, rather than the nuances of the claimed design, [and] . . . ignores multiple, readily apparent differences between the claimed invention and the purported prior art.” Prelim. Resp. 1. We discuss here only some of the features identified by the parties.

1. Cutouts

Both parties identify cutouts in the lower perimeter line of the bumper as a pertinent feature of the design. Pet. 16; Prelim. Resp. 11–12. Petitioner provides annotated Figures, including the following annotated version of Figure 2, to visually identify the referenced feature.

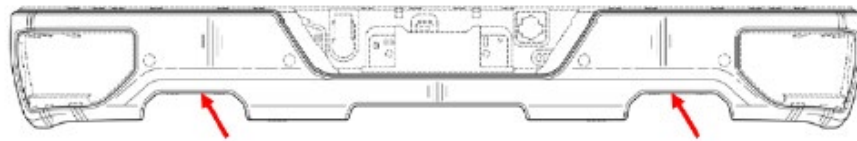
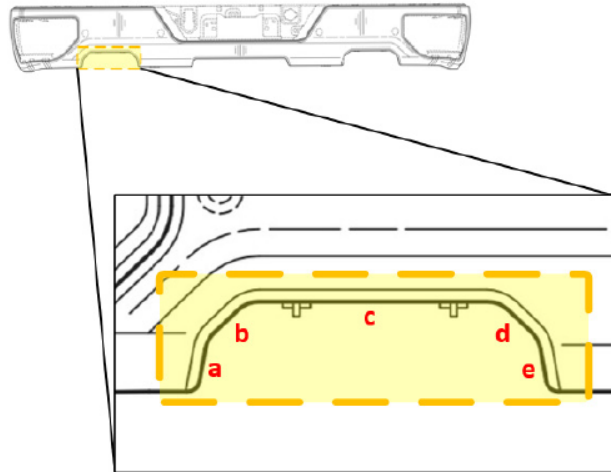


FIG. 2

Pet. 16. The depiction above is an annotated version of Figure 2 with the addition of arrows pointing to those features that Petitioner calls “geometric cutouts.” *Id.*

Patent Owner argues that Petitioner’s “generic characterization” of the feature as “geometric” “ignor[es] the unique design elements of this claimed feature” and “does not adequately describe the claimed invention.” Prelim. Resp. 12. Patent Owner provides the following demonstrative exhibit to visually explain what it contends are the important aspects of the specific cutout configuration. *Id.* at 11–12.



Id. at 12. The depiction above is Figure 2 of the claimed design with an enlarged view of a cutout with annotations identifying the sides as “a” through “e.” Patent Owner agrees that “[t]he claimed design has two geometric cutouts” but goes further with its description, asserting that:

[Each cutout has] multi-angled perimeter edges coalescing into framing contour lines of the bumper, which together create the bold, fluid appearance of the claimed design. As shown [above] in annotated FIG. 2, the upper perimeter edges (b and d) are angled at about 45 degrees, and lower perimeter edges (a and e) are angled to a lesser degree relative to a vertical axis. The upper and lower perimeter edges together create an opening that forms a gradual, enlarged opening at the bottom edge of the bumper. Further, the contoured surface extends around the cutout shapes nearly parallel to the b and c surfaces (left-side cutout) or to the c and d surfaces (right-side cutout).

Id. at 11–12. For purposes of this decision, we need not adopt Patent Owner’s characterization in its entirety, but we do agree that Petitioner’s verbal description is inadequate. While we recognize that the illustration, rather than a verbal description, is the better representation of the claimed design, *Egyptian Goddess, Inc.*, 543 F.3d at 679, Petitioner’s verbal description in this case does not go far enough. Petitioner’s characterization of the feature as a “geometric cutout” is too general and is not an adequate

verbal description of the visual appearance of the claimed design. For example, in addition to Patent Owner’s observation that the sides of the cutout are nearly parallel to the surrounding surface contours, we observe that the sides of the cutout that are angled at approximately forty-five degrees (sides b and d) are nearly parallel to the walls of the inset openings at the ends of the bumper.

2. *Negative Space/Inset Openings*

Both parties identify “negative spaces” (Petitioner’s term) or “inset openings” (Patent Owner’ term) at the bumper’s outer corners as a pertinent feature of the design. Pet. 14; Prelim. Resp. 13–14. We, herein, refer to that feature as inset openings. Petitioner provides annotated figures, including the following annotated version of Figure 2, to visually identify the referenced feature.

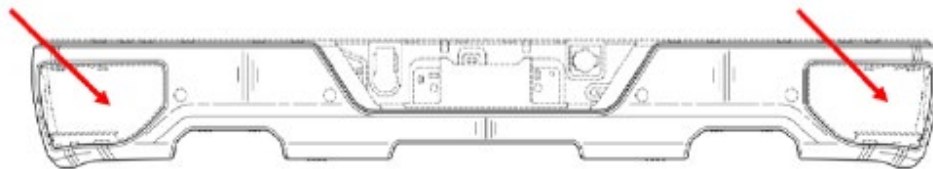
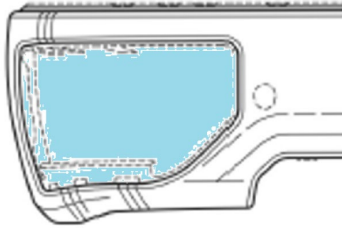


FIG. 2

Pet. 14. The depiction above is an annotated version of Figure 2 with Petitioner’s addition of arrows to indicate the inset openings. *Id.*

Patent Owner argues that “[Petitioner’s] characterization of the ‘negative space at the outer corners of the bumper’ does not acknowledge the overall shape of the inset opening defined by the bumper and thus fails to acknowledge its unique design features.” Prelim. Resp. 13. Patent Owner supplies its own annotated figure, which is reproduced below.



Id. at 13. The figure above is an annotated select portion of Figure 2 of the challenged patent with blue shading of the area bounded by the solid line perimeter. According to Patent Owner, “[t]he claimed design has a unique inset opening defined by curved edges and angled edges of varying degrees along its unique-shaped perimeter.” *Id.* at 13.

Patent Owner argues that Petitioner over-simplifies the claimed design and that this “obscures the complex geometry associated with the claimed design, effectively ignoring the claimed features.” *Id.* at 14. Patent Owner further argues that “[t]hese unique features accent key portions of the vertical face that affects the overall shape of the claimed bumper and contributes to its bold and aerodynamically fluid visual appearance.” *Id.* at 14.

For purposes of this decision, we again need not adopt Patent Owner’s characterization in its entirety, but we do agree that Petitioner’s verbal description does not go far enough. We agree that Petitioner’s verbal description is an over-simplification. Petitioner’s characterization of the feature merely as “negative space at the outer corners” is not an adequate verbal description of the appearance of the claimed design. The perimeter of each inset opening of the claimed design has multiple curved and angled lines.

3. *Surface Contour*

Patent Owner contends that there is an important design feature that is not addressed in the Petition. Specifically, Patent Owner argues that

Petitioner “fails to accurately convey the overall shape and dimensions of the rear bumper by ignoring surface contour lines in the claimed design, depicted by solid lines.” Prelim. Resp. 9. In that regard, Patent Owner asserts that “[t]he claimed design also includes vertical contour lines that . . . denote its non-planar exterior contours,” and provides the following annotated version of Figure 1.

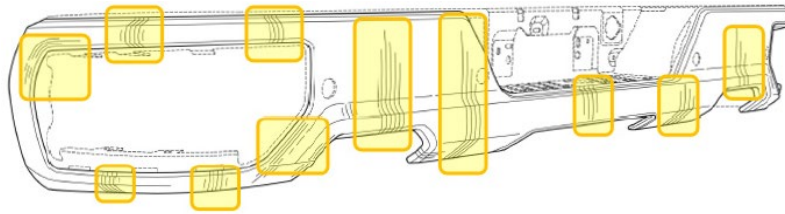


FIG. 1

Prelim. Resp. 10. Above is Figure 1 of the '703 patent annotated by Patent Owner to highlight the straight-line surface shading indicating contoured surfaces. *Cf.* 37 C.F.R. § 1.152 (“Appropriate and adequate surface shading should be used to show the character or contour of the surfaces represented.”). According to Patent Owner:

[T]he claimed contoured surface forms a protruding lower portion . . . that extends along the length of the bumper from one cutout to the other cutout, surrounding and mimicking the outward-angled shape of the cutout portions so as to accentuate these features. This protrusion significantly contributes to the overall visual appearance of the '703 Patent's design.

Prelim. Resp. 10.

We observe that the protrusion yielded by the surface contour is readily discernable in Figure 3 of the '703 patent, an annotated version of which is reproduced below.

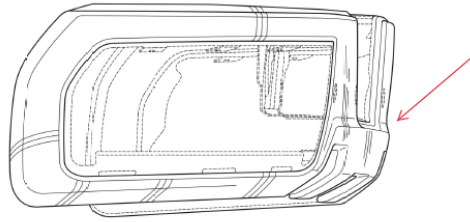


FIG. 3

The image above is a left side elevation view of the claimed design with our annotation in the form of an arrow pointing to the protrusion.

Petitioner, in the context of describing the claimed design, submits into evidence a “photograph of the 2020 Chevrolet Silverado” (Ex. 1005), reproduced below, which Petitioner contends shows the commercial embodiment of the claimed design of the ’703 patent. Pet. 10 (citations omitted).



Above is a photograph of the rear portion of a truck that Petitioner represents is the 2020 Chevrolet Silverado. *Id.* In this photograph, a surface contour in the form of a protrusion at the lower portion of the bumper is readily discernable.

D. Evidence

Petitioner relies on the following references⁴:

Reference	Exhibit
Michael Harley, 2014 GMC Sierra, Autoblog (June 12, 2013), https://www.autoblog.com/2013/06/12/2014-gmc-sierra-review-first-drive/ , archived on June 15, 2013 by the Internet Archive organization’s “Wayback Machine” at https://web.archive.org/web/20130615234717/https://www.autoblog.com/2013/06/12/2014-gmc-sierra-review-first-drive/ .	1006
2014 GMC Sierra brochure (accessed August 21, 2019) https://media.gm.com/dld/content/Pages/news/us/en/2012/Dec/1213-2014-sierra/_jcr_content/rightpar/sectioncontainer_2/par/download_1/file.res/2014_GMC_Sierra.pdf	1007
2012 Cadillac Escalade brochure (accessed August 13, 2019), http://www.motorologist.com/wpcontent/uploads/2012-cadillac_escalade_brochure.pdf	1008
Tim Healey, Review: 2012 Cadillac Escalade ESV, Web2Carz (November 15, 2011), https://www.web2carz.com/cadillac/escalade-esv/2012/3/review , archived on July 21, 2012 by the Internet Archive organization’s “Wayback Machine” at http://web.archive.org/web/20120721181646/https://www.web2carz.com/cadillac/escalade-esv/2012/3/review	1009
Ford Atlas Concept Truck, FordF150.net, https://www.fordf150.net/atlas-concept/ , archived on January 20, 2013 by the Internet Archive organization’s “Wayback Machine” at http://web.archive.org/web/20130120060450/https://www.fordf150.net/atlas-concept/	1010

⁴ We adopt, for purposes of this decision only, Petitioner’s descriptions of the references. *See* Pet. v–vi (Table of Exhibits), 17 (identification of evidence relied upon). We make no substantive determinations regarding Petitioner’s descriptions and representations. We also make no determinations regarding Petitioner’s evidentiary arguments and we need not address Petitioner’s request for the Board to “take official notice of the facts reflected in the screenshots of the archived webpages.” *Id.* at 44–45 n.3.

Petitioner also relies on the Declarations of James M. Gandy (Ex. 1003) and Jason C. Hill (Ex. 1004) in support of its arguments.

E. Asserted Grounds of Unpatentability

Petitioner asserts that the sole design claim of the '703 patent is unpatentable on the following grounds (Pet. 17):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	103	2014 GMC Sierra (Exs. 1006, 1007), 2012 Cadillac Escalade (Exs. 1008, 1009) ⁵
1	103	2014 GMC Sierra (Exs. 1006, 1007), Ford Atlas Concept Truck (Ex. 1010)

II. ANALYSIS

A. Principles of Law

“In addressing a claim of obviousness in a design patent, the ultimate inquiry is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Apple, Inc. v. Samsung Elec. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012) (internal quotation and citations omitted); *see also High Point Design*, 730 F.3d at 1313 (“The use of an ‘ordinary observer’ standard to assess the potential obviousness of a design patent runs contrary to the precedent of this court and our predecessor court, under which the obviousness of a design patent must, instead, be assessed from the viewpoint of an ordinary designer.”).⁶ This

⁵ As discussed further below, Petitioner identifies two exhibits as the “Primary” reference (2014 GMC Sierra) for both grounds, and two exhibits as the “Secondary” reference (2012 Cadillac Escalade) for the first ground. *See* Pet. 17.

⁶ Petitioner incorrectly applies the ordinary observer standard in its obviousness analysis. Pet. 42, 47–48 (citing in *Int’l Seaway Trading Corp.*

obviousness analysis generally involves two steps: first, “one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design”; second, “once this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design.” *High Point Design*, 730 F.3d at 1311 (internal quotation and citations omitted). In performing the first step, we must “(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates basically the same visual impression.” *Id.* at 1312 (internal quotation and citations omitted). In the second step, the primary reference may be modified by secondary references “to create a design that has the same overall visual appearance as the claimed design.” *Id.* at 1311 (internal quotation and citations omitted). However, the “secondary references may only be used to modify the primary reference if they are ‘so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.’” *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

When evaluating prior art references for purposes of determining patentability of ornamental designs, the focus must be on actual appearances and specific design characteristics rather than design concepts. *In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993); *see also Apple, Inc. v.*

v. Walgreens Corp., 589 F.3d 1233, 1240 (Fed. Cir. 2009)). “[T]he court [in *Int’l Seaway*] could not rewrite precedent setting forth the designer of ordinary skill standard.” *High Point Design*, 730 F.3d at 1313 n.2.

Samsung Elec. Co., 678 F.3d at 1332 (“Rather than looking to the ‘general concept’ of a tablet, the district court should have focused on the distinctive ‘visual appearances’ of the reference and the claimed design.”).

B. The Designer of Ordinary Skill

Petitioner contends that:

a designer of ordinary skill would be an individual who has at least an undergraduate degree in transportation or automotive design and has work experience in transportation or automotive design, or someone who has several years’ work experience in transportation or automotive design.

Pet. 27 (citing Ex. 1003 ¶ 40; Ex. 1004 ¶ 38). Patent Owner argues, without citation to evidence, that:

[a] designer of ordinary skill in the art relevant to the ’703 Patent would have at least an undergraduate degree in automotive design, or other related industrial design field, with at least two years of relevant practical experience in designing automotive body parts. An increase in experience could compensate for less education, and an increase in education could likewise compensate for less experience.

Prelim. Resp. 8. The parties do not identify, and we do not discern, any material difference between the parties’ proposed definitions. For purposes of this decision and on the record currently before us, which includes testimony by Petitioner’s witnesses, we adopt Petitioner’s proposed definition of the ordinary designer.

*C. The Alleged Obviousness of the Claim
Over the 2014 GMC Sierra and the 2012 Cadillac Escalade*

Petitioner alleges that the claimed design of the ’703 patent would have been obvious over the 2014 GMC Sierra and the 2012 Cadillac Escalade. *See* Pet. 29–43. Specifically, Petitioner focuses on the design features that it identified in its proposed claim construction and argues “there

is a primary reference, Patent Owner’s 2014 GMC Sierra, which is ‘a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design.’” *Id.* at 29 (quoting *Durling*, 101 F.3d at 103; citing *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982)) (emphasis and internal quotation marks omitted). Petitioner further argues that “[a]ny differences between Patent Owner’s 2014 GMC Sierra and the claimed design of the ’703 Patent are *de minimis* and/or suggested by the secondary reference—the 2012 Cadillac Escalade.” *Id.* (citations omitted). Petitioner also argues that “[t]he single missing element that is not a *de minimis* difference (the geometric cutouts) is easily found in the [2012 Cadillac Escalade].” *Id.* at 3.

Patent Owner argues that “[t]he Board should deny institution because [Petitioner] LKQ’s claim construction is based on generic design concepts, rather than addressing the features of the claimed design.” Prelim. Resp. 8 (citations omitted). Patent Owner further argues that Petitioner, in comparing the claimed design to the prior art references, “ignores specific features that contribute to the overall shape and dimensions of the claimed design.” *Id.* at 16 (citations omitted). For the reasons discussed below, we find Patent Owner’s position to be persuasive.

1. 2014 GMC Sierra (Ex. 1006, Ex. 1007)

The identity of the primary reference is unclear. Petitioner articulates the grounds using the phrase “2014 GMC Sierra” and labels two documents, Exhibits 1006 and 1007, as the “Primary” reference. *See, e.g.*, Pet. 17. In arguing that the primary reference is prior art to the challenged patent, Petitioner refers to: the “2014 GMC Sierra” as “prior art,” the two exhibits as plural “depictions” of the Sierra, and a singular “publication date” of these “depictions.” Pet. 30; *see also id.* at 29 (characterizing “2014 GMC

Sierra” as “a single reference”), 31 (arguing that “Patent Owner’s 2014 GMC Sierra [is] a proper, primary *Rosen* reference.”). Thus, Petitioner may be utilizing, as the primary reference, a combination of two purported printed publications or the physical Sierra truck itself. For purposes of this decision, we need not resolve that uncertainty. For purposes of this decision, we, like the parties, treat both of the two exhibits identified by Petitioner as constituting the primary reference, the 2014 GMC Sierra. *See, e.g.*, Pet. 17 (labeling both Exhibit 1006 and Exhibit 1007 as “Primary”); Prelim. Resp. 18–22 (citing both Exs. 1006, 1007).

Reproduced below are excerpts from Exhibits 1006 and 1007.



On the left above is a rear view of bumper of the 2014 GMC Sierra. *See* Pet. 2 (reproducing the above cropped photograph from Ex. 1006, 1). On the right above is a perspective view of the rear bumper of the 2014 GMC Sierra. Ex. 1007, 10 (as cropped).

2. 2012 Cadillac Escalade (Ex. 1008, Ex. 1009)

As with the primary reference, Petitioner identifies two exhibits, Exhibits 1008 and 1009, as the singular secondary reference, the 2012 Cadillac Escalade. Pet. 17. For purposes of this decision, we treat both of the exhibits as constituting the secondary reference, the 2012 Cadillac Escalade. *See* Ex. 1008, 17; Ex. 1009, 1; *cf.* Pet. 41 (citing Exs. 1008, 1009); Prelim. Resp. 26 (depicting a cropped and magnified select portion of a photograph that appears to be from either Exhibit 1008 or Exhibit 1009). Reproduced below is an illustrative photograph of the Escalade’s bumper.



Pet. 3 (citing Ex. 1008, 17; Ex. 1009, 1)⁷. The text associated with the Petitioner’s relied-upon photo of the Escalade states, “[t]he dual-outlet stainless-steel exhaust’s bold, rectangular tips are seamlessly integrated in the rear bumper.” Ex. 1008, 17.

3. *Analysis of Petitioner’s Challenge to the Claim as Being Obvious Over the 2014 GMC Sierra and the 2012 Cadillac Escalade*

Petitioner argues that “Patent Owner’s 2014 GMC Sierra discloses a vehicle rear bumper with basically the same overall visual appearance as the claimed design in the ‘703 Patent, which makes Patent Owner’s 2014 GMC Sierra a proper, primary *Rosen*^[8] reference.” Pet. 31 (citations omitted). Petitioner identifies the lack of “geometric cutouts” in the Sierra bumper as a difference between the primary reference and the claimed design. *Id.* at 40. Petitioner addresses this difference in arguing,

the secondary reference [the 2012 Cadillac Escalade] suggests the slight modification of adding the integrated squared cutouts to Patent Owner’s undisclosed 2014 GMC Sierra . . . [and] a hypothetical prior art created by combining the base of Patent

⁷ The photograph shown is from the Petition and appears to be either the photograph on page 17 of Exhibit 1008 or a cropped version of the photograph on page 1 of Exhibit 1009.

⁸ In the context of design patent law, a proper primary, or *Rosen*, reference is “something in existence, the design characteristics of which are basically the same as the claimed design.” *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982).

Owner's 2014 GMC Sierra with the geometric cutouts of Patent Owner's 2012 Cadillac Escalade would have an overall appearance that is substantially the same as the '703 Patent.

Id. at 42.

Petitioner's analysis of the claimed design is exemplified in the following quote: "[T]he design elements of the '703 Patent are nothing new—all of these elements (the center depression area; the negative spaces at the outer corners of the bumper; the scalloped lower perimeter line; and the geometric cutouts) are easily found within the prior art." Pet. 2. We do not find Petitioner's arguments persuasive because Petitioner focuses on design concepts rather than actual appearances and specific design characteristics. *See In re Harvey*, 12 F.3d at 1064; *see also Apple, Inc. v. Samsung Elec. Co.*, 678 F.3d at 1332 ("Rather than looking to the 'general concept' of a tablet, the district court should have focused on the distinctive 'visual appearances' of the reference and the claimed design."); Prelim. Resp. 8 ("The Board should deny institution because [Petitioner] LKQ's claim construction is based on generic design concepts, rather than addressing the features of the claimed design.").

Patent Owner argues that Petitioner has failed to analyze adequately several features of the claimed design that distinguish it from the primary reference, the 2014 GMC Sierra, and from Petitioner's proposed combination where that primary reference is modified to have the cutouts of the 2012 Cadillac Escalade. Prelim. Resp. 16, 26–27; *see id.* at 8–9 (Patent Owner arguing that "[Petitioner] ignores or mischaracterizes at least four distinctive features of the claimed design, and fails to analyze all of the views provided by the '703 Patent, obscuring critical features as a result."

(emphasis omitted)). We only discuss here an exemplary number of features identified by Patent Owner and their impact on the overall design.

a. Surface Contour

Patent Owner argues that the claimed design has surface contour lines and an associated protrusion, and contends that Petitioner has failed to address this feature. Prelim. Resp. 9–11, 17–19. According to Patent Owner, “the claimed design has a series of contour lines on the exterior surface that accent select portions of the vertical face of the bumper, creating a multi-dimensional, stylized look[.]” *Id.* at 17. Patent Owner further argues that, “[i]n contrast, the 2014 GMC Sierra’s bumper has a planar vertical face that lacks both a horizontal contour line as well as an elongate protrusion along the lower portion of the bumper.” *Id.*

As mentioned above, a protrusion is readily discernable in the side view of the claimed design, an annotated version of which is reproduced again below.

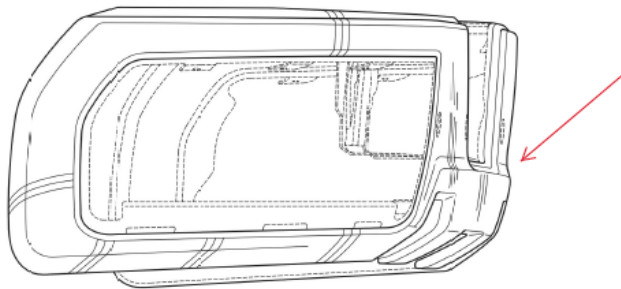
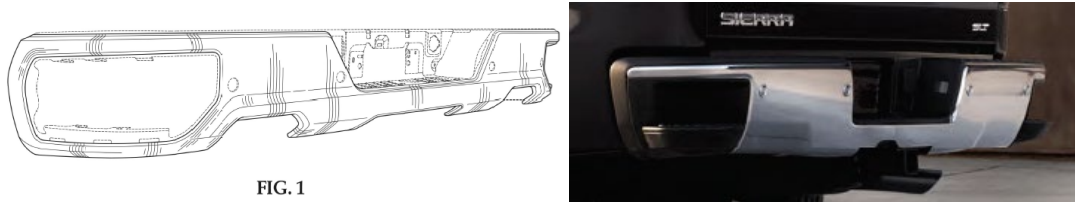


FIG. 3

The image above is a left side elevation view of the claimed design with our annotation in the form of an arrow pointing to the protrusion.

To assist in a comparison of the appearance of the bumper of the claimed design and of the primary reference, the 2014 GMC Sierra, the perspective views of both are shown below.



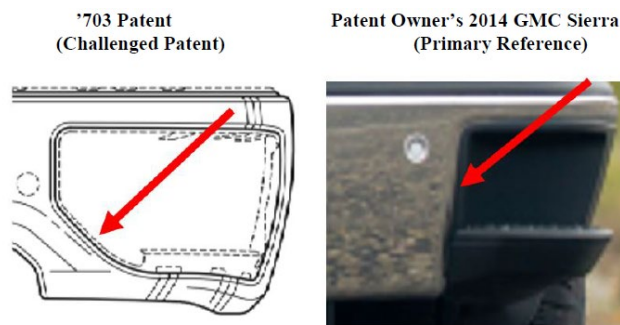
Shown above, on the left, is Figure 1 of the '703 patent and is a front and left side perspective view of a vehicle rear bumper of the claimed design. Ex. 1001, code (57). Shown above, on the right, is a perspective view of the bumper of the primary reference, the 2014 GMC Sierra. Ex. 1007, 3 (cropped).

We are unable to discern a discussion of this contour feature in Petitioner's comparison of the claimed design to the relied-upon prior art. *See* Pet. 29–43; *id.* at 36 (Petitioner identifying what it characterizes as the only four differences between the primary reference and the claimed design); *see also id.* at 12–13 (describing the claimed design). To the extent that Petitioner argues that this is a *de minimis* feature that, therefore, needs no analysis, we are not persuaded. *See, e.g., id.* at 29 (“Any differences between Patent Owner’s 2014 GMC Sierra and the claimed design of the ’703 Patent are *de minimis* and/or suggested by the secondary reference—the 2012 Cadillac Escalade—and, therefore, are not sufficient to justify a finding that the claimed design in the ’703 Patent is patentable.”). Accordingly, we determine that Petitioner does not address adequately the differences in appearance due to the contour lines and the protrusion. The bumper of the prior art has a relatively smooth profile resulting in a clean look, whereas the claimed design, as Patent Owner argues, has a

multi-dimensional appearance. We also observe that, in the claimed design, certain portions of the contour are parallel to the approximately forty-five degree angles of the inset openings and of the exhaust pipe cutouts, resulting in a portion of the protrusion that carries the angular appearance of the inset openings through to the exhaust cutouts.

b. Negative Spaces/Inset Openings

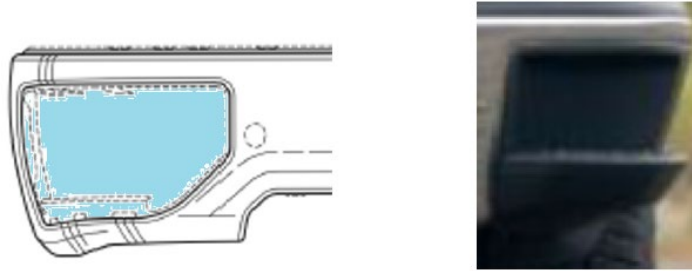
For the inset openings, or “negative spaces at the outer corners,” Petitioner identifies a single difference between the inset openings of the primary reference, the 2014 GMC Sierra, and that of the claimed design. Pet. 36–37. Petitioner contends that “the negative spaces at the outer corners of the bumper present at slightly different angles,” and provides the annotated depictions reproduced below. *Id.* at 36–37.



Id. at 37. Above, on the left, is an annotated and cropped version of Figure 2 of the '703 patent showing the inset opening of the claimed design (Ex. 1001) and, on the right, an annotated and cropped version of a photograph of the inset opening of the 2014 GMC Sierra (Ex. 1006, 1). Both are annotated by Petitioner to have an arrow indicating that which Petitioner characterizes as “slightly different angles.” Pet. 36–37.

Patent Owner argues that Petitioner “fails to acknowledge the shape of the inset opening provided by the claimed design . . . [and] ignores the unique inset opening features and their contributions to the overall shape and

dimensions of the claimed design.” Prelim. Resp. 21. Patent Owner contends, with reference to the depictions reproduced below, that “the 2014 GMC Sierra [the primary reference] discloses ‘squared’ insets opening (shown on right), as opposed to the complex geometry of the inset opening illustrated by the claimed design (shown on left).” *Id.* at 21.



Id. Above, on the left, is a cropped and annotated version of Figure 2 of the '703 patent with blue shading of the area bounded by the solid line perimeter of the inset opening and, on the right, a cropped version of the bumper of the 2014 GMC Sierra (Ex. 1006, 1).

We find Patent Owner’s argument persuasive. Petitioner, as mentioned above, offers, as its proposed claim construction, the over-simplified verbal description of the inset openings as “negative space at the outer corners of the bumper” rather than acknowledging the complex outer perimeter of the claimed design’s inset openings. Pet. 12–13. Similarly, in summarizing its arguments, Petitioner identifies a “design element[] of the '703 Patent” that is “easily found within the prior art” using the same simplified label of “negative spaces at the outer corners of the bumper.” *Id.* at 2. Petitioner mentions that “the negative spaces . . . present at slightly different angles,” and argues that this difference is *de minimis* and that the necessary “slight” change to make the angle of the primary reference to conform to that of the claimed design “does not alter the overall visual appearance to make the '703 design patentable.” *Id.* at 37–38. We observe

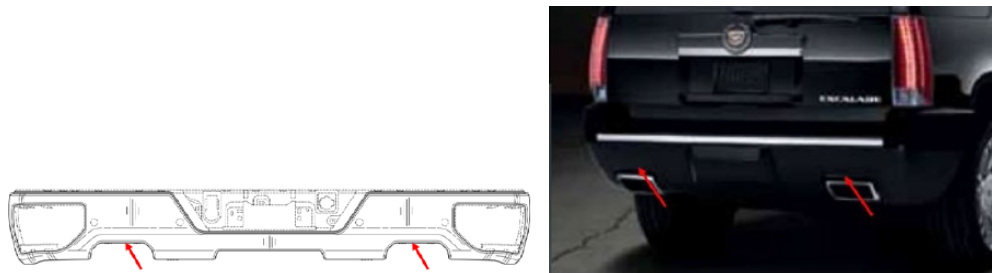
that the angles to which Petitioner apparently refers are a slightly acute angle in the primary reference and a very pronounced obtuse angle (approximately 135 degrees) in the claimed design. We are not persuaded that this is *de minimis*. Furthermore, we fail to discern any meaningful and adequate discussion regarding the visual appearance of the remaining aspects of the claimed inset opening boundary and its contribution to the overall visual appearance of the claimed bumper as compared to that of the 2014 GMC Sierra. *See id.* at 36–38.

We determine that Petitioner—rather than focusing on the actual visual appearance of the claimed design as compared to that of the 2014 GMC Sierra—incorrectly has reduced the inset opening to a general design concept of negative space having angle. *Cf. In re Harvey*, 12 F.3d at 1064 (“[I]n considering prior art references for purposes of determining patentability of ornamental designs, the focus must be on appearances and not uses. . . . [and] the Board should have focused on actual appearances, rather than ‘design concepts.’”); Ex. 1004 ¶ 45 (Petitioner’s declarant: “[T]he truck bumper shows a functional aspect of inset stepping points to allow access to the truck bed with the tailgate in a closed position.”).

Petitioner appears to contend that it would have been obvious to modify the angle of the primary reference’s inset openings to match that of the claimed design *after* the primary reference is modified to have the cutouts of the secondary reference. *See* Pet. 37–38. The first step of a proper obviousness analysis, however, requires, *prior to modification*, “a something in existence, the design characteristics of which are basically the same as the claimed design.” *High Point Design*, 730 F.3d at 1311 (internal quotation and citations omitted).

c. Cutouts

The claimed bumper design has cutouts in the lower perimeter. Petitioner’s primary reference, the 2014 GMC Sierra, lacks cutouts. Petitioner turns to the 2012 Cadillac Escalade. Petitioner provides the following two depictions in its comparison of the claimed bumper design with the bumper of the secondary reference.



Pet. 41 (citing Ex. 1001, Fig. 2 (annotated); Ex. 1009, 1 (cropped and annotated)). The depictions above are, on the left, Figure 2 of the ’703 patent annotated by Petitioner to identify the cutouts, and, on the right, a cropped photograph of the rear of the Escalade with arrows added by Petitioner to identify cutouts in the bumper. Petitioner argues “the secondary reference suggests the slight modification of adding the integrated *squared* cutouts to Patent Owner’s undisclosed 2014 GMC Sierra.” Pet. 42 (emphasis added) (citing Ex. 1003 ¶ 63; Ex. 1004 ¶ 64).⁹

As an initial matter, we agree with Patent Owner’s assertion that Petitioner “relies on a dark image of the 2012 Cadillac Escalade provided in

⁹ Petitioner’s declarants, in the relied upon paragraphs, both opine that the Escalade “readily suggests modifying the 2014 GMC Sierra by adding the integrated geometric cutouts to accommodate a squared, dual exhaust system.” Ex. 1003 ¶ 63; Ex. 1004 ¶ 64. The 2014 GMC Sierra does not have squared, dual exhaust pipes, *see* Ex. 1006, 1, and, therefore, Petitioner’s proposed modification is more than the argued “slight modification” of adding cutouts, Pet. 42.

a single view that obscures the reference, and renders comparison of the appearance of its ornamental features difficult at best.” Prelim. Resp. 24.

Patent Owner argues that Petitioner does not show that the proposed combination would be substantially identical to the claimed design, that “the perimeter shape of the cutouts is not described in any more detail than ‘geometric cutouts,’ and the contribution of the cutout perimeter shape to the overall appearance of the bumper is wholly absent” *Id.* at 26.

We also are not persuaded that Petitioner has made a threshold showing that the proposed modification will result in “a design that has the same overall visual appearance as the claimed design.”¹⁰ *High Point Design*, 730 F.3d at 1311. Petitioner has reduced the feature to the general design concept of a “geometric cutout.” *See, e.g.*, Pet. 46 (“the prior art is rife with vehicle designs, and publication of those designs, which have squared cutouts on the lower perimeter line of a bumper to accommodate a dual exhaust system.”). Petitioner characterizes the contribution of the Escalade as “squared cutouts.” Pet. 42. Although the shape of the cutout in the claimed design might be described at a high level as “squared,” that is a general concept and not reflective of the actual visual appearance of the claimed design, which has cutouts with multiple angled sides. Further, we cannot properly evaluate Petitioner’s proposed combination because the appearance of the Escalade’s cutout is not discernable in the dark image.

¹⁰ In light of our ultimate determinations in this decision, we need not and do not reach the issue as to whether the lack of cutouts in the 2014 GMC Sierra bumper preclude it from being a proper primary reference, namely something having design characteristics basically the same as the claimed design.

4. *Conclusions Regarding the Obviousness Challenge Based on the 2014 GMC Sierra and the 2012 Cadillac Escalade*

On the record before us and for purposes of this decision, we determine that the particular inset openings and surface contour contribute to the overall visual impression of the design claimed in the '703 patent. In light of that, we also determine that Petitioner has not made a threshold showing that the 2014 GMC Sierra is a single reference that creates basically the same visual impression as the claimed design. *High Point Design*, 730 F.3d at 1312. Petitioner has not established satisfactorily at this stage that the 2014 GMC Sierra is an appropriate primary reference.

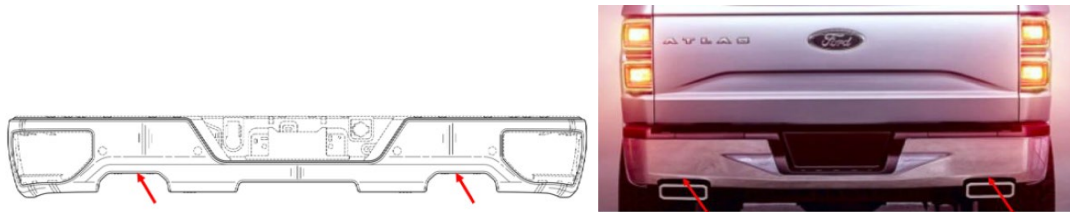
We further determine, on the record before us and for purposes of this decision, that the particular cutouts in the lower perimeter line of the bumper contribute to the overall visual impression of the design claimed in the '703 patent. In light of that, we also determine that Petitioner has not made a threshold showing that the 2014 GMC Sierra as modified by the 2012 Cadillac Escalade creates a design having the same overall visual appearance as the claimed design. *High Point Design*, 730 F.3d at 1311.

Accordingly, Petitioner has not demonstrated that it is more likely than not that the challenged claim would have been obvious over the 2014 GMC Sierra and the 2012 Cadillac Escalade.

D. *The Alleged Obviousness of the Claim
Over the 2014 GMC Sierra and the Ford Atlas Concept Truck*

Petitioner alleges that the claimed design of the '703 patent would have been obvious over the 2014 GMC Sierra and the Ford Atlas Concept Truck. *See* Pet. 43–48. Petitioner again asserts that the 2014 GMC Sierra is a proper primary reference and relies on its arguments made in the first ground, discussed above. *See id.* at 43–45. Petitioner further argues that

“[a]ny differences between Patent Owner’s 2014 GMC Sierra and the ’703 Patent are *de minimis* and/or suggested by the secondary references—the Ford Atlas Concept Truck—and, therefore, are not sufficient to justify a finding that the claimed design in the ’703 Patent is patentable.” *Id.* at 43 (citations omitted). Petitioner also asserts that a difference between the primary reference and the claimed design is “the geometric cutouts on the lower perimeter line of the bumper” and argues “[t]hat missing design element, shown in the ’703 claim but not in Patent Owner’s 2014 GMC Sierra, is readily supplied by the Ford Atlas Concept Truck.” *Id.* at 45–46. Petitioner provides the following two depictions in its comparison of the claimed bumper design with the bumper of the secondary reference.



Pet. 46–47 (citing Ex. 1001, Fig. 2 (annotated); Ex. 1010, 5 (cropped and annotated)). The depictions above are, on the left, Figure 2 of the ’703 patent annotated by Petitioner to identify the cutouts, and, on the right, a cropped photograph of the rear of the Ford Atlas Concept Truck with arrows added by Petitioner to identify cutouts in the bumper. Petitioner argues “the secondary reference suggests the slight modification of adding the integrated *squared* cutouts to Patent Owner’s 2014 GMC Sierra.” Pet. 47 (emphasis added) (citing Ex. 1003 ¶ 69; Ex. 1004 ¶ 70).¹¹

¹¹ As with the first ground, the relied upon opinion testimony is that the proposed modification would be made “to accommodate a squared, dual exhaust system”; however, the primary reference does not have such an exhaust system. Ex. 1003 ¶ 69; Ex. 1004 ¶ 70; Ex. 1006, 1.

For the same reasons as set forth in the discussion of the first ground, we determine that Petitioner has not made a threshold showing that the 2014 GMC Sierra is a single reference that creates basically the same visual impression as the claimed design. *High Point Design*, 730 F.3d at 1312. Therefore, Petitioner has not established satisfactorily at this stage that the 2014 GMC Sierra is an appropriate primary reference. We need not reach the parties' arguments regarding the secondary reference or the proposed combination.

Petitioner has not demonstrated that it is more likely than not that the challenged claim would have been obvious over the 2014 GMC Sierra and the Ford Atlas Concept Truck.

III. CONCLUSION

Petitioner has not demonstrated that that it is more likely than not that the challenged design claim is unpatentable.

IV. ORDER

For the foregoing reasons, it is

ORDERED that the Petition is *denied* and no trial is instituted.

PGR2020-00003
Patent D847,703 S

PETITIONER:

Barry F. Irwin, P.C.
Reid Huefner
IRWIN IP LLC
birwin@irwinip.com
rhuefner@irwinip.com

PATENT OWNER:

Dorothy P. Whelan
Craig A. Deutsch
Grace J. Kim
Jennifer J. Huang
Joseph A. Herriges
FISH & RICHARDSON P.C.
whelan@fr.com
deutsch@fr.com
gkim@fr.com
jhuang@fr.com
herriges@fr.com