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Paper No. 28
Entered: August 4, 2021

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.

IPR2020-00534
Patent D797,625 S

Before GRACE KARAFFA OBERMANN, SCOTT A. DANIELS, and CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges.*

DANIELS, *Administrative Patent Judge.*

JUDGMENT
Final Written Decision
Determining No Challenged Claim Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. Background

LKQ Corporation and Keystone Automotive Industries, Inc., (collectively "LKQ") filed a Petition to institute an *inter partes* review of the claim for a "Vehicle Front Fender" in U.S. Patent No. D797,625 S (Ex. 1001, "the '625 patent"). Paper 2 ("Pet."). GM Global Technology Operations, Inc., ("GM") filed a Preliminary Response. Paper 9 ("Prelim. Resp."). On August 11, 2020, we entered a Decision instituting an *inter partes* review of the challenged claim in this proceeding. Paper 10 ("Inst. Dec.").

Following our Institution Decision, GM timely filed a Response. Paper 17 ("PO Resp."). LKQ filed a Reply. Paper 21 ("Pet. Reply"). GM subsequently filed a Sur-Reply. Paper 23 ("PO Sur-Reply"). We heard oral argument on April 27, 2021. A transcript of the argument has been entered into the record. Paper 27 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(b). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). Having reviewed the arguments of the parties and the supporting evidence, we find that Petitioner has not demonstrated by a preponderance of the evidence that the sole claim of the '625 patent is unpatentable.

B. Additional Proceedings

The parties identify various other *inter partes* and post-grant review proceedings that Petitioner has filed challenging different patents owned by GM. The parties do not state that these other proceedings affect, or would be affected by, the outcome of this proceeding. Pet. 5–6; Paper 5, 2.

C. The ’625 Patent and Claim

The ’625 patent (Ex. 1001) is a design patent that issued September 19, 2017, and lists GM as the assignee. Ex. 1001, codes (45), (73). The title, “Vehicle Front Fender,” refers to an outer surface of a vehicle front fender, which the figures of the patent illustrate in solid lines, but with certain portions shown in dashed lines, such as the inner surface, that would not be observable when the fender is attached to a vehicle. *See* 37 C.F.R. § 1.152; *see also* MPEP 1503.02, subsection III (“Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof.”).

The ’625 design includes Figures 1–4, reproduced below, illustrating the claimed front fender as set forth below.[1]

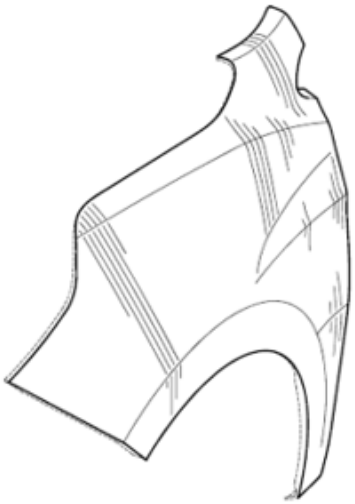


FIG. 1

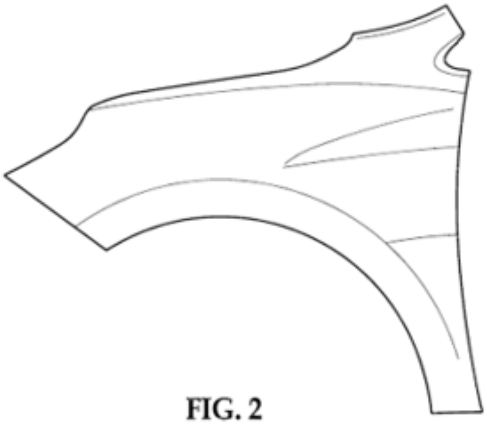


FIG. 2

[1] We refer to the claim, i.e., the vehicle front fender shown in Figures 1–4, also as “the ’625 design.”

FIG. 3

FIG. 4

Ex. 1001. Figures 1–4 above depict, respectively, the following views of the claimed vehicle front fender design: a perspective view, a side view, a front view, and a top view. *Id.* at code (57).

D. Claim Construction

In an *inter partes* review based on a petition filed after November 13, 2018, the claims are construed

> using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.

37 C.F.R. § 42.100(b); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc) (setting forth claim construction standard in civil actions).

With respect 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 district court, in part, for a "verbal description of the claimed design to evoke a visual image consonant with that design").

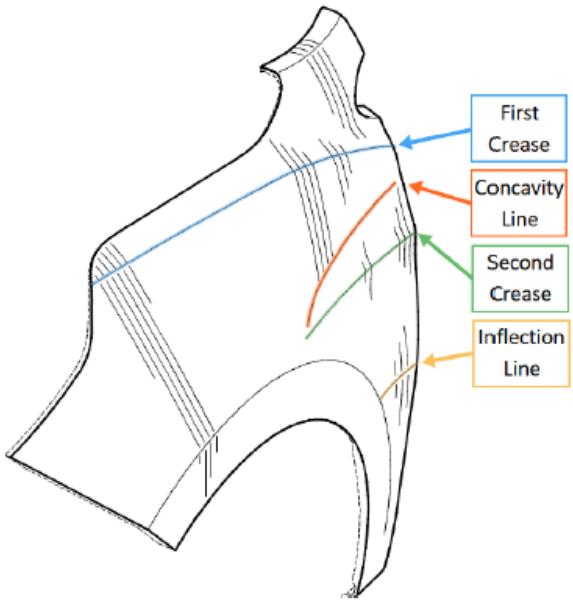
1. LKQ's Proposed Claim Construction

LKQ relies on the Declarations of Jason M. Gandy (Ex. 1003) and Jason C. Hill (Ex. 1004; Ex. 1043) in support of its claim construction and arguments. GM relies on the Declaration of Thomas V. Peters (Ex. 2004).

LKQ contends that the claim of the '625 patent, as shown by the solid lines in the drawings, can be textually described as:

> [a] vehicle fender comprising:
>
> a top protrusion extending rearwardly and upwardly from an upper portion of the fender and having an intermittent u-shaped notch;
>
> a first crease and a second crease extending forwards from a rear edge of the fender, a concavity line disposed between the first crease and the second crease, and an inflection line below the second crease; and
>
> an angular front elevation profile.

Pet. 13–15 (emphasis omitted). LKQ provides the following annotated Figure 1 from the '625 patent, emphasizing certain claim elements.



In annotated Figure 1, above, LKQ illustrates a front perspective view of the claimed vehicle fender pointing to a "first crease," a "concavity line," a "second crease," and an "inflection line." *Id.* at 14.

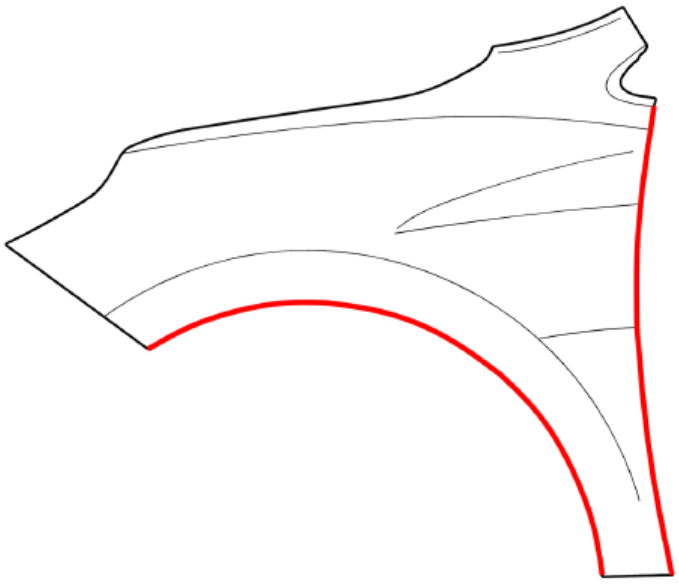
2. GM's Proposed Claim Construction

GM's position is that LKQ's construction is too general and simplistic. *See* PO Resp. 1 (GM arguing that it "is not the presence or absence of common features, but the details in the claimed design that stand out"). GM describes the claimed design as "a coordinated set of features that contribute to a unique overall appearance." *Id.* at 3. Summarized below, GM asserts that there are five specific ornamental aspects of the design that contribute to its uniqueness. *Id.* at 4–11.

(a) "[f]irst, the claimed design includes distinct lateral and lower perimeter shapes"

GM argues that the right hand lateral edge, i.e., "door cut line," and the circular edge of the wheel arch "complement each other—both have smooth, arcuate shapes that echo the smooth and consistent curvature of the

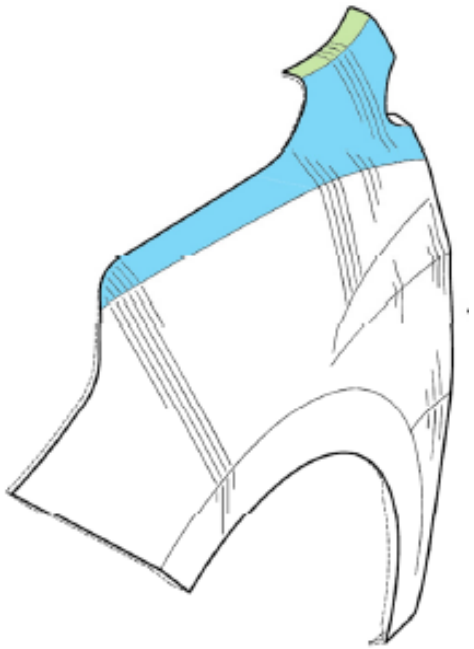
'first' and 'second' creases and other sculpting of the fender." *Id.* at 4. Reproduced below is GM's annotated version of Figure 2 of the '625 design.



GM's annotated version of Figure 2 of the '625 design is shown above with the door cut line and wheel arch highlighted in red. *Id.* at 5.

(b) "[s]econd, the claimed design includes a 'protrusion' having a particular three-dimensional shape"

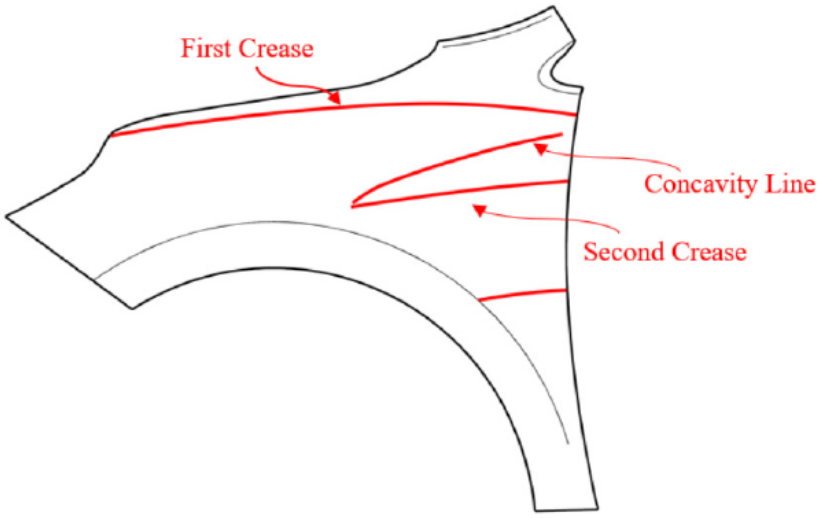
GM argues that the shape of the protrusion is unique, specifically drawing our attention to the consistent width of the upper surface of the protrusion, shown highlighted in green in Patent Owner's annotated Figure 1 reproduced below.



GM's annotated version of Figure 1 of the '625 design is shown above with the upper surface of the protrusion highlighted in green. *Id.* at 6. Patent Owner argues that "[t]he upper surface (green) has a thickness and consistent width that mirrors the inside surface of the 'u-shaped notch,' furthering the cohesive overall appearance of the fender." *Id.* at 5 (citing Ex. 2004 ¶¶ 39–40).

> *(c) "[t]hird, the claimed design includes lines and surfaces having smooth, arcing shapes that provide a distinctive sculpting"*

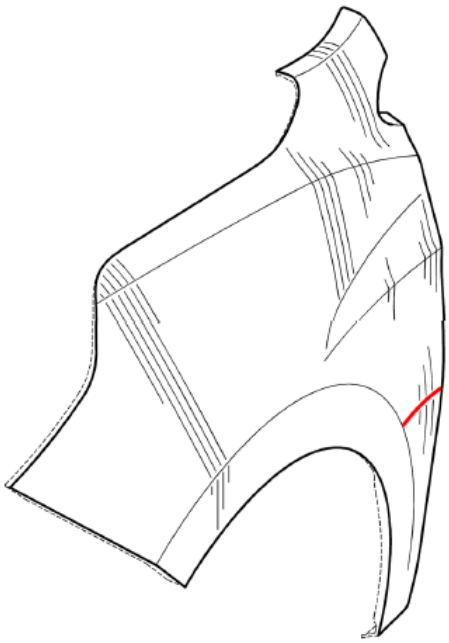
According to GM, the claimed design has first and second creases that "gently curve between respective ends." *Id.* at 7. GM contends that the "concavity line" is similarly curved and that "[t]hese lines cooperate with the smooth, arching lines of the fender perimeter, and the contoured surfaces between these lines, to provide an overall appearance of smooth, curving shapes." *Id.* Figure 2 of the '625 patent as annotated by Patent Owner is reproduced below.



GM's annotated version of Figure 2 of the '625 design is shown above with the first and second creases, and concavity line, highlighted in red. *Id.* at 5. Patent Owner refers to the first crease as a "character line." *Id.* at 9. According to GM's declarant, Mr. Peters, "the curvature and relative positioning of the 'first crease' helps set a tone for the proportions and body shape of the fender." Ex. 2004 ¶ 44.

> *(d) "[f]ourth, the claimed design includes a horizontal crease near the lower portion of the fender that extends between the wheel arch and the lateral edge"*

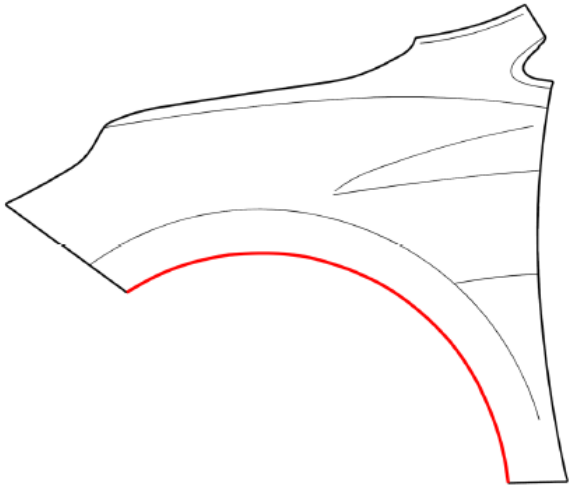
GM argues that the horizontal crease located adjacent to the wheel arch "contributes to the overall sculpted appearance of the front fender, and adds a focal location extending to the right of the wheel arch." PO Resp. 10. We note LKQ refers to this feature as an "inflection line." Pet. 14. Patent Owner's annotated Figure 1 is reproduced below.



GM's annotated version of Figure 1 of the '625 design is shown above with the horizontal crease highlighted in red. PO Resp. 10.

> *(e) "[f]ifth, the claimed design defines a wheel arch having a circular perimeter. The perimeter has a smooth, continuous curvature that extends between the front corner and rear bottom corner of the fender"*

GM contends also that the wheel arch contributes to the overall appearance of the claimed design because "the circular perimeter of the cutout echoes the smooth, arcing lines of the other perimeter edges, the protrusion, first and second creases, and other sculpting of the fender." *Id.* at 11. Figure 2, as annotated by GM, is reproduced below.



GM's annotated Figure 2, above, illustrates the perimeter of the wheel arch highlighted in red. *Id.*

3. The Claim Construction Analysis

In addition to its claim construction the specific design elements discussed above, GM makes several arguments to support its overarching contention that, "in the field of vehicle fender design, nuanced features are significant to overall appearance." *Id.* at 12 (citing Ex. 2004 ¶¶ 48–56). GM argues that an ordinary observer would consider the overall appearance of the claimed design and that details are important "because (1) the art is crowded; (2) the fender at issue must interface with other aspects of a vehicle, which puts increased focus on incongruities; and (3) fender replacement part marketing materials tout the importance of details and parts being 'identical' in this field." *Id.* We address these three arguments in turn.

(a) Whether Vehicle Fender Design is a Crowded Art

GM argues that vehicle fenders are in a crowded field. *Id.* at 13. GM argues that during prosecution of the application thatthat became the '625 patent, the Examiner cited and considered "dozens" of vehicle front fenders.

Id. GM cites several cases, including *In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993), where the Federal Circuit discusses crowded art. In *Harvey*, the Federal Circuit distinguished the facts from a prior case, *In re Hopkins*, explaining that the loud speaker designs at issue in *Hopkins* were in a field "much less crowded than that of ornamental vase design," which was the focus of *Harvey*. *Harvey*, 12 F.3d at 1064.

We appreciate that a recognition that the vehicle fender field is considered to be in a "crowded art" would be helpful for GM insofar as small or "nuanced" differences between the claimed design and the prior art will then become even more important. However, the "crowded art" concept is highly fact dependent. GM has presented evidence of other design patents for vehicle fenders. *See* PO Resp. 15; *see also* Ex. 1001, code (56) (listing dozens of references). GM's declarant, Mr. Peters, points out 24 design patents relating to vehicle fender design and, out of those, specifically addresses six "vehicle fender designs that reflect common design concepts like those recited in Petitioner's proposed construction for the '625 Patent." Ex. 2004 ¶ 50. Mr. Peters explains that, due to the necessity to interface with other vehicle components and body parts, commonalities between fender designs can "include arcuate wheel arches, protrusions that interface between the vehicle hood and A-pillar, door cut lines that interface with a door panel, and contoured surface sculpting that includes multiple creases." Ex. 2004 ¶ 51. Also, Mr. Peters references "an article from October 2017 estimating that over 1,700 different car models were on the road." *Id.* ¶ 53 (citing Ex. 2002, 2).

We are not persuaded that the field is crowded based merely on the evidence of the number of vehicle models that include front fenders. GM

has not defined clearly the field of art that is allegedly crowded. For example, it is unclear whether the field of art should include all vehicles as recited in the title, or be limited to sedans, as opposed to trucks or sports cars which could arguably be significantly different in appearance. GM's analysis of six other fender designs, advanced to show that the field of fender design is crowded, is helpful to show certain commonalities among related fender designs, but it is not as persuasive that fender design is specifically a crowded art. Moreover, to the extent *In re Harvey* is applicable here, we find that vehicle fenders are more fairly akin to loud speakers, as compared to vases, which have been made for thousands of years. *See Un-Making Sense of Alleged Abkhaz-Adyghean Inscriptions on Ancient Greek Pottery*, Alexei Kassian, Copyright: Koninklijke Brill NV, Leiden, 2016 (last viewed Aug. 4, 2021 at https://www.researchgate.net/publication/311802093_Un_Making_Sense_of_Alleged_Abkhaz Adyghean_Inscriptions_on_Ancient_Greek_Pottery) (explaining that "[a] large number of Ancient Greek vases, starting from the late 8th to the early 4th centuries BC, bear short inscriptions").

We acknowledge that there are many different front fender designs, and we find that this fact helps illustrate both commonalities and differences among the designs. *See, e.g.*, PO Resp. 13 (GM providing a collage of fender designs to illustrate common features). We are not persuaded, on the record before us, that GM has provided sufficient facts or evidence for the Board to determine that vehicle fender design is a relatively crowded art.

(b) Interfacing with Other Vehicle Components and the Similar Appearance of Replacement Parts

GM argues that "the ordinary observer would have been especially attuned to interfacing aspects of the design because they directly impact the

match/fit with other parts of the vehicle." PO Resp. 15–16 (citing Ex. 2004 ¶ 54; *Auto. Body Parts Ass'n v. Ford Glob. Techs., LLC*, 930 F.3d 1314, 1319 (Fed. Cir. 2019)). In this case, extending our claim construction inquiry beyond the metes and bounds of the claim to address "fit with other vehicle components" is not necessary. PO Resp. 15–16 (citing Ex. 2004 ¶ 54). For one thing, the claim in the '625 patent does not include any other body parts or vehicle components. Ex. 1001, code (57), Figs. 1–4; *see also OddzOn Prod., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) ("A design patent only protects the novel, ornamental features of the patented design."). However, we do find persuasive GM's evidence that, when repairing a vehicle, consumer preference is to choose identical replacement parts, for the reason that identical parts best return the vehicle to its original appearance. Pet. 16 (citing Ex. 2003, 10, 14; Ex. 2004 ¶¶ 55–56; Ex. 2005, 3–4). This evidence helps support GM's position that "[t]he ordinary observer's overall impression would have been defined by a multitude of readily apparent features of the '625 Patent's design." PO Resp. 17.

(c) How the Claim is Construed

We are persuaded by the parties' arguments and the evidence in this case that vehicle fender designs include unique ornamentation as shown in the drawings of the '625 patent. We are further persuaded that we should consider and describe, in more detail than the description LKQ proffers, the elements and ornamentation as part of the overall appearance of the claimed design. *See Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1294 (Fed. Cir. 2010) (The Federal Circuit questioning how "a court could effectively

construe design claims, where necessary, in a way other than by describing the features shown in the drawings.").

Therefore, in addition to the commonalities between fenders described by LKQ and its declarant, Mr. Hill, we find persuasive Mr. Peters' testimony that "[t]he ordinary observer would have been attuned to nuanced differences between fender designs," and "readily recognized differences that distinguish vehicle fender designs." Ex. 2004 ¶¶ 52–53. Mr. Peters testifies, for example, that "[t]he sculpture of vehicle front fenders significantly impacts the character and visual impression of the fender in the eyes of the ordinary observer." Ex. 2004 ¶ 81. Likewise, LKQ's declarant, Mr. Hill, testified in his deposition that an ordinary designer would consider various features, including sculpting, on vehicle fenders:

> Q. Right. What about the sculpting on the face of the fender, would you agree with me that those are features, the sculpting on the side of a vehicle including on a fender, that are going to be meaningful to an ordinary observer?
>
> . . . .
>
> A. Yes.

Ex. 2008, 20:6–15.

In our Decision on Institution, we determined that no express verbal description was necessary. Inst. Dec. 5–6. We explained that "the best description of the ornamental features of the '625 design comes from the drawings themselves." *Id.* at 6. Now, on the full record before us, we still find that the best evaluation of the claimed design occurs by observing and considering the overall appearance of the claimed design as shown explicitly in Figures 1–4 of the drawings. *See In re Jennings*, 182 F.2d 207, 208 (CCPA 1950) ("In considering patentability of a proposed design the

appearance of the design must be viewed as a whole, as shown by the drawing, or drawings.").

However, based on the competing analyses by the parties and considering the relationship of the prior art to the claimed design, we find it helpful to describe verbally certain elements of the claim for purposes of our analysis in this Final Decision. *See Egyptian Goddess*, 543 F.3d at 680; *see also Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 104 (Fed. Cir. 1996) ("A proper interpretation of [the] claimed design focuses on the visual impression it creates.").

Considering the overall appearance of the '625 design, we determine that LKQ's proposed construction is incomplete. In addition to LKQ's construction, we find certain other elements of the claimed fender, some of which are described by GM, are readily observable and relevant to the overall appearance of the claimed design.

1) As best observed in Figures 1–4 of the '625 patent, on the right side, the claimed design illustrates a door cut line having a slight but consistent curvature extending from the u-shaped notch downwards to a lower terminus of the fender, and a circular wheel arch extending from the lower terminus to an angular forward edge of the distal portion. *See* PO Resp. 4–5 (citing Ex. 2004 ¶¶ 35–38).
2) A consistent width lower rearward terminus shape defined between the wheel arch and door cut line. *See* Ex. 1001, Figs. 1–2.
3) A protrusion where the upper surface of the protrusion (shown highlighted green in GM's annotated Figure 1, above) has a thickness and consistent width that mirrors the inside surface of the u-shaped notch. PO Resp. 7 (citing Ex. 2004 ¶¶ 41–42).

4) A gently curving first and second crease extending forwards from the door cut line and defining a concavity line there between. The first and second crease and concavity lines providing a sculpted appearance to the fender body below the protrusion, as best shown in the perspective view of Figure 1. *Id.* at 10; Pet. 14–15 (citing Ex. 1004 ¶ 46).
5) As best seen in Figure 1 of the '625 patent, below the first and second creases, the claimed design illustrates an inflection line defined by opposing shade lines, the inflection line extending between the wheel arch and door cut line. PO Resp. 10, Ex. 1001, Fig. 1.

Considering Figures 1–4 and keeping these visually apparent characteristics of the claimed design in mind, we turn below to the anticipation and obviousness challenges that Petitioner has raised in this proceeding.

E. Instituted Grounds

LKQ contends that the challenged claim is unpatentable under 35 U.S.C. §§102, 103 based on U.S. Design Patent No. D773,340 S (Ex. 1006, "Lian"), which is assigned to BYD Company Ltd. and issued December 6, 2016. Pet. 18. LKQ also argues that the challenged claim is unpatentable under 35 U.S.C. §103 based on Lian combined with images of the 2010 Hyundai Tucson (Ex. 1007) as disclosed in a promotional brochure. *Id.*

Claims Challenged	35 U.S.C. §	References/Basis
Claim 1	102	Lian[2]
Claim 1	103	Lian
Claim 1	103	Lian and 2010 Hyundai Tucson[3]

II. ANALYSIS

A. Principles of Law

1. Anticipation

The "ordinary observer" test for anticipation of a design patent is the same as that used for infringement, except that for anticipation, the patented design is compared with the alleged anticipatory reference rather than an accused design. *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238, 1240 (Fed. Cir. 2009). The ordinary observer test for design patent infringement was first enunciated by the Supreme Court in *Gorham Co. v. White*, 81 U.S. 511 (1871), as follows:

> [I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

Id. at 528. The ordinary observer test requires the fact finder to consider all of the ornamental features illustrated in the figures that are visible at any time in the "normal use" lifetime of the accused product, i.e., "from the completion of manufacture or assembly until the ultimate destruction, loss, or disappearance of the article." *Int'l Seaway*, 589 F.3d at 1241. In other

[2] Ex. 1006, U.S. Design Pat. No. D773,340 S (December 6, 2016).
[3] Ex. 1007, 2010 Hyundai Tucson Brochure, copyright 2009, http://www.auto-brochures.com/makes/Hyundai/Tucson/Hyundai_US Tucson_2010.pdf.

words, the ordinary observer test requires consideration of the design as a whole. *See id.* at 1243; *Egyptian Goddess*, 543 F.3d at 677. In applying the ordinary observer test, we must "determine whether 'the deception that arises is a result of the similarities in the overall design, not of similarities in ornamental features in isolation.'" *See Richardson*, 597 F.3d at 1295.

Additionally, while the ordinary observer test requires consideration of the overall prior art and claimed designs,

> [t]he mandated overall comparison is a comparison taking into account significant differences between the two designs, not minor or trivial differences that necessarily exist between any two designs that are not exact copies of one another. Just as "minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement" . . . so too minor differences cannot prevent a finding of anticipation.

Int'l Seaway, 589 F.3d at 1243 (citation omitted) (quoting *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984)).

2. Obviousness

"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.").

Often referred to as the *Durling* test, the 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, "[o]nce 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." *Durling*, 101 F.3d at 103 (internal quotation and citations omitted).

The first step has two parts; 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.* 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.* 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.'" *Id.* (alteration in original) (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

Also, 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. *Harvey*, 12 F.3d at 1064; *see also Apple*, 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 Ordinary Observer

The parties dispute who is an ordinary observer. LKQ argues that "the ordinary observer should be the retail consumer of an automobile." Pet. 40 (citing Ex. 1003 ¶ 40; Ex. 1004 ¶ 34). GM argued in its Preliminary

Response that "the ordinary observer includes commercial buyers who purchase replacement vehicle front fenders to repair a customer's vehicle, such as repair shop professionals." Prelim. Resp. 7. GM noted that LKQ has acknowledged in a related proceeding (IPR2020-00065) that "replacement automobile body parts[] are typically purchased on behalf of vehicle owners by repair shops." *Id.* (quoting IPR2020-00065, Paper 2, 21) (emphasis omitted).

Before us is evidence that both automobile owners, as well as insurance and repair companies, desire to return vehicles to their original appearance. GM points to a letter from LKQ's counsel to U.S. Customs and Border Protection stating that "[a]utomobile owners seek to repair their automobiles in a way that returns their automobile as closely as possible to its original appearance and condition." Ex. 2003, 11. This letter also states that "[i]nsurance companies are overwhelmingly the customers in aftermarket repair parts market transactions, acting on behalf of their driver clients." *Id.*

The '625 design claims a "vehicle front fender," not a vehicle in total. Ex. 1001, code (54). Based on this, as well as the evidence from both parties, we determined in our Institution Decision

> that the ordinary observer includes a commercial buyer of replacement vehicle parts and a retail consumer of an automobile. That is to say, as discussed in detail below, the evidence on the record before us demonstrates that the designs at issue have such distinct and similar characteristics that either ordinary observer (the retail consumer or the repair shop professional who would be aware of prior art designs) would confuse the prior art designs for the design claimed by the '625 patent.

Inst. Dec. 12 (citation omitted). LKQ clings to its argument that Federal Circuit case law supports just the vehicle owner as the ordinary observer. *See* Tr. 9:20–19:8 (LKQ's counsel arguing that "the proper ordinary observer in this context should be the vehicle -- the retail vehicle purchaser."); *see also* Pet. Reply 3 (citing *Pacific Coast Marine Windshields v. Malibu Boats*, 739 F.3d 694, 701–702 (Fed. Cir. 2014)). Federal Circuit cases are consistent in that the determination of the ordinary observer is factually dependent. *See Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1323 (Fed. Cir. 2007), *abrogated on other grounds by Egyptian Goddess*, 543 F.3d at 665 (The Federal Circuit explaining "that the ordinary observer is a person who is either a purchaser of, or sufficiently interested in, the item that displays the patented designs and who has the capability of making a reasonably discerning decision when observing the accused item's design whether the accused item is substantially the same as the item claimed in the design patent.").

On the facts and evidence in this proceeding, the interests and goals of both the vehicle owner and repair shop person are aligned, that is—in the context of repair, to return the vehicle to its original appearance. Ex. 2003, 11; Ex. 2005, 3–4; Ex. 1043; Ex. 2004 ¶¶ 26, 54–56. Even if we chose between the two, the level of detail and analysis would not change sufficiently to affect the outcome of this Decision. Therefore, we do not alter our determination made at institution, that the ordinary observer includes both a vehicle owner and consumer and also a replacement parts buyer.

GM offers additional evidence as to the level of detail an ordinary observer would consider including a website selling a replacement fender for

the Chevrolet Equinox. PO Resp. 16–17 (citing Ex. 2005). The website states, for example, "[t]o replace your damaged parts, get these premium fenders by Replace. They are identical to OE in fit, form, and function." Ex. 2005, 3–4. In light of the evidence that both a vehicle owner and repair shop person would desire to return a vehicle in most cases to its original appearance, we find Mr. Peters' testimony persuasive that "the ordinary observer readily recognized incongruity associated with a part that does not fit or match other parts of the vehicle it is attached to." Ex. 2004 ¶ 54. We understand that this type of observation and consideration would require a certain level of examination when determining what replacement fender to purchase. Thus, we find persuasive GM's and Mr. Peters' assertions that, when considering the overall appearance of a vehicle fender, "details are readily noticed by the ordinary observer." PO Resp. 17 (citing Ex. 2004 ¶ 56).

C. The Designer of Ordinary Skill in the Art

LKQ contends that:

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

Pet. 38 (citing Ex. 1003 ¶ 42; Ex. 1004 ¶ 36). GM argues that:

> [a] designer of ordinary skill in the art relevant to the '625 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. 9. We do not discern a significant difference in these definitions proposed by the parties for an ordinary designer. Both definitions allow for an undergraduate professional degree, or alternatively, a reasonable period of time and work experience in the field of transportation and automotive design field. For purposes of this decision and on the complete record before us, we adopt LKQ's proposed definition of the ordinary designer. Adopting GM's definition would not alter the outcome of this Decision.

D. Anticipation by Lian

1. Lian (Ex. 1006)

Lian includes seven drawings of a "Vehicle." Ex. 1006, code (54). We reproduce Lian's Figures 1, 4, and 6 below.

FIG. 1

Figure 1 of Lian is a front elevation view of a vehicle. Ex. 1006, 2.

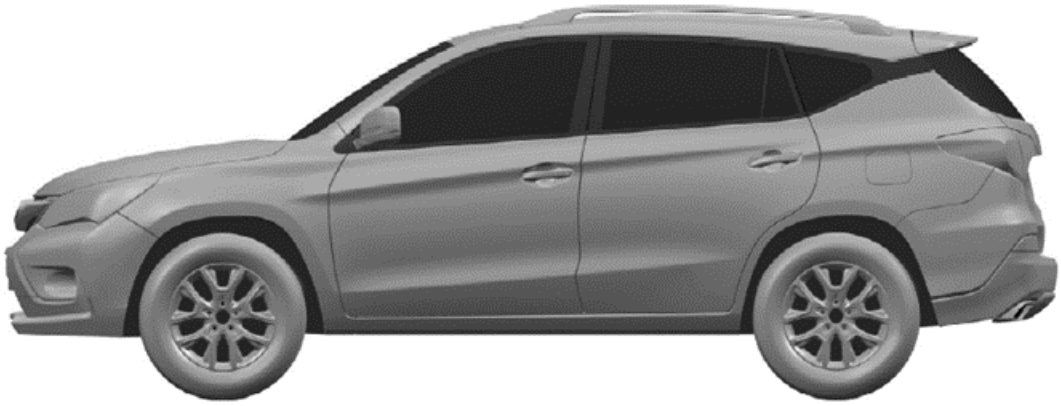


FIG. 4

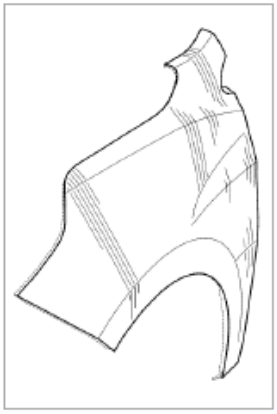
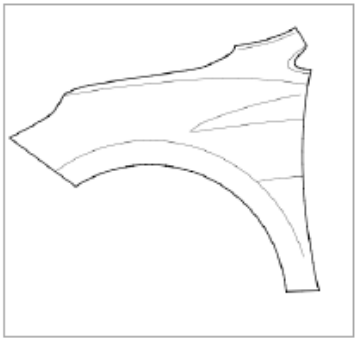
Figure 4 of Lian is a left side elevation view of the vehicle. *Id.* at 3.

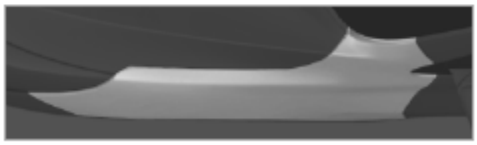
FIG. 6

Figure 6 of Lian is a front perspective view of the vehicle. *Id.* at 5. We selected these figures from among Lian's seven drawings because they show best Lian's left front fender for comparison with the claimed design.

2. LKQ's Arguments

Because we find it helpful, we reproduce below LKQ's chart from the Petition comparing cropped and annotated views of Lian's figures side-by-side with Figures 1–4 of the '625 design. Pet. 46–47.

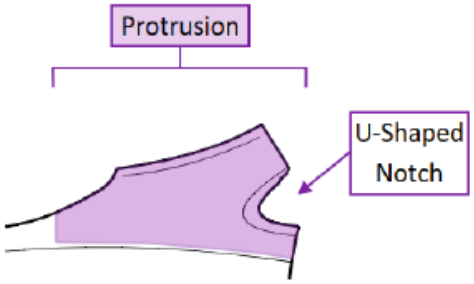
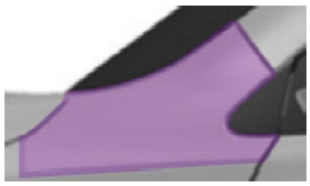
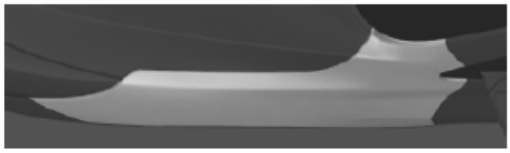
'625 PATENT	LIAN
 Ex. 1001, FIG. 1	 Ex. 1006, FIG. 6 (cropped, annotated)
 Ex. 1001, FIG. 2	 Ex. 1006, FIG. 4 (cropped, annotated)

'625 PATENT	LIAN
 Ex. 1001, FIG. 3	 Ex. 1006, FIG. 1 (cropped, annotated)
 Ex. 1001, FIG. 4	 Ex. 1006, FIG. 5 (cropped, annotated)

LKQ provides on the left side of the claim chart, reproduced above, each of Figures 1–4 of the claimed front fender compared with a similar cropped view of the front fender from Lian on the right side of the claim chart.

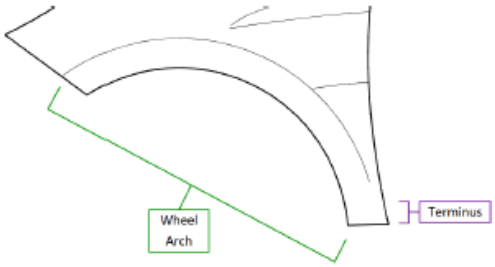
LKQ provides additional claim charts showing certain similarities between specific portions of the '625 design and Lian. *Id.* at 48–54. For example, with respect to the "top protrusion," LKQ compares cropped portions of the '625 design and Lian, asserting that the similarities of the top protrusions are "an overall visual appearance that is substantially the same as the claimed design." *Id.* at 47 (citing Ex. 1003 ¶ 55; Ex. 1004 ¶ 60). We

reproduce below LKQ's claim chart comparing the relevant portions of the top protrusion

'625 PATENT	LIAN
 Ex. 1001, FIG. 2 (annotated)	 Ex. 1006, FIG. 4 (cropped)
 Ex. 1001, FIG. 4	 Ex. 1006, FIG. 5 (cropped, annotated)

Id. at 48. LKQ provides on the left side of the claim chart, above, cropped and highlighted portions of Figures 2 and 4 of the claimed front left fender compared with the same referential cropped and highlighted view of the front left fender of Lian on the right side of the claim chart. LKQ argues that "both feature a top protrusion extending rearwardly and upwardly and having an intermittent u-shaped notch." *Id.* (citing Ex. 1003 ¶ 55; Ex. 1004 ¶ 60).

Using another claim chart, below, LKQ also points out some differences, such as the "wheel arch" and "terminus" between the '625 design and Lian. *Id.* at 55.

'625 PATENT	LIAN
	
Ex. 1001, FIG. 2 (cropped, annotated)	Ex. 1006, FIG. 4 (cropped, annotated)

LKQ provides on the left side of the claim chart, above, cropped and highlighted portions of Figure 2 of the claimed front fender compared with the same referential cropped and highlighted view of the front fender of Lian shown on the right side of the claim chart. LKQ argues that the different curvature of the wheel arch and lower terminus of the fenders "are, at most, minor distinctions and neither diminishes the overall visual similarity between the designs." *Id.* at 56 (citing Ex. 1003 ¶ 62; Ex. 1004 ¶ 67). Mr. Gandy testifies, with respect to the wheel arch, that "[t]he minor difference in shape would not be apparent to an ordinary observer and would be overwhelmed by the many other common features, especially the similarities in the more prominent features and particularly in view of the virtual

identicality [sic] in the width, proportion, and general appearance of the wheel arch flats of the two designs." Ex. 1003 ¶ 63.

3. GM's Arguments

Consistent with its claim construction position, GM argues that when the overall appearance of the claimed design is considered, many elements of the claimed design are absent from Lian. PO Resp. 21. GM makes the following specific arguments:

(a) The claimed door cut line is different from Lian (*Id.* at 21–24);

(b) "Lian does not disclose a 'top protrusion' having the appearance of the claimed design." (PO Resp. 24–30);

(c) Lian lacks the inflection line on the lower portion of the fender between the wheel arch and door cut line. (PO Resp. 30–32);

(d) Lian fails to disclose the same overall appearance provided by the sculpting shown in the claimed design. (PO Resp. 32–37);

(e) Lian's wheel arch lacks the consistent curvature of the claimed design. (PO Resp. 37–41); and

(f) Lian has a different lower rearward terminus shape than the claimed design. (PO Resp. 41–44).

GM argues that all these elements are important to the overall appearance of the claimed fender, and are not, as LKQ asserts, "'a miniscule element' that is 'beneath an ordinary observer's notice,'" for example with respect to the lower rear terminus. PO Resp. 43 (citing Pet. 57).

4. Analysis

(a) Similarities between the '625 patent and Lian

We recognize there are certain articulable and visible similarities in the overall appearance of the claimed design and Lian that would be

apparent to an ordinary observer. As LKQ contends, both designs include a top protrusion and u-shaped notch. Pet. 13, 48. Below the u-shaped notch, Lian arguably shows a first and second crease extending forward from a door cut line as well as a concavity between the first and second creases. *Id.* at 14, 48–49. Also, the distal portion, i.e. the front left, of both designs has a slanted forward edge extending between the wheel arch and front elevation profile fairly close in appearance. *Id.* at 52–53. These similarities are readily observable by comparing the elevation views of Figure 2 of the claimed design with Figure 4 of Lian, reproduced below.

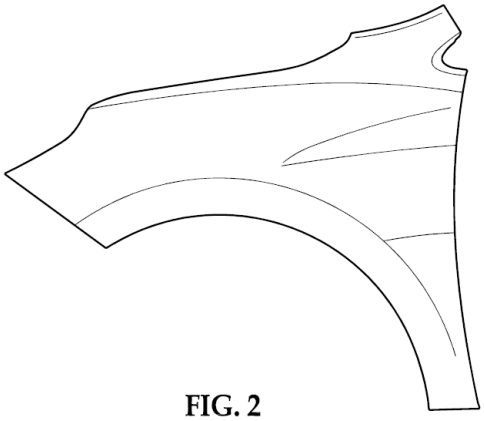
'625 patent Figure 2	**Lian's Figure 4**
 FIG. 2	

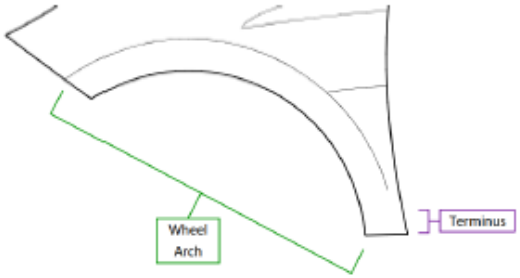
Figure 2 of the '625 patent above left, in comparison to a cropped version of Lian's Figure 4, on the right.

(b) Differences between the '625 patent and Lian

Wheel Arch and Terminus

We agree with LKQ that when considering the elevation views, the wheel arch shape is different, and also the fender terminus, lower right, is

visibly different. *Id.* at 55. We reproduce LKQ's annotated figures from the '625 patent and Lian, below.

'625 PATENT	LIAN
	
Ex. 1001, FIG. 2 (cropped, annotated)	Ex. 1006, FIG. 4 (cropped, annotated)

LKQ's annotated and cropped Figure 2 of the '625 patent above left, in comparison to an annotated and cropped Figure 4 of Lian, on the right.

We are not persuaded, however, that "these two differences are, at most, minor distinctions" as LKQ and its declarants assert. *Id.* at 56 (citing Ex. 1003 ¶ 62; Ex. 1004 ¶ 67). One of LKQ's declarants, Dr. Gandy, testifies as to the wheel arch and terminus features that "[t]he minor difference in shape would not be apparent to an ordinary observer and would be overwhelmed by the many other common features, especially the similarities in the more prominent features." Ex. 1003 ¶ 63. GM's declarant, Mr. Peters, states the opposite, testifying that "Lian's wheel arch accounts for a substantial portion of the fender perimeter and is a prominent feature of the overall appearance of Lian's design." Ex. 2004 ¶ 93.

Considering the design as a whole, we are persuaded by Mr. Peters's testimony and GM's evidence that an ordinary observer would perceive, along with the similarities discussed above, that Lian's wheel arch is non-circular and that the terminus has a rearwardly extending segment different from the claimed design. Considering our claim construction and the testimony of both parties' declarants, we find that an ordinary observer certainly would evaluate these visually significant features in defining the overall appearance of the claimed design, and find them to be missing in Lian. *See* Section I.D.3.

Also bearing on our analysis, GM has produced evidence of other prior art references that disclose and claim various fender designs. *See* PO Resp. 13–14 (citing Ex. 2004 ¶¶ 49–53). Because an ordinary observer would consider at least the wheel arch and terminus differences as a relevant part of the overall appearance of the claimed design in the context of Lian and other known prior art fenders, and because these elements are not minor in that they affect the overall visual impression of the fender, we are persuaded that an ordinary observer would not be so easily deceived into purchasing Lian's fender thinking it to be the claimed fender.[4] *See Egyptian Goddess*, 543 F.3d at 677 ("Where the frame of reference consists of numerous similar prior art designs, those designs can highlight the

[4] Although LKQ argues that *Egyptian Goddess* was designated as a test for infringement, not validity, the Federal Circuit has clarified "that the ordinary observer test must logically be the sole test for anticipation as well. In doing so, we will prevent an inconsistency from developing between the infringement and anticipation analyses." *Int'l Seaway*, 589 F.3d at 1240.

distinctions between the claimed design and the accused design as viewed by the ordinary observer.").

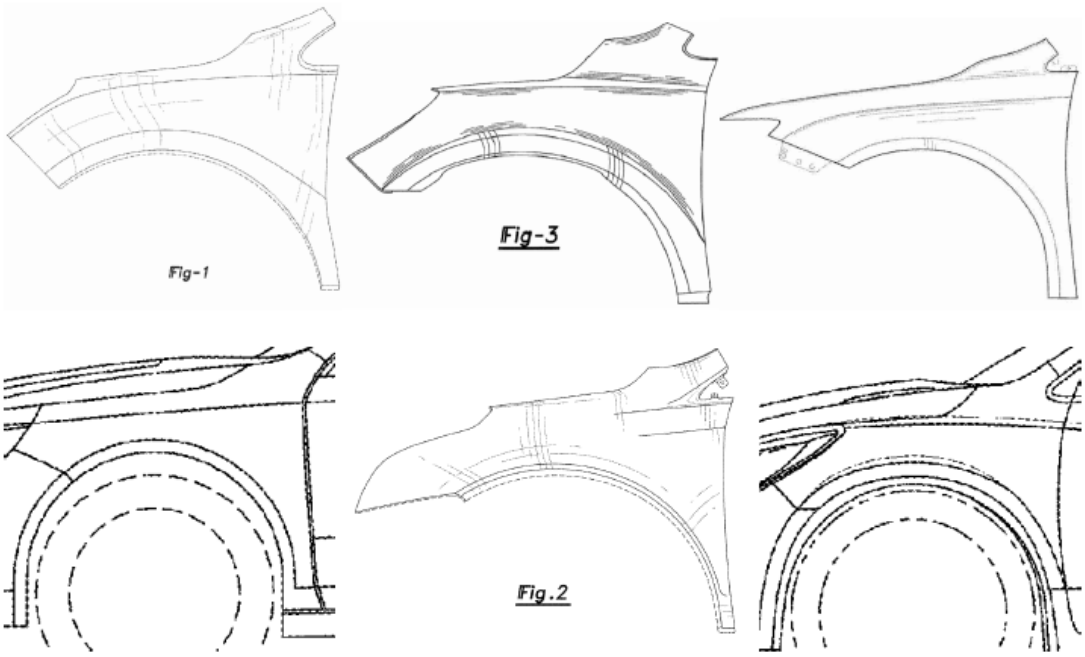
Moreover, the wheel arch and terminus are not the only differences between Lian and the claimed design. LKQ argues that "[n]one of Lian's door cut line, protrusion, inflection line, or pattern of creases and sculpture are meaningfully dissimilar from the claimed design." Pet. Reply. 11. For the reasons discussed below, we disagree.

Although in the next sections we analyze additional features of the claimed design and Lian, we never lose sight of the overall visual impressions of the claimed design and Lian, or the question of whether Lian creates the same overall visual impression as the claimed design. *Gorham Mfg. Co. v. White*, 81 U.S. 511, 530, 20 L. Ed. 731 (1871) ("though variances in the ornament are discoverable, the question remains, is the effect of the whole design substantially the same?").

Door Cut Line

Considering Figure 2 of the '625 patent in comparison to Figure 4 of Lian, it is apparent that the door cut lines are different. Even a cursory examination reveals that the claimed door cut line is a visually consistent curvature when observed in the elevation view, whereas Lian's door cut line presents a more angular transition at the second crease line. *Compare* Ex. 1001, Fig. 2, *with* Ex. 1006, Fig. 4. The door cut line differences may not be a hugely critical point of emphasis, but they can be a visually differentiable feature that draws an ordinary observer's attention. *See* Ex. 2008 8:13–9:21 (LKQ's declarant, Mr. Hill, agreeing that a door cut line could have visual significance to an ordinary observer).

The importance of small design differences, such as the door cut line, may increase in importance when we consider the claimed design within the context of the prior art. *See Egyptian Goddess*, 543 F.3d at 676 (The Federal Circuit explaining that "when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer."). GM's compilation of other vehicle fender designs is reproduced below. PO Resp. 13.

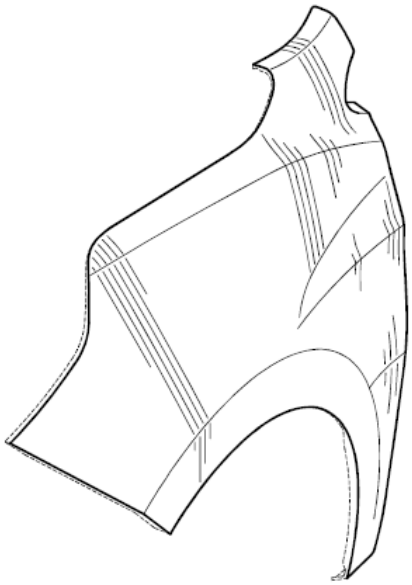
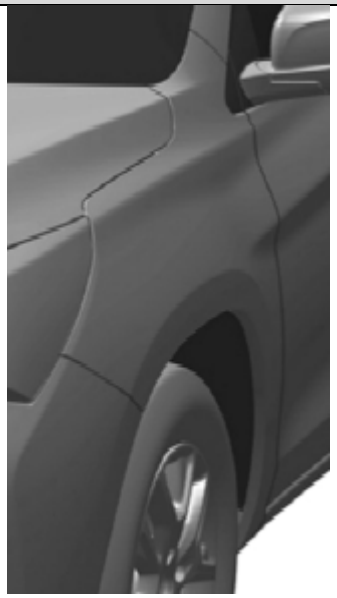


Shown above are various elevation view figures from U.S. Pat. Nos. D766149, D704607, D763753, D686536, D692798, and D762151 as compiled by GM. The door cut lines illustrated in the prior art are generally slightly arcuate vertical lines, but even among the six designs shown above, there are visibly apparent differences in angularity and curvature when viewed objectively. Considering the evidence here, we find persuasive Mr.

Peters' testimony that when considered in light of prior art fender designs, an ordinary observer would have considered differences, even in nuanced elements such the door cut lines, "and these nuanced differences would have had a substantial impact on the overall appearance of fender designs to the ordinary observer." Ex. 2004 ¶ 52.

Protrusion

Similarly, and keeping in mind the prior art discussed above, we are further persuaded that differences in the protrusions of the claimed design and Lian play a role in the overall appearance of the designs. While one might initially observe some relative similarity of the protrusions at issue here, specifically in the elevation views, these views alone do not provide a complete picture and sufficient comparison of the protrusions. The protrusions in this case are better seen in the perspective views Figures 1 and 4 of the '625 patent and Figures 5 and 6 of Lian, reproduced below.

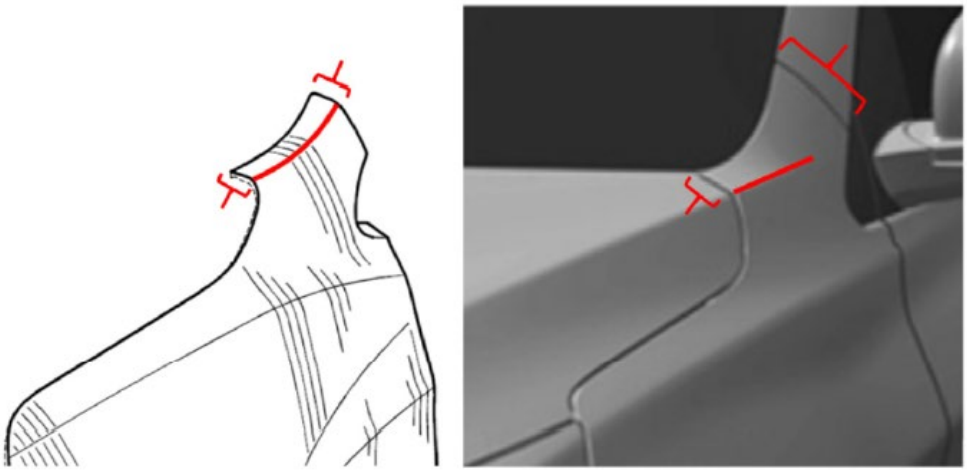
'625 patent Figure 1	**Lian's Figure 6**
	

Above left, Figure 1 of the '625 patent depicts a perspective view of the claimed fender design, in comparison to a cropped version of Lian's perspective view in Figure 6, on the right.

'625 patent Figure 1	Lian's Figure 6
 FIG. 4	

Figure 4 showing a top plan view of the fender design of the '625 patent above left, in comparison to a cropped top plan view of Lian's Figure 6, on the right.

In its comparison, LKQ mainly offers that "both [designs] feature a top protrusion extending rearwardly and upwardly and having an intermittent u-shaped notch." Pet. 48 (citing Ex. 1003 ¶ 55; Ex. 1004 ¶ 60). GM's comparison, appropriately in our opinion, includes more detail. GM notes that the upper surface of the claimed design is generally consistent from front to back, but "Lian, on the other hand, depicts an upper surface that changes width and curvature along the length of this surface from its left to right edges." PO Resp. 26. We reproduce GM's annotated comparison of the protrusions below.



GM's annotated Figure 1 of the '625 patent, above left, and annotated Figure 6 of Lian, above right. We find that GM's declarant, Mr. Peters, provides the most persuasive testimony consistent with the elements an ordinary observer would consider in vehicle fender design. Mr. Peters testifies that "Lian's protrusion has an upper surface that rotates and varies in width between left and right edges. For example, the left edge that interfaces with a portion of the hood is substantially narrower than a right edge that interfaces with the A-pillar." Ex. 2004 ¶ 70.

Sculpting

Sculpting, in the manner of the generally horizontal creases seen in both the '625 patent and Lian, certainly plays a role as part of the overall appearance of the fender as both parties address these elements in their claim construction and validity analyses. *See, e.g.*, Pet. 48–52 (LKQ describing visual characteristics of first and second creases and inflection line); *see also* PO Resp. 30–37 (GM comparing horizontal creases of the '625 patent and Lian). At first glance, the sculpting between the designs exhibits some similarity in location and arrangement. On the other hand, in his deposition,

Mr. Hill testified about the emphasis that a designer places on horizontal features of a fender:

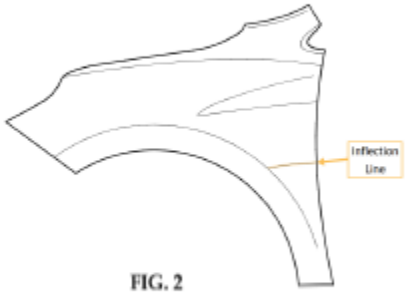
> Q. Okay. And I think earlier you said that it's the horizontal features of the vehicle that are more often emphasized; is that right?
>
> A. Yes. Again, very broadly, but also extremely -- you know, we read left to right and the horizontal aspect, you know, the orientation of vehicles is generally long and in a horizontal manner as opposed to buildings which are more architecture and vertically oriented. So most of the elements are emphasized to -- or harmonized to emphasize an implied length in a horizontal manner.

Ex. 2008, 9:3–13.

Considering the crease lines and horizontal visual details of the designs, we find persuasive GM's arguments and Mr. Peters' testimony that an ordinary observer would not find the fender body sculpting substantially similar between Lian and the claimed design. PO Resp. 32–37 (citing Ex. 2004 ¶¶ 81–89). Moreover, it is reasonably clear that an ordinary observer would be aware of other prior art fender designs and would notice specific details in the sculpting. *See, e.g.*, Ex. 2008, 20:6–15 (LKQ's declarant, Mr. Hill, agreeing that the sculpting on the fender would "be meaningful to an ordinary observer.").

Inflection Line

LKQ argues that Lian exhibits the identical inflection line as the claimed design, utilizing the annotated figure for comparison below. Pet. 50–52.

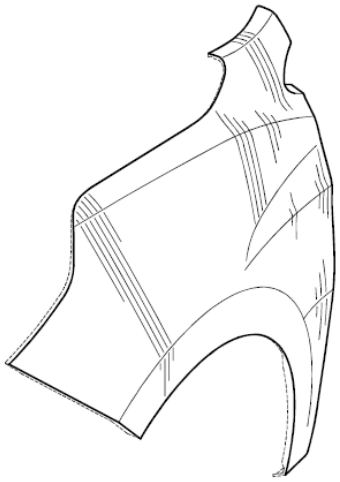
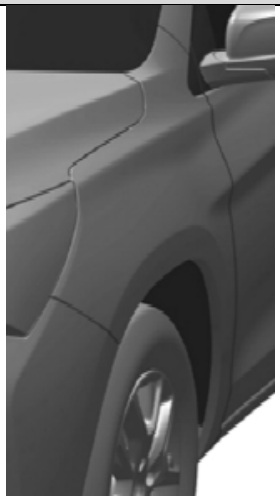
'625 PATENT	LIAN
 FIG. 2	
Ex. 1001, FIG. 2 (cropped, annotated)	Ex. 1006, FIG. 4 (cropped, annotated)

LKQ's annotated Figure 2 from the '625 patent, above left, and Lian's annotated and cropped Figure 4, above right. LKQ uses a horizontal yellow highlight line on Lian's design to indicate where it considers a similar inflection line on the claimed design. GM takes issue with this comparison and argues that the claimed inflection line in the '625 design is in fact a crease as shown where "the shade lines in FIG. 1 signal a distinct and abrupt angle change of the fender above and below the crease." PO Resp. 30 (citing Ex. 2004 ¶ 76). Whether termed an inflection line, or a crease, our consideration of this feature is consistent with Mr. Peters' testimony that Lian lacks such a feature. Mr. Peters compares LKQ's annotated Figure 4 of Lian with a similar cropped image *without* LKQ's yellow highlight line. Mr. Peters explains persuasively that different from the claimed design, in Lian "[t]here is simply no crease at the location annotated with a crease by the Petition." Ex. 2004 ¶ 77.

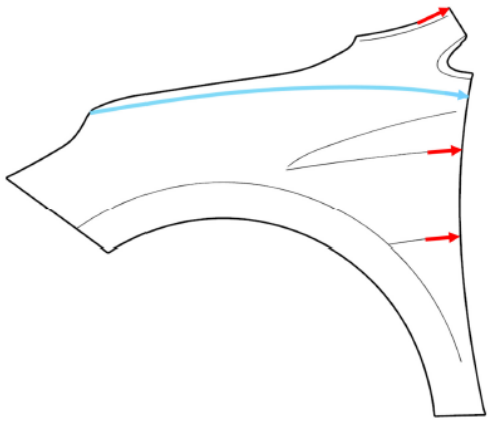
Shown above is Figure 4 of Lian as annotated by LKQ, on the left, with a yellow highlight allegedly indicating an inflection line or crease, and on the right, a cropped annotated image from Figure 4 without the yellow highlight.

First and Second Creases

Also, while certainly nuanced, we are persuaded that there are visually ascertainable differences between the first and second creases, which are part of the sculpting of the two designs that would be apparent to an ordinary observer. We reproduce the perspective views of Figure 1 of the '625 patent and Lian's Figure 6 below.

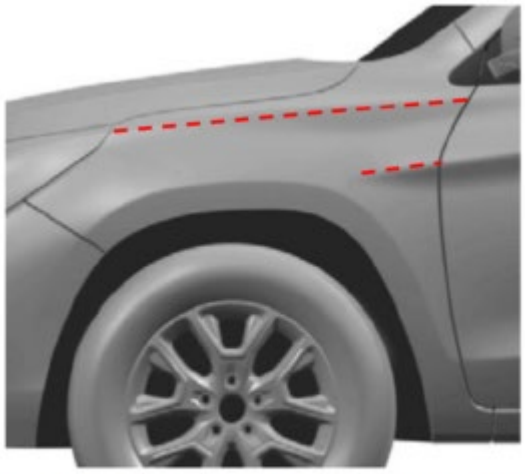
’625 patent Figure 1	Lian’s Figure 6
	

Above, left, Figure 1 is a perspective view of the fender design of the ’625 patent, in comparison to a cropped version of Lian’s perspective view in Figure 6, on the right. We are persuaded by Mr. Peters’ testimony and annotated Figure 2, reproduced below, that an ordinary observer would recognize in the claimed design that, as shown in blue, “the ‘first crease’ extends downwardly while the upper crease of the protrusion, and second and third creases extend upwardly.” Ex. 2004 ¶ 88.



Mr. Peters’ annotated elevation view, Figure 2 of the ’625 patent, above, includes annotations highlighting the curvatures of the claimed creases. *Id.*

Considering how the sculpting plays into the overall appearance of the fender, Mr. Peters testifies that compared to Lian, "[t]he '625 Patent's sculpting is characterized by smooth, curving lines." *Id.* ¶ 82. For comparison, we reproduce below Mr. Peters's annotated cropped portion of Lian's Figure 4. *Id.*

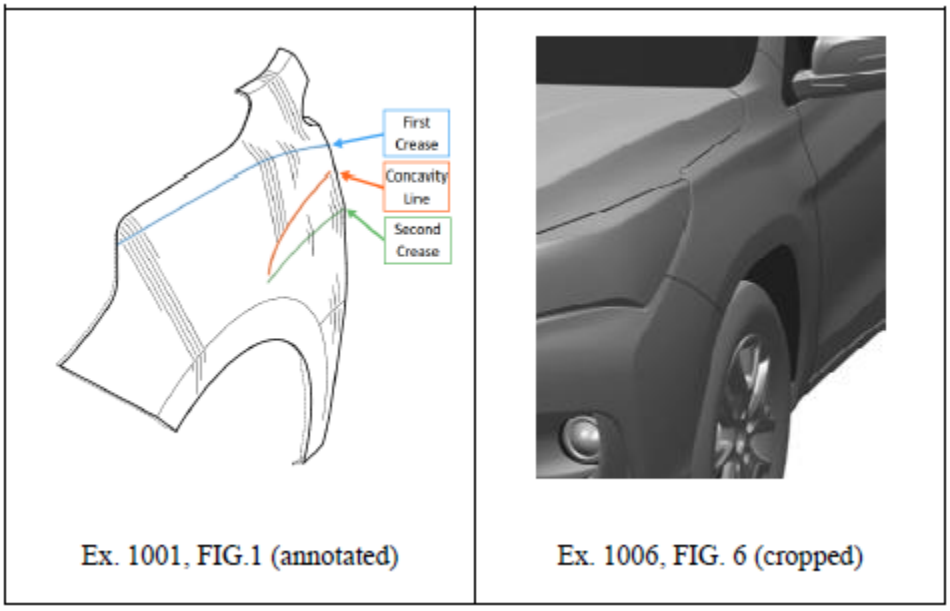


Above is Mr. Peters' annotated and cropped portion of Lian's Figure 4 elevational view. *Id.* Considering Lian's creases, we find persuasive Mr. Peters' testimony that "Lian depicts substantially linear, angled lines," and that an ordinary observer would have recognized these lines as elements integral to the overall appearance of Lian that differ from the claimed design. *Id.*

Concavity Line

Both LKQ and GM contest the relevance and similarity of the concavity line that is positioned and essentially defined between the first and second creases. LKQ argues that both designs are similar in that relative to the first and second creases "the interplay between the resulting contours creates a curved concavity line." Pet. 48 (citing Ex. 1003 ¶ 56; Ex. 1004

¶ 61). We reproduce below LKQ's comparison of annotated Figure 2 of the '625 patent and a cropped version of Figure 4 of Lian.



Ex. 1001, FIG.1 (annotated)

Ex. 1006, FIG. 6 (cropped)

Above left, Figure 2 of the '625 patent depicts an annotated perspective view of the claimed fender design alongside a cropped version of the perspective view from Lian's Figure 6.

GM argues that the concavity lines are different. PO Resp. 34. GM's declarant, Mr. Peters, testifies that "Lian altogether lacks a 'concavity line' having the shape of the claimed design's concavity line." Ex. 2004 ¶ 86. GM argues of the second crease and concavity lines that "[t]he sculpting depicted by these lines further contributes to the overall appearance of the claimed design, providing distinctly shaped areas of relatively lighter and darker surfaces." PO Resp. 34 (citing Ex. 2004 ¶ 85).

There does not appear to be any dispute that both designs include a concavity line defined between the first and second creases. As discussed above, without much persuasive support, both parties and their respective declarants conclude that the concavity lines are either the same or different.

Based on our review, it is not clear, in either the '625 patent or Lian, what the scope or significance of the concavity line is with respect to either the '625 patent or Lian. Observing the claimed design as a whole, we disagree with GM that the concavity line can be considered "prominen[t]." *Id.* at 35. However, overall, the creases and concavity line together play a part in the overall appearance of each design. Considering our analysis, *supra*, of the differences in the first and second creases of both designs, we find persuasive GM's position that the concavity line, like the first and second creases, presents a nuanced difference in the claimed design that contributes to a visually disparate sculpting and overall appearance of the claimed design as compared to Lian.

5. Conclusion as to Anticipation by Lian

Having reviewed the complete record, including both parties' evidence and arguments, and having considered the overall appearance of the claimed design as compared to that of Lian, we are not persuaded that LKQ has shown by a preponderance of the evidence that an ordinary observer would be deceived into "purchas[ing] one supposing it to be the other." *Gorham Co. v. White*, 81 U.S. 511, 528 (1871). LKQ has not established persuasively that the '625 patent design and the design of Lian are substantially the same under the ordinary observer analysis.

Accordingly, based on the final record before us, LKQ has not established by a preponderance of the evidence that Lian anticipates the claim of the '625 patent.

E. Obviousness by Lian, or Lian in view of 2010 Hyundai Tucson

"In determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken

into consideration." *See In re Rosen*, 673 F.2d 388, 390 (CCPA 1982). The proper standard is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved, which, in this case, are vehicle fenders. *See In re Nalbandian*, 661 F.2d 1214, 1217 (CCPA 1981); Ex. 1001, Title, Fig. 1 (illustrating ornamental features on the outer surface of a vehicle fender). For the reasons that follow, we determine that LKQ fails to carry its burden of identifying a primary, i.e., *Rosen*, reference. *See Rosen*, 673 F.2d at 391. As a consequence, LKQ fails also to establish that the challenged claim is unpatentable as obvious.

1. LKQ's Arguments

LKQ contends the ornamental design of the '625 patent would have been obvious to a designer of ordinary skill based on Lian alone, or based on Lian in view of 2010 Hyundai Tucson. Pet. 58–76. LKQ relies on a comparison of the combined ornamental features of Lian and 2010 Hyundai Tucson with the design of the '625 patent, as well as the Gandy and Hill declarations, to support its conclusion that the "Lian Patent is an appropriate primary reference for establishing obviousness of the '625 Patent because it constitutes 'a single reference, a something in existence, the design characteristics of which are ***basically the same*** as the claimed design.'" *Id.* at 58 (citing *Durling*, 101 F.3d at 103). *Id.*

LKQ asserts, as it did with respect to its claim construction and anticipation analysis, that a designer of ordinary skill in the art would have "recognized that the only possible differences between Lian and the claimed design relate to the specific shape of the wheel arch and the lower rearward terminus of the fender." Pet. 62 (citing Ex. 1003 ¶ 71; Ex. 1004 ¶ 76). LKQ argues that Lian is an appropriate primary reference because of all the

similarities and further argues, as to the two differences, that '[t]he ordinary skill and creativity of a designer of ordinary skill in the art would have suggested the few minute alterations needed for the designer to arrive at the claimed design." Pet. 58 (citing Ex. 1003 ¶ 66; Ex. 1004 ¶ 71). More specifically, LKQ argues that an ordinary designer would have found the '625 patent and Lian to have "nearly identical protrusions, first and second creases, and concavity line." *Id.* at 61 (citing Ex. 1003 ¶ 68; Ex. 1004 ¶ 73).

2. GM's Arguments

GM argues that Petitioner failed to properly evaluate the "multiple, readily apparent differences between the claimed design and Lian that are significant to the overall appearance in the eyes of the ordinary observer/designer." PO Resp. 45. Because LKQ mainly addressed just two differences between the claimed design and Lian relating to the wheel arch and lower terminus, GM argues that even if these differences can be sufficiently addressed, "multiple, simultaneous changes related to the overall appearance of the design would be required to achieve the '625 Patent's design." *Id.* at 46 (citing Pet. 59; Ex. 2004 ¶ 101). According to GM, "the Petition summarily dismisses any differences as '*de minimis*,' without meaningful analysis of each one of the many required changes." *Id.* In other words, GM's main argument is that LKQ has failed to show that Lian is a proper primary, i.e., *Rosen*, reference. *Id.* GM also argues that LKQ has failed to provide a reasoned analysis as to why an ordinary designer would have modified the shape of Lian's wheel arch and the shape of Lian's lower terminus. *Id.* at 47. Further, GM argues that even if Lian were modified as proposed in the ground relying on Lian and 2010 Hyundai Tucson, LKQ

fails to demonstrate the result would have an overall appearance "basically the same" as the claimed design. *Id.* at 54.

3. Obviousness Analysis

As discussed previously, for design patents, the relevant obviousness inquiry is a two-step process. First, we must identify a primary or *Rosen* reference, "a something in existence, the design characteristics of which are basically the same as the claimed design." *MRC Innovations*, 747 F.3d at 1331 (quoting *Rosen*, 673 F.2d at 391). The "basically the same" test requires initial consideration of the "visual impression created by the patented design as a whole." *Id.* The second step requires a determination of whether any secondary reference is "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." *Id.* (alteration in original) (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

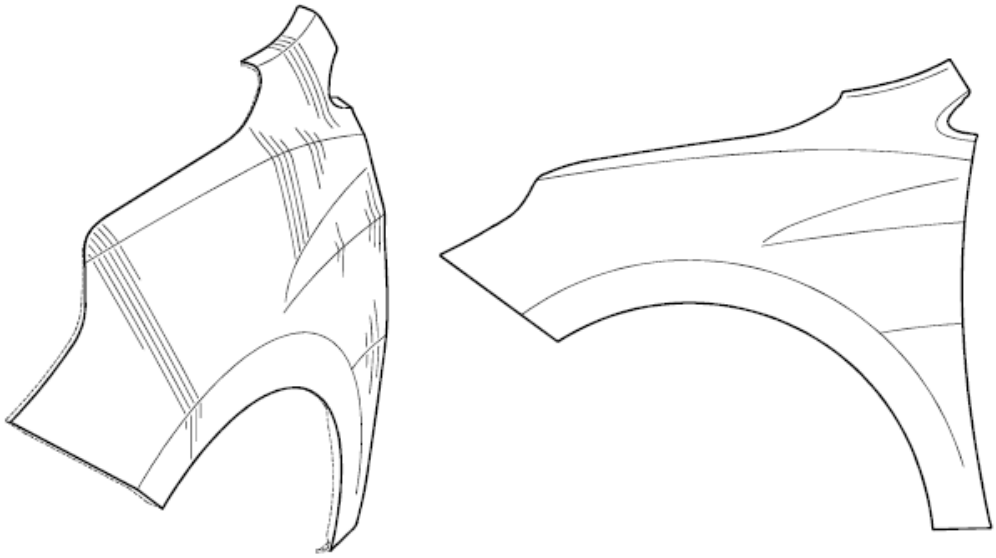
The Petition asserts that Lian qualifies as a primary or *Rosen* reference. We address the two steps of the obviousness inquiry below.

(a) The Visual Impression of the Patented Design as a Whole

We set forth in our claim construction the overall visual impression of the claimed design. Section I.D.3.(c). We determined that the appropriate visual impression of the claimed design occurs by observing and considering the overall appearance of the claimed design as shown explicitly in Figures 1–4 of the drawings. *Id.* Also, we found that LKQ's proposed claim construction offers a starting point, but does not go far enough, in describing the overall appearance of the claimed design. According to LKQ, the claimed design can be described as follows:

> [a] vehicle fender comprising:
>
> a top protrusion extending rearwardly and upwardly from an upper portion of the fender and having an intermittent u-shaped notch;
>
> a first crease and a second crease extending forwards from a rear edge of the fender, a concavity line disposed between the first crease and the second crease, and an inflection line below the second crease; and
>
> an angular front elevation profile.

Pet. 10–13; Section I.D.3.(c). We reproduce below Figures 1 and 2 of the '625 patent.



Ex. 1001, Figs. 1–2. Figure 1, above left, is a perspective view of the fender with ornamental features illustrated as solid lines and unclaimed features illustrated by broken lines. Figure 2, above right, is an elevation view of the claimed fender. Ex. 1001, Description.

In addition, we determined based on GM's arguments that the appropriate visual impression considers other ornamental elements and features of the claimed fender design including:[5]

1) A consistently curved door cut line and a circular wheel arch. *See* PO Resp. 4–5 (citing Ex. 2004 ¶¶ 35–38).
2) A consistent width lower rearward terminus defined between the wheel arch and door cut line. *See* Ex. 1001, Figs. 1–2.
3) The top protrusion having an upper surface having a thickness and consistent width that mirrors the inside surface of the u-shaped notch. PO Resp. 7 (citing Ex. 2004 ¶¶ 41–42).
4) A gently curving first and second crease extending forward from the door cut line and defining a concavity line there between. *Id.* at 10; Pet. 14–15 (citing Ex. 1004 ¶ 46).
5) Below the first and second crease, an inflection line extending between the wheel arch and door cut line. PO Resp. 10, Ex. 1001, Fig. 1.

Section I.D.3.(c).

(b) The First Step of the Durling Test

A preponderance of the evidence supports a conclusion that LKQ fails to take account adequately of the numerous elements of the patented design and, therefore, fails also to identify "the correct visual impression created by the patented design as a whole"—a required first step in identifying a *Rosen* reference. *Durling*, 101 F.3d at 103. That failure, standing alone, justifies

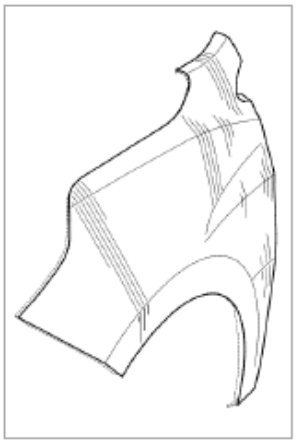
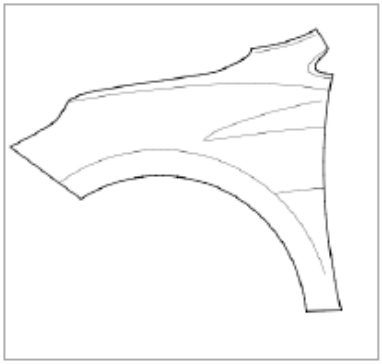
[5] These element descriptions are the same as that described in our claim construction analysis, Section I.D.3., which we summarize here for readability.

our conclusion that LKQ fails also to prove by a preponderance of the evidence that the challenged claim of the '625 patent is unpatentable.

For purposes of completeness, and alternatively, we turn to the second part of the first step of the *Durling* test, which presents an independent basis for concluding that LKQ fails to carry its burden of proving that the challenged claim is unpatentable. We thus consider the overall appearance of the claimed design from the perspective of the ordinary designer in our analysis as to whether or not the overall appearance of Lian is "basically the same" as the claimed fender. *MRC Innovations*, 747 F.3d at 1331. For the following reasons, we are not persuaded that Lian is basically the same as the claimed design.

(c) LKQ Fails to Identify a Single Reference that Creates Basically the Same Visual Impression as the Patented Design

We reproduce Petitioner's claim chart, which features Figures 1 and 2 of the claimed design in side-by-side comparison with Lian's Figures 4 and 6, below.

'625 PATENT	LIAN
	
Ex. 1001, FIG. 1	Ex. 1006, FIG. 6 (cropped, annotated)
	
Ex. 1001, FIG. 2	Ex. 1006, FIG. 4 (cropped, annotated)

LKQ provides on the left side of the claim chart reproduced above, each of Figures 1 and 2 of the claimed front fender compared with a similar cropped view of the front fender from Lian's Figures 4 and 6 on the right side of the claim chart.

Lian and the ’625 patent do share certain vehicle fender elements such as an upper protrusion, a wheel arch, a door cut line, a front angled edge, and sculpting including at least first and second creases in both designs. *See* Section I.D.3.(c); *see also* Pet. 7–10 (citing Ex. 1044, 73). GM’s declarant, Mr. Peters, agreed with LKQ’s counsel during his deposition that certain shared features of the claimed design contribute to the overall appearance of the challenged design. Ex. 1044, 73–81. But determining whether a design is “basically the same” is not simply a matter of counting up the similarities and differences. The appropriate comparison focuses on the correct visual impression created by the designs. *See Durling*, 101 F.3d at 104. As we describe below, and keeping in mind the level and skill of an ordinary designer in vehicle fender design, a complete visual comparison of the overall appearance of both designs sufficiently shows that the two designs are quite different.

It is immediately apparent that the profiles of the wheel arches are not the same. *Compare* Ex. 1001, Fig. 2, *with* Ex. 1006, Fig. 4. Compared to the claimed consistently circular wheel arch, Lian depicts a more square profile matched by the square planar edge of the wheel arch extending from the front angled edge to the fender terminus, lower right. *Id.* LKQ’s declarant Mr. Hill agreed that the wheel arch can be a significant feature:

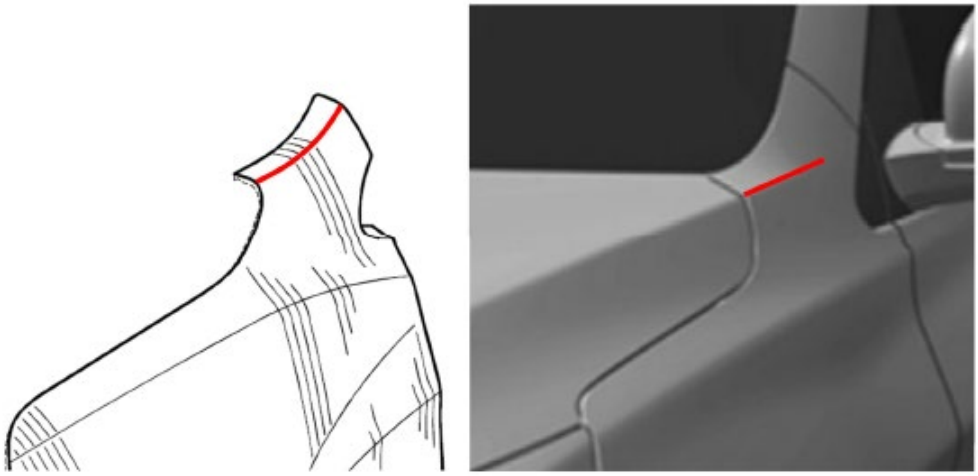
> Q. Yeah. Do you believe that the difference in wheel arches between two fenders is something that a consumer or a designer would find -- could find significant?
>
> A. Depending on the degree of the extreme thematic element of a wheel arch, yes. It will always be important to a designer whether they settle for kind of a common solution or they’re looking for a new solution. The consumer would also notice it if it was to such a degree that it presented something, you know, unique.

Ex. 2008 16:17–17:5.

The fender terminus of Lian is also visibly different from the claimed design. *Compare* Ex. 1001, Fig. 2, *with* Ex. 1006, Fig. 4. Lian's terminus has a rearward protrusion forming a more sharply curved lower portion of the door cut line. *See*, *e.g.*, Ex. 1006, Fig. 4. Also, the door cut line of the claimed design is a mostly consistent curvature extending downward from the u-shaped notch smoothly to the terminus. Ex. 1001, Fig. 2. A reasonable observation of Lian's door cut line reveals a more angular, sharper bend at the second crease. We appreciate from the deposition testimony of Mr. Hill, that the door cut and terminus might not be considered highly significant by an ordinary designer. *See, e.g.*, Ex. 2008, 6:5–7:11, (Mr. Hill testifying about the door cut line, "from the standpoint that a designer is focused on it, they're concerned with it, but they're not overly concerned with it"). And, we balance this testimony along with Mr. Peters' testimony that "I note that the appearance of the door cut line would have had a substantial impact on the overall appearance of the design." Ex. 2004 ¶ 38. We determine that the door cut and terminus features, even if not overly significant, influence and differentiate the overall appearance of the claimed design and Lian.

We are also persuaded that the upper protrusions of Lian and the claimed design are visually different in meaningful ways. When observed in a comparison of elevation views, the upper protrusions of both designs may at first glance appear similar. *Compare* Ex. 1001, Fig. 2, *with* Ex. 1006, Fig. 4. However, considering all the views of the claimed design and Lian, specifically the perspective views, it is apparent that the surfaces of the

protrusions are quite different. We reproduce GM's annotated Figure 1 of the claimed design and annotated cropped Figure 6 below.



GM's annotated cropped Figure 1 of the '625 patent, above left, as compared to Lian's cropped annotated Figure 6, above right. Considering the ordinary designer's perspective, our review of the differences between the designs is consistent with GM's argument referring to Lian's Figure 6 above, that in Lian, "[t]he crease becomes less prominent and disappears as the top surface of the protrusion rotates into a more vertical orientation where it meets the A-pillar." PO Resp. 28 (citing Ex. 2004 ¶ 72).

GM argues persuasively that the U-shaped notches are different because in the claimed design, "the 'u-shaped cutout' has the appearance of a scalloped feature with consistent thickness and smooth curvature." *Id.* In support of this position Mr. Peters explains that "[t]he shape of the scalloped feature thus mimics the upper surface of the protrusion, which likewise has a smooth curvature and a nearly identical thickness. The relatedness of these features again promotes the cohesive overall appearance of the '625 Patent's design." Ex. 2004 ¶ 73. LKQ's declarant, Mr. Hill, likewise testified in his deposition about the U-shaped notch: "[I]t's going to be very significant to

the designer to use that space. Normally that is either a mirror pocket or it's used as a window . . . [s]o it's very significant to a designer to manage that area." Ex. 2008, 18:13–19:3.

We are also persuaded that Lian lacks the inflection line (as LKQ refers to it), i.e., the third crease (as GM calls it), as illustrated below the first and second crease of the claimed design. *See* Ex. 1001, Figs 1, 2. GM's declarant, Mr. Peters, testifies that in the claimed design, "[w]hile subtle, the third crease has significant impact on the overall appearance of the fender in the eyes of the ordinary observer." Ex. 2004 ¶ 77. We appreciate that LKQ's declarant, Mr. Hill, testifies that "the fender of Lian curves convexly to a maximum at approximately the same location on the fender panel as the inflection line of the '625 Patent." Ex. 1004 ¶ 63. However, Mr. Hill's testimony does not explain sufficiently that Lian shows a corresponding visually apparent element. We reproduce, below, a cropped version of Lian's Figure 4.

Shown above is cropped version of Lian's Figure 4, an elevation view of Lian's fender design. Mr. Hill would not commit during his deposition that Lian shows a corresponding crease or line:

> Q. Yeah. There's no line within the red circle on the Lian close-up, is there?
>
> []
>
> THE WITNESS: No. There's the surface, and I can infer the -- the inflection, the wide line.
>
> []
>
> Q. But there's no line like the kind shown in the '625 patent?
>
> []
>
> THE WITNESS: One being a shaded 3D model and one being a line drawing, they -- there is no line in the Lian.

Ex. 2006, 77:3–14. In light of certain general consistencies between the parties' witnesses, we find persuasive Mr. Peters' testimony that Lian "lacks both the appearance provided by the third crease itself, as well as the distinct change between light and dark surface shading associated with the third crease." Ex. 2004 ¶ 78. Whatever nomenclature we give this element in the design, we are not persuaded that the inflection line or third crease, an ornamental feature illustrated in the claimed design, is shown by Lian.

On this record, considering altogether the differences between the overall appearances of the claimed design and the design shown in Lian, LKQ does not establish that Lian "creates 'basically the same' visual impression" as the patented design. The claimed design includes the visually disparate elements discussed above including the upper protrusion, the u-shaped notch, the door cut line, a circular wheel arch, the lower rear terminus, the specific sculpting of the first and second creases along with the

concavity line, and the inflection line below the first and second creases. *See Durling*, 101 F.3d at 103. Neither the Petition nor the Reply, each of which dismisses many of these elements as minor, adequately accounts for these ornamental features of the patented design. *See, e.g.*, Pet. Reply 12 ("Any difference between the door cut lines, such as the 'depth' to which the door advances beyond the U-shaped notch or the height of its apex, is likely too minor for an ordinary observer to even notice." (citing Ex. 1004 ¶¶ 32–34)).

In sum, a preponderance of the evidence supports a conclusion that LKQ fails to identify "a single reference that creates 'basically the same' visual impression" as the patented design. *Durling*, 101 F.3d at 103. That failure provides an independent basis for concluding that LKQ fails to carry its burden of proving that the subject matter of the challenged claim of the '625 patent would have been obvious at the time of the invention.

(d) The Second Step of the Durling Test

Accordingly, for the reasons given above, LKQ fails also to establish by a preponderance of the evidence that the challenged claim is unpatentable based on the ground that asserts Lian as a *Rosen* reference, in combination with 2010 Hyundai Tucson. Pet. 66–76 (asserting Lian as the primary reference in the challenge identified as Ground 3). We need not, therefore, reach the second step of the Durling test because the first step has not been met.

III. CONCLUSION

LKQ has not proved by a preponderance of the evidence that the claim of the '625 patent is anticipated by Lian or would have been obvious over Lian alone or in combination with 2010 Hyundai Tucson.

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1	102	Lian		1
1	103	Lian		1
1	103	Lian and 2010 Hyundai Tucson		1
Overall Outcome				1

IV. ORDER

For the reasons given, it is

ORDERED that, based on a preponderance of the evidence, the claim of the ’625 patent has not been shown to be unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, any party to the proceeding seeking judicial review of this Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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