

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.

PGR2020-00020
Patent D852,099 S

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

PAULRAJ, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background and Summary

Petitioners, LKQ Corporation and Keystone Automotive Industries, Inc. (collectively “Petitioner”), filed a Petition requesting post-grant review of U.S. Patent No. D852,099 S (“the ’099 patent,” Ex. 1001). Paper 2 (“Pet.”). The Petition challenges the patentability of the sole design claim of the ’099 patent. Patent Owner, GM Global Technology Operation LLC (“Patent Owner”), 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

The parties identify various other *inter partes* and post grant review proceedings that Petitioner has filed challenging different patents owned by Patent Owner. The parties do not state that these other proceedings affect, or would be affected by, this proceeding involving the ’099 patent. Pet. 5; Paper 5, 2.

C. The ’099 Patent and Claim

The ’099 patent is titled “Vehicle Grille Bezel,” and issued June 25, 2019, from U.S. Application No. 29/670,195, filed Nov. 14, 2008, which

is a division of U.S. Application No. 29/597,752, filed Mar. 20, 2017.¹ Ex. 1001, codes (21), (22), (45), (54), (62). The claim recites “[t]he ornamental design for a vehicle grille bezel, as shown and described.” *Id.* at code (57). The drawings of the claim depict several views of the claimed grille bezel with certain portions of the design shown as unclaimed by broken lines. *See id.* (“The broken lines in the drawings illustrate portions of the vehicle grille bezel that form no part of the claimed design.”). The ’099 design is depicted in five figures, which are reproduced below.²

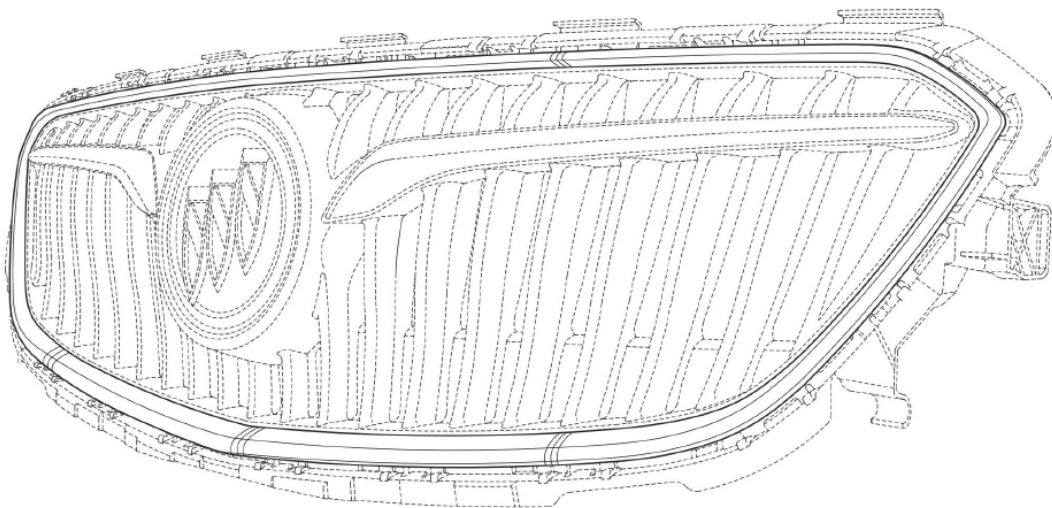


FIG. 1

¹ Because the earliest possible effective filing date for the ’099 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 February 7, 2020, and within 9 months of its issue date, the ’099 patent is eligible for post-grant review. *See* 35 U.S.C. § 321(c).

² We refer to the claim, i.e., the vehicle grille bezel shown in Figures 1–5, also as “the ’099 design.”

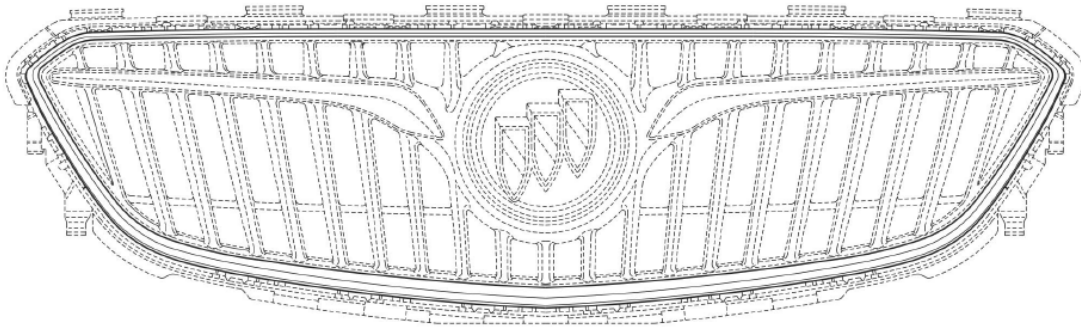


FIG. 2

FIG. 3

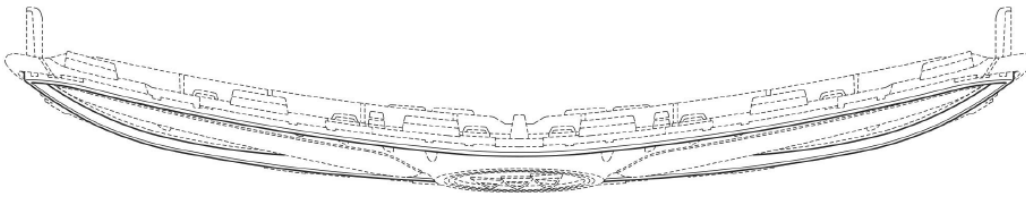
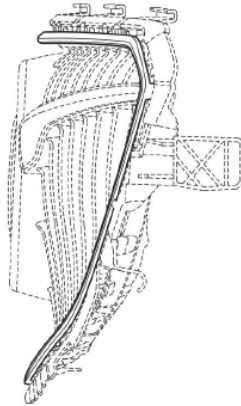


FIG. 4

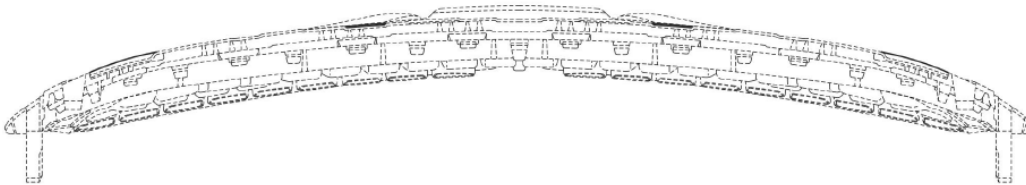


FIG. 5

Ex. 1001. Figures 1–5 above depict, respectively, the following views of the claimed vehicle grille bezel design: a perspective view, a front elevational view, a left side elevation view, a top plan view, and a bottom plan view. *Id.* at code (57).

The parties both describe certain features that contribute to the overall appearance of the claimed design. *See* Pet. 13–18; Prelim. Resp.; *see also* Ex. 1003 ¶¶ 17–19; Ex. 1004 ¶¶ 16–18. Petitioner contends that the claim can be described according to the drawings as shown by the solid lines as

A vehicle grille bezel comprising:

a substantially horizontal top portion terminating in a short, downward-pointing diagonal bezel segment at each end;
and

a substantially u-shaped bottom portion extending from one diagonal bezel segment to the other diagonal bezel segment;

wherein the substantially u-shaped bottom portion further includes a minimum at the center line of the bezel;

and wherein the bezel is horizontally convexly curved, and the bottom of the u-shaped portion is forward of the substantially horizontal portion.

Pet. 15–17.

Patent Owner does not agree with Petitioner’s claim construction. Rather, Patent Owner contends that the proposed “claim construction is insufficient because it focuses on generic design concepts common to many vehicle grille bezels, rather than addressing the particular features of the claimed design.” Prelim. Resp. 15. Patent Owner further contends that Petitioner “ignores or mischaracterizes various distinctive features of the claimed design and fails to analyze all of the view provided by the ’099 patent, ignoring critical features as a result.” *Id.* Patent Owner proceeds to

outline what it considers to be errors in the Petitioner's construction and requests that we deny the Petition as a result of those perceived errors. *Id.* at 14–27.

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. *See* 37 C.F.R. § 42.200(b) (2019). Generally in the context of a design patent, an illustration, rather than a verbal description, is the better representation of the claimed design. “As the Supreme Court has recognized, a design is better represented by an illustration ‘than it could be by any description and a description would probably not be intelligible without the illustration.’” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (quoting *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”).

Here, the overall visual appearance of the vehicle grille bezel design shown in Figures 1–5 of the '099 design is clearly exemplified in the drawings. In other words, the elements and features of the '099 design which contribute to the overall appearance of the design are readily discernable and apparent to any observer. We determine that the best description of the ornamental features of the '099 design comes from the drawings themselves. Accordingly, we determine that no articulated verbal

description is necessary to describe the overall ornamental nature of the '099 design. Nonetheless, we have taken into account Petitioner's verbal description of the design in our analysis, but agree with Patent Owner's contention that Petitioner's verbal description is an incomplete description of the actual design. Although we do not undertake a specific verbal construction, we acknowledge in our following analyses the relevant design characteristics of the '099 design, including key similarities and distinctions in comparison to the prior art. *See MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1332 (Fed. Cir. 2014) (Affirming that a verbal claim construction was unnecessary, the Federal Circuit explained that "the district court did not err by failing to provide an express verbal description of the claimed design; rather, it described the claimed design in the context of comparing it to the prior art.").

D. Asserted Grounds of Unpatentability

Petitioner asserts that the sole design claim of the '099 patent is unpatentable on the following grounds (Pet. 18):

Claim Challenged	35 U.S.C. §	References/Basis
1	171	Patent Exhaustion, Right-of-Repair
1	103	2014 Buick Enclave, ³ 2013 Buick Regal ⁴

³ Ex. 1006–1008, "2014 Buick Enclave" (Pet. vi) (characterized as "archived on April 2, 2014 by Internet Archive organization's 'Wayback Machine.'")

⁴ Ex. 1009–1011, "2013 Buick Regal" (Pet. vi–vii) (characterized as "archived on April 2, 2014 by Internet Archive organization's 'Wayback Machine.'")

Claim Challenged	35 U.S.C. §	References/Basis
1	103	2013 Buick Regal, 2013 Buick Enclave ⁵

Petitioner submits the Declaration of James M. Gandy (Ex. 1003) and the Declaration of Jason C. Hill (Ex. 1004) in support of its arguments.

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.”). This 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).

⁵ Ex. 1012, “2013 Buick Enclave” (Pet. vii) (characterized as “archived on April 2, 2014 by Internet Archive organization’s ‘Wayback Machine.’”)

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*, 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 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. 31 (citing Ex. 1003 ¶¶ 37–42; Ex. 1004 ¶¶ 35–42). Patent Owner argues, without citation to evidence, that:

[a] designer of ordinary skill in the art relevant to the '099 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. 10. 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 declarants, we adopt Petitioner's proposed definition of the ordinary designer. Also, we point out that adopting Patent Owner's definition would not alter the outcome of this Decision.

C. The Ordinary Observer

Both parties also offer definitions of an "ordinary observer." Pet. 33–34; Prelim. Resp. 6–9. The "ordinary observer" test is one that arises in the context of either (1) anticipation of a claim of a design patent by prior art, or (2) infringement of the patented design by an accused product design. *See Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238, 1240 (Fed. Cir. 2009). Neither anticipation nor infringement is relevant to this proceeding, which is premised on proposed grounds of unpatentability based on obviousness. The ordinary observer test, however, is not without some role in connection with contentions of obviousness. To that end, the Federal Circuit has stated the following:

For design patents, the role of one skilled in the art in the obviousness context lies only in determining whether to combine earlier references to arrive at a single piece of art for comparison with the potential design or to modify a single prior art reference. Once that piece of prior art has been constructed, obviousness, like anticipation, requires application of the ordinary observer test, not the view of one skilled in the art.

Int'l Seaway Trading Corp., 589 F.3d at 1240.

According to Petitioner, “the ordinary observer would be the retail consumer of an automobile.” Pet. 33 (citing Ex. 1003 ¶ 36; Ex. 1004 ¶ 34). Neither Petitioner, nor its declarants, provide evidentiary support for the assessment of an ordinary observer or further elaborate as to who may qualify as a retail consumer of an automobile.

Patent Owner generally does not agree with Petitioner’s position as to the ordinary observer. Prelim. Resp. 6–9. Patent Owner contends that the position is “unsupported.” *Id.* at 9. Patent Owner argues that “the ordinary observer includes commercial buyers who purchase a replacement vehicle grille bezel[] to repair a customer’s vehicle, such as repair shop professionals.” *Id.* at 7. Patent Owner also contends that Petitioner has admitted in a related proceeding (IPR2020-00065) that “customers for aftermarket automotive parts primarily consist of professional auto body and mechanical repair shops who are knowledgeable about the automotive industry.” *Id.* at 8 (quoting IPR2020-00065, Paper 2, 21) (emphasis omitted). Patent Owner points out that “[b]ecause a repair shop buyer reviews and analyzes various products as part of his or her job duties, that buyer is particularly discerning.” *Id.*; Ex. 2004, 11 (“LKQ’s customers for aftermarket automotive parts primarily consist of professional auto body and

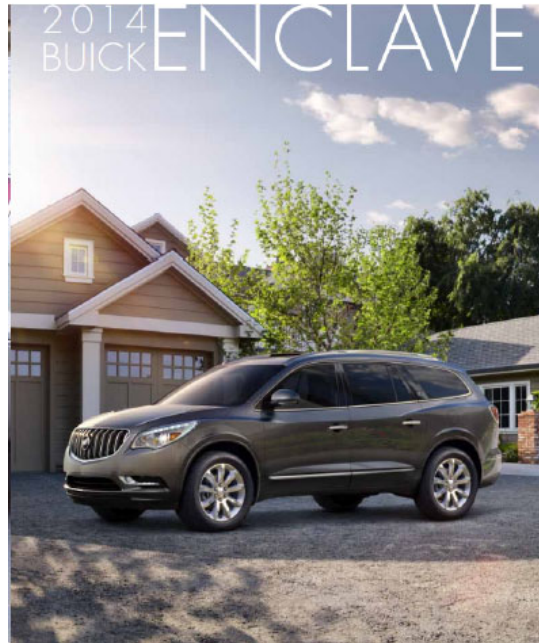
mechanical repair shops who are knowledgeable about the automotive industry.”) (Emphasis omitted).

Patent Owner has presented credible argument and evidence as to why the ordinary observer would be a repair shop professional. The evidence, however, also reveals that a retail consumer, such as the owner of a vehicle, may also be in the position of an ordinary observer. A vehicle owner may have a contract with its insurance agent which “require the insurer to repair vehicles with parts of ‘like kind and quality’ to the OEM parts.” Ex. 2004, 14, *see also id.* at 11 (“Automobile owners seek to repair their automobiles in a way that returns their automobile as closely as possible to its original appearance and condition.”). For purposes of this Decision we accept that both parties’ definitions fall within the purview of an ordinary observer. Our analysis reaches the same result using either parties’ definition of the ordinary observer.

D. Overview of the Prior Art

1. Overview of the 2014 Buick Enclave

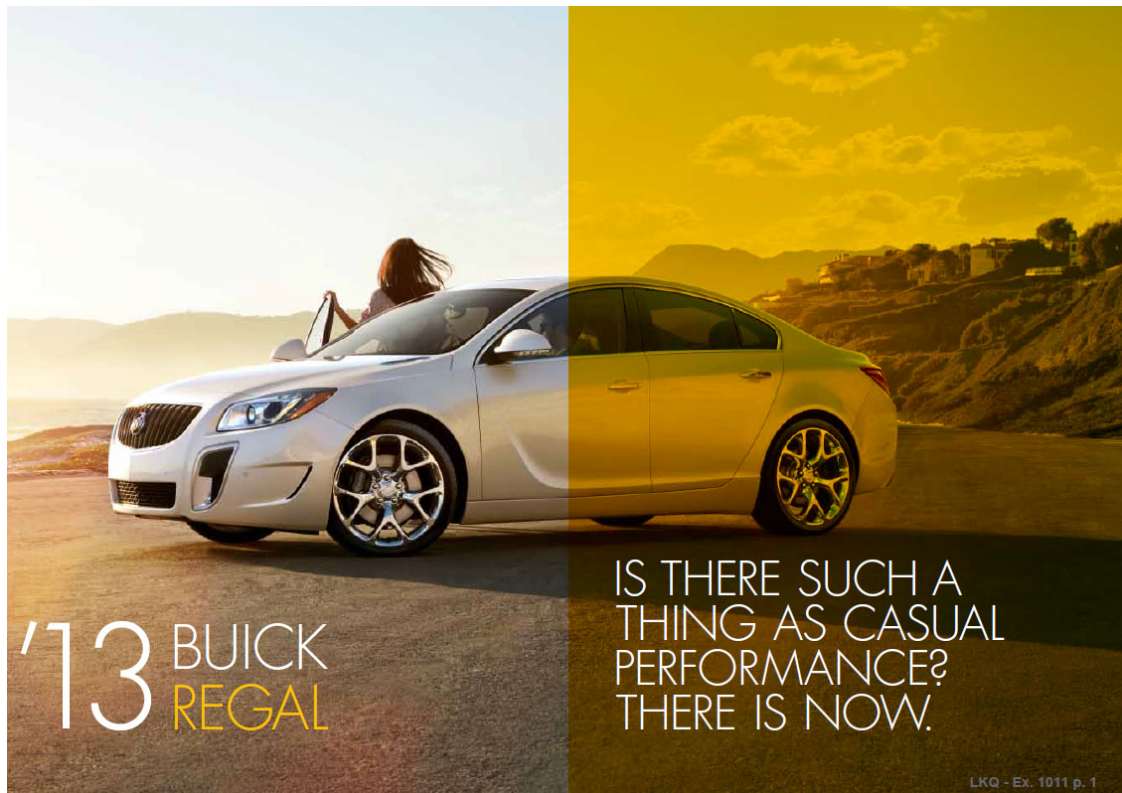
Petitioner relies upon the 2014 Buick Enclave, as depicted in several marketing brochures (Exs. 1006–1008), as the primary reference for its first obviousness challenge (Ground 2). Photographs from Exhibit 1006 and Exhibit 1007 are reproduced below.



Ex. 1006, 1; Ex. 1007, 1. The image on the left above is understood to be front perspective view of the 2014 Buick Enclave, including its grille bezel. The image on the right above is understood to be a side view of the 2014 Buick Enclave, including its grille bezel.

2. *Overview of the 2013 Buick Regal*

Petitioner also relies upon the 2013 Buick Regal, as presented in several marketing brochures (Ex. 1009–1011), for both its obviousness challenges. Photographs from Exhibit 1009 and Exhibit 1010 are reproduced below.



Ex. 1009, 1; Ex. 1010, 1. The top image above is understood to be front perspective view of the 2013 Buick Regal, including its grille bezel. The bottom image above is understood to be a side view of the 2013 Buick Regal, including its grille bezel.

3. *Overview of the 2013 Buick Enclave*

Petitioner relies upon the 2013 Buick Enclave, as depicted in several brochures (Exs. 1012–1013), as the secondary reference for its second

obviousness challenge (Ground 3). Photographs from Exhibits 1012 and 1013 are reproduced below:



Ex. 1012, 1; Ex. 1013, 2. The top image above is understood to be front perspective view of the 2013 Buick Enclave, including its grille bezel. The bottom image above is understood to be a side view of the 2013 Buick Enclave, including its grille bezel.

E. Alleged Obviousness of the Claim Based on 2014 Buick Enclave and 2013 Buick Regal (Ground 2)

Petitioner asserts that Patent Owner’s 2014 Buick Enclave is a proper primary reference, *i.e.*, a “*Rosen*”⁶ reference, because it has “basically the same overall visual appearance as the claimed design for a vehicle grille bezel in the ’099 Patent, which makes Patent Owner’s 2014 Buick Enclave a proper primary, *Rosen* reference.” Pet. 41 (citing Ex. 1003 ¶ 49; Ex. 1004 ¶ 49; *Durling*, 101 F.3d at 103). Specifically, Petitioner asserts

Patent Owner’s “2014 Buick Enclave and the claimed design in the ’099 Patent share the following design elements:

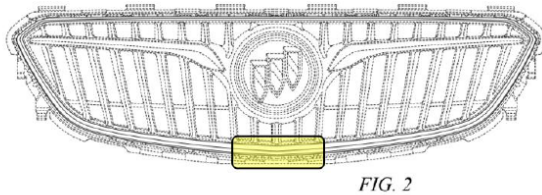
1) the same overall shape and dimensions; ... 2) a substantially horizontal top portion terminating in a short, downward-pointing diagonal bezel segment at each end; ... 3) a substantially u-shaped bottom portion extending from one diagonal bezel segment to the other diagonal bezel segment; ... 4) wherein the substantially u-shaped bottom portion further includes a minimum at the center line of the bezel; ... 5) and wherein the bezel is horizontally convexly curved, and the bottom of the u-shaped portion is forward of the substantially horizontal portion.

Pet. 42–44. In support of this assertion, Petitioner provides side-by-side comparisons of the figures shown in the ’099 Patent with images of the 2014 Buick Enclave, with the common features color-coded. *See id.* For example, Petitioner depicts how the substantially u-shaped bottom portion of the bezel of each of the ’099 Patent and the 2014 Buick Enclave includes a minimum at the center line of the bezel, as seen below.

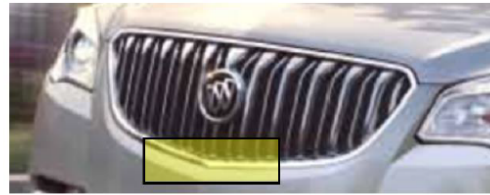
⁶ In the context of design patent law, a proper primary reference for the obviousness analysis is “a reference, a something in existence, the design characteristics of which are basically the same as the claimed design.” *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982).



**'099 Patent
(Challenged Patent)**



**GM's 2014 Buick Enclave
(Primary Reference)**

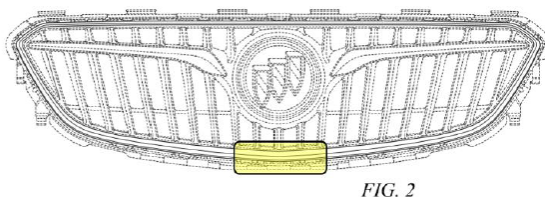


The image above is offered by Petitioner to compare an annotated copy of Figure 2 of Exhibit 1001 to a cropped and annotated image of the bezel from page 1 of Exhibit 1006. *Id.* at 44.

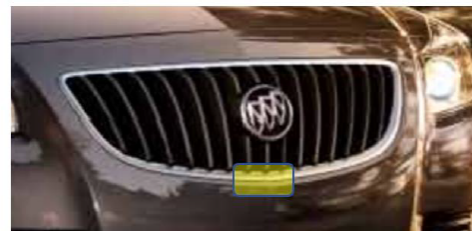
According to Petitioner, the only difference between Patent Owner's 2014 Buick Enclave and the claimed design of the '099 Patent is that the "2014 Enclave's center line minimum is slightly sharper than the minimum of the '099 Patent." *Id.* at 45 (citing Ex. 1003 ¶¶ 52–53; Ex. 1004 ¶ 51). Petitioner contends that the "softening" of the center minimum line is readily provided by the 2013 Buick Regal. *Id.* A copy of Petitioner's side-by-side comparison allegedly depicting this feature is reproduced below.

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**'099 Patent
(Challenged Patent)**



**GM's 2013 Buick Regal
(Secondary Reference)**



The image above is offered by Petitioner to compare an annotated copy of Figure 2 of Exhibit 1001 to a cropped and annotated image of the bezel from page 1 of Exhibit 1009. *Id.* at 45.

Petitioner reasons that a designer of ordinary skill would have been motivated to combine the ornamental components of the 2014 Buick Enclave vehicle grille bezel with those of the 2013 Buick Regal “to create a softer appearance in the vehicle and as part of the natural evolution of the overall appearance of the Buick line and in conformity with other vehicle makes produced by Patent Owner.” *Id.* at 46 (citing Ex. 1003 ¶ 56; Ex. 1004 ¶ 53).

In its Preliminary Response, Patent Owner contends that Petitioner’s assertion that the appearance of the ’099 Patent is substantially identical to the 2014 Buick Enclave is deficient because the Petition “does not compare the side view shown in Figure 3 of the ’099 Patent to any such side view of the vehicle grille bezel of the 2014 Buick Enclave that shows the rear portion of the design.” Prelim. Resp. 27. In that respect, Patent Owner argues the following:

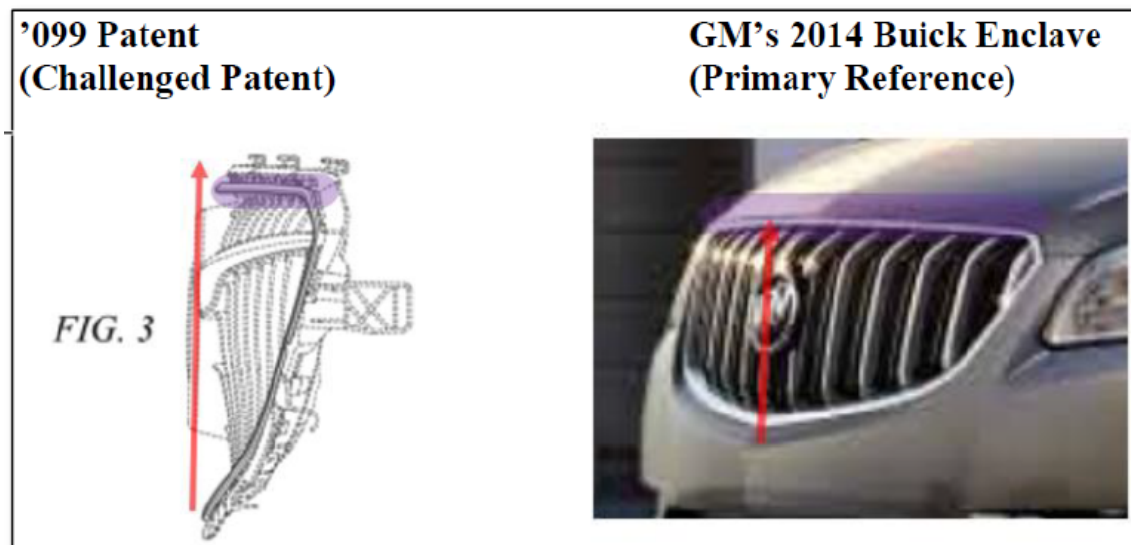
LKQ merely shows an angled perspective view of the *front* of the vehicle (reproduced below). This view of the 2014 Buick Enclave does not show a side view of the grille, and fails to show the specific lines and angles that form the rear portion of the 2014 Buick Enclave’s grille. This shortcoming also results in a failure to show that the 2014 Buick Enclave includes a vehicle grille bezel where “the bottom of the u-shaped portion is forward of the substantially horizontal portion,” as required by LKQ’s own claim construction.

Id. at 28 (citations omitted). Patent Owner argues that Petitioner “impermissibly ignores the full three-dimensionality of the claimed design.” *Id.* at 29.

We have considered the arguments and evidence of record and determine that Petitioner has not met the threshold showing necessary to support trial institution with respect to this obviousness ground. In

particular, we agree with Patent Owner that Petitioner's analysis is deficient insofar as it fails to sufficiently consider the claimed design from the side perspective as shown in Figure 3 of the '099 patent.

The only photograph that Petitioner relies upon to show how the grille bezel of the 2014 Buick Enclave allegedly meets the claimed design from the side does not adequately show the features depicted in Figure 3. Petitioner provides a side-by-side comparison of Figure 3 of the '099 Patent with the 2014 Buick Enclave, as reproduced below.



The image above is offered by Petitioner to compare Figure 3 of Exhibit 1001 to page 1 of Exhibit 1007 to allegedly show that “the bezel is horizontally **convexly curved**, and the **bottom of the u-shaped portion is forward of the substantially horizontal portion.**” Pet. 44–45 (color in original). However, that photograph shows more of the front than the side of the grille bezel. It is not clear from the comparison photograph provided whether “the bottom of the u-shaped portion is forward of the substantially horizontal portion,” as required by Petitioner's own textual claim

construction. It is also not clear from the photograph that the “short, downward-pointing diagonal bezel segment at each end” as described in Petitioner’s textual construction extends backward from the “horizontal top portion” to meet the top end of the “substantially u-shaped bottom portion.” Petitioner does not explain why the ordinary observer would not have considered these features from the side perspective in determining the overall visual impression created by the claimed design. We agree with Patent Owner that Petitioner impermissibly ignores the full three-dimensionality of the claimed design.

For the foregoing reasons, we conclude that Petitioner has not met its burden of demonstrating that it is more likely than not that the challenged claim is unpatentable based on the 2014 Buick Enclave and the 2013 Buick Regal.

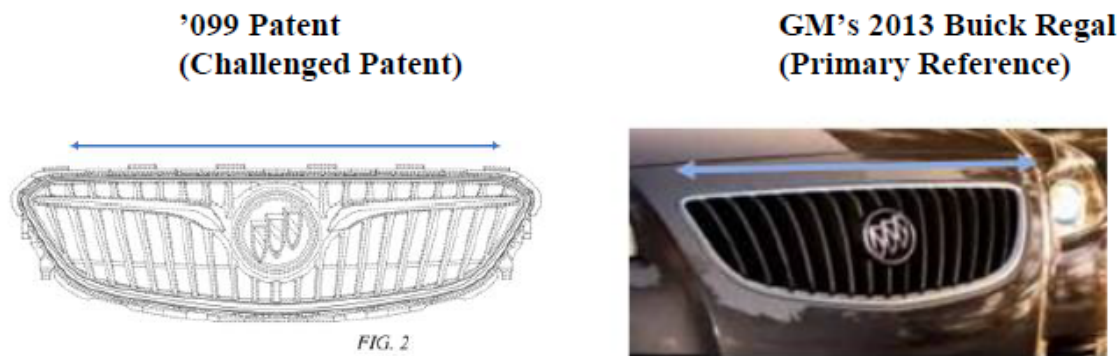
F. Alleged Obviousness of the Claim Based on 2013 Buick Regal and 2013 Buick Enclave (Ground 3)

Petitioner also contends that the ’099 design would have been obvious based on the 2013 Buick Regal and the 2013 Buick Enclave. Pet. 47–55. For this obviousness ground, Petitioner asserts that Patent Owner’s 2013 Buick Regal (discussed above as a secondary reference) can also be a proper primary (*Rosen*) reference insofar as it includes a vehicle grille bezel with basically the same overall visual impression as the claimed design. *Id.* at 47, 49 (citing Ex. 1003 ¶ 63; Ex. 1004 ¶¶ 62, 64; *Durling*, 101 F.3d at 103). Specifically, Petitioner asserts the ’099 Patent and Patent Owner’s 2013 Buick Regal share the following design characteristics:

- 1) the same overall shape and dimensions; ... 2) a substantially horizontal top portion; ... 3) a substantially u-shaped bottom portion; ... 4) wherein the substantially u-shaped bottom portion

further includes a minimum at the center line of the bezel; ... 5) and wherein the bezel is horizontally convexly curved, and the bottom of the u-shaped portion is forward of the substantially horizontal portion.

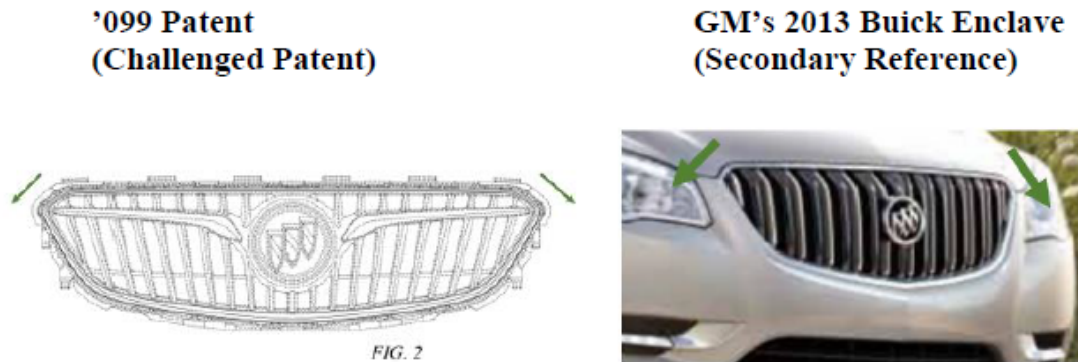
Pet. 50–52. In support of this assertion, Petitioner provides side-by-side comparisons of the figures shown in the '099 Patent with images of the 2013 Buick Regal, with the common features color-coded. *See id.* . For example, Petitioner depicts how the substantially u-shaped bottom portion of the bezel of each of the '099 Patent and the 2013 Buick Regal includes a substantially horizontal top portion, as seen in the side-by-side comparison below.



The image above is offered by Petitioner to compare an annotated copy of Figure 2 of Exhibit 1001 to a cropped and annotated image of the bezel from page 1 of Exhibit 1009. *Id.* at 50.

According to Petitioner, the only difference between Patent Owner's 2013 Buick Regal and the claimed design of the '099 Patent is that “[t]he horizontal top portion of the '099 Patent terminates in short, downward-pointing diagonal bezel segments at each end, whereas the 2013 Buick Regal's horizontal top portion connects directly to the u-shaped bottom portion without intervening diagonal bezel segments.” *Id.* at 52 (citing Ex. 1003 ¶ 66; Ex. 1004 ¶ 64). Petitioner contends that this missing design

element is readily supplied by Patent Owner's 2013 Buick Enclave and is common to numerous Buick models. *Id.* at 52–53 (citing Ex. 1003 ¶¶ 67–69; Ex. 1004 ¶¶ 65–68). A copy of Petitioner's side-by-side comparison allegedly depicting this feature is reproduced below.



The image above is offered by Petitioner to compare an annotated copy of Figure 2 of Exhibit 1001 to a cropped and annotated image of the bezel from page 1 of Exhibit 1012. *Id.* at 53.

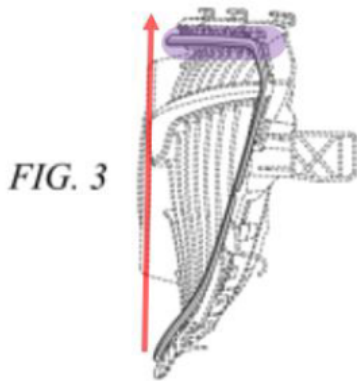
Petitioner reasons that a designer of ordinary skill would have been motivated to combine the ornamental components of the 2013 Buick Enclave vehicle grille bezel with those of the 2013 Buick Regal “to create a more traditional appearance in the vehicle and as part of the natural evolution of the overall appearance of the Buick line and in conformity with other vehicle makes produced by Patent Owner.” *Id.* at 53–54 (citing Ex. 1003 ¶ 71; Ex. 1004 ¶ 70). Petitioner contends that “a hypothetical prior art created by combining the base of Patent Owner's 2013 Buick Regal with the diagonal bezel segments of Patent Owner's 2013 Buick Enclave would have an overall appearance that is the same as the '099 Patent.” *Id.* at 54 (citing Ex. 1003 ¶ 73; Ex. 1004 ¶ 73).

In its Preliminary Response, Patent Owner contends that, as with Ground 2, Petitioner “fails to fully analyze the side views of the claimed

design that show the rear portion and profile of the vehicle grille bezel.”
Prelim. Resp. 36–37.

We agree with Patent Owner that Petitioner’s showing based on the 2013 Buick Regal and 2013 Buick Enclave under Ground 3 fares no better than the one discussed above with respect to Ground 2. Petitioner provides a side-by-side comparison of Figure 3 of the ’099 Patent with the 2013 Buick Regal, as reproduced below.

**’099 Patent
(Challenged Patent)**



**GM’s 2013 Buick Regal
(Primary Reference)**



The image above is offered by Petitioner to compare Figure 3 of Exhibit 1001 to page 1 of Exhibit 1010 to once again allegedly show that “the bezel is horizontally **convexly curved**, and the **bottom of the u-shaped portion is forward of the substantially horizontal portion.**” Pet. 52 (color in original). However, as with the comparison photograph of the 2014 Buick Enclave in Ground 2, Petitioner’s comparison of the side view shown in Figure 3 to the 2013 Buick Regal in this ground does not show sufficiently that “the bottom of the u-shaped portion is forward of the substantially horizontal portion,” as required by Petitioner’s own textual claim construction. Furthermore, although Petitioner relies upon the 2013 Buick Enclave for incorporating

diagonal bezel segments at each end, Petitioner does not explain how the combination of the prior art designs would result in the “diagonal bezel segment at each end” extending backwards from the “horizontal top portion” to meet the top end of the “substantially u-shaped bottom portion.” As noted above, Petitioner does not explain why the ordinary observer would not have considered these features from the side perspective in determining the overall visual impression created by the claimed design. Thus, Petitioner again impermissibly ignores the full three-dimensionality of the claimed design in its analysis for this ground.

For the foregoing reasons, we conclude that Petitioner has not met its burden of demonstrating that it is more likely than not that the challenged claim is unpatentable based on the 2013 Buick Regal and the 2013 Buick Enclave.

G. Assertion that the '099 Patent is Unpatentable Because it is a Partial-Product Patent which Violates the Doctrine of Exhaustion and the Repair Rights of Patent Owner's Customers

In addition to the obviousness grounds present in the Petition, Petitioner contends that the '099 Patent should be found unpatentable because “it is a design applied to a functionless component part of a functional whole, and therefore empowers Patent Owner and other OEMs with the ability to improperly subvert the exhaustion doctrine and prevent consumers from exercising their right to repair their own vehicles.” Pet. 34–35. Petitioner is of the view that a design patent can only be issued for a complete article, not a part or sub-part. *Id.* at 35.

Patent Owner, by contrast, contends that the law permits design patents on particular vehicle components. Prelim. Resp. 10 (citing *Automotive Body Parts Ass'n v. Ford Global Techs.*, 930 F.3d 1314, 1325

(Fed. Cir. 2019). Patent Owner contends, moreover, that “[e]xhaustion is not an invalidity ground, but rather, an affirmative defense to patent infringement,” and that “right of repair is a related doctrine and similarly is not an invalidity ground.” *Id.* at 11–12. Patent Owner also contends that because the doctrine of exhaustion and right of repair are not permitted grounds for post-grant review, they cannot serve as a basis for invalidity in this proceeding. *Id.* at 12 (citing 37 C.F.R. §42.204). Patent Owner also asserts that because the facts in *Automotive Body Parts* and the present case are similar, the outcome should be similar that “there is no exhaustion.” *Id.* at 13 (citing *Automotive Body Parts*, 930 F.3d at 1322). Patent Owner likewise asserts that the right of repair arguments should be rejected. *Id.* at 14.

We determine that Petitioner’s subversion theory arguments assertions are insufficiently legally, and factually underdeveloped to sufficiently support this ground. It appears that Petitioner is making more of a policy argument as to why design patents should not extend to automotive body parts rather than relying upon any particular statutory basis for unpatentability. *See* 37 C.F.R. § 42.204 (requiring Petitioner to identify “[t]he specific statutory grounds permitted under 35 U.S.C. 282(b)(2) or (3) on which the challenge to the claim is based”). Petitioner contends that design patents are limited to an “article of manufacture” under 35 U.S.C. § 171 and the “original meaning of an ‘article of manufacture’ was an article that was complete in itself, and not a part or sub-part of something that needed further assembly to be functional.” Pet. 35. The Supreme Court, however, has more recently interpreted the term “article of manufacture,” as used in 35 U.S.C. § 289, to encompass both a product sold to a consumer

and a component of that product. *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 434–435 (2016) (noting that the fact that “a component may be integrated into a larger product . . . does not put it outside the category of articles of manufacture.”). The Court also noted that this reading of article of manufacture in § 289 is consistent with how “[t]he Patent Office and courts have understood § 171 to permit a design patent for a design extending to only a component of a multicomponent product.” *Id.* at 435 (citations omitted). The Federal Circuit has likewise recognized that design patents for auto-body components are permissible under § 171. *See Automotive Body Parts Association*, 930 F.3d at 1325 (“Ford chose to claim designs as applied to portions of particular components, and the law permits it to do so.”). Petitioner does not address this case law in the Petition.

Accordingly, we conclude that Petitioner has not met its burden of demonstrating that it is more likely than not that the challenged claim is unpatentable based on this ground.

III. CONCLUSION

Petitioner has not demonstrated that that it is more likely than not that the challenged design claim of the '099 patent is unpatentable based on the challenges presented.

IV. ORDER

For the foregoing reasons, it is

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

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