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Paper No. 39
Entered: April 15, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

GM GLOBAL TECHNOLOGY OPERATIONS LLC,
GM,
Patent Owner.

IPR2020-00064
Patent D823,741 S

Before JOSIAH C. COCKS, SCOTT A. DANIELS, and ROBERT L. KINDER, *Administrative Patent Judges.*

DANIELS, *Administrative Patent Judge.*

JUDGMENT
Final Written Decision
Determining The 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. D823,741 (Ex. 1001, "the '741 patent"). Paper 2 ("Pet."). GM Global Technology Operations, Inc., ("GM") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). LKQ requested, and we authorized, a Preliminary Reply to the Preliminary Response. Paper 10 ("Reply"). We entered a Decision instituting an *inter partes* review of the challenged claim in this proceeding. Paper 13 ("Inst. Dec."). GM timely filed a Response. Paper 16 ("PO Resp.") LKQ filed a Reply. Paper 28 ("Pet. Reply"). GM subsequently filed a Sur-Reply. Paper 34 ("PO Sur-Reply"). We heard oral argument on January 28, 2021. A transcript of the argument has been entered into the record. Paper 38 ("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 demonstrated by a preponderance of the evidence that the sole claim of the '741 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, this proceeding involving the '741 patent. Pet. 4–5; Paper 4.

C. The '741 Patent and Claim

The '741 patent (Ex. 1001) issued July 24, 2018, 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 illustrated in solid lines but with certain portions, which appear to be mainly functional attachment points, shown in dashed lines. *Id.* at code (54); *see* 37 C.F.R. § 1.152, *see also* MPEP § 1503.02, subsection III (9th ed. rev. 10.2019 June 2020) ("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.").

1. The Claim

The '741 design includes Figures 1–4, reproduced below, illustrating the claimed front fender as set forth below.[1]

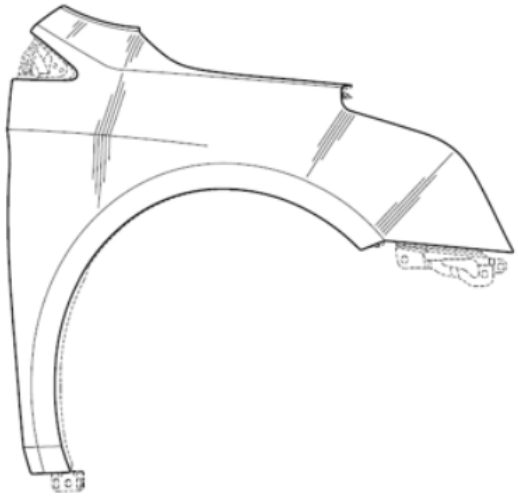


FIG. 1

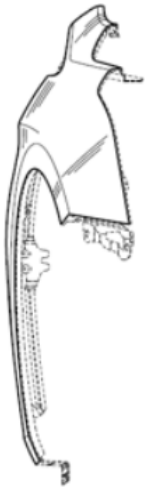


FIG. 2

[1] We refer to the claim, i.e., the vehicle front fender shown in Figures 1–4, also as "the '741 design."

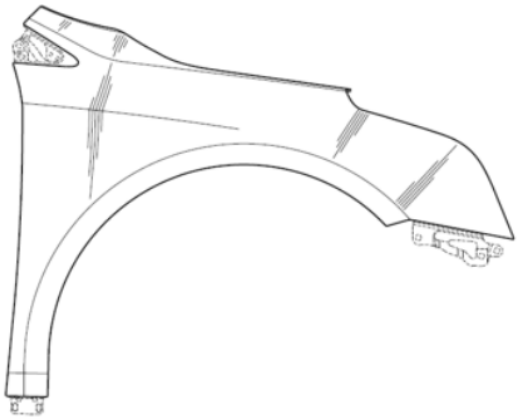


FIG. 3

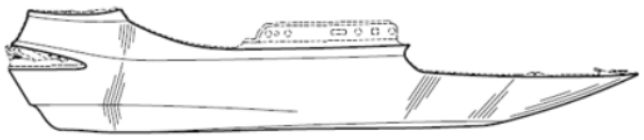


FIG. 4

Ex. 1001. Figures 1–4 above illustrate, respectively, the following views of the claimed vehicle rear bumper design: a perspective view, a front view, a side elevation view, and a top view. *Id.* at code (57). The Description of the invention explains, "[t]he broken lines shown in the drawings depict portions of the vehicle front fender that form no part of the claimed design." *Id.* at Description. *See* 37 C.F.R. § 1.152.

2. The Claim Construction Standard

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.

Phillips v. AWH Corp., 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (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." *Egyptian Goddess*, 543 F.3d 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").

3. LKQ's Proposed Claim Construction

LKQ contends that the claim of the '741 patent can be described according to the drawings as shown by the solid lines as

> [a] vehicle front fender comprising:
>
> a substantially vertical side including an intermittent u-shaped notch near a top of the fender;
>
> the top of the fender including a top protrusion near the intermittent, u-shaped notch, the top of the fender sloping down and away from the substantially vertical side to a curved, distal portion;
>
> a crease in a surface of the fender extending from the substantially vertical side and in the general direction of the curved, distal portion; and
>
> a wheel arch between the curved, distal portion and a bottom of the fender, wherein the wheel arch is connected to an edge of the curved, distal portion at an obtuse angle.

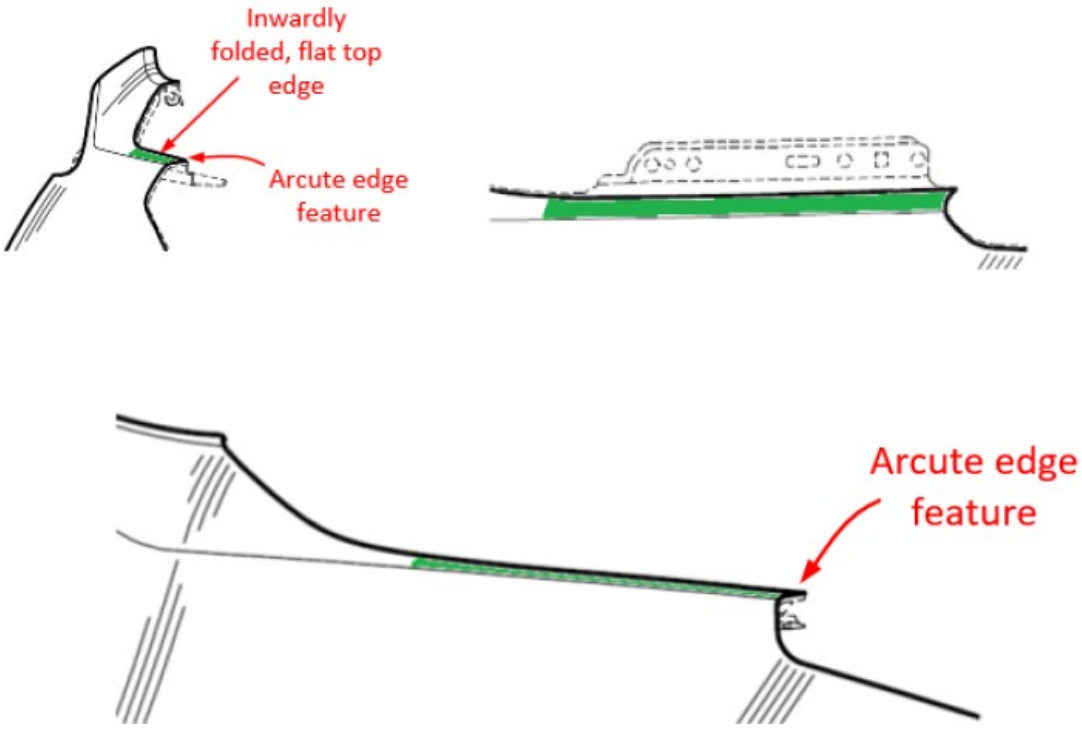
Pet. 12–14 (emphasis omitted).

4. GM's Proposed Claim Construction

GM contends that LKQ's claim construction is superficial and does not present an accurate visual image of the design. PO Resp. 2. GM proposes a more detailed construction arguing that the "design includes a

unique top edge shape, overall profile, and nuanced divergent sculpting of its surfaces. Each of these features contributes to the overall appearance of the claimed design." *Id.* (citing Ex. 2004 ¶¶ 26–50 (Peters declaration)). Summarized below are four aspects of the fender design which GM argues require more detailed consideration. *Id.* at 2–13.

First, GM asserts that the design includes a "substantially parallel top edge" and an "arcuate edge feature." *Id.* (citing Ex. 2004 ¶ 38). GM's annotated portions of Figures 2, 4, and 6 illustrating the parallel top edge in green, and the arcuate edge feature are reproduced below.



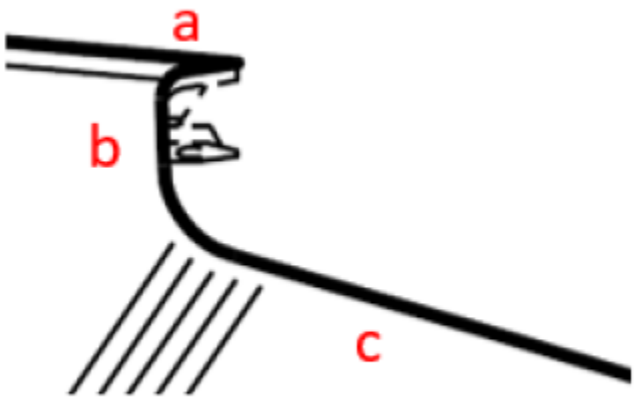
Portions of Figures 2, 4, and 6 of the '741 design as annotated by GM are shown above illustrating the top edge and arcuate edge features. Referring to annotated Figure 1 of the '741 patent, reproduced below, GM argues that the arcuate edge feature is a prominent element of the design and includes:

(i) an inwardly folded, linear top edge *a*;

(ii) a sharp, downwardly sloped edge *b*; followed by

(iii) a gradual, downwardly sloped edge *c*.

Id. at 3 (citing Ex. 2004 ¶ 39).



Perspective view

Annotated partial Figure 1 is shown above illustrating GM's annotated parts a, b, and c, of the arcuate edge feature.

Second, according to GM's annotated Figure 4 reproduced below, the perimeter shape of the '741 design "narrows as it extends from the rear end to the front tip." *Id.* at 6.

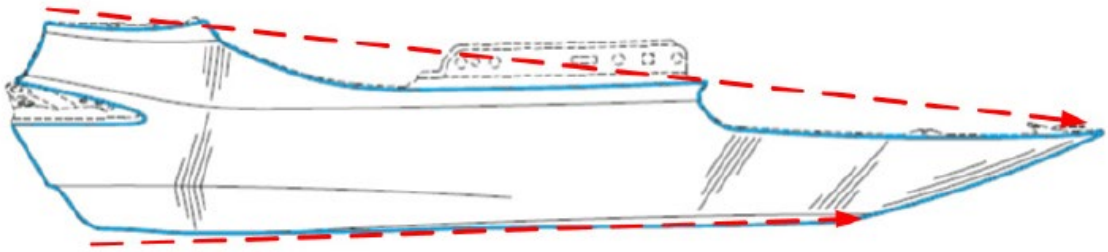


Figure 4 of the '741 patent, above, as annotated by GM illustrates a narrowing profile from rear to front. Also, GM points out that in Figure 4 a portion of the wheel arch can be observed due to the surface contours of the

fender body as shown in another annotated view of Figure 4 reproduced below. *Id.* at 6–7.

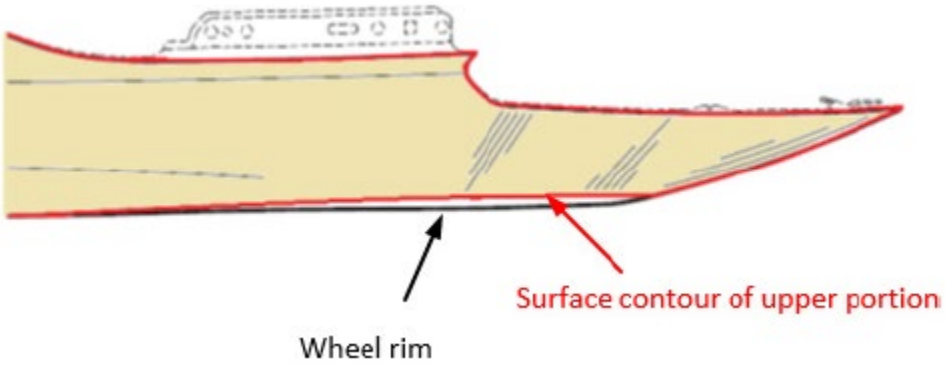


Figure 4 of the '741 patent, above, as annotated by GM, illustrates the wheel arch, i.e. rim, relative to the upper surface contour of the fender.

Third, GM argues that the front of the fender includes "a unique distal portion shape that is prominent and significant in its impact on the overall appearance of the vehicle front fender." *Id.* at 7 (citing Ex. 2004 ¶ 43). GM provides an annotated portion of Figure 3, reproduced below.

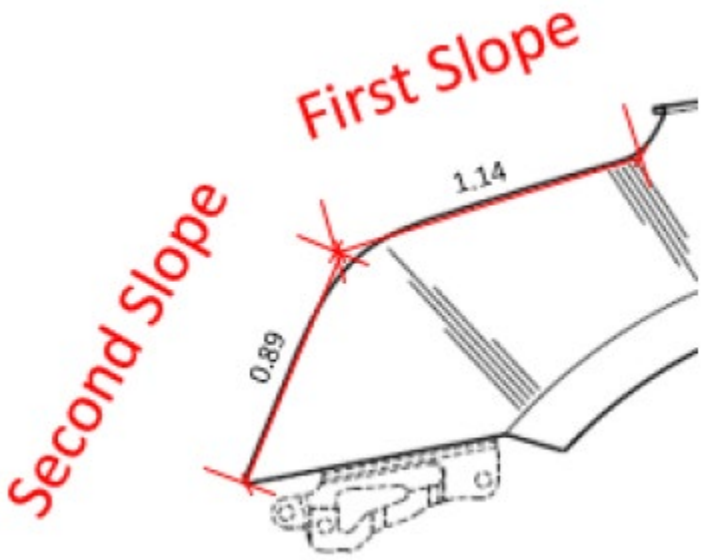


Fig. 3 of the '741 patent, above, as annotated by GM, depicts a first slope which GM argues "is approximately 30% longer than the" second slope which leads to a pointed edge. *Id.* at 8–9.

Fourth, GM argues that the '741 design includes a "character line," what LKQ refers to as the "crease," and that "the top view shape of the character line shows that it is divergent (*i.e.*, not parallel) with respect to all of the surrounding edges (highlighted in blue and yellow) as shown in Figure 4, as annotated by GM and reproduced below. *Id.* at 10–11.

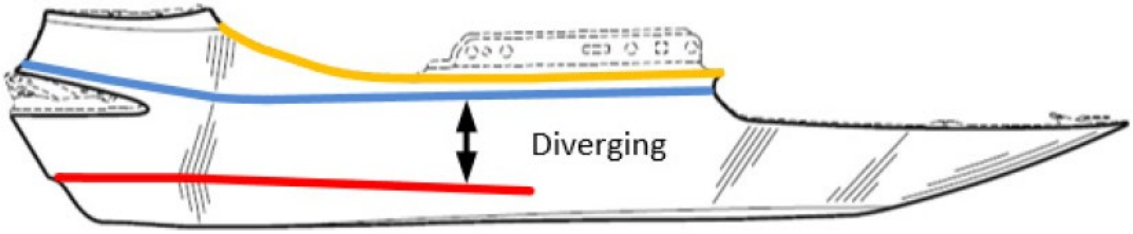


FIG. 4

Figure 4, as annotated by GM above, depicts the red character line as "diverging" from surrounding edges shown in blue and yellow. GM also argues that the character line is formed by a convex surface of the fender. *Id.* GM relies upon its declarant, Mr. Peters, who testifies that

> [t]he character line is a critical feature of car design because it sets the tone for the proportions and the basic body shape of not only the fender, but also of many vehicle parts attached to the fender, such as the front portion of the vehicle such as the bumper, head lights, side panels, as well as rear portions of the vehicle, such as side panels and rear bumper.

Ex. 2004 ¶ 48. Mr. Peters also points out that "the inflection line (highlighted in blue) is a crease that extends from the claimed design's rear lateral edge to its arcuate edge feature." *Id.* ¶ 49. GM contends that overall

"[e]ach of these features contributes to the overall appearance of the claimed design. PO Resp. 2 (citing Ex. 2004 ¶¶ 26–50).

In addition, GM argues that the nuances discussed above are important, and "become even more significant when assessing those nuances in view of the crowded art." *Id.* at 13. GM argues that "[t]he field of fender designs is a crowded one." *Id.* at 15. In support of this position, GM lists 22 patents that depict fender designs. GM argues that when looking at fenders, "a skilled designer would focus not on the generic commonalities, but on the nuanced differences between the designs." *Id.* at 17.

5. The Claim Construction Analysis

We address initially the particular argument made by GM that vehicle fender designs is a crowded art. 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 *In re Harvey*. *In re Harvey*, 12 F.3d 1064. We appreciate that the idea, or theory, of "crowded art" would be helpful for GM in this proceeding because if the vehicle fender field is considered to be crowded than the supposition is that small or "nuanced" differences in the claimed design become even more important. We are not persuaded, however, that on the record now before us GM has provided sufficient facts or evidence for the Board to determine that vehicle fender design is a crowded art.

The "crowded art" concept is highly fact dependent. What is before us is evidence of twenty-two design patents for vehicle fenders. PO Resp.

15; Ex. 1001, code (56). Although we suspect without doing a search ourselves that there is more prior art, we are not prepared in this proceeding to find that the field of fender design is specifically a crowded art simply because there exist at least 22 vehicle fender design patents. Moreover, to the extent *In re Harvey* is applicable here, it is more than likely that vehicle fenders would be considered fairly contemporaneous with loud speaker design, as compared to vases, which have been arguably 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 3/31/2021 at http://web.a.ebscohost.com/ehost/pdfviewer/ pdfviewer? vid= 1&sid=b88ee19b-40c8-4c27-aca9 af3c0f61d645%40 sessionmgr4007 (Explaining that "[a] large number of Ancient Greek vases dated to the 1st millennium BC contain short inscriptions).

Although we do not determine that the facts and evidence in this case support a finding that vehicle fenders are a crowded art, we do agree with GM "that the 'ordinary observer is considered to be familiar with prior art designs."' PO Resp. 14 (citing *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Access., Inc.*, 942 F.3d 1119, 1129 (Fed. Cir. 2019). For determining obviousness we use the ordinary designer, rather than the ordinary observer, and further agree with GM that "familiarity with the prior art designs would be equally applicable—if not more applicable—to the ordinary designer." *Id.* We find Mr. Peters' testimony persuasive when he explains that "[a] designer of ordinary skill would be both familiar with prior art designs and attuned to small differences." Ex. 2004 ¶ 52. Similarly,

LKQ's declarant, Mr. Hill, agreed in his deposition that an ordinary designer would notice nuances and small differences:

> Q. [] You would agree with me that ordinary designers of fenders will observe small differences between fenders?
>
> . . .
>
> A. Ordinary designers in the skilled art would observe lots of little nuances and differences, yes.

Ex. 2013, 15:23–15:3.

We determine that there is a middle road here for claim construction. What both parties' claim construction arguments reinforce is the importance of the overall appearance of the claimed design. *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."). On one hand, we appreciate that there are more elements and features making up the overall appearance of the claimed fender design than LKQ's express construction embodies. LKQ's description for example, omits any reference to the arcuate edge feature that is part of the upper edge of the fender design and also does not account for the visibly different slope and angularity of the edges making up the curved, distal portion at the front of the fender.

On the other hand, as discussed above, we are not persuaded to apply GM's concept of crowded art and we do not determine that any one feature or element of the claimed design is particularly prominent, significant, or unique. GM's description refers to certain features as unique, significant, and prominent. *See, e.g.*, PO Resp. 3–7 (Patent Owner stating that "[t]he prominent arcuate edge feature also has a three-dimensional shape," and "the

claimed design has a unique distal portion shape that is prominent and significant in its impact on the overall appearance.").

On the facts in this proceeding, we take an egalitarian approach when considering the elements of the claimed design in the context of the overall appearance of the fender. Our observation is that all the elements of the claimed design are significant for their contribution to the overall appearance of the front fender, and that no one element has been shown to be significantly more important than any other element. In other words, we are not persuaded that there is any one element, on its own, so unique or prominent as to be deserving of significantly more weight in our analysis than any other element.

In our Decision on Institution we determined that no verbal description was necessary. Inst. Dec. 4–5. We explained that "the best description of the ornamental features of the '741 design comes from the drawings themselves." *Id.* at 5. Now, on the full record before us we still find that the best description 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. 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 '741 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 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 '741 patent, the claimed design illustrates that the top edge of the fender is defined by an upper and a lower proportional inflection line above the v-notch. The upper and lower inflection lines delineate the top protrusion, and the lower inflection line extends substantially parallel with the top edge to an arcuate edge feature that curves downwards from the top edge towards the curved distal portion of the fender.
2) We further observe, consistent with GM's argument, and shown particularly in Figures 1 and 3, that the curved distal portion is multi-angular, composed of a first and second sloping edge defining an angular top edge leading to a pointed tip. *See* PO Resp. 7–9 (citing Ex. 2004 ¶ 43–44).
3) As best seen in Figure 4 of the '741 patent, the claimed design has a perimeter shape that narrows from the rear to the front when observed from above.
4) The overall appearance of the crease, or "character line" as GM refers to it, is best considered by reference to each of Figures 1–4. *Id.* at 10. The crease, as we will refer to it, extends from the rear edge and displays a spatial relationship relative to the wheel arch, the lower inflection line, and top edge of the fender.
5) And, best seen in Figure 2, the crease itself is formed by the intersection of a lower convex surface and a more planar upper

surface providing a three-dimensional sculpted appearance to the contour of the fender.

D. Instituted Grounds

LKQ contends that the challenged claim is unpatentable under 35 U.S.C. § 103 based on U.S. Design Patent No. D679,231 S (Ex. 1006), "Karras," a design assigned to GM, issued April 2, 2013, combined with the images of GM's 2015 Cadillac Escalade as disclosed in various media forms, i.e., documents and websites, (Ex. 1007, Ex. 1008).[2] Pet. 28–40.

Claims Challenged	35 U.S.C. §	References
1	103	Karras,[3] autoblog,[4] and cadillac.com[5]
1	103	autoblog, cadillac.com, and Karras

LKQ relies on the Declarations of James M. Gandy (Ex. 1003) and Jason C. Hill (Ex. 1004) in support of its arguments. GM relies upon the Declaration of Thomas V. Peters (Ex. 2004) and Robert Gollehur (Ex. 2006).

E. The Designer of Ordinary Skill in the Art

For design patents, a person of ordinary skill in the art is referred to usually as a *designer* of ordinary skill in the art or simply an "ordinary designer." *See In re Nalbandian*, 661 F.2d 1214, 1216 (CCPA 1981) ("The

[2] We adopt LKQ's descriptions of the references. *See* Pet. vi–vii (Table of Exhibits), 16 (identification of evidence relied upon).
[3] Ex. 1006, U.S. Design Pat. No. D679,231 S, (April 2, 2013) ("Karras").
[4] Ex. 1007, 2015 Cadillac Escalade—Flying High in Caddy's First-Class SUV, Aug. 29, 2014, http://www.autoblog.com/2014/08/29/2015-cadillac-escalade-review.
[5] Ex. 1008, Cadillac—2015 Escalade / ESV, http://www.cadillac.com/escalade-suv/exterior-photos.html

'ordinary designer' means one who brings certain background and training to the problems of developing designs in a particular field, comparable to the 'mechanic' or 'routineer' in non-design arts.").

In this proceeding, LKQ and its declarants, Mr. Gandy and Mr. Hill, contend 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 or automotive design, or someone who has several years' work experience in transportation or automotive design.

Pet. 25 (citing Ex. 1003 ¶ 40; Ex. 1004 ¶ 39). GM does not identify, and we do not discern, any material issues concerning LKQ's proposed definition. *See* Ex. 2004 ¶ 25 (GM's declarant, Mr. Peters, stating "I do not discern any relevant differences between these proposals, nor do I have any substantive disagreement with Mr. Gandy's proposal."). For purposes of this Decision and on the complete record now before us, which includes testimony by LKQ and GM's Declarants, we adopt LKQ's proposed definition of the ordinary designer.

II. ANALYSIS

LKQ bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to GM. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, LKQ must establish the facts supporting its challenge by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

A. Principles of Design Patent Obviousness

In a challenge to a design patent based on obviousness under 35 U.S.C. § 103, 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 Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012) (quoting *Durling*, 101 F.3d at 103). This obviousness inquiry consists of two steps. *Id.* In the first step, a primary reference (sometimes referred to as a "*Rosen* reference") must be found, "the design characteristics of which are basically the same as the claimed design." *Id.* (quoting *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982)). This first step is itself a two-part inquiry under which "a court must both '(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.'" *High Point Design*, 730 F.3d at 1311–12 (quoting *Durling*, 101 F.3d at 103).

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. 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*, 101 F.3d at 103 (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

Although already discussed in our claim construction section, we point in that 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 at 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.").

As we have set forth the proper claim construction above, notably the drawings imparting the correct visual impression of the '741 design, that is—the appearance of the vehicle front fender in Figures 1–4 themselves, as well as verbal description identifying certain objectively visual elements of the claimed design, we turn below to the second part of the first step in the obviousness analysis.

B. Obviousness Based on Karras, autoblog, and cadillac.com

LKQ argues that the claim of the '741 design for "a vehicle front fender" would have been obvious over Karras, autoblog, and cadillac.com. Pet. 28.

1. The Asserted Primary Reference—Karras

LKQ asserts Karras, which is GM's own U.S. Design Patent No. D679,231, as the initial primary, or *Rosen*, reference. Pet. 29 (citing Ex. 1003 ¶ 48; Ex. 1004 ¶¶ 48, 50–51, 56–62). We reproduce, below, Figures 1 and 2 from Karras.

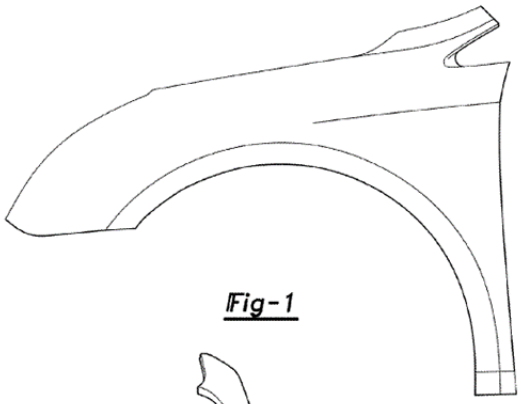


Fig-1

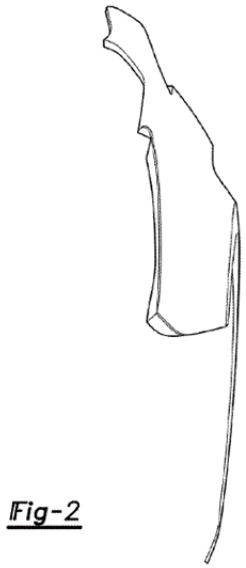


Fig-2

Figures 1 and 2 of Karras, above, depict a side and front view, respectively, of the Karras design. Ex. 1001, code (57). Below we reproduce Figures 3 and 4 of Karras.

Fig-3

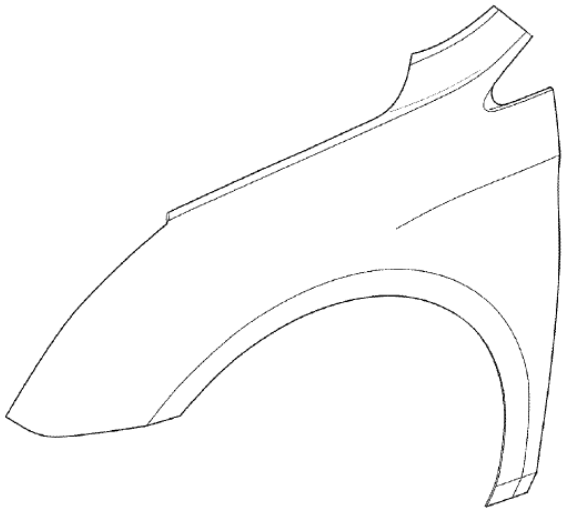


Fig-4

Figures 3 and 4 of Karras, above, depict a top plan view and a perspective view, respectively, front of the Karras design. *Id.*

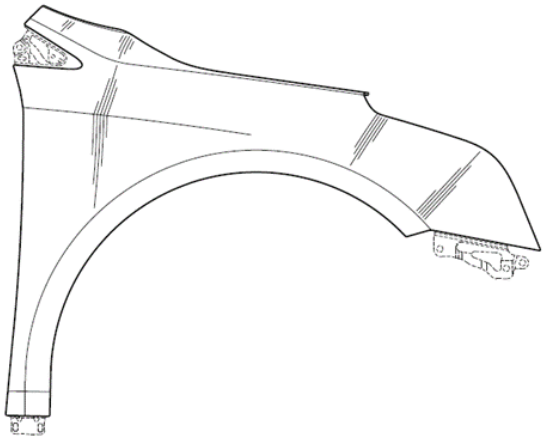
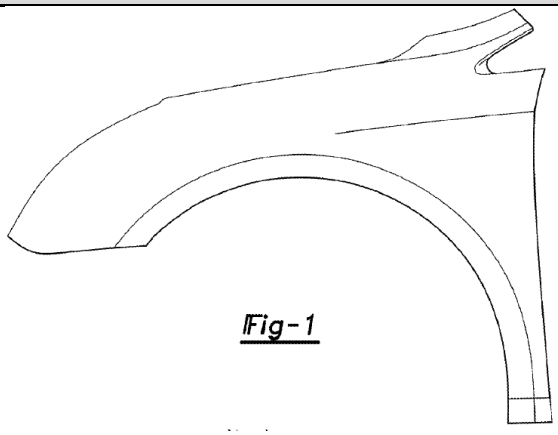
2. The Asserted Secondary References—Autoblog (Ex. 1007) and Cadillac.com (Ex. 1008)

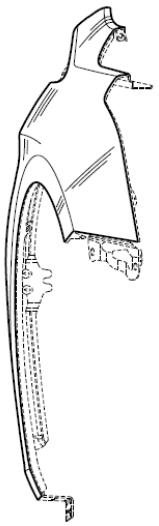
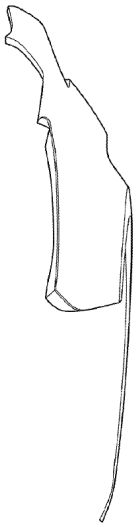
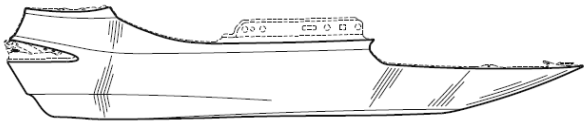
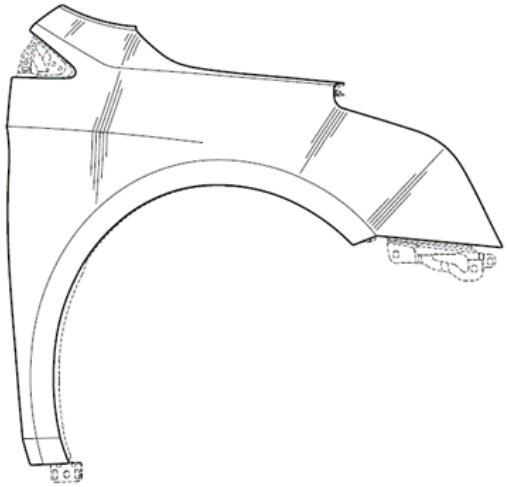
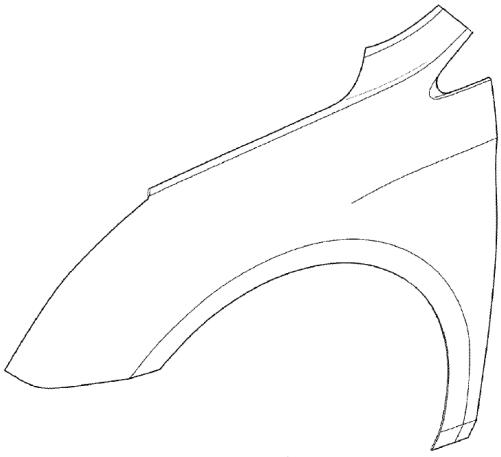
LKQ argues that either or both of autoblog, (Ex. 1007), and cadillac.com, (Ex. 1008), is an appropriate secondary reference because each reference reveals images of a 2015 Cadillac Escalade depicting a related and similar vehicle front fender to Karras. Pet. 35–40. LKQ contends that autoblog and cadillac.com teach the elements not found in Karras. *Id.* We reproduce cropped images from autoblog and cadillac.com, below.

The figure, above, on the left, is a cropped image and side elevation view of a 2015 Cadillac Escalade front fender from autoblog, and the photograph on the right is a cropped image and perspective view of a 2015 Cadillac Escalade front fender, from cadillac.com.

3. Whether Karras is a Proper Primary Reference

We must first determine whether Karras is an appropriate primary, i.e., *Rosen* reference. Below is a chart comparing each relative figure of Karras and the '741 design.

'741 Patent Drawings (Figures 1–4)	**Karras (Figures 1-4)**
 FIG. 3	 Fig-1

’741 Patent Drawings (Figures 1–4)	Karras (Figures 1-4)
 FIG. 2	 Fig-2
 FIG. 4	 Fig-3
 FIG. 1	 Fig-4

4. LKQ's Arguments

Relying on testimony from its Declarants, Mr. Gandy and Mr. Hill, LKQ argues that these designs share the following elements:

1) a substantially vertical side;
2) an intermittent, u-shaped notch in the substantially vertical side near a top of the fender;
3) the top of the fender including a top protrusion near the intermittent, u-shaped notch;
4) the top of the fender sloping down and away from the substantially vertical side to a curved, distal portion;
5) a crease in a surface of the fender extending from the substantially vertical side and in the general direction of the curved, distal portion; and
6) a wheel arch between the curved, distal portion and a bottom of the fender.

Pet. 33–35 (citing Ex. 1003 ¶¶ 50–51; Ex. 1004 ¶ 54).

Based on the similarities above, LKQ acknowledges two differences between the '741 design and Karras. *Id.* at 36 (citing Ex. 1003 ¶ 52; Ex. 1004 ¶ 55). LKQ contends that "[f]irst, in the '741 Patent, the curved distal portion is a slightly angled diagonal edge that rounds into a steeply angled diagonal edge that ends on a point, whereas Karras's distal portion is a single, continuous curvature that ends at a short, diagonally rearward, extending lower edge." *Id.* (citing Ex. 1003 ¶ 54; Ex. 1004 ¶ 55. LKQ contends "[s]econd, Karras's wheel arch is not connected to an edge of the distal portion of the fender at an obtuse angle." *Id.* at 38 (citing Ex. 1003 ¶

55; Ex. 1004 ¶ 58). According to LKQ, these two missing elements are supplied by the secondary references. Despite these two differences, LKQ argues that overall Karras discloses "a vehicle front fender with basically the same overall visual appearance as the claimed design in the '741 Design, claiming a vehicle fender, making Karras a proper primary reference." *Id.* at 31 (citing Ex. 1003 ¶ 49; Ex. 1004 ¶ 51).

5. GM's Arguments

GM disagrees that there are only two differences between Karras and the '741 design. GM argues that "[t]here are actually multiple, readily apparent differences between Karras and the claimed design, showing that Karras is not "basically the same." PO Resp. 18. GM argues that a designer of ordinary skill in the art, aware of other fender designs in the prior art, would find that the '741 design has multiple design elements that "provide a meaningful impact on the totality of elements that interact with one another to form a unique, distinctive design." *Id.* at 19 (citing Ex. 2004 ¶ 71). GM argues that the following elements are distinct between the designs:

a) Karras does not disclose the claimed design's top edge shape including a flat top edge and arcuate edge features. *Id.* at 19–24 (citing Ex. 2004 ¶¶ 72–78).
b) Karras does not disclose the same distal portion, including the concave intersection of the more angular distal portion with the arcuate edge feature. *Id.* at 24–25 (citing Ex. 2004 ¶ 79).
c) Karras has a different overall three-dimensional profile and shape compared to the claimed design. *Id.* at 27–31 (citing Ex. 2004 ¶¶ 81–86).

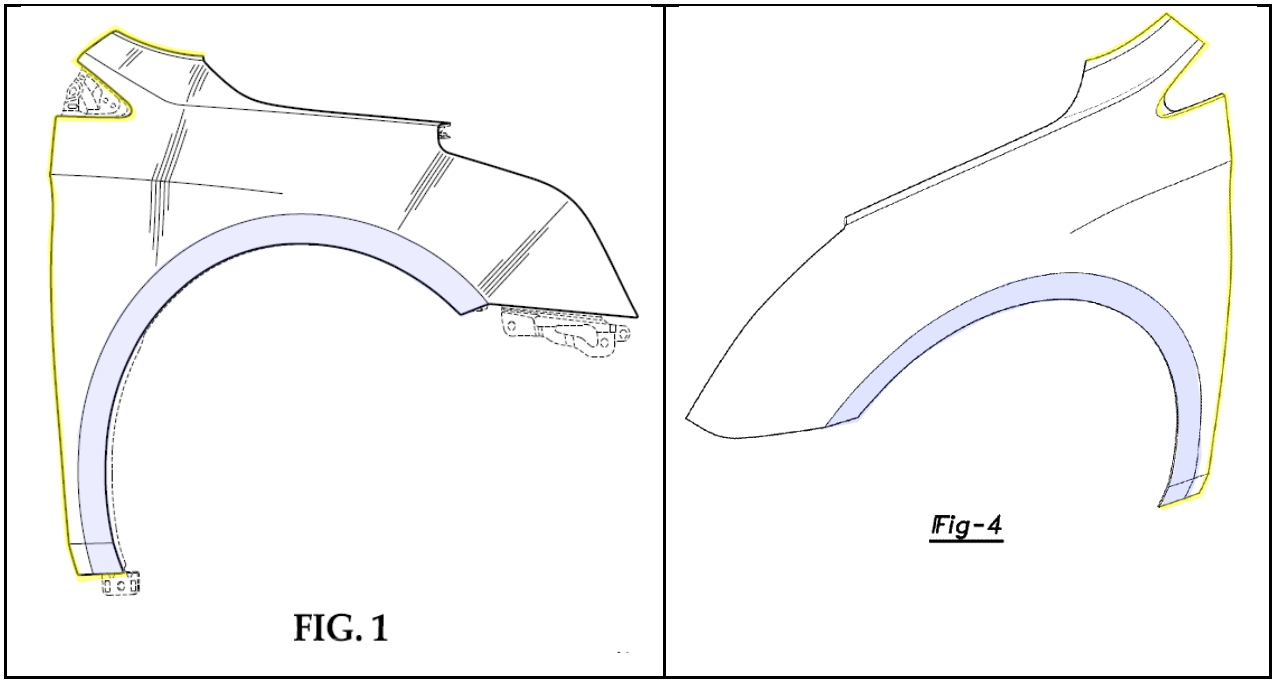
d) Karras has different "divergent sculpting and contour lines." *Id.* at 31–32 (citing Ex. 2004 ¶¶ 87–89).

6. Comparing Karras and the '741 design

The overall appearance of the claimed fender design is in some ways fairly basic, as the design includes only the outer side of a vehicle fender and we are not overwhelmed by a horde of disparate elements. In other ways there is a complexity and art in the interrelating elements which exists in the sum of its ornamental features, which may impart aspects of functionality to an ordinary observer and a designer of ordinary skill. *See, e.g.*, Ex. 2004 ¶ 10 (Mr. Peters explaining that "I believe that good automotive design is a three-dimensional product solution to a problem or a challenge that is beautifully executed. . . [t]he design conveys not only aesthetics, but customer perception of function").

As discussed in our claim construction section we agree with GM to some extent that LKQ has not considered all the relevant ornamental features which contribute to the overall appearance of the claimed design. Yet, we also find that many of the differences which GM asserts would be important to a designer of ordinary skill in the art, are over-blown, particularly as many are based on GM's flawed perception of vehicle fender design as a crowded art and falter in light of Mr. Peters' cross-examination testimony. As discussed in detail below, we are not persuaded that the differences are so great that the '741 design cannot be considered substantially the same as Karras.

To start, we reproduce below the annotated perspective figures from the '741 design (Figure 1) and Karras (Figure 4).



A highlighted perspective view of the '741 design (Figure 1) is shown above on the left, compared to a highlighted perspective view (Figure 4) of Karras, on the right.

An initial observation we make is that Karras does not include any shade or trim lines. At times, this can impact the comparison mainly because with shade lines the surface contours of the '741 design are somewhat more definitive in nature. However, there is no argument before us that Karras is indefinite.[6] And, being able to observe Karras from its side, perspective, top plan and front views in Figures 1–4 we determine that there is sufficient disclosure that an ordinary designer would perceive with

[6] When asked at oral argument about the lack of detail in Karras, GM's Counsel stated that "I don't think I'm prepared to say that it would render it indefinite . . . [w]e're stuck with what a skilled designer would have perceived this reference to show." Tr. 28:15–29:1–2.

reasonable clarity the relevant surface contours of Karras's design making possible an objective comparison with the '741 design.

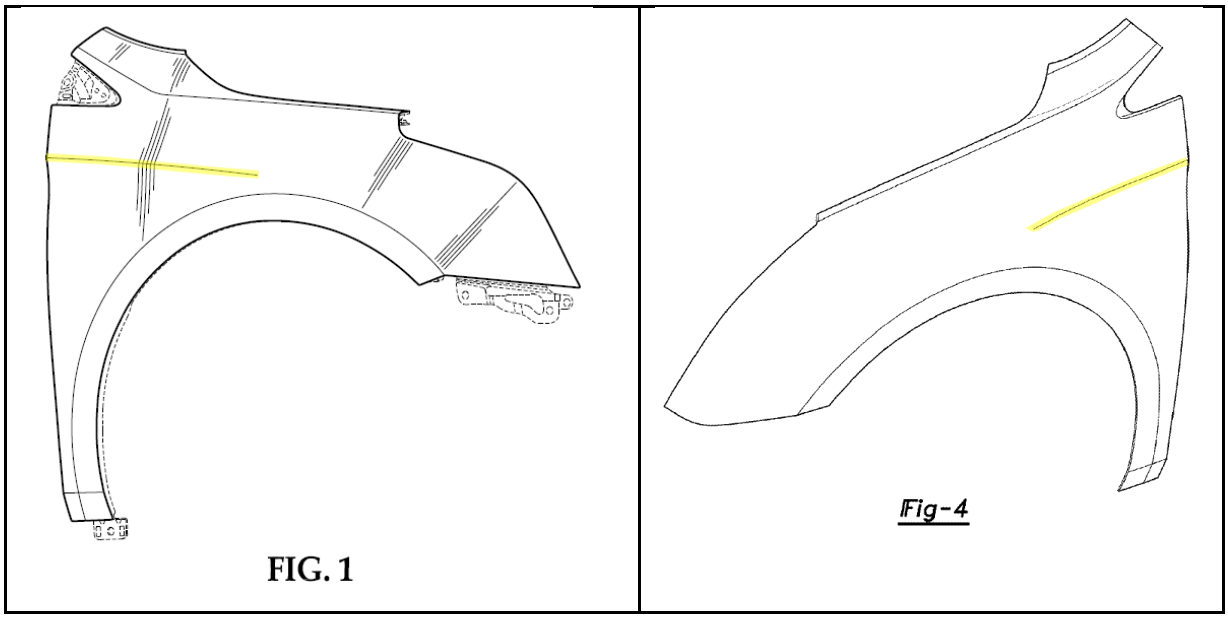
a. The rear edge, protrusion, and wheel arch

We agree with, and GM does not persuasively dispute, several of LKQ's points of comparison which we find relevant to our analysis. GM does try to downplay these comparisons, for example arguing that "every car on the road has a front fender, and many of those fenders share the generic characteristics LKQ discusses in its Petition—a 'vertical side,' 'u-shaped notch,' 'curved distal portion,' or 'side crease.'" PO Resp. 1. However, as set forth in our claim construction we determine that all elements of the '741 design are entitled to some similar relative weight.

Quite similar are the substantially vertical side edges of the designs including, as highlighted above, the nearness and proportional spacing of the vertical side edges relative to the wheel arch, the concave sculpting of the fender surface immediately below the crease which extends forward and substantially normal to the vertical side edge, as well as the U-shaped notch above the crease. *Compare* Ex. 1001, Fig. 1, *with* Ex. 1006, Fig. 4. Also, GM does not persuasively dispute that the top protrusion illustrated in the '741 design, above the intermittent u-shaped notch, is not substantially the same as in Karras. PO Resp. 1–12. In addition, the wheel arch for both designs highlighted in blue above, is highly similar if not exactly the same, being defined by the same or similar general circumferential planar flat rim in similar proportions relative to the rest of the fender design. *Compare* Ex. 1001, Fig. 1, *with* Ex. 1006, Fig. 4.

b. The crease

Still considering the annotated perspective views in Figure 1 of the '741 design and Figure 4 of Karras, reproduced below, we address the crease feature found in both designs.



A highlighted perspective view of the '741 design (Figure 1) is shown above on the left, compared to a highlighted perspective view (Figure 4) of Karras, on the right. The crease extends normal to the rear edge of both designs, just above a slight in-cut section of the rear edge, and appears fairly similar between Figure 1 of the '741 design and Figure 4 of Karras. In both designs the crease extends approximately halfway across the width of the wheel arch and is similarly proportionally located above the wheel arch and below the u-shaped notch.

Reproduced below are Figure 4 of the '741 in comparison (on left) to Figure 3 of Karras (on right) also illustrating the crease as seen from a top view.

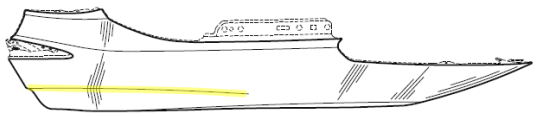


FIG. 4

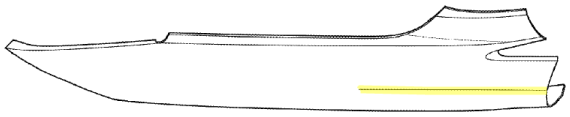


Fig-3

A highlighted perspective view of the '741 design (Figure 4) is shown above on the left, compared to a highlighted perspective view (Figure 3) of Karras, on the right. We observe, as GM points out in Figure 4 of the '741 patent, the crease is slightly divergent, or curved towards its end above the wheel arch, as compared to Karras which remains generally horizontal as it extends out over the wheel arch. *See* PO Resp. 31. On the other hand, as shown by the in-cut on the rear edge, in both designs the crease is formed with a slightly convex lower surface below and a more planar surface above. Despite the minor difference, comparing the designs as a whole including the crease as shown in each of Figures 1–4 of both designs, we determine that the evidence of record establishes that a designer of ordinary skill in the art would find the crease in Karras substantially the same as the crease in the '741 design.

c. The top edge

In our view, there are mostly similarities in the top edge between the '741 design and Karras, which extends from the protrusion to the distal portion. In each design, extending from the very similar protrusions the top edge curves downward at a comparable curvature to form an inwardly folded edge portion that is defined by and substantially parallel to a lower inflection line. The lower inflection lines of each design are highlighted below in

reproduced annotated Figure 4 of the '741 design in comparison to Figure 3 of Karras.

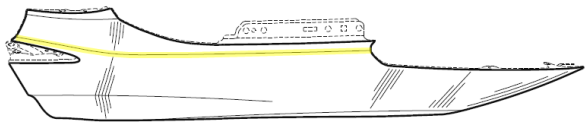


FIG. 4

Fig-3

The inflection line is shown, highlighted above, in the '741 design (Figure 4) above on the left, compared to a highlighted top plan view (Figure 3) of Karras, on the right. GM argues that one nuanced difference is that the '741 design "includes an inwardly folded, flat top edge . . . extending from the protrusion to the arcuate edge feature." PO Resp. 19 (citing Ex. 2004 ¶ 74). Karras, GM argues, "has neither a sharp bend nor a flat top edge. Instead, the top edge is a curved surface, having a substantially smaller width." *Id.* at 20 (citing Ex. 2004 ¶ 74).

We do not find that the evidence of record consistent with GM's argument and its Declarant's testimony here. Specifically, we are not persuaded that Karras has a "curved" top edge as compared to a "flat top edge" in the '741 design as GM asserts. GM relies, in part of Karras's Figure 2 which is a front view of Karras's fender showing no inflection or crease lines. *Id. at* 20. However, Figures 1, 3, and 4 of Karras illustrate a similarly distinctive lower inflection line as the '741 design, indicating a radius leading to the top edge of the fender. It cannot be readily ascertained exactly what is the specific radius of Karras's inflection line, or that of the

'741 design for that matter. However, looking at all Karras's figures together, we find it more persuasive that the inflection lines are similar if not the same to the '741 design. Our view is confirmed to some extent by Mr. Peters who conceded in his deposition that both top edges were similarly "crowned."

> Q. That surface is a crown surface; correct?
>
> []
>
> A. To some degree, it is crown.
>
> []
>
> Q. And, similarly, in Karras, that surface above the inflection line is a crowned surface, right?
>
> []
>
> A. In general, yes.

Ex. 1037, 201:24–202:7. Also in his deposition Mr. Peters was reluctant to confirm that the '741 top edge was in fact flat, instead stating:

> A. I'd say a narrow, linear shear surface.
>
> Q. Does that capture the concept that even though it's not perfectly flat, it's sort of horizontal?
>
> A. Not necessarily horizontal, but it has a consistent direction. It could be sloped. It could go up. It could be angled, if you're seeing my hands. The shearness refers to the amount of crown. You could say a crowned shear linear surface, like your watch.
>
> Q. All right. Crowned shear linear surface?
>
> A. And that can be metered in an infinite amount of configurations.

Ex. 1037, 180:3–15. And, Mr. Peters reluctantly conceded that Karras's top edge, like the '741 design, was crowned and possibly shear:

> Q. And is that surface crowned?
>
> []
>
> A. I can't tell in this particular illustration. I would venture to say it has some sort of crown in it.
>
> []
>
> Q. And is it shear?
>
> []
>
> A. It's possible.

Id. at 186:11–20. Mr. Peter's deposition testimony is not unequivocal that there exists a significant difference in the top edge between the two designs. Our perspective, observing both designs as a whole, and considering in this instance the top edges in comparison, it appears that the top edges of the '741 and Karras are substantially the same. Our own observation and comparison of the top edges by themselves suggests that there is some difference. Our comparison of the designs as a whole shows, however, that the visual difference is not particularly remarkable, and the lack of specificity by Mr. Peters as to what the difference actually is, further informs our determination that the top edges are substantially the same.

d. The perimeter shape

GM argues that the perimeter shape of the '741 design, particularly when viewed in the top views, as seen in Figure 4 of the '741 design and Figure 3 of Karras, above, is unique. PO Resp. 6 (citing Ex. 2004 ¶¶ 40–42). GM argues specifically that the '741 design narrows from rear to front and that "the wheel arch contour line is visible from the top view, protruding outwardly at the front portions of the front end of the fender due to the narrowing of the upper portion of the fender body." *Id.* at 6–7.

LKQ argues that a designer of ordinary skill in the art would have seen the perimeters as largely the same, and supports this with cross-examination testimony from Mr. Peters, who mostly agreed that the perimeter sections of the designs were similar:

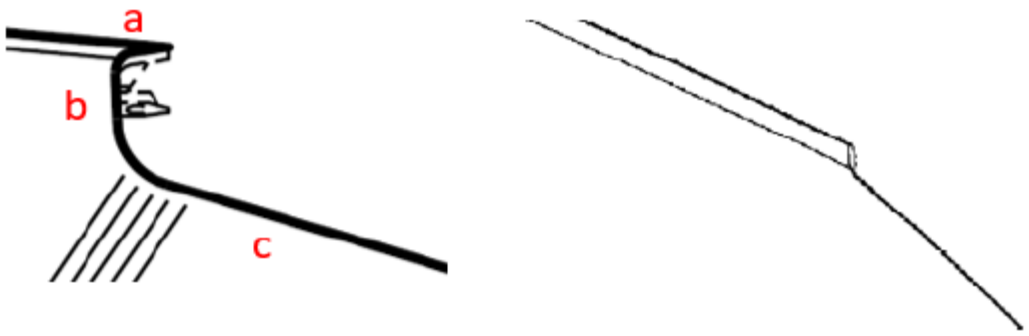
> Q. . . . Is the dimension that I've indicated as F, generally, an accurate characterization of the width of the fender at the rear of Karras?
>
> A. Generally, I would agree.
>
> Q. Thank you. Would you agree that the dimension that I've indicated at E, as E, is the thickness of Karras at the front?
>
> A. Approximately.

Ex. 1037, 192:10–20. We would agree that viewing only the top views in isolation appear to present some minor disparities in profile and contour. However, we find Mr. Peter's testimony telling, and consistent with our own observations—namely, that viewing all the figures in context of the overall appearance of the designs indicates that the perimeter shape and edge sections, while different in certain minor respects as a whole, are substantially similar and proportionally arranged so as to define a perimeter and surface contour of the designs that is substantially similar.

e. The transition from top edge to distal portion

GM argues that the "three-dimensional arcuate edge" transition from the top edge to the distal portion of the '741 design is not the same as in Karras. PO Resp. 20 (citing Ex. 2004 ¶ 75). GM relies on testimony from Mr. Peters, who provides the annotated figures below and testifies that different from the '741 design "Karras has a subtle transition from the curved top edge. Karras does not depict any arcuate edge feature defined by

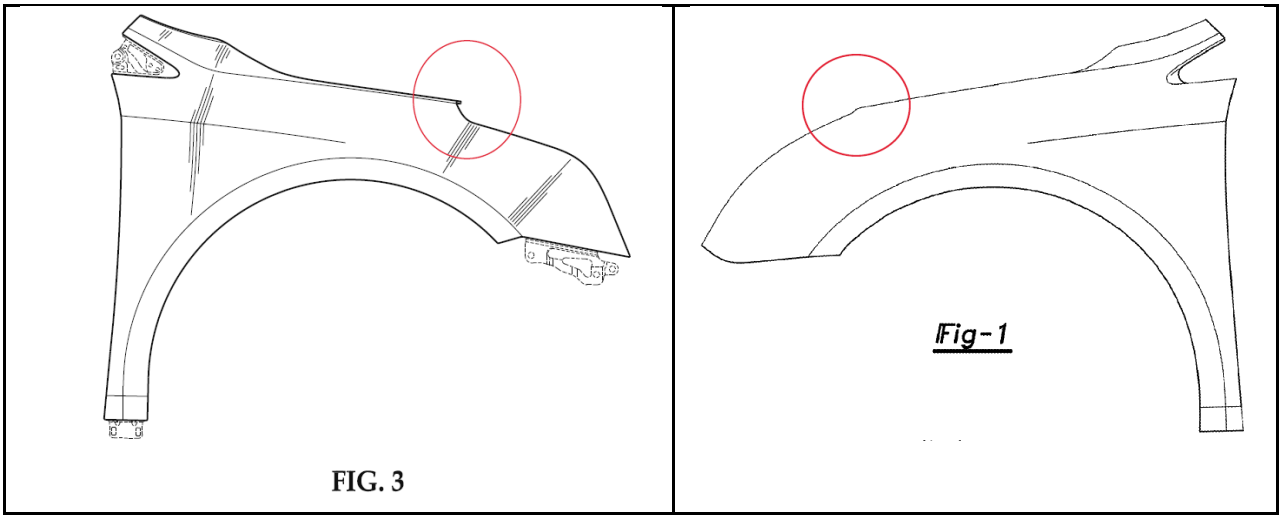
three distinct edge shapes *a-c*, as provided by the claimed design." Ex. 2004 ¶ 75.



'741 Patent *Karras*

Above, on the left is an annotated partial blown-up view, provided by Mr. Peters, of the top edge transition to the distal portion as seen in the '741 design on the left, and in Karras on the right. *Id.*

Mr. Peters' contrast, above, compares the '741 design to a slightly different perspective view of Karras's top edge which does not show as well the related edge sections. Observing Karras' Figures 1–4 together we see a similar transition to which one could apply the "a, b, c" designation as well. For example, as seen in Karras's Figure 1 below, although not as pronounced as in the '741 design, there is, in our observation, a "b" edge in Karras's top edge transition to the distal portion. But, GM has a point here, it is a reasonable and visibly apparent size difference in the transitions between the designs.



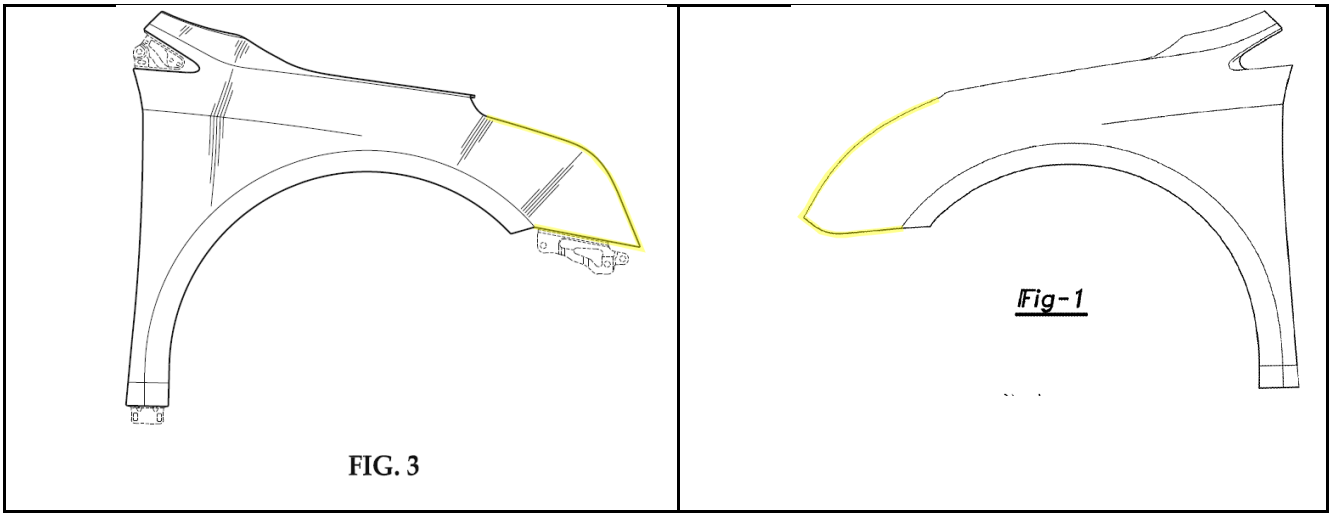
An annotated side view of the '741 design (Figure 3) is shown above on the left, compared to an annotated side view (Figure 1) of Karras, on the right. We are persuaded that there is a visual difference that weighs in favor of finding that the transition (annotated with red circle) from the top edge to the distal portion where the transition in the '741 is deeper and more convex than the more shallow transition in Karras. PO Resp. 23 (citing Ex. 2004 ¶ 78).

f. The distal portion

GM argues that arcuate edge transition discussed above, and the distal portion of the '741 design are part of an overall unique profile that is different and not substantially the same as Karras. PO Resp. 7–9, 20–26. GM argues the distal portion is different from Karras, mainly because it has two distinct slopes making up a "multi-angled top edge and a symmetric pointed tip." *Id.* at 7. Here, considering the distal portions of each design, we get to the heart of the matter in this proceeding, that is—in the context of a primary reference, what aspects of the overall appearance of each design are clearly different.

LKQ in fact concedes that "in the '741 Patent, the curved distal portion is a slightly angled diagonal edge that rounds into a steeply angled diagonal edge that ends on a point, whereas Karras's distal portion is a single, continuous curvature that ends at a short, diagonally rearward, extending lower edge." Pet. 36 (citing Ex. 1003 ¶ 54; Ex. 1004 ¶ 55).

We reproduce below, the highlighted side views of the respective fender designs in each of the'741 design and Karras.



An annotated side view of the '741 design (Figure 3) is shown above on the left, compared to an annotated side view (Figure 1) of Karras, on the right. As readily apparent from the comparison above, the distal portion of the '741 design has two sloping sections creating a multi-angled top edge that is unlike the continuous curve of the complimentary top edge in Karras. Also, the lower edge of the distal portion in the '741 design is linear creating an acute angle with the multi-angled top edge. Karras has a curved lower edge that forms approximately a 90 degree angle with the continuously curved top edge.

g. Karras is a proper primary reference

Overall, our analysis of the claimed design and Karras shows considerably more similarities than differences in a comparison of the overall appearances of both designs. We acknowledge that there are nuanced differences for similar features, as GM and its Declarants point out, such as a slightly outward turn in the crease of the '741 design and a nominally different radius of the lower inflection line as it defines the top edge. PO Resp. 20, 31. The greatest differences are found in the transition and distal portions of the designs. We find that these differences, while noticeable and important as part of the overall analysis, do not outweigh the substantial similarity between the overall appearance of Karras and the '741 design.

It is not simply that Karras depicts a front fender, but, as described above, when the visual appearances of Karras and the '741 patent are compared, we are persuaded that the claimed design has a multitude of similar, if not the same features, as Karras. *See Apple*, 678 F.3d at 1332 (The Federal Circuit explaining that "Fidler does not qualify as a primary reference simply by disclosing a rectangular tablet with four evenly rounded corners and a flat back."). In an obviousness analysis, a primary reference need not be the exact same as the claimed design. *See MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1333 (Fed. Cir. 2014) (The Federal Circuit explaining "[t]hat there are slight differences in the precise placement of the interlock fabric and the ornamental stitching does not defeat a claim of obviousness; if the designs were identical, no obviousness analysis would be required."). We are persuaded that an ordinary designer would find the overall visual impression created by the '741 design is very

much the same as Karras and we conclude on the full record now before us that Karras is "basically the same as the claimed design." *Rosen,* 673 F.2d at 391.

7. Whether autoblog and cadillac.com are Appropriate Secondary References

LKQ argues that either or both of autoblog, (Ex. 1007), and cadillac.com, (Ex. 1008), is an appropriate secondary reference because each reference reveals photographs of a 2015 Cadillac Escalade including a similar vehicle front fender to Karras which teaches the arcuate edge transition and distal portion not found in Karras. Pet. 35–40. We provide partial images from autoblog and cadillac.com, below.

The figure, above, on the left, is a portion of an image of a 2015 Cadillac Escalade from autoblog, and the photograph on the right is a portion of an image also of a 2015 Cadillac Escalade from Cadillac.com.

According to LKQ, both autoblog and cadillac.com depict a vehicle front fender "which is an appropriate, secondary reference 'so related [to Karras] that the appearance of certain ornamental features in one would suggest the application of those features to the other.'" Pet. 36 (quoting *In re Borden*, 90 F.3d at 1575). LKQ argues specifically that the 2015 Cadillac Escalade front fender discloses the design elements missing in Karras's front fender, including a distal portion having "a slightly angled diagonal edge

that rounds into a steeply angled diagonal edge ending at a point." *Id.* at 37 (citing Ex. 1003 ¶ 54; Ex. 1004 ¶ 57). According to LKQ, the 2015 Cadillac Escalade fender also discloses a lower edge of the distal portion which "readily supplies the missing element in Karras, an obtuse angle." *Id.* LKQ argues that an ordinary designer, having all the relevant prior art before them, would have found that the 2015 Cadillac Escalade taught a related front fender and suggested "the slight modification of changing the angle at which the wheel arch meets the distal portion of the fender and ending the curved, distal portion at a point." *Id.* at 39 (citing Ex. 1003 ¶ 56; Ex. 1004 ¶¶ 59–60).

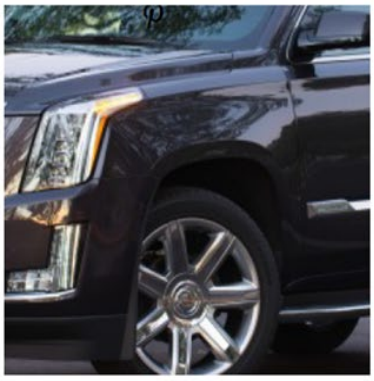
GM does not agree that an ordinary designer would have combined the distal portion elements from the 2015 Cadillac Escalade fender with Karras. GM argues that "a skilled designer would not even have been motivated to combine Karras and the Cadillac Escalade because they are different vehicle types with drastically different styles. PO Resp. 32–33 (citing Ex. 2004 ¶¶ 91–95). GM argues that "LKQ ignores other differences between the vehicle front fenders, such as the Escalade's rectangular wheel arch." *Id.* at 34. GM contends that even if the 2015 Cadillac Escalade is combined with Karras, the 2015 Cadillac Escalade "still fails to teach the claimed design's distal portion" as well as other features of the '741 design. *Id.* at 36 (citing Ex. 2004 ¶¶ 96–100).

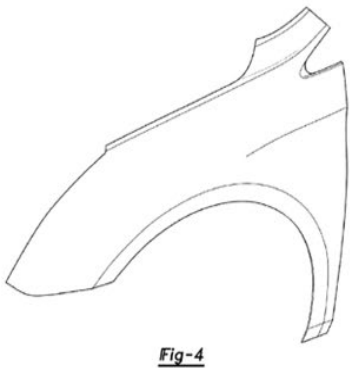
As discussed in detail below, we are persuaded by the evidence before us in this proceeding that LKQ has shown by a preponderance of the evidence that a designer of ordinary skill in the art would have found that the 2015 Cadillac suggested the modification of Karras to create a design that

has the same overall visual appearance as the '741 design. *MRC Innovations*, 747 F.3d at 1331.

An initial question we address is whether or not the front fender shown on the 2015 Cadillac Escalade is so related to Karras that in the context of an ordinary designer "that the appearance of certain ornamental features in one would suggest the application of those features to the other." *Durling*, 101 F.3d at 103, *see also In re Borden*, 90 F.3d at 1574 (The Federal Circuit explaining that "there must be some suggestion in the prior art to modify the basic design with features from the secondary references.").

We provide a visual comparison of the images from autoblog and cadillac.com, below, relative to Karras's Figure 4.





The two images on the left show a 2015 Cadillac Escalade vehicle front fender from Exhibits 1007–1008, as compared to Karras's figure 4, on the right. Considering the images and Karras Figure 4, above, like Karras, autoblog and cadillac.com depict a vehicle front fender. Many of the same and similar ornamental elements can be found between Karras and the 2015 Cadillac Escalade fender shown in the secondary references, for example a

vertical rear edge extending upwards to an upper protrusion that is proportional in size and positioning to the wheel arch. Another similarity is the inflection line below the upper protrusion extending generally perpendicular from the vertical rear edge parallel with the top edge to intersect the front distal portion at the transition. Also, the 2015 Cadillac Escalade depicts a substantially planar wheel arch surface which forms and surrounds the wheel arch to differentiate the wheel arch surface relative to the other surfaces on the fender.

It is true that the appearance of the 2015 Cadillac Escalade fender is not the same as Karras's fender. There are differences, for example in the proportionality of the surfaces defined by the inflection line and top edge, the lack of a u-shaped notch below the upper protrusion in the 2015 Cadillac Escalade fender and no lateral crease extending from the rear edge. However, besides being related as vehicle front fenders, in our view there is an overall visual consistency in the dramatic profile, surface contours, and transition to the distal portion in the overall appearance of the 2015 Cadillac Escalade's fenders as compared to Karras, suitable to determine that the designs are related and similar. *See MRC Innovations*, 747 F.3d at 1334 (The Federal Circuit explained that when considering secondary references, "it is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design.").

The evidence reveals that Karras and the 2015 Cadillac Escalade are related beyond being simply vehicle front fenders. Karras, according to Mr. Peters, embodies the 2013-2014 Cadillac XTS front fender. *See* Ex. 1037, 203:7–8 (Mr. Peters stating that "[m]y understanding is 2013-2014 is the Karras XTS Cadillac."). Although Mr. Peters did not concede during his

deposition that the Cadillac Escalade fender was sufficiently related to Karras so as to be a proper secondary reference, he does ascribe to both fender designs the descriptor "Cadillac character."

> Q. But do you have an opinion as to whether it meets the relatedness test?
>
> A. In certain aspects.
>
> Q. What is that?
>
> A. That they are both Cadillacs.
>
> . . .
>
> A. Yeah. The fenders. Okay. Just the fender. To me, they are different enough. I don't – you know, I can see Cadillac character in both of them; but as far as comparing them, I guess I'd have to understand what you mean by "comparing" them.
>
> Is that comparing math? Is it the overall impression or whatever?
>
> But, to me, those are two different vehicles.
>
> Q. I understand they are two different vehicles, and I'm not asking you to create an opinion now. I am asking you, as you sit here today, do you have an opinion as to whether or not the Escalade fender meets the relatedness test such that its features can be applied to the Cadillac --
>
> A. I guess I have to say no.

Ex. 1037, 130:11–31:24. Mr. Peters' testimony here is not unequivocal. However it is sufficient to support our determination of relatedness. Moreover, Mr. Peters explained in his Declaration that "the designs of vehicles have certain shapes, angles, proportions, and overall profiles that create a brand and differentiation within the crowded field of consumer vehicles." Ex. 2004 ¶ 15. These similarities, according to Mr. Peters, are how consumers identify and distinguish between vehicle brands. *Id.* This

testimony reinforces our determination that Karras and 2015 Cadillac Escalade, although clearly different fenders for different vehicles, indicate to consumers, and thus ordinary designers, sufficient relatedness and similarity to determine that the 2015 Cadillac Escalade is a proper secondary reference.

GM advances several arguments with respect to the inapplicability of the 2015 Cadillac Escalade as a sufficient secondary references which we do not find persuasive, and for purposes of completeness, we address below.

GM argues that "the 2015 Cadillac Escalade is a truck-styled SUV, while Karras is a sedan." PO Resp. 33 (citing Ex. 2004 ¶¶ 91–93). We do not find this argument persuasive or credit Mr. Peters' testimony regarding the difference in the vehicles as a whole because the primary reference Karras is not a sedan, or even a vehicle, but simply claims a vehicle component, a "Vehicle Front Fender." Ex. 1006, code (54). Moreover, as described above, we credit the testimonial evidence from Mr. Peters that vehicles and components across particular brands, despite being different models, can include certain visual similarities. Ex. 2004 ¶ 15.

GM also argues that "LKQ plucks select features—the alleged 'distal portion' and 'obtuse angle'—from the 2015 Cadillac Escalade for incorporation with Karras while ignoring the remaining features of the vehicle front fender of the 2015 Cadillac Escalade that are not shared with Karras." PO Resp. 34. This argument is not persuasive because LKQ's analysis need not bodily incorporate all the elements of the 2015 Cadillac Escalade into Karras. It is enough in design patent law that the references as so closely related that the missing elements found in autoblog and cadillac.com would convert Karras into the claimed design "in a setting that

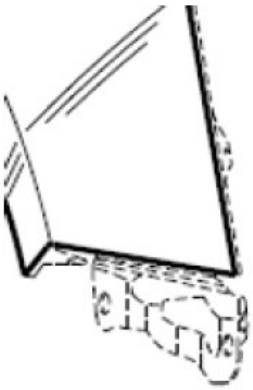
would suggest the combination to one of skill in the art." *In re Borden*, 90 F.3d 1570, 1576 (Fed. Cir. 1996).

In a similar vein, GM also argues that "LKQ has provided no reason why a designer of ordinary skill would have incorporated the ***particular aspects***—the 'distal portion' and 'obtuse angle'—that LKQ cherry-picks from the 2015 Cadillac Escalade." PO Resp. 35. This is an interesting argument because it essentially invokes, without supporting case law or legal analysis, the Supreme Court's decision in *KSR International Co. v. Teleflex, Inc.,* 550 U.S. 398 (2007). We have no persuasive position or arguments from GM that *KSR* has substantively altered the *Durling* test or somehow added additional requirements that LKQ must expressly assess in order to support the combination of Karras and the 2015 Cadillac Escalade. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness") (*cited with approval in KSR*, 550 U.S. at 419 (holding a rigid insistence on teaching, suggestion, or motivation [TSM] is incompatible with its precedent concerning obviousness)).

GM argues further that "the Escalade's design is simply not compatible with Karras' softer aesthetic," and therefore modifying Karras with the 2015 Cadillac Escalade distal portion is improper hindsight reconstruction. PO Resp. 35–36 (citing Ex. 2004 ¶¶ 59–70, 95). For support of this hindsight argument, GM cites to *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993). In *L.A. Gear*, the Federal Circuit upheld the district court's finding of non-obviousness based on the design patent challenger's assertion of twenty-two references. Specifically, the Federal Circuit found no error in the district court's conclusion "that there

was no teaching or suggestion in the prior art of the appearance of the claimed design as a visual whole." *L.A. Gear*, 988 F.2d at 1124. Quite different from the reconstruction based on twenty-two references in *L.A. Gear*, in this proceeding we have a primary reference, Karras, and a secondary reference depicting the 2015 Cadillac Escalade. As discussed above, LKQ has shown by preponderance of the evidence that the secondary reference is so related to the primary reference that it would have suggested to a designer of ordinary skill in the art the modification of Karras's distal portion with the multi-angled distal portion and obtuse angled lower edge from the 2015 Cadillac Escalade. On the record in this proceeding, we do not find GM's hindsight argument persuasive.

GM makes additional arguments asserting that even if the references are properly combined, and Karras is modified with the distal portion elements of the 2015 Cadillac Escalade, the proposed combination would (1) not have a sharp tip that points downward as in the '741 design, and (2) the proposed combination would necessarily include the beveled front edge of the downward sloping front edge of the distal portion which the '741 design does not have. We reproduce below GM's annotated comparison illustrating their arguments. PO Resp. 37.



'741 Patent

2015 Cadillac Escalade

Above is GM's annotated comparison of a portion of Figure 2 of the '741 design on the left, and a blow-up view of the distal portion of the 2015 Cadillac Escalade on the right.

As to argument (2), GM's Declarant Mr. Peters, testifies that "[t]his beveled edge difference between the 2015 Cadillac Escalade and the claimed design would be evident to a vehicle designer." Ex. 2004 ¶ 98.

Even if we find Mr. Peters' testimony on this point convincing, GM's argument misses the mark because it attacks the references in isolation. As discussed above with respect to other features of the 2015 Cadillac Escalade which GM argues are excluded by LKQ, the proposed combination is based on the teachings of the two references and need not incorporate all elements of the secondary reference. An ordinary designer would have been aware of the teachings in the 2015 Cadillac Escalade of a multi-angled profile and obtuse angled lower edge in conjunction with the planar wheel arch and because of the relatedness of the primary and secondary references would

have incorporated those elements into Karras to achieve the claimed '741 design.

As for argument (1), we compare below a perspective view of the 2015 Cadillac Escalade with the perspective view shown in Figure 1 of the '741 design.

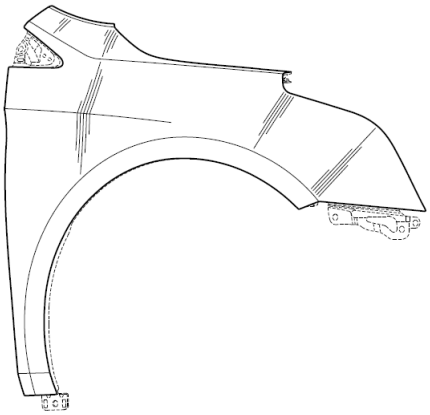
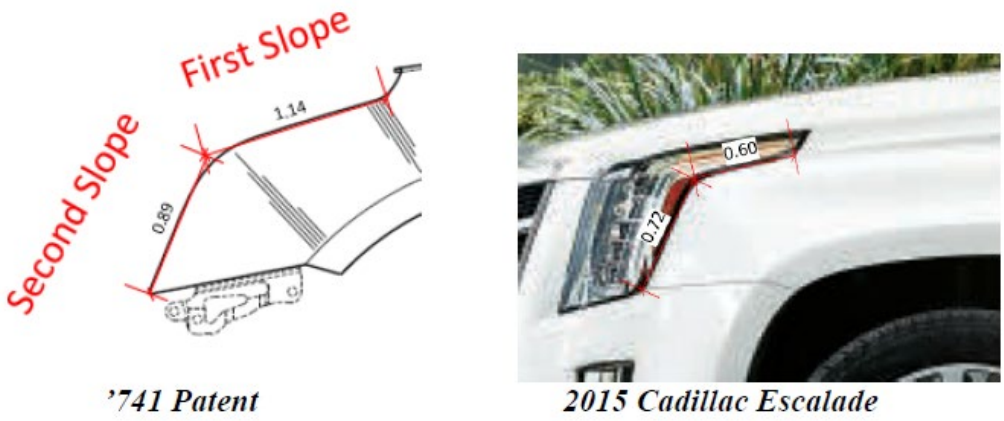


FIG. 1

Figure 1 of the '741 front fender design is illustrated above, left, compared to a cropped image of the 2015 Cadillac Escalade fender, on the right. We appreciate GM's argument and Mr. Peters' testimony that, when considered in exacting detail, the '741 design appears to have a pointed, forward and downwardly aimed arcuate tip. Ex. 2004 ¶ 97. However, we determine that the 2015 Cadillac Escalade successfully bridges the gap with the claimed design because it too has an arcuate tip that appears pointed similarly in a forward and downward direction. *Compare* Exs. 1007, 1008, *with* Ex. 1001, Figs. 1–4. Perhaps the 2015 Cadillac Escalade does not disclose quite as downwardly pointing a tip as the '741 design, but considering the overall appearance of the designs we find the arcuate tip of the distal portions of both designs sufficiently similar that a designer of ordinary skill would still

consider the claimed design and the proposed combination of Karras and the 2015 Cadillac Escalade nearly identical.

Similarly, GM argues that the 2015 Cadillac Escalade has a differently shaped distal portion where "[t]he combined sloped regions (both first and second sloped regions) of the 2015 Cadillac Escalade also have a shorter length extending along the horizontal axis as compared to the claimed design." PO Resp. 40 (citing Ex. 2004 ¶ 100). GM provides the annotated comparison, reproduced below, of the 2015 Cadillac Escalade and a cropped portion of Figure 3 of the '741 design. *Id.*



'741 Patent *2015 Cadillac Escalade*

Above is GM's annotated comparison of Figure 3 of the '741 design on left, and a cropped image of the 2015 Cadillac Escalade, on the right. GM argues that "[t]hese differences would create a hypothetical combination having a 'distal portion' with a different shape, which would contribute to an overall appearance different [than] the claimed design." PO Resp. 40 (citing Ex. 2004 ¶ 100).

In GM's comparison, above, we agree that there is an observable difference between the lengths of the sloped regions. Despite this, and even considering Mr. Peters' testimony and that a designer of ordinary skill would recognize the difference, when considered in the context of the overall

appearance of the '741 design, we find the similar sloped regions and multi-angular character of the distal portion along with the obtuse angular intersection with the wheel arch of the 2015 Cadillac Escalade strikingly similar in overall appearance between the two designs. In addition, we also observe, in a cropped image of the 2015 Cadillac Escalade below, a deeper transition from the top edge to the first sloped region of the distal portion. We reproduce, below, Figure 3 of the '741 design in comparison to an image of the 2015 Cadillac Escalade.

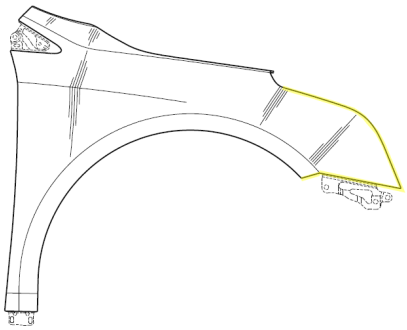


FIG. 3

On the left, above, is a side view, Figure 3 of the '741 design compared to a cropped image from the 2015 Cadillac Escalade on the right. We are persuaded on the arguments and evidence presented that the distal portion elements of the Cadillac Escalade bridge the gap between Karras and the '741 design such that LKQ has shown by a preponderance of the evidence that the '741 design would have been obvious in view of Karras and the 2015 Cadillac Escalade.

8. Conclusion of Obviousness Based on Karras, autoblog and cadillac.com

Based on the complete trial record in the proceeding, we are persuaded Karras is a proper primary reference, and that the front fender of the 2015 Cadillac Escalade is related and sufficiently similar to the appearance of Karras to be an appropriate secondary reference. In this way, the elements of the multi-angled distal portion and obtuse angle with the wheel arch in the 2015 Cadillac Escalade would have suggested themselves to a designer of ordinary skill in the art as a modification to the overall appearance of Karras. *See Borden*, 90 F.3d at 1574*, see also MRC Innovations*, 747 F.3d at 1334 (Fed. Cir. 2014) (The Federal Circuit explaining that "it is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design."). GM has not produced evidence, or provided argument, that any secondary considerations of nonobviousness support its position. We are persuaded based on the arguments and evidence in this proceeding that the distal portion elements of the Cadillac Escalade bridge the gap between Karras and the '741 design such that LKQ has shown by a preponderance of the evidence that the '741 design would have been obvious in view of Karras and the 2015 Cadillac Escalade.

C. Obviousness Based on autoblog, cadillac.com, and Karras

Because we determine that the claim of the '741 design is unpatentable over Karras, autoblog, and cadillac.com, we do not reach LKQ's additional challenge asserting that the claim of the '741 design is obvious based on autoblog and cadillac.com, depicting the 2015 Cadillac Escalade, as a primary reference, and Karras as a proper secondary reference.

III. CONCLUSION[7]

Petitioner has proved by a preponderance of the evidence that the claim of the '741 patent would have been obvious over Karras, autoblog, and cadillac.com.

Claims	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1	103	Karras, autoblog, cadillac.com	1	
1	103	autoblog, cadillac.com, Karras,	Not Reached	
Overall Outcome			1	

IV. ORDER

For the reasons given, it is

ORDERED, based on a preponderance of the evidence that the claim of the '741 patent is unpatentable; and

[7] Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

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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