

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DORMAN PRODUCTS, INC.,
Petitioner,

v.

PACCAR, INC.,
Patent Owner.

Case IPR2014-00542
Patent D525,731 S

Before JAMES T. MOORE, PHILLIP J. KAUFFMAN,
and PHILIP J. HOFFMANN, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, Dorman Products, Inc., seeks review of the sole claim of US Patent No. D525,731 S (Ex. 1001, “the ’731 patent”). *See* Paper 1 (“Pet.”). Patent Owner, PACCAR, Inc., contends that Petitioner’s request should be denied. *See* Paper 9 (“Prelim. Resp.”). As detailed in the following opinion, Petitioner has not established a reasonable likelihood of prevailing on the claim challenged. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.108. Consequently, we do not institute *inter partes* review.

A. *Related Proceedings*

Petitioner identified, as a related proceeding, co-pending case, *Dorman Products Inc. v. PACCAR, Inc.*, Civil Action No. 2:13-cv-06383-JD (E.D. Pa.). Pet. 2; *see* Ex. 1002.

B. *The ’731 Patent and Claim*

In an *inter partes* review, “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b). With regard to design patents, it is well-settled that a design is represented better by an illustration than a description. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)). Although preferably a design patent claim is not construed by providing a detailed verbal description, it may be “helpful to point out . . . various features of the claimed design as they relate to the . . . prior art.” *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”).

The '731 patent is entitled “Truck Headlamp,” and the claim recites, “[t]he ornamental design for a truck headlamp, as shown and described.” Ex. 1001, 1. The first embodiment, depicted in Figures 1–7, is a left side truck headlamp (the driver’s side in North American vehicles), and the second embodiment, depicted in Figures 8–14, is a right side truck headlamp (the passenger’s side in North American vehicles). *See* Ex. 1001, 1; Prelim. Resp. 4. Broken lines in the Figures form no part of the claimed design. Ex. 1001, 1.

The parties use different nomenclature for the elements of the headlamp.¹ We utilize the nomenclature provided by Patent Owner because it names more of the elements involved. *See, e.g.*, Pet. 19, 21; Prelim. Resp. 7–8. Figure 9 of the '731 patent, as annotated by Patent Owner, follows:

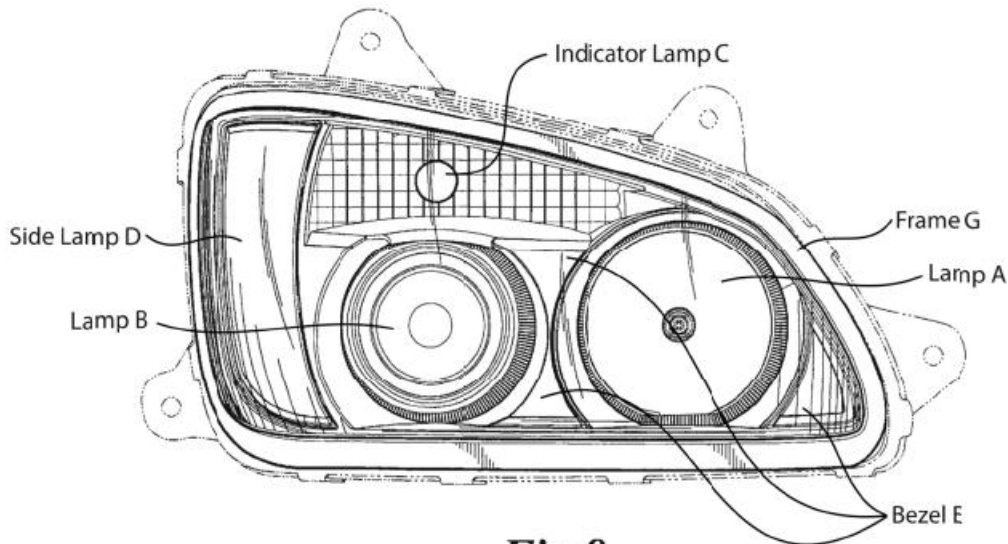


Fig. 9.

¹ Nomenclature of elements is not provided in the '731 patent itself.

Figure 9 is a front elevation view of the second embodiment of a truck headlamp (the right or passenger side). Ex. 1001, 1 (Figure description); Prelim. Resp. 7 (description), 8 (annotated Figure).

The parties acknowledge that the focus of an obviousness inquiry is the visual impression of the claimed design as a whole. *See* Pet. 13–15; Prelim. Resp. 26; *High Point Design*, 730 F.3d at 1312 (citing *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)). The parties disagree with regard to whether functional elements of the design form part of the claim. Petitioner asserts that the design feature of a given embodiment cannot be the result of functional or mechanical considerations, and therefore the functional elements² of the headlamp of the '731 patent do not form part of the claim. Pet. 12, 15–17; *see also* Pet. 21–37 (arguing that the facets and the curved bezel are functional features). Patent Owner argues that whether or not these elements are functional, they must be considered and construed as part of the visual impression created by the patented design as a whole. Prelim. Resp. 25–26. For the reasons that follow, we agree with Patent Owner.

Petitioner conflates invalidity based on functionality under 35 U.S.C. § 171 with invalidity based on obviousness under 35 U.S.C. § 103. An ornamental design for an article of manufacture may not be patented if that design is “primarily functional” rather than “primarily ornamental.” *See* 35 U.S.C. § 171; *High Point Design*, 730 F.3d at 1315. If a design is dictated

² Petitioner identifies the following as functional elements: the headlamp’s shape (trapezoidal or cat eye), Bezel E (the curved bezel), and the interior checkered surface pattern (facets) and striations. Pet. 12 (featuring Petitioner’s parenthetical nomenclature).

by the utilitarian purpose of the article, it is not “primarily ornamental” and may be declared invalid under 35 U.S.C. § 171. *High Point Design*, 730 F.3d at 1315.

Beyond the requirement that the design be “primarily ornamental,” § 171 incorporates the requirement of nonobviousness under § 103 by reciting that an ornamental design must meet the “conditions and requirements” of title 35. Therefore, as the Federal Circuit acknowledged in *High Point Design*, whether a design patent is “primarily ornamental” is an inquiry that is distinct from the nonobviousness requirement. *High Point Design*, 730 F.3d at 1311–17 (separately addressing invalidity based on functionality under 35 U.S.C. § 171 and invalidity based on obviousness under 35 U.S.C. § 103).

Further, a challenge based on functionality under 35 U.S.C. § 171 is not permitted in an *inter partes* review because it is not based on 35 U.S.C. § 103 nor is it based on prior art that consists of a patent or printed publication. 35 U.S.C. § 311(b); 37 C.F.R. § 42.105(b)(2). Therefore, we agree with Patent Owner that the allegedly functional elements identified by Petitioner (Pet. 12) must be considered in an obviousness analysis of the visual impression created by the patented design as a whole (Prelim. Resp. 26). We further analyze the ’731 patent through comparison to the primary reference in section II.B. below.

C. *Prior Art Relied Upon*

Petitioner’s challenge relies upon the following items of asserted prior art:

Exhibit #	Reference	Date
1005	Kenworth T600 Brochure	1996
1006	Kenworth T600A Brochure	Aug. 1991
1007	Kenworth T660 Brochure	2007
1009	US D498,859 S to Kobayashi	Nov. 23, 2004
1010	US D476,430 S to Ikuma	June 24, 2003
1011	US Des. 426,905 to Cook	June 20, 2000
1012	US 4,704,661 to Kosmatka	Nov. 3, 1987
1013	US 5,272,408 to Levin	Dec. 21, 1993
1017	Chrysler Town and Country Brochure	2001
1018	Chrysler Sebring Convertible Brochure	2001
1021	Chrysler PT Cruiser Brochure	2001

D. The Asserted Grounds

Petitioner asserts that the claim of the '731 patent is unpatentable based upon the following grounds under 35 U.S.C. § 103:

References
Kobayashi, the Kenworth T600A brochure ³ , Ikuma, and Cook
Kobayashi and the Chrysler Town and Country Brochure
Kobayashi and the Chrysler Sebring Convertible Brochure
Kobayashi and the Chrysler PT Cruiser Brochure

³ Petitioner repeatedly states that this ground is over “the T660A brochure.” See, e.g., Pet. 4, 18–20. The Exhibits include Kenworth T600, T600A, and T660 brochures (Exhibits 1005–1007, respectively), but do not include a “T660A” brochure. The Petition includes a figure purported to be page 7 of the T660A brochure (Pet. 20). This figure actually is found at page 7 of the Kenworth T600A brochure (Ex. 1006). From this, we conclude Petitioner intended this ground to be over the Kenworth T600A brochure (Ex. 1006) and not the Kenworth T660A.

II. ANALYSIS

A. Principles of Law

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). Here, the parties agree that the relevant designer of ordinary skill is “someone with a background and training in vehicle headlight designs and who is presumed to have knowledge of the prior art relevant to vehicle headlight designs.” Pet. 13; Prelim. Resp. 23.

This obviousness inquiry consists of two steps. *Apple*, 678 F.3d at 1329. 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)).

B. Primary Reference

Each of Petitioner’s four grounds of unpatentability relies on Kobayashi as the primary or *Rosen* reference.⁴ Pet. 4–5, 18–60. Kobayashi’s design patent is entitled, “Combination Lamp for an Automobile,” and the claim recites, “[t]he ornamental design for a combination lamp for an automobile, as shown and described.” Ex. 1009, 1. Figures 1, 2, and 3 of Kobayashi follow:

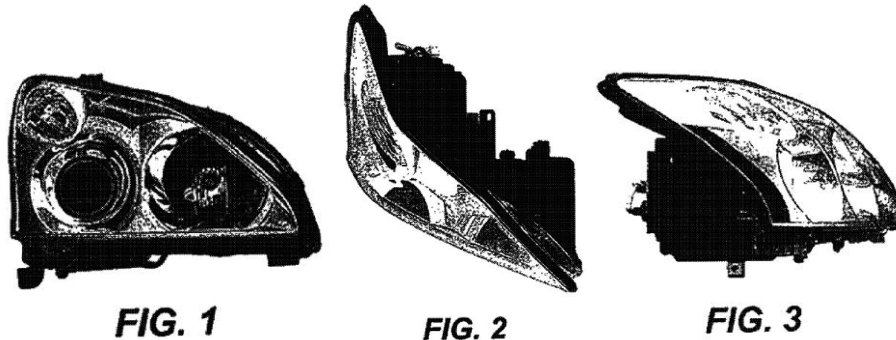


Figure 1 is front elevation view, Figure 2 is a top plan view and Figure 3 is a left side elevation view of Kobayashi’s automobile lamp. Ex. 1009, 1.

Petitioner contends that Kobayashi is a proper primary or *Rosen* reference because in front elevation view, Kobayashi’s headlamp and the ’731 headlamp are essentially the same shape (trapezoidal or cat eye) and design. Pet 12, 18, 37, 45, 52. Petitioner proposes to modify the Kobayashi headlamp by adding a side Lamp D,⁵ adding striations and a checkered

⁴ Our analysis references Petitioner’s contentions in the first ground of unpatentability, and the contentions in the other grounds are similar.

⁵ Referred to by Petitioner as a: “vertically positioned rectangular light (turn

surface pattern, and curving the bezel. Pet. 19–39 (similar modifications in other grounds). Though not explicit, by proposing these modifications to Kobayashi, Petitioner acknowledges that Kobayashi does not include a side Lamp D, striations, and a checkered surface pattern as shown in the patented design.

Petitioner’s analysis does not address Frame G of the ’731 patent, an element not present in Kobayashi. Pet. 18–37; Prelim. Resp. 35; Ex. 1009, Fig. 1. Nor does Petitioner’s analysis address repositioning of Lamp C or the difference in shape between Kobayashi’s Lamp C and the claimed design. In sum, Petition asserts that Kobayashi’s lamp is basically the same as the claimed design, despite: the absence of Lamp D, the lack of striations and a checkered surface pattern, the lack of a curved bezel, the lack of a frame G, and the differences in position and shape of Lamp C. For the reasons that follow, we do not agree.

Figure 9 of the ’731 patent and Figure 1 of Kobayashi follow:

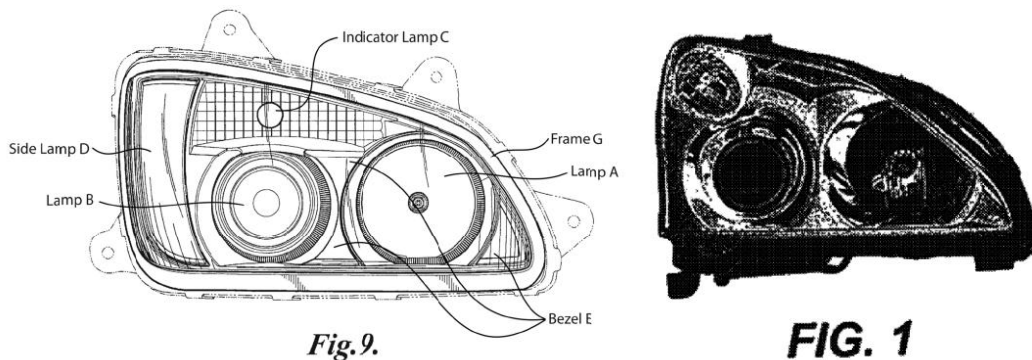


Figure 9 of the ’731 patent and Figure 1 of Kobayashi are front elevation views. Ex. 1001, 1; Ex. 1009, 1. The top side of the ’731 headlamp deviates

indicator),” “vertical indicator light,” and “turn signal indicator.” Pet. 12, 19, 20.

far less from horizontal than does the top side of the Kobayashi lamp, and it does not cut across the circular shape of Lamp A.

The result is that the '731 headlamp retains most of its height from left to right. The visual impression created by the '731 headlamp approximates a trapezoid, a shape that is further emphasized by Frame G. In contrast, the top side of the Kobayashi lamp, from the left side to the right side, bends near the midpoint to a greater angle from horizontal, and then in the final roughly ten percent of its length, bends again to an even greater angle from horizontal that approaches vertical. The consequence is that Kobayashi's lamp does not retain most of its height from left to right. The visual impression created by Kobayashi's lamp approximates a right triangle (right angle in the bottom left corner), a shape that is emphasized by the top side cutting a chord across circular Lamp A. Therefore, we cannot agree with Petitioner's assertion that the headlamp of the '731 patent and Kobayashi have essentially the same shape.

Although the above is sufficient to show that design characteristics of Kobayashi's headlamp are not basically the same as those of the '731 headlamp, there are several additional distinctions between Kobayashi and the claimed design. As detailed above, Petitioner's contention that it would have been obvious to make Kobayashi's Bezel E curved implies that it is not curved as claimed. Pet. 22.

Figure 11 of the '731 patent and Figure 2 of Kobayashi follow:

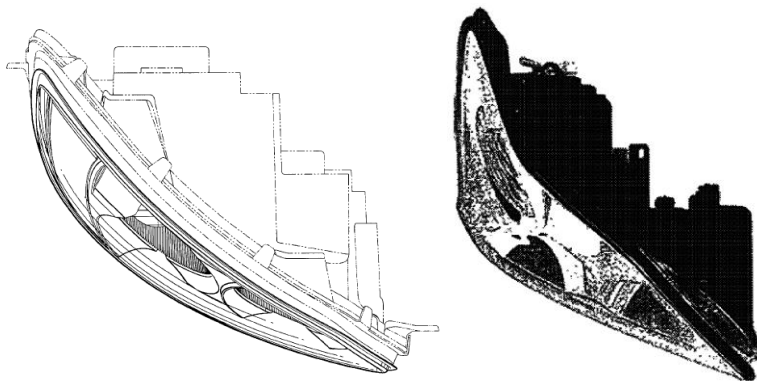


Fig.11.

FIG. 2

Figure 11 of the '731 patent and Figure 2 of Kobayashi are top plan views. Ex. 1001, 1; Ex. 1009, 1. The '731 headlamp is arcuate along its length with a gradual change to a tighter curvature (shorter radius) from front to rear.⁶ The Kobayashi lamp is not arcuate along its length; rather, it is formed by two relatively straight segments joined by a sharper curve.

Petitioner does not address the shape of the lamps in an inboard facing side elevation view.

Figure 14 of the '731 patent and Figure 3 of Kobayashi follow:

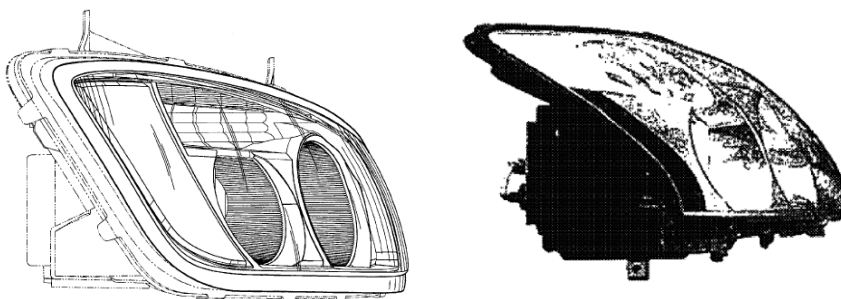


Fig.14.

FIG. 3

⁶ From “front to rear” is made in reference to the vehicle and the headlamp.

Figure 14 of the '731 patent and Figure 3 of Kobayashi are inboard facing side elevation views. Ex. 1001, 1; Ex. 1009, 1. The lamps are dissimilar in that the left side of the '731 headlamp is approximately straight along most of its length, while the left side of Kobayashi's lamp is arcuate.

The lamps are also dissimilar in that, as detailed above, the '731 headlamp includes a side Lamp D and a Frame G, both of which are absent from Kobayashi's lamp. Additionally, indicator Lamp C of the '731 patent is roughly rectangular with a checkered appearance and is positioned just below the upper side of the lamp above Lamp B and part of Lamp A. Kobayashi's indicator Lamp C is oval shaped, without a checkered appearance, and is partially above Lamp B in the upper-outboard-most corner of the lamp.

In light of the difference in shape in front elevation view and the numerous other differences noted above, we are not persuaded that a designer of ordinary skill would have viewed the Kobayashi lamp to give the same visual impression as the '731 patent. For this reason, Petitioner has not shown a reasonable likelihood of prevailing with regard to any of the grounds of unpatentability.

C. Secondary References

Even if Kobayashi were a valid primary reference, which we have determined above it is not, the modification proposed by Petitioner would not result in "the same overall visual appearance as the claimed design." *High Point Design*, 730 F.3d at 1311. For example, in each of the four grounds of unpatentability, because Kobayashi does not include a side Lamp D, Petitioner proposes to add such a lamp as disclosed by a secondary

reference (i.e., the Kenworth T600A brochure, the Chrysler Town and Country Brochure, the Chrysler Sebring Convertible Brochure, and the Chrysler PT Cruiser Brochure). Pet. 18–60.

As discussed above, Lamp D of the '731 design is positioned outboard of Lamp B, is generally rectangular⁷ with the vertical sides longer than the horizontal sides, and the inboard vertical side is arcuate and arced away from Lamp B. Ex. 1001, Figs. 8, 9, 11, 14. None of the secondary references cited by Petitioner are generally rectangular. Pet. 19–20; Ex. 1006, 7 (ground based on the Kenworth T600A brochure having a Lamp D with the outboard vertical side angled inward); Pet. 38-39; Ex. 1017, 10 (ground based on the Chrysler Town and Country Brochure having a Lamp D with arcuate left and right sides); Pet.46-48; Ex. 1018, 21 (ground based on the Chrysler Sebring Convertible Brochure having a Lamp D with arcuate left and right sides); Pet. 53–54; Ex. 1021, 5 (ground based on the Chrysler PT Cruiser Brochure having a tear drop shaped Lamp D). Even assuming that an ordinary designer would have been prompted to modify Kobayashi's lamp to include a Lamp D as disclosed by each respective secondary reference, the resulting design would not have the overall appearance of the '731 patent claim.

On this record, Petitioner has not shown a reasonable likelihood of prevailing with regard to any of the grounds of unpatentability.

⁷ Petitioner acknowledges Lamp D is rectangular. *See* Pet. 12.

III. CONCLUSION

Upon consideration of the Petition and Preliminary Response, we are not persuaded, for the reasons discussed, that there is a reasonable likelihood that Petitioner would prevail on at least one alleged ground of unpatentability with respect to the claim of the '731 patent.

IV. ORDER

It is

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

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