

# Design Patent Case Digest

[Dorman Products, Inc. v. PACCAR, Inc.](#)



**Decision Date:** September 5, 2014

**Court:** Patent Trial and Appeal Board

**Patents:** [D525,731](#) and [D526,429](#)

**Holding:** Petitions to Institute Inter Partes Review DENIED

## **Opinion:**

Dorman Products, Inc., a provider of replacement automotive parts, filed a petition requesting *inter partes* review of U.S. Design Patent No. D525,731 ("the '731 Patent"), entitled "Truck Headlamp," and another petition requesting *inter partes* review of U.S. Design Patent No. D526,429 ("the '429 Patent"), entitled "Surface Configuration of Truck Headlamp." PACCAR, Inc., a designer and manufacturer of trucks, owns both the '731 Patent and the '429 Patent. Dorman's petition challenged the sole claim of each patent as obvious in light of various combinations of design patents and car brochures. The Patent Trial and Appeal Board ("the Board") evaluated whether Dorman had a reasonable likelihood of prevailing on the challenged claim, which is the required standard for instituting *inter partes* review.

Each party acknowledged that an obviousness inquiry for a design patent must focus on "the visual impression of the claimed design as a whole," but the parties disagreed on whether functional elements form part of the claimed design. According to Dorman, the headlamp's "trapezoidal or cat eye" shape and curved bezel in both the '731 Patent and the '429 Patent and the interior checkered surface pattern in the '731 Patent are all functional elements that do not form part of the claim. PACCAR argued that whether or not they are functional, such features must be considered as part of the visual impression of the claimed design.

The Board agreed with PACCAR and stated that Dorman was improperly conflating invalidity based on functionality—an ornamental design may not be patented if the design is primarily functional—with invalidity based on obviousness. Also, the Board clarified that invalidity based on functionality could not be challenged here because an *inter partes* review only allows challenges under 35 U.S.C. § 102 and 35 U.S.C. § 103 based on prior art consisting of patents or printed publications. Therefore, the Board considered all features of the claimed designs in its obviousness inquiry.

An obviousness inquiry in a design patent case consists of two steps. First, the tribunal must find a primary reference that has design characteristics basically the same as the claimed design. Second, the primary reference may be modified by secondary references to create a visual impression that is the same as the claimed design, but only if the secondary references 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.”

Between the two petitions, Dorman provided multiple grounds of obviousness with different primary references. The primary references included U.S. Design Patent No. [D498,859](#) (“Kobayashi”), U.S. Design Patent No. [D426,905](#) (“Cook”), and U.S. Design Patent No. [D421,817](#) (“Tucker”), as well as the 2001 Chrysler Sebring Convertible Brochure (“Sebring Brochure”). In evaluating each of these references, the Board found none of them to be a proper primary reference for either the ‘731 Patent or the ‘429 Patent.

The Board explained that in front elevation view both the ‘731 Patent and the ‘429 Patent create the visual impression of a non-rectangular trapezoid. In contrast, the Board stated, Kobayashi creates the visual impression of a right triangle and both Cook and Tucker create the visual impression of what approximates a rectangle. With regard to the Sebring Brochure, the Board described the headlamp as “arcuate and angled downward” on the bottom side and “arcuate and curved inward” on the left side. The Board found this different than the ‘429 Patent, which has a bottom side that is “approximately straight and extends horizontally” and a left side that is “approximately straight and at approximately a 90° angle relative to the bottom side.” While the Board indicated these differences are sufficient to show the design characteristics are not the same, it also found other differences not addressed by Dorman, such as differences evident from side views of the headlamps.

The Board went further to state that even if Kobayashi, Cook, Tucker, or the Sebring Brochure was a proper primary reference, any modification by secondary references still did not create the same visual impression as the claimed designs. In denying the petition for *inter partes* review of the ‘731 Patent, the Board indicated that even if there was a reason to modify the primary reference, none of the secondary references contain a lamp positioned on the outer side that is the same shape as the lamp in the ‘731 Patent. Therefore, none of the grounds for obviousness would have the same overall appearance as the claimed design. Similarly, none of the references have a curved bezel that is sufficiently similar to the claimed design of the ‘429 Patent to create the same overall appearance.

Accordingly, the Board found that Dorman had not shown a reasonable likelihood of prevailing with regard to any of the grounds of unpatentability and denied institution of *inter partes* review in response to both petitions.  
the patented design.

If you have any questions or would like additional information on this topic, please contact:

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