

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LKQ CORPORATION,  
Petitioner,

v.

GM GLOBAL TECHNOLOGY OPERATIONS LLC,  
Patent Owner.

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IPR2020-00062 (Patent D811,964)  
IPR2020-00063 (Patent D828,255)  
IPR2020-00064 (Patent D823,741)  
IPR2020-00065 (Patent D813,120)<sup>1</sup>

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

DANIELS, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceedings  
37 C.F.R. § 42.5

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<sup>1</sup> This Order addresses issues pertaining to all four cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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Petitioner requested, by emails dated February 20, 2020, a conference with the Board seeking authorization to file a motion under 37 C.F.R. 42.71(a) to terminate IPR2020-00063 and IPR2020-00065, and also seeking authorization under 37 C.F.R. 42.108(c) to file a reply to Patent Owner's Preliminary Response in IPR2020-00062 and IPR2020-00064. We conducted a conference call on February 25, 2020, with Patent Owner's and Petitioner's counsel. We address Petitioner's requests, below, in turn.

*Authorization to file a motion to dismiss  
IPR2020-00063 and IPR2020-00065*

Petitioner indicated in its emails that it desires to terminate these *inter partes* review proceedings without prejudice and, instead, file a consolidated *ex parte* reexamination of the '255 and '120 patents. This situation is unique because Patent Owner is opposed to dismissal and termination of these proceedings. Patent Owner argues that Petitioner is unfairly forum shopping within the Patent Office by terminating these Petitions in order to file an *ex parte* reexamination. Patent Owner argues that it has expended significant effort in these proceeding defending its patents, developing evidence and filing its Preliminary Response in each case. To end these proceedings without a decision on the merits, and particularly without prejudice, is unfair, Patent Owner argues, because no estoppel will apply and allows Petitioner to attack its patents again at a later date.

We explained to Petitioner's counsel that, rather than simply termination, because we have not made any determination on institution in this case, that authorization would properly be styled as a motion to dismiss

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the Petition. 37 C.F.R. § 42.71. Also, with respect to Patent Owner's argument and alleged prejudice, we told the parties that we were unaware of any Board precedent, rule, or statute which permits the Board to dismiss or terminate with prejudice an *inter partes* review proceeding. We also pointed out that Petitioner can file an *ex parte* reexamination at this phase of the *inter partes* review proceedings.

We instructed the parties to meet and confer on the matter of dismissal and prejudice in these proceedings and see if they can come to agreement on any issues pertaining to future *inter partes* review filings. We note that whether a statutory provision such as Section 315(a)(1) bars a subsequent petition and whether the Board will apply its discretion pursuant to Sections 314(a) and 325(d) to deny a subsequent petition are questions that the Board decides after filing of such a subsequent petition, not before.

We authorized Petitioner to file an eight (8) page motion to dismiss its Petition, due March 6, 2020, and Patent Owner an eight (8) page opposition, due March 20, 2020.

*Authorization to file a reply to Patent Owner's Preliminary Response  
IPR2020-00062 and IPR2020-00064<sup>2</sup>*

Petitioner also requests to file a reply to Patent Owner's Preliminary Response to address several issues with respect to printed publications, namely, (1) whether Petitioner's asserted grounds are based on printed publications; (2) which printed publications were specifically relied upon for Petitioner's grounds, versus as supporting evidence probative of the printed

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<sup>2</sup> Unless otherwise noted, we refer to the papers and exhibits numbers in IPR2020-00064 under this heading.

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publications status of Petitioner’s relied-upon references; (3) whether certain references were available prior to the critical date of the challenged patent; and (4) clarifying a typographical error that erroneously suggests more than one reference was relied upon.

Review of the Preliminary Response indicates that one of Patent Owner’s main arguments is specifically that “[b]oth Grounds 1 and 2 fail because they are based on a physical vehicle—the ‘2015 Cadillac Escalade’—not ‘patents or printed publications.’” Paper 7 (“Prelim. Resp.”), 8. Patent Owner argues that it is unclear which exhibit, i.e. Ex. 1007, or Ex. 1008, or the physical 2015 Cadillac Escalade, Petitioner is in fact relying on for the asserted grounds as the purported secondary reference. *Id.* at 9. After discussing with the parties, we determined that the question is mainly whether Grounds 1 and 2 in the Petition include as part of the challenge, a printed publication, or the physical vehicle itself, and whether the challenges and supporting evidence relied upon by Petitioner have been set forth in the Petition with sufficient particularity. *See* Paper 2 (“Pet.”), 30 (stating that “[a]t least as early as August 4, 2015, the design of Patent Owner’s undisclosed 2015 Cadillac Escalade prior art was made publicly available online by Cadillac Worldwide and included a copyright date of 2015 attributed to General Motors.” (citing Ex. 1008; Ex. 1010 ¶ 8)), *and see* Prelim. Resp. 9 (Patent Owner arguing that Petitioner has impermissibly relied “on the ‘2015 Cadillac Escalade’ vehicle as purported prior art.”). In this regard, Patent Owner’s argument, and Petitioner’s issues (1), (2), and (4) are directed to the sufficiency of the Petition under 35 U.S.C. § 312(a).

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Petitioner is authorized to file a five (5) page reply to address these issues as to the sufficiency of the Petition under 35 U.S.C. § 312(a). 37 C.F.R. § 42.108(c). As we also directed during the call, no new evidence should be included or filed with any reply. No sur-reply was authorized.

Also during the call, Petitioner’s counsel raised specifically issue (3), indicating a desire to submit with its reply, evidence in the form of an affidavit from the Internet Archive, which could potentially be supplemental information (37 C.F.R. § 42.123) or supplemental evidence (37 CFR § 42.64(b)) with respect to foundation and public availability of certain printed publications as of the asserted dates. *See* Pet. 28, n.4 (The Petition states that “[a]n affidavit has been requested from the Internet Archive with respect to Exhibits 1005 and 1007–1009.”). First, we point out that Patent Owner did not specifically dispute, or raise, the issue of any specific date of public availability of the purported printed publications in its Preliminary Response. Prelim. Resp. 8–9. Thus, such supplemental information or supplemental evidence is not appropriate for a reply in this case. *See Hulu, LLC v. Sound View Innovations, LLC*, Case IPR2018-01039, Paper 29 at 14 (PTAB Dec. 20, 2019) (Precedential) (explaining that the additional “evidence must be responsive to the prior briefing.” (citing 37 C.F.R. § 42.23)). To the extent Petitioner desires to submit supplemental information or supplemental evidence, Petitioner may, at the proper time, respond to Patent Owner’s evidentiary objections or request authorization from the Board to file a motion to submit supplemental information. 37 C.F.R. §§ 42.108(c), 42.23, 42.64, 42.123.

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