
The Federal Circuit's New Nonobviousness Standard For Design Patents

For the first time in decades, the Federal Circuit has a new standard to assess the nonobviousness of design patents. *LKQ Corp. v. GM Global Tech. Op. LLC*, No. 2021-2348 (Fed. Cir. May 21, 2024).

Instead of its rigid, 30-year old *Rosen-Durling* test,¹ which required the references and challenged design to be “basically the same,” the Federal Circuit will now apply the utility patent nonobviousness standard to design patents. This new approach is more flexible and aligns with Supreme Court precedent, including *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

The Old Guard: *Rosen-Durling*

The long-standing *Rosen-Durling* test for the nonobviousness of design patents has two prongs: (1) whether a primary reference is “basically the same” as the challenged design claim; and (2) if a suitable primary reference is identified, whether any secondary references are “so related” to the primary reference that features in one would suggest application of those features to the other.²

The *LKQ* appeal involves GM's U.S. Design Patent No. D797,625, which claims a design for a vehicle's front fender. In an *inter partes* review before the Patent Trial and Appeal Board (PTAB) at the United States Patent and Trademark Office, LKQ challenged the '625 patent as obvious in light of a primary and secondary reference. In a final written decision, the PTAB upheld the '625 patent's nonobviousness because LKQ failed prong one of the *Rosen-Durling* test, *i.e.*, LKQ did not identify “a single reference that creates basically the same visual impression” as the patented design.³ LKQ appealed, and the Federal Circuit eventually reheard that appeal *en banc*.

The Future: Applying the *Graham* Factors to Design Patents

In its *en banc* decision, the Federal Circuit abrogated the *Rosen-Durling* test because the test is improperly rigid and does not align with *KSR* and other 35 U.S.C. § 103 precedent, which suggest a broad, flexible approach to the obviousness analysis. Instead, the three *Graham* factors (with some modifications) should be used to determine the obviousness of a patented design.⁴ Those factors are as follows:

¹ *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (quoting *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982)).

² Unlike for obviousness, the Federal Circuit did not disturb the “ordinary observer” test for anticipation of a design patent, which provides that “if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.” (quoting *Gorham Manufacturing Co. v. White*, 81 U.S. 511, 528 (1871)).

³ 2021 Pat. App. LEXIS 4724, 2021 WL 3411458, at *48-49 (citation omitted).

⁴ The *Graham* factors are used to assess the validity of a utility patent under § 103. See *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

-
- **Factor One:** consider the “scope and content of the prior art” within the knowledge of an ordinary designer in the field of the design.

Sticklers No More – The Analogous Prior Art Standard

The scope and content of the prior art now encompass art that is analogous to the challenged design. The Federal Circuit declined to delineate the “full and precise” analogous art test for design patents, but explained that the primary reference will likely be the prior art design that is most visually similar to the claimed design, and will typically be in the same field of endeavor as the claimed design’s article of manufacture. Therefore, under *LKQ*—and unlike in *Rosen* and *Durling*—there is no threshold similarity or “basically the same” requirement to qualify as prior art. Analogous art will suffice.

- **Factor Two:** determine the visual differences between the prior art designs and the design claim at issue.

The Artist Formerly Known As POSA

Whereas the nonobviousness of a utility patent is assessed from the perspective of the person of ordinary skill in the art (“POSA”), nonobviousness of a design patent is assessed through the eyes of the ordinary designer.

Specifically, the comparison between the prior art and claimed design is made from the perspective of an “ordinary designer in the field of the article of manufacture.” For example, the comparison between a claimed bottle design and prior art bottles should be made from the perspective of an ordinary bottle designer;⁵ likewise, the comparison between a claimed tire tread design and prior art tire treads should be made from the perspective of an ordinary tire designer.⁶

- **Factor Three:** determine the ordinary skill in the pertinent art, *i.e.*, the viewpoint of an ordinary designer who designs articles of the type presented in the application or patent.⁷

The *Graham* factors are then applied to the obviousness inquiry: a design is obvious if an ordinary designer in the field to which the claimed design pertains would have been motivated to modify the prior art design “to create the same overall visual appearance as the claimed design.”⁸ The *Graham* obviousness inquiry also requires assessment of secondary considerations as indicia of nonobviousness, when presented (though the Federal Circuit declined to create a design-specific secondary considerations analysis).⁹

Next Steps for Design Patent Practitioners

By abandoning/abrogating the *Rosen-Durling* test in favor of the *Graham* factors, the Federal Circuit made it considerably easier to invalidate a design patent claim for obviousness.

After *LKQ*, design patent prior art merely needs to be analogous, rather than highly similar, to the claimed design. And challengers are free to use secondary references to prove obviousness, even without an exceedingly

⁵ See *In re Borden*, 90 F.3d 1570 (Fed. Cir. 1996).

⁶ See *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372 (Fed. Cir. 2009).

⁷ See Factor Two, *supra*.

⁸ *Campbell Soup, Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021) (citation and quotation marks omitted).

⁹ See *Graham*, 383 U.S. at 17-18.

strong primary reference. Using these new tools at their disposal, challengers may find it easier to present multiple prior art references that together create the same overall visual appearance as the claimed design.

In addition to understanding the new challenges to obtaining or maintaining design patents, practitioners and patent owners should continue to monitor the district court's, the PTAB's, and the Federal Circuit's jurisprudence on this topic, especially regarding the open issues from *LKQ* (including a more precise test for analogous art and secondary considerations specific to design patents). Practitioners should also keep an eye out for any guidance or rule-making issued by the United States Patent and Trademark Office because that may be the first indication of how the examining division will interpret and implement the holding of *LKQ*.

Given that *LKQ* has expanded the possible universe of prior art, design patent owners should assess the strength of their design patents against similar items of manufacture to ensure that their designs are truly unique in the field. It is no longer enough that their claimed design is marginally different from that of the competition.

However, design patent owners can still rest assured that their patent, just like a utility patent, carries a presumption of validity under 35 U.S.C. §282.

* * *

If you have any questions about the issues addressed in this memorandum, or if you would like a copy of any of the materials mentioned in it, please do not hesitate to call or email authors Gerald J. Flattmann Jr. (partner) at 212.701.3645 or gflattmann@cahill.com; Andrew Cochran (counsel) at 212.701.3320 or acochran@cahill.com; or Camille Mangiaratti (attorney) at 212.701.3441 or cmangiaratti@cahill.com; or email publicationscommittee@cahill.com.

This memorandum is for general information purposes only and is not intended to advertise our services, solicit clients or represent our legal advice.