Keywords: **obviousness; design patent claims; 35 U.S.C. § 103.**

General: **Design patents no longer use the long-standing *Rosen-Durling* test to assess obviousness of a claimed design. Now, obviousness in designed patents are determined by the four-part Graham test which considers: the scope and content of the prior art, the differences between the prior art designs and the design claim at issue, the level of ordinary skill in the pertinent art, and the obviousness or nonobviousness of the claimed design.**

LKQ Corporation, Keystone Automotive Industries, Inc. v GM Global Technology Operations LLC.

United States Court of Appeals for the Federal Circuit
No. 2021-2348
Decided May 21, 2024

I. Facts

GM Global Technology LLC ("GM") owned U.S. Design Patent No. D797,625, which claimed the design of the front fender used in the 2018-2020 Chevrolet Equinox. LKQ Corporation and Keystone Automotive Industries, Inc. (collectively "LKQ") filed a petition to institute an inter partes review of GM's patent, claiming that it was unpatentable under 35 U.S.C. § 102 based on U.S. Design Patent No. D773,340 ("Lian") or under 35 U.S.C. § 103 on Lian alone or Lian as modified by a 2010 Hyundai Tucson promotional brochure ("Tucson").

The Board held that LKQ did not establish that Lian anticipated the claim of the D'625 patent. The Board then applied the long-standing *Rosen-Durling* test to assess the nonobviousness of the claimed design. The first step of the test requires a primary reference where "the design characteristic of which are basically the same as the claimed design." Only after this primary reference is established can other secondary references be used to modify the primary reference to create a design with the same overall visual appearance as the claimed design. The second step of the test requires secondary references be "so related to the primary reference that appearance of certain ornamental features in one would suggest the application of those features to the other." Applying this test, the Board determined LKQ failed to establish a suitable primary reference.

LKQ appealed to the Federal Circuit that, among other things, the Supreme Court's decision in *KSR* overruled the *Rosen-Durling* test. The panel ruled that it could not overrule the *Rosen-Durling* test without a clear directive from the Supreme Court, and it was not clear that the Supreme Court had done that. The Federal Circuit granted rehearing en banc to decide whether the *Rosen-Durling* test should be eliminated or modified, and if so, what test should be applied for evaluating design patent obviousness challenges.

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II. Issue

Should the *Rosen-Durling* test be eliminated?

III. Discussion

Yes. The court held that the statutory language of § 103 and Supreme Court precedent are inconsistent with the *Rosen-Durling* test.

In coming to the decision, the court relied on the Supreme Court precedent in *KSR*. In *KSR*, the Supreme Court rejected the "TSM" test, which stated that a patent claim was only proved obvious if "some motivation or suggestion to combine the prior art teachings existed in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art." The court explained that rigid, preventative rules that deny factfinders recourse to common sense are improper. The court further explained that while the TSM test might provide helpful insights, these insights "need not become rigid and mandatory formulas."

The court also relied on the Supreme Court case *Smith v Whitman Saddle Co.* In this case, the Supreme Court considered the patentability of an ornamental design for a saddle which "made up the front half of one known saddle and the back half (or cantle) or another, with a further modification to one half." In the analysis, the Court noted that it was customary for saddlers to make combinations of designs. The Supreme Court then concluded that combining the two known saddle designs was nothing more than an exercise of the ordinary skill of workmen of the saddle trade and thus did not make the claimed saddle design inventive.

Applying precedent to the first step of the *Rosen-Durling* test, the court explained that the standard that a primary reference have a design characteristic that was "basically the same" as the claimed design creates a rigid rule that is inconsistent with the Supreme Court's guidance in *KSR*. Furthermore, the court explained that the standard imposes limitations absent from § 103's broad and flexible standard. Finally, the court reasoned that the Supreme Court's analysis in *Whitman Saddle* was inconsistent with the "basically the same" standard, as in the analysis the Court never established any prior art that was "basically the same" as the claimed design. The Court rather based the analysis on the custom of saddlers to combine designs.

Applying precedent to the second step of the *Rosen-Durling* test, the circuit court similarly reasoned that the standard that secondary sources must be "so related" to the primary reference creates a rigid rule that is inconsistent with the Supreme Court's guidance in *KSR*. Furthermore, the court explained that the standard imposes limitations absent from § 103's broad and flexible standard. Finally, the court reasoned that the "so called" standard creates an analysis that was absent the *Whitman Saddle* decision, and contrary to the analysis employed by the Supreme Court.

The circuit court, after overruling the *Rosen-Durling* test, established that obviousness for design patents should be considered with the four-part *Graham* obviousness test. The first *Graham* factor is the "scope and content of the prior art." The court explained that a reference only qualifies as prior art for obviousness when there is a determination that it is analogous to the claimed invention. The court said that prior art designs for the same field of endeavors as the article of manufacture will be analogous and left future cases to further develop the application of the standard when prior art is not from the same field. The second *Graham* factor considers the visual

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differences between the prior art designs and the design claim at issue from the perspective of an ordinary designer in the field. The third *Graham* factor considers the level of ordinary skill of a designer in the field to which the claimed design pertains. Finally, the fourth *Graham* factor considers the obviousness or nonobviousness of the claimed design. The court explained that in using a primary reference with secondary references, though there is no need for a "so related" test, there does need to be some record-supported reason that an ordinary designer in the field of the article of manufacture would have modified the primary reference with the features of the second to achieve the claimed design. Furthermore, the court explained that success, industry praise, and copying may demonstrate nonobviousness of design patents.

IV. Conclusion

The court rejected the *Rosen-Durling* test for obviousness and replaced it with the four-part *Graham* factors. In the specific case, the court remanded for the Board to address the obviousness of the design patent with this new framework.