

In a precedential decision, the Federal Circuit in *LKQ Corp. v. GM Global Tech. Operations LLC*, 102 F.4th 1280 (Fed. Cir. 2024) has overruled the long-standing Rosen-Durling test, significantly altering the design patent landscape. Moving forward, the Graham factors, in combination with the teachings of KSR, will be utilized to assess the obviousness of design patents. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966); *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

The LKQ case involved a dispute between LKQ Corp. and GM over the validity of GM's design patents for automotive body parts. Following the expiration of their licensing agreement, GM accused LKQ of infringing on their design patents. LKQ challenged the validity of those patents through inter partes review (IPR), and eventually, the case made it to the Federal Circuit for an en banc review.

On appeal, the court considered three questions around the Rosen-Durling test. First, whether the decision in KSR overruled or abrogated the Rosen-Durling test. Second, if KSR did not overrule the Rosen-Durling test, whether the court should eliminate or modify the Rosen-Durling test. Finally, if either of the first two questions is answered affirmatively, which test should be applied for evaluating the obviousness of a design patent?

The Rosen-Durling test was a two-prong test, the first of which required that “before one can begin to combine prior art designs...one must find a single reference, ‘a something in existence, the design characteristics of which are basically the same as the claimed design.’” *LKQ Corp.*, 102 F.4th at 1289. This first prong, otherwise known as a Rosen reference, required the prior art to be “basically the same” to the point where the reference disclosed nearly every aspect of the claimed design. If such a reference was lacking, the analysis ended, and the claimed design was determined to be nonobvious. If a Rosen reference existed, the test proceeded to the Durling prong. This second prong required “once the primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design.” *Id.* Importantly, this secondary reference was required to be “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.” *Id.* (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

Reviewing the Rosen-Durling test, the court found it improperly rigid considering *Graham*, *KSR*, and *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893), all of which suggested a more flexible approach. For instance, in *Whitman Saddle*, the court did not ask whether either of the two prior art saddles were “basically the same” as the claimed invention; the court merely combined the two prior art references. *LKQ*, 102 F.4th at 1294; *Whitman Saddle Co.*, 148 U.S. at 680. Indeed, *Graham* emphasized the need for an “expansive and flexible approach” to obviousness. *Id.* (quoting *KSR*, 550 U.S. at 415);

Graham, 383 U.S. at 18. The second prong of the Rosen-Durling test fared no better since the “so related” requirement was analogous to the rigid teaching-suggestion-motivation test that was overruled in KSR. *Id.* at 1295. Thus, the court found the Rosen-Durling test inconsistent with the Supreme Court’s precedent (and the wording of 35 U.S.C. §

103), and thereby overruled the Rosen-Durling two-prong test for design patent obviousness. *Id.* at 1293

With the Rosen-Durling test gone, the obviousness of design patents will be evaluated using the Graham factors going forward. First, Graham requires a person to “consider the ‘scope and content of the prior art’ within the knowledge of an ordinary designer in the field of design.” *Id.* at 1295–96 (quoting Graham, 383 U.S. at 17). This step includes looking at what is considered analogous art. Although the court indicated that the typical two-part test—(i) same field of endeavor, and (ii) reference reasonably pertinent to a particular problem—used to determine analogous art was applicable, the court found there may be problems with the second prong since designs don’t relate to “particular problems.” Ultimately, the court left what qualifies as “analogous art” open for future case law to determine.

Having considered the scope and content of the prior art, step two requires “determining the differences between the prior art designs and the design claims at issue.” *Id.* at 1298 (citing Graham, 383 U.S. at 17). Here, the visual appearance of the claimed design is compared with that of the prior art “from the perspective of an ordinary designer in the field of the article of manufacture.” *Id.* Step three requires resolving “the level of ordinary skill in the pertinent art.” *Id.* (quoting Graham, 383 U.S. at 17). This step requires evaluating the knowledge of a designer who is of ordinary skill and designs articles in the field being considered.

Finally, step four requires analyzing “whether 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.’” *Id.* at 1299 (quoting *Campbell Soup, Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021)). Factors such as commercial success, industry praise, and copying will remain relevant in demonstrating nonobviousness, providing real-world evidence of the design’s impact and significance. However, the court left open the applicability of other secondary considerations such as long-felt but unresolved needs or failure of others.

Taken together, the Graham factors have years of supporting case law, albeit regarding utility patents, which will hopefully provide guidance as this area of law morphs to encompass design patents. The LKQ decision marks a pivotal change in the assessment of design patent obviousness; necessitating a more flexible, yet challenging,



examination process. Design patent applicants and holders must adapt by employing strategic measures to navigate the broader and more detailed scrutiny their applications will face. Despite these challenges, design patents remain a valuable tool for protecting innovative designs and maintaining a competitive advantage in the market.

For more information on how this decision may impact your design patent strategy, please contact our Intellectual Property team at Patterson Intellectual Property Law, P.C..



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