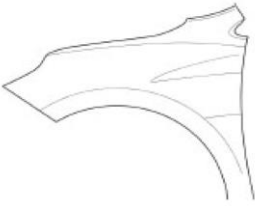



After 40 Years, a Fundamental Change to Design Patent Law  
*LKQ Corp.<sup>1</sup> v. GM Global Tech. Operations LLC, No. 21-2348 (Fed. Cir. May 21, 2024)*

By: Reid Huefner & Katie Schelli | May 24, 2024

On May 21, 2024, the Federal Circuit overruled its long-standing *Rosen-Durling* obviousness test for design patents and replaced it with the more flexible four-factor *Graham*<sup>2</sup> test. LKQ filed a petition for *inter partes* review of GM Global Technology Operations LLC’s U.S. Design Patent D797,625 (the “D’625 Patent”), asserting the D’625 Patent was invalid as obvious under 35 U.S.C. § 103. The Patent Trial and Appeal Board applied the *Rosen-Durling* test and found that the prior art did not render the D’625 Patent obvious. On appeal, a panel of the Federal Circuit affirmed, rejecting LKQ’s argument that the Supreme Court’s decision in *KSR International Co. v. Teleflex, Inc.*

'625 PATENT CLAIMED DESIGN	LIAN PRIMARY REFERENCE
	

overruled *Rosen-Durling*. *KSR* established a more lenient test for assessing obviousness in utility patents that LKQ asserted overruled the rigid two-part *Rosen-Durling* test.

For the first time in fifteen years, the Federal Circuit granted rehearing en banc in a design patent case to assess the merits of *Rosen-Durling*. The en banc court unanimously held in favor of LKQ, finding *Rosen-Durling* to be too rigid an unreconcilable with Supreme Court precedent and 35 U.S.C. § 103: “invalidity based on obviousness of a patented design is determined based on factual criteria similar to those that have been developed as analytical tools for reviewing the validity of a utility patent under § 103, that is, on application of the *Graham* factors.”

The court then delineated the four-part *Graham* test as it applies to design patents. The first factor—the scope and content of the prior art—applies the analogous art standard to all prior art references, replacing the “basically the same” and “so related” standards. However, a primary reference still must be determined in this factor to prevent hindsight bias. With utility patents, whether art is analogous depends on (1) whether the art is from the same filed of endeavor as the claimed invention; and (2) if the art is not in the same field of endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. The court noted that the first part of this standard applies readily to design patents, but the second part does not. It declined to “delineate the full and precise contours of the analogous art test for design patents,” holding that “[p]rior art designs for the same field of endeavor as the article of manufacture will be analogous, and we do not foreclose that other art could also be analogous,” leaving further development of the standard to future cases.

The remaining *Graham* factors mirror utility patent law. The second factor compares the visual appearance of the claimed design and the prior art to determine the differences between them. The third factor requires determining characteristics of a designer of ordinary skill in the art because an obviousness determination is from that designer’s viewpoint. The fourth and final factor requires determining “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;’” if answered in the affirmative, the design is obvious.

<sup>1</sup> **Disclaimer:** Irwin IP LLP is privileged to be lead counsel for LKQ Corporation and Keystone Automotive Industries, Inc. in several design patent infringement matters, including this case against GM Global Technology Operations and by extension General Motors Co. LKQ neither requested nor paid for preparation of this article, and the views expressed herein are those of the authors alone.

<sup>2</sup> *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

The court did not “disturb [its] existing precedent regarding ... secondary considerations such as commercial success, industry praise, and copying,” but noted uncertainty in the application of other secondary considerations—such as long felt but unresolved needs and failure of others—but, again, left these questions for future cases.

Briefly addressing concerns of overruling the *Rosen-Durling* test, the court noted that the *Graham* test has years of precedent that courts can draw on for assessing obviousness in the design patent. Though much of the test is a case-by-case factual analysis, the difficulties presented thereby are not unusual. This decision marks a significant change in how design patent obviousness analyses are conducted. The adoption of the flexible *Graham* test in design patent cases is likely to lead to more design patents being rejected at the USPTO (as noted in a [previous IP Case of the Week](#), under *Rosen-Durling*, 102/103 rejection rates during design patent prosecution were “about 4%” compared to nearly 70% for utility patents) and could potentially lead to longer trials with a higher success rate for defendants as design patent invalidity defenses will likely be more difficult to summarily dismiss.