US Design Patents following LKQ: Dramatic Change or Mere Harmonization?

Tracy-Gene G. Durkin[1], Christopher Sylvain[2], Richard J. McKenna[3], Translated by Chen Shan[4]

(1.Sterne, Kessler, Goldstein & Fox PLLC, Washington, DC 20005, USA; 2. Polson Intellectual Property Law, Westminster, CO 80234, USA; 3. Foley & Lardner LLP, Milwaukee, WI 53202-5306, USA; 4. Beijing NTD Law Office, Beijing 100033)

Abstract: The criteria for judging the obviousness of design patents are of great significance to the stability of design patents. In practice, due to the influence of subjective factors, the conclusion of the obviousness judgment of design patents has a certain degree of uncertainty. The US design patent system has made multiple adjustments to the criteria for judging obviousness, especially in 2024, when it underwent a significant innovation in conjunction with the LKQ case, making it converge with the obviousness judgment of US utility patents. This article introduces the development of the obviousness judgment of US design patents through multiple specific cases, focusing on the new criteria established in the LKQ case and its potential impact on the US design patent system.

Keywords: US design patent; US utility patent; judgment criteria of obviousness

On May 21, 2024, the US Court of Appeals for the Federal Circuit made a decision No. 2021-2348 on a patent case co-appealed by LKQ Corporation and Keystone Automotive Industries, Inc. (hereinafter collectively referred to as LKQ) against GM Global Technology Operations LLC (hereinafter referred to as GM) (hereinafter referred to as *LKQ* case). The court overruled the long-established *Rosen-Durling* test on determining obviousness of a US design patent and turned to the Graham test. This decision may potentially bring remarkable influences on the US design patent system and has caused extensive discussions among patent practitioners.

Below is a brief history of obviousness determination for US design patents, an introduction to the *LKQ* case, and potential impacts of the decision.

I. Brief history of the Design Patent Obviousness

To be eligible for a US design patent, 35 U.S.C. requires that a design must be:

(a) Novel § 102
(b) Non-obvious § 103
(c) Satisfy the written description requirement § 112
(d) Be ornamental § 171 (not purely functional)

Under 35 U.S.C. § 171, the provisions on patents for designs state:

(a) In General — Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.
(b) Applicability of This Title — The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

Under 35 U.S.C. § 103, the conditions for patentability and non-obvious subject

matter state:

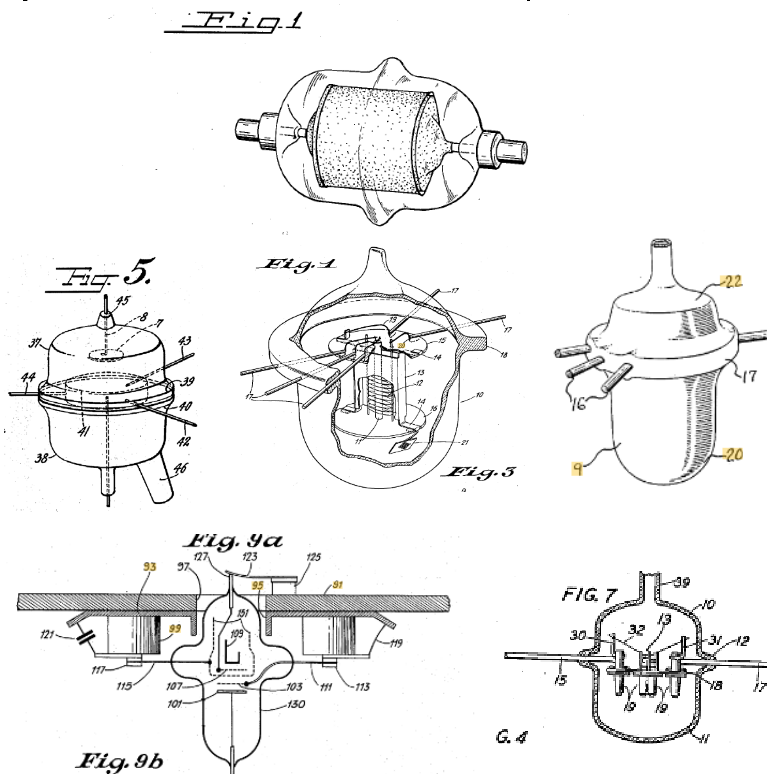
> "A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains."

The following five cases show the changes on obviousness determination of a design patent.

(i) *In re Jennings* (C.C.P.A. 1950)

In this case, the USPTO Board of Appeals affirmed the Examiner's rejection of Jennings' "vacuum condenser" based on a combination of 5 prior art references. The US Court of Customs and Patent Appeals (C.C.P.A.), which was the predecessor court to the Federal Circuit, reversed by stating:

> "the design must be viewed as a whole, as shown by the drawing, or drawings, and compared with something in existence - not with something that might be brought into existence by selecting individual features from the prior art and combining them, particularly where combining them would require modification of every individual feature, as would be required here".

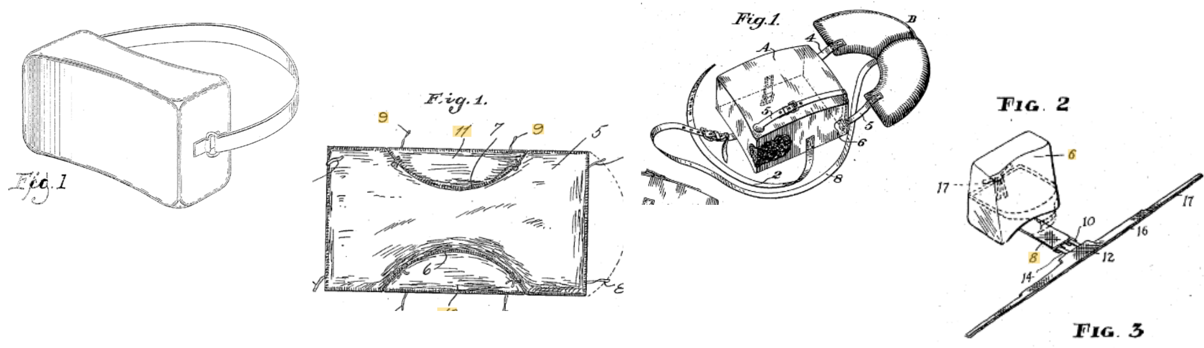


(ii) *In re Glavas (C.C.P.A 1956)*

In this case, the USPTO Board of Appeals affirmed the Examiner's rejection of Glavas' "float" based on a combination of 3 prior art references. The C.C.P.A. reversed by stating:

(i) "the design must be viewed as a whole, as shown by the drawing, or drawings, and compared with something in existence"

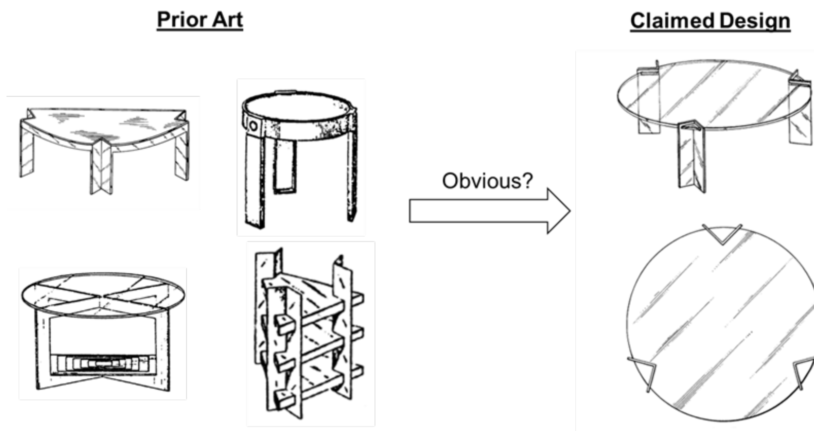
(ii) The question … is not whether the references sought to be combined are … analogous … in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other



(iii) *In re Rosen* (C.C.P.A. 1982)

In this case, the USPTO Board of Appeals affirmed the Examiner's rejection of Rosen's "Low Table" based on a combination of 4 prior art references. The C.C.P.A. reversed by stating:

> "[T]here must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness"

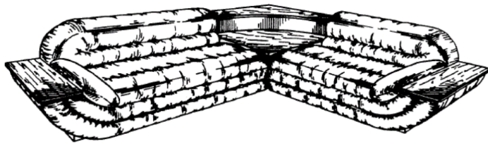


(iv) *Durling v. Spectrum Furniture Co.* (Fed. Cir. 1996)

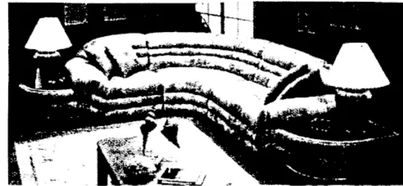
In this case, the error in the district court's approach is that it construed Durling's

claimed design too broadly “a sectional sofa with integrated end tables”. “The record contains no prior art design that creates basically the same visual impression as … Durling's claimed design … it is improper to invalidate a design patent on grounds of obviousness”. The Federal Circuit affirmed the patent validity.

Claimed Design



Prior Art

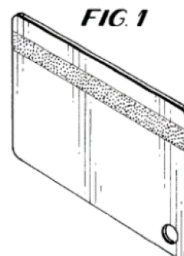


(v) *Vanguard Identification Systems Inc. v. Kappos and Bank of America* (Fed. Cir 2011)

In this case, the USPTO Board of Appeals reversed the Examiner’s alternate final rejections, each based on a combination of 2 references finding the “the aperture … critical to the overall appearance and visual effect of the claimed card design in a reexamination. The lack of an aperture in either primary reference made them not basically the same. The Federal Circuit affirmed under Rule 36.

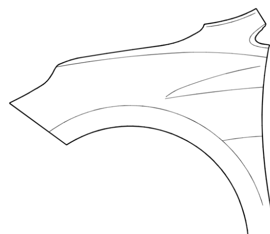
Prior Art

Claimed Design



II. Introduction to the LKQ case

General Motors (GM) owns U.S. Design Patent D797, 625 for “Vehicle front fender”, which is used in GM’s 2018-2020 Chevrolet Equinox.



Claimed Design

LKQ sells aftermarket car parts, i.e., replacement parts not produced by the original equipment manufacturer (OEM) which would be GM in this case. LKQ files case to challenge the validity of GM’s patent with the USPTO’s Patent Trial and Appeal

Board (PTAB). LKQ asserts two grounds:

(i) Anticipated by a prior art reference – design patent (Lian)

(ii) Obvious over Lian alone, or over Lian in view of another prior art reference – Hyundai Tucson brochure (Tucson)

The Board found no anticipation due to multiple differences between the claimed design and Lian. The Board found Lian was not a proper primary reference for obviousness under the *Rosen-Durling* test due to these differences (i.e., not "basically the same") and the case was dismissed.

The References

Primary reference (Lian) **Secondary reference (Tucson)**

LKQ appealed to the Federal Circuit (last stop before Supreme Court) and argued the Supreme Court's *KSR* decision implicitly overruled the *Rosen-Durling* test. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) rejected the long-established obviousness test for utility patents as being overly rigid, and held the obviousness determination must be expansive and flexible – consistent with the patent law statute (35 USC § 103) and case law precedent, and § 103 for obviousness applies equally to utility and design patents under U.S. law.

Federal Circuit overrules *Rosen-Durling* and states:

(i) The "basically the same" and "so related" requirements under the *Rosen-Durling* test are overly rigid and inflexible.

(ii) Proper framework is the Supreme Court's approach under *Graham v. John Deer Co.*, 383 U.S. 1 (1966):

Factor 1: What is the relevant prior art to the claimed design

Factor 2: What are the differences between the prior art and the claimed design

Factor 3: What is the knowledge and ordinary skill of a designer who designs articles of the type involved

Factor 4: Evaluate the obviousness or non-obviousness of the claimed design, which includes considering any other evidence

LKQ case particularly discusses Factors 1 and 4.

Factor 1 under *LKQ*: Scope of the prior art

A reference can be used as prior art under § 103 only if it is analogous art, which for utility patents means:

(1) From the same field of endeavor of the invention; or
(2) Reasonably pertinent to the problem faced by the inventor

Federal Circuit admits the second prong does not seem to apply to designs. Under new framework, a primary reference must still be identified which will likely be the closest prior art (but need not be “basically the same”), and leaves to future cases to develop the contours and application of the analogous art standard for designs. In short, open questions arise as to what prior art can now be used in the design obviousness analysis.

Factor 4 under *LKQ*: Evaluate obviousness

Test is whether the prior art (or combination thereof) creates the same overall visual appearance as the claimed design. Focus is the visual impression of the design as a whole, not the individual features of the design. Where a primary reference does not render the claimed design obvious, secondary references may be considered (but need not be “so related” such that features in one would suggest application in the other).

For motivation to combine references, there must be a record-supported reason that a designer in the field of the relevant article would have modified the primary reference with the feature(s) of the secondary reference(s) to create the same overall appearance as the claimed design.

Like with utility patents, any secondary evidence of indicators of non-obviousness must be considered for designs when present. What clearly applies are commercial success, industry praise, and copying by others, and what is unclear are long-felt but unsolved needs and failure of others.

III. Potential Impacts of the Decision

Federal Circuit adopts the Graham test, which is similar to that for utility patents and more flexible, when determining obviousness of design patents in the LKQ case, which brings significant changes compared with the Rosen-Durling test. The following factual inquiries from *Graham* must be made and be clear from the record:

(i) the scope and content of the prior art (which must be analogous to the claimed design but the court left for another day what is analogous for designs)
(ii) differences between the prior art and the claimed design
(iii) the level of ordinary skill in the art

Although the above changes have been made to the new test, the following aspects stay the same:

(i) Inquiry must focus on the design as a whole, not on design concepts or on individual features of the design.
(ii) The primary reference must be "something in existence" not something brought into existence by combining prior art.
(iii) The combination of prior art must disclose the same design as the claim.

Under the new test, some questions still remain:

(a) What is "analogous" art?
(b) What secondary considerations can apply to design patents?
(c) What is required to show "motivation to combine"?
(d) With the obviousness analysis being the same between utility and design patents, are there other analyses that are currently different between the two that should or could likewise be made uniform?

Although the LKQ case brings some changes and uncertainties to the US design patent system, what can be foreseen is that both the design patent prosecution and litigation would be potentially influenced by the newly-followed Graham test.

For design patent prosecution, arguments that the applied art is not analogous to the claimed design may become more common. Examiners may continue to narrow prior art searches to art that is analogous or from the same field of endeavor as the claimed design especially post *In re Surgisil*, 14 F.4th 1380 (Fed. Cir. 2021) (holding "[a] design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract"). The title may distinguish the field of endeavor. We may see an increase in the use of experts and evidence of secondary considerations (but limited to copying and must show nexus).

For design patent litigations, the potential Impacts may lie in the cost and outcome uncertainty being increased.

Old "improperly rigid" test means parties may have forgone obviousness challenges under *Rosen-Durling* (e.g., due to high burden of establishing a *Rosen* primary reference), while new "more flexible" test means parties may be relatively more willing to pursue obviousness challenges, trying different combinations/modifications of the prior art that they would not have made under the *Rosen-Durling* test. Increased use of opposing "designers of ordinary skill in the art" (expert reports, depositions, testimony, etc.) and more attorney briefing may bring net increase in costs.

Outcome uncertainty may be increased. Trial courts (U.S. federal district courts) for patent cases are largely courts of general jurisdiction that hear criminal/civil matters across diverse areas of law. They are not specialized in patent law, let alone design patent law. Generally they are inexperienced with design law (relatively few filed cases compared to other areas of law) and there lacks an established body of case law

precedent after *LKQ*. There may be a potential for disparate applications and outcomes re obviousness issues – at least until new case law develops and homogenizes over time.

IV. Conclusion

It appears that the *LKQ* decision reveals both a dramatic change in the US design patent system and a harmonization with the US utility patent system. The new “more flexible” test may put forward higher requirements for obviousness which would have great impact on patentability of design patent applications and validity of existing design patents.