Federal Circuit Overturns Obviousness Test for Design Patents

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PRACTICES Intellectual Property, Patents

On May 21, 2024, the Federal Circuit issued an *en banc* opinion in *LKQ Corp., v. GM Global Tech. Operations*,[1] overturning the long-standing *Rosen-Durling* test used to assess obviousness of design patent claims. Going forward, the *Graham* test, which is a more flexible test that is used for utility patent claims, will now also be used for design claims. This decision appears to continue a trend by the Federal Circuit to more closely conform design patent law with utility patent law, with the authors representing SurgiSil in the Federal Circuit's 2021 decision of *In re SurgiSil*.[2]

The *Rosen-Durling* test required a primary reference to have design characteristics "basically the same as the claimed design,"[3] and any secondary reference 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."[4] Since it was difficult to find a primary reference that was "basically the same as the claimed design," design claim rejections and cancellations based on obviousness were somewhat rare.

The new test, specifically the traditional utility patent *Graham* test but as applied to a design claim, is less rigid as to what can be considered primary and secondary references. When discussing what is considered prior art, the Federal Circuit stated that "there is no threshold similarity or 'basically the same' requirement to qualify as prior art."[5] Instead, prior art just must be analogous and this requirement is satisfied if the prior art is in the same field of endeavor as the claimed article of manufacture of the design claim.[6] But the Federal Circuit went further, stating that "other art could also be analogous."[7] As this test is newly developed in the design patent context, the Federal Circuit declined to "delineate the full and precise contours of the analogous art test for design patents."[8] As such, the number of references that can now be considered during an obviousness analysis of a design claim has grown significantly. This growth in available prior art references, coupled with the flexibility of the remaining *Graham* factors, including the differences between the prior art references and the design claim and the viewpoint of an ordinary designer in the field of the design claim, will likely result in more obviousness rejections during design patent examination and more successful obviousness invalidity arguments for issued design patents.

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[1] *LKQ Corp. v. GM Global Tech. Operations*, No. 21-2348 (Fed. Cir. May 21, 2024) (en banc).
[2] *In re SurgiSil*, 14 F.4 1380, 1382 (Fed. Cir. 2021) ("[a] design claim is limited to the article of manufacture identified in the claim").
[3] *Id.* at 7 (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)).

[4]*Id.* at 17 (quoting *Durling*, 101 F.3d at 103).
[5]*Id.* at 19.
[6]*Id.* at 22.
[7]*Id.* at 23.
[8]*Id.*