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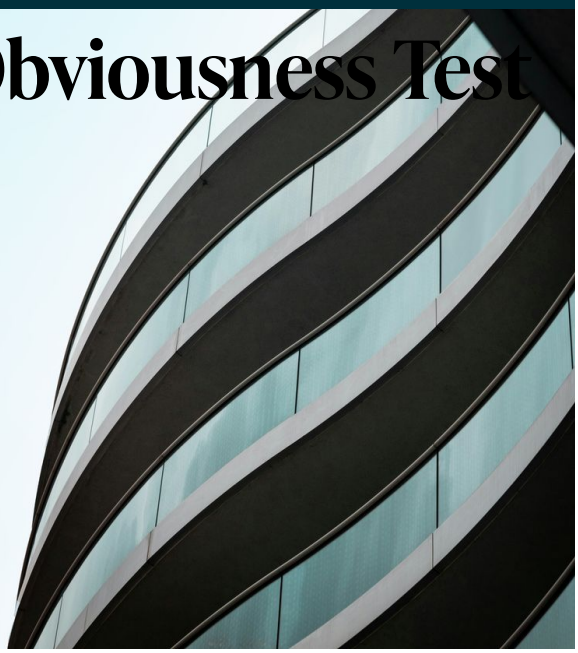
Federal Circuit Revamps Obviousness Test for Design Patents



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By: Ian Swan

In its recent *en banc* decision issued in *LQK v. GM Global*, the Federal Circuit overruled the *Rosen-Durling* test for design patent obviousness,[1] jettisoning decades-old precedent and loosely outlining a design patent obviousness test that aligns with the standard for utility patents. In doing so, the court has lowered the bar for design patent obviousness and opened the door for more prior art rejections by the USPTO.

This case centers on an LQK's IPR challenge to the validity of GM's patent claiming an automobile fender design. The PTAB held that the design patent was nonobvious based on the longstanding *Rosen-Durling* test, and a Federal Circuit panel affirmed. The court granted LKQ's subsequent petition for rehearing *en banc* to consider whether it should modify or eliminate the *Rosen-Durling* test.

The *Rosen-Durling* test requires the obviousness proponent to identify a "*Rosen* reference," which must be "basically the same" as the claimed design. Any secondary references must 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." The Federal Circuit held that the rigid approach required by *Rosen* and *Durling* was inconsistent with the flexible approach of Section 103 generally and the Supreme Court's precedent. The court thus overruled *Rosen* and *Durling* altogether.

The new test outlined by the court largely aligns with the *Graham* factors used to assess utility patent obviousness.[2] Under both tests, courts must consider (1) the scope and content of the prior art, (2) the differences between the prior art and the invention/design at issue, (3) the ordinary skill in the pertinent art, and (4) secondary considerations of obviousness. With regard to factor (1), the court held that, like for utility patents, the standard was "analogous art." Although it found that prior art in the same field of design was "analogous," the court left open the question of whether prior art from different fields could be analogous. Likewise, the court acknowledged that some secondary considerations, like commercial success and copying, were relevant to design patents. However, it did not determine when or if secondary considerations more related to functionality (e.g., long-felt but unsolved needs, failure of others) would be relevant.

Overall, the "new" test for design patents is much less demanding than the *Rosen-Durling* test. With a lower bar for proving obviousness, the PTO is likely to issue more obviousness rejections (at oral argument, the government noted that a mere 4% of design patents receive a prior art rejection at examination). And, with several key parts of the new analysis left undefined, there will be at least temporary uncertainty around design patent obviousness. The question now is: how will the PTO and courts fill in the gaps left by the Federal Circuit?

[1] *LKQ Corp. v. GM Global Tech. Op. LLC*, No. 2021-2348 (Fed. Cir. May 21, 2024).

[2] *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

> **"As with any change, there may be some degree of uncertainty for at least a brief period, but our elimination of the rigid Rosen-Durling test is compelled by both the statute and Supreme Court precedent."**

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