

Design Patent Obviousness:

LKQ Corp. v. GM Glob. Tech. Operations LLC, 71 F.4th 1383
(Fed. Cir. 2023)

February 15, 2024

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Overview

- History of design patent obviousness
- *Rosen-Durling* Framework
 - Two-part rule for design obviousness requires
 - Primary reference that is “basically the same” as the claimed design
 - Additional references be “so related” to primary reference before considering whether a POSITA would modify that reference
- *KSR*- Supreme Court’s flexible approach for combining references
- *LKQ* – does *KSR* apply to design patents?



LKQ Corp. v. GM Glob. Tech. Operations LLC, 71 F.4th 1383 (Fed. Cir. 2023), reh'g en banc granted, opinion vacated, 71 F.4th 1383 (Fed. Cir. 2023)

Sources

1. Mueller et al., *Overcoming the “Impossible Issue” of Nonobviousness in Design Patents*, Kentucky Law Journal, Vol. 99, No. 3 (2009).
2. Perry J. Saidman & Theresa Esquerra, *A Manifesto on Industrial Design Protection: Resurrecting the Design Registration League*, 55 J. Copyright Soc’y U.S.A. 423 (2008).
3. “Fed. Cir. Questions Call to Throw Out Design Patent Tests,” Law360, February 5, 2024.
4. Callahan, *Fashion Frustrated: Why the Innovative Design Protection Act Is a Necessary Step in the Right Direction, But Not Quite Enough*, Brooklyn Journal of Corporate, Financial & Commercial Law, Vol. 7, Issue 1.
5. Du Mont et al., *The Origins of American Design Patent Protection*, *Indian Law Journal*, Vol. 88:837 (2013).

Why Design *Patent* Protection?

- UK implemented registration system similar to copyrights for new and original articles of manufacture in 1839.
- U.S. manufacturers in 1841 petitioned Congress for a similar registration system (outside of the patent system), which was endorsed by then Commissioner of Patents, Henry Ellsworth.¹
- Congress instead enacted Ornamental Design Act of 1842, making design patent protection part of the patent system rather than copyright or establishing a separate system, largely due to the fact that the Patent Office needed an additional revenue stream.⁵

Ornamental Design Act of 1842

- Any citizen or citizens, or alien or aliens, having resided one year in the United States and taken the oath of his or their intention to become a citizen or citizens who by his, her, or their own industry, genius, efforts, and expense, may have *invented or produced*:
 - any new and original design for a manufacture, whether of metal or other material, or
 - any new and original design for the printing of woolen, silk, cotton or other fabrics, or
 - any new and original design for a bust, statue . . . , or
 - any new and useful pattern, or print, or picture, to be either worked on, any article of manufacture, or
 - any new and original shape or configuration of any article of manufacture
- The “invented or produced” language repeated in the Patent Act of 1861 and the Patent Act of 1870.
- Even though designs were folded into the patent system, the original Design Act arguably did not have an obviousness requirement, which is consistent with the 1841 petition.

Subsequent legislation

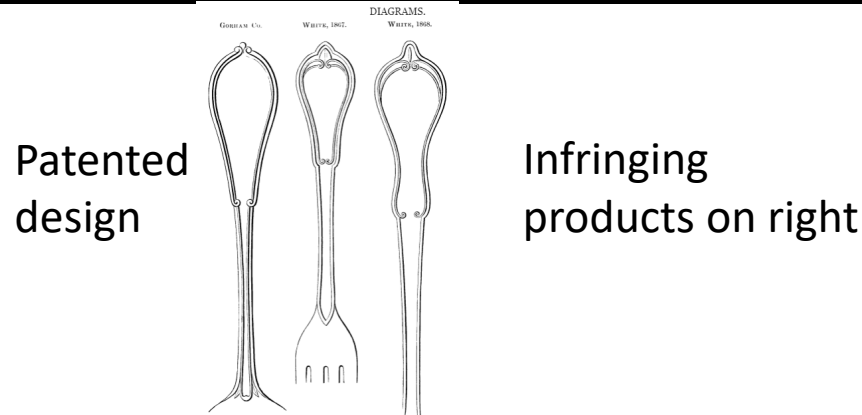
- Section 4929 of 1874 Revised Statutes: “Any person who, by his own industry, genius, efforts, and expense, has *invented and produced* any new and original”*
- 1902 amendment: “Any person who has *invented* any new, original, and ornamental design for an article of manufacture”
- **Patent Act of 1952 (obviousness codified):** “Whoever invents any new, original design for an article of manufacture The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.” **Co-author, Giles Rich,** later acknowledged that 35 U.S.C. § 103 doesn’t really apply to designs. “The problem was well known to the drafters of the 1952 Act” but they decided **“to retain the substance of the existing design patent statute and attack the design problem at a later date.”** *In re Nalbandian*, 661 F.2d 1214 (CCPA 1981).

*Mueller et al. suggests that the introduction of the word “and”, which effectively introduced an obviousness requirement for designs, was a legislative error.

Attempts to Reform Design Patent Law

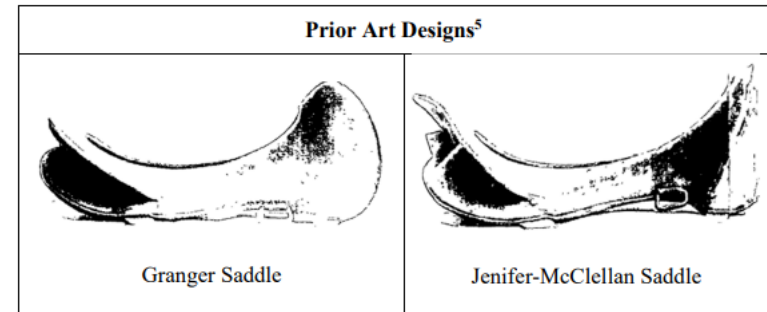
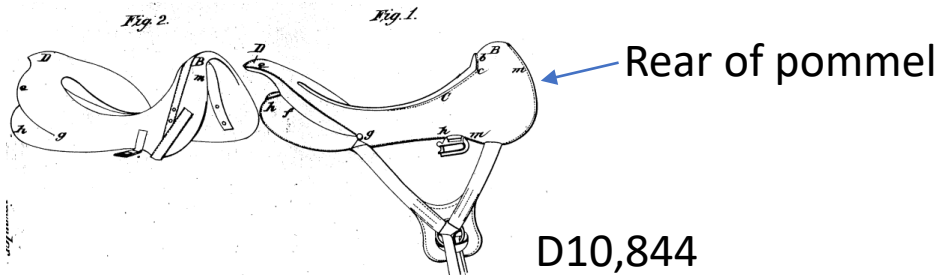
- Design patent examination moves too slow for some industries.
- Many foreign countries understand this and have a registration process for industrial designs similar to copyright.
- Bills for implementing separate registration process for designs introduced to Congress in 1916, 1924, 1957, 1969, and 1990.
- “Despite strong support from the automotive and allied industrials, [the 1990 bill] failed, largely because of **politically powerful oppositions by automotive spare parts manufacturers**, their insurance company allies, and discount retailers.”²
- Congress has been presented with over 70 bills over last 100 years for various forms copyright protection for fashion design (e.g., clothing, handbags, purses, belts, and eyeglasses)⁴, most recently in 2006, 2007, 2009 and 2012, presumably to target Target.
- Conversely, there didn’t seem to be much push back against the passage of the Vessel Hull Design Protection Act in 1998.

Gorham v. White, 81 U.S. 511 (1871) – prior to 1874 Amendment



- Design infringement exists “if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, . . .the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other.”
- Although this isn’t an invalidity case, the Court rejected the use of a POSITA to determine infringement: There is no design that can’t be distinguished by an expert. “Experts, therefore, are not the persons to be deceived.”

Smith v. Whitman Saddle Co., 148 U.S. 674 (1893)- after 1874 Amendment



- The patented design was a combination of the front half of Granger and the rear half of Jenifer, but with a sharper drop at the rear of the pommel and a center slot.
- The Court seemed to acknowledge that the shape of the rear of the pommel was new and material, but nonetheless found that the accused saddle was sufficiently different from the patented design.
- The Court focused the infringement analysis only on the differences between patented design and the main reference, foreshadowing the point of novelty test.

In re Faustmann, 155 F.2d 388 (C.C.P.A. 1946)



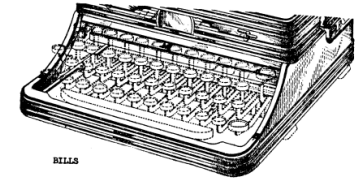
Portion of
claimed design



Lentz prior
art

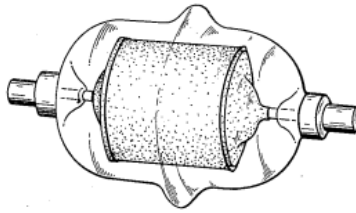


Fairweather
prior art



- Claimed design included keys that were flat at the front and rounded at the back.
- The court concedes that determining whether an invention exists is an “impossible task” but concludes that “we can see nothing what appellant has done that is beyond the ability of the ordinary skilled mechanic or designer of typewriters.”

In re Jennings, 182 F. 2d 207 (C.C.P.A. 1950)



claimed design
for a vacuum
condenser

- Application rejected over combination of five prior patents.
- “In considering patentability of a proposed design ***the appearance of 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 prior art and combining them, particularly where combining them would require modification of every individual feature, as would be required here.”

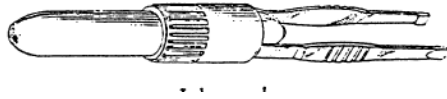
In re Laverne, 356 F. 2d 1003 (C.C.P.A. 1966)



- Judge Rich: The test for obviousness “must be applied in a way which will implement the legislative intent to promote progress in the field of industrial designs by means of the patent incentive.”
- A POSITA is not an inventor in the field of industrial design; otherwise, all new designs could be precluded from patent coverage. **Instead, obviousness should be judged by the perspective of “the ordinary intelligent man.”**
- Despite there being numerous small differences between the claimed design the prior art, “taken together the net result is distinctly different.”

In re Nalbandian, 661 F.2d 1216 (C.C.P.A. 1981) (*pre-Rosen*)

Appellant's



Claimed
design

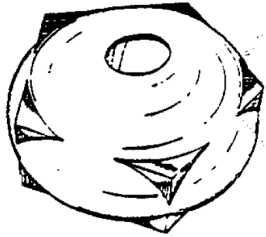
Johnson's



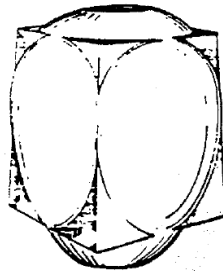
Prior art

- The court identified the fluting on the middle cylindrical portion as the only noticeable difference. A secondary reference made up for that deficiency.
- The court held that the Laverne test would no longer be followed due to the inconsistency between the CCPA and the regional circuits and instead would consider the “fictitious person identified in § 103 as ‘one of ordinary skill in the art.’”
- Despite the higher standard during examination, an applicant has the ability to submit evidence of secondary considerations.
- The court upheld 103 rejection.
- **Judge Rich (concurring):** rehashes history of the 1952 Patent Act and the decision “to retain the substance of the existing design patent statute and attack the design problem at a later date.”

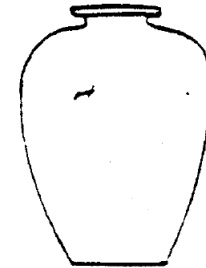
In re Harvey, 12 F.3d 1061 (Fed. Cir. 1993) (*post-Rosen*)



Claimed designs



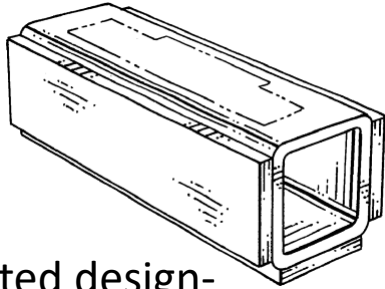
Harvey prior art



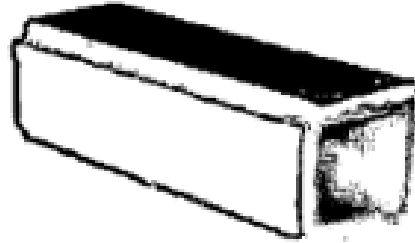
Carder prior art

- A primary reference must satisfy the *Rosen* test.
- “The designs of other references may then be properly relied upon for modification [of the *Rosen* reference] when the references are ‘so related that the appearance of certain ornamental features in one . . . Would have suggested application of those features to another.’” (citing *In re Sung Nam Cho*, 813 F.32d 382 (Fed. Cir. 1987)).
- The court held that the Harvey prior art was not a proper *Rosen* reference and that there was no suggestion to combine. The court emphasized the importance of focusing on specific design features as opposed to “design concepts.”

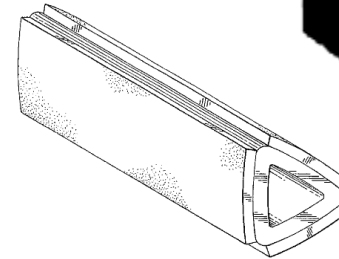
Egyptian Goddess, Inc. v. Swisa, Inc., 543 F. 3d 665 (Fed. Cir. 2008)



Patented design-
4-sided frame
with 3 buffer
pads



Accused- 4-sided
frame with 4
buffer pads



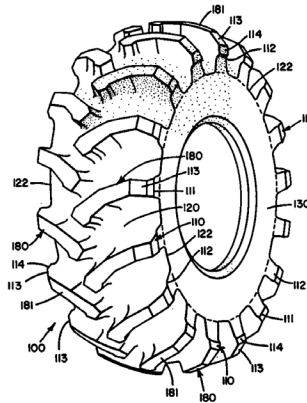
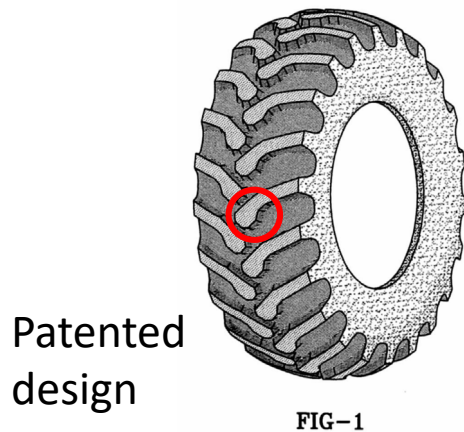
Prior art

- Ordinary observer test is the sole test for infringement.
- Result: A buffer with pads on all four sides does not infringe a design with pads on only three sides. The court gave weight to expert opinion that the patented design was an obvious modification.

***Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F. 3d 665 (Fed. Cir. 2008) – Cont’d**

“[C]ourts should not treat the process of claim construction as requiring a detailed verbal description of the claimed design, as would typically be true in the case of utility patents.”

Titan Tire Corp. v. Case New Holland, Inc. 566 F.3d 1372 (Fed. Cir. 2009)

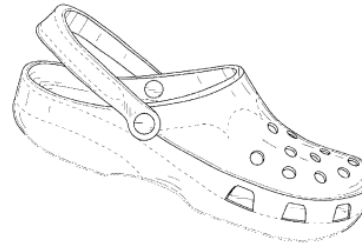


- The patented design differed only from the primary references in the specific hexagonal shape of the tire lugs, disclosed in a secondary reference.
- The Fed. Cir. agreed that the primary references were proper *Rosen* references.
- The Fed. Cir. acknowledged, but punted on whether obviousness analysis should conform to *Egyptian Goddess* and whether Supreme Court intended for *KSR* to extend to design patents.

International Seaway Trading Corporation v. Walgreens Corporation, 589 F. 3d 1233 (Fed. Cir. 2009)



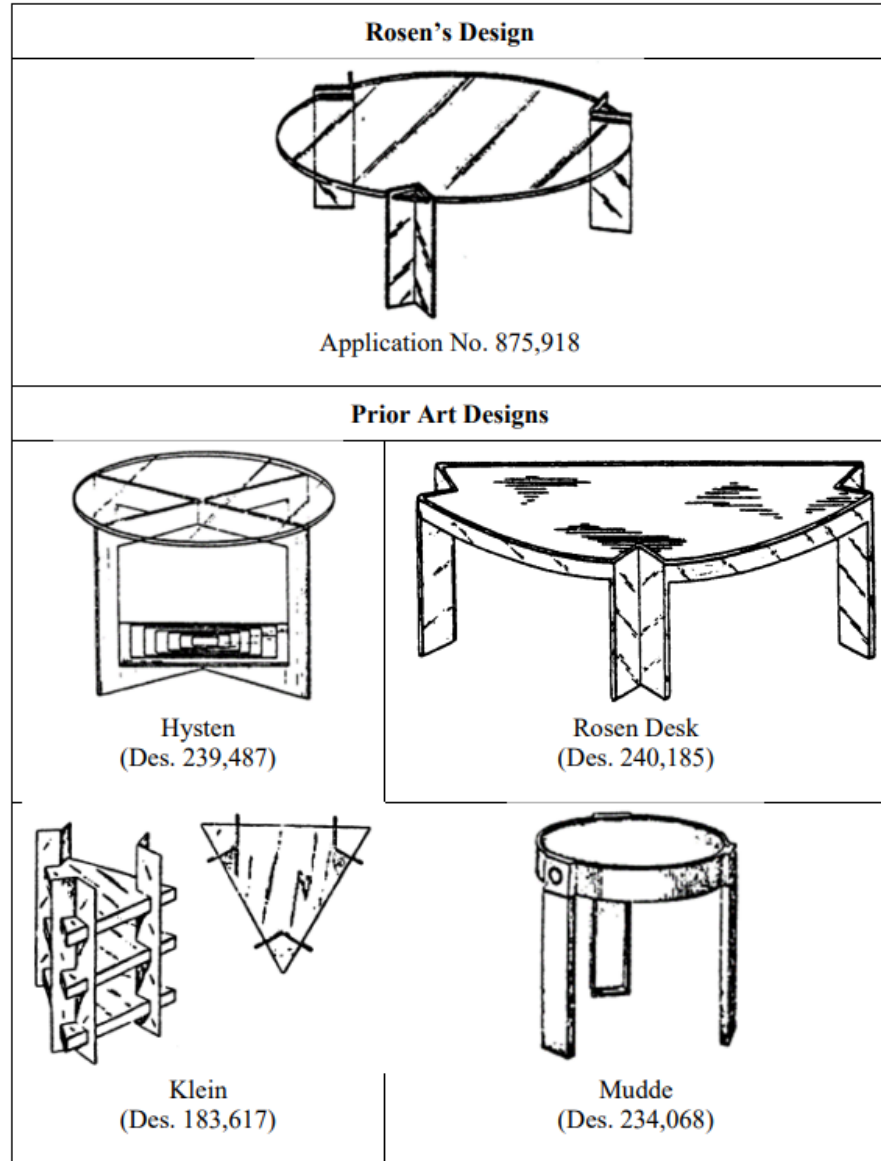
Patented design



Prior art
Croc

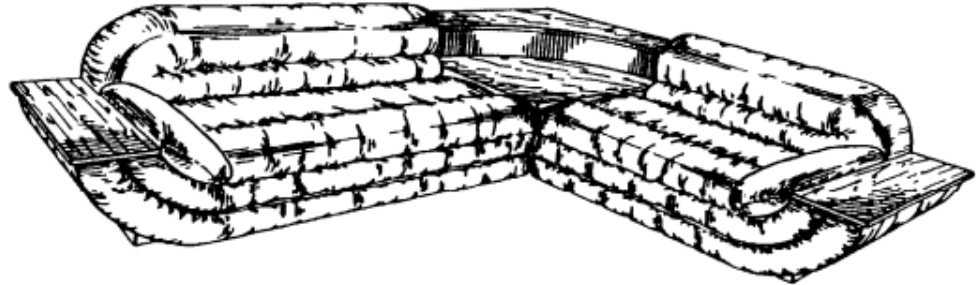
- The Fed. Cir. held that the district court erred in failing to consider the insoles of the patented design and the prior art in the invalidity analysis.
- Obviousness: “The role of one skilled in the art in the obviousness context lies only in determining whether to combine earlier references to arrive at a single piece of prior art for comparison with the potential design or to modify a single prior art reference. **Once that piece of prior art has been constructed, obviousness, like anticipation, requires application of the ordinary observer test.**”

*In re
Rosen, 673
F.2d 388
(C.C.P.A.
1982)*



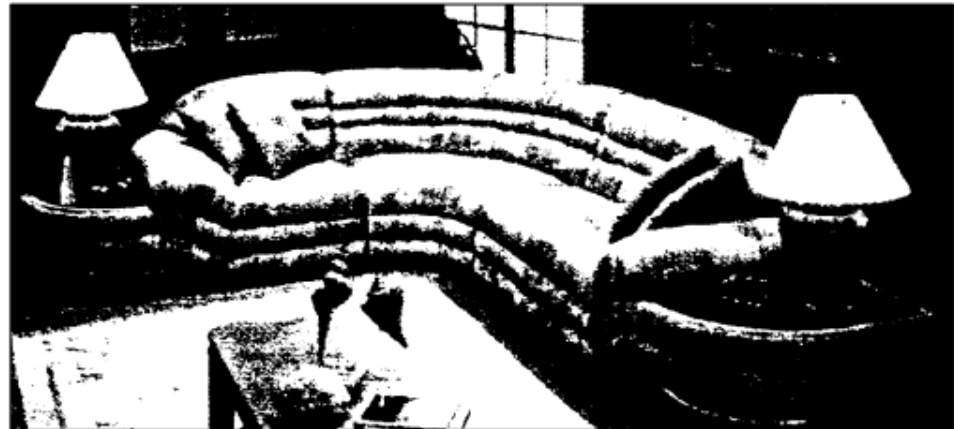
*Durling v.
Spectrum
Furniture Co.,
101 F.3d 100
(Fed. Cir.
1996)*

Durling's Design



U.S. Pat. No. D339,243

Prior Art Design



The Schweiger

Rosen-Durling 2 Step Test

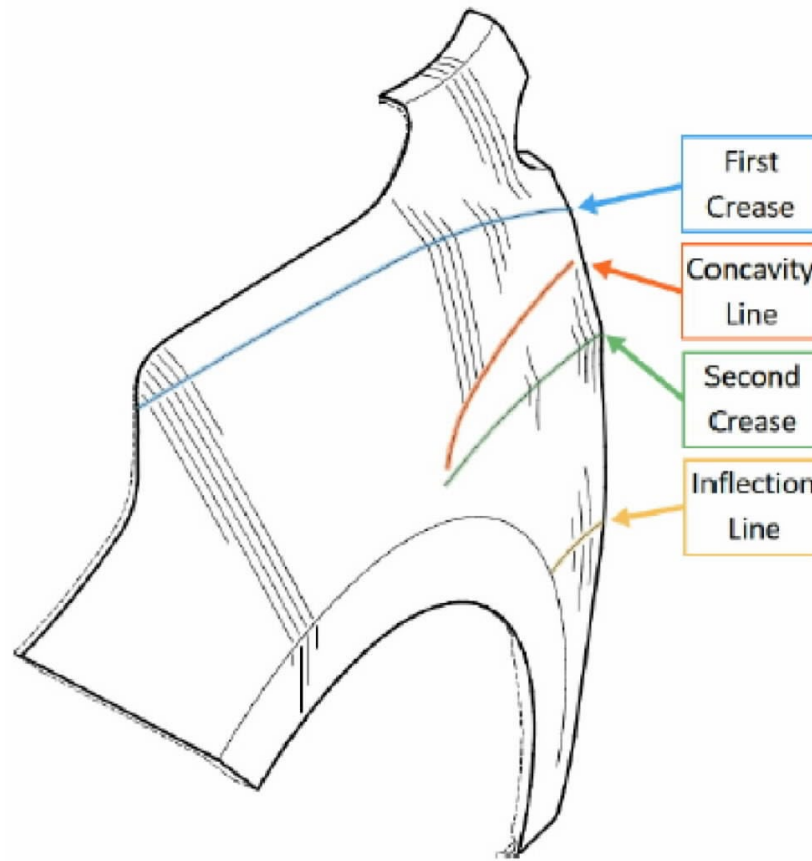
- Is there a “*Rosen* reference” with characteristics “basically the same” as the claimed design?
- If yes, then consider whether an ordinary designer would have modified the primary reference to create a design with the same overall visual appearance as the claimed design (but only if “so related”)



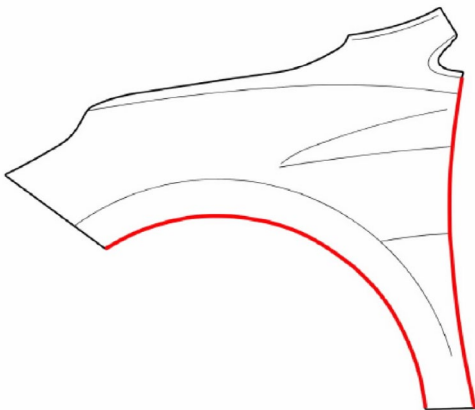
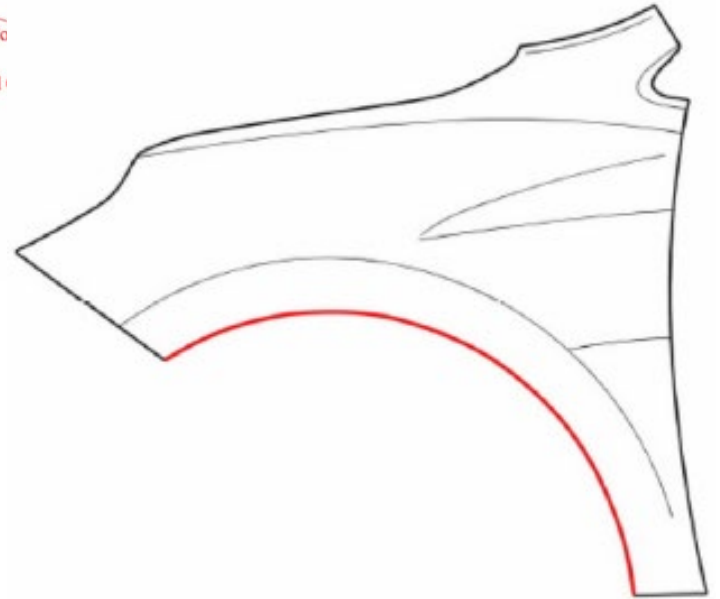
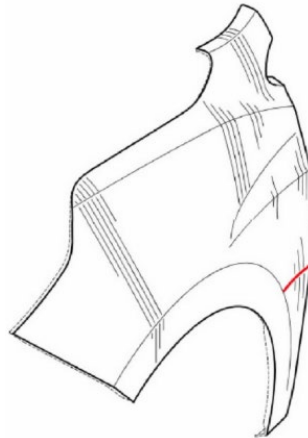
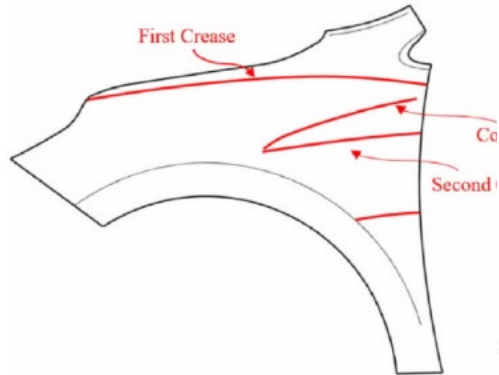
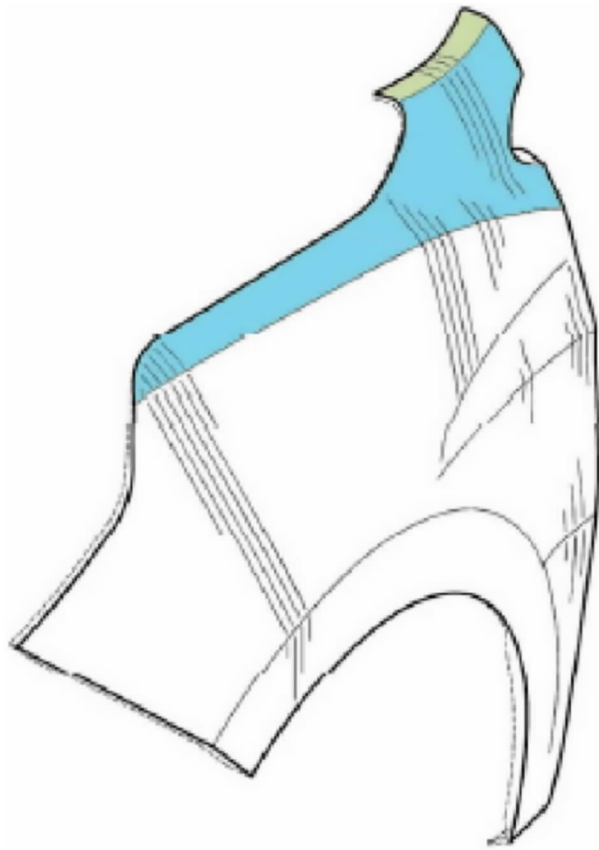
KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007)

- “The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation....”





LKQ Proposed Construction






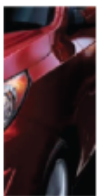


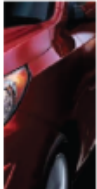





GM Proposed Construction

'625 Patent and Prior Art

Not a Rosen reference



'625 PATENT <i>CLAIMED DESIGN</i>	LIAN (PRIOR ART) <i>PRIMARY REFERENCE</i>	TUCSON (PRIOR ART) <i>SECONDARY REFERENCE</i>
		
		
		
		

Amicus Brief of the United States

LKQ Corp. v. GM Glob. Tech. Operations LLC, 71 F.4th 1383 (Fed. Cir. 2023), reh'g en banc granted, opinion vacated, 71 F.4th 1383 (Fed. Cir. 2023)

- Majority (Judge Clevenger)
 - “[T]he Board's finding that the ordinary observer would include both retail consumers who purchase replacement fenders and commercial replacement part buyers who purchase replacement fenders was supported by substantial evidence”
 - “[T]he Board's finding of no anticipation was supported by substantial evidence”
 - *KSR* does not overrule *Rosen-Durling*

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- Additional views (Judge Lourie)
 - Agreed that substantial evidence supported that the '625 patent claims were not unpatentable as anticipated or obvious
 - *KSR* is not applicable to design patents
 - “*Rosen* may have overstated its point in adding to the quoted *Jennings* language such as that the primary reference must have design characteristics that are ‘basically the same’ as those of the claimed design”
 - BUT “*Rosen* was not essentially incorrect. In any obviousness analysis, the question is whether the claimed invention was obvious, but obvious over *what*”

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- concurring in part and concurring in judgment (Judge Stark)
 - Agreed that substantial evidence supported that the '624 patent claims were not unpatentable as anticipated or obvious
 - LKQ forfeited its argument that KSR overruled *Rosen-Durling*

LKQ Corp., 71 F.4th at 1384 Questions Presented

- Does *KSR* overrule *Rosen-Durling*?
- If not overruled/abrogated, does *KSR* apply to design patents suggest the court should eliminate or modify the *Rosen-Durling* test?
- If the court were to eliminate or modify the *Rosen-Durling* test, what should the test be for evaluating design patent obviousness challenges?
- Has any precedent from this court already taken steps to clarify the *Rosen-Durling* test? If so, please identify whether those cases resolve any relevant issues.
- Given the length of time in which the *Rosen-Durling* test has been applied, would eliminating or modifying the design patent obviousness test cause uncertainty in an otherwise settled area of law?
- To the extent not addressed in the responses to the questions above, what differences, if any, between design patents and utility patents are relevant to the obviousness inquiry, and what role should these differences play in the test for obviousness of design patents?

LKQ Arguments

- *KSR* implicitly abrogated *Rosen* and *Durling*
 - The principles of obviousness applied to utility patents apply equally to design patents
 - *KSR* rejected rigid application of obviousness analysis yet *Rosen* and *Durling* impose rigid limitations

LKQ Arguments

- The *Rosen-Durling* test should be eliminated
 - *Rosen-Durling* extends patent monopoly
 - Reduces ordinary designer to an automation
 - Reduces obviousness to anticipation analysis
 - Hinders ability to enforce prohibition against obvious subject matter
 - Inflexible
 - The *Rosen* primary reference requirement
 - *Durling's* requirement that the primary reference may only be modified by secondary references that are “so related”

LKQ Arguments

- Test for obviousness should be based on what an ordinary designer would have found obvious
- *Rosen-Durling* has not been clarified by subsequent precedent
- Correcting design patent obviousness test to align with KSR would not lead to uncertainty
- Differences between design patents and utility patents do not warrant any difference in the fundamental principles applied to determine if a claimed design was obvious

GM Arguments

- Design patents are unique
- The *Rosen* reference is the correct starting point
- It is consistent with *KSR*, which did not prohibit all frameworks
- *KSR* did not mention design patents or *Rosen-Durling*
- At most the court should
 - Provide additional explanation of “basically the same”
 - Make clear the factfinder is not barred from considering the full scope of the relevant prior art
 - Clarify that the “so related” inquiry
 - Emphasize the availability of common sense

U.S. Amicus Brief

- The *Rosen-Durling* Framework should be preserved, but needs clarification
 - Replace “basically the same” terminology
 - Lack of a primary reference should not end obviousness inquiry
 - Eliminate “so-related” requirement

Oral Arguments (10 Judges, Newman and Cunningham not participating)³

- Judge Moore: None of the parties that filed briefs “told us what the standard would be” if the *Rosen* test is eliminated or modified. “We don't want to replace one potentially bad test with a different potentially bad test.”
- Judge Chen: Concerned about expanding test to include primary references from unrelated fields. “If we really were to invite that kind of inquiry, we would really be in wide open territory.”
- Judge Reyna: Concerned that the after-market auto parts industry seems to be the only industry that thinks *Rosen* is a problem. “Aren't we entering a slippery slope here in trying to fashion a new test under your arguments when we don't fully understand the implications of what we're doing?” **Overruling *Rosen* and *Durling* is “not going to happen.”**
- Judge Lourie: Raised concerns that the current test is too restrictive.

Why the Fed. Cir. won't find that *KSR* overrules *Rosen* and *Durling*.

- *KSR* never mentioned design patents, *Rosen* or *Durling*.
- *KSR* rationales are predicated on combining known individual elements to yield predictable results or predictable solutions or predictable uses. *KSR* irrelevant to designs because:
 - Unlike utility inventions, designs do not have to be useful.
 - Except for a few detours, most of the case law beginning with *Gorham* in 1871 focuses on analyzing the design as a whole, not individual elements (though some tension with *Whitman Saddle*).
 - A POSITA must be knowledgeable of design trends across many fields with an *infinite* number of design options.
 - The primary goal of an engineer/mechanic/scientist is to solve a technical problem, the solution of which may be suggested in the prior art, whereas the primary goal of a designer is to make a product more aesthetically pleasing to the customer, which is inherently unpredictable.
- Allowing examiners to apply *KSR* to designs would stifle the progress of designs.
- Also, see Judge Reyna's comments above.

If *Rosen-Durling* overruled or modified, then what?

- More flexible comparison
 - Scope of prior art can vary depending on field- is the designer of the product a generalist or specialist
 - For example, car designer is specialist, so scope of prior art is more limited but minor differences have more significance in identifying a Rosen reference.
 - On other hand, designer consumer products may be generalist, so scope of prior art is broader but minor differences have less significance.
- Seems like an impossible task for an examiner or a court.
- Introduces a lot uncertainty in an otherwise settled area of law.
- What do you think?

Questions?

Klarquist
