

Full Federal Circuit Set to Consider Changing the Test for Obviousness of Design Patents

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Last week, the Federal Circuit decided to consider, *en banc*, whether the Supreme Court's 2007 *KSR* decision regarding obviousness overruled the Federal Circuit's decades-old *Rosen* and *Durling* tests for design patents, setting in motion a potential lowering of the bar for obviousness.

The framework for determining whether a design patent is obvious traces back to two decisions from the eighties and nineties. *In re Rosen*, 673 F.2d 388 (CCPA 1982), established what constitutes a primary reference for assessing whether a design patent is obvious. For a reference to qualify as a primary reference under *Rosen*, the reference needs to show design characteristics that are "basically the same" as the claimed design. *Durling v. Spectrum Furniture Co.*, 101 F.3d 100 (Fed. Cir. 1996), established the following two-part test for obviousness of design patents based on the standard set forth in *Rosen*: (1) whether there is a primary reference (a "Rosen reference") with characteristics that are "basically the same" as the claimed design by discerning the visual impression of the design as a whole; and (2) if there is a *Rosen* reference, whether an ordinary designer would have modified the *Rosen* reference to create a design with the same overall visual appearance as the claimed design?

The Federal Circuit's decision to grant *en banc* review stems from a Patent Trial and Appeal Board ("PTAB") decision in a post-grant review ("PGR") of U.S. Patent No. D855,508 S (the "'508 patent"). In particular, in April of 2020, LKQ Corporation and Keystone Automotive Industries, Inc. ("Petitioners") filed a petition for PGR of the sole claim of GM Global Technology Operations LLC's '508 patent for a vehicle front skid bar. Petitioners asserted three grounds of unpatentability, including one ground of anticipation and two grounds of obviousness.

The PTAB instituted trial but ultimately found that Petitioners had "not demonstrated by a preponderance of the evidence that the sole claim of the '508 patent [wa]s anticipated or would have been unpatentable."

Petitioners appealed and argued "that the Supreme Court's decision in *KSR* [*International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007)] implicitly overruled the long-standing *Rosen* and *Durling* tests for obviousness of design patents, and therefore the Board's decision applying such tests must at least be vacated and remanded."

In January 2023, a Federal Circuit panel in a *per curiam* decision affirmed the PTAB's decision and declined to overrule *Rosen* or *Durling*. The panel explained that "*KSR* did not involve or discuss design patents, which is the type of patent we have here before us and that was addressed by *Rosen* and *Durling*." The panel further explained as follows:

And we note that in the more than fifteen years since *KSR* was decided, this court has decided over fifty design patent appeals. In these appeals, this court has continually applied *Rosen* and *Durling* just as it had in the decades preceding. Notably, the correctness of our current law in light of *KSR* was raised in only two of those over fifty appeals, only tangentially, and not addressed in our decisions in those two cases. ***This challenge is therefore an outlier.***

Despite the panel's assertion that Petitioner's challenge was "an outlier," the Federal Circuit granted Petitioners' petition for rehearing *en banc*. The Federal Circuit posed the following questions for briefing:

A. Does *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), overrule or abrogate *In re Rosen*, 673 F.2d 388 (CCPA 1982), and *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100 (Fed. Cir. 1996)?

B. Assuming that *KSR* neither overrules nor abrogates *Rosen* and *Durling*, does *KSR* nonetheless apply to design patents and suggest the court should eliminate or modify the *Rosen-Durling* test? In particular, please address whether *KSR*'s statements faulting "a rigid rule that limits the obviousness inquiry," 550 U.S. at 419, and adopting "an expansive and flexible approach," *id.* at 415, should cause us to eliminate or modify: (a) *Durling*'s requirement that "[b]efore one can begin to combine prior art designs . . . one must find a single reference, 'a something in existence, the design characteristics of which are basically the same as the claimed design,'" 101 F.3d at 103 (quoting *Rosen*, 673 F.2d at 391); and/or (b) *Durling*'s requirement that secondary references "may only be used to modify the primary reference if they are '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,'" *id.* at 103 (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)) (internal alterations omitted).

C. If the court were to eliminate or modify the *Rosen-Durling* test, what should the test be for evaluating design patent obviousness challenges?

D. 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.

E. 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?

F. 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?

The Federal Circuit invited the views of the United States as *amicus curiae*. Based on previous appeal timeframes, a decision may be expected in mid-to-late 2024.

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