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Federal Circuit Relaxes Standard for Design Patent Obviousness Challenges

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On 21 May 2024, the Federal Circuit overturned the *Rosen-Durling* test used to assess non-obviousness of design patents. In *LKQ Corporation v. GM Global Technology Operations LLC*, the Court en banc ruled the same conditions for patentability that apply to utility patents apply to design patents, specifically holding the obviousness rationale articulated in *KSR International Co. v. Teleflex Inc*., 550 U.S. 398 (2007), will now apply to design patents. *LKQ Corp. v. GM Glob. Tech. Operations LLC*, No. 2021-2348, 2024 WL 2280728, at 1 (Fed. Cir. May 21, 2024) (en banc).

LKQ argued in an *Inter Partes* Review proceeding that GM's design patent was invalid under 35 U.S.C. § 103. The Patent Trial and Appeal Board (Board) applied the *Rosen-Durling* test, which states, "[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'" (a *Rosen* reference). *Id.* at 2 (citations omitted). If no *Rosen* reference is found, the obviousness inquiry ends there without consideration of step two, and it is improper to invalidate a design patent on obviousness grounds. If a *Rosen* reference is located, "other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design." *Id.* (citations omitted). Such "other references" must be "so related" to the *Rosen* reference "that the appearance of certain ornamental features in one would suggest the application of those features to the other." *Id.* (citations omitted).

The Board held LKQ failed to identify a *Rosen* reference and ended its obviousness inquiry. LKQ appealed and a Federal Circuit panel affirmed. After granting rehearing en banc, this Court vacated the prior Federal Circuit panel opinion, holding the *Rosen-Durling* test is "improperly rigid" and "out of keeping with the Supreme Court's general articulation of the principles underlying obviousness." *Id.* at 5. The Court emphasized that "[t]he § 103 obviousness language sets forth an expansive and flexible approach," and "*Rosen*'s rigid requirement limiting a primary reference to designs that are basically the same as the claimed design—and abruptly ending the analysis in the absence of such a reference—imposes limitations absent from § 103's broad and flexible standard." *Id.* at 6. Likewise with respect to step two of the *Rosen-Durling* test, the Court held

that the "'so related' requirement is at odds with the broad standard for obviousness set forth in § 103 and Supreme Court precedent." *Id.*

So, moving forward courts and the Board will apply the *KSR* standard for obviousness analyses related to design patents. Because this standard is less rigid than how currently issued design patents were examined, the Court's decision may result in litigants having an easier time invalidating design patents, both in district court litigation and post-grant proceedings. Parties may wish to consider supplemental examination to assess prior art, especially if the design patent is going to be asserted against potential infringers.

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