

Cantor Colburn Client Alert: Federal Circuit Overrules Longstanding Test for Non-Obviousness as Applied to Design Patents

Summary

The Federal Circuit recently discarded its long-established test for assessing non-obviousness as it relates to a challenged design patent and to design patent applications under examination at the U.S. Patent and Trademark Office. The court replaced the test with a modified version of the *Graham* multi-factor analysis currently used for assessing the validity of a utility patent and the non-obviousness of utility applications.

Overview of the Case

U.S. Design Patent No. D797,625, owned by GM Global Technology LLC, covers a design for the front fender piece of a vehicle (the “**625 Patent Design**”). The ‘625 Design was used for the 2018-2020 Chevrolet Equinox.

LKQ Corporation and Keystone Automotive Industries (collectively, “**LKQ**”) filed a petition for inter partes review of the ‘625 Design Patent. LKQ argued the challenged claim was unpatentable pursuant to 35 U.S.C. §103 based on U.S. Design Patent No. D773,340 (“**Lian Design Patent**”), independently, or based on the Lian Design Patent, “as modified by a promotional brochure depicting the design of the front fender on the 2010 Hyundai Tucson.”

The Patent Trial and Appeal Board (“**PTAB**” or “**Board**”), when considering non-obviousness, the Board applied the *Rosen-Durling* test, a two-part inquiry, to assess the non-obviousness of the ‘625 Design Patent. The Board found LKQ failed to establish the first part of the *Rosen-Durling* test and thus did not consider the second portion of the inquiry. The *Rosen-Durling* test required that the primary reference must be “basically the same” as the challenged design claim and that any secondary references must be “so related” to the primary reference that features in one would suggest application of those features to the other. As the Board explained, Rosen’s “basically the same” test required consideration of the visual impression created by the patented design as a whole. If no “Rosen” primary reference was found, the analysis would stop there and there would be no analysis of secondary references.

LKQ appealed the PTAB decision to the United States Court of Appeals for the Federal Circuit (“**Federal Circuit**”). The Federal Circuit considered an argument made by LKQ, pointing to an earlier decision made by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (2007), which LKQ argued, indirectly overruled the *Rosen-Durling* test.

The Federal Circuit granted a rehearing *en banc*, centered around the above-mentioned argument made by LKQ.



After walking through the Supreme Court's precedent and accompanying framework for analyzing non-obviousness as it relates to design patents, the Federal Circuit found its current framework (i.e., *Rosen-Durling* test) to be "out of step" and "improperly rigid" as compared to the Supreme Court's framework utilized in utility patent non-obviousness analyses.

In place of the *Rosen-Durling* test, the Federal Circuit crafted a slightly modified version of the obviousness test established in *Graham v. John Deere Co. of Kansas City* (1966), affirmed most recently in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), traditionally used to assess the validity of a utility patent based on 35 U.S.C. §103.

A factfinder must, first, consider the following when analyzing non-obviousness in a challenged claim of a design patent: (1) "the scope and content of the prior art" as applied to an "ordinary designer" within the relevant field; (2) differences (if any) between the prior art designs and the claimed design at issue; and (3) an evaluation of the level of ordinary skill in the relevant art. Once all factors have been considered, the court will examine the obviousness or non-obviousness of the claimed design of the design patent, with a focus on the "visual impression of the claimed design as a whole." The court must also examine the primary reference and any relevant secondary references. As with the *Graham* analysis for utility patents, the court must, lastly, consider "secondary considerations as indicia of obviousness or non-obviousness," which include: "commercial success, long felt but unsolved needs, and failure of others, etc." The new analysis does away with the *Rosen-Durling* requirement of finding a "basically the same" primary reference and that any secondary references must be "so related" to the primary reference that features in one would suggest application of those features to the other.

Takeaways

While this test is likely to be subject to modifications by the Federal Circuit in months and years to come, it appears the new non-obviousness inquiry as it applies to a challenged design patent or a pending design patent application, may spark more challenges to design patents at the PTAB and may impact efforts by design patent applicants seeking to secure patents on their designs. This is because the new test, which is akin to the Supreme Court's *Graham* framework for assessing non-obviousness in utility patents, is significantly more flexible than the *Rosen-Durling* test.

For Further Information and Assistance

Cantor Colburn has substantial experience representing clients in all types of design patent matters, including litigation. Please do not hesitate to contact [Daniel Drexler](mailto:ddrexler@cantorcolburn.com), Co-Chair of Cantor Colburn's [Design Patents Practice](#), at ddrexler@cantorcolburn.com, [Michael Rye](mailto:mrye@cantorcolburn.com), Co-Chair of Cantor Colburn's [Litigation Practice](#), at mrye@cantorcolburn.com, or your Cantor Colburn attorney with any questions you may have regarding this matter and your IP in general.

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