PATTISHALL insights
WINTER 2025
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The New Test For Design Patent Obviousness: From Horse Saddles to Auto Fenders



By Daniel S. Hess

... DESIGN PATENT OBVIOUSNESS SHOULD BE ANALYZED UNDER THE SAME FRAMEWORK AS UTILITY PATENTS.

In May, 2024, the U.S. Court of Appeals for the Federal Circuit, sitting *en banc*, overruled the traditional *Rosen-Durling*[1] test that courts (and the USPTO) have used for 30 years to determine whether a design patent is invalid as obvious under 35 U.S.C. §103. The Federal Circuit in *LKQ Corporation v. GM Global Technology Operations LLC*, decided that test was "improperly rigid," inconsistent with Supreme Court precedent, and must be overruled.[2] According to the Federal Circuit, design patent obviousness should be analyzed under the same framework as utility patents. While it is too early to predict the full impact of this new standard, a significant uptick in obviousness challenges seems likely in design patent cases.

Background of *LKQ* and the PTAB Decision

LKQ and GM have been battling over design patents for years. LKQ sells automotive body repair parts for most mainstream automobiles, including various GM vehicles. GM owns many design patents covering automobile parts (and replacement parts), and for several years licensed them to LKQ. However, LKQ and GM's licensing renewal negotiations broke down and GM began asserting its design patents against LKQ. LKQ responded by filing numerous *inter partes* review (IPR) petitions to invalidate GM's design patents.[3]

1. *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982); *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996).
2. 102 F.4th 1280 (Fed. Cir. 2024).
3. *LKQ Corporation v. GM Global Technology Operations LLC*, 2023 WL 328228, at *1 (Fed. Cir. Jan. 20, 2023)

GM's design patent at issue D797,625 (the "'625 patent") is directed to an "ornamental design for a vehicle front fender".

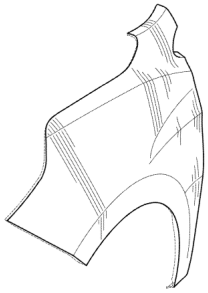


FIG. 1

LKQ argued before the Patent Trial and Appeal Board (PTAB) that the '625 patent was invalid as obvious based on the prior art that it cited. The PTAB applied the *Rosen-Durling* test to determine LKQ's obviousness challenge, which generally involved two steps:

1. One must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design"; and second,
2. "Once this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design." [4]

The single, "basically the same," prior art reference is often called the '*Rosen* reference'. The PTAB held that LKQ failed to identify a *Rosen* reference because the prior art it cited was not "basically the same" as the design covered by the '625 patent. Therefore, the PTAB rejected LKQ's obviousness challenge.[5]

The Federal Circuit Panel Decision

LKQ appealed to the Federal Circuit, arguing that the PTAB's obviousness analysis was incorrect because *Rosen-Durling* was implicitly overruled by the Supreme Court in *KSR International Co. v. Telflex, Inc.*, 550 U.S. 398 (2007). *KSR* was a utility patent case in which the Supreme Court held that the Federal Circuit's application of the "teaching, suggestion, and motivation" test ("TSM test") to adjudicate obviousness challenges was "overly rigid." Instead, the Supreme Court in *KSR* instructed that obviousness challenges should be analyzed under the more flexible *Graham* factors.[6]

LKQ argued to the Federal Circuit panel that the *Rosen-Durling* test represented exactly the kind of rigidity that

> ... THE FEDERAL CIRCUIT OVERRULED THE *ROSEN-DURLING* TEST ...

the Supreme Court disavowed in *KSR*. However, the Federal Circuit panel distinguished *KSR* as a utility patent case that did not specifically discuss design patents, and refused to overrule the *Rosen-Durling* test as precedent.

LKQ petitioned for an *en banc* hearing, which is extremely rare in design patent cases, but the Federal Circuit granted it.

The Federal Circuit *En Banc* Decision

The Federal Circuit, sitting *en banc*, agreed with LKQ that the *Rosen-Durling* test's rigidity could not be reconciled with the Supreme Court's holding in *KSR*. The Federal Circuit vacated the PTAB's nonobviousness ruling and remanded the case for further proceedings.

In doing so, the Federal Circuit relied heavily on an 1893 Supreme Court case involving a design patent for a horse saddle.[7] In *Whitman Saddle*, the Supreme Court held the challenged design patent invalid as obvious based on the prior art, as it appeared to combine the front half of a "Granger tree saddle" with the back half of a "Jenifer-McClellan tree saddle." The Supreme Court held:

"[n]othing more was done in this instance ... than to put the two halves of these saddles together ... in the way and manner ordinarily done"

The Federal Circuit reasoned that if the Whitman Saddle design were analyzed under the *Rosen-Durling* test, neither the Granger nor the Jenifer-McClellan prior art references would have satisfied the *Rosen-Durling* test's requirement that a "single reference" be "basically the same" as the challenged design, and the challenged design patent would have be held valid as nonobvious. The Federal Circuit said this would be an absurd result, demonstrating that the rigid *Rosen-Durling* test is flawed.

4. *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996)
5. *LKQ Corporation and Keystone Automotive Industries, Inc., v. GM Global Technology Operations LLC*, IPR2020-00534, 2021 WL 3411458, at *20 (PTAB Aug. 4, 2021).
6. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).
7. *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893).

Relying on KSR and Whitman Saddle, the Federal Circuit overruled the *Rosen-Durling* test and instructed that design patent obviousness cases be analyzed under the same *Graham* factors used for utility patents, namely, to consider:

1. the scope and content of the prior art within the knowledge of an ordinary designer in the field of the design;
2. the differences between the prior art designs and the design claims at issue;
3. the level of ordinary skill of a designer in the pertinent art to which the claimed design pertains and whether they would have been sufficiently motivated to combine the cited prior art; and;
4. any secondary considerations as indicia of obviousness or nonobviousness such as industry success, failure of others, long felt but unsolved needs etc.[8]

The court said that when assessing the *Graham* factor's "motivation to combine" component, the prior art references need not be "so related" as the *Rosen-Durling* test required, but a challenger would still have to demonstrate "some record-supported reason (without hindsight) that an ordinary designer in the field of the article of manufacture would have modified the primary reference with the feature(s) from the secondary reference(s) to create the same overall appearance as the claimed design."[9]

Aftermath of *LKQ*

The new design patent obviousness test's more flexible approach leaves many questions unanswered. Although the court noted the *Graham* factors have been applied for a long time in the utility patent context, it is difficult to see how some of this jurisprudence would apply to design patents. For example, *LKQ* does not provide much guidance as to how courts should determine what constitutes analogous prior art, rather stating that it should be left to "future cases to develop the application of this standard."[10] This lack of guidance and loosening of the design patent obviousness test suggests it will be easier to assert invalidity challenges to design patents.

It has been only eight-months since *LKQ* was handed down, so it is still too early to tell the long-term impact on design patent obviousness challenges. Nevertheless, design patent owners should stay tuned on forthcoming developments in case law elaborating on this "new" test for design patent obviousness challenges. ■

8. *Supra* note 1 at *passim*. 9. *Supra* note 1 at 1299. 10. *Supra* note 1 at 1297.

*firm*UPDATE

APPOINTMENTS



Thad Chaloemtiarana

Thad has been appointed by the U.S. Secretary of Commerce to serve a three-year term on the Trademark Public Advisory Committee of the United States Patent and Trademark Office. TPAC is the statutorily-authorized advisory committee representing the needs and interests of users of the USPTO's trademark registration and dispute operations. TPAC reviews USPTO policies, goals, performance, budget, and user fees with respect to trademarks, and advises the Under Secretary of Commerce for Intellectual Property and Director of the USPTO on such matters.



Robert Sacoff

Bob has been appointed to Co-Chair the AIPPI-US Committee responsible for preparing the US Group Report on Study Question Q294, "Exhaustion of Trademark Rights." Based on this and other national reports from typically 30-40 responding countries, a harmonizing "Best Practices" Resolution will be drafted, debated, amended, and adopted at AIPPI's 2025 Global IP Congress in Yokohama, Japan, in September.

PRESENTATIONS



Jonathan Jennings

Jonathan discussed the U.S. trade secret ramifications of the European Health Data Space initiative in a CMS webinar on October 24.

Phillip Barengolts, Jonathan Jennings, and Daniel Hess

On February 13, Phil, Jonathan and Danny will speak on significant trademark and design patent cases to the INTA Healthcare and Pharmaceutical Industry Group.

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*firm*NOTEWORTHY

Illinois Super Lawyers 2025

Brett August, Phillip Barengolts, Ashly Boesche, Thad Chaloemtiarana, Bradley Cohn, Jonathan Jennings, Janet Marvel and **Robert Sacoff** have been designated Illinois Super Lawyers, and J**essica Ekhoff, Daniel Hess, Brett Manchel** and **Novaira Paul** have been designated Illinois Rising Stars. **Ashly** was also recognized in *Super Lawyers*' "Top 100" and "Top 50 Women" lists.

Leading Lawyers Magazine

Brett August, Jonathan Jennings and **Robert Sacoff** have been selected as Illinois "Leading Lawyers" for 2025.

World Trademark Review Magazine (WTR) 1000

Pattishall McAuliffe received top Gold Band Rankings in the prestigious WTR 1000 Rankings for 2025.

Thad Chaloemtiarana, Jonathan Jennings, Janet Marvel and **Robert Sacoff** were "Highly Recommended" nationally for "prosecution and strategy" and "Recommended" nationally for "enforcement and litigation." **Thad** and **Jonathan** also received Gold rankings in Illinois for "prosecution and strategy" and "enforcement and litigation." In the same categories in Illinois, **Janet** received Gold and Silver rankings respectively. **Bob** was ranked Silver in Illinois for "enforcement and litigation." **Brett August, Phillip Barengolts, Ashly Boesche** and **Bradley Cohn** were ranked Silver in Illinois for "enforcement and litigation." **Seth Appel** was ranked Silver in Illinois in "prosecution and strategy." **Jessica Ekhoff** was ranked Bronze in Illinois in "enforcement and litigation."

WTR writes: "'Pattishall, McAuliffe, Newbury, Hilliard & Geraldson is an excellent one-stop shop for soft IP matters in the United States. The team is excellent, not only in legal matters, but also for any administrative business-related questions. The firm provides a dependable, top-class service.' Also coming in for high praise, '**Thad Chaloemtiarana** has been instrumental in helping build and maintain worldwide trademark portfolios. He is always easy to reach, responsive, practical and well organised. He's a clear communicator who connects easily with lawyers and non-lawyers.' **Janet Marvel** has sizeable experience in the space, making her an excellent all-rounder for her clients' every need. She has also taught classes at various law schools and was the co-author of the 10th edition of *Trademarks and Unfair Competition*. '**Seth Appel** has very fast response times and offers cost-effective advice. He pays great attention to detail on the economic impacts of his legal advice for businesses. Even in complex situations, Seth always finds a solution and has outstanding knowledge of trademark law. Apart from his tremendous skillset as a lawyer, he is also very pleasant to work with.' The firm's managing partner, **Bradley Cohn**, manages global IP projects for his clients and tries various cases across the United States on a regular basis. He has recently been acting for Buildxact Software at the TTAB, drawing on his in-depth knowledge of the law to score a favourable result for his client as well as a precedent-setting decision. **Jessica Ekhoff** furthers the team's litigation skillset, ensuring that she delivers practical advice suitable for furthering business prospects in the courtroom. She consistently secures wins in federal, district and appellate courts. **Robert Sacoff** has successfully litigated cases and practiced trademark law for over 40 years, and is recognised as a leader in the IP legal landscape. **Ashly Boesche** has an expansive clientele, representing icons such as Karl Lagerfeld and Not a Real Holding Company (Schitt's Creek). Not only is she incredibly savvy when it comes to trademark protection, but she is also an experienced and successful litigator. '**Brett August** offers excellent practical advice and is very responsive. You know you are in good hands with Brett and will get good results.' **Jonathan Jennings**' international reputation and **Phillip Barengolts**' impressive court presence pair perfectly on complex dispute matters for clients, recently defeating a summary judgment motion for healthcare service provider, Lincare Holdings."