

## Fed. Circ. Scrapping Design Patent Tests Creates Uncertainty

By Tracy-Gene Durkin, Deirdre Wells and Daniel Gajewski (May 29, 2024, 1:35 PM EDT)

On May 21, the U.S. Court of Appeals for the Federal Circuit, sitting en banc, overruled more than 40 years of precedent defining the design patent obviousness standard.[1]

The decision eliminates the Rosen-Durling test, which had required:

1. A primary reference that is "basically the same" as the claimed design; and
2. Any differences between the primary reference and the claimed design be covered by secondary references that are so related to the primary reference's features that features in one suggest the application of those features to the other.[2]

The court found the Rosen-Durling requirements too rigid — incompatible with U.S. Supreme Court precedent in *KSR International Co. v. Teleflex Inc.*, which required a flexible approach to obviousness.[3]

*KSR*, decided in 2007, dealt with a utility patent. Until now, it had not been applied by the Federal Circuit to a design patent.

To replace the Rosen-Durling test, the court adopted a flexible approach, drawing from seminal obviousness cases discussing utility patents. In particular, the court found that these four Graham factors should apply to the design patent obviousness analysis:

1. The scope and content of the prior art;
2. The differences between the prior art and the claimed invention;
3. The level of ordinary skill in the art; and
4. Any secondary considerations of nonobviousness.[4]

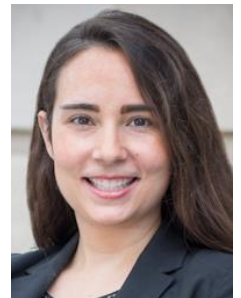
The court optimistically hopes that the uncertainty wrought by this change will last for a brief period, as it leaves ample room for future cases to further develop the law.

But the decision leaves much unknown for design patent applicants, patentees and challengers, as well as practitioners, courts, and the U.S. Patent and Trademark Office.

**What is analogous art? You tell us.**



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A key part of the court's analysis focuses on the first Graham factor.

The court affirmed that an analogous art standard applies to the obviousness of design patents. To meet this standard, one option is for a prior art reference to be in the same field of endeavor as the claimed design.

This is similar to a portion of the corresponding utility analysis. The court concluded it to be straightforward to assess whether a given prior art reference is "from the same field of endeavor as the article of manufacture of the claimed design," and thereby analogous.[5]

The court, however, did not "foreclose that other art could also be analogous," even from different fields of endeavor.[6] The court defined no contours or test for this second, open-ended option for determining if art is analogous, leaving it to be addressed on a case-by-case basis and developed in the future.

Defining what is "analogous art" will likely be a big source of uncertainty and cost for design patent applicants, patent owners and challengers, as well as design examiners at the USPTO.

While the coming months and years will no doubt begin to build some guideposts as to what is and is not analogous art, the overall infrequency of design patent jurisprudence all but guarantees that it will be a slow process.

### **What's my motivation?**

In applying the Graham factors, secondary references can still be applied to support the obviousness of modifications to a primary reference, but the court threw out the previous requirement that a secondary reference be "so related to the primary reference that the appearance of certain ornamental features in one would suggest application of those features to the other."

This raises the — unanswered — question of how secondary references will be considered and applied.

We know from utility patent case law that there must be a motivation to combine prior art references. For design patents, there must be a record-supported reason why an ordinary designer would have been motivated to modify the prior art design to arrive at the claimed design.[7]

The motivation, however, does not need to come from the art itself. Instead, it could come from designer experience, market demands or industry customs, for example.

The court's emphasis on articulating the reason why a proposed modification would have been obvious may benefit applicants. Until now, there has been little emphasis placed by design examiners on articulating a rationale for an obviousness rejection, supported by the facts and record of the particular case.

Given the emphasis that the court placed on the record-supported reason, applicants may expect to see fuller rationales articulated in obviousness rejections before the USPTO, which may be an effective forum to help develop the boundaries of obviousness that have been left ill-defined by the court.

## **Are there other secondary considerations?**

To complete its mapping of Graham onto design patents, the court noted that secondary considerations, including "commercial success, industry praise, and copying," can demonstrate nonobviousness.[8]

The court, however, admitted that it is "unclear whether certain other factors such as long felt but unsolved needs and failure of others apply in the design patent context." The court suggested that the rigidity of the Rosen-Durling requirements might have prevented the development of case law concerning secondary considerations for design patents.[9]

However, it is alternatively possible that fundamental differences between utility and design patents account for the smaller repertoire of viable secondary considerations for design patents.

Given that design patents are directed to ornamental appearance, not function, it is unlikely that design patent owners and applicants can leverage the full spectrum of secondary considerations developed for utility patents pursuant to Graham.

## **Saddle up.**

To show that its new standard is compatible with Supreme Court precedent in the design context, the court reached back to the Supreme Court's 1893 design patent case, *Smith v. Whitman Saddle Co.*

As the court admitted, the Supreme Court decided *Whitman Saddle* when "patent law did not speak of obviousness." [10]

The *Whitman Saddle* court evaluated a saddle design in view of two prior art references, identified that the claimed design was a combination of those prior designs, and then reasoned it was within the ordinary skill of saddlers to combine two halves of a saddle together.[11]

The court assumed that neither of the *Whitman Saddle* references was basically the same as the claimed design, supporting its decision to overrule *Rosen-Durling*. [12]

The court reasoned that *Whitman Saddle* considered "the prior art in the field of the article of manufacture, the knowledge of an ordinary saddler, and the differences between the prior art and the claimed design," supporting its new, more flexible standard.[13]

## **Conclusion**

Was there a better way?

Although the majority determined *Rosen-Durling* was incompatible with the flexible approach to obviousness prescribed under *Graham*, *KSR* and *Whitman Saddle*, the concurring opinion advocated for simply loosening *Rosen-Durling*. [14]

The concurring opinion specifically advanced that *Rosen-Durling* "has long been regarded as the application of the relevant *Graham* factors to design patents," and the test just needed "a bit of tinkering." [15]

The majority opinion did not take this approach. Instead, the majority decided to start anew, despite the

warnings and counterproposals from several amici.

The court did not agree that its abrogation of the Rosen-Durling test would "increase confusion, disrupt settled expectations, and leave lower courts and factfinders without the necessary guidelines to properly conduct the obviousness analysis," but acknowledged that there may be "some degree of uncertainty for at least a brief period."

There appears to be disagreement over how brief that period will be.

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[1] LKQ Corp. v. GM Global Tech. Operations LLC, No. 21-2348, slip op. at 15 (Fed. Cir. May 21, 2024) (en banc).

[2] See *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982); *Durling v. Spectrum Furniture Co. Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996).

[3] See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 416-421 (2007) (rejecting the requirement that a prior art reference recite a teaching, suggestion, or motivation to render a utility patent obvious. Instead, opting for a flexible approach by considering various other reasons why one of ordinary skill in the art would combine references).

[4] *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).

[5] LKQ, No. 21-2348, slip op. at 22.

[6] *Id.* at 23.

[7] KSR, 550 U.S. at 416.

[8] LKQ, No. 21-2348, slip op. at 27.

[9] *Id.* at 28, footnote 4.

[10] *Id.* at 3, footnote 2.

[11] *Id.* at 14-15.

[12] Id. at 16-17.

[13] Id. at 14.

[14] Id. at 31. (Lourie, C.J., Concurring).

[15] Id. at 32, 36. (Lourie, C.J., Concurring).