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## Federal Circuit Overrules *Rosen-Durling* Test For Design Patent Obviousness

The Federal Circuit has overruled the long-standing *Rosen-Durling* test used to evaluate obviousness of design patents. *LKQ Corp. v. GM Global Tech. Op. LLC*, No. 2021-2348 (Fed. Cir. May 21, 2024).

The court, which reheard the appeal *en banc* from a PTAB final written decision, cited a plain reading of the statutory scheme for design patents, as well as the Supreme Court's guidance in *KSR Int'l Co. v. Teleflex Inc.* that obviousness determinations must be flexible. In considering *Rosen-Durling's* dual requirements that (1) the primary prior art reference be "basically the same" as the claimed design and (2) secondary references must be "so related" to the primary reference that features from one would suggest application to the other, the court found these "rigid" standards to be at odds with Supreme Court precedent.

Instead, the Federal Circuit ordered an application of the same *Graham* factors used to evaluate utility patents, explaining how each factor should be applied within the context of a patented design. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Specifically, obviousness of a design patent is to be determined based on consideration of:

1. The scope and content of analogous prior art designs—i.e., designs from the same field of endeavor as the article to which the patented design is applied;
2. Differences between the overall visual appearance of the prior art design(s) and the patented design from the viewpoint of an ordinary designer in the relevant field;
3. Level of ordinary skill in the art—i.e., a designer who designs the type of articles to which the patented design is applied;
4. Secondary considerations of nonobviousness—specifically, commercial success, industry praise, and copying.



## BACKGROUND ON DESIGN PATENT LAW

A design patent protects a “new, original and ornamental design for an article of manufacture” and is governed by the same provisions of the Patent Act that relate to utility patents. 35 U.S.C. Section 171(a)-(b).

Since 1996, courts have assessed whether a claimed design is eligible for patent protection or whether it is obvious in view of the prior art based on the two-part *Rosen-Durling* test. First, *Rosen* provides a gateway requirement that the patent challenger find a single prior art reference where the design characteristics are “basically the same” as the claimed design. *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982). This reference has been referred to as the *Rosen* reference, and without such a reference, the obviousness inquiry ends.

If a suitable *Rosen* reference exists, then it may be modified by or combined with secondary references to determine whether the resulting design has the same overall visual appearance as the claimed design, thus rendering it obvious. However, *Durling* requires that any secondary reference must be “so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Durling v. Spectrum Furniture Co. Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996).

The historical application of this test made invalidation of design patents quite difficult and highly dependent on whether a *Rosen* reference could be found that is “basically the same” as the challenged design. This difficulty is reflected in the PTAB’s institution rate for proceedings involving design patents, which sits at less than 40%—significantly lower than the PTAB’s general institution rate, which has ranged from 60%-75% over the years.

## THE LKQ CASE

In August 2020, LKQ filed a series of petitions for *inter partes* review, challenging the validity of automotive design patents belonging to General Motors. In particular, IPR2020-00534 concerns GM’s Design Patent No. D797,625, which claims a design for a vehicle’s front fender. LKQ’s petition included an assertion that the D’625 patent was rendered obvious by a combination of two prior art references and, therefore, invalid. In its final written decision, the PTAB applied the *Rosen-Durling* test, finding that LKQ’s proffered *Rosen* reference did not create “basically the same” visual impression as the patented design. Accordingly, the Board ended its obviousness analysis without further consideration.

On appeal, LKQ argued that the Supreme Court’s 2007 decision in *KSR* had implicitly overruled the *Rosen* and *Durling* tests. In *KSR*, the Supreme Court advised against “rigid preventative rules” in assessing the obviousness of a challenged patent, because “obviousness analysis cannot be confined by a formalistic conception.”

While a panel of the Federal Circuit affirmed the Board’s final written decision on LKQ’s petition, the judges were divided in their analysis of whether and why *KSR*’s holding might apply to design patents. The Federal Circuit, therefore, granted rehearing en banc to consider whether *KSR* overruled the *Rosen-Durling* test and, if not, whether the court should nonetheless eliminate or modify the *Rosen-Durling* test.

On rehearing, the Federal Circuit held that the *Rosen-Durling* test was “improperly rigid” in view of Supreme Court precedent, which suggests a more flexible approach when determining obviousness. Specifically, “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” that go beyond the Supreme Court’s broad and flexible standard for obviousness.



In overruling *Rosen* and *Durling*, the Federal Circuit advised that invalidity of a patented design would be determined based on the same criteria used to assess the validity of a utility patent—i.e., the *Graham* factors. The Federal Circuit explained each factor within the context of design patent analysis.

**Factor 1.** As for the first *Graham* factor—i.e., the scope and content of prior art within the knowledge of an ordinary designer in the field of the design—the Federal Circuit formally rejected any limitation that the primary reference be “basically the same.” Instead, the Federal Circuit explained that the appropriate scope could already be determined under existing precedent, which states that a prior art reference may be used for an obviousness determination only when it is “analogous” to the claimed invention. That is, a prior art design may be used in an obviousness ground where the design is from the same field of endeavor as the article to which the patented design has been applied.

**Factor 2.** Regarding the second *Graham* factor—i.e., the differences between the prior art design and the design claim at issue—the court clarified that such a determination should compare the visual appearance of the claimed design with the prior art designs from the perspective of an ordinary designer in the field of the relevant article. This mirrors the infringement test established in *Egyptian Goddess*, though it is evaluated from the perspective of the ordinary *designer* as opposed to the ordinary *observer*.

**Factor 3.** The Federal Circuit affirmed its previous interpretation that factor three—the level of ordinary skill in the pertinent art—refers in the design patent context to an ordinary designer who designs the type of articles to which the claimed design is applied.

As with utility patents, obviousness of a design patent is evaluated after consideration of *Graham* factors 1-3. And in the case of multiple prior art references, motivation to modify the prior art design to create the same overall visual appearance as the patented design must exist. The court noted that while primary and secondary references would no longer need to be “so related,” as they were under the *Rosen-Durling* test, common sense dictates that where the references are more different, it may be more difficult for a challenger to establish a motivation to alter the primary prior art design without the aid of hindsight.

**Factor 4.** Finally, the Federal Circuit explained that just as secondary considerations of nonobviousness must be considered when applying *Graham* factor 4 to utility patents, so too should they be considered for design patents. In particular, obviousness should be considered in light of any evidence of commercial success, industry praise, and copying tied to the patented design.

Based on its holding, the Federal Circuit then vacated the Board’s final written decision regarding obviousness and remanded for reconsideration under the *Graham* framework.

#### KEY TAKEAWAY

The downfall of the *Rosen-Durling* test will generally make it harder to obtain design patents and easier to invalidate design patents. In doing away with the need for a *Rosen* reference that is “basically the same” as the patented design, the Federal Circuit has significantly broadened the field of potential prior art. And challengers will no longer be restricted to combining references that meet *Durling*’s “so related” standard.



## REMAINING QUESTIONS

### 1. Analogous Prior Art

While relying on the preexisting test for analogous art to define the scope of relevant prior art, the Federal Circuit declined to delineate the limits of what may or may not be analogous art within the context of design patents. As applied to utility patents, the test for analogous art has traditionally allowed for two categories of prior art: (1) art from the same field of endeavor as the claimed invention and (2) art that is reasonably pertinent to the particular problem with which the inventor is involved. While acknowledging that this second category was not clearly applicable within the design context, the court explicitly left it “to future cases to further develop the application” of the analogous standard.

The analysis of whether prior art designs are analogous will likely be straightforward where the patented design is applicable to only a single, manufacturable article. However, some designs are not so clearly limited as to one article, and parties may find it difficult to define the relevant “field of endeavor.”

### 2. Secondary Considerations of Nonobviousness

While expressly noting that commercial success, industry praise, and copying may demonstrate nonobviousness of a design, the Federal Circuit found it unclear whether other secondary considerations of nonobviousness, such as long felt but unsolved needs and failure of others, were relevant in the design patent context. It again left this question to future cases.

This question—like many design patent inquiries—demonstrates the difficulty in separating a patented design from the function of the article to which the design is applied. Particularly where the patented design directly influences the article’s utility, parties may try to rely on evidence of long felt need or failure of others, but the Federal Circuit’s decision does not make clear whether this evidence—which results from the design’s function and not strictly its appearance—should be relevant.

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