

LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 6/30/2023)

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This is a decision on a petition for rehearing en banc, from PTAB case IPR2020-00534.

LKQ appealed. The en banc court vacated the panel opinion *LKQ Corp. v. GM Global Technology Operations LLC*, No. 2021-2348, 2023 WL 328228 (Fed. Cir. Jan. 20, 2023).

The en banc court invited briefing on the following questions:

A. Does *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), overrule or abrogate *In re Rosen*, 673 F.2d 388 (CCPA 1982), and *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100 (Fed. Cir. 1996)? [*LKQ Corporation v. GM Global Technology Operations LLC*, 2021-2348 (Fed. Cir. 6/30/2023).]

B. Assuming that *KSR* neither overrules nor abrogates *Rosen* and *Durling*, does *KSR* nonetheless apply to design patents and suggest the court should eliminate or modify the *Rosen-Durling* test? In particular, please address whether *KSR*'s statements faulting "a rigid rule that limits the obviousness inquiry," 550 U.S. at 419, and adopting "an expansive and flexible approach," *id.* at 415, should cause us to eliminate or modify: (a) *Durling*'s requirement that "[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,'" 101 F.3d at 103 (quoting *Rosen*, 673 F.2d at 391); and/or (b) *Durling*'s requirement that secondary references "may only be used to modify the primary reference if they are 'so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other,'" *id.* at 103 (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)) (internal alterations omitted) [*LKQ Corporation v. GM Global Technology Operations LLC*, 2021-2348 (Fed. Cir. 6/30/2023).]

C. If the court were to eliminate or modify the *Rosen-Durling* test, what should the test be for evaluating design patent obviousness challenges? [*LKQ Corporation v. GM Global Technology Operations LLC*, 2021-2348 (Fed. Cir. 6/30/2023).]

D. Has any precedent from this court already taken steps to clarify the *Rosen-Durling* test? If so, please identify whether those cases resolve any relevant issues. [*LKQ Corporation v. GM Global Technology Operations LLC*, 2021-2348 (Fed. Cir. 6/30/2023).]

E. Given the length of time in which the *Rosen-Durling* test has been

applied, would eliminating or modifying the design patent obviousness test cause uncertainty in an otherwise settled area of law? [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 6/30/2023).]

F. To the extent not addressed in the responses to the questions above, what differences, if any, between design patents and utility patents are relevant to the obviousness inquiry, and what role should these differences play in the test for obviousness of design patents? LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 6/30/2023).]

The en banc court stated that the issues of issues of anticipation and forfeiture were preserved, and the court did not require additional briefing on those issues.

The en banc court invited amicus curiae input and stated that “briefs of amicus curiae may be filed without consent and leave of the court.” Amicus briefs in support of a party are due by 14 days after the service of the opening brief of the corresponding party’s brief.

In note the following case law quotes defining the *Rosen-Durling* test. In *Rosen*, the CCPA stated:

While a § 103 rejection of a claimed design need not be based on a single reference, *In re Spreter*, 661 F.2d 1220, 211 USPQ 866 (Cust. & Pat.App.1981); *In re Krueger*, 41 CCPA 757, 208 F.2d 482, 100 USPQ 55 (1953), the long-standing test for the proper combination of references has been "whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." *In re Glavas*, 43 CCPA 797, 801, 230 F.2d 447, 450, 109 USPQ 50, 52 (1956). Moreover, as we stated in *In re Jennings*, 37 CCPA 1023, 1025, 182 F.2d 207, 208, 86 USPQ 68, 70 (1950): ["] In considering patentability of a proposed design the appearance of the design must be viewed as a whole, as shown by the drawing, or drawings, and compared with something in existence — not with something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would require modification of every individual feature, ... [Emphasis added.] ["] Thus there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references. [In re Rosen, 673 F. 2d 388, 391 (CCPA 1982).]

Here the "something in existence" which we must use for comparison with appellant's table design is the Rosen desk, the primary reference. If the Rosen desk design is modified only to the extent that it becomes a table, it does not thereby have the design characteristics of appellant's table. The table top would be notched, and the surface surrounded by a substantial apron which is integral with

the legs. Appellant's table cannot be rejected as no more than an adaptation of the desk design to table form. *See In re Lamb*, 48 CCPA 817, 286 F.2d 610, 128 USPQ 539 (1961). Thus, the reference clearly cannot stand alone. [*In re Rosen*, 673 F. 2d 388, 391 (CCPA 1982).]

In *Durling*, the Federal Circuit stated:

Before one can begin to combine prior art designs, however, one must find a single reference, "a something in existence, the design characteristics of which are basically the same as the claimed design." *In re Rosen*, 673 F.2d at 391, 213 USPQ at 350. [*Durling v. Spectrum Furniture Co., Inc.*, 101 F. 3d 100 (Fed. Cir. 1996).]

...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. *See In re Harvey*, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). These secondary references may only be used to modify the primary reference if they are "so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other." *In re Borden*, 90 F.3d at 1575, 39 USPQ2d at 1526-27. [*Durling v. Spectrum Furniture Co., Inc.*, 101 F. 3d 100, 103 (Fed. Cir. 1996).]

The Federal Circuit has restated and clarified the Rosen-Durling test as follows:

In considering prior art references for purposes of determining patentability of ornamental designs, the focus must be on appearances and not uses.

Like the examiner, the Board improperly mixed principles of obviousness for utility patents with those for ornamental design patents. Unlike an invention in a utility patent, a patented ornamental design has no use other than its visual appearance, *In re Glavas*, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956), and its scope is "limited to what is shown in the application drawings," *In re Mann*, 861 F.2d 1581, 1582, 8 USPQ2d 2030, 2031 (Fed. Cir. 1988). Therefore, in considering prior art references for purposes of determining patentability of ornamental designs, the focus must be on appearances and not uses. *In re Glavas*, 230 F.2d at 450, 109 USPQ at 52. [*In re Harvey*, 12 F. 3d 1061, 1065 (1993).]

In considering prior art patent references for purposes of determining patentability of ornamental designs, the specific design characteristics, and not a "design concept," can be relied upon.

... Extending the rule in *In re Glavas* and *In re Mann* one step further, we hold that the Board should have focused on actual appearances, rather than "design concepts." Accordingly, we hold that the Board erred in misapplying the obviousness standard because it admittedly relied upon the prior art Harvey vase as a "design concept" rather than for its specific design characteristics. Design patent references must be viewed in the latter fashion. Nor can we say that resort to such an analysis was harmless error. Rather, viewing the principal prior art reference as a design concept produced a type of post-hoc rationalization of the claimed designs that is improper. [*In re Harvey*, 12 F. 3d 1061, 1065 (1993).]

The ultimate inquiry in an obviousness analysis is "whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved."

Under the first step, a court must both "(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates 'basically the same' visual impression." *Durling*, 101 F.3d at 103. The ultimate inquiry in an obviousness analysis is "whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved." *Id.*, quoted in *Apple*, 678 F.3d at 1329. [*High Point Design LLC v. Buyers Direct, Inc.*, 730 F. 3d 1301, ___ (Fed. Cir. 9/11/2013).]

A reference only qualifies as a primary reference if its "design characteristics ... are basically the same as the claimed design." If a primary reference exists, "other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design."

When assessing the potential obviousness of a design patent, a finder of fact employs two distinct steps: first, "one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design"; second, "[o]nce 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." *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir.1996) (internal quotations omitted); *see also Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012). Under the first step, a court must both "(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates 'basically the same' visual impression." *Durling*, 101 F.3d at 103. [*High Point Design LLC v. Buyers Direct, Inc.*, 730 F. 3d 1301, 1311-1312 (9/11/2013).]

Comments:

It seems to me pretty clear that the Federal Circuit is going to modify the *Rosen-Durling* test because it is a rigid rule, requiring a primary reference test, and it does not comport with the “expansive and flexible approach” required by *KSR*. However, the exact contours of the modification are to be determined.