

[LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 \(Fed. Cir. 5/21/2024\)\(en banc\)](#)

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This is an en banc decision in an appeal from PTAB case IPR2020-00534.

The PTAB issued a final written decision that held that "LKQ failed to establish that the challenged [design patent] claim would have been obvious," because LKQ failed to identify a *Rosen* reference.

Legal issue: 35 USC 103, Obviousness, design patents

The Federal Circuit changed the test for determining obviousness of design patents. On that basis, the Federal Circuit vacated and remanded the portion of the final written decision relating to that obviousness.

The Federal Circuit overruled the *Rosen-Durling* test.

Having overruled *Rosen* and *Durling*, we consider what the framework for evaluating obviousness of design patent claims should be. [[LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 \(Fed. Cir. 5/21/2024\)\(en banc\)](#).]

The Federal Circuit incorporated the test and case law applicable to evaluating obviousness of utility patents, for to evaluating obviousness of design patents, but for certain criteria specific to design patents.

The Federal Circuit retained the "ordinary designer in the field of the design," for the scope and content of analogous prior art.

...We are guided by the language of § 103, as well as the Supreme Court's and our court's precedent on obviousness in both the design and utility patent contexts. We are also mindful of the differences between design and utility patents, as well as the policy concerns emphasized by the parties and amici. Ultimately, we agree with our precedent holding that "[i]nvalidity based on obviousness of a patented design is determined [based] on factual criteria similar to those that have been developed as analytical tools for reviewing the validity of a utility patent under § 103, that is, on application of the *Graham* factors." *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1462 (Fed. Cir. 1997). [[LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 \(Fed. Cir. 5/21/2024\)\(en banc\)](#).]

The Federal Circuit restated that analogous art meant:

the "scope and content of the prior art" within the knowledge of an ordinary designer in the field of the design. *See Graham*, 383 U.S. at 17. [[LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 \(Fed. Cir.](#)

5/21/2024)(en banc).]

The Federal Circuit held that "an analogous art requirement applies for obviousness of design patents."

The Federal Circuit held that the first part of the two-part test for scope of analogous art used in utility patents applied to design patents.

For utility patents, we use a two-part test to determine the scope of analogous art: (1) whether the art is from the same field of endeavor as the claimed invention; and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *See Airbus S.A.S.*, 941 F.3d at 1379. This is a fact-dependent inquiry that requires a case-by-case determination. *See id.* ("Whether a reference qualifies as analogous prior art is a question of fact . . ."). [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 5/21/2024)(en banc).]

We conclude that the first part of this two-part test applies to design patents in a straightforward manner. In other words, analogous art for a design patent includes art from the same field of endeavor as the article of manufacture of the claimed design. *See* 35 U.S.C. § 171(a) ("Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor" (emphasis added)). As we have previously held, "[t]he scope of the prior art is not the universe of abstract design and artistic creativity, but designs of the same article of manufacture or of articles sufficiently similar that a person of ordinary skill would look to such articles for their designs." *Hupp*, 122 F.3d at 1462. [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 5/21/2024)(en banc).]

The Federal Circuit did not hold that the second part of the two-part test for scope of analogous art used in utility patents applied to design patents. Instead, the Federal Circuit indicated that the precise contours of the scope of analogous art for design patents was left to future cases to develop.

On the other hand, the second part of the two-part analogous art test for utility patents would not seem to apply to design patents in the same way, and how to translate this part of the test into the design context is less apparent. Unlike a utility patent, a design patent itself does not clearly or reliably indicate "the particular problem with which the inventor is involved." *See Airbus S.A.S.*, 941 F.3d at 1379 (emphasis added). Indeed, design patents have no written description or written claims to define their scope; the invention is defined by the overall visual impression that the drawings convey. *See Egyptian Goddess, Inc. v. Swisa Inc.*, 543 F.3d 665, 679–80 (Fed. Cir. 2008) (en banc) (a design claim is better

represented by an illustration). Moreover, at oral argument, the parties disputed whether an ornamental design for an article of manufacture could be viewed as solving a problem. *See* Oral Arg. at 2:08–3:11, 1:09:12–1:10:29, https://oralarguments.cafc.uscourts.gov/default.aspx?fl=21-2348_02052024.mp3. [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 5/21/2024)(en banc).]

In this opinion, we do not delineate the full and precise contours of the analogous art test for design patents. Prior art designs for the same field of endeavor as the article of manufacture will be analogous, and we do not foreclose that other art could also be analogous. Whether a prior art design is analogous to the claimed design for an article of manufacture is a fact question to be addressed on a case-by-case basis and we “leave it to future cases to further develop the application of this standard.” *Cf. Egyptian Goddess*, 543 F.3d at 679 (quoting *In re Seagate Tech., LLC*, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (en banc)). [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 5/21/2024)(en banc).]

The Federal Circuit held that there was no longer a threshold "similarity" requirement for a primary reference in determining design patent claim obviousness.

After considering the scope and content of the prior art, we turn to *Graham* factor two: determining the differences between the prior art designs and the design claim at issue. *Graham*, 383 U.S. at 17. This approach casts aside a threshold “similarity” requirement. [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 5/21/2024)(en banc).]

The Federal Circuit held that the level of ordinary skill to be applied in design patent cases remained the knowledge of a designer of ordinary skill who designs articles of the type involved.

The pertinent art [must be] resolved.” *Graham*, 383 U.S. at 17. This requirement comes directly from § 103, which provides that a claimed invention is unpatentable if it “would have been obvious before the effective filing date of the claimed invention to a person of ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103. [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 5/21/2024)(en banc).]

In the design patent context, we have interpreted “a person of ordinary skill in the art to which the invention pertains” in § 103 as meaning that obviousness of a design patent claim is assessed from the viewpoint of an ordinary designer in the field to which the claimed design pertains. In *In re Nalbandian*, our predecessor court explained that, consistent with *Graham*, “[i]n design cases we will consider the fictitious person identified in § 103 as ‘one of ordinary skill in the art’ to be the

designer of ordinary capability who designs articles of the type presented in the application.” 661 F.2d 1214, 1216 (CCPA 1981). In other words, for *Graham* factor three, we consider the knowledge of “a designer of ordinary skill who designs articles of the type involved.” *Borden*, 90 F.3d at 1574 (citation omitted); *Hupp*, 122 F.3d at 1462 (“The determination of the ultimate question of obviousness is made from the viewpoint of a person of ordinary skill in the field of the patented design.”); *Whitman Saddle*, 148 U.S. at 681 (determining patentability from the perspective of “the ordinary skill of workmen of the trade” and an ordinary “saddler”). [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 5/21/2024)(en banc).]

The Federal Circuit held that legal motivation to modify the prior art design required motivation to modify the prior art design to create the same overall visual appearance as the claimed design, and that this test focused on the "visual impression of the claimed design as a whole."

After ascertaining the knowledge of an ordinary designer in the relevant field, the scope and content of the prior art, and the differences between the prior art and the claimed design, the obviousness or nonobviousness of the claimed design is evaluated. We have previously described this inquiry as whether an ordinary designer in the field to which the claimed design pertains would have been motivated to modify the prior art design “to create the same overall visual appearance as the claimed design.” *Campbell Soup, Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021) (citation and quotation marks omitted); *see also Borden*, 90 F.3d at 1574. We reaffirm that the “inquiry focuses on the visual impression of the claimed design as a whole and not on selected individual features.” *Borden*, 90 F.3d at 1574. [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 5/21/2024)(en banc).]

The Federal Circuit held that sufficient motivation to modify merely required a "record-supported reason" why 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.

Where a primary reference alone does not render the claimed design obvious, secondary references may be considered. The primary and secondary references need not be “so related” such that features in one would suggest application of those features in the other but they must both be analogous art to the patented design. Consistent with *KSR*, the motivation to combine these references need not come from the references themselves. *KSR*, 550 U.S. at 418–19 (rejecting a rigidly applied TSM test). But there must be 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. *See Campbell Soup*, 10 F.4th at 1275 (discussing the question of whether “an ordinary designer would have modified the primary reference to create a design that has the same overall visual appearance as the claimed design”); see also *Amicus United States Br.* at 12–13 (describing factors to consider including “ordinarily skilled designer’s experience, creativity,” as well as “what market demands and industry customs exist” in the relevant field and, “which ornamental features are commonplace in the relevant field”). Just as with the analogous art inquiry, in the area of motivation to combine, the problem to be solved may have less relevance in the design patent context than in the utility patent context. Of course, it follows that the more different the overall appearances of the primary reference versus the secondary reference(s), the more work a patent challenger will likely need to do to establish a motivation to alter the primary prior art design in light of the secondary one and demonstrate obviousness without the aid of hindsight. [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 5/21/2024)(en banc).]

The Federal Circuit held that secondary considerations must be considered in assessing whether a design patent claim would have been obvious.

Consistent with *Graham*, the obviousness inquiry for design patents still requires assessment of secondary considerations as indicia of obviousness or nonobviousness, when evidence of such considerations is presented. *Graham*, 383 U.S. at 17–18 (“Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circum-stances surrounding the origin of the subject matter sought to be patented.”). In prior cases involving design patents, we have confirmed that commercial success, industry praise, and copying may demonstrate nonobviousness of design patents. *Campbell Soup*, 10 F.4th at 1276–79 (considering evidence of commercial success, industry praise, and copying); *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1335–36 (Fed. Cir. 2014) (same). We do not disturb our existing precedent regarding the application of secondary considerations such as commercial success, industry praise, and copying to the obviousness analysis in design patents. It is unclear whether certain other factors such as long felt but unsolved needs and failure of others apply in the design patent context. We leave to future cases the determination of whether considerations such as long felt but unsolved need and failure of others will have significance to the obviousness inquiry in the design patent context.[4] [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 5/21/2024)(en banc).]

Regarding facts specific to this case, the Federal Circuit also held that the PTAB erred by requiring LKQ to have identified “the correct visual impression created by the patented design as

a whole," to show design patent claim obviousness.

As an alternative ground for holding the D'625 patent nonobvious, the Board held that LKQ's failure to identify "the correct visual impression created by the patented design as a whole" in its claim construction, "standing alone, justifies [the Board's] conclusion that LKQ fails also to prove by a preponderance of the evidence that the challenged claim of the '625 patent is unpatentable." *Board Decision*, 2021 WL 3411458, at *17 (quoting *Durling*, 101 F.3d at 103). We have repeatedly held that tribunals "should not treat the process of claim construction [in design patent cases] as requiring a detailed verbal description of the claimed design, as would typically be true in the case of utility patents." *Egyptian Goddess*, 543 F.3d at 680; *see also Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1302–03 (Fed. Cir. 2010) (stating that for design patents, "claim construction must be adapted to a pictorial setting" and warning of "the dangers of reliance on a detailed verbal claim construction"). Rather, the tribunal is not "obligated to issue a detailed verbal description of the design" as "a design is better represented by an illustration." *Egyptian Goddess*, 543 F.3d at 679. We reaffirm this principle and hold that the Board erred in rejecting LKQ's asserted obviousness grounds on this basis. [LKQ Corporation v. GM Global Technology Operations LLC, 2021-2348 (Fed. Cir. 5/21/2024)(en banc).]

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