



## Federal Circuit Overrules Rosen-Durling Test for Design Patent Obviousness – USPTO Follows Quickly with Guidance

June 3, 2024

Reading Time : **3 min**

By: Megan R. Mahoney, Michael P. Kahn, Daniel L. Moffett, Kayla Flanders (Law Clerk)

In a highly anticipated decision, the *en banc* Federal Circuit overruled the longstanding *Rosen-Durling* test for assessing obviousness of design patents. The challenged framework, derived from two cases, *In re Rosen*, 673 F.2d 388 (CCPA 1982) and *Durling v. Spectrum Furniture Co.*, 101 F.3d 100 (Fed. Cir 1996), required (1) a primary reference to be “basically the same” as the challenged design, and (2) any secondary reference to be “so related” to the primary reference that features in one would suggest application of those features to the other. That test was deemed “improperly rigid” and was overruled in favor of *KSR*’s application of the more flexible *Graham* factors to utility patents.

The dispute arose when LKQ Corporation and Keystone Automotive Industries, Inc. (“LKQ”) filed a petition for *inter partes* review of GM Global Technology LLC’s (“GM”) design patent for a vehicle’s front fender. LKQ argued that GM’s design is unpatentable as obvious under 35 U.S.C. § 103. The Patent Trial and Appeal Board applied the *Rosen-Durling* test and determined that LKQ failed to identify a reference that created “basically the same” visual impression as the patented design. On appeal, a three-judge panel of the Federal Circuit affirmed the Board’s decision and declined to overrule *Rosen* or *Durling* without a “clear directive from the Supreme Court.”

In support of its petition for *en banc* review, LKQ argued that the *Rosen-Durling* test adopts a strict rule that is inconsistent with the Supreme Court’s decision in *KSR*. LKQ further argued that the test should be replaced by the factual *Graham* inquiry. GM argued that LKQ had

forfeited this argument by not raising it before the Board and, even if it were not forfeited, *KSR* does not overrule *Rosen* or *Durling*.

The court did not find forfeiture and determined that the petition was sufficient to preserve LKQ's argument, which was a pure question of law presenting a "question of significant impact." On the merits, the *en banc* court held that 35 U.S.C. § 103 obviousness conditions apply to design and utility patents alike and, on that basis, adopted the *Graham* approach.

Under the *Graham* analysis, the fact finder considers the "scope and content of the prior art" within the knowledge of an ordinary designer in the field of design. While there is no "basically the same" requirement to qualify as prior art, an analogous art requirement applies to each reference. The court maintained that the continued requirement of a primary reference will help prevent undue confusion while avoiding "rigid preventative rules that deny factfinders recourse to common sense."

For utility patents, a two-prong analysis is applied when considering whether a reference qualifies as analogous art. The Federal Circuit declined to "delineate the full and precise contours" of the analogous art requirement when applied to design patents. The court held the "same field of endeavor" first prong can be applied to design patents but left open the question as to whether the "pertinent to the particular problem" second prong applies to design patents. The majority recommended a case-by-case approach.

The day after the *en banc* decision, on May 22, 2024, the United States Patent and Trademark Office issued a memorandum "to provide updated guidance and examination instructions, effective immediately, on evaluating obviousness in design patent applications and design patents." Director Vidal explained that USPTO personnel "must apply a flexible approach to obviousness similar to that applied in utility applications." This approach involves factual inquiries into (1) the scope and content of the prior art, (2) the differences between the prior art and the design as claimed at issue, (3) the level of ordinary skill in the art, and (4) secondary considerations. Director Vidal provided detailed instructions concerning each factual inquiry and promised to issue further guidance, examples, and training consistent with *LKQ*.

**Practice Tip:** Upending over 40 years of precedent, this decision is expected to have a significant impact on the landscape of obtaining and enforcing design patents. Design patent owners and challengers alike should follow post-LKQ decisions and the relevant USPTO guidance closely to understand how this more-flexible obviousness analysis will impact design patent invalidity and patentability determinations moving forward.

*LKQ Corp., Keystone Auto. Indus., Inc., v. GM Global Tech. Operations LLC*, Case No. 2021-2348 (Fed. Cir. 2024) (Stoll, J.).

## Categories

Patent Litigation

Patent Law

© 2025 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. Prior results do not guarantee a similar outcome. Akin is the practicing name of Akin Gump LLP, a New York limited liability partnership authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG. For more information about Akin Gump LLP, Akin Gump Strauss Hauer & Feld LLP and other associated entities under which the Akin Gump network operates worldwide, please see our Legal Notices page.