

Insights: Alerts

Federal Circuit Upends Design Patent Validity Test

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Unlike utility patents, which are frequently invalidated on obviousness grounds, design patents historically faced a rigid test making obvious findings rare. The Federal Circuit has just issued an *en banc* decision that upends the existing law of design patent obviousness, which will likely make obviousness challenges to design patents a much more viable line of defense to claims of infringement going forward.

The Federal Circuit's May 21, 2024 *en banc* decision in *LKQ Corp. v. GM Global Tech. Operations LLC*, No. 21-2348, slip op. at 15 (Fed. Cir. May 21, 2024) overruled the *Rosen-Durling* test that has been used for decades to assess obviousness of U.S. design patent. The *Rosen-Durling* test required (1) the identification of a primary reference that was “basically the same” as the claimed design and (2) that secondary references must be “so related” to the primary reference that features from one would suggest application to the other. In practice the *Rosen-Durling* test proved to be a rigid test creating a high hurdle to invalidating a design patent, with most attempts to invalidate never making it past the requirement that a primary reference be identified that is “basically the same.”

The *LKQ en banc* decision overrules both prongs of the *Rosen-Durling* test, and *Rosen-Durling* is no longer the proper framework for evaluating design patent obviousness. Instead, *LKQ* holds that the same *Graham* factors used to evaluate obviousness of utility patents should also be used for design patents. *LKQ* further holds that the flexible obviousness analysis allowed for under the Supreme Court's decision in *KSR* also applies to design patents.

LKQ provides some guidance for how the *Graham* and *KSR* framework should be employed in the context of design patents. For example, when reviewing the scope and content of the prior art, the analogous art requirement is to be used, and the primary reference, which still must be identified, must be from an analogous art. The Court reasoned that the first factor of the two-part analogous art inquiry, whether the art is from the same field of endeavor as the claimed invention, should apply to design patents but questioned whether the second factor, whether the reference is reasonably pertinent to the particular problem faced by the inventor, would also apply to design patents.

Although *LKQ* provides some guidance as to how *Graham* and *KSR* should be applied to design patents, it also leaves much to future cases to clarify exactly how this will work in practice. While much remains uncertain, what is clear is that obviousness will take a much more significant role in U.S. design patents than it has in the past, and that strategies for protecting designs, enforcing designs, and defending against claims of design patent infringement will need to significantly evolve to account for this sea change in the law.

Read the *LKQ en banc* decision [here](#).

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