

How *Graham* factor one applies to design patents in a post-LKQ world

R. Parrish Freeman and Matthew Petersen of Maschoff Brennan discuss the impact of the *LKQ Corp. v. GM Global Tech.* case on design patent obviousness, highlighting the shift from the *Rosen-Durling* test to the more flexible *Graham* factors.

LKQ Corp. v. GM Global Tech. shook up the world of design patents, as the Federal Circuit, sitting en banc, overruled the longstanding *Rosen-Durling* test for determining design patent obviousness. 102 F.4th 1280, 1293 (Fed. Cir. 2024). In the wake of such seismic precedential activity, the LKQ court left only the *Graham* factors, broad guidance on how they apply to design patents, and a flood of questions from patent practitioners. See *id.* at 1295-1300. This article, while briefly walking through the background of *Rosen-Durling*, focuses on one of those questions: how does *Graham* factor one apply to design patents?

Over-ruling *Rosen-Durling*

Before LKQ, to establish obviousness of a design patent claim under § 103, a party had to provide prior art in the form of a primary reference and a secondary reference, and those references had to satisfy the two-part *Rosen-Durling* test. *Id.*; see also *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331-1332, 1334 (Fed. Cir. 2014) (applying the *Rosen-Durling* test). The primary reference, referred to as the "*Rosen* reference," comprises step one of the *Rosen-Durling* test. LKQ, 102 F.4th at 1289. That is, the primary reference had to be "basically the same" as the challenged design claim – leaving little wiggle room for prior art references that differed, even if only slightly. *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982). If this first step of the test was not satisfied, the obviousness analysis proceeded no further. LKQ, 102 F.4th at 1289. The second step of *Rosen-Durling* focused on a secondary reference (or references). There, one or more secondary references might serve as a source for ornamental features missing from the primary reference, but only if each



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secondary reference was "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." *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996). This "so related" requirement further limited the availability of viable prior art references. *Id.*

Given the "rigidity" of the *Rosen-Durling* test, the court was quick to replace it with a more "flexible" approach. See LKQ, 102 F.4th at 1293. In doing so, the court based its reasoning in the statutory language of § 103, and the Supreme Court precedents of *Graham*, *KSR*, and *Whitman Saddle* (a nineteenth-century horse saddle case that invalidated a design patent under § 103 by flexibly combining two prior art references). See *id.*; *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007); *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 680-682 (1893). To summarize this transition to flexibility in design patent obviousness, the LKQ court quoted *KSR*: an "obviousness analysis cannot be confined by a formalistic conception." *KSR*, 550 U.S. at 419. Unsurprisingly, then, the LKQ court *did not* fall victim to a "formalistic conception" in replacing the previous *Rosen-Durling* regime for determining design patent obviousness. *Id.*

Out with *Rosen-Durling*, in with *Graham*

The Federal Circuit explained that, despite the differences between design and utility patents, "design patents, like utility patents, must meet the nonobviousness requirement of 35 U.S.C. § 103." LKQ 102 F.4th at 1293 (citing *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1380,

1384-85 (Fed. Cir. 2009)). As such, the court reaffirmed its precedent 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." LKQ, 102 F.4th at 1295 (quoting *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1462 (Fed. Cir. 1997)). And just like that, goodbye *Rosen-Durling*, hello *Graham*. But how, exactly, do the *Graham* factors apply to design patents? The court walked through each factor, describing such application with varying levels of specificity. LKQ, 102 F.4th at 1295-1301. This article, however, is primarily concerned with the first *Graham* factor – the "scope and content of prior art." *Graham*, 383 U.S. at 17.

Graham factor one and the primary reference

While the en banc LKQ court abandoned the need for a *Rosen* reference, it made clear that, when applying *Graham* factor one to determine the "scope and content of the prior art," a "primary reference must be identified." LKQ, 102 F.4th at 1298. Maintaining this primary reference requirement is necessary to prevent hindsight bias, as the court noted, because "almost every new design is made up of elements which, individually, are old somewhere in the prior art." *Id.* (quoting *In re Glavas*, 230 F.2d 447, 450 (C.C.P.A. 1956)). Unlike the *Rosen* reference, though, a primary reference "need not be 'basically the same' as the claimed design." LKQ, 102 F.4th at 1298. Instead, as stated in *In re Jennings* and quoted by the court, the primary reference must be "something in existence – not ... 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." 182 F.2d 207, 208 (C.C.P.A. 1950); see also LKQ, 102 F.4th at 1298. In other words, a primary reference must be considered, and exist, "as a whole." *Jennings*, 182 F.2d at 208, and cannot merely be a conglomeration of various designs to meet the features of the claimed design, LKQ, 102 F.4th at 1298.

Résumés

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To determine a proper primary reference, *Jennings* does little more than establish that the reference must *exist*, so the LKQ court provided a bit more guidance. See *id.* Specifically, the court states:

"[t]he primary reference will likely be the closest prior art, i.e., the prior art design that is most visually similar to the claimed design. The more visually similar the primary reference design is to the claimed design, the better positioned the patent challenger will be to prove its § 103 case."

LKQ, 102 F.4th at 1298. Thus, instead of needing to clear the "basically the same" bar, a primary reference can exist on a spectrum of "visual similarity." *Id.* And the court keeps it simple: the more a primary reference looks like a claimed design, the more likely the claim will not survive the obviousness analysis. LKQ, 102 F.4th at 1298.

Importantly, the court provides one last piece of advice regarding the primary reference requirement: "The primary reference will typically be in the same field of endeavor as the claimed ornamental design's article of manufacture, but it need not be, so long as it is *analogous art*." *Id.* (emphasis added). Put differently, the primary reference may or may not be in the same field of endeavor as the claimed design (though it usually will), but it *must* be analogous art. *Id.* This holding begs the inevitable question: what constitutes analogous art for design patents?

Institution of the design patent analogous art requirement

At the outset of its discussion of *Graham* factor one, the *LKQ* court held that "an analogous prior art requirement applies for obviousness of design patents" – not just utility patents. *LKQ*, 102 F.4th at 1296. The court then outlined this requirement, quoting Federal Circuit precedent: "a reference qualifies as prior art for an obviousness determination only when it is analogous to the claimed invention." *Id.* (quoting *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1379 (Fed. Cir. 2019)). It also laid out the rationale behind such a requirement: to fall in line with the language of § 103 (tying the scope of prior art to the knowledge and understanding of the hypothetical person of ordinary skill in the art), and to "defend against hindsight." *LKQ*, 102 F.4th at 1296 (citing *Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1358 (Fed. Cir. 2023)).

Finally – to further solidify the correctness of its analogousness holding – the *LKQ* court walked through *In re Glavas*, a case that paved the way for the *Rosen-Durling* test. *See LKQ*, 102 F.4th at 1296–1297. There, the then-C.C.P.A. instituted an analogous art requirement for design patents but held that it could not be applied in the same way it applied to utility patents. *Glavas*, 230 F.2d at 450.

As such, the court made the following rule: "The question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are *so related* that the appearance of certain ornamental features in one would suggest the application of those features to the other." (emphasis added). *Id.* With that, the "so-related" prong of *Rosen-Durling* was born, only to become more rigid with time.

In overruling the *Rosen-Durling* test, the en banc *LKQ* court effectively overruled the *Glavas* analogous art rule. However, the court found "no basis for abandoning the underlying analogous art requirement for assessing nonobviousness of design patents" that was established in *Glavas*. *LKQ*, 102 F.4th at 1296. Instead, the court wrote of a "return to a more flexible fact-based analysis of whether the references are analogous art in

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a manner similar to utility patents"; an approach that "casts aside a threshold 'so-related' requirement but maintains the threshold analogous art requirement." *Id.*

Application of the design patent analogous art requirement

Currently, it seems that the court succeeded in creating a flexible approach to the threshold analogous art requirement. Whereas utility patents depend on 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 not within the same field of endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved – the test is now much more open-ended for design patents. *See id.*

That is, speaking to the first part of the analogous art test, "prior art designs for the same field of endeavor as the article of manufacture will be analogous," but the court does "not foreclose that other art could also be analogous." *Id.* at 1297. Thus, the court wrote, "[w]hether 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." *Id.* at 1297–1298. Put differently, the first prong of the analogous art test applies to design patents, but that a reference fails to directly satisfy that prong does not preclude it from being considered analogous prior art. *See id.*

Regarding the second part of the analogous art test, because it deals with the solving of a problem – not the appearance of a design – the court noted that "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." *Id.* at 1297. The court further discussed the difficulties of applying the second part of the test to design patents, but conspicuously avoided an outright rule stating that it would *never* apply to design patents. *See id.*

Importantly, to cover its bases on analogous prior art as a whole, the court wrote the following: "In this opinion, we do not delineate the full and precise contours of the analogous art test for design patents," adding, "[w]e leave it to future cases to further develop the application of this standard." *Id.* at 1297–1298. The bottom line: an analogous art requirement has been instituted for design patents – not dissimilar to that of the requirement for utility patents – and a prior art reference is analogous if it is from the same field of endeavor as the claimed design, though it doesn't have to be. *See id.* Rigidity be gone; the analogous art requirement for design patents apparently knows no bounds (yet).

A summary of *LKQ*'s application of *Graham* factor one and a bit of advice

Following *LKQ*, the *Graham* factors now apply to obviousness analyses for design patents. *Id.* at 1295. To satisfy the first *Graham* factor, a patent challenger must provide a primary reference. *Id.* at 1298. The primary reference must be considered, and exist, as a whole. *Id.* And, at the very least, the primary reference must be analogous art. *Id.* at 1297. Secondary references, if needed, must also be analogous art (and do not need to be "so related" to the primary reference). *Id.* at 1299. A prior art reference is analogous if it is from the same field of endeavor as the claimed design; however, depending on the facts, a reference may still be analogous if it falls outside of that field. *Id.* at 1297–1298. Thus, if a potential main or secondary reference exists, whether it will be deemed analogous cannot easily be predicted. Evidently, *LKQ* intentionally left an enormous amount of space for arguments to be crafted, and caselaw to be made, regarding design patent obviousness. *See id.* So, perhaps the best piece of advice in this post-*LKQ* world is this: take a page out of the Federal Circuit's book and use a *flexible* approach when dealing with obviousness for design patents – particularly as it pertains to applying *Graham* factor one.

Contact info

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