



LKQ: What is it all about and what is its impact likely to be?

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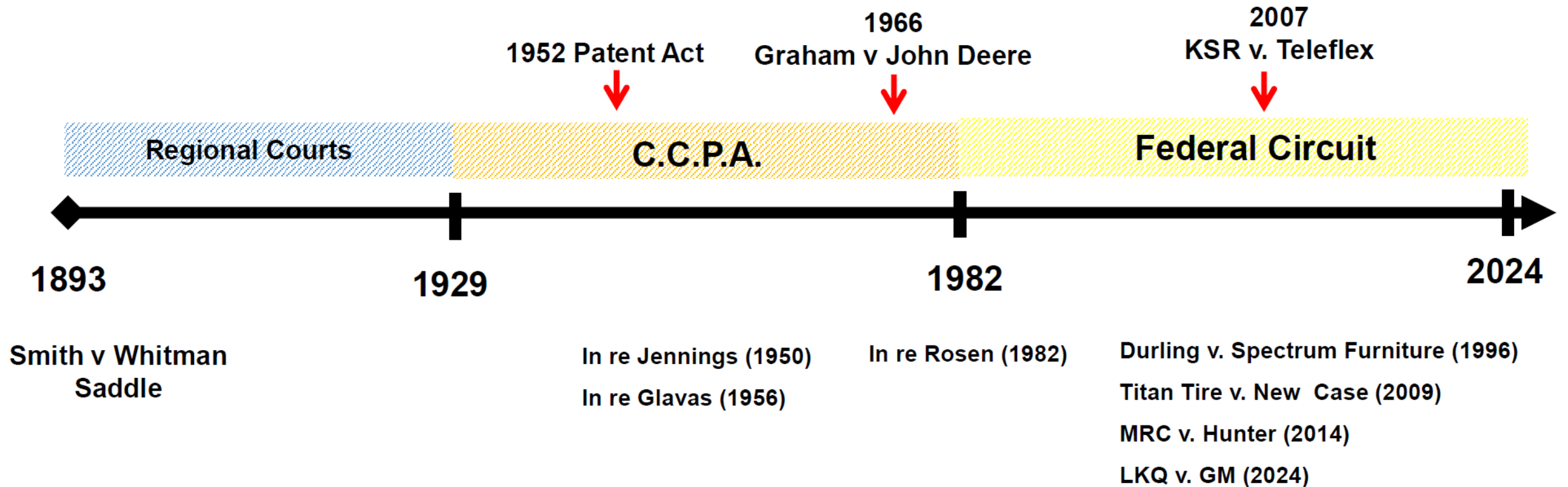
DESIGN
LAW
2024

LKQ Corp. v. GM Global Technology
(Fed. Cir. 2024) (*en banc*)

Obviousness – Sec. 103

- 35 U.S.C. § 171 – Patents for designs
 - (a) In General.—Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.
 - (b) Applicability of This Title.—The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.
 - **Obviousness under Sec. 103 also applies to design patents**

Design Patent Obviousness Timeline

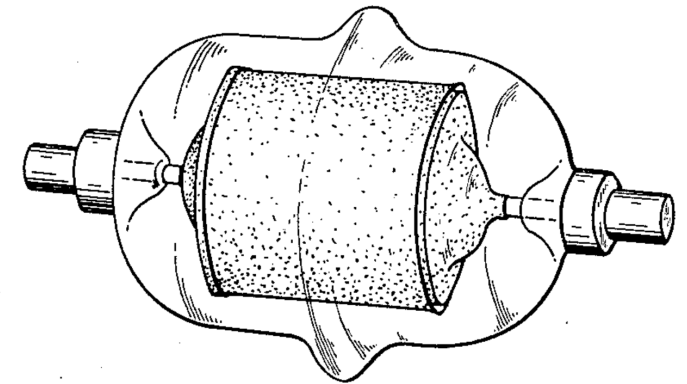


Timeline courtesy of Christopher V. Carani

In re Jennings, 182 F.2d 207, 208 (C.C.P.A. 1950)

- “In considering patentability of a proposed design the appearance of the design must be viewed as a whole . . . 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 . . .”

Fig. 1



D159,342
Vacuum Condenser

In re Nalbandian, 661 F.2d 1214 (C.C.P.A. 1981)

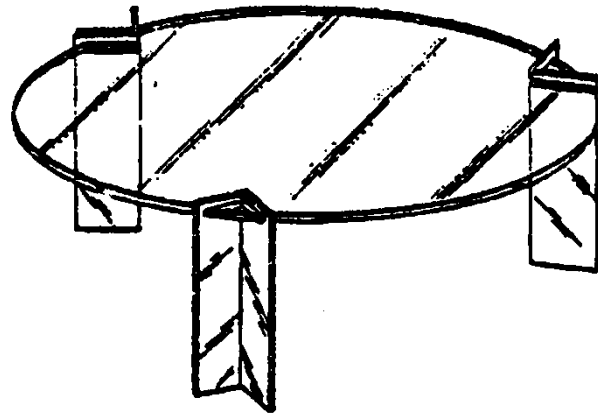
- Judge Rich, concurring opinion:
 - The real problem is with the necessity of finding unobviousness in a design.
 - The problem long antedates 1952 and its Patent Act and existed from the beginning.
 - When work on revision of the patent statutes began in 1950, a deliberate decision was made not to attempt any solution of the “controversial design problem” but simply to retain the substance of the existing design patent statute and attack the design problem at a later date, after the new Title 35 had been enacted.

In re Nalbandian, 661 F.2d 1214 (C.C.P.A. 1981)

- Judge Rich, concurring opinion:
 - “Thus it was that the patentability of designs came to be subject to the new Sed. 103 which was written with an eye to the kinds of inventions encompassed by Sec. 101 with no thought at all of how it might affect designs.”
 - “Therefore, the design protection problem was in no way made better; perhaps it was made worse.”
 - The “impossible issue of obviousness in design patentability cases”

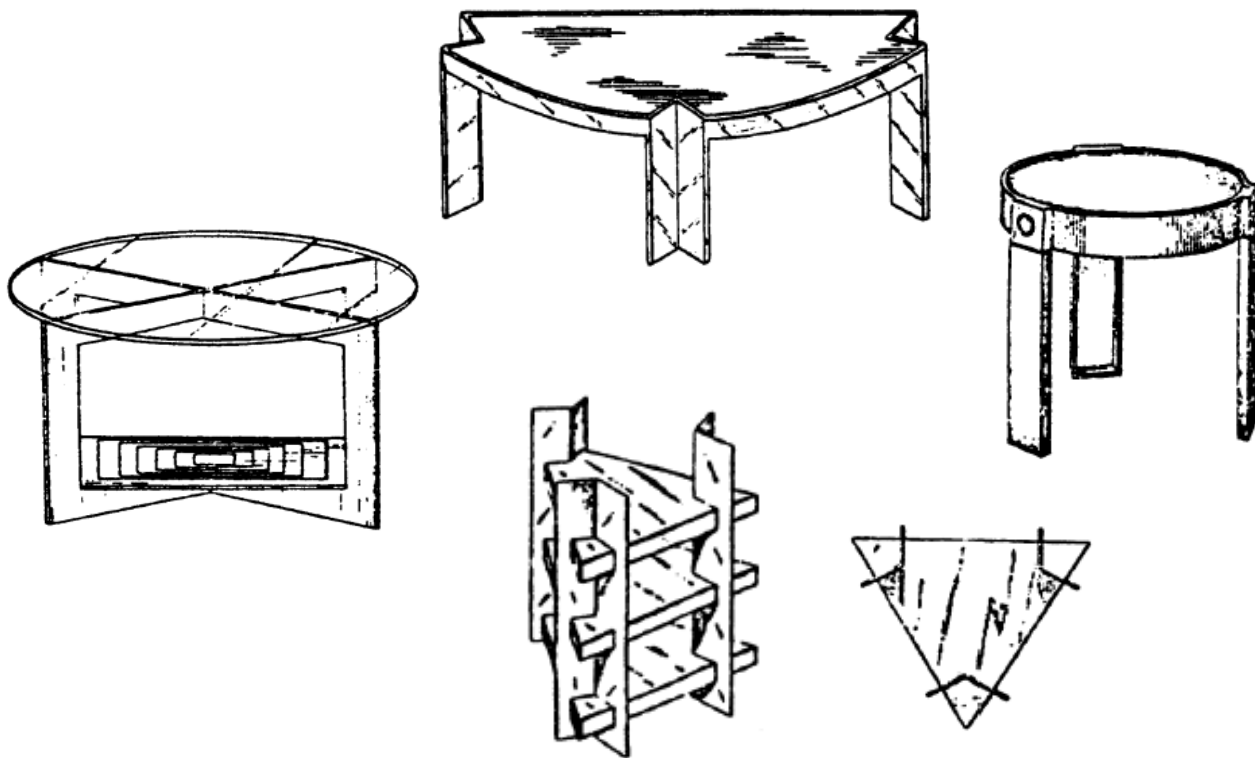
In re Rosen, 673 F.2d 388 (C.C.P.A. 1982)

- “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.”

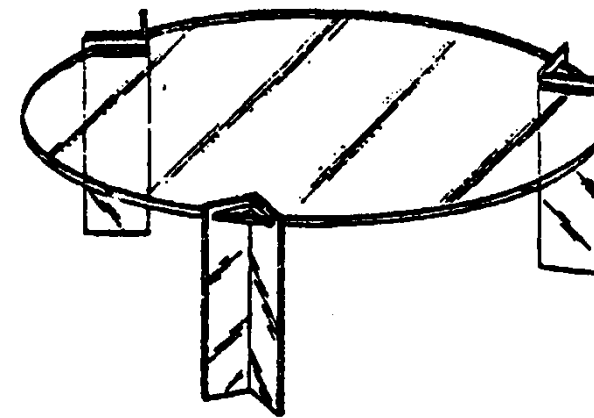


In re Rosen, 673 F.2d 388 (C.C.P.A. 1982)

Prior art references



Claimed design

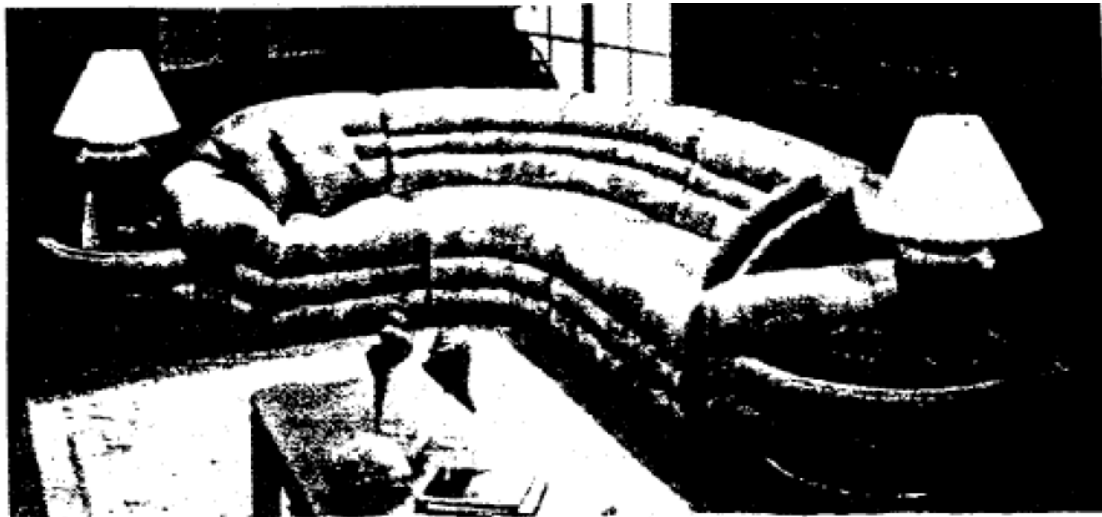


Is there a primary reference that is “basically the same”?

ANSWER: NO

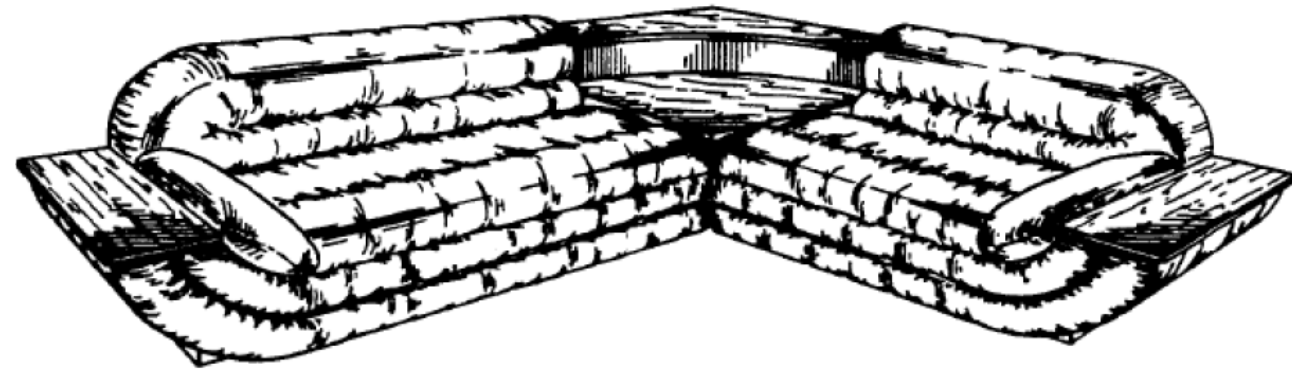
Durling v. Spectrum Furniture 101 F.3d (Fed. Cir. 1996)

Prior art reference (primary)



Secondary references must be “so related” to primary reference

Claimed design



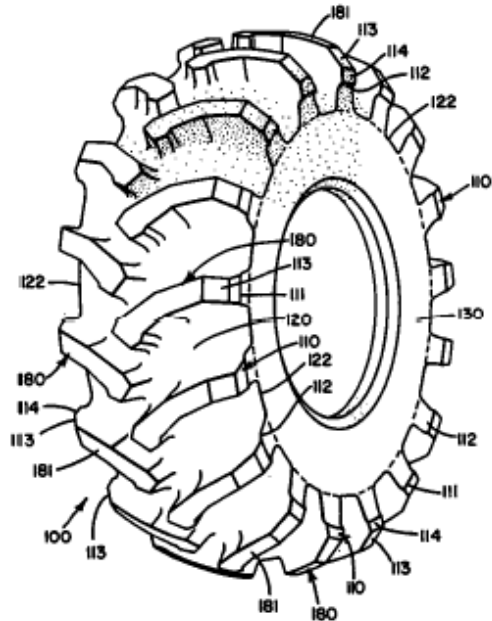
Is there a primary reference that is “basically the same”?

ANSWER: NO

Titan Tire v. Case New Holland

566 F.3d 1372 (Fed. Cir. 2009)

Prior art references



Claimed design



Is there a primary reference that is “basically the same”?

ANSWER: YES

MRC Innovations, Inc. v. Hunter Mfg., 747 F.3d 1326, 1329 (Fed. Cir. 2014)

Prior art reference (primary)

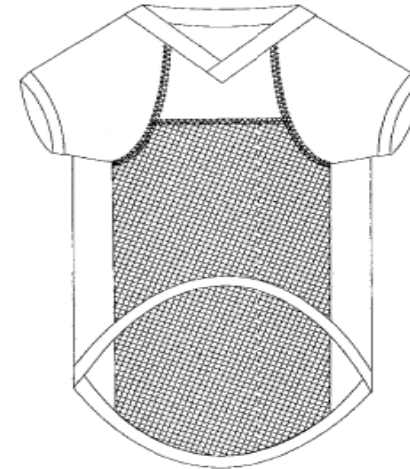


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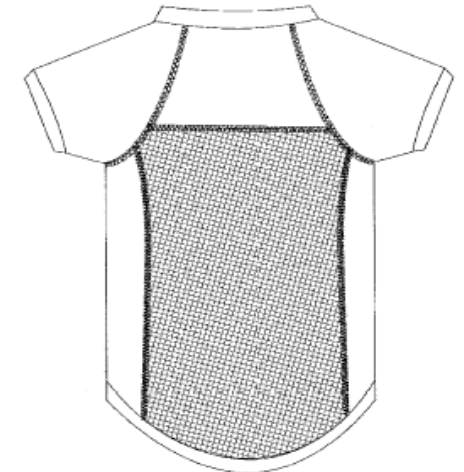


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Claimed design



front



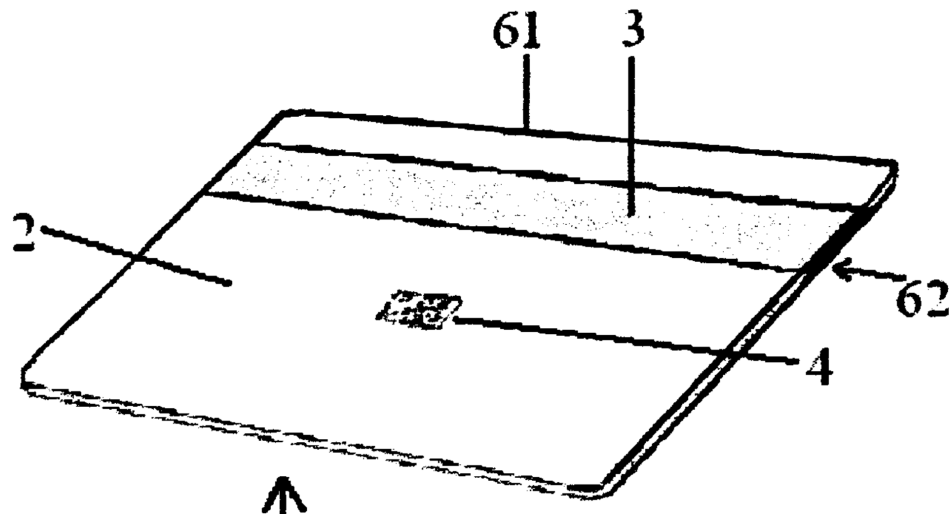
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Is there a primary reference that is “basically the same”?

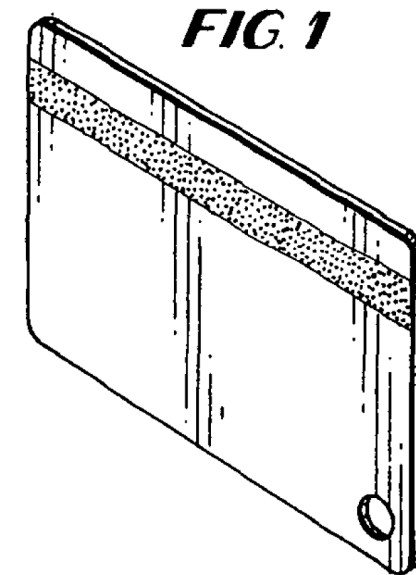
ANSWER: YES

Vanguard Identification Sys., Inc. v. Kappos, 407 F. App'x 479, 480 (Fed. Cir. 2011) (Fed. Cir. R. 36)

Prior art reference (primary)



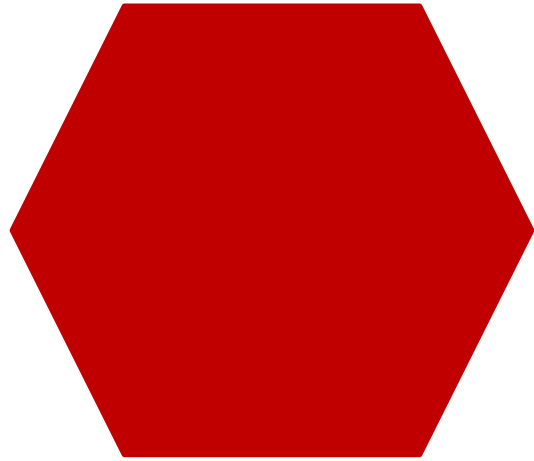
Claimed design



Is there a primary reference that is “basically the same”?

ANSWER: NO

What the Court Held - Rosen/Durling Overruled



In re Rosen, 673 F.2d 388 (C.C.P.A. 1982)

Durling v. Spectrum Furn. Co., 101 F.3d 100
(Fed. Cir. 1996)

“Improperly
Rigid”

“More Flexible
Approach”

The Court's Rationale

35 U.S.C. Section 171

The statutory provisions relating to utility patents shall apply to design patents, except as otherwise provided.



35 U.S.C. Section 103

Does not differentiate between utility and design patents.



Supreme Court Precedent

Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966)

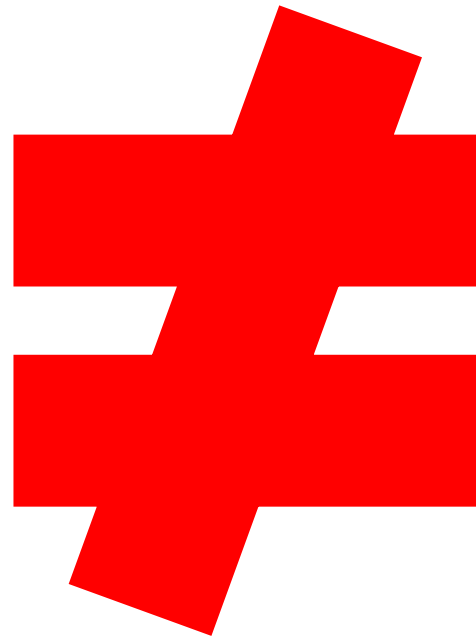
KSR International Co. v. Teleflex Inc., 550 U.S. 398 (2007)

Smith v. Whitman Saddle Co., 148 U.S. 674 (1893)

The Court's Rationale

Rosen's "Basically the Same" requirement

Durling's "So Related" requirement



Statutory rubric along with Supreme Court precedent

New Framework for Obviousness

Graham v. John Deere

- The ultimate question of obviousness is one of law based on several basic factual inquiries including:
 1. The scope and content of the prior art
 2. The differences between the prior art and the claims at issue;
 3. The level of ordinary skill in the pertinent art; and
 4. Secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc.
- The ultimate question is whether the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious to a person of ordinary skill in the pertinent art at the time of the invention.

New Framework for Obviousness

- Primary reference
 - Need not be “basically the same”
 - Rather, the primary reference need only be “something in existence”
 - In the same field or analogous art
- Secondary reference(s)
 - Need not be “so related”
 - In the same field or analogous art

New Framework for Obviousness

- Identify the differences between the prior art and the claim
- Ascertain the level of ordinary skill in the field
- Determine whether it would have been obvious to modify the prior art to create the same overall visual appearance
 - “Must be some record-supporting reason (without hindsight)”
- Reevaluate with any applicable secondary considerations

New Framework for Obviousness

- Record Supporting Reason
 - Without hindsight
 - Problem to be solved less relevant in the design patent context
 - The more different the primary and secondary references are from each other, the more work a challenger will likely need to do to establish a motivation to alter the primary reference in view of the secondary reference to demonstrate obviousness

Looking Ahead

- OLD TEST

- Arguments were mostly focused on:

- Is the primary reference a valid Rosen reference, i.e., “basically the same?”
 - Is the secondary reference “so closely related?”
 - Would the modification arrive at the claimed design?

- Whether the ordinary designer would have made the combination was not commonly argued.

- NEW TEST

- Arguments will more likely focus on:

- Whether there are record supported reasons why an ordinary designer would have made the combination.
 - Would the modification arrive at the claimed design?



LKQ Corp. v. GM Global Technology

USPTO Response

Record-based determination

Appeal No. 2018-005678 (decided 12/31/2019)

Hanked Cable

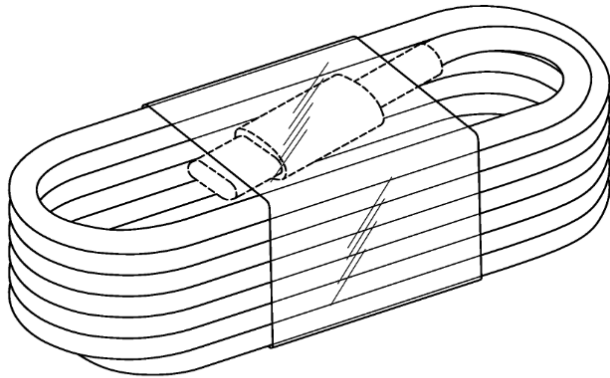


FIG. 1

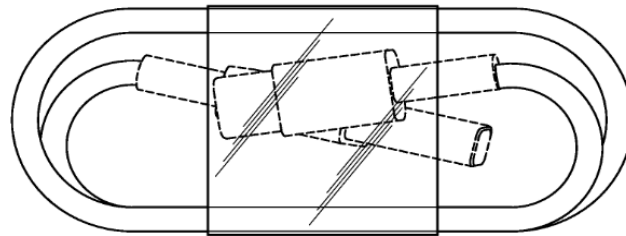


FIG. 2

“winding cable in a single layer in a pill shape ... shape maintained once the band is applied”

Record-based determination

Lilley, Jr. –U.S. 5,129,514, issued 7/14/1992

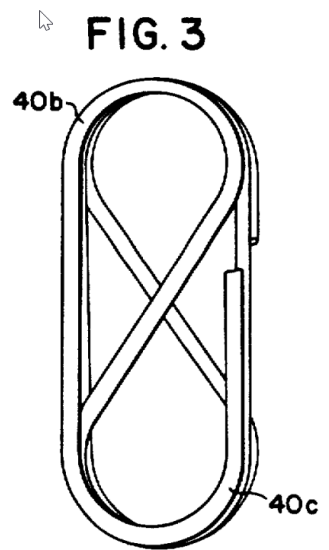


FIG. 3 is a schematic view of a partial cord package of this invention which illustrates a continuation of the pattern shown in FIG. 2C with an additional oval turn;

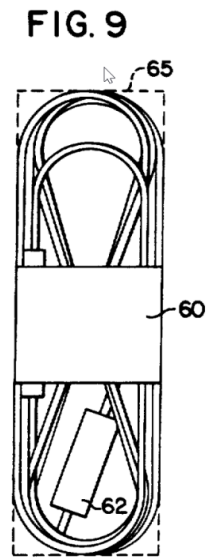


FIG. 9 is a top plan view of a schematic cord arrangement of the present invention;

Record-based determination

- Lilley cited as *Rosen* reference – PTAB reversed
- Proper principal reference under LKQ?
 - Flexible cord winding and packaging configuration
 - Particularly useful for products...such as in blasting initiation systems
- Record-based reason to modify, per LKQ? (remove Figure 8 crossovers, stack oval windings)
 - Teaching away – *In re Haruna* – POSITA is led in divergent direction
 - Destroying function – specific (OK?) vs. broad (not OK) - MPEP 1504.03(II)

Industrial Design

Overall Skills:

- While aesthetics is one thing industrial designers bring to the design of a new product, it is only one part of the overall User Experience, that is our purview.
- Making a product easy to understand and use, can often have a greater effect on user preference.

Industrial Design

Competitive Research:

- Industrial designers normally do competitive research to make sure the appearance they are creating is not the same as others. However, it may not be thorough enough or include products from foreign (only) markets.
- The big problem is that early designs are typically not compared to the prior art of patents, for appearances that are not on the market, but exist.

Industrial Design

Motivation:

- Generally, the motivations for the overall visual appearance of a products would include:
 - To create a new and different appearance of a product to differentiate it from the competition.
 - To include brand language when the product is part of an overall brand portfolio.
- We aren't taught to “design around”.

KSR Rationale

KSR rationales that may support a conclusion of obviousness:

- “a technique [that] has been used to improve one device,” where “a person of ordinary skill in the art would recognize that it would improve similar devices in the same way” and that application is not beyond the ordinary skilled artisan’s skill.
 - This sounds too functionally based. Can you really prove an aesthetic change would “improve a device”?

KSR Rationale

KSR rationales that may support a conclusion of obviousness:

- circumstances in which “there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions” and “the known options [are] within [an ordinary skilled artisan’s] technical grasp” and pursuing those options “leads to the anticipated success,”
 - This sounds too functionally based. Are aesthetics a “finite number of known options”? Does aesthetics alone “solve the problem”?



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Thank you!

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