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MEMORANDUM

DATE: May 22, 2024

TO: TC 2900; Patent Trial and Appeal Board

FROM: Katherine K. Vidal *Kathi Vidal*
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

SUBJECT: **Updated Guidance and Examination Instructions for Making a Determination of Obviousness in Designs in Light of *LKQ Corp. v. GM Global Technology Operations LLC***

The purpose of this memorandum is to provide updated guidance and examination instructions, effective immediately, on evaluating obviousness in design patent applications and design patents resulting from applications in light of yesterday's *en banc* decision in *LKQ Corp. v. GM Global Technology Operations LLC*, No. 2021-2348 (Fed. Cir. May 21, 2024) (*LKQ*).^[i]

I. Introduction

The Federal Circuit concluded “that the *Rosen-Durling* test requirements—that (1) the primary reference be ‘basically the same’ as the challenged design claim; and (2) any secondary references be ‘so related’ to the primary reference that features in one would suggest application of those features to the other—are improperly rigid.” In place of *Rosen-Durling*, the Court provides a more flexible approach that amounts to a restatement of *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) for design patent claims while recalibrating the helpful aspects of *Rosen*, namely starting with a “primary reference” that is “something in existence” and “visually similar” to the claimed design to protect against hindsight.^[ii]

What has changed: To fully resolve the question of obviousness after *LKQ*, United States Patent and Trademark Office (USPTO) personnel must apply a flexible approach to obviousness similar to that applied in utility applications.^[iii] See Manual of Patent Examining Procedure (MPEP) 2141 et seq. for the guidelines to follow in utility applications. In this approach, the following factual inquiries must be made: (1) the scope and content of the prior art, (2) differences between the prior art and the design as claimed at issue, and (3) the level of ordinary skill in the art. In addition to these factors, “[s]uch secondary considerations as commercial success . . . might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to

be patented” and may be relevant as “indicia of obviousness or nonobviousness, when evidence of such considerations is presented.”^[iv]

II. Examination Instructions

Factual Inquiry One:

In determining the scope and content of the prior art during Factual Inquiry One, a primary reference must be identified. The primary reference is analyzed in terms of its visual similarity to the claimed design, but this primary reference need not be “basically the same” as the claimed design. Rather, the primary reference need only 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.” The “more visually similar the primary reference is to the claimed design, the better positioned” a design examiner will be to set forth a *prima facie* case of obviousness.^[v]

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. It is often the case that the primary reference alone does not render the claimed design obvious, and design elements from secondary prior art references may be considered. As with the primary reference, a design examiner must also determine whether a secondary prior art reference is from the same field of endeavor or is analogous.^[vi]

As the Federal Circuit did not define how to determine whether a prior art design outside the field of endeavor of the article of manufacture is analogous, the design examiner should consider the degree to which an ordinarily skilled designer would be motivated to consider other fields. If the examiner questions whether a design is analogous art, the examiner should confer with their supervisory patent examiner (SPE). The USPTO will compile examples of when it has determined a reference to be analogous art, and those examples will reduce the need to discuss the determination with an examiner’s SPE over time. If a design is not analogous art, it may not be considered by the examiner in assessing obviousness.^[vii]

Factual Inquiry Two:

After considering the scope and content of the prior art, the differences between the prior art designs and the design claim at issue must be determined. This approach does not use a threshold “similarity” requirement. Instead, when determining differences between the prior art and the design at issue, the design examiner must compare the visual appearance of the claimed design with prior art designs from the perspective of an ordinary designer in the field of the article of manufacture.^[viii]

Factual Inquiry Three:

In determining the level of ordinary skill in the art, the design examiner should consider the knowledge of a designer of ordinary skill who designs articles of the type being examined.^[ix]

Factual Inquiry Four:

In addition, whenever present, design examiners should continue to consider secondary considerations as indicia of obviousness or nonobviousness.^[x] See MPEP 1504.03, subsections I.D and III.

Evaluating Obviousness:

After ascertaining the scope and content of the prior art, the knowledge of an ordinary designer in the relevant field, and the differences between the prior art and the claimed design, the design examiner must evaluate the obviousness or nonobviousness of the claimed design. If 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, then the examiner should reject the claim under 35 U.S.C. 103 barring convincing secondary indicia of nonobviousness being of record. This inquiry must focus on the visual impression of the claimed design as a whole and not on selected individual pieces.^[xi]

The primary and secondary references need not be “so related” that features in one would suggest application of those features in the other, but they must both be analogous art to the patented design. Also, the motivation to combine these references need not come from the references themselves. But there must be some record-supported reason (without impermissible 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. Design examiners should keep in mind that, generally, the more different the overall appearances of the primary reference versus the secondary reference(s), the more difficult it will be to establish a motivation to alter the primary prior art design in light of the secondary one and set forth a *prima facie* case of obviousness.^[xii]

Examiners should use Form Paragraph 15.19.aia in making a rejection under 35 U.S.C. § 103 based on two or more references in an application subject to 35 U.S.C. § 103, as revised by the America Invents Act. Existing form paragraphs will be updated as needed to be consistent with *LKQ*. Training for design examiners on 35 U.S.C. § 103 and the principles set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) will be provided in the short term.

III. Patent Trial and Appeal Board Instructions

As for the Patent Trial and Appeal Board, any decisions addressing obviousness in the design patent context must follow the *LKQ* decision, in view of the guidance articulated above.

IV. Next Steps

The USPTO is continuing to study *LKQ* in the context of existing precedent; further guidance and training will be forthcoming.

[i] The citations to the slip opinion of the *LKQ* decision are provided at the end of each paragraph. The decision is available at https://cafc.uscourts.gov/opinions-orders/21-2348.OPINION.5-21-2024_2321050.pdf.

[ii] *LKQ*, slip op. at 15.

[iii] *Id.*, slip op. at 5.

[iv] *Id.*, slip op. at 11, 27 (citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)).

[v] *Id.*, slip op. at 23-24 (citing *In re Jennings*, 182 F.2d 207, 208 (CCPA 1950)). See also MPEP 1504.03, subsection II.

[vi] *Id.*, slip op. at 23-24, 26.

[vii] See *id.*, slip op. at 22-23.

[viii] *Id.*, slip op. at 24-25 (citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966); *Apple, Inc. v. Samsung Elects., Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012)).

[ix] *Id.*, slip op. at 25-26 (citing *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996)). See also MPEP 1504.03, subsection I.C.

[x] *Id.*, slip op. at 27-28 (citations omitted).

[xi] *Id.*, slip op. at 26-27 (citing *Campbell Soup, Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021); *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996)).

[xii] *Id.*, slip op. at 26-27 (citations omitted).