

No. 2022-1253

---

---

In the  
United States Court of Appeals  
for the Federal Circuit

---

LKQ CORP. & KEYSTONE AUTOMOTIVE INDUSTRIES, INC.,  
*Appellants,*

v.

GM GLOBAL TECHNOLOGY OPERATIONS LLC,  
*Appellee.*

---

*Appeal from the United States Patent and Trademark Office  
Patent Trial and Appeal Board in PGR2020-00055  
(JJ. Ken B. Barrett, Scott A. Daniels, and Robert L. Kinder)*

---

---

**APPELLANTS' REQUEST FOR REHEARING EN BANC**

---

---

Barry F. Irwin  
Iftekhhar A. Zaim  
Andrew C. Himebaugh  
**IRWIN IP LLP**  
150 N. Wacker Drive, Suite 700  
Chicago, IL 60606  
Tel: (312) 667-6080  
birwin@irwinip.com  
izaim@irwinip.com  
ahimebaugh@irwinip.com

Mark A. Lemley  
Mark P. McKenna  
**Lex Lumina, PLLC**  
745 Fifth Avenue, Suite 500  
New York, NY 10151  
Tel: (646) 898-2055  
mlemley@lex-lumina.com  
mark@lex-lumina.com

*Counsel for Appellants  
LKQ Corp. and Keystone Automotive Industries, Inc.*

---

---

**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF INTEREST**

**Case Number** 2022-1253

**Short Case Caption** LKQ Corporation, et al. v. GM Global Technology Operations LLC

**Filing Party/Entity** LKQ Corporation

**Instructions:** Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 03/23/2023

Signature: /s/ Barry F. Irwin

Name: Barry F. Irwin

| <p><b>1. Represented Entities.</b><br/>Fed. Cir. R. 47.4(a)(1).</p>                            | <p><b>2. Real Party in Interest.</b><br/>Fed. Cir. R. 47.4(a)(2).</p>   | <p><b>3. Parent Corporations and Stockholders.</b><br/>Fed. Cir. R. 47.4(a)(3).</p>   |
|--|---|---|
| <p>Provide the full names of all entities represented by undersigned counsel in this case.</p> | <p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p> | <p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input type="checkbox"/> None/Not Applicable</p> |
| <p>LKQ Corporation</p>   |   | <p>None</p>   |
| <p>Keystone Automotive Industries, Inc,</p>  |   | <p>LKQ Corporation</p>  |
|  |   |   |
|  |   |   |
|  |   |   |
|  |   |   |
|  |   |   |
|  |   |   |
|  |   |   |
|  |   |   |
|  |   |   |
|  |   |   |

Additional pages attached

**4. Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable  Additional pages attached

|              |                   |  |
|--------------|-------------------|--|
| Reid Huefner | Margaret Herrmann |  |
|              |                   |  |
|              |                   |  |

**5. Related Cases.** Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

None/Not Applicable  Additional pages attached

|  |  |  |
|--|--|--|
| LKQ Corp., et al. v. GM Global Technology Operations LLC, Fed. Cir. Case No. 2021-2348 |  |  |
|  |  |  |
|  |  |  |

**6. Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable  Additional pages attached

|  |  |  |
|--|--|--|
|  |  |  |
|  |  |  |

**TABLE OF CONTENTS**

STATEMENT OF RELATED CASES..... 1

RULE 35(B) STATEMENT ..... 2

REASONS FOR GRANTING THE PETITION ..... 3

SUMMARY OF THE APPEALED FINAL WRITTEN DECISION ..... 4

SUMMARY OF THE PANEL DECISION ..... 5

ARGUMENT..... 7

    I.    *Rosen* And *Durling* are Incompatible with 35 U.S.C. § 103 as  
    Interpreted in *KSR*..... 7

        A.    Design Patents are Subject to 35 U.S.C. § 103..... 8

        B.    *KSR* Barred Rigid Restrictions on the Obviousness  
        Analysis..... 8

        C.    *Rosen* and *Durling* Require a Rigid, Restrictive Approach  
        to Obviousness..... 9

            1.    *The Rosen Requirement that a Challenger Identify  
            “a Single Reference that Creates ‘Basically the  
            Same’ Visual Impression” as the Claimed Design,  
            as a Prerequisite to the Obviousness Analysis, is  
            Inconsistent with § 103 and KSR*..... 10

            2.    *Durling’s Requirement that the Primary Reference  
            May Only be Modified If Specific, Restrictive  
            Conditions are Met is Inconsistent with § 103 and  
            KSR*..... 12

            3.    *Supreme Court Precedent Supports Greater  
            Latitude for Combining References*..... 13

        D.    *Rosen* and *Durling* Improperly Constrict the Obviousness  
        Inquiry by Foreclosing Analysis of What a Designer  
        Would, in Fact, Have Found Obvious ..... 14

|     |  |    |
|-----|--|----|
| E.  | This Court Should Grant En Banc Review to Overrule <i>Rosen</i> and <i>Durling</i> and Replace Them with a Test Consistent with <i>KSR</i> , <i>Graham</i> , and <i>Whitman Saddle</i> ..... | 16 |
| II. | LKQ’s Challenge of <i>Rosen</i> and <i>Durling</i> is Properly Presented and Warrants Resolution. ....   | 17 |
|     | CONCLUSION .....   | 18 |

## TABLE OF AUTHORITIES

### Cases

|   |               |
|---|---------------|
| <i>Alice Corp. Pty. Ltd. v. CLS Bank Int’l</i> ,<br>573 U.S. 208 (2014).....                    | 24            |
| <i>Bilski v. Kappos</i> ,<br>561 U.S. 593 (2010).....   | 25            |
| <i>Cancer Rsch. Tech., Ltd. v. Barr Lab’ys., Inc.</i> ,<br>637 F.3d 1293 (Fed. Cir. 2011) ..... | 25            |
| <i>Durling v. Spectrum Furniture Co., Inc.</i> ,<br>101 F.3d 100 (Fed Cir. 1996).....           | <i>passim</i> |
| <i>eBay Inc. v. MercExchange, L.L.C.</i> ,<br>547 U.S. 388 (2006).....                          | 25            |
| <i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.</i> ,<br>535 U.S. 722 (2002).....  | 25            |
| <i>Forshey v. Principi</i> ,<br>284 F.3d 1335 (Fed. Cir. 2002) .....                            | 9, 10, 25     |
| <i>Graham v. John Deere Co. of Kansas City</i> ,<br>383 U.S. 1 (1966).....                      | 4, 9          |
| <i>Hadco Prods., Inc. v. Walter Kidde &amp; Co.</i> ,<br>462 F.2d 1265 (3d Cir. 1972).....      | 22            |
| <i>Halo Elecs., Inc. v. Pulse Elecs., Inc.</i> ,<br>579 U.S. 93 (2016).....                     | 24, 25        |
| <i>Hotchkiss v. Greenwood</i> ,<br>52 U.S. 248 (1850).....                                      | 15            |
| <i>Icon Health and Fitness, Inc. v. Strava, Inc.</i> ,<br>849 F.3d 1034 (Fed. Cir. 2017) .....  | 24            |
| <i>In re Laverne</i> ,<br>356 F.2d 1003 (CCPA 1966).....  | 22            |

|   |               |
|---|---------------|
| <i>In re Nalbandian</i> ,<br>661 F.2d 1214 (CCPA 1981).....                                 | 13, 22        |
| <i>In re Rosen</i> ,<br>673 F.2d 388 (CCPA 1982).....                                       | 2, 6, 16, 17  |
| <i>KSR Int’l Co. v. Teleflex, Inc.</i> ,<br>550 U.S. 398 (2007).....                        | <i>passim</i> |
| <i>Nautilus, Inc. v. Biosig Instruments, Inc.</i> ,<br>572 U.S. 898 (2014).....             | 24            |
| <i>Octane Fitness, LLC v. ICON Health and Fitness, Inc.</i> ,<br>572 U.S. 545 (2014).....   | 25            |
| <i>Perfect Web Techs., Inc. v. InfoUSA, Inc.</i> ,<br>587 F.3d 1324 (Fed. Cir. 2009) .....  | 18            |
| <i>Smith v. Whitman Saddle Co.</i> ,<br>148 U.S. 674 (1893).....                            | 4, 5, 20, 21  |
| <i>Titan Tire Corp. v. Case New Holland, Inc.</i> ,<br>566 F.3d 1372 (Fed. Cir. 2009) ..... | 23            |
| <b>Statutes</b>   |               |
| 35 U.S.C. § 103 .....   | <i>passim</i> |
| 35 U.S.C. § 171 .....   | 2             |
| 35 U.S.C. § 171(b).....   | 2, 3, 8, 15   |



### **STATEMENT OF RELATED CASES**

No appeal has been previously taken from the Patent Trial and Appeal Board's decision in PGR2020-00055. Appellants identify as a related case the co-pending appeal in Case No. 2021-2348 (Fed. Cir.), which was related before the panel, decided on the same day, and is the subject of a petition for rehearing en banc filed on the same day.

### **RULE 35(B) STATEMENT**

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. Whether the rigid approach to evaluating the obviousness of designs under *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982) and *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100 (Fed Cir. 1996) is consistent with the Supreme Court’s interpretation of 35 U.S.C. § 103 in *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007); and
2. What standard, consistent with *KSR* and 35 U.S.C. §171, should replace the current requirement that a patent challenger identify a primary reference that is basically the same as the claimed design as a prerequisite to evaluating obviousness and the further limitation that allows modification of the primary reference only if there is a secondary reference that is “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.

Based on my professional judgment, I believe the panel decision is contrary to the statutory language of 35 U.S.C. §§ 103 and 171(b), and the following decisions of the Supreme Court of the United States: *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S.

398 (2007); *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966); and *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893).

### **REASONS FOR GRANTING THE PETITION**

In *KSR*, the Supreme Court rejected a rigid approach to obviousness that relies on bright-line rules or mandatory formulas. 550 U.S. at 419. It reiterated that 35 U.S.C. § 103 requires an assessment that focuses on the knowledge and motivations of a person having ordinary skill in the relevant art (“PHOSITA”). That interpretation of § 103 applies with equal force to design patents, which are generally subject to the same requirements as patents for inventions. 35 U.S.C. §171(b). Indeed, the Supreme Court has long applied a flexible test for design patent obviousness that permits combining two different references if doing so was obvious to a PHOSITA. *See Whitman Saddle*, 148 U.S. at 681.

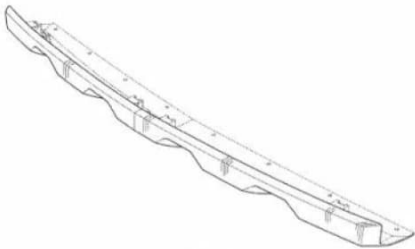



This Court and its predecessor have, for more than forty years, approached design patent obviousness with just the sort of rigid, mandatory formula that the Supreme Court rejected in *KSR*. Specifically, this Court requires, as a prerequisite to determining whether the claimed design is obvious in light of the prior art, identification of a single reference the design characteristics of which are “basically the same” as the claimed design. *Rosen*, 673 F.2d at 391. If and only if there is such a primary reference, then other references may be combined, but only if they are deemed “so related” to the claimed design that the appearance of certain ornamental

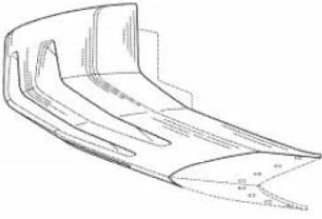
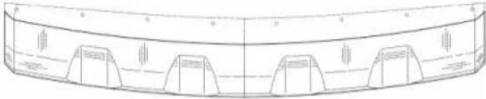

features in one would suggest the application of those features to the other. *Durling*, 101 F.3d at 103.

That framework has no statutory basis and is at odds with *KSR*, *Graham*, and *Whitman Saddle*. It is also inconsistent with the way designers create new designs. This Court should rehear this case en banc to recognize that *Rosen* and *Durling* are inconsistent with *KSR*, and to set forth a standard for design patent obviousness that is faithful to the law.

**SUMMARY OF THE APPEALED FINAL WRITTEN DECISION**

LKQ argued to the Board that the '508 Patent was invalid as obvious to a designer of ordinary skill in the art (“DOSA”) in view of the Changfeng Leopard CS10 (“Leopard”) alone or in combination with the 2012 Chevrolet Equinox (“Equinox”). Appx0207-0215; Appx0995-1025. *See also* Appx0991:

| <p><b>'508 PATENT<br/>CLAIMED DESIGN</b></p>  | <p><b>LEOPAARD (PRIOR ART)<br/>PRIMARY REFERENCE</b></p>                             |
|---|--|
|  <p>FIG. 1</p> |  |
|  <p>FIG. 2</p> |  |

| <p style="text-align: center;"><b>'508 PATENT<br/>CLAIMED DESIGN</b></p>   | <p style="text-align: center;"><b>LEOPAARD (PRIOR ART)<br/>PRIMARY REFERENCE</b></p>  |
|--|---|
| <div style="text-align: center;">  <p style="text-align: center;">FIG. 3</p>  <p style="text-align: center;">FIG. 4</p> </div> | <div style="text-align: center;">  </div> |

In its Final Written Decision (“FWD”), the Board stated that the *Rosen/Durling* test required that the Leopard be “basically the same as the claimed design” “[e]ven before any modifications may be considered.” Appx0058. The Board found that the same differences relied upon in its anticipation analysis “in the aggregate create an overall ornamental design that is not basically the same between the claimed design ... and the Leopard” and concluded that “the Leopard is not a proper *Rosen* reference.” *Id.* And the Board faulted LKQ’s grounds as based on “speculation and conjecture about certain features that might be present in the [Leopard] ... but are not shown in the exhibits.” Appx0060.

### SUMMARY OF THE PANEL DECISION

Before the Panel, GM argued that LKQ forfeited its argument that the *Rosen/Durling* obviousness framework did not survive *KSR*. But the panel majority found LKQ’s assertions in its Petition regarding *KSR*’s applicability “sufficient to

preserve the argument ... that *KSR* overrules our current test for design patent obviousness,” and that LKQ’s challenge “to *Rosen* and *Durling* is a pure question of law that undoubtedly presents a significant question of general impact, favoring the exercise of our discretion to hear and decide this issue.” PD at 11-12. The panel further noted that this Court “may decide to apply the correct law even if the parties did not argue it, so long as the issue is properly before the Court.” *Id.* at 12 (citing *Forshey v. Principi*, 284 F.3d 1335, 1356-57 (Fed. Cir. 2002) (en banc)).

Nevertheless, the Panel found that it, “as a panel, c[ould not] overrule *Rosen* or *Durling* without a clear directive from the Supreme Court.” PD at 12-13. Noting that “*KSR* did not involve or discuss design patents,” the Panel felt “bound to apply existing law to this appeal” because it felt “it [was] not clear the Supreme Court ha[d] overruled *Rosen* or *Durling*.” *Id.*

Applying *Rosen* and *Durling*, the Panel affirmed the Board’s non-obviousness determination. It found that substantial evidence supported the determination that “LKQ failed to show that the Leopard creates ‘basically the same’ visual impression as the claimed design.” PD at 14. Like the Board, the Panel considered only on what the photographs expressly showed (rather than what they would have taught a DOSA) and did not address LKQ’s arguments that the ’508 Patent’s execution of those occluded aspects of the skid bar were routine and obvious to a DOSA.

Judge Lourie, providing Additional Views, stated that design patents differ from utility patents and that *KSR* did not overrule *Rosen*. Dkt. 45, ECF 16-19 (J. Lourie, Additional Views). But Judge Lourie also noted that “*Rosen* may have overstated its point in adding to the quoted *Jennings* language such as that the primary reference must have design characteristics that are ‘basically the same.’” *Id.* at 19.<sup>1</sup> Judge Stark, in his concurrence in co-pending Case No. 21-2348, noted that all three parts of the *Rosen/Durling* test for design patent obviousness potentially run contrary to the Supreme Court’s *KSR* holding. *See LKQ Corp., et al. v. GM Global Techs Ops, LLC*, No. 21-2348, Dkt. 48, ECF 20 *et seq.* (“J. Stark Concurrence”). And, in oral argument in that case, Judge Clevenger noted that one could not envision a more rigid rule than “if you don’t have the *Rosen* reference, we don’t look at the prior art.” *Id.* at Dkt. 42, Hearing Recording at 15:40-15:50.

## ARGUMENT

### I. ***ROSEN AND DURLING ARE INCOMPATIBLE WITH 35 U.S.C. § 103 AS INTERPRETED IN KSR***

Like the TSM test this Court applied in hundreds of cases over many years, the *Rosen/Durling* framework for design patent obviousness is incompatible with 35 U.S.C. § 103 as the Supreme Court interpreted that section in *KSR*. *Rosen* and *Durling* rigidly restrict the obviousness inquiry, leading the analysis away from the

---

<sup>1</sup> Judge Clevenger, in oral argument, noted that *Rosen* misstated *Jennings* in imposing this requirement. No. 21-2348, Dkt. 42, Hearing Recording at 3:21-4:00.

statutorily mandated question: whether the claimed design would have been obvious to a DOSA. The framework also conflicts with the Supreme Court’s prior design patent precedent, which contemplated combining references that were not “basically the same” as the claimed design.

**A. Design Patents are Subject to 35 U.S.C. § 103**

The Patent Act denies protection for claimed inventions that would have been obvious to a PHOSITA. 35 U.S.C. § 103. That rule applies with equal force to designs. 35 U.S.C. § 171(b). No provision of the Patent Act exempts design patents from § 103, no statutory language modifies how § 103 applies to designs, and this Court’s predecessor acknowledged that designs are subject to § 103 and cases interpreting it. *See In re Nalbandian*, 661 F.2d 1214, 1217 (CCPA 1981) (“designs must be evaluated on the same basis as other patents, the test of *Graham* must be followed.”).

**B. *KSR* Barred Rigid Restrictions on the Obviousness Analysis**

“In *KSR* the Supreme Court rejected the ‘rigid, mandatory formula’ embodied in the Federal Circuit’s then-prevailing ‘teaching suggestion motivation’ requirement as improperly limiting the obviousness inquiry and, instead, prescribed a more flexible approach to obviousness and motivation to combine prior art teachings.” PD at 11, n. 2. The Supreme Court’s objection to the TSM test was not that it believed teaching, suggestion, or motivation are irrelevant to the obviousness



inquiry, but that this Court applied the TSM test as a rigid formula. *See KSR*, 550 U.S. at 418-19:

When it first established the requirement of demonstrating a teaching, suggestion, or motivation to combine known elements in order to show that the combination is obvious, the [C.C.P.A.] captured a helpful insight.

...

Helpful insights, however, need not become rigid and mandatory formulas; and when it is so applied, the TSM test is incompatible with our precedents.

*KSR* also acknowledged that the TSM requirement was properly motivated by concern about hindsight bias. *Id.* at 421. Nonetheless, *KSR* instructed that “[r]igid preventative rules that deny factfinders recourse to common sense ... are neither necessary under our case law nor consistent with it.” *Id.* *See also id.* at 419 (“When a court transforms the general principle into a rigid rule that limits the obviousness inquiry, ... it errs.”).

*KSR* endorsed the flexible multifactor approach prescribed in *Graham*, which, in turn, “reaffirmed the ‘functional approach’ of *Hotchkiss*[.]” *Id.* at 415 (citing *Hotchkiss v. Greenwood*, 52 U.S. 248 (1850)).

**C. *Rosen* and *Durling* Require a Rigid, Restrictive Approach to Obviousness**

*Durling* creates a rigid sequential test for evaluating obviousness of design patents. First, the adjudicator must:

(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates ‘basically the same’ visual impression.

*Durling*, 101 F.3d at 103 (quoting *Rosen*, 673 F.2d at 391). “[I]n comparing the patented design to a prior art reference, *the trial court judge* may determine *almost instinctively* whether the two designs create basically the same visual impression.”

*Id.* (emphasis added). Only if the adjudicator concludes that there is a single reference that is “basically the same” as the claimed design (a “*Rosen* reference”) can other references even be considered. Even then:

[t]hese secondary references may only be used to modify the primary reference if they are 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.

*Id.* (cleaned up).

**1. *The Rosen Requirement that a Challenger Identify “a Single Reference that Creates ‘Basically the Same’ Visual Impression” as the Claimed Design, as a Prerequisite to the Obviousness Analysis, is Inconsistent with § 103 and KSR***

If ever there was a rigid rule of obviousness, it is *Rosen*’s primary reference requirement. “[I]f a design patent challenger fails to identify a *Rosen* reference, the obviousness analysis stops.” J. Stark Concurrence, No. 2021-2348, Dkt. 48, ECF 30. No other information can even be considered unless this threshold primary reference requirement is satisfied. That rule denies courts “the opportunity to consider other

factors that often drive the analysis in utility patent obviousness cases.” *Id.* In particular, it “appears to prevent consideration of the ordinary designer’s creativity, at least in cases like the one before us now.” *Id.*

This Court has recognized that, “the obviousness analysis should ‘take account of the inferences and creative steps that a person of ordinary skill in the art would employ.’” *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1330 (Fed. Cir. 2009) (quoting *KSR*, 550 U.S. at 418). *KSR* further cautioned that obviousness was likely where “there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions[.]” *KSR*, 550 U.S. at 421. Yet, following *Rosen*’s rigid formula, the Board focused on whether the Leopaard ‘in existence’ was ‘basically the same’ as the claimed design; it never considered what inferences or creative steps a DOSA might draw from the Leopaard over the course of the design process or the routine and ordinary ways a DOSA would have executed the portions of the Leopaard skid bar that were occluded in the photos. *See, e.g.*, Appx1761-1769.

The Board’s conclusion demonstrates just how *Rosen* distracts from the statutorily-mandated question. The issue is not whether the claimed design is different from any individual piece of prior art (if it were not, it would be anticipated), but whether a DOSA would have found the claimed design obvious in light of the Leopaard’s teachings and disclosure. Further, as to the features the

photographs of the Leopaard allegedly did not disclose—purported differences the Board itself had failed to notice on institution—LKQ provided un rebutted evidence that a DOSA exercising ordinary creativity and common sense would have filled in the blank with the claimed feature because there were only a limited number of ways to execute those areas of the skid bar and the '508 Patent's execution of those features was routine and non-inventive. Appx1761-1762; Appx1767-1769. The Board dismissed these arguments as “speculation and conjecture” and driven by “hindsight.” Appx0060-0061. This is not consistent with the realities of the professional design process, which *KSR* puts at the center of the inquiry. It is undisputed that designers are trained and skilled professionals who combine and change existing designs. *See* Appx1749 (“The ordinary designer is still a skilled design professional, with the creativity that would be expected of such a professional and the capability to envision solutions to at least routine problems encountered in the field of automotive design.”). The Board merely looked at the photographs of the Leopaard; it never considered what a skilled and trained DOSA would understand from the Leopaard.

**2. Durling's Requirement that the Primary Reference May Only be Modified If Specific, Restrictive Conditions are Met is Inconsistent with § 103 and KSR**

Finally, *Durling* requirement that any such secondary reference be “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” is inconsistent with *KSR*. J. Stark Concurrence, No. 2021-2348, Dkt. 48, ECF 30-31. The Board’s application of *Rosen* and *Durling* to find the claimed design nonobvious *as a matter of law* in spite of a highly similar prior art design and unrebutted testimony that the features not expressly disclosed by the Leopard’s photographs would have been routine and obvious executions of those occluded features is irreconcilable with § 103 post-*KSR*.

**3. *Supreme Court Precedent Supports Greater Latitude for Combining References***

The *Rosen/Durling* framework contradicts the only Supreme Court design patent obviousness precedent. In *Whitman Saddle*, the claimed design essentially consisted of a combination of the front half of one saddle and the back of another. 148 U.S. at 680. Neither of those two saddles was “basically the same” as the claimed design. Still, the Supreme Court had no trouble combining the two references and stating the combination would be ineligible for protection:

Nothing more was done in this instance . . . than to put the two halves of these saddles together in the exercise of the ordinary skill of workmen of the trade, and in the way and manner ordinarily done.

*Id.* at 681. *Rosen* and *Durling* forbid the very approach the Supreme Court used.

**D. *Rosen and Durling* Improperly Constrict the Obviousness Inquiry by Foreclosing Analysis of What a Designer Would, in Fact, Have Found Obvious**

Rejecting the rigid formula of *Rosen* and *Durling* does not mean that every design will be obvious just because it is technically possible for designers to combine features from multiple pieces of prior art. Cf. Sarah Burstein, *In defense of Rosen references*, Patently-O (Dec. 6, 2022), <https://patentlyo.com/patent/2022/12/defense-rosen-references.html>. (suggesting that the primary reference requirement is necessary to avoid the “Frankenart” approach). Design patent obviousness is and will continue to be bounded by the practices of ordinary designers, just as obviousness in utility patent law is bounded by the practices of those with ordinary skill in the relevant art. There is no reason to believe that designers work from a single reference; there is also no reason to think that designers take into account only the technical ability to combine features.

Regardless, even Burstein recognizes that the test, as-applied, overly restricts the obviousness inquiry. *Id.* (“the Federal Circuit’s current § 103 ... cases apply the proper primary reference requirement too strictly.”). While the idea of starting with a primary reference may provide a helpful insight and be rationally motivated, “rigid preventative rules that deny factfinders recourse to common sense ... are neither necessary under our case law nor consistent with it.” *KSR* at 421.

Any analysis that reaches a conclusion on obviousness without considering what a DOSA would find obvious or even looking at the universe of prior art cannot stand. Yet, *Durling* inverts § 103's mandate and instructs the trial court to supplant the skill, knowledge, and creativity of the designer with a preliminary, "almost instinctive[]" determination of "basic similarity" by the decision-maker that ignores whether modifications would be routine and obvious. 101 F.3d at 103.

Nor can the *Rosen/Durling* regime be justified on the ground that designs are different or that "[o]rnam[en]t is in the eyes of the beholder." J. Lourie, Additional Views, Dkt. 45, ECF 18. First, the Patent Act plainly applies the same § 103 to design patents. 35 U.S.C. § 171(b). Second, this Court already rejected *Laverne's* view that "design is nothing more than appearance" and "no special skill is required to determine what things look like." See *Nalbandian*, 661 F.2d at 1216 (quoting *In re Laverne*, 356 F.2d 1003, 1006 (CCPA 1966)) (citing cases); see also *Hadco Prods., Inc. v. Walter Kidde & Co.*, 462 F.2d 1265, 1269-70, 1272-74 (3d Cir. 1972) (vacating a district court decision whose "reasoning and conclusion on [obviousness] were actually based on subjective visual impressions," insisting that the analysis focus on common practices and design features in the field).

Finally, even if it were true that utility patent obviousness considerations like routine modifications, unexpected effects, and teaching away, are inapplicable to design patents, J. Lourie, Additional Views, Dkt. 45, ECF 18-19, that would not

mean that a rigid rule is any more appropriate for design patents than utility patents. *See Nalbandian*, 661 F.2d at 1217 (*Graham* allows for consideration of objective evidence bearing on obviousness) (citing cases). Regardless, the suggestion that those considerations are not relevant to design is incorrect. Record evidence from both parties shows certain design features are routine and achieve intended effects. *See, e.g.*, Appx0655.

**E. This Court Should Grant En Banc Review to Overrule *Rosen* and *Durling* and Replace Them with a Test Consistent with *KSR*, *Graham*, and *Whitman Saddle***

By improperly and rigidly restricting the design patent obviousness analysis, the *Rosen/Durling* framework unlawfully extends the patent monopoly in a way that frustrates the Constitutional purpose of the patent regime. *KSR*, 550 U.S. at 402.

In *Titan Tire*, this Court recognized that *KSR* likely applies to design patents, but did not need to resolve that issue. *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1384-85 (Fed. Cir. 2009). It should now.

It may be desirable for this Court to grant en banc review not only to overrule *Rosen* and *Durling* but also to consider how to apply that precedent in the design context. In resolving that latter question, it may be desirable to invite the parties and amici to brief how *KSR* translates to the world of design patents.



## II. LKQ'S CHALLENGE OF *ROSEN* AND *DURLING* IS PROPERLY PRESENTED AND WARRANTS RESOLUTION

GM argued that LKQ forfeited its argument that the *Rosen/Durling* test as applied in the FWD could not survive *KSR*. Resp. Br. at 39-40. However, as the Panel majority found, LKQ did argue that *KSR* governs design patent obviousness, and specifically “enunciate[d] concern that the applied obviousness test was ‘overly restrictive’ in light of *KSR*, which [was] the heart of [LKQ’s] argument on appeal.” PD at 12. And, in co-pending Case No. 2021-2348, regarding a very similar dispute and underlying language, Judge Stark acknowledged that LKQ’s arguments to the Board “impl[ied] that *KSR* *maybe* overruled unspecified aspects of our design patent obviousness doctrine.” J. Stark Concurrence, No. 2021-2348, Dkt. 48, ECF 24 n.1. Further, until the Board reversed its own Institution Decision and held that *Rosen* prevented it from even considering the prior art, LKQ had no reason to object to the Board’s handling of those issues. Presenting additional arguments based on *Rosen* cannot be grounds for forfeiture.

Indeed, LKQ raised its *KSR* challenge more clearly than the parties to *KSR* raised the problems with this Court’s former TSM test. *See* Reply Br. at 19. And in numerous cases where the Supreme Court significantly changed patent law, it did so *sua sponte* or when the appellants first challenged the law on appeal. *Id.* (citing *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014); *Alice Corp. Pty. Ltd.*

*v. CLS Bank Int'l*, 573 U.S. 208 (2014); *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 579 U.S. 93 (2016)).

Regardless, whether *KSR* applies to design patents was a “pure question of law that undoubtedly presents a significant question of general impact, favoring exercise of [the Court’s] discretion to hear and decide this issue.” PD at 12 (citing *Icon Health and Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1040 (Fed. Cir. 2017)). And, the Court “may decide to apply the correct law even if the parties did not argue it, so long as the issue is properly before the Court.” PD at 12 (citing *Forshey*, 284 F.3d at 1356-57). Indeed, it is not merely that the Court *may* choose to apply the correct law; it has an obligation to do so.

## CONCLUSION

Retiring the unduly restrictive *Rosen/Durling* test is due. It represents one of the last vestiges of formalistic, restrictive patent law tests that the Supreme Court has repeatedly rebuked. *See Cancer Rsch. Tech., Ltd. v. Barr Lab’ys., Inc.*, 637 F.3d 1293 (Mem.), 1296 (Fed. Cir. 2011) (en banc) (JJ. Prost, Gajarsa, Moore, and O’Malley, dissenting) (“the Supreme Court has repeatedly—and recently—cautioned against such excessive formalism in application of the patent laws,” and “[i]n each of th[o]se cases, flexibility was favored over rigidity.”) (citing *Bilski v. Kappos*, 561 U.S. 593 (2010); *KSR*, 550 U.S. at 419-22; and *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 393 (2006)). That list of stricken, unduly rigid

doctrines was not exhaustive in 2011, and has only grown. *See, e.g., Halo Elecs., Inc.*, 579 U.S. at 105-106; *Octane Fitness, LLC v. ICON Health and Fitness, Inc.*, 572 U.S. 545, 553 (2014); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 738 (2002). It is time for this Court to correct the unduly rigid and restrictive *Rosen/Durling* test as well.

Petitioner respectfully requests that this Court grant en banc review, vacate the Panel Decision, and align its standards for design patent obviousness with 35 U.S.C. § 103 as it is understood post-*KSR*.

Dated: March 23, 2023

Respectfully submitted,

By: /s/ Barry F. Irwin

Barry F. Irwin

Iftekhhar A. Zaim

Andrew C. Himebaugh

**IRWIN IP LLP**

150 N. Wacker Dr., Suite 700

Chicago, IL 60606

Tel: (312) 667-6080

birwin@irwinip.com

izaim@irwinip.com

ahimebaugh@irwinip.com

Mark A. Lemley

Mark P. McKenna

**Lex Lumina, PLLC**

745 Fifth Avenue, Suite 500

New York, NY 10151

Tel: (646) 898-2055

mlemley@lex-lumina.com

mark@lex-lumina.com

*Attorneys for Appellants*

*LKQ Corporation and*

*Keystone Automotive Industries, Inc.*

# **ADDENDUM**

NOTE: This disposition is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

---

**LKQ CORPORATION, KEYSTONE AUTOMOTIVE  
INDUSTRIES, INC.,**  
*Appellants*

v.

**GM GLOBAL TECHNOLOGY OPERATIONS LLC,**  
*Appellee*

---

2022-1253

---

Appeal from the United States Patent and Trademark  
Office, Patent Trial and Appeal Board in No. PGR2020-  
00055.

---

Decided: January 20, 2023

---

MARK A. LEMLEY, Lex Lumina PLLC, New York, NY,  
argued for appellants. Also represented by MARK P.  
MCKENNA; ANDREW HIMEBAUGH, BARRY IRWIN, IFTEKHAR  
ZAIM, Irwin IP LLC, Chicago, IL.

JOSEPH HERRIGES, JR., Fish & Richardson P.C., Minne-  
apolis, MN, argued for appellee. Also represented by JOHN  
A. DRAGSETH; NITIKA GUPTA FIORELLA, Wilmington, DE;  
LAURA E. POWELL, Washington, DC.

---

Before LOURIE, CLEVINGER, and STARK, *Circuit Judges*.

Opinion for the court filed PER CURIAM.

Additional views filed by *Circuit Judge* LOURIE.

Opinion concurring in part and concurring in judgment  
filed by *Circuit Judge* STARK.

PER CURIAM.

LKQ Corp. and Keystone Automotive Industries, Inc. (collectively, “LKQ”) appeal from a final written decision of the U.S. Patent and Trademark Office Patent Trial and Appeal Board (“the Board”) holding that LKQ failed to show by a preponderance of the evidence that U.S. Patent D855,508 (the “508 patent”) was anticipated or would have been obvious over the cited prior art before the effective filing date. *See LKQ Corp. v. GM Glob. Tech. Operations LLC*, PGR2020-00055, Paper 33 (P.T.A.B. Oct. 8, 2021) (“*Decision*”), J.A. 1–65. For the reasons provided below, we affirm.

#### BACKGROUND

GM Global Technology Operations LLC (“GM”) owns the ’508 patent, which is directed to an “ornamental design for the vehicle front skid bar” as shown below.

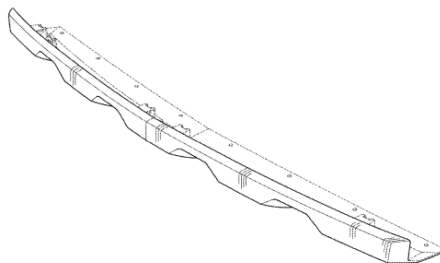


FIG. 1

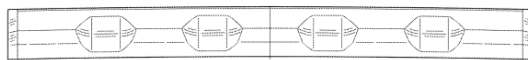


FIG. 2

LKQ CORPORATION v.  
GM GLOBAL TECHNOLOGY OPERATIONS LLC

3

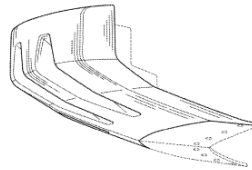


FIG. 3

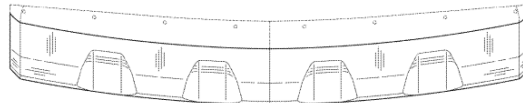


FIG. 4

GM manufactures and sells automotive vehicles. LKQ sells automotive body repair parts for most mainstream vehicle models available, including front skid bars for vehicles manufactured by GM. GM and LKQ had previously been parties to a license agreement, under which LKQ was granted a license to many of GM's design patents. The license agreement expired in February 2022 following a breakdown of renewal negotiations, after which GM sent letters to LKQ's business partners alleging that the now unlicensed LKQ parts infringe its patents.

LKQ petitioned for post-grant review of the '508 patent, asserting that it was anticipated by the design of the 2015 Changfeng Leopaard CS1020 ("Leopaard") and would have been obvious over the Leopaard alone or in combination with the design of the 2012 Chevrolet Equinox ("Equinox"). The Board issued a final written decision concluding that LKQ had not demonstrated by a preponderance of the evidence that the '508 patent was anticipated or would have been obvious before the effective filing date. *Decision*, J.A. 1–65.

First, the Board determined that the ordinary observer would include both retail consumers who purchase replacement skid bars and commercial replacement part buyers. *Decision*, J.A. 14–16. In so doing, the Board emphasized that the "'508 design claims a 'vehicle front skid bar,' not a vehicle in total." *Decision*, J.A. 15.



Second, applying that understanding of the ordinary observer, the Board concluded that, although there were some similarities, the references produced depicting the Leopaard design did not show certain aspects of the claimed design (*e.g.*, the bottom or the sides) and what was visible from the provided images created a different overall impression. *Decision*, J.A. 18, 42–61. Namely, the claimed features in the aggregate contributed to a “rugged, chiseled, three-dimensional overall appearance” that the Leopaard’s sloping design did not have. *Decision*, J.A. 57. The Board was ultimately not persuaded that an ordinary observer would be deceived into purchasing the Leopaard skid bar supposing it to be the claimed skid bar, finding no anticipation.

Third, applying the tests established in *Rosen* and *Durling*, the Board found that LKQ failed to identify a sufficient primary reference, and therefore failed to prove obviousness by a preponderance of the evidence. *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100 (Fed. Cir. 1996); *In re Rosen*, 673 F.2d 388 (C.C.P.A. 1982); *Decision*, J.A. 57–60. Because the Board found that the Leopaard did not qualify as a proper primary reference under *Rosen*, the Board did not turn to *Durling* step two and look beyond the Leopaard to the Equinox. *Decision*, J.A. 57–60. The Board further noted that even if the Leopaard could serve as a sufficient primary reference, LKQ only proposed modifying the Leopaard skid bar “to have the vertical side edges” of the Equinox. As explained by the Board, because many other differences existed between the claimed design of the ’508 patent and the Leopaard, LKQ could not meet its burden to demonstrate obviousness of the claimed design. *Decision*, J.A. 57–60.

In summary, the Board concluded that LKQ had not demonstrated that the claimed design of the ’508 patent was anticipated or would have been obvious before the effective filing date. LKQ appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(4)(A).

LKQ CORPORATION v.  
GM GLOBAL TECHNOLOGY OPERATIONS LLC

5

## DISCUSSION

LKQ raises two main challenges on appeal. First, LKQ contends that the Board erred in finding that the ordinary observer would include only retail consumers who purchase replacement skid bars and commercial replacement part buyers, and, ultimately, in finding no anticipation. Second, LKQ contends that the *Rosen* and *Durling* tests on which the Board relied in its obviousness analysis have been implicitly overruled by the Supreme Court’s decision in *KSR International Co. v. Telflex, Inc.*, 550 U.S. 398 (2007). We address each argument in turn.

We review the Board’s legal conclusions *de novo* and its factual findings for substantial evidence. *Campbell Soup Co. v. Gamon Plus, Inc.*, 939 F.3d 1335, 1339 (Fed. Cir. 2019). Anticipation is a question of fact reviewed for substantial evidence. *Id.*; *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1237 (Fed. Cir. 2009). The ultimate determination of obviousness is reviewed *de novo*, and any underlying factual findings are reviewed for substantial evidence. *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021). Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Consol. Edison Co. v. N.L.R.B.*, 305 U.S. 197, 229 (1938).

### I

We first consider LKQ’s challenge to the Board’s determination that LKQ failed to meet its burden to prove that the ’508 patent was anticipated by the Leopaard design. LKQ first argues that the Board erred in not finding that original retail vehicle purchasers are the correct ordinary observer. LKQ notes that replacement parts are merely a downstream consequence of prior whole vehicle sales, that skid bars are not sold in the first instance as replacement products, and that replacement products make up a small subset of total skid bar sales. LKQ further asserts that that alleged error led the Board to place undue emphasis

on allegedly trivial differences between the claimed design of the '508 patent and the Leopaard design that would not have mattered to the correct ordinary observer, and that the Board failed to properly compare the designs as a whole.

GM responds that the Board correctly defined the ordinary observer. GM emphasizes that the '508 patent is not directed to the design of a whole vehicle, but rather a design for a specific part of a vehicle. Therefore, GM argues that the ordinary observer must be the person who purchases that part or is otherwise sufficiently interested in that part, not necessarily the vehicle as a whole. GM further argues that, regardless of the ordinary observer, the Board's holding that the claimed design of the '508 patent is not anticipated by the Leopaard design was supported by substantial evidence.

We agree with GM that the Board's finding that the ordinary observer would include both retail consumers who purchase replacement skid bars and commercial replacement part buyers was supported by substantial evidence. Defining the ordinary observer is a fact-dependent inquiry. *See Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1323 (Fed. Cir. 2007) (abrogated on other grounds by *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008)). It is through the lens of the ordinary observer that the anticipation inquiry is viewed. *Gorham Co. v. White*, 81 U.S. 511, 528 (1871). The Board's finding that the ordinary observer here includes repair professionals and vehicle owners purchasing replacement parts, and does not include retail vehicle purchasers, is well-grounded in the record. LKQ itself recognized that repair shop mechanics and auto parts store employees who order replacement parts may be ordinary observers of skid bars. J.A. 195–96. And LKQ cannot disagree that there is a market for the claimed skid bar alone, given that its business is selling individual replacement parts. *See Appellant Br.* at 1. That GM sells whole vehicles to retail consumers, rather

LKQ CORPORATION v.  
GM GLOBAL TECHNOLOGY OPERATIONS LLC

7

than skid bars to car manufacturers, is of no consequence. As the Board noted, the ordinary observer test requires consideration of the features visible in the “normal use” lifetime of the accused product, *i.e.*, “from the completion of manufacture or assembly until the ultimate destruction, loss, or disappearance of the article.” *Decision*, J.A. 12 (quoting *Int’l Seaway*, 589 F.3d at 1241). *See also Contessa Food Prods. v. Conagra, Inc.*, 282 F.3d 1370, 1380 (Fed. Cir. 2002) (“[T]he ‘ordinary observer’ analysis is not limited to those features visible during only one phase or portion of the normal use lifetime of an accused product.”). The “normal use” would thus include repair or replacement.

Most notably, the claimed design of the ’508 patent is not the design of a whole vehicle, but rather a design of a specific part of a vehicle. J.A. 66–71. In *Arminak* and *Keystone*, we recognized that the ordinary observer can be the purchaser of a component part of a later-assembled product as opposed to the purchaser of the later-assembled product. *Arminak*, 501 F.3d at 1321–24; *KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1451 (Fed. Cir. 1993). The same is true here. In this case, substantial evidence supports the Board’s conclusion that the ordinary observer is a person who purchases that part or is otherwise sufficiently interested in that part, not the vehicle as a whole. *See Egyptian Goddess*, 543 F.3d at 665.

When determining whether a design patent is anticipated, we consider:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other . . . .

*Gorham*, 81 U.S. at 528.<sup>1</sup> Under this standard, substantial evidence supports the Board’s finding of no anticipation.

Most importantly, the references submitted by LKQ depicting the Leopaard design do not sufficiently show certain aspects of its design, *e.g.*, the bottom or the sides, to enable comparison with the claimed design of the ’508 patent. As the Board found:

LKQ has not produced images of the Leopaard that would enable a persuasive comparison with corresponding views of the claimed invention. The evidence produced by LKQ related to the Leopaard simply fails to clearly show several claimed aspects of the design. . . . The exhibits do not show a sufficient bottom view to allow comparison and the exhibits also have obscured side views due to other trim features covering the outsides of the skid board.

*Decision*, J.A. 18. LKQ’s expert admits that these perspectives are obscured or not shown in the references they provided. J.A. 832 at 2:5, 13–17. This impedes a comparison of the claimed design to the reference by *any* ordinary observer and is alone sufficient to support a finding of no anticipation. It would be speculation to assume that the unshown features have certain characteristics that match the claimed invention.

Additionally, given the evidence in the record, the Board concluded that the design claimed in the ’508 patent and the Leopaard design created different overall

---

<sup>1</sup> While the test articulated in *Gorham* was with regard to infringement, we have found “that the same tests must be applied to infringement and anticipation,” as to “prevent an inconsistency from developing between the infringement and anticipation analyses.” *Int’l Seaway*, 589 F.3d at 1240.

LKQ CORPORATION v.  
GM GLOBAL TECHNOLOGY OPERATIONS LLC

9

impressions. The Board pointed to several differences in the designs: (1) the front face, (2) the outwardly projecting top and side surfaces, (3) the size, shape, and positioning of the recesses, and (4) the curvature from side-to-side. *Decision*, J.A. 56–57. And LKQ’s claim that the Board failed to properly compare the designs as a whole is without merit. The Board clearly found the claimed design of the ’508 patent created a rugged, chiseled, durable, three-dimensional truck-like appearance, while the skid bar of the Leopaard had a softer, sloping appearance. *Decision*, J.A. 57. We agree and find the Board’s finding of no anticipation was supported by substantial evidence.

## II

LKQ next argues that the Supreme Court’s decision in *KSR* implicitly overruled the long-standing *Rosen* and *Durling* tests for obviousness of design patents, and therefore the Board’s decision applying such tests must at least be vacated and remanded. For design patent obviousness, *Durling* outlines a two-step analysis. First, it must be determined whether a primary reference, also known as a *Rosen* reference, exists with characteristics “basically the same” as the claimed design by discerning the visual impression of the design as a whole. *Durling*, 101 F.3d at 103; *Rosen*, 673 F.2d at 390–91. Second, if a satisfactory primary reference exists, the court must consider whether an ordinary designer would have modified the primary reference to create a design with the same overall visual appearance as the claimed design. *Id.* This test safeguards against a challenger picking and choosing features from multiple references to create something entirely new, fundamentally changing the overall visual impression of the original designs. *See In re Jennings*, 182 F.2d 207, 208 (C.C.P.A. 1950) (explaining that one must start with “something in existence -- not with something that might be brought into existence by selecting individual features from prior art and combining them”).

While *KSR* does not address *Rosen* or *Durling*, LKQ argues that its holding implicates the test established in these cases. GM argues that LKQ has forfeited this argument by not raising it before the Board, and even if it were not forfeited, *KSR* does not overrule *Rosen* or *Durling*.

## A

As a general proposition, a federal appellate court does not consider issues not raised before the lower tribunal. *Singleton v. Wulff*, 428 U.S. 106, 120 (1976). The exact phrasing of the argument need not have been used below “so long as it can be said that the tribunal was ‘fairly put on notice as to the substance of the issue.’” *Nike Inc. v. Adidas AG*, 812 F.3d 1326, 1342 (Fed. Cir. 2016) (citing *Consolidation Coal Co. v. United States*, 351 F.3d 1374, 1378 (Fed. Cir. 2003) (quoting *Nelson v. Adams*, 529 U.S. 460, 469 (2000) (“But [issue preservation] does not demand the incantation of particular words; rather, it requires that the lower court be fairly put on notice as to the substance of the issue.”))).

But even if an issue was not presented below, there is no absolute bar to considering and deciding the issue on appeal, as forfeiture is a matter of discretion. *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1251 (Fed. Cir. 2005) (“An appellate court retains case-by-case discretion over whether to apply waiver.”). In *Icon Health and Fitness, Inc. v. Strava, Inc.*, we set forth some relevant considerations to guide the exercise of such discretion. 849 F.3d 1034, 1040 (Fed. Cir. 2017) (citing *Automated Merch. Sys., Inc. v. Lee*, 783 F.3d 1376, 1379 (Fed. Cir. 2015)). These considerations include whether the issue involves a pure question of law and refusal to consider it would result in a miscarriage of justice, and whether the issue presents significant questions of general impact. *Id.*

In this case, appellants argue that *KSR*, 550 U.S. 398, overrules this court’s long-standing precedents, *Rosen*, 673 F.2d 388, and *Durling*, 101 F.2d 100, which outline the test

LKQ CORPORATION v.  
GM GLOBAL TECHNOLOGY OPERATIONS LLC

11

for determining design patent obviousness. In their petition to the Board, the appellants raised their *KSR* argument in the following manner:

As a final matter, the Federal Circuit has, to date, been silent regarding whether the Supreme Court’s opinion in *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), governs design patent obviousness, other than to say that it was “not obvious that the Supreme Court necessarily intended to exclude design patents from the reach of *KSR*.” *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1384–85 (Fed. Cir. 2009).<sup>2</sup> In a design patent obviousness analysis, to modify a primary reference, a secondary reference must be “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.” *Titan Tire*, 566 F.3d at 1381 (quoting *Durling*, 101 F.3d at 103). To the extent that the “so related” test operates to unduly limit the scope of design patent obviousness, such an overly restrictive view would run afoul of *KSR*’s proscription against rigid restrictions on the scope of an obviousness analysis.

J.A. 186–87.

We consider that this assertion in the petition is sufficient to preserve the argument that LKQ seeks to make, that *KSR* overrules our current test for design patent

---

<sup>2</sup> In *KSR*, the Supreme Court rejected the “rigid, mandatory formula” embodied in the Federal Circuit’s then-prevailing “teaching suggestion motivation” requirement as improperly limiting the obviousness inquiry and, instead, prescribed a more flexible approach to obviousness and motivation to combine prior art teachings. *KSR*, 550 U.S. at 420–22.



obviousness. While not extensive, LKQ's argument enunciates concern that the applied obviousness test was "overly restrictive" in light of *KSR*, which is the heart of its argument on appeal. To be sure, LKQ could have made its argument in depth. However, such arguments would have been to an unreceptive audience, as the Board already had heard and rejected the argument. *See, e.g., Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2015-1453, 2017 Pat. App. LEXIS 3419 at \*63-64 (P.T.A.B. Jan. 11, 2017) (concluding that there was no suggestion that *KSR* is "germane to an obviousness determination in design patents, or has any effect upon the relevance of the *Durling* analysis," and that, regardless, the "basically the same test" is consistent with *KSR*).

Further, this challenge to *Rosen* and *Durling* is a pure question of law that undoubtedly presents a significant question of general impact, favoring the exercise of our discretion to hear and decide this issue. *See Icon Health*, 849 F.3d at 1040. Moreover, we may decide to apply the correct law even if the parties did not argue it, so long as the issue is properly before the court. *Forshey v. Principi*, 284 F.3d 1335, 1356–57 (Fed. Cir. 2002) (en banc) (superseded by statute on other grounds, *Flores v. Nicholson*, 476 F.3d 1379, 1381 (Fed. Cir. 2006)). Given the aforementioned considerations and in our discretion, we decline to find LKQ's *KSR* argument forfeited.

## B

Appellant argues that the Supreme Court, in reviewing *Teleflex, Inc. v. KSR Int'l Co.*, 119 Fed. Appx. 282 (Fed. Cir. 2005), overruled *Rosen* and *Durling*. The Court stated, "[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation . . . ." *KSR*, 550 U.S. at 419. The Court did note that the teaching, suggestion, and motivation test "captured a helpful insight," but it found it overly "rigid." *Id.* at 418. However, *KSR* did not involve or discuss design

LKQ CORPORATION v.  
GM GLOBAL TECHNOLOGY OPERATIONS LLC

13

patents, which is the type of patent we have here before us and that was addressed by *Rosen* and *Durling*.

And we note that in the more than fifteen years since *KSR* was decided, this court has decided over fifty design patent appeals. In these appeals, this court has continually applied *Rosen* and *Durling* just as it had in the decades preceding. Notably, the correctness of our current law in light of *KSR* was raised in only two of those over fifty appeals, only tangentially, and not addressed in our decisions in those two cases. This challenge is therefore an outlier.

We, as a panel, cannot overrule *Rosen* or *Durling* without a clear directive from the Supreme Court. *Deckers Corp. v. United States*, 752 F.3d 949, 965 (Fed. Cir. 2016) (explaining panels are “bound by prior panel decisions until they are overruled by the court en banc or the Supreme Court”). *See also California Inst. Of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 990–91 (Fed. Cir. 2022) (explaining the panel only had authority to overrule circuit precedent without en banc action given the Supreme Court’s reasoning undermining said circuit precedent). As explained above, it is not clear the Supreme Court has overruled *Rosen* or *Durling*. The panel is therefore bound to apply existing law to this appeal.

### C

Finally, applying existing law, we affirm the Board’s non-obviousness determination, and conclude that its factual findings are supported by substantial evidence.

Our above discussion of the differences between the Leopaard design and the claimed design of the ’508 patent applies equally here. Although the tests for anticipation and obviousness of design patents are viewed through different lenses—the ordinary observer and ordinary designer, respectively—we, like the Board, acknowledge the relevance of the findings of one to the other. *See In re Nalbandian*, 661 F.2d 1214, 1217 (C.C.P.A. 1981) (discussing

the “ordinary observer” and “ordinary designer” tests); *Decision*, J.A. 57–59 (citing *LKQ Corp.*, PGR2020-00055, Ex. 2004, ¶ 86).

In sum, LKQ failed to show that the Leopaard creates “basically the same” visual impression as the claimed design. *Durling*, 101 F.3d at 103; *Rosen*, 673 F.2d at 390–91. The Board found several differences between the claimed design and Leopaard, including (1) the front face, (2) the outwardly projecting top and side surfaces, (3) the size, shape, and positioning of the recesses, and (4) the curvature from side-to-side. *Decision*, J.A. 56–57. The Board found that these “differences in the aggregate create an overall ornamental design that is not basically the same between the claimed design of the ’508 patent and the Leopaard.” *Id.* at 58. For example, the “features of the claimed design that are missing from the Leopaard are significant in the aggregate, and contribute to its rugged, chiseled, three-dimensional overall appearance that contrasts with the Leopaard’s appearance dominated by a rearward sloping lower surface and relatively shallow recesses.” *Id.* at 57. In reaching these determinations, the Board credited the testimony of GM’s witnesses. *Id.* We cannot find that the Board erred in valuing certain testimony over others. *In re Jolley*, 308 F.3d 1317, 1329 (Fed. Cir. 2002) (where “two different, inconsistent conclusions may reasonably be drawn from the evidence in record, an agency’s decision to favor one conclusion over the other is the epitome of a decision that must be sustained upon review for substantial evidence”). The Board’s finding that Leopaard did not create “basically the same” visual impression as created by the claimed design is therefore supported by substantial evidence.

Further, as discussed in Section I, the references provided by LKQ depicting the Leopaard did not show all the features necessary for comparison (*e.g.*, the bottom or sides). *Decision*, J.A. 18, 58–60. As the Board noted, “There are simply too many aspects of the claimed design that are

LKQ CORPORATION v.  
GM GLOBAL TECHNOLOGY OPERATIONS LLC

15

not adequately disclosed by the images of the [Leopaard].”  
*Id.* at 60. This amounts to a failure of proof. We therefore  
affirm the Board’s conclusion that LKQ did not show that  
the ’508 patent would have been obvious over the cited ref-  
erences.

#### CONCLUSION

We have considered LKQ’s remaining arguments but  
find them unpersuasive. For the foregoing reasons, the de-  
cision of the Board is *affirmed*.

**AFFIRMED**

NOTE: This disposition is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

---

**LKQ CORPORATION, KEYSTONE AUTOMOTIVE  
INDUSTRIES, INC.,**  
*Appellants*

v.

**GM GLOBAL TECHNOLOGY OPERATIONS LLC,**  
*Appellee*

---

2022-1253

---

Appeal from the United States Patent and Trademark  
Office, Patent Trial and Appeal Board in No. PGR2020-  
00055.

---

LOURIE, *Circuit Judge*, additional views.

The panel resolves this case by determining that substantial evidence supports the Board's conclusion that the claims of the '508 patent are not unpatentable as anticipated or obvious. I agree. I write separately to respond to the assertion by appellant that the Board improperly relied on our predecessor court's *Rosen* decision for its rationale in deciding its case. Appellant argues that *Rosen*, whatever its validity at the time it was decided, is inconsistent with, and hence was implicitly overruled, by the Supreme Court in *KSR*. The panel resolves the case without having

to reach this issue, but I comment separately on the argument appellant raises, but which we do not reach.

*Rosen* was decided by the Court of Customs and Patent Appeals in 1982, sitting with its usual en banc panel of Judges Markey, Rich, Baldwin, Miller, and Nies, hardly a group unversed in patent law. *Rosen*, in reversing the Patent Office's Board of Appeals, stated that "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, 391 (C.C.P.A. 1982) (citing *In re Jennings*, 182 F.2d 207, 208 (C.C.P.A. 1950)).

Appellant argues that the Supreme Court in reviewing *Teleflex, Inc. v. KSR Int'l Co.*, 119 Fed. Appx. 282 (Fed. Cir. 2005), a non-precedential decision of ours that recited almost as boilerplate the longstanding requirement that, in evaluating a combination of references asserted to render a claimed invention obvious, there must be some teaching, suggestion, or motivation shown in the prior art to combine the references, overruled *Rosen*. The Court stated, "[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation . . . ." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). The Court did note that the teaching, suggestion, and motivation test "captured a helpful insight," but it found it overly "rigid." *Id.* at 418. That essentially is the broad concept that appellant now asserts has overruled an almost forty-year-old design patent decision that this court has been bound to follow and has continued to follow in the decade since *KSR* was decided.

I disagree. First, *KSR* did not involve design patents, which is the type of patent we have here before us. Utility patents and design patents are distinct types of patents. Utility patents protect processes, machines, manufactures, compositions of matter, and improvements thereof. But their inventions must be "useful." 35 U.S.C. § 101. A design

LKQ CORPORATION v.  
GM GLOBAL TECHNOLOGY OPERATIONS LLC

3

patent protects ornamentation, the way an article looks, 35 U.S.C. § 171. See M.P.E.P. § 1502.01. Claims and claim construction in design patents are thus quite different compared with utility patents. See *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1294 (Fed. Cir. 2010) (questioning how “a court could effectively construe design claims, where necessary, in a way other than by describing the features shown in the drawings.”); *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)) (finding that a design is better represented by an illustration than a description).

While 35 U.S.C. § 103, which deals with obviousness, does not differentiate between types of inventions, and hence applies to all types of patents, the considerations involved in determining obviousness are different in design patents. Obviousness of utility patents requires considerations such as unexpected properties, utility, and function. Design patents, on the other hand, relate to considerations such as the overall appearance, visual impressions, artistry, and style of ornamental subject matter. Ornament is in the eyes of the beholder. Functional utility is objective.

What is the utility or function of something that is ornamental? To be sure, it may also be functional and have use, as do the skid bars in the case before us, but that function is beside the point when considering whether its ornamental features would have been obvious. And what is an unexpected property in the context of design patents, for it must be related to ornament, as function is not to be considered in evaluating obviousness of a design?

Obviousness of an ornamental design thus requires different considerations from those of a utility invention. *KSR* did not address any of these considerations, and it did not even mention design patents. Surely, it did not intend to speak to obviousness of designs, and what was said about a test long applied to utility inventions was not

indicated to apply to design patents. It cannot reasonably be held to have overruled a precedent of one of our predecessor courts involving a type of patent it never mentioned.

A comprehensive review of obviousness in design patents, *Overcoming the “Impossible Issue” of Nonobviousness in Design Patents*, supports the view that “*KSR* has very limited, if any, applicability to design patents.” Janice M. Mueller and Daniel Harris Brean, 99 KY. L. J., 419, 518 (2011). It further states that, “[m]ost of the *KSR* Court’s discussion is completely irrelevant to what design patents protect.” *Id.* It notes that “[t]he subject matter of a design patent is fundamentally different from a utility patent, as evidenced by the separate statutory provisions that define the eligible subject matter of each type of patent.” *Id.* “Indeed, a patented design ‘need not have any practical utility,’ the antithesis of a utility invention.” *Id.*

Second, while *Rosen* may have overstated its point in adding to the quoted *Jennings* language such as that the primary reference must have design characteristics that are “basically the same” as those of the claimed design, this statement hardly reflects the rigidity the Court was condemning in *KSR*. 673 F.2d at 391.

And finally, *Rosen* was not essentially incorrect. In any obviousness analysis, the question is whether the claimed invention was obvious, but obvious over *what*. One has to start from somewhere. See *K/S Himpp v. Hear-Wear Techs.*, 751 F.3d 1362, 1366 (Fed. Cir. 2014) (finding that an examiner may not rely on his common knowledge without a supporting prior art reference) (citing M.P.E.P. § 2144.03).

In any event, whether *Rosen* was right or wrong, or over-simplified, the Supreme Court, in *KSR*, reviewing a decision involving a utility patent, did not address the basic concept of beginning an obviousness analysis in design patents by looking for a “something in existence.” And, especially, it did not overrule *Rosen*.



NOTE: This disposition is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

---

**LKQ CORPORATION, KEYSTONE AUTOMOTIVE  
INDUSTRIES, INC.,**  
*Appellants*

v.

**GM GLOBAL TECHNOLOGY OPERATIONS LLC,**  
*Appellee*

---

2022-1253

---

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. PGR2020-00055.

---

STARK, *Circuit Judge*, concurring in part and concurring in judgment.

I agree with the majority's conclusion that the Board had substantial evidence to conclude LKQ failed to show that the '508 patent was anticipated or would have been obvious. Accordingly, I join the majority's anticipation analysis and most of its obviousness analysis. However, for the reasons I set forth fully in *LKQ Corp., Keystone Automotive Industries, Inc. v. GM Global Technology Operations LLC*, No. 21-2348 (Fed. Cir. Jan. 20, 2022), I

2

LKQ CORPORATION v.  
GM GLOBAL TECHNOLOGY OPERATIONS LLC

respectfully decline to join parts II.A and II.B of the majority's opinion.

**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS**

**Case Number:** 2022-1253

**Short Case Caption:** LKQ Corporation, et al. v. GM Global Technology Operations LLC

**Instructions:** When computing a word, line, or page count, you may exclude any items listed as exempted under Fed. R. App. P. 5(c), Fed. R. App. P. 21(d), Fed. R. App. P. 27(d)(2), Fed. R. App. P. 32(f), or Fed. Cir. R. 32(b)(2).

The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because it meets one of the following:

- the filing has been prepared using a proportionally-spaced typeface and includes 3,678 words.
- the filing has been prepared using a monospaced typeface and includes \_\_\_\_\_ lines of text.
- the filing contains \_\_\_\_\_ pages / \_\_\_\_\_ words / \_\_\_\_\_ lines of text, which does not exceed the maximum authorized by this court's order (ECF No. \_\_\_\_\_).

Date: 03/23/2023

Signature: /s/ Barry F. Irwin

Name: Barry F. Irwin