

Impacts on Obviousness Analysis under 35 U.S.C. 103 for Designs in view of *LKQ v. GM Global Tech*

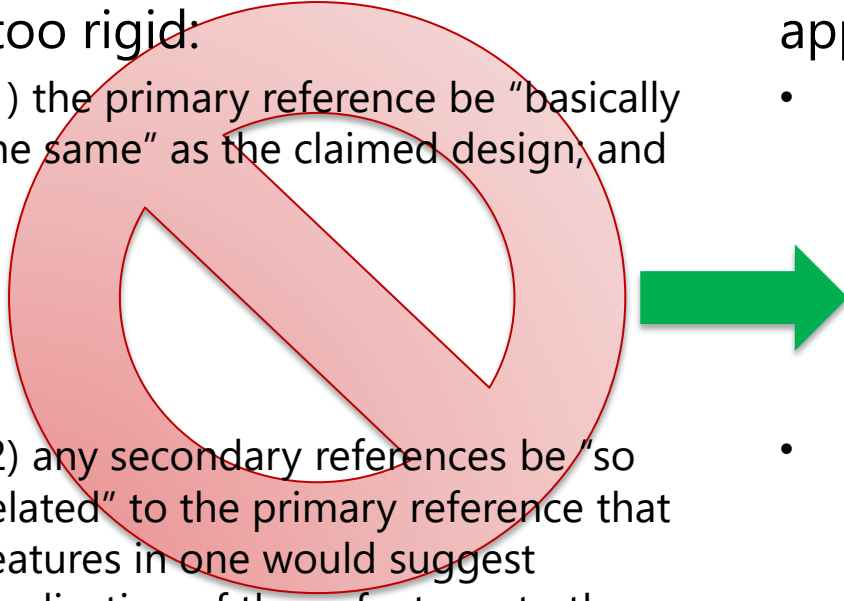
TC 2900

July 2024

What has changed since *LKQ*?

Rosen-Durling test requirements are too rigid:

- (1) the primary reference be “basically the same” as the claimed design, 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



LKQ adopts the more flexible approach of *KSR*:

- Primary reference need not be “basically the same” as the claimed design
 - Need only be “something in existence” and “visually similar” to the claimed design and must be analogous to the claimed design
- Secondary reference(s) need not be “so related” to the primary reference that features in one would suggest application of those features to the other
 - However, must be analogous to the claimed design

Learning outcomes

- Recognize that design applications should be evaluated for obviousness using the flexible approach similar to that applied in utility applications because the *Rosen-Durling* test for obviousness has been overruled as being improperly rigid.
- Recognize that 1) a primary reference need not be "basically the same" as the claimed design and need only be "something in existence" and "visually similar" to the claimed design and must be analogous to the claimed design and 2) that secondary references need not be "so related" to the primary reference that features in one would suggest application of those features to the other but must be analogous to the claimed design.
- Recognize the requirements for prior art designs to be analogous art to the claimed design for an article of manufacture.
- Recognize that 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 based on the teaching(s) of the secondary reference(s) to create the same overall visual appearance as the claimed design.

Design patents must meet the nonobviousness requirement of 35 U.S.C. 103

- Although design patents and utility patents are different, design patents, like utility patents must meet the nonobviousness requirement of 35 U.S.C. 103. [*LKQ Corp. v. GM Global Technology Operations LLC*, No. 2021-2348 (Fed. Cir. May 21, 2024) (*en banc*)].
- The basic factual inquiries guiding the evaluation of obviousness, as outlined by *Graham v. John Deere*, are applicable to the evaluation of design patentability. See MPEP 1504.03(I).

Basic factual inquiries guiding the evaluation of obviousness

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art;
- (3) Resolving the level of ordinary skill in the art; and
- (4) Evaluating any objective evidence of nonobviousness (i.e., so-called "secondary considerations").
 - Such evidence, sometimes referred to as "secondary considerations," may include evidence of commercial success, long-felt but unsolved needs, failure of others, and unexpected results.

See MPEP 1504.03(I) and MPEP 2141(II).

Factual inquiry 1: Determining the scope and content of the prior art

In determining the scope and content of the prior art, 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:
 - visually similar to the claimed design;
 - “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”; and
 - analogous to the claimed design.

Factual inquiry 1: Determining the scope and content of the prior art (cont'd)

- 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 to the claimed ornamental design's article of manufacture.
- As with the primary reference, a design examiner must also determine whether a secondary prior art reference is analogous to the claimed ornamental design's article of manufacture.
- However, each reference applied in an obviousness rejection need not be analogous art to *each other*.

Factual inquiry 1: Determining the scope and content of the prior art (cont'd)

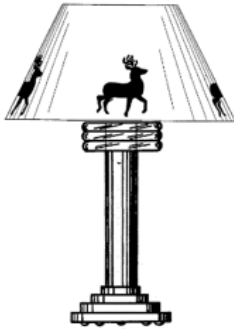
- Prior art is analogous to the claimed invention if:
 - the prior art is from the same field of endeavor as the article of manufacture of the claimed invention; **or**
 - is otherwise analogous to the claimed design for an article of manufacture as determined on a case-by-case basis.
 - As the Federal 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 consider other fields.
 - If the examiner questions whether a design is analogous art, the examiner should confer with their supervisory patent examiner (SPE).
 - The Office will compile examples of when a reference is analogous art.
- If prior art is not analogous art, it may not be considered by the examiner in assessing obviousness.

Factual inquiry 1: Determining the scope and content of the prior art (cont'd)

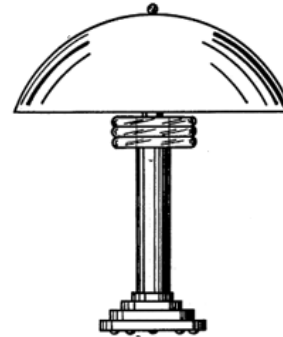
Example A: Evaluating the same field of endeavor

Title of the application: Lamp

Claim: The ornamental design for a lamp as shown and described.



Claimed design for a lamp



Prior art design for a lamp

- In this example, it would be reasonable for the examiner to determine that the prior art is in the same field of endeavor as the article of manufacture of the claimed invention, barring any evidence to the contrary.

Factual inquiry 1: Determining the scope and content of the prior art (cont'd)

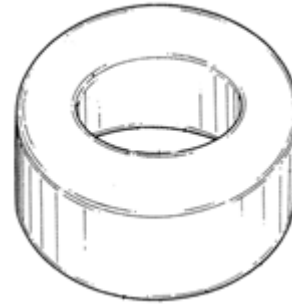
Example B: Evaluating the same field of endeavor

Title of the application: Wheel

Claim: The ornamental design for a wheel as shown and described.



Claimed design for a wheel



Prior art design for a cake

- In this example, it would be reasonable for the examiner to determine that the prior art is **NOT** in the same field of endeavor as the article of manufacture of the claimed invention, barring any evidence to the contrary.

Factual inquiry 2: Ascertaining the differences between the claimed invention and the prior art

After considering the scope and content of the prior art, the differences between the prior art and the design claim at issue must be determined.

- This approach **does not use the threshold requirement of “basically the same” from *Rosen-Durling*** and is more flexible.
- 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 from the perspective of an ordinary designer in the field of the article of manufacture.

Factual inquiry 3: Resolving the level of ordinary skill in the art

- 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.
 - See MPEP 1504.03(I)(C).

Factual inquiry 4: Evaluating any objective evidence of nonobviousness

- Referred to as "secondary considerations"
- Whenever present, design examiners should continue to consider secondary considerations as indicia of obviousness or nonobviousness.
 - See MPEP 1504.03(I)(D) and 1504.03(III).

Knowledge Checks

Knowledge Check 1

Is the following statement true or false?

To qualify as a reference in an obviousness rejection under 35 U.S.C. 103, a primary reference needs to be “basically the same” as the claimed design.

- a. True
- b. False

Knowledge Check 1: Answer

The correct answer is b, False.

To qualify as a reference in an obviousness rejection under 35 U.S.C. 103, a primary reference needs to be:

- visually similar to the claimed design;
- “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”; and
- analogous to the claimed design.

Knowledge Check 2

Is the following statement true or false?

A secondary reference need be "so related" to the primary reference that features in the secondary reference would suggest application of those features to the primary reference.

- a. True
- b. False

Knowledge Check 2: Answer

The correct answer is b, False.

Secondary references **need not be** "so related" to the primary reference that features in one would suggest application of those features to the other but must be analogous to the claimed design.

Knowledge Check 3

Is the following statement true or false?

The primary reference needs to be "something in existence" and "visually similar" to the claimed design.

- a. True
- b. False

Knowledge Check 3: Answer

The correct answer is a, True.

The primary reference needs to be "something in existence" and "visually similar" to the claimed design.

Also, the primary reference needs to be analogous to the claimed design.

Knowledge Check 4

Is the following statement true or false?

Each reference applied in a 35 U.S.C. 103 rejection must be analogous art **to each other**.

- a. True
- b. False

Knowledge Check 4: Answer

The correct answer is b, False.

Each reference applied in a 35 U.S.C. 103 rejection must be analogous art **to the claimed design**.

Knowledge Check 5

Is the following statement true or false?

Analogous art must be in the same field of endeavor as the claimed design.

- a. True
- b. False

Knowledge Check 5: Answer

The correct answer is b, False.

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 to the claimed ornamental design's article of manufacture.

Evaluating Obviousness

Background: “*Prima facie*” defined

- The legal concept of ***prima facie*** case of unpatentability is a procedural tool of patent examination, which allocates the burden of going forward with production of evidence in each step of the examination process between the examiner and applicant.
- The initial burden is on the examiner to explain why a claim is not patentable.
- Only through setting forth a *prima facie* case of unpatentability in the written Office action does the burden shift to applicant to come forth with arguments or evidence to rebut the *prima facie* case.

See MPEP 2142.

***Prima Facie* Obviousness**

- After ascertaining the scope and content of the prior art, the knowledge of an ordinary designer in the field to which the claimed design pertains, 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.
- The inquiry must focus on the visual impression of the claimed design as a whole and not on selected individual pieces.

When establishing a *prima facie* case of obviousness – Remember...

- If the rejection set forth in the Office action does not answer **WHY** it would have been obvious to have combined the teachings or made the modification, the examiner has failed to set forth the rationale necessary to establish a *prima facie* case of obviousness.
- Factors to consider in setting forth the rationale include:
 - the ordinarily skilled designer's experience, creativity, and common sense;
 - market demands and industry customs that exist in the relevant field;
 - ornamental features that are commonplace in the relevant field;
 - the extent to which ornamental features are motivated by functional considerations; and
 - whether industry designers face similar design problems as designers in other industries or otherwise look to other industries for design ideas.

When establishing a *prima facie* case of obviousness – Remember... (cont'd)

- The rationale may come from a variety of sources. See MPEP 2144 and 2143.01.
- Examples of rationales that may support a conclusion of obviousness include:
 - Simple substitution of one known design element for another
 - Industry designers face similar design problems as designers in other industries or otherwise look to other industries for design ideas
 - Consumer or market demand or industry customs for certain ornamental features as demonstrated by:
 - Prevalence in the prior art so that adding them to a claimed design would be an obvious design choice; or
 - Functional considerations that motivate a particular design choice.
 - Ornamental features that are commonplace in the relevant field
 - Some other teaching, suggestion, or motivation in the prior art that would have led a designer of ordinary skill in the art to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention

When establishing a *prima facie* case of obviousness – Remember... (cont'd)

- Note that the list of rationales provided is not intended to be an all-inclusive list.
 - Other rationales to support a conclusion of obviousness may be relied upon by examiners.
 - The rationales should not be treated as per se rules, but rather must be explained and shown to apply to the facts at hand.
 - Any rationale employed must provide a link between the factual findings and the legal conclusion of obviousness.
- Should you have concerns about whether to rely on other rationales, submit an inquiry to designcaselaw@uspto.gov together with application number, prior art and proposed rationale.

How to Write a 35 U.S.C. 103 Rejection Based on Multiple References

Establishing a *prima facie* case of obviousness based on multiple references

- **Reminder:** 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 based on the teaching(s) of the secondary reference(s) to create the same overall visual appearance as the claimed design.

Writing an obviousness rejection based on multiple references

The following is a suggested format for writing an obviousness rejection using the facts determined from the *Graham v. John Deere* inquiries:

- A. A description of what the primary reference teaches relative to the claimed invention
- B. An identification of what the differences are between the claimed invention and the primary reference
- C. An indication of what the secondary reference(s) teach(es) relative to the differences
- D. An explanation of how the primary reference is to be modified by each secondary reference to arrive at the claimed invention, and the rationale for making each modification
 - An examiner must explain **why** each modification or combination of prior art teachings would have been obvious to a designer of ordinary skill who designs articles of the type being examined in order to support the legal conclusion of obviousness.



Let's take a closer look at D

D. Explanation of the modification and the rationale for combining prior art

- The rationale to combine references need not come from the references themselves.
- “[T]here 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 visual appearance as the claimed design.” *LKQ slip op.* at 26.
- Design examiners should keep in mind that, generally, the more different the overall visual 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.

Examples

Guidance for examples

- Resolve the factual inquiries:
 - (1) Determining the scope and content of the prior art;
 - (2) Ascertaining the differences between the claimed invention and the prior art;
 - (3) Resolving the level of ordinary skill in the art; and
 - (4) Evaluating any objective evidence of nonobviousness (i.e., so-called "secondary considerations").
- Determine if an ordinary designer in the field of the claimed design would have been motivated to modify a prior art design to create the same overall visual appearance as the claimed design.
- Write a rejection under 35 U.S.C. 103 supported by the facts determined from the factual inquiries using the suggested format:
 - A. Description of what the primary reference teaches relative to the claimed invention
 - B. Identification of what the differences are between the claimed invention and the primary reference
 - C. Indication of what the secondary reference(s) teach(es) relative to the differences
 - D. Explanation of how the primary reference is to be modified by each secondary reference to arrive at the claimed invention, and the rationale for making each modification

For the following examples, assume the factual inquiries have been resolved and an ordinary designer in the field of the claimed design would have been motivated to modify a prior art design to create the same overall visual appearance as the claimed design. Let's look at how to write up the obviousness rejections...

Example 1

Title: Footwear Upper

Claim: The ornamental design for a footwear upper as shown and described.



Example 1 (cont'd)

A. A description of what the primary reference teaches relative to the claimed invention

- Examiners can explain the similarities using annotations



Claimed footwear upper



Alexis (prior art) shoe upper

Alexis teaches a shoe upper having an overall appearance with design characteristics that are visually similar to those of the claimed design, in showing an upper with...

Example 1 (cont'd)

B. An identification of what the differences are between the claimed invention and the primary reference



Claimed footwear upper



Alexis (prior art) shoe upper

The claimed design differs from Alexis in that the shoe upper has thick, flat lace loops running along the edge of its lacing region.

Example 1 (cont'd)

C. An indication of what the secondary reference(s) teach(es) relative to the differences



Bob shows a shoe upper with flat lace loops in the lacing region.

Bob (prior art) shoe upper

Example 1 (cont'd)

D. An explanation of how the primary reference is to be modified by each secondary reference to arrive at the claimed invention, and the rationale for making each modification

- An examiner must explain **why** each modification or combination of prior art teachings would have been obvious to a designer of ordinary skill in the art in order to support the legal conclusion of obviousness.

It would have been obvious to a designer of ordinary skill in the art before the effective filing date of the claimed invention to modify Alexis with Bob by substituting the eyelets of Alexis with the lace loops of Bob because such a modification is no more than a simple substitution of one known design element for another (lacing loops replacing lacing eyelets). Moreover, such substitution of one known design element for another known design element in the same field would have been within the skill of an ordinarily skilled designer.

Example 1 (cont'd)

- In this example there was no evidence of secondary considerations in the record such as commercial success and copying of the design by others. (MPEP 1504.03(1)(D)).
 - Therefore, for this example, there was no need to address evidence of secondary considerations.
- As with any obviousness rejection, applicant can respond by arguing that a *prima facie* case of obviousness was not established. The examiner must consider and respond to those arguments in the next succeeding action.
- In addition, applicants may submit evidence of secondary considerations (e.g., commercial success or copying) that may rebut the *prima facie* case of obviousness. If such evidence is submitted, the examiner must consider and comment on the evidence in the next succeeding action.

Example 1 – 35 U.S.C. 103 rejection based on multiple references

Claim Rejection - 35 U.S.C. §103

The following is a quotation of **35 U.S.C. 103** which forms the basis for all obviousness rejections set forth in this Office action:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section [102](#), if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

The claim is rejected under 35 U.S.C. 103 as being unpatentable over US Design Patent D##### to Alexis (hereinafter Alexis) in view of the prior art as demonstrated by D##### to Bob (hereinafter Bob).

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a designer having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable.

Example 1 – 35 U.S.C.103 rejection based on multiple references (cont'd)

Alexis has an overall appearance with **design characteristics that are visually similar to those of the claimed design**, in showing an upper with (***)

The claimed design differs from Alexis in that the shoe upper has thick, flat lace loops running along the edge of its lacing region.

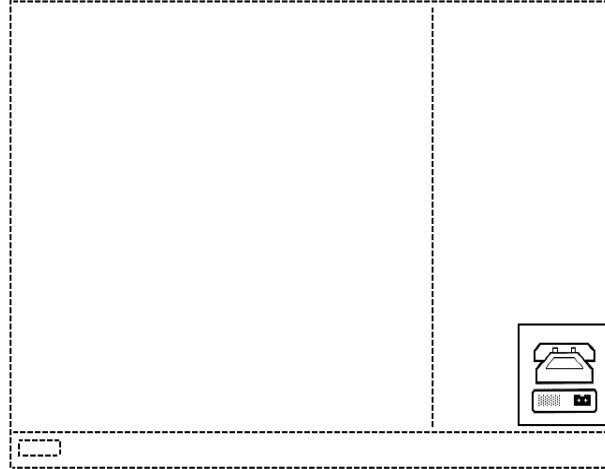
Bob shows a shoe upper with flat lace loops in the lacing region.

It would have been obvious to a designer of ordinary skill in the art before the effective filing date of the present claimed invention to modify Alexis with Bob by **substituting the eyelets of Alexis with the lace loops of Bob because such a modification is no more than a simple substitution of one known design element for another (lacing loops replacing lacing eyelets)**. Moreover, such **substitution of one known design element for another known design element in the same field would have been within the skill of an ordinarily skilled designer**.

Example 2

Title: Computer Screen with Icon

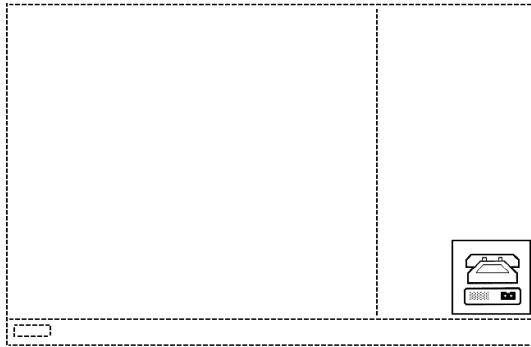
Claim: The ornamental design for a computer screen with icon as shown and described.



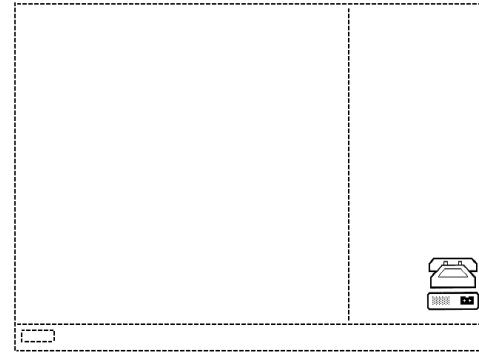
Example 2 (cont'd)

A. A description of what the primary reference teaches relative to the claimed invention

- Examiners can explain the similarities using annotations



Claimed computer screen with icon

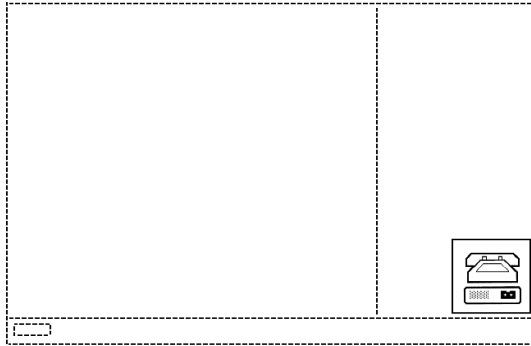


Peters (prior art) computer screen with icon

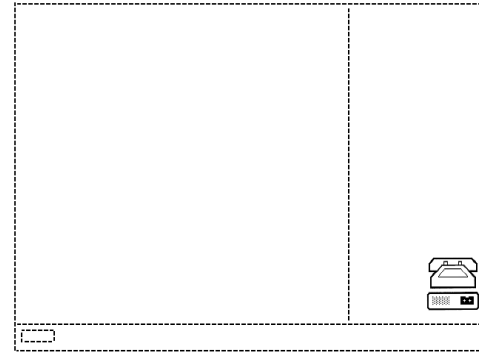
Peters teaches a computer screen with icon having an overall appearance with design characteristics that are visually similar to those of the claimed design, in showing a computer screen with a telephone and speaker icon...

Example 2 (cont'd)

B. An identification of what the differences are between the claimed invention and the primary reference



Claimed computer screen with icon

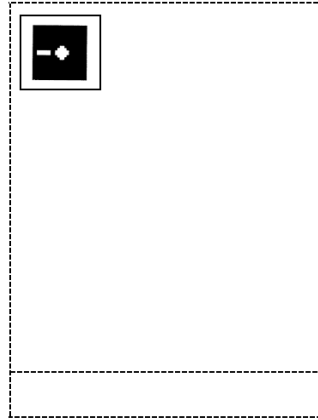


Peters (prior art) computer screen
with icon

The claimed design differs from Peters in that the telephone and speaker icon is surrounded by a rectangular box.

Example 2 (cont'd)

C. An indication of what the secondary reference(s) teach(es) relative to the differences

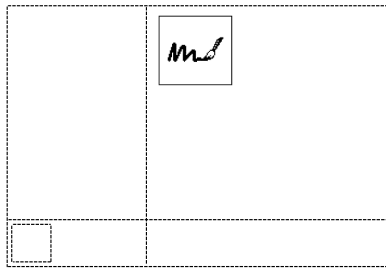


Doe

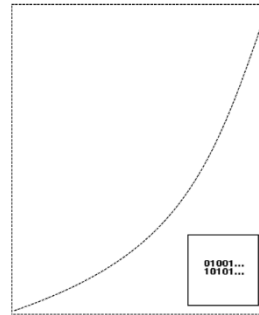
Doe teaches a computer screen with an icon surrounded by a rectangular box.

Example 2 (cont'd)

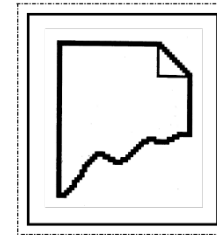
Note that references 2-4 are not relied upon for the rejection. However, the examiner could cite these references as references of interest confirming the commonality of the feature to forestall an argument that the modification of Doe is not commonplace in the art of icons using, for example, form paragraph 7.96.



Reference 2



Reference 3



Reference 4

Example 2 (cont'd)

D. An explanation of how the primary reference is to be modified by each secondary reference to arrive at the claimed invention, and the rationale for making each modification

- An examiner must explain why each modification or combination of prior art teachings would have been obvious to a designer of ordinary skill in the art in order to support the legal conclusion of obviousness.

It would have been obvious to a designer of ordinary skill in the art before the effective filing date of the claimed invention to modify Peters by adding the rectangular box of Doe since Doe demonstrates that the ornamental feature of a rectangular box surrounding an icon is commonplace in the field of designing computer screens with icons and would therefore have been an obvious design choice.

Example 2 (cont'd)

- In this example there was no evidence of secondary considerations in the record such as commercial success and copying of the design by others. (MPEP 1504.03(1)(D)).
 - Therefore, for this example, there was no need to address evidence of secondary considerations.
- As with any obviousness rejection, applicant can respond by arguing that a *prima facie* case of obviousness was not established. The examiner must consider and respond to those arguments in the next succeeding action.
- In addition, applicants may submit evidence of secondary considerations (e.g., commercial success or copying) that may rebut the *prima facie* case of obviousness. If such evidence is submitted, the examiner must consider and comment on the evidence in the next succeeding action.

Example 2 – 35 U.S.C. 103 rejection based on multiple references

Claim Rejection - 35 U.S.C. §103

The following is a quotation of **35 U.S.C. 103** which forms the basis for all obviousness rejections set forth in this Office action:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section [102](#), if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

The claim is rejected under 35 U.S.C. 103 as being unpatentable over US Design Patent D##### to Peters (hereinafter Peters) in view of the prior art as demonstrated by D##### to Doe (hereinafter Doe).

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a designer having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable.

Example 2 – 35 U.S.C. 103 rejection based on multiple references (cont'd)

Peters teaches a computer screen with icon having an overall appearance with **design characteristics that are visually similar to those of the claimed design**, in showing a computer screen with a telephone and speaker icon...

The claimed design differs from Peters in that the telephone and speaker icon is surrounded by a rectangular box.

Doe teaches a computer screen with an icon surrounded by a rectangular box.

It would have been obvious to a designer of ordinary skill in the art before the effective filing date of the claimed invention to modify Peters by adding the rectangular box of Doe since **Doe demonstrates that the ornamental feature of a rectangular box surrounding an icon is commonplace in the field of designing computer screens with icons and would therefore have been an obvious design choice.**

Summative Assessment

Summative assessment question 1

Which of the following language is consistent with the flexible approach for determining obviousness, and may be used in a 35 U.S.C. 103 rejection, in light of the LKQ decision?

- a. The reference has an overall appearance with design characteristics that are **visually similar** to those of the claimed design.
- b. The reference has an overall appearance with design characteristics that are **basically the same** as the claimed design.

Summative assessment question 2

Which of the following rationales is **proper** in light of the *LKQ* decision?

- a. This modification of the primary reference in light of the secondary reference is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other. See *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982); *In re Carter*, 673 F.2d 1378, 213 USPQ 625 (CCPA 1982), and *In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956).
- b. It would have been obvious to a designer of ordinary skill in the art before the effective filing date of the present claimed invention to modify Alexis with Bob by substituting the eyelets of Alexis with the lace loops of Bob because such a modification is no more than a simple substitution of one known design element for another (lacing loops replacing lacing eyelets). Moreover, such substitution of one known design element for another known design element in the same field would have been within the skill of an ordinarily skilled designer.

Summative assessment question 1:

Answer

- The correct answer is a.
- The appropriate language for use in a 35 U.S.C. 103 rejection should analyze the primary reference in terms of its visual similarity to the claimed design, but this primary reference need not be “basically the same” as the claimed design.

Summative assessment question 2:

Answer

- The correct answer is b.
- A rationale that uses language related to the *Rosen/Durling* test requirements is no longer appropriate in view of *LKQ*.

Takeaways

- Design applications should be evaluated for obviousness using the flexible approach similar to that applied in utility applications because the *Rosen-Durling* test for obviousness has been overruled as being improperly rigid.
- The basic factual inquiries guiding the evaluation of obviousness, as outlined by *Graham v. John Deere*, are applicable to the evaluation of design patentability.
- The primary and secondary reference(s) must be analogous art to the claimed design for an article of manufacture.
- Prior art designs may be considered analogous art to the claimed invention if:
 - the prior art is from the same field of endeavor as the article of manufacture of the claimed invention; or
 - is otherwise analogous to the claimed design for an article of manufacture as determined on a case-by-case basis.

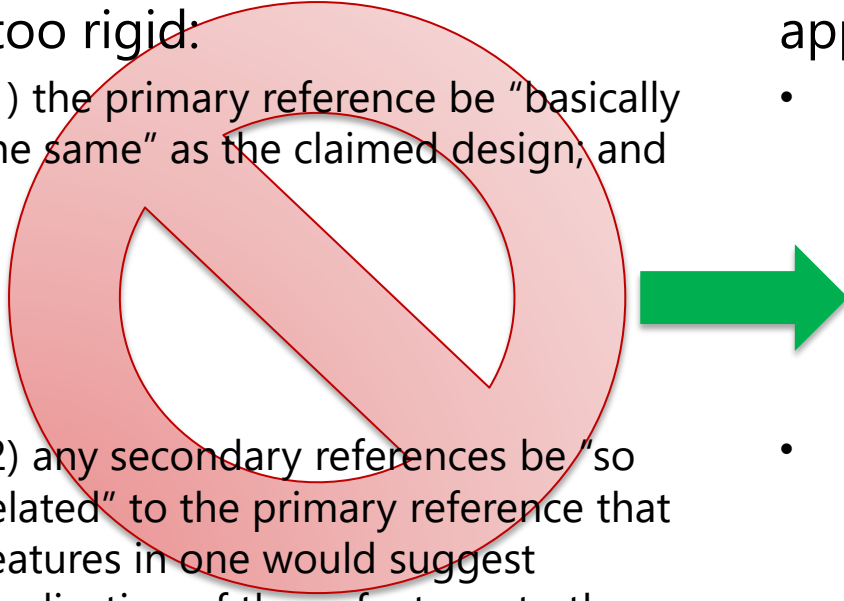
Takeaways (cont'd)

- The primary reference need not be “basically the same” as the claimed design but need only be “something in existence” and “visually similar” to the claimed design and must be analogous to the claimed design.
- Secondary reference(s) need not be “so related” to the primary reference that features in one would suggest application of those features to the other.
- 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 based on the teaching(s) of the secondary reference(s) to create the same overall visual appearance as the claimed design.
- When writing a rejection, take the following steps:
 - Resolve the factual inquiries;
 - Determine if an ordinary designer in the field of the claimed design would have been motivated to modify a prior art design to create the same overall visual appearance as the claimed design; and
 - Write a rejection under 35 U.S.C. 103 supported by the facts determined from the factual inquiries.

What has changed since *LKQ*?

Rosen-Durling test requirements are too rigid:

- (1) the primary reference be “basically the same” as the claimed design, 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



LKQ adopts the more flexible approach of *KSR*:

- Primary reference need not be “basically the same” as the claimed design
 - Need only be “something in existence” and “visually similar” to the claimed design and must be analogous to the claimed design
- Secondary reference(s) need not be “so related” to the primary reference that features in one would suggest application of those features to the other
 - However, must be analogous to the claimed design



Thank you!