

TRADE DRESS AND DESIGN LAW

Second Edition
2024-25 Update

Graeme B. Dinwoodie

University Distinguished Professor &
Global Professor of Intellectual Property Law
IIT Chicago-Kent College of Law

Mark D. Janis

Robert A. Lucas Chair of Law
Indiana University Maurer School of Law

Jason J. Du Mont

Doctoral Candidate
Ludwig Maximilian University, Munich

Copyright Graeme B. Dinwoodie, Mark D. Janis, and Jason J. Du Mont 2024

Contents

PART II – TRADE DRESS1

Chapter 2 - Distinctiveness 2

 TBL LICENSING, LLC v. VIDAL (4th Cir. 2024) 2

 PROBLEM 2-1: FRUITY PEBBLES12

PART III – DESIGN PATENTS 14

Chapter 5 – Securing Rights15

 LKQ CORP. v. GM GLOBAL TECHNOLOGY OPERATIONS LLC (Fed. Cir. 2024)19

 PROBLEM 5-3: APPLYING THE DESIGN PATENT OBVIOUSNESS ANALYSIS38

Chapter 8 – Sui Generis Design Protection43

DISTINCTIVENESS

2

At page 136, after *Yurman*, add the following:

TBL LICENSING, LLC v. VIDAL
98 F.4th 500 (4th Cir. 2024)

QUATTLEBAUM, Circuit Judge:

TBL Licensing, LLC, more commonly known as Timberland, tried to register certain features from the design of its popular boot under the Lanham Act as trade dress. But the law prohibits the registration of product designs that have not acquired a distinctive meaning identifying the product with its maker in the minds of the consuming public. It also bars the registration of product designs that are functional since protection of functionality is reserved for patent law. Concluding the boot design is not distinctive, the United States Patent and Trademark Office (“USPTO”) refused to register it. TBL turned to federal district court, which agreed with the USPTO that the boot design is not distinctive and added that it is impermissibly functional. On either independent ground, the district court granted the USPTO’s motion for summary judgment. On distinctiveness, the issue we face is not whether the public recognizes the entire product as Timberland’s perhaps iconic boot; rather, we must decide whether the district court reversibly erred in concluding that the subset of design features that TBL selectively sought to register lacks distinctiveness in the public’s view. We hold that the district court did not reversibly err. So, without deciding functionality, we affirm the district court’s grant of summary judgment for the USPTO.

I.

A.

Generally, trademark law protects marks that distinguish the products of one maker from those of another. [cit]. The first to use the distinctive mark acquires rights to that mark, including the right to prevent others from using it. Though being the first to use a mark is enough to generate trademark protection, federal law provides various mechanisms that augment that protection. Relevant here, the Lanham Act confers various legal rights to trademark owners who register their marks.

Trademark law is commonly known to protect words, for example, “Nike,” and symbols, like Nike’s “swoosh.” See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000). But it also can cover product designs. . . Examples of product designs treated as trade dress include Coca-Cola’s hourglass-shaped bottle, *see Qualitex*, 514 U.S. at 162, the dripping red wax seal on a bottle of Maker’s Mark, *see Maker’s Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410 (6th Cir. 2012), and the fish-shape of Goldfish crackers, *see Nabisco, Inc. v. PF Brands, Inc.*, 50 F. Supp. 2d 188 (S.D.N.Y. 1999).

But not all product designs can receive trade dress protection. [cit]. Trademark law does not protect product designs that are functional as whole. Nor does it protect product designs that lack distinctive meaning as a source identifier. *Wal-Mart Stores*, 529 U.S. at 210. The same principles apply for purposes of registration under trademark law. *See id.*; 15 U.S.C. § 1052(e)(5).

Whether a word, logo or design, to register a mark and obtain the benefits that follow, the mark’s owner must file an application with the USPTO. That application must include, among other things, “a drawing of the mark.” [15 U.S.C.] § 1051(a)(2); see also 37 C.F.R. § 2.51. Per USPTO regulations, an application to register a product design must also include a written description of the design. See 37 C.F.R. § 2.37. Both the drawing and description define the mark that the applicant intends to register. See *id.* (“A description of the mark must be included if the mark is not in standard characters.”); *id.* § 2.52 (“A drawing depicts the mark sought to be registered.”); see also Trademark Manual of Examining Procedure § 1202.02(c) (Jan. 2015) (“To ensure proper examination, the drawing and description of such a mark must accurately depict the mark the applicant intends to register.”); 1 McCarthy § 8:7 (“To be registerable as a trademark or service mark, the elements of the trade dress must be listed and defined so that the public will know the exact parameters of the claimed exclusive right covered by the registration.”). . .

B.

For decades, TBL has sold the following boot in several colors:



In May 2015, TBL applied to register aspects of the boot’s design as protected trade dress with the USPTO. As required by law, see 37 C.F.R. § 2.37, TBL included a written description “specify[ing] which elements ... constitute the mark and are claimed as part of the mark and which are not.” Trademark Manual of Examining Procedure § 1202.02(c)(ii).

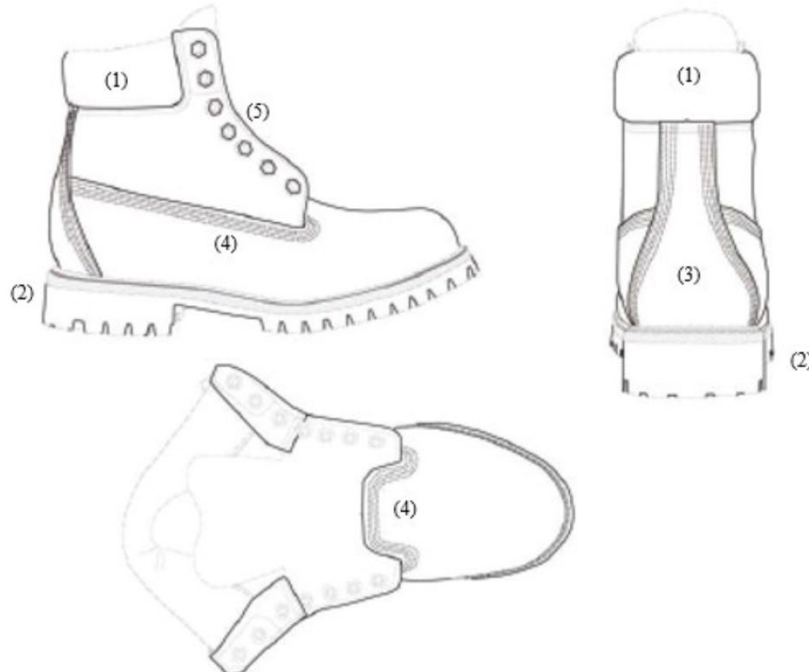
The mark consists of a three-dimensional configuration of a lace-up boot having an overall shape and silhouette as depicted in the drawings, with a visibly bulbous toe box and the following individual features:

- (1) the external appearance of a tube-shaped ankle collar on the outside surface of the product running from one eyelet panel to the other eyelet panel around the sides and rear of the boot and protruding over the upper side and rear panels of the boot (material on the inside of the ankle collar not being claimed);
- (2) outsoles having two color tones divided horizontally and extending around the circumference of the boot, and visibly showing inverted tooth shaped cuts on each side of the heel of the outsole and around the sides and front of the forward portion of the outsole;
- (3) an hourglass-shaped rear heel panel, defined by four vertical stitching lines from the top of the outsole to the rear collar;
- (4) quad-stitching forming an inverted “U” shape around the vamp line in front of the boot at the bottom of the tongue and curving around to the left and right sides and ending at the cinched portion of the hourglass stitching of the rear heel panel; and
- (5) eyelets shaped hexagonally on the exterior-facing outside surface.

The double row stitching around the rear and side ankle collar, the single stitching around the upper two eyelets on each side, the single stitching along the upper perimeter of the shaft in front of the eyelets and the boot tongue, the appearance of the eyelets on the boot interior, the top of the ankle collar, the bottom, outer most surface of the outsole, and the uppermost surface of the outsole connecting to the boot around the perimeter, all of which are depicted in broken or dotted lines, are not being claimed as part of the mark and serve only to show the position or placement of the mark.

J.A. 253–54 (paragraph breaks added).

Also as required by law, see 15 U.S.C. § 1051(a)(2); 37 C.F.R. § 2.51, TBL included this drawing of the design features it sought to register:



For clarity, we have added the numbers on the drawing, which correspond to the design features described in the application.

Importantly, TBL did not try to register every aspect of the boot. In its registration application, TBL asserted—or, to use the legal term, “claimed”—intellectual property rights in some, but not all, of the features of its boot design. For instance, as a part of the design it sought to register, TBL claimed “the external appearance of a tube-shaped ankle collar on the outside surface of the product” but not “material on the inside of the ankle collar.” Likewise, it claimed two-colored outsoles “visibly showing inverted tooth shaped cuts” along the soles’ sides, but not “the bottom, outer most surface of the outsole.” Also, the application claimed no particular color as a part of the boot’s design, such as the popular wheat-yellow color depicted above. Nor did it include TBL’s already-registered tree logo or TIMBERLAND word mark.⁴

The USPTO’s examining attorney refused to register the design, finding it overall functional and not distinctive. TBL appealed to TTAB, which affirmed the examining attorney’s refusal to register the design, finding the design lacks distinctiveness and declining to reach whether it is functional.

As allowed by the Lanham Act, TBL challenged TTAB’s decision in federal district court, naming as defendants the USPTO and its then-acting director (collectively “USPTO”) . . .

The district court held that TBL could not register the design described in its application for two independent reasons. First, the district court found the design functional. Second, it found that the design, as described, has not acquired a distinctive meaning identifying the boots as Timberlands. On either ground, the district court granted the USPTO’s motion for summary judgment, denied TBL’s cross-motion and dismissed the case. TBL timely appealed that final decision, which falls within our appellate jurisdiction. *See* 28 U.S.C. § 1291.

II.
A.

[H]ere, we must affirm the district court unless it reversibly erred in finding both that the design TBL claimed is functional and that the same design is not distinctive. In assessing both issues, we focus on the design drawn and described in TBL’s application . . . Crucial to this appeal, that means we consider only the outer ankle collar, the two-tone color and etching on the side of the boot’s sole, the hourglass rear heel panel, the quad stitching along the boot’s side and tongue area, the hexagonal eyelets for the boot’s laces and the boot’s bulbous toe box. Other design features of the boot—such as the popular wheat-yellow color, the tree logo, the lug soles and the inner ankle collar—cannot be used to prove distinctiveness, as they are not design features that TBL claimed in its application. . .

C.

⁴ TBL’s decision to limit the design features of the boot in its application was quite possibly strategic. Had it included, for instance, the inner ankle collar or the lug sole, the overall risk of a functionality finding likely would have increased. But having omitted these features in its application, TBL must prove that, without resorting to these unclaimed features, the public associates the features TBL did claim exclusively with Timberland.

To be registerable, a mark must cause the public to identify the product bearing it as coming from a specific source. That is, the mark must be distinctive. A mark generally acquires distinctiveness “if it has developed secondary meaning, which occurs when, ‘in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.’” [*Wal-Mart Stores*, at 211] (*quoting Inwood Labs.*, 456 U.S. at 851 n.11). While the public “need not be able to identify the name of the manufacturer that produces the product,” it must perceive “that the product emanates from a single source.” [cit]. That public perception must rely on the features claimed, as drawn and described in TBL’s application.

This point is critical. Some consumers might recognize the whole boot, unclaimed features and all, as a Timberland. But TBL did not undertake to register the entire boot. Instead, TBL sought to register only the select attributes described in its application—for instance, two-colored outsoles “visibly showing inverted tooth shaped cuts” along the soles’ sides, but not “the bottom, outer most surface of the outsole.” Just as TBL effectively narrowed the functionality inquiry by tailoring its application to select elements of its boot design, so too must we limit our secondary meaning analysis to those applied-for features. Thus, the question is whether the design features claimed in TBL’s application have acquired secondary meaning. And those features have not if consumers associate them with sources other than just Timberland. [cit].

A party seeking to establish secondary meaning in a product design bears a “formidable burden of proof.” [cit]. Reflecting that “rigorous evidentiary standard,” our circuit assesses secondary meaning through many factors: (1) advertising expenditures; (2) consumer studies linking the mark to a source; (3) record of sales success; (4) unsolicited media coverage of the product; (5) attempts to plagiarize the mark; and (6) the length and exclusivity of the mark’s use. [cit]. “[N]o single factor is determinative.” [cit].

Applying these factors, the district court found that TBL failed to carry its formidable burden of proving that the design features of the boot that it sought to register have acquired secondary meaning. And, as described below, the district court did not clearly err in reaching that finding.

1. Consumer Studies

We start with consumer studies, or surveys, due to their importance in the secondary meaning analysis. “Survey evidence is generally thought to be the most direct and persuasive way of establishing secondary meaning.” [cit]. Indeed, TBL hired a survey expert in its effort to show that consumers associate the claimed features of its boot’s design with Timberland. But the district court pointed out several flaws with the survey.

First, the survey, according to the district court, improperly suggested an outcome. The uncolored and unshaded drawing in TBL’s application “depicts the mark sought to be registered.” 37 C.F.R. § 2.52. But, instead of using that drawing, the survey used grayscale photographs of the boots. While those photographs depicted boots that were light in color, the grayscale photographs of the non-Timberland boots used as control images appeared darker.

The district court concluded that the grayscale photographs of the light-colored boots suggested to the survey respondents that the boot presented to them was a Timberland boot depicted in its best-selling wheat-yellow color. While the boot is now offered in multiple colors, the boot has been sold in a wheat-

yellow color from the beginning. In fact, TBL previously applied to register that color but was ultimately unsuccessful. In its present application, the one on which our present analysis must focus, TBL has not claimed the wheat-yellow color or any other. So, the district court found that the survey used features of the boot's design that were not part of the application to improperly suggest the boot was a Timberland.

Second, the district court determined that the survey used a problematic progression. The survey began by asking, "Do you associate this boot design with any company or companies?" Then, it asked, "What company?" The district court worried that this progression may have nudged respondents to name only a single company, even if the respondents associated the boot with several. Such a nudge would matter because if the public associated the claimed design features with more than just Timberland, the design did not acquire a distinctive secondary meaning. . .

TBL has not challenged the district court's critique. In fact, it affirmatively waived any challenge to the district court's findings regarding the weight, or lack thereof, of the survey TBL proffered. Without "this most direct and persuasive" evidence of secondary meaning from consumers, TBL must resort to circumstantial evidence. [cit].

2. Advertising Expenditures

TBL did, however, challenge the district court's ruling on advertising expenditures, arguing it clearly erred in not giving such expenditures more weight. No doubt, TBL has spent vast sums on advertising. According to the declaration of a senior Timberland manager, TBL has spent over \$81 million marketing the boot in the U.S. across various media over the past six years. But the district court declined to infer secondary meaning from advertisements merely picturing Timberland boots. It emphasized TBL's failure to point to advertisements encouraging consumers to identify the boots as Timberlands by looking for the specific design features TBL sought to register.

Expenditures themselves do not, from a legal standpoint, establish secondary meaning without a showing that they translated into what counts—consumers associating the claimed design features with a single source. . .

Accordingly, not all advertisements are equally probative of secondary meaning. Advertisements that direct consumers to "look for" features claimed as trade dress to identify the advertiser's product provide particularly powerful evidence that those features have acquired secondary meaning. See 1 McCarthy § 8:8.50 (stating that sometimes look-for advertising is "the only practical way to develop secondary meaning in trade dress"); . . . see also *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 662 (7th Cir. 1995) ("Advertising that touts a product feature for its desirable qualities and not primarily as a way to distinguish the producer's brand is not only not evidence that the feature has acquired secondary meaning, it directly undermines such a finding."). The *Maker's Mark* red wax seal illustrates this principle. In *Maker's Mark*, the Sixth Circuit affirmed the district court's finding that "Maker's Mark usually focus[ed] directly on the red dripping wax seal." It explained that "the district court had before it, and considered, an abundance of Maker's Mark advertisements that specifically feature the red dripping wax seal." *Maker's Mark*, 679 F.3d at 421.

On the other hand, advertising proves less if it does not somehow spotlight the claimed design features over other unclaimed attributes. See *Forney Indus., Inc. v. Daco of Mo., Inc.*, 835 F.3d 1238, 1254 (10th

Cir. 2016) (“[A]dvertising alone is typically unhelpful to prove secondary meaning when it is not directed at highlighting the trade dress.”); *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 871 (8th Cir. 1994) (“The advertisements submitted with the application cannot establish secondary meaning because they do not separate the claimed dress of the products from the other marks that serve to identify the products as those of *Aromatique*.”). . .

This makes sense. If advertising calls no special attention to the features of the product’s design claimed to have secondary meaning, such evidence generally carries less weight. Even so, less talk may be required to showcase to consumers a product’s more prominent features, which to an extent speak for themselves. *See, e.g.*, *Nabisco*, 50 F. Supp. 2d at 200 (“The Goldfish shape, the most salient feature of the product design, dominates these advertisements.”); *id.* at 204 (“The print advertisements call attention to the product configuration, prominently displaying the Goldfish form.”).

The district court followed these principles. Looking beyond the mere expenditures, it explained that the advertisements TBL introduced depicted the entire boot. Those pictures, for example, included the wheat-yellow color and Timberland’s tree logo, even though those features are not claimed in its current trade dress application. Compared to those unclaimed, but perhaps more conspicuous, features of the boot, the advertisements did not call attention to the design features in the application—like the hexagonal shape of the eyelets or the fourth row of stitching, to name two examples. As a result, the district court did not clearly err in its analysis of this factor.

3. Sales Success

TBL similarly argues that the district court’s analysis of the boot’s sales success was clearly erroneous. Without a doubt, the Timberland boot has enjoyed commercial success. According to the same declaration setting forth TBL’s advertising expenditures, the boot has brought in over a billion dollars in sales from 2013 through 2021, averaging well over \$100 million per year. However, the district court did not lend these sales much weight without any evidence showing why customers bought the boots. The district court reasoned that sales would suggest secondary meaning only if customers bought the boots because they associated the claimed design features with Timberland. But, the district court emphasized, TBL had not produced evidence that customers bought its boots because they attributed to Timberland the features TBL sought to register—the outer ankle collar, the two-tone color and etching on the side of the boot’s sole, the hourglass rear heel panel, the quad stitching on the boot’s side and tongue area, the hexagonal eyelets for the boot’s laces and the bulbous toe box. As the district court observed, customers could just as well have bought the boots because they liked how those features look or work. Liking those features is, of course, good for sales, but it does not establish that the design features in the application acquired secondary meaning, which focuses on source identification.⁸

Are sales numbers themselves ever indicative of secondary meaning in product design cases? Other circuits have deduced that they typically are not “since the product’s market success may well be attributable to the desirability of the product configuration rather than the source-designating capacity of

⁸ In addition, customers may have bought the boots because they liked other features that were not part of TBL’s application, such as the wheat-yellow color, the tree logo or the lug sole. Or customers may have attributed those unclaimed features to Timberland. Regardless, customer perceptions of the unclaimed aspects of the boot cannot demonstrate that the claimed portions of the boot have acquired secondary meaning.

the supposedly distinguishing features or combination of features.” *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1452 (3d Cir. 1994); . . . *In re Bongrain Int’l (Am.) Corp.*, 894 F.2d 1316, 1318 (Fed. Cir. 1990) (determining that “[g]rowth in sales” did not prove acquired distinctiveness where it “may indicate the popularity of the product itself rather than recognition of the mark”). . . Although our court has long listed sales success as one of the relevant factors for assessing secondary meaning of trademarks in general, [cit], when it comes to product designs, we agree with our sister circuits that a product’s sales success, considered in a vacuum, typically is less helpful to showing whether the product’s design has acquired secondary meaning. That is not to say that sales success should be ignored in product design cases, only that the sales numbers by themselves—without evidence linking them to a product’s source designation as opposed to its design—will rarely, if ever, signal the presence or absence of secondary meaning.

Therefore, while the Timberland boot boasts impressive sales, we see no clear error in the district court’s determination that the numbers themselves did little to indicate that the claimed features of the boot’s design have acquired secondary meaning.

4. Unsolicited Media Coverage

TBL’s challenge to the district court’s analysis concerning media coverage follows the same pattern. The Timberland boot has appeared in various media. As one senior Timberland manager has catalogued, the boots have appeared in television, movies, music and publications. The record also contains reams of Instagram posts of individuals, mostly celebrities, wearing boots that user comments identify as “Timberlands,” “Tims” or the like.

Even so, the district court found that these references did little to show that the design features TBL specifically sought to register had acquired secondary meaning. Rather, the district court stressed that these images from media coverage, like the advertisements, included features of the Timberland boot that were not part of its trade dress application. Some images include TBL’s registered tree logo burned onto the boot’s side. Also, as the district court observed, most of the images present the boot in its best-selling wheat-yellow color, a feature TBL does not claim in its current application. The district court considered these unclaimed design features to be more distinctive than the design that TBL now wishes to register as trade dress.

True, as TBL argues, the presence of other identifiers is not always fatal to showing a product design’s distinctiveness. But their presence can suggest that a producer relies on that other branding rather than just the claimed design to identify itself as the product’s maker. See *Aromatique*, 28 F.3d at 872 (concluding that articles were insufficient to support a showing of secondary meaning since they “do not distinguish between the trade dress and *Aromatique*’s other marks”); see also *Gen. Shoe Corp. v. Rosen*, 111 F.2d 95, 99 (4th Cir. 1940) (“It is of course possible that marks may be so completely associated with one another in the minds of the public as not to indicate separately the origin of the goods.”). So, the district court did not legally err by considering the role of the unclaimed design features.

In finding the unclaimed design features played a predominant role in identifying the boot, the district court did not need to look far since TBL had already admitted that they do. When previously TBL sought to register the wheat-yellow color as trade dress, TBL officers stated under oath that it was only the boots’ color that allowed for their identification as Timberlands. . .

As with TBL's advertising, the media coverage of the Timberland boot does not highlight the aspects of the boot design claimed in TBL's current application. To the contrary, many of the design features TBL described in its application are imperceptible in many of the images contained in the record.

In weighing the media portrayals of the boot, the district court did not legally or clearly err.

5. Attempts to Plagiarize

TBL also argues that attempts by others to plagiarize its boot show secondary meaning. And true, attempts to plagiarize a design can evince its distinctiveness. [cit]. But, under the law of secondary meaning, it matters why one imitates. Imitation of design features only to profit from the design's functionality does not establish secondary meaning. Imitation suggests secondary meaning only if it is intended to deceive consumers about the product's source. See *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 45 (1st Cir. 2001) (“[T]he relevant intent is not just the intent to copy, but to ‘pass off’ one’s goods as those of another.”); *Duraco*, 40 F.3d at 1453 (“[A]ttempts to copy a product configuration [may] not be probative [because] the copier may very well be exploiting a particularly desirable feature, rather than seeking to confuse consumers as to the source.”); . . . *Aromatique*, 28 F.3d at 871 (holding that it was clearly erroneous to infer secondary meaning from the copying of a product when the copier conspicuously used its own trademarks to distinguish its products); *Craft Smith, LLC v. EC Design, LLC*, 969 F.3d 1092, 1106 (10th Cir. 2020) (“[W]hen a competitor copies a product’s design, its purpose is not necessarily to confuse consumers, but to copy the aspects of that product that make it more functional.”); see also 2 *McCarthy* § 15:38 (“[E]vidence of copying must be accompanied by evidence that the copier’s intent was to confuse customers as to source or sponsorship and was not merely copying to replicate a useful product feature or to join in a market trend.”). But see *P & P Imps. LLC v. Johnson Enters., LLC*, 46 F.4th 953, 962 (9th Cir. 2022) (“Though some circuits have adopted ... an intent to confuse requirement, we have not done so.” (internal citation omitted)).⁹

Here, the district court declined to infer distinctiveness from the existence of boots resembling Timberlands. It concluded that TBL has not provided any evidence showing that its competitors sell similar looking boots intending to trick consumers into thinking their boots are Timberlands. In support of that conclusion, the court noted that TBL has not identified any ruling that competitors have infringed its alleged trade dress.

TBL responds that it persuaded two of its competitors to stop selling similar looking boots. But it never provided written documentation of those supposed enforcement efforts, even after the USPTO requested it. Though TBL asserts that it resolved those matters over the phone without documentation, TBL has not demonstrated that any of its competitors crossed the fine line that distinguishes emulating desirable product features from plagiarizing protected designs to confuse consumers about their source. Since TBL failed to produce evidence of intentional plagiarism, the district court did not clearly err in declining to infer distinctiveness from the mere existence of similar looking boots.

⁹ In our circuit, a plaintiff in an infringement case triggers a rebuttable presumption of secondary meaning by proving that “the defendant directly and intentionally copied its mark.” . . . But even this infringement framework focuses on the copier’s intent to confuse consumers about a product’s source. See *Osem Food Indus. Ltd. v. Sherwood Foods, Inc.*, 917 F.2d 161, 165 (4th Cir. 1990) . . .

6. Continuous and Exclusive Use

Instead, the district court found that the presence of similar looking boots from other manufacturers actually undermined TBL’s argument that its claimed design features are distinctive. The last factor suggests secondary meaning only if the continuous use of the design in commerce is also substantially exclusive. [cit]. The saturation of the market with look-alike boots,” to the district court, undercut TBL’s assertion of secondary meaning. TBL argues that the district court lent too much weight to those lookalikes.

TBL contends that the district court erred by considering competing designs without scrutinizing on a more granular level each design and its relative share of the U.S. boot market. It is true that courts sometimes have considered competitors’ minimal market shares to find that their competing marks did not weaken the commercial strength of a senior mark. See, e.g., . . . *Select Auto Imps. Inc. v. Yates Select Auto Sales, LLC*, 195 F. Supp. 3d 818, 833 (E.D. Va. 2016) (“Without evidence as to the extent of actual day-to-day use of [third-party] marks, the probative value of such evidence is minimal.”). But we have never required a deep dive into those details. See, e.g., *CareFirst of Md., Inc. v. First Care, P.C.*, 434 F.3d 263, 269–71 (4th Cir. 2006) (reasoning that third-party use of similar marks undermined commercial strength, without analyzing market share) . . . Nor have other circuit courts when there is evidence of significant third-party use.¹⁰ Even when the record “does not establish the exact extent,” widespread third-party use of substantially similar designs suggests the at-issue design lacks secondary meaning. *Echo Travel, Inc. v. Travel Assocs., Inc.*, 870 F.2d 1264, 1269 (7th Cir. 1989).

So, while TBL had every right to argue that the lookalike boots were not substantially similar and that their minimal sales did not preclude exclusivity, the district court was entitled to consider the countervailing evidence. And based on our review, the record is replete with pictures of boots marketed and sold in the United States that appear “substantially similar” to the design TBL sought to register, which suffices to prevent TBL from proving it exclusively used that design. See . . . *Converse, Inc. v. Int’l Trade Comm’n*, 909 F.3d 1110, 1122 (Fed. Cir. 2018) (ruling that evidence of the use of “substantially similar” but not identical trade dress may inform a secondary meaning analysis).

¹⁰ *Compare* . . . *Forney*, 835 F.3d at 1254 (holding that CEO’s testimony that Forney was the exclusive user of the trade dress was an insufficient showing of exclusive use to survive summary judgment, especially in light of “several pictures offered by [the defendant] showing product packages in the retail-metalworking sector that bear a close resemblance to Forney’s product packaging”); [and] *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373–74 (Fed. Cir. 2015) (“[E]xtensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.”), *with* *Scarves by Vera, Inc. v. Todo Imps. Ltd.*, 544 F.2d 1167, 1173 (2d Cir. 1976) (finding that evidence of third-party registrations was insufficient to weaken a trademark where “[d]efendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by consumers”); *Curtis-Stephens-Embry Co. v. Pro-Tek-Toe Skate Stop Co.*, 199 F.2d 407, 414 (8th Cir. 1952) (finding evidence of third-party trademark registrations insufficient to support a finding of invalidity where the registrations “did not show, and there was no effort made to prove, where they had been used (other than at the place of business), whether they were in use after the dates of the registrations or had been discontinued, or how exclusive their use had been”); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1537 (11th Cir. 1986) (“[T]hird party use of one or more suggestive or arbitrary elements of a plaintiff’s trade dress renders that trade dress indistinct only if the third party use is so extensive and so similar to the plaintiff’s that it impairs the ability of consumers to use the trade dress of the products to identify their source.”)

...

As the party seeking registration, TBL bore the “rigorous” burden of showing secondary meaning, including continuous and exclusive use. [cit]. To find TBL failed to discharge its burden, the district court was not required to assess the market shares of the myriad of lookalike boots. Nor was the district court obligated to run through each boot one-by-one and discuss how it resembled the applied-for TBL design. As a result, the district court did not clearly err in finding that TBL came up short of showing its use of the design was substantially exclusive.

To sum up our secondary meaning analysis, TBL had to show that the design features described in its application encourage consumers to buy the boot not because those features make the boot a solid product but because, to the public, those features make the boot a Timberland product. Since this distinctiveness concept is “intuitive” and “heavily fact-dependent,” “when a factfinder does make findings on this question ..., an appellate court will naturally be exceedingly reluctant to rule such findings clearly erroneous.” [cit]. Without a viable consumer survey, TBL lacks direct evidence of secondary meaning. Resorting to circumstantial evidence, TBL has not shown that its sales or advertising expenditures have translated into consumer recognition of the design elements it sought to register. Indeed, portrayals of TBL’s boot in marketing materials and the media tend to highlight features not claimed in TBL’s current application. The many similar looking products in the boot market do not show that competitors copied TBL’s design intending to confuse consumers. Rather, those lookalikes undermine TBL’s attempt to show that the design it sought to register has come to be “uniquely associated” with Timberland. [cit]. Assessing these various factors, the district court found that TBL failed to show that the combination of features it specified in its registration application—the outer ankle collar, the two-tone color and etching on the side of the boot’s sole, the hourglass rear heel panel, the quad stitching along the boot’s side and tongue area, the hexagonal eyelets for the boot’s laces and the boot’s bulbous toe box—leads consumers to associate the boot with Timberland alone. Since our review of the record does not leave us with “a definite and firm conviction that a mistake has been made,” we conclude that the district court did not clearly err in finding that the design TBL sought to register has not acquired secondary meaning.

PROBLEM 2-1: FRUITY PEBBLES

Post makes breakfast cereals. It seeks to register the mark pictured below for breakfast cereals:



Post stated in its application that “[t]he mark consists of the colors of yellow, green, light blue, purple, orange, red and pink applied to the entire surface of crisp cereal pieces. The broken lines depicting the shape of the crisp cereal pieces indicate placement of the mark on the crisp cereal pieces and are not part

of the mark.” The PTO is skeptical that the mark is a valid mark, given the prevalence of numerous cereals that have multicolor contents (consisting of puffed rice, balls, and ring shapes). How might the applicant revise its application to optimize its chances of ensuring validity?

At page 357, before the divider add the following:

On November 22, 2024, World Intellectual Property Organization (WIPO) member states adopted the Riyadh Design Law Treaty (“DLT”). Like the Hague Agreement, the DLT aims for procedural harmonization; it does not purport to establish substantive standards for design protection. It does require member countries to establish a minimum twelve-month grace period for filing an application after a disclosure or other triggering event—a requirement that is arguably substantive in nature. (As we will discuss, U.S. design patent law already includes a grace period.) It also requires members to allow multiple designs to be included in a single application filing for purposes of establishing a filing date, although it would still permit the relevant intellectual property office to divide such an application into multiple applications for purposes of examination. The DLT also requires members to accept representations of a design in a range of media, not limited to blackline drawings. This may prove to be important for digital designs. The DLT will come into force when at least fifteen parties have agreed to its terms.

Delete pages 411-434 and substitute the following:

2. Nonobviousness

Anticipation is not the only doctrine of patentability over the prior art. As the next set of materials indicates, a claimed design that is not anticipated by the prior art may nevertheless be unpatentable if it would have been obvious in view of the prior art. While an anticipation argument must be based on a single prior art reference, an obviousness argument can be based on a combination of prior art references, making it a potentially powerful check against patentability.

In utility patent cases, courts long ago developed the requirement that subject matter evidence some inventive variation over the prior art to be patentable. In 1952, Congress codified the requirement in the form of the nonobviousness condition for patentability. In its current incarnation, the nonobviousness provision reads as follows.

35 U.S.C. §103 Conditions for patentability: Non-obvious subject matter

(a) A patent for a claimed invention may not be obtained, notwithstanding that the invention is not identically disclosed or described as set forth in section 102 of this title, 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.

In utility patent cases, the courts developed a substantial jurisprudence applying the language of 35 U.S.C. §103. In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Court laid out a doctrinal framework

for analyzing the obviousness provision. According to the Court, obviousness should be assessed by undertaking a series of primary inquiries into:

- (1) scope and content of the prior art;
- (2) differences between the prior art and the claims at issue; and
- (3) level of ordinary skill in the pertinent art.

The Court also noted that inquiries into certain “secondary” considerations might be appropriate. For example, the fact that a commercial embodiment of the claimed invention has proven to be commercially successful might trigger an inference that the claimed invention would not have been obvious.

In deciding which prior art references fall into “the scope and content of the prior art” for obviousness purposes as specified in *Graham* factor #1, courts and the PTO generally start from the proposition that prior art references that qualify for use in an anticipation analysis also qualify for use in an obviousness analysis. However, in relatively rare instances, otherwise-qualifying prior art may be deemed “nonanalogous” and thus not usable in an obviousness challenge. If a reference (1) falls within the patentee’s field of endeavor, or (2) is reasonably pertinent to the problem that the patentee seeks to solve, it is deemed analogous for obviousness purposes in a utility patent case. *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992).

The analysis of both *Graham* factors #1 and #2 can be complicated in many cases because, unlike anticipation challenges, most obviousness challenges involve combinations of prior art references. In utility patent cases, one major concern about this exercise of combining references is that many inventions look simple in hindsight. Consider, for example, a utility patent claiming a pencil with an attached eraser. Suppose that pencils were known in the prior art, as were erasers, but no prior art reference discloses the combination. The combination is novel, but is it nonobvious? It might be tempting to say no, but is this only because *after* one sees the combination, it seems simply the product of routine mechanical skill rather than invention? That is, with the benefit of hindsight, a judge (or a patent examiner) may be tempted to hunt through the prior art references, extracting relevant teachings and hypothesizing that a person of ordinary skill in the art would have combined them to achieve the claimed invention. Spurred in part by this concern over hindsight bias, the Federal Circuit elaborated a requirement that the obviousness proponent prove not only that the relevant disclosures existed in the various references, but also that there existed some teaching, suggestion, or motivation for combining those disclosures. *See, e.g., Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1323-24 (Fed. Cir. 1999). In *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), a utility patent case, the Court reversed the Federal Circuit’s application of the teaching/suggestion/motivation test, and warned that to the extent that the test had become a “[r]igid preventative rule” that “den[ied] fact finders recourse to common sense,” it was an inappropriate response to fears of hindsight bias, and inconsistent with the law of obviousness. According to the Court, the Federal Circuit had committed several errors in its jurisprudence on the teaching/suggestion/motivation test, including: (1) focusing only on the problem that the inventor was attempting to solve, rather than considering any need or problem known to those of skill in the pertinent art; and (2) assuming that a person of ordinary skill seeking to solve a problem would be led only to those elements of the prior art directed at solving the same problem. The challenge of applying obviousness tests with the requisite flexibility has occupied courts in the years following *KSR*, to the present.

As difficult as it has been for courts and the PTO to apply the obviousness criterion to utility patents, it has been even more challenging for design patents. The design patent provisions came into being before

the obviousness criterion had fully crystallized in patent law. The criterion gradually began to appear in utility patent cases, and, eventually, carried over into design patent cases. For the leading study on this topic, see Jason J. Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 GONZ. L. REV. 531 (2009).

In a string of cases decided starting in the 1950s and continuing into the early 1980s (when the Federal Circuit was created), the CCPA attempted to lay down rules that would permit the nonobviousness criterion to be applied to designs, while minimizing the risk that nonobviousness analyses would become exercises in reconstructing designs in hindsight. In *Jennings*, the CCPA aired just such a concern. The claimed design had been rejected in view of five utility patents, evidently on the ground that individual features could be extracted from each of the prior art references and combined to formulate a design closely resembling the claimed design. The court rejected this approach, demanding instead that the claimed design must be “compared with something in existence- not with something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would require modification of every individual feature, as would be required here.” *In re Jennings*, 182 F.2d 207, 208 (C.C.P.A. 1950).

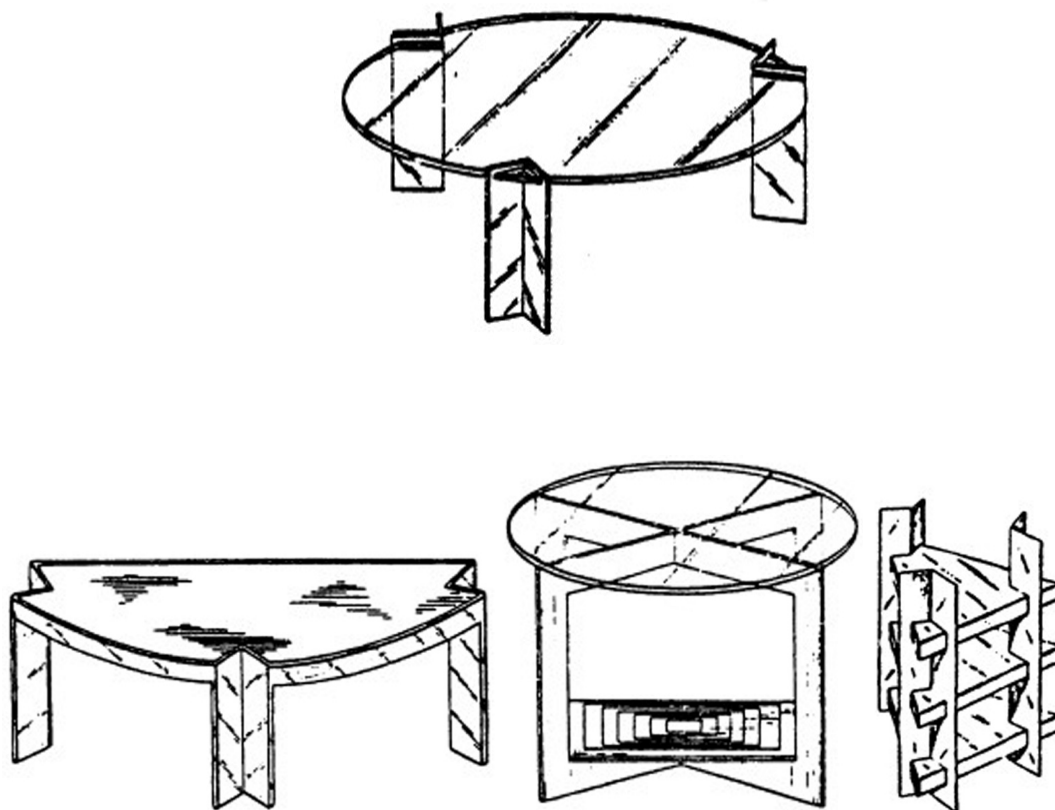
In *Glavas*, the claimed design was for a life preserver having a generally rectangular form with rounded corners and edges and concave surfaces. *In re Glavas*, 203 F.2d 447, 448 (C.C.P.A. 1956). The rejection had been based on a prior art reference disclosing a life preserver, taken in view of any of a variety of secondary references – disclosing, respectively, a pillow, bottles, a razor blade sharpener, and a bar of soap, each of which was generally rectangular in shape with concave surfaces. This reasoning seemed to reflect a view that any reference was analogous (and therefore usable as part of an obviousness combination) for designs. In *Glavas*, the C.C.P.A. pushed back against this view. The court found it evident that, at least for designs for product shapes, “a worker seeking ideas for improving the appearance of a device would look first to the similar devices of the prior art for ideas,” *id.* at 451. The court seemed to conclude that a designer of life preservers might consider designs for pillows but would not look to designs of products that would not ordinarily be adapted to serve as life preservers, such as razor sharpeners or bars of soap. *Id.* More generally, according to *Glavas*, the non-analogous art limitation could not be applied to design cases “in exactly the same manner as to mechanical cases,” given that “[t]he question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Id.* at 450.

In *Nalbandian*, after a vigorous debate, the Court of Customs and Patent Appeals ruled (in a split decision) that obviousness for design patents was to be undertaken from the perspective of the designer of ordinary skill, not the ordinary observer. *In re Nalbandian*, 661 F.2d 1214 (C.C.P.A. 1981).

The court drew on several of the foregoing ideas in *In re Rosen*, 673 F.2d 388 (C.C.P.A. 1982). Invoking *Jennings*, the court declared 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. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references.” *Id.* at 391. Invoking *Glavas*, the court asserted that “the long-standing test for the proper combination of references” in an obviousness challenge involving designs “has been ‘whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.’” *Id.*, quoting *Glavas*, 230 F.2d at 450.

The court in *Rosen* did not mention the perils of hindsight explicitly, but did seem motivated by a concern about obviousness challenges that amounted to little more than unconstrained regrouping of design elements from disparate prior art references to arrive at the claimed design. The PTO had argued that Rosen’s claimed design for a contemporary table was rendered obvious by combining the legs from the Rosen desk prior art reference, with the circular top from the Hysten table reference, by way of a slot disclosed in the Klein reference (directed to a design for a display stand). (The claimed design is shown as Fig. 1 below. The three prior art references, respectively, are shown left to right below the drawing of the claimed design.)

FIG. 1



The court concluded that the Rosen desk design could not satisfy the test for qualifying as a “basic” reference embodying similar design concepts as the claimed design. The modifications of that reference necessary to achieve the claimed design would “destroy the fundamental characteristics” of the prior art design. *Rosen*, 672 F.2d at 391. Hence, the court stated that it did not need to reach the question of whether “modifications of the Rosen [prior art design] are suggested by the [other] cited prior art.” *Id.*

The Federal Circuit restated the CCPA design patent obviousness decisions in the form of a two-part test, which came to be known as the *Rosen-Durling* test. *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100 (Fed. Cir. 1996). The first part required that there be a single reference, “the design characteristics of which are basically the same as the claimed design.” *Durling*, 101 F.3d at 103 (quoting *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982)). The second part provided that if such a primary prior art reference

was found, other secondary prior art references could be combined with the primary reference to provide the basis for an obviousness argument, but only if the secondary references were “so related” to the primary reference “that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Durling*, 101 F.3d at 103 (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

While designs were not the only subject matter subjected to a specialized test for obviousness, it seemed evident in the wake of *KSR* that the very existence of the *Rosen-Durling* test would invite arguments that the Federal Circuit was acting with inappropriate rigidity by relying on the test. The issue eventually came before the en banc Federal Circuit, resulting in the following decision.

LKQ CORP. v. GM GLOBAL TECHNOLOGY OPERATIONS LLC
102 F.4th 1280 (Fed. Cir. 2024) (en banc)

STOLL, Circuit Judge:







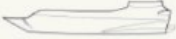





This case involves the standards for assessing nonobviousness of design patents under 35 U.S.C. § 103.

The principal question that this case presents is whether Supreme Court precedent, including *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), should cause us to rethink the long-standing *Rosen-Durling* test used to assess nonobviousness of design patents. We answer in the affirmative and overrule the *Rosen-Durling* test requirements that the primary reference must be “basically the same” as the challenged design claim and that any secondary references must be “so related” to the primary reference that features in one would suggest application of those features to the other. We adopt an approach consistent with Congress’s statutory scheme for design patents, which provides that the same conditions for patentability that apply to utility patents apply to design patents, as well as Supreme Court precedent which suggests a more flexible approach than the *Rosen-Durling* test for determining nonobviousness.

BACKGROUND

GM Global Technology LLC (“GM”) owns U.S. Design Patent No. D797,625, which claims a design for a vehicle’s front fender. This design is used in GM’s 2018–2020 Chevrolet Equinox.

Appellants LKQ Corporation and Keystone Automotive Industries, Inc. (collectively “LKQ”) filed a petition to institute an inter partes review of GM’s D’625 patent, asserting that the challenged claim is unpatentable under 35 U.S.C. § 102 based on U.S. Design Patent No. D773,340 (“Lian”) or under 35 U.S.C. § 103 based on Lian alone or Lian as modified by a promotional brochure depicting the design of the front fender on the 2010 Hyundai Tucson (“Tucson”). LKQ presented the following comparisons between the D’625 patent, Lian, and Tucson:

'625 PATENT CLAIMED DESIGN	LIAN PRIMARY REFERENCE	TUCSON SECONDARY REFERENCE
 <p data-bbox="456 537 634 562">Appx0063, FIG. 2</p>	 <p data-bbox="712 527 909 575">Appx0450, FIG. 4 (cropped, annotated)</p>	 <p data-bbox="979 527 1175 575">Appx0464 (cropped, rotated)</p>
 <p data-bbox="456 779 634 804">Appx0064, FIG. 3</p>	 <p data-bbox="712 768 909 816">Appx0449, FIG. 1 (cropped, annotated)</p>	 <p data-bbox="979 768 1175 816">Appx0462 (cropped, flipped)</p>
 <p data-bbox="456 1020 634 1045">Appx0064, FIG. 4</p>	 <p data-bbox="712 1010 909 1058">Appx0451, FIG. 5 (cropped, annotated)</p>	 <p data-bbox="979 1010 1175 1058">Appx0462 (cropped, flipped)</p>
 <p data-bbox="456 1251 634 1276">Appx0063, FIG. 1</p>	 <p data-bbox="712 1241 909 1289">Appx0452, FIG. 6 (cropped, annotated)</p>	 <p data-bbox="979 1241 1175 1289">Appx0453 (cropped, flipped)</p>

Figures 1–4 of the D’625 patent illustrate the claimed front fender from a perspective view, a side view, a front view, and a top view, respectively.

The Board held that LKQ had not established by a preponderance of evidence that Lian anticipates the claim of the D’625 patent. ... The Board found that while “there are certain articulable and visible similarities in the overall appearance of the claimed design and Lian that would be apparent to an ordinary observer,” differences between the designs, including (1) the wheel arch shape and the terminus; (2) door cut line; (3) protrusion; (4) sculpting; (5) inflection line; (6) the first and second creases; and (7) the concavity line, affect the overall visual impression of each design such that they are not substantially the same.

The Board then applied the long-standing *Rosen-Durling* test to assess the nonobviousness of the claimed design. Under this two-part test, first, *In re Rosen* requires that “[b]efore one can begin to combine prior art designs ... one must find a single reference, ‘a something in existence, the design characteristics of which are basically the same as the claimed design.’” *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (quoting *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982)). This primary reference

is commonly referred to as the *Rosen* reference. As the Board explained, *Rosen*'s "basically the same" test requires consideration of the visual impression created by the patented design as a whole. *Rosen*, 673 F.2d at 391. If no *Rosen* reference is found, the obviousness inquiry ends without consideration of step two. *Durling*, 101 F.3d at 105 ("Without such a primary reference, it is improper to invalidate a design patent on grounds of obviousness.").

At step two, *Durling* requires that "[o]nce this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design." *Id.* at 103. But another threshold must be met. Specifically, any secondary references 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." *Id.* (alteration in original) (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

In this case, the Board determined that LKQ failed to establish that the challenged claim would have been obvious because LKQ failed to identify a *Rosen* reference. LKQ had proffered Lian as its *Rosen* reference. Identifying the same differences it emphasized with regard to anticipation, the Board found that Lian differs from the claimed design in "the upper protrusion, the u-shaped notch, the door cut line, a circular wheel arch, the lower rear terminus, ... first and second creases along with the concavity line, and the inflection line." Considering these differences together, the Board found that Lian does not "create[] 'basically the same' visual impression" as the patented design. Accordingly, the Board ended its obviousness analysis without further consideration.

LKQ appealed, and a panel of this court affirmed the Board decision [concluding that substantial evidence supported the Board's finding that the Lian reference did not anticipate the claimed design, and the determination that Lian did not qualify as a *Rosen* reference. LKQ sought rehearing en banc, arguing that the *Rosen/Durling* test was incompatible with *KSR*.]

This court granted rehearing en banc and vacated the panel opinion. *See LKQ Corp. v. GM Glob. Tech. Operations LLC*, 71 F.4th 1383, 1384 (Fed. Cir. 2023). Among other questions, our order requested briefing on: (1) whether *KSR* overrules or abrogates the *Rosen-Durling* test; (2) if not, whether the court should nonetheless eliminate or modify the *Rosen-Durling* test; and (3) if we answer either of these two questions affirmatively, what test should apply for evaluating design patent obviousness challenges. *Id.* at 1384–85. We reinstate the portion of the panel opinion holding that substantial evidence supports the Board's finding of no anticipation. The panel decision remains vacated in all other respects. We vacate the final written decision of the Board as to the nonobviousness determination and remand for further proceedings consistent with this opinion.

DISCUSSION

I

A design patent protects a "new, original and ornamental design for an article of manufacture." 35 U.S.C. § 171(a). Under the Patent Act, the statutory provisions "relating to patents for inventions," or utility patents, "shall apply to patents for designs, except as otherwise provided." *Id.* § 171(b). Our discussion of nonobviousness of a design or utility patent claim should start with the statutory language of § 103...

The Supreme Court addressed the meaning of the statute in *Graham v. John Deere Co. of Kansas City*, which involved utility patents. 383 U.S. 1 (1966). The Court in *Graham* explained that the ultimate question of obviousness is one of law based on “several basic factual inquiries.” *Id.* at 17. The Court elaborated that under § 103, these factual inquiries include “the scope and content of the prior art”; “differences between the prior art and the claims at issue”; and “the level of ordinary skill in the pertinent art.” *Id.* In addition to these factors, “[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented” and may be relevant as “indicia of obviousness or nonobviousness.” *Id.* at 17–18. The ultimate question is whether differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious to a person of ordinary skill in the pertinent art at the time of the invention.

More recently, the Supreme Court again addressed the standards for assessing nonobviousness in *KSR*, 550 U.S. 398. There, the district court had held Teleflex’s utility patent claim obvious based on its findings that (1) a first prior art reference taught every limitation of the claim except one; (2) this missing aspect was taught in two other prior art references; and (3) a person of ordinary skill in the art would have been motivated to modify the first prior art reference to include the missing aspect taught by the secondary prior art references. *Id.* at 413. The Supreme Court in *KSR* specifically addressed the “teaching, suggestion, or motivation” or “TSM” test recited in our precedent, under which a patent claim was only proved obvious if “some motivation or suggestion to combine the prior art teachings” existed in “the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art.” *Id.* at 407. We had previously applied the TSM test to prevent factfinders from falling victim to hindsight bias in determining whether there was a reason to combine prior art references to arrive at the claimed invention. *Id.* at 421.

The Supreme Court rejected our rigid application of the TSM test in the case before it. The Court explained that *Graham* “set forth an expansive and flexible approach inconsistent with the way the Court of Appeals applied its TSM test here.” *Id.* at 415. The Court reasoned that while factfinders should guard against hindsight, “[r]igid preventative rules that deny factfinders recourse to common sense” are improper under § 103. *Id.* at 421. The Court further explained that a person of ordinary skill in the art could find a motivation to combine prior art references in ways other than meeting the TSM test as rigidly applied. The Court noted, for example, that design incentives and market forces could be a reason to apply an invention from one field into another, and that a patent claim might be proved obvious with a showing that it would have been “obvious to try” a “finite number of identified, predictable solutions” to a problem where there is “a design need or market pressure to solve.” *Id.* at 417, 421. The Court explained that while the TSM test might provide helpful insight on the obviousness of an invention, such insights “need not become rigid and mandatory formulas” as the “obviousness analysis cannot be confined by a formalistic conception.” *Id.* at 419.

II

The Supreme Court has also addressed the validity of design patent claims in view of combined prior art designs. Most notably, in *Smith v. Whitman Saddle Co.*, the Supreme Court considered whether a design patent claim directed to an ornamental design for a saddle was patentable in view of the combination of two prior art saddles, known as the Granger tree and the Jenifer or Jenifer-McClellan tree. 148 U.S. 674,

680 (1893).² Comparing the claimed saddle design to the prior art, the Court explained that:

The saddle design described in the [patent] specification differs from the Granger saddle in the substitution of the Jenifer cantle [raised rear part] for the low, broad cantle of the Granger tree. In other words, the front half of the Granger and the rear half of the Jenifer, or Jenifer-McClellan, make up the saddle in question, though it differs also from the Granger saddle in that it has a nearly perpendicular drop of some inches at the rear of the pommel [upper front part], that is, distinctly more of a drop than the Granger saddle had.

Id. In this way, the Supreme Court explained that the claimed design was made up of the front half of one known saddle and the back half (or cantle) of another, with a further modification to one half. The Supreme Court explained that the record evidence showed that there were several hundred types of saddles, “and that it was customary for saddlers to vary the shape and appearance of saddletrees [saddle frames] in numerous ways, according to the taste and fancy of the purchaser.” *Id.* at 681. Addressing the combination of the Granger and Jenifer saddles, the Court determined that “[n]othing more was done in this instance (except as hereafter noted) 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,” and that “the addition of a known cantle to a known saddle, in view of the fact that such use of the cantle was common,” did not make the claimed saddle design inventive. *Id.*

The Court then turned to the primary “difference between the pommel of [the claimed] saddle [design] and the pommel of the Granger saddle, namely, the drop at the rear of the pommel.” *Id.* The Court withheld judgment on the validity of the overall design given this secondary difference in design. Rather, the Court held that if this secondary difference was “what was new and to be material,” it was not present in the potentially infringing saddle, and as such, no infringement could occur. *Id.* at 682.

In short, the Court considered the prior art in the field of the article of manufacture, the knowledge of an ordinary saddler, and the differences between the prior art and the claimed design, and concluded that combining the two known saddle designs was nothing more than an “exercise of the ordinary skill of workmen of the [saddle] trade.” *Id.* at 681. The Court refrained from drawing the same conclusion for a secondary modification without evidence that it was known in the prior art or similar to the existing prior art references.

III

Our test for design patent obviousness, in its present form, does not adequately align with *KSR*, *Whitman Saddle*, and other precedent, both in terms of its framework and threshold rigidity. *Rosen-Durling* is out of keeping with the Supreme Court’s general articulation of the principles underlying obviousness, as well as its specific treatment of validity of design patents.

...

The en banc court has never considered the merits of the *Rosen-Durling* test, and we now take this

² At the time, patent law did not speak of obviousness. The *Whitman Saddle* Court addressed the matter by reference to “the inventive faculty.” 148 U.S. at 679. The reasoning of *Whitman Saddle* carries over to the modern § 103 standard of obviousness.

opportunity, sitting en banc, to do so in light of § 103, Supreme Court precedent, and our own precedent guiding the nonobviousness inquiry for utility patents. We do so bearing in mind the respect due to long-standing panel precedents even when the en banc court is newly considering an issue. *See Robert Bosch, LLC v. Pylon Mfg. Corp.*, 719 F.3d 1305, 1316–17 (Fed. Cir. 2013) (en banc).

We conclude that the *Rosen-Durling* test requirements—that (1) the primary reference be “basically the same” as the challenged design claim; and (2) any secondary references be “so related” to the primary reference that features in one would suggest application of those features to the other—are improperly rigid. The statutory rubric along with Supreme Court precedent including *Whitman Saddle*, *Graham*, and *KSR*, all suggest a more flexible approach than the *Rosen-Durling* test when determining obviousness.

1

Design patents and utility patents are, of course, different. Nevertheless, “[d]esign patents, like utility patents, must meet the nonobviousness requirement of 35 U.S.C. § 103.” *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1380, 1384–85 (Fed. Cir. 2009); *see also* 35 U.S.C. § 171(b) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”).

The § 103 obviousness language sets forth an expansive and flexible approach for assessing obviousness, involving assessment of the “differences between the claimed invention and the prior art” and whether those differences are such that the invention as a whole would have been obvious to a person of ordinary skill in the field to which the claimed design pertains. *Rosen*’s rigid requirement limiting a primary reference to designs that are “basically the same” as the claimed design—and abruptly ending the analysis in the absence of such a reference—imposes limitations absent from § 103’s broad and flexible standard.

The *Rosen* “basically the same” requirement is also inconsistent with the Supreme Court’s analysis in *Whitman Saddle*. There, the Court did not ask whether the design of the prior art Granger saddle was “basically the same” as the claimed saddle design. Instead, the Supreme Court acknowledged that the claimed design combined the front half of Granger with the rear half of Jenifer, 148 U.S. at 680, suggesting that neither Granger nor Jenifer would qualify as a *Rosen* reference. Moreover, even though neither prior art saddle design was “basically the same” as the claimed design, the Supreme Court continued its analysis and held that combining the front half of the Granger saddle with the back half of the Jenifer saddle was not inventive because it was “customary for saddlers” to make such combinations. *Id.* at 681. This analysis reflects the reality that the one-size-fits all approach of *Rosen*—in which a single primary reference discloses nearly every aspect of the claimed design—does not fit all obviousness scenarios for designs and cannot be reconciled with Supreme Court precedent.

Indeed, as the Supreme Court explained in *KSR*, “when a court transforms [a] general principle into a rigid rule that limits the obviousness inquiry, ... it errs.” *KSR*, 550 U.S. at 419. The Court in *KSR* emphasized that both § 103 and *Graham* “set forth an expansive and flexible approach” to obviousness and reiterated “the need for caution in granting a patent based on the combination of elements found in the prior art.” *Id.* at 415. Continuing, the Court explained, “[r]igid, preventative rules that deny factfinders recourse to common sense, ... are neither necessary under our case law nor consistent with it.” *Id.* at 421. Because the strict *Rosen* reference requirement—in which an obviousness analysis fails absent a prior art design that is “basically the same” as the claimed design—is such a rigid rule, we conclude that it is inconsistent with

the Supreme Court’s general guidance in *KSR*.

2

We reach the same conclusion for step two of the *Rosen-Durling* test. Under step two, a fact finder may consider ornamental features missing in a primary reference but shown in secondary reference(s) only when the secondary reference(s) 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.” *Durling*, 101 F.3d at 103 (alterations omitted) (quoting *Borden*, 90 F.3d at 1575). Like the *Rosen* reference requirement, this “so related” requirement is at odds with the broad standard for obviousness set forth in § 103 and Supreme Court precedent.

First, § 103 requires consideration of the differences between the claimed design and prior art designs and an inquiry into whether those differences would have been obvious to a person of ordinary skill in the relevant field. When the answer to this question is affirmative, the statute provides that a patent may not be obtained. The statute gives no indication that a secondary prior art reference need be “so related” to the primary that—as the *Durling* test is too readily understood to demand—it creates its own motivation to combine the two prior art references.

We agree with LKQ that *Durling*’s inflexible “so related” requirement is analogous to the rigid application of the teaching-suggestion-motivation test rejected by the Supreme Court in *KSR*. Just as the Supreme Court in *KSR* explained that the TSM test had sometimes been applied as if it had evolved from a useful insight to a rigid rule, the *Durling* “so related” requirement has evolved into a rigid rule that limits the broad standard set forth in § 103 and “den[ies] factfinders recourse to common sense” when assessing a motivation to combine prior art references. *KSR*, 550 U.S. at 421.

The *Durling* so-related test is also inconsistent with the Supreme Court’s decision in *Whitman Saddle*. There, in considering a claimed design that essentially combined the front half of the Granger saddle with the rear half (specifically, the cantle) of the Jenifer saddle, the Supreme Court did not ask whether the Granger and Jenifer references were “so related” that the use of certain ornamental features in one would suggest the application of those features to the other. *Whitman Saddle*, 148 U.S. at 680–81. Rather, in a manner consistent with the *Graham* framework for assessing obviousness of utility patents, the Supreme Court explained that it was not inventive for a saddler to combine the front half of Granger with the cantle of Jenifer because record evidence established that “it was customary for saddlers to vary the shape and appearance of saddletrees in numerous ways, according to the taste and fancy of the purchaser” and “the Jenifer cantle was used upon a variety of saddles.” *Id.* at 681. The Court reasoned that, based on this evidence, “[n]othing more was done in this instance (except as hereafter noted) 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.* Continuing, the Court explained the “addition of a known cantle to a known saddle,” was not inventive “in view of the fact that such use of the cantle was common.” *Id.* The Court thus relied on the knowledge and practice of a saddler or ordinary workman of the trade instead of a “so related” requirement to combine prior art references. *Id.*

IV

25

Having overruled *Rosen* and *Durling*, we consider what the framework for evaluating obviousness of design patent claims should be. We are guided by the language of § 103, as well as the Supreme Court’s and our court’s precedent on obviousness in both the design and utility patent contexts. We are also mindful of the differences between design and utility patents, as well as the policy concerns emphasized by the parties and amici. Ultimately, we agree with our precedent holding that “[i]nvalidity based on obviousness of a patented design is determined [based] on factual criteria similar to those that have been developed as analytical tools for reviewing the validity of a utility patent under § 103, that is, on application of the *Graham* factors.” *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1462 (Fed. Cir. 1997).

1

Applying *Graham* factor one, the fact finder should consider the “scope and content of the prior art” within the knowledge of an ordinary designer in the field of the design. *See Graham*, 383 U.S. at 17. In determining the scope of the prior art, there is no threshold similarity or “basically the same” requirement to qualify as prior art. Rather, an analogous art requirement applies to each reference. The analogous art requirement reins in the scope of prior art and serves to guard against hindsight. We reaffirm that an analogous art requirement applies for obviousness of design patents.

We have stated that a “reference qualifies as prior art for an obviousness determination only when it is analogous to the claimed invention.” *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1379 (Fed. Cir. 2019) (citing *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011)). The analogous art requirement is tied to the statutory language of § 103 in that it provides the perspective of the person of ordinary skill in the art by defining that person’s scope of knowledge. The rationale is that a person of ordinary skill “could not possibly be aware of every teaching in every art” and thus we limit the scope of the prior art to analogous arts. *See Airbus*, 941 F.3d at 1381–82 (quoting *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979)). The analogous art requirement is also “meant to defend against hindsight.” *See Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1358 (Fed. Cir. 2023) (quoting *Kahn*, 441 F.3d at 987); *see also In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (“The combination of elements from non-analogous sources, in a manner that reconstructs the applicant’s invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness.”).

An important precedent that preceded adoption of the *Rosen-Durling* test, and introduced the “so related” phrase, supports application of an analogous art requirement to design patents. In *In re Glavas*, 230 F.2d 447 (CCPA 1956), the patent at issue related to the ornamental design for a float (e.g., a life preserver) and the Board affirmed a final rejection of the patent based on a patent relating to a float in view of patents relating to a cushion and a pillow. The Board added an additional ground for rejection based on other secondary references—patents relating to bottles, a razor blade sharpener, and a bar of soap. On appeal, the court grappled with whether the analogous art requirement for utility patents applies to obviousness of design patents. Ultimately, the court concluded that “[t]he principle of nonanalogous arts ... cannot be applied to design cases in exactly the same manner as to mechanical cases,” because design patent combinations rely on appearance rather than use. *Glavas*, 230 F.2d at 450. In the very next sentence, the *Glavas* court then created the “so-related” requirement for design cases: “The question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Id.* In applying the “so related” test, the court addressed the analogous art issue by noting that while pillows may plausibly be related art to a float, a designer of a float

would not likely turn to bottles, soap, or razor blade sharpeners for design inspiration. *Id.* at 450–51.

Glavas thus created the “so related” test as a design-context proxy or replacement for the analogous art requirement of utility cases. Unfortunately, application of the *Rosen-Durling* test over time has become rigid to the point where we abandon it today. But there is no basis for abandoning the underlying analogous art requirement for assessing nonobviousness of design patents and we return to a more flexible fact-based analysis of whether the references are analogous art in a manner similar to utility patents. This approach casts aside a threshold “so-related” requirement but maintains the threshold analogous art requirement.

For utility patents, we use a two-part test to determine the scope of analogous art: (1) whether the art is from the same field of endeavor as the claimed invention; and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *See Airbus S.A.S*, 941 F.3d at 1379. This is a fact-dependent inquiry that requires a case-by-case determination. [cit.]

We conclude that the first part of this two-part test applies to design patents in a straightforward manner. In other words, analogous art for a design patent includes art from the same field of endeavor as the article of manufacture of the claimed design. *See* 35 U.S.C. § 171(a) (“Whoever invents any new, original and ornamental design *for an article of manufacture* may obtain a patent therefor” (emphasis added)). As we have previously held, “[t]he scope of the prior art is not the universe of abstract design and artistic creativity, but designs of the same article of manufacture or of articles sufficiently similar that a person of ordinary skill would look to such articles for their designs.” *Hupp*, 122 F.3d at 1462.

On the other hand, the second part of the two-part analogous art test for utility patents would not seem to apply to design patents in the same way, and how to translate this part of the test into the design context is less apparent. Unlike a utility patent, a design patent itself does not clearly or reliably indicate “the particular problem with which *the inventor* is involved.” *See Airbus S.A.S*, 941 F.3d at 1379 (emphasis added). Indeed, design patents have no written description or written claims to define their scope; the invention is defined by the overall visual impression that the drawings convey. *See Egyptian Goddess, Inc. v. Swisa Inc.*, 543 F.3d 665, 679–80 (Fed. Cir. 2008) (en banc) (a design claim is better represented by an illustration). Moreover, at oral argument, the parties disputed whether an ornamental design for an article of manufacture could be viewed as solving a problem.

In this opinion, we do not delineate the full and precise contours of the analogous art test for design patents. Prior art designs for the same field of endeavor as the article of manufacture will be analogous, and we do not foreclose that other art could also be analogous. Whether a prior art design is analogous to the claimed design for an article of manufacture is a fact question to be addressed on a case-by-case basis and we “leave it to future cases to further develop the application of this standard.” *Cf. Egyptian Goddess*, 543 F.3d at 679 (quoting *In re Seagate Tech., LLC*, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (en banc)).

In applying *Graham* factor one, the scope and content of the prior art, a primary reference must be identified. Identifying a primary reference protects against hindsight because “almost every new design is made up of elements which, individually, are old somewhere in the prior art.” *Glavas*, 230 F.2d at 450. As noted above, this primary reference need not be “basically the same” as the claimed design. Rather, the primary reference need only be “something in existence—not ... something that might be brought into existence by selecting individual features from prior art and combining them, particularly where

combining them would require modification of every individual feature.” *In re Jennings*, 182 F.2d 207, 208 (CCPA 1950). The primary reference will likely be the closest prior art, i.e., the prior art design that is most visually similar to the claimed design. The more visually similar the primary reference design is to the claimed design, the better positioned the patent challenger will be to prove its § 103 case. The primary reference will typically be in the same field of endeavor as the claimed ornamental design’s article of manufacture, but it need not be, so long as it is analogous art. It is often the case that the primary reference alone does not render the claimed design obvious, and design elements from secondary prior art references may be considered as discussed below.

2

After considering the scope and content of the prior art, we turn to *Graham* factor two: determining the differences between the prior art designs and the design claim at issue. *Graham*, 383 U.S. at 17. This approach casts aside a threshold “similarity” requirement.

The Supreme Court has explained that design patents protect the appearance of the design on an article of manufacture, and thus, in the context of design patent infringement, we compare the visual appearance of the claimed design with that of allegedly infringing design. *See Gorham*, 81 U.S. at 526–27 (“[T]he true test of identity of design ... must be sameness of appearance”); *see also Egyptian Goddess*, 543 F.3d at 676 (focusing on the “overall appearance of the design” when assessing infringement). Likewise, in addressing the differences between the claimed design and prior art designs for validity purposes, we compare the visual appearance of the claimed design with prior art designs, albeit from the perspective of an ordinary designer in the field of the article of manufacture. *See Apple, Inc. v. Samsung Electcs., Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012) (characterizing obviousness as whether “one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design”) (quoting *Titan Tire*, 566 F.3d at 1381); *Borden*, 90 F.3d at 1574, 1576 (affirming the Board’s affirmance of an obviousness rejection where the examiner found “differences between the [prior art] and appellant’s design had little or no effect on the overall appearance of the design”); *Dobson v. Dornan*, 118 U.S. 10, 15 (1886) (“Undoubtedly, the claim in this case covers the design as a whole, and not any part of it as a part, and it is to be tested as a whole as to novelty and infringement.”).

3

Under *Graham* factor three, “the level of ordinary skill in the pertinent art [must be] resolved.” *Graham*, 383 U.S. at 17. This requirement comes directly from § 103, which provides that a claimed invention is unpatentable if it “would have been obvious before the effective filing date of the claimed invention to a person of ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103.

In the design patent context, we have interpreted “a person of ordinary skill in the art to which the invention pertains” in § 103 as meaning that obviousness of a design patent claim is assessed from the viewpoint of an ordinary designer in the field to which the claimed design pertains. In *In re Nalbandian*, our predecessor court explained that, consistent with *Graham*, “[i]n design cases we will consider the fictitious person identified in § 103 as ‘one of ordinary skill in the art’ to be the designer of ordinary capability who designs articles of the type presented in the application.” 661 F.2d 1214, 1216 (CCPA 1981). In other words, for *Graham* factor three, we consider the knowledge of “a designer of ordinary

skill who designs articles of the type involved.” *Borden*, 90 F.3d at 1574 (citation omitted); *Hupp*, 122 F.3d at 1462 (“The determination of the ultimate question of obviousness is made from the viewpoint of a person of ordinary skill in the field of the patented design.”); *Whitman Saddle*, 148 U.S. at 681 (determining patentability from the perspective of “the ordinary skill of workmen of the trade” and an ordinary “saddler”).

4

After ascertaining the knowledge of an ordinary designer in the relevant field, the scope and content of the prior art, and the differences between the prior art and the claimed design, the obviousness or nonobviousness of the claimed design is evaluated. We have previously described this inquiry as whether 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.” *Campbell Soup, Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021) (citation and quotation marks omitted); *see also Borden*, 90 F.3d at 1574. We reaffirm that the “inquiry focuses on the visual impression of the claimed design as a whole and not on selected individual features.” *Borden*, 90 F.3d at 1574.

Where a primary reference alone does not render the claimed design obvious, secondary references may be considered. The primary and secondary references need not be “so related” such that features in one would suggest application of those features in the other but they must both be analogous art to the patented design. Consistent with *KSR*, the motivation to combine these references need not come from the references themselves. *KSR*, 550 U.S. at 418–19 (rejecting a rigidly applied TSM test). But there must be some record-supported reason (without hindsight) that an ordinary designer in the field of the article of manufacture would have modified the primary reference with the feature(s) from the secondary reference(s) to create the same overall appearance as the claimed design. *See Campbell Soup*, 10 F.4th at 1275 (discussing the question of whether “an ordinary designer would have modified the primary reference to create a design that has the same overall visual appearance as the claimed design”); *see also Amicus United States Br.* at 12–13 (describing factors to consider including “ordinarily skilled designer’s experience, creativity,” as well as “what market demands and industry customs exist” in the relevant field and, “which ornamental features are commonplace in the relevant field”). Just as with the analogous art inquiry, in the area of motivation to combine, the problem to be solved may have less relevance in the design patent context than in the utility patent context. Of course, it follows that the more different the overall appearances of the primary reference versus the secondary reference(s), the more work a patent challenger will likely need to do to establish a motivation to alter the primary prior art design in light of the secondary one and demonstrate obviousness without the aid of hindsight.

5

Consistent with *Graham*, the obviousness inquiry for design patents still requires assessment of secondary considerations as indicia of obviousness or nonobviousness, when evidence of such considerations is presented. *Graham*, 383 U.S. at 17–18 (“Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”). In prior cases involving design patents, we have confirmed that commercial success, industry praise, and copying may demonstrate nonobviousness of design patents. *Campbell Soup*, 10 F.4th at 1276–79 (considering evidence of commercial success,

industry praise, and copying); *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1335–36 (Fed. Cir. 2014) (same). We do not disturb our existing precedent regarding the application of secondary considerations such as commercial success, industry praise, and copying to the obviousness analysis in design patents. It is unclear whether certain other factors such as long felt but unsolved needs and failure of others apply in the design patent context. We leave to future cases the determination of whether considerations such as long felt but unsolved need and failure of others will have significance to the obviousness inquiry in the design patent context.

6

We recognize that GM and several amici have raised concerns as to the uncertainty that may result from overruling the *Rosen-Durling* test and applying a new test. GM argues that eliminating the test will “revert to a rudderless free-for-all [and] will increase confusion, disrupt settled expectations, and leave lower courts and factfinders without the necessary guidelines to properly conduct the obviousness analysis.” Appellee’s Br. at 13. Along the same lines, amici argue that “[e]liminating this framework now carries great risk, including exposing up to 400,000 U.S.[.] design patents to substantial uncertainty [and] upsetting settled expectations for applicants before the USPTO and the public at large.” Amicus Am. Intell. Prop. L. Ass’n Br. at 26; *see also* Amicus Intell. Prop. Owners Ass’n Br. at 15 (“Elimination would leave USPTO examiners and design patent owners without any analytical framework for evaluating obviousness tailored to design patents.”).

We do not agree. The *Graham* four-part obviousness test for utility patents has existed for a very long time and there is considerable precedent from which the PTO and the courts can draw when assessing obviousness in the design patent context. As the Supreme Court acknowledged in *Graham*, there may well be some difficulties with this fact-based non-rigid test, but these difficulties are not unusual:

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amendable to a case-by-case development.

Graham, 383 U.S. at 18. This test has proven workable for utility patents and we see no reason why it would not be similarly workable for design patents. As with any change, there may be some degree of uncertainty for at least a brief period, but our elimination of the rigid *Rosen-Durling* test is compelled by both the statute and Supreme Court precedent.

V

Turning to the merits of the specific case before us, we vacate the Board’s determination of nonobviousness of the D’625 patent. We remand for the Board to address in the first instance whether the D’625 patent would have been nonobvious under 35 U.S.C. § 103 based on Lian alone or Lian as modified by Tucson, applying the framework for evaluating obviousness of design patent claims set forth in this opinion.

As an alternative ground for holding the D'625 patent nonobvious, the Board held that LKQ's failure to identify "the correct visual impression created by the patented design as a whole" in its claim construction, "standing alone, justifies [the Board's] conclusion that LKQ fails also to prove by a preponderance of the evidence that the challenged claim of the '625 patent is unpatentable." *Board Decision*, 2021 WL 3411458, at *17 (quoting *Durling*, 101 F.3d at 103). We have repeatedly held that tribunals "should not treat the process of claim construction [in design patent cases] as requiring a detailed verbal description of the claimed design, as would typically be true in the case of utility patents." *Egyptian Goddess*, 543 F.3d at 680; *see also Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1302–03 (Fed. Cir. 2010) (stating that for design patents, "claim construction must be adapted to a pictorial setting" and warning of "the dangers of reliance on a detailed verbal claim construction"). Rather, the tribunal is not "obligated to issue a detailed verbal description of the design" as "a design is better represented by an illustration." *Egyptian Goddess*, 543 F.3d at 679. We reaffirm this principle and hold that the Board erred in rejecting LKQ's asserted obviousness grounds on this basis.

[The court affirmed the Board's finding of no anticipation and vacated and remanded as to the Board's nonobviousness determination.]

LOURIE, Circuit Judge, concurring in judgment:

I concur in the court's decision to vacate and remand the Board's decision for it to reevaluate the validity of the claimed design in light of the majority opinion.

I write separately because I do not agree that we need to "overrule" *In re Rosen*, 673 F.2d 388 (CCPA 1982) and *Durling v. Spectrum Furniture Co.*, 101 F.3d 100 (Fed. Cir. 1996). To the extent that *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) abjured what it called rigid tests for evaluating patent issues, all we needed to do in this case was to make the *Rosen* and *Durling* precedents less rigid. Their use of "must" and "only" in their analyses are the only signs of rigidity in those opinions. Replacing them with words such as "generally," "usually," or "typically" would have sufficed. Otherwise, they were basically correct on the law.

Rosen was decided by a Court of Customs and Patent Appeals ("CCPA") panel that consisted in part of Judges Markey, Rich, and Nies, a group that one might say knew a bit about patent law, including the analysis of obviousness. And *Durling*, decided by an equally knowledgeable panel of this court, merely cemented an already long-standing principle likewise established by the CCPA in *In re Glavas*, 230 F.2d 447, 450 (CCPA 1956). The basics of the *Rosen-Durling* framework have therefore existed, and been consistently applied to design patent validity, for decades and long after *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893).

Perhaps, in the fullness of time and in light of *KSR*, it can be seen that *Rosen* and *Durling* may have used overly strong language. But, "overruled"? It only needed to be modified. Overruling is destabilizing. Courts should, if possible, rule in modest steps, not abrupt acts of overruling. Even post-*KSR*, we did not wholly abandon the requirement that there be a motivation to combine simply because the Supreme Court criticized one instance of its application. And since *KSR*, we have continued to apply tests and frameworks for validity. *See, e.g., Graham v. John Deere Co.*, 383 U.S. 1 (1966).

The majority walks away from *Rosen* and *Durling* as if they violated basic tenets of patent law. In reality, all they needed was a bit of tinkering. It is important to note that the U.S. Patent and Trademark Office, which also knows a good deal about evaluating design patents, basically endorsed *Rosen* and *Durling*, but found their application needed a little more flexibility. Oral Arg. at 32:25–48 (“We’re saying that the existing test is fine The *Rosen-Durling* test is fine, but we do recommend some changes to it.”).

The substantial briefing by amici in this en banc appeal was primarily dominated by entities with economic interest in the outcome of the case—supporters of automotive manufacturers, automotive part replacement companies, and insurance companies, each advocating for results and legal concepts supporting their economic interests. That is fine, but we most benefit from entities without an economic bias.

Broad-based organizations with a primary interest in the stability and clarity of the law have told us that the *Rosen-Durling* test is basically correct. They include the American Intellectual Property Law Association, the Institute for Design Science and Public Policy, the International Trademark Association, the Industrial Designers Society of America, and others, all of whom supported this precedent, which the court now “overrules.” Am. Intellectual Prop. Ass’n Amicus Br. (“[T]he *Rosen-Durling* framework ... allows for an expansive and flexible approach consistent with the principles of *KSR*” and “eliminating [it] would cause unnecessary uncertainty in an area of design patent law that has worked reasonably well for over 40 years.”); Inst. for Design Sci. and Pub. Policy et al. Amicus Br. (“Eliminating the *Rosen-Durling* test will unnecessarily harm design innovation.”); Indus. Designers Soc’y of Am. Amicus Br. (“[I]t is evident that this Court should uphold the existing *Rosen-Durling* framework.”); Int’l Trademark Ass’n Amicus Br. (“The *Rosen-Durling* test sets the appropriate balance for determining the obviousness of a design, and the Court should not abandon it.”).

The essence of *Rosen* and *Durling* is that for obviousness, which generally assumes that one reference does not anticipate the claimed design, one ought to have a basic starting reference with “basically the same” “design characteristics” as the challenged design and a second one that is “so related” as to result in a conclusion of obviousness. *Rosen*, 673 F.2d at 391; *Durling*, 101 F.3d at 103 (citation omitted). What the majority is doing here is confirming these concepts while overruling their cases of origin, just to make minor modifications in their language.

Presumably, such a basic starting reference, just as with utility patents, should be the closest prior art. The majority uses that phrase only once, but it ought to be central, as it is with utility patents. It does state that “a primary reference must be identified” and it “will likely be ... the prior art design that is most visually similar to the claimed design.” *Id.* But we did not need to “overrule” a case with language that a reference’s “design characteristics” must be “basically the same” to substitute “most visually similar.” Those two phrases themselves are basically the same or similar.¹ Maybe the word “must” used in *Rosen* was excessive, but the thought expressed was sound.

¹ “Basically the same” did not mean that a reference and the challenged design must be near-identical or even substantially the same. Indeed, such an interpretation would conflate anticipation and obviousness. See *Gorham Co. v. White*, 81 U.S. 511, 528 (1871) (explaining that infringement, which has the same test as anticipation, *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009), considers whether or not the “two designs are substantially the same”). Rather, “basically” meant “generally” or “roughly.” Moreover, *Rosen* did not require that the primary reference be “basically the same” as the claimed design, but only that the primary reference have “*design characteristics* of which are basically the same as the claimed design.” 673 F.2d at 391 (emphasis added).

As the majority acknowledges, the primary reference must fall within the range of what may be called analogous art. (“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.”). But the majority sets forth the test for analogous art as part of the obviousness inquiry. *See* Maj. Op. Sec. IV.1 (considering whether or not a reference is analogous art as part of its *Graham* factor one analysis). Properly understood, the analogous art test is not a test for obviousness. It is a gateway. Determining whether art is analogous is determining what may properly be considered in an obviousness inquiry, not part of the test for what would have been considered obvious. It is a threshold for qualifying art, not an indicator of obviousness. *E.g.*, *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (“A reference qualifies as prior art for an obviousness determination under § 103 only when it is analogous to the claimed invention.”). In my view, it should not be defined as a test for considering obviousness. That misconstrues its role in the analysis.

Moving to the second step of the *Rosen-Durling* test, an examiner or challenger might find another reference that, combined with the basic reference, might lead a skilled designer to what is claimed. That is where the “so-related” language in *Durling* comes in. The additional reference, or references, in order to lead to obviousness, 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.” *Durling*, 101 F.3d at 103 (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996) (quoting *Glavas*, 230 F.2d at 450)). Such a reference or references would also be within the scope of analogous art in order to be combinable with the basic reference. Again, perhaps the word “only” in *Durling* is excessive. But it just needed to be fine-tuned, not “overruled.” And that is essentially what the majority did, merely swapping the “so related” language of *Durling* for “some record-supported reason ... that an ordinary designer ... would have modified the primary reference” Maj. Op. at 1299.

Rosen and *Durling* therefore expressed the same concepts now adopted by the majority, albeit with a couple of unnecessarily strong words. Such a basic analysis was simply the way obviousness is examined and should be considered with design as well as with utility patents. Indeed, the *Rosen-Durling* framework has already been long-regarded as the application of the relevant *Graham* factors to design patents. *See, e.g.*, *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021); *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1462 (Fed. Cir. 1997).

With those thoughts, *Rosen* and *Durling* should have been allowed to stand, as modified, rather than been decisively overruled.

With that being said, I agree that the Board’s decision should be vacated and remanded.

NOTES AND QUESTIONS

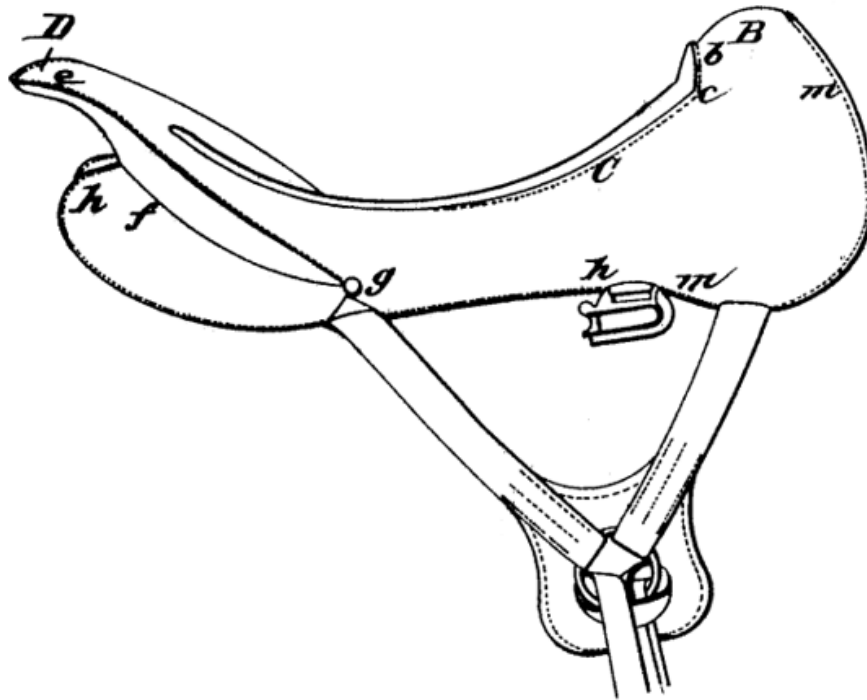
1. ***Obviousness as redundant?*** Obviousness performs a critical role in the utility patent system, earning it a designation as the “ultimate condition” of patentability. In utility patent law, anticipation operates under a strict identity standard, and competent patent attorneys who know about particular prior art references can frequently draft claim language that avoids anticipation by those references. Would you expect obviousness to be equally important in the design patent system? To the extent that the design

patent law features a more flexible anticipation analysis, is the obviousness doctrine less important? Redundant? Does the Federal Circuit's attention to the doctrine in *LKQ* suggest that it views the doctrine as crucial independently of the anticipation doctrine?

2. **Obviousness as “impossible”?** Judge Rich, a CCPA (and, later, Federal Circuit) judge noted for his contributions to utility patent law, was an outspoken skeptic about the application of the non-obviousness requirement to design patents. *In re Nalbandian*, 661 F.2d 1214, 1219 (C.C.P.A. 1981) (Rich, J., concurring) (urging the passage of comprehensive design protection legislation that would “get the impossible issue of obviousness in design patentability cases off the backs of the courts and the Patent and Trademark Office, giving some sense of certainty to the business world of what designs can be protected and how.”). Does the *LKQ* decision demonstrate that the puzzle of obviousness for designs is solvable? Or does it reinforce the view that the doctrine is in fact “impossible” when applied to designs? If the latter, what does that say about the core idea of adapting utility patent rules for designs?

3. **Are designs different?** *LKQ* seems to adopt the view that while designs may differ from inventions, the obviousness rules developed for inventions still carry over (to some extent) to designs...to some extent. Do you agree? Only because of the inclusion of the qualifier “to some extent”? In a given case, how is a court to know the extent to which a utility patent rule applies to designs?

4. **Whitman Saddle rides again.** *LKQ* justifies its ruling in part by asserting that the *Rosen-Durling* test does not align with the Supreme Court's decision in *Whitman Saddle*. *Whitman Saddle* preceded the codification of obviousness by several decades, but the Federal Circuit claims that the reasoning in *Whitman Saddle* carries over to the modern § 103 standard even though the *Whitman Saddle* court used the rhetoric of inventiveness. Should it? *Whitman Saddle* is often mischaracterized as involving a claimed design (shown below) that merely fused the front half of one prior art saddle design (the “Granger”) with the back half of another (the “Jenifer”). But the facts were more complicated. The front half of the claimed design bore some resemblance to the Granger prior art saddle (see reference letter “B” below), except that the claimed design also included a “drop” in the front half of the saddle that was visually different from that of the Granger design. (The drop can be seen near reference letters “b” and “c.”) Indeed, it was so different visually that was the basis for the conclusion that the accused design, which lacked such a drop, did not infringe. *Whitman Saddle* did not rule on the validity of the claimed design; it ruled on infringement. Did the Federal Circuit invoke *Whitman Saddle* appropriately in *LKQ*?



Suppose, contrary to the facts of *Whitman Saddle*, the claimed design really was nothing more than fifty percent of one prior art saddle and fifty percent of another. Would the claimed design have withstood an obviousness challenge under *Rosen-Durling*, on the rationale that neither of the prior art references could qualify as a primary reference? How would the analysis come out under *LKQ*?

5. ***A new role for the analogous art doctrine?*** The *LKQ* opinion gives new prominence to the doctrine of analogous art for design patent obviousness analysis. How important will that doctrine be in future cases? (It may be difficult to answer that question given the court’s refusal to “delineate the full and precise contours of the analogous art test for design patents.”) The court adopts from utility patent law only the first part of the analogous art test, asserting that the first part of the test applies to design patents “in a straightforward manner” – specifically, “analogous art for a design patent includes art from the same field of endeavor *as the article of manufacture* of the claimed design.” (emphasis supplied). What is a field of endeavor of an article of manufacture? How much weight should be given to the court’s remark that other art beyond the field of endeavor “could also be analogous”? Does the court’s approach to the article of manufacture in *Surgisil* have any relevance, given that the court there was purporting to speak of design patent scope? Or should the court’s remarks in *Surgisil* about the article of manufacture apply only in the context of anticipation?

6. ***The primary reference after LKQ.*** *LKQ* discards the requirement from *Rosen* that the primary reference be “basically the same,” but it retains the requirement that there be a primary reference, and that it be the prior art design that is most visually similar to the claimed design. The primary reference will also typically be in the same field of endeavor “as the claimed ornamental design’s article of manufacture,” but it need not be (although it must be analogous). How far from the first step of the *Rosen-Durling*

analysis has the court actually moved? Suppose that in a group of prior art references, each reference is visually dissimilar from the claimed design, but reference #1 in the group is arguably the least visually dissimilar. Is it a proper primary reference? Would it have satisfied the first step of *Rosen-Durling*?

7. *The secondary references and combinability after LKQ.* *LKQ* discards the “so related” test from the second step of *Rosen-Durling*, but the court expressly acknowledges the concern about hindsight. Indeed, unconstrained mixing and matching of prior art references with the benefit of hindsight (an exercise that some have called the making of “Frankenart”) presumably could prove fatal to the validity of many design patents. Does the *LKQ* test adequately guard against hindsight? The court states that “there must be some record-supported reason (without hindsight) that an ordinary designer in the field of the article of manufacture would have modified the primary reference with the feature(s) from the secondary reference(s) to create the same overall appearance as the claimed design.” What sorts of evidence substantiate the existence of such a reason to modify?

8. *The secondary considerations after LKQ.* *LKQ* states that it is leaving undisturbed the existing caselaw on the application of the secondary considerations to design patents, at least as to considerations such as commercial success, industry praise, and copying. Are you surprised that copying is included in this list? You might recall from Chapters 2 and 4 that courts in product design trade dress cases have expressed reluctance to rely on evidence of copying to infer secondary meaning or mark strength.

9. *Proving a nexus for secondary considerations in design patent cases.* In utility patent cases involving secondary considerations, especially those presenting evidence of commercial success, courts require a showing of a “nexus” between the features of the claimed invention and the secondary considerations evidence. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367 (Fed. Cir. 1986). The nexus requirement is often difficult to prove. The Federal Circuit has been willing to presume a nexus where the secondary considerations evidence concerns a commercial product that is “coextensive” with the claimed invention, albeit only in litigation and inter partes administrative proceedings, not in ex parte examination. See, e.g., *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). A commercial product is likely to include any number of features that are not explicitly recited in a utility patent’s claims. As long as these features are “insignificant,” the requirement for coextensiveness is said to be met and it can be presumed that the secondary considerations evidence is connected to the claimed features. In a design patent, the claimed invention is defined by the drawings, and the drawings often will not show all of the features of the corresponding commercial product, especially if the drawings employ the dotted-line convention to signal that the inventor is making a partial claim. How should the coextensiveness requirement work for design patents? In *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1277, n. 1 (Fed. Cir. 2021), the court concluded that the requirement would virtually never be met for design patents (and hence a nexus would virtually never be presumed), because the corresponding commercial product is almost certain to include features (especially functional features) that do not fall within the claim. Even if a nexus is not presumed, the proponent of the secondary considerations evidence (usually the patentee) could still attempt to prove a nexus-in-fact. In *Campbell*, the court concluded that the patentee had failed to prove a nexus-in-fact because its secondary considerations evidence was linked only to a design feature that was known in the prior art. *Campbell Soup Co.*, 10 F.4th at 1277-79. If secondary considerations evidence is tied to the overall visual impression conveyed by the design, should this suffice to show a nexus-in-fact? If it does not, what role, if any, would you expect for secondary considerations evidence in design patent cases?

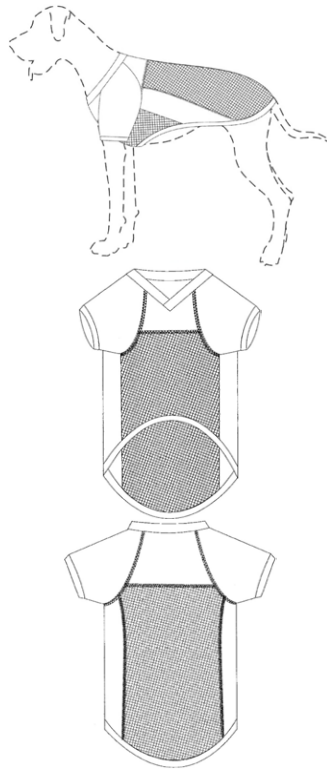
10. Is LKQ just Rosen-Durling repackaged? Do you agree with Judge Lourie that the court could have retained the *Rosen-Durling* framework but made minor modifications to emphasize its flexibilities? Does the *LKQ* opinion in fact confirm the concepts embodied in the *Rosen-Durling* framework, as Judge Lourie asserts? In perhaps the first decision to consider *LKQ*, a jury had found that Top Brand had infringed Cozy Comfort’s design patents before *LKQ* was decided. Top Brand moved for a new trial based in part on the argument that *LKQ* had changed the law of design patent obviousness. The trial judge denied the motion:

In regard to Plaintiffs’ argument about the change in controlling law, the Court has reviewed *LKQ* but does not find its holding so disruptive as to consider the jury instructions in this case a miscarriage of justice. *LKQ* in effect loosened the standard for obviousness by abolishing the “rigid” threshold similarity or “basically the same” requirement from *In re Rosen...* However, the jury in this case was not instructed to stop if the initial *Rosen* “basically the same” requirement was not met. Instead, the jury was instructed to consider seven different factors which included and mirror the four factors from *Graham v. John Deere Co.* This is the exact analysis for obviousness which *LKQ* commands. Thus, the jury instructions in this case do not constitute a miscarriage of justice, and the intervening change in the law does not warrant a new trial.

Top Brand, LLC v. Cozy Comfort Co., LLC, No. CV-21-00597-PHX-SPL (D. Ariz. June 28, 2024). Do you agree with the trial judge’s reasoning?

PROBLEM 5-3: APPLYING THE DESIGN PATENT OBVIOUSNESS ANALYSIS

MRC sued Hunter, alleging infringement of the '488 design patent, which claimed an ornamental design for a football jersey for a dog, as shown below:



Hunter challenged the '488 design patent as invalid for obviousness. The district court granted summary judgment in Hunter's favor on the issue, relying on the Eagles jersey (below) as the primary reference and the V2 jersey (also below) as a secondary reference.

V2 Jersey

Eagles Jersey



MRC appealed. Because the case arose before *LKQ*, the Federal Circuit assessed obviousness using the *Rosen-Durling* test. The Federal Circuit determined that the district court had not erred

in finding that the design characteristics of the ‘488 design created “basically the same” overall visual impression as the Eagles jersey prior art reference. As the district court noted, both designs contain the same overall shape, similar fabric, and ornamental surge stitching. That there are slight differences in the precise placement of the interlock fabric and the ornamental stitching does not defeat a claim of obviousness; if the designs were identical, no obviousness analysis would be required. Indeed, we have permitted prior art designs to serve as “primary references” when their differences are as great or greater than the differences in this case. *See Jore Corp. v. Kouvato, Inc.*, 117 Fed. Appx. 761, 763 (Fed. Cir. 2005) (finding prior art drill bit to be a primary reference despite containing a smooth cylindrical shaft rather than the grooved hexagonal shaft of the claimed design); *In re Nalbandian*, 661 F.2d 1214, 1217-18 (C.C.P.A. 1981) (finding tweezer design obvious in light of prior art reference that contained vertical rather than horizontal fluting and straight rather than curved pincers).

MCR Innovations, Inc. v. Hunter Mfg., LLP, 747 F.3d, 1326, 1333-34 (Fed. Cir. 2014). Alternatively, the Federal Circuit noted, the district court could have relied on the V2 jersey as a primary reference:

The only differences between the V2 jersey and the claimed design are: (1) that the V2 jersey does not contain an “interlock” fabric panel; (2) it has “drop” sleeves while the claimed jersey has “raglan-style” sleeves; and (3) the V2 jersey lacks any ornamental surge stitching. A side-by-side comparison of the two designs demonstrates that of those three differences, only the ornamental surge stitching truly alters the “overall visual appearance” of the design. Moreover, the ornamental stitching on the claimed design is suggested by the seam lines on the V2 jersey, further minimizing the difference in overall appearance.

Id. at 1333, n. 3.

The Federal Circuit then upheld the district court’s use of the V2 jersey as a secondary reference under the *Rosen-Durling* test:

The district court found that both jerseys suggested the use of a V-neck pattern and non-mesh fabric on the side panels...MRC argues that the district court erred by failing to explain *why* a skilled artisan would have chosen to incorporate those features of the V2 [jersey] with the Eagles jersey.

We disagree... [I]t is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design.

In re Borden, [90 F.3d 1570 (Fed. Cir. 1996)], discussed what is required for a reference to be considered sufficiently “related” for that test to apply. There, we noted that the secondary references were “closely akin” to the claimed design, and relied heavily on the fact that “the two missing design elements [were] not taken from unrelated references, but [were] found in other dual-chamber containers.” *Id.* Thus, those references could be used “to bridge the small gap between the [primary] container and Borden’s claimed design.” *Id.* So too, here, the secondary references that the district court relied on were not furniture, or drapes, or dresses, or even human football jerseys; they were football jerseys designed to be worn by dogs. Moreover, as discussed above, the V2 could easily have served as a primary reference itself, so similar is its overall visual appearance to that of the claimed design and the Eagles jersey. We therefore agree that those references were “so related” to the Eagles jersey that the striking similarity in appearance across all three jerseys would have motivated a skilled designer to combine features from one with features of another.

With respect to the only remaining difference between the Eagles jersey and the ‘488 claimed design—the presence of additional ornamental surge stitching running down the rear of the jersey—the district court acknowledged that no prior art reference contained exactly that same stitching on the rear of the jersey, but nevertheless concluded that this was not a “substantial” difference that created a patentably distinct design, but rather was a “*de minimis* change[] which would be well within the skill of an ordinary designer in the art.” [cit.]

MRC argues that adding *any* ornamental feature to a primary reference that is not suggested by the prior art is, by definition, more than *de minimis*. But our case law plainly contradicts that position; on numerous occasions we have invalidated design patents despite the inclusion of

ornamental features that were entirely absent from prior art designs. *See, e.g., In re Nalbandian*, 661 F.2d at 1217 (different shape of fluting on finger grips and different shape of pincers were de minimis differences in design for tweezers); *In re Carter*, 673 F.2d at 1380 (modifications to the waistband of an infant garment were “de minimis changes which would be well within the skill of an ordinary designer in the art”); *In re Chung*, No. 00-1148, 2000 WL 1476861, at *3 (Fed. Cir. Oct. 4, 2000) (two small depressions in the design of a cigarette package were de minimis changes); *In re Cooper*, 480 F.2d 900, 901-02 (C.C.P.A. 1973) (affirming Board’s conclusion that numerous changes to the design of a prior art building—including a single rather than double door and the addition of windows—were de minimis because the overall impression was still a building that looked like a barrel).

Here, the Eagles jersey had already disclosed the use of ornamental surge stitching. The only additional step needed was to extend the stitching down the sides of the rear of the jersey. Moreover, the V2 jersey plainly suggested the addition of vertical lines down the rear of the jersey through the use of the seams between the two types of fabric. We agree with the district court that adding ornamental surge stitching on top of a preexisting seam was an insubstantial change that would have been obvious to a skilled designer.

MRC v. Hunter, 747 F.3d at 1335.

Would the obviousness issue be decided the same way under *LKQ*? How, if at all, would the analysis differ?

At page 660, in the third full paragraph regarding the new EU design legislation, add the following:

The new EU design legislation entered into force on 8 December 2024. The Amending Regulation on Community designs no. 2024/2822 will in large part be applicable as of 1 May 2025, with some provisions delayed until 1 July 2026. The new Recast Directive on the legal protection of designs no. 2024/2823 entered into force on 8 December 2024, and EU Member States have 36 months to transpose it into national legislation.