# Stating the Obvious

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***The Federal Circuit overturned its 42-year-old obviousness test for designs. Fashion companies, take note.***

*By Julia Mazur*

The shape of a handbag, the red sole of a shoe: for fashion companies, design patents have long played a role in brand protection efforts.

To file a design patent application, however, a company must identify some part of an article that is new, original, ornamental and non-obvious — and now, the legal test for non-obviousness has changed. In May, the US Court of Appeals for the Federal Circuit overruled its longstanding test for determining whether a design claimed in a design patent or application is obvious and therefore not patentable under Section 103 of the Patent Act.[1] In its place, the Federal Circuit adopted a more flexible test meant to better align with the Patent Act, Supreme Court precedent and the obviousness test used to analyze inventions claimed in utility patents or applications.

Under the prior *Rosen-Durling* test for obviousness, a challenging party seeking to prove a design was obvious (and therefore ineligible for protection) had to first show that a single piece of prior art had design characteristics that were "***basically the same*** as the claimed design" (i.e., a *Rosen* reference).[2] If there was no *Rosen* reference, the obviousness inquiry ended. If a *Rosen* reference was identified, the challenger could argue that designs in other references could be used "to create a design that has the same overall visual appearance as the claimed design," but only if they were "***so related***" to the *Rosen* reference that "the appearance of certain ornamental features in one ***would suggest*** the application of those features to the other."[3]

The Federal Circuit, *en banc*, found that this test was inflexible and inconsistent with Supreme Court precedent. For example, in *Smith v. Whitman Saddle Co.*, the Court found a horse saddle design obvious because "[n]othing more was done" than to combine the front half of one saddle with the

back half of another "in the exercise of the ordinary skill of workmen of the trade, and in the way and manner ordinarily done."[4] More recently, the Supreme Court reiterated the need for caution in granting a patent based on a combination of elements found in the prior art, but rejected rigid, mandatory formulas that prevent fact finders from applying common sense.[5]

Now, finders of fact should generally apply the "fact-based non-rigid test" established in *Graham v. John Deere Co. of Kansas City*, [6] which analyzes whether an invention claimed in utility patents or applications is obvious to determine whether related designs are obvious. LKQ Corp., 102 4th at 1301. The *Graham* test has four factors.

**Step one:** Evaluate the "'scope and content of the prior art' within the knowledge of an ordinary designer in the field of design."[7] The primary piece of prior art no longer needs to be "basically the same" as the design at issue. However, the prior art must be "analogous art" to protect against the benefit of hindsight.[8] The Federal Circuit did not overrule precedent for determining analogous art, but left open whether prior art from a different field than the design at issue could be analogous art.[9]

**Step two:** Assess the visual differences between the prior art designs and the claimed design from the perspective "of an ordinary designer in the field of the article of manufacture."[10]

**Step three:** Determine the knowledge or level of skill of an ordinary designer who designs articles of the type presented in the patent or patent application.[11]

**Step four:** Analyze whether the design is obvious or nonobvious, focusing on the visual impression of the claimed design as a whole.[12] If a primary reference does not render the design obvious, other references can be considered. They need not be "so related," and the motivation to combine them to create the design at issue need not come from the references themselves.[13] Nonetheless, a "record-supported" reason, without the benefit of hindsight, must explain why an ordinary designer in the relevant field would combine features from the primary reference with features from other references to create a design with the same overall appearance as the design at issue.[14] This might include experience, creativity, market demands, industry customs or common ornamental features in the relevant field.[15] "Secondary considerations," such as commercial success, industry praise and copying, may also indicate obviousness or non-obviousness.[16]

The new obviousness test applies to obtaining and challenging a design patent. The US Patent and Trademark Office, Patent Trial Appeal Board and federal courts will determine the contours of applying the *Graham* factors to designs. Brands and their designers should stay up to date with the developing obviousness test case law as nuanced interpretations emerge and carefully assess how this framework affects the ornamental innovations in their products.

1 *See LKQ Corp. v. GM Global Tech. Operations, LLC*, 102 F.4th 1280 (Fed. Cir. 2024).

2 *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)) (emphasis added).

3 *Id.* at 103 (emphasis added).

4 148 US 674, 681 (1893).

5 *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415–421 (2007).

6 383 US 1 (1966).

7 *Id.* at 1295–96.

8 *Id.* at 1296.

9 *See id.* at 1297–98.

10 *Id.* at 1298.

11 *See id.* at 1298–99.

12 *Id.* at 1299.

13 *See id.*

14 *See id.*

15 *See id.* at 1299–1300.

16 *See id.* at 1300.

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