



ARE Design Patent Alert: The Full Federal Circuit is Considering Obviousness of Design Patents

Author(s): Chester Rothstein, Charles R. Macedo, David P. Goldberg, Sofia Siciliani

On June 30, 2023, the U.S. Court of Appeals for the Federal Circuit agreed to take on the following question:

Whether the current test for proving obviousness for a design patent has been overruled by US Supreme Court precedent.

LKQ Corp. v. GM Global Tech., 21-2348 (Fed. Cir. 2023)

In 1982, *In re Rosen* held that there must be an earlier design that has the same visual impression as the patented design to test whether a design patent is obvious. In addition, the test analyzes whether it would have been obvious for a designer to modify the earlier reference to create the patented design in question.

This matter was raised by LKQ Corp, which is seeking rehearing en banc of a January decision in its case against General Motors, insisting that the appellate court's 'decades-old' test for proving obviousness for a design patent cannot stand following the Supreme Court's 2007 *KSR v. Teleflex* decision, and should be modified or eliminated. While the question divided the panel, the most significant issue is what the replacement test should be. Not surprisingly, General Motors opposed the review, stating that not only did LKQ fail to raise the *KSR* issue with the PTAB, but also they are now seeking a complete 'rewrite of design patent obviousness framework that has otherwise remained unchallenged for decades.'

For more information, please contact one of our attorneys.

* [Chester Rothstein](#) and [Charles R. Macedo](#) are partners, [David Goldberg](#) is an associate and Sofia Siciliani is a law clerk at Amster, Rothstein & Ebenstein LLP. They may be reached at cmacedo@arelaw.com, crothstein@arelaw.com, dgoldberg@arelaw.com and ssiciliani@arelaw.com.