

# Design Patent Nonobviousness: The Road Ahead?

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*ABSTRACT: In this Essay, I comment on Mark Bartholomew's Article Nonobvious Design and link it to an important contemporary debate over the nonobviousness test for design patents in the en banc rehearing in LKQ. I begin by challenging the assertion that nonobviousness doctrine is the most compelling vehicle for design patent policy reform, suggesting that Nonobvious Design may be borrowing this thinking from utility patent law, where nonobviousness plays a different role. I then turn to Nonobvious Design's elaboration of the concept of the "aesthetic middle," which provides the chief impetus for the suggested nonobviousness reforms. I question the normative implications of using the aesthetic middle as the driver of patentability for designs. Finally, I take up the reforms to design patent nonobviousness suggested in Nonobvious Design, and those at issue in the LKQ case, and offer my views on how the court should rule in that case.*

INTRODUCTION.....	129
I. THE CURIOUS CHOICE OF OBVIOUSNESS AS A REFORM TARGET .....	130
A. OBVIOUSNESS IS ANALYZED FROM THE ORDINARY DESIGNER PERSPECTIVE, WHICH IS EXCEPTIONAL.....	130
B. ANTICIPATION MAY BE A MORE ATTRACTIVE TOOL FOR REFORM .....	132
C. DESIGN PATENT OBVIOUSNESS IS NOT QUITE AS DEAD AS PROFESSOR BARTHOLOMEW ASSERTS.....	134
II. CONCERNS ABOUT THE NORMATIVE UNDERPINNINGS OF THE "AESTHETIC MIDDLE" AS A BASIS FOR OBVIOUSNESS ADJUDICATION.....	135
III. LOOKING AHEAD—THE LKQ PROBLEM.....	138
A. KSR APPLIES TO DESIGN PATENT OBVIOUSNESS, BUT DOES NOT PREEMPT THE FEDERAL CIRCUIT FROM USING THE ROSEN-DURLING	

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FRAMEWORK .....	140
B. THE TWO-STEP STRUCTURE OF THE ROSEN-DURLING FRAMEWORK SHOULD BE RETAINED, WITHOUT THE “HARD-STOP” PRACTICE .....	142
C. THE “BASICALLY THE SAME” INQUIRY IN ROSEN-DURLING STEP ONE SHOULD BE CONDUCTED AGAINST THE BACKDROP OF THE ART AS A WHOLE	143
D. GUIDANCE ON OTHER ASPECTS OF THE DESIGN PATENT OBVIOUSNESS ANALYSIS.....	144
1. Flexibility in the “So Related” inquiry in <i>Rosen-Durling</i> Step Two.....	144
2. Resolving the “Fifty-Fifty Problem”.....	144
3. Explaining the Reach of <i>SurgiSil</i> and the Applicability of the Analogous Art Doctrine.....	145
CONCLUSION .....	147

## INTRODUCTION

For decades, design patent obviousness doctrine was only rarely the subject of judicial interest or scholarly explication.<sup>1</sup> Now, suddenly, design patent obviousness doctrine is having its moment. The Federal Circuit granted a petition for en banc rehearing in *LKQ Corp. v. GM Global Technology Operations LLC* (“*LKQ*”),<sup>2</sup> asking whether the existing doctrinal framework for assessing design patent obviousness must be scrapped on the ground that it is out of compliance with utility patent obviousness principles enunciated in the Supreme Court’s *KSR International Co. v. Teleflex* decision.<sup>3</sup> Just a few months earlier, Professor Mark Bartholomew delivered his views on the long-term future of the doctrine in *Nonobvious Design*.<sup>4</sup> This Essay comments on Professor Bartholomew’s Article and connects it to the *LKQ* debate.

In *Nonobvious Design*, Professor Bartholomew begins with the common refrain that design patents are too easy to obtain,<sup>5</sup> and after surveying the

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1. But see Jason J. Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 GONZAGA L. REV. 531, 588–604 (2010) (definitive work on the subject); Janice M. Mueller & Daniel Harris Breaun, *Overcoming the “Impossible Issue” of Nonobviousness in Design Patents*, 99 KY. L.J. 419, 428 (2010) (noting “scant academic attention” on “the negative impact of the nonobviousness requirement on design innovation”).

2. *LKQ Corp. v. GM Glob. Tech. Operations LLC*, 71 F.4th 1383, 1384 (Fed. Cir. June 30, 2023) (mem.) (order granting petition for rehearing en banc).

3. See generally *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

4. Mark Bartholomew, *Nonobvious Design*, 108 IOWA L. REV. 601, 631–49 (2023). The Article is another welcome installment in Professor Bartholomew’s excellent series of papers on the interconnections between intellectual property law and neuroscience. Prior papers are *Neuromarks*, 103 MINN. L. REV. 521 (2018) (discussing neuroscience and trademark law, considering the implications for distinctiveness, likelihood of confusion, and dilution) and *Copyright and the Brain*, 98 WASH. U. L. REV. 525 (2020) (neuroscience and copyright doctrines such as substantial similarity).

5. Bartholomew, *Nonobvious Design*, *supra* note 4, at 602.

patentability requirements for designs, asserts that strengthening the obviousness doctrine is the most promising avenue for reform.<sup>6</sup> He next introduces and characterizes the concept of the “aesthetic middle,”<sup>7</sup> and then argues that obviousness doctrine should be reformed to encourage designs that are located outside the aesthetic middle<sup>8</sup>—a creative and contrarian position that provides ample fodder for thought and commentary, as one would expect from Professor Bartholomew’s work.

This Essay proceeds in three parts. Part I questions Professor Bartholomew’s assertion that the obviousness requirement is a more attractive target for reform than other design patent law doctrines such as anticipation and infringement and explores work that others have already done to bring neuroscientific methods to bear on those doctrines. Part II applauds Professor Bartholomew’s presentation of the concept of the “aesthetic middle,” but challenges the normative implications that Professor Bartholomew derives from that concept. Part III turns to Professor Bartholomew’s prescriptions for reform, connects them to the Federal Circuit’s en banc *LKQ* case, and takes a position on how the en banc court should rule in that case.<sup>9</sup>

#### I. THE CURIOUS CHOICE OF OBVIOUSNESS AS A REFORM TARGET

I’ll begin where Professor Bartholomew does, with the choice of obviousness as the vehicle for reform. It’s a curious choice, in several ways. As I detail in this Part, obviousness is an exceptional doctrine in that it is analyzed from the perspective of the ordinary designer, unlike other major doctrines such as anticipation and infringement, which are analyzed from the perspective of the ordinary observer. Moreover, obviousness doctrine in its current (pre-*LKQ*) state is not quite so dead as *Nonobvious Design* asserts. For both reasons, obviousness doctrine may not be such a compelling target for the sort of radical reform that *Nonobvious Design* recommends.

##### A. OBVIOUSNESS IS ANALYZED FROM THE ORDINARY DESIGNER PERSPECTIVE, WHICH IS EXCEPTIONAL

The current design patent obviousness framework requires a two-step showing.<sup>10</sup> The first step requires identification of a primary reference (often called a *Rosen* reference), specifically, a single reference—“the design characteristics of which are basically the same as the claimed design.”<sup>11</sup> The second step specifies that additional “references may only be used to modify the primary reference if they are ‘so related [to the primary reference] that the

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6. *Id.* at Part I.

7. *Id.* at Part II.

8. *Id.* at Part III.

9. Professor Bartholomew’s paper was published before the Federal Circuit issued its panel decisions in *LKQ*, so *Nonobvious Design* does not address with particularity the en banc questions raised in the case.

10. Sometimes referred to as the “*Rosen-Durling*” framework. See generally *In re Rosen*, 673 F.2d 388 (C.C.P.A. 1982); *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100 (Fed. Cir. 1996).

11. *Durling*, 101 F.3d at 103 (quoting *In Re Rosen*, 673 F.2d at 391).

appearance of certain ornamental features in one would suggest the application of those features to the other.”<sup>12</sup>

What makes this framework unique in design patent law—and therefore somewhat surprising as a vehicle for major design patent law reform—is that the inquiry is to be carried out from the perspective of the “ordinary designer.”<sup>13</sup> Other prominent design patent inquiries—notably, the anticipation requirement (a patentability doctrine) and the infringement analysis—use the perspective of the “ordinary observer.”<sup>14</sup> Thus, if the goal is to recast design patent law to make it better-informed by neuroscientific methodologies, the anticipation and infringement inquiries would seem to be a more natural starting point.

Indeed, some work toward this end has already been done. In several papers,<sup>15</sup> Charles Mauro and coauthors have advocated for the use of an “empirical ordinary observer test,”<sup>16</sup> which they describe as an effort to mitigate “large-scale variability” in design patent anticipation and infringement inquiries.<sup>17</sup> While the empirical ordinary observer test appears to be an elaborate form of a survey instrument, the authors say that there are “lab-based applications” available that

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12. *Id.* (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

13. *In re Nalbandian*, 661 F.2d 1214, 1215 (C.C.P.A. 1981). The United States Court of Customs and Patent Appeals had previously ruled to the contrary. *In re Laverne*, 356 F.2d 1003, 1006 (C.C.P.A. 1966). Judge Rich, who authored the *Laverne* opinion, concurred grudgingly in *Nalbandian*, but also voiced his skepticism about the entire enterprise of assessing designs for nonobviousness. *Nalbandian*, 661 F.2d at 1218–19 (Rich, J., concurring).

14. *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009) (anticipation); *Gorham Co. v. White*, 81 U.S. 511, 528 (1871) (infringement); *cf. In re Maatita*, 900 F.3d 1369, 1377–78 (Fed. Cir. 2018) (ruling that indefiniteness in design patent law is to be assessed from the perspective of the designer of ordinary skill, but that the designer in such circumstances would adopt the views of the ordinary observer).

15. *E.g.*, Charles L. Mauro & Christopher Morley, *Why the Future of Design Patent Protections Will Rely on Modern Neuroscience, not Constitutional and Legal Reversionism*, 36 BERKELEY TECH. L.J. 278, 290–94 (2021). According to Mauro and Morley, “[t]he most important insight from modern neuroscience is that no individual judge, lawyer, or legal academic can ever represent the hypothetical ordinary observer . . . because there is too much real variation in how a given consumer population judges the shapes of objects in our everyday world.” *Id.* at 282.

16. *Id.* at 281. For a more detailed account, including a validation exercise using the subject matter of the *Gorham* test, see Charles L. Mauro, Chris Morley & Paul W. Thurman, *Development and Initial Validation of an Empirical Ordinary Observer Test for Design Patent Infringement*, SSRN (June 5, 2020) <https://ssrn.com/abstract=3620088> [<https://perma.cc/P24L-LZM8>]. See also Charles Lee Mauro & Christopher Daniel Morley, *How Different is Different? Modern Neuroscience and its Impact on Design Law*, in RESEARCH HANDBOOK ON DESIGN LAW 530–49 (Henning Hartwig ed., 2021) (addressing, *inter alia*, neuroscience and design patent damages calculations).

17. They posit that the variability stems from several internal and external sources, including the fact that individuals vary widely in their innate sensitivity to visual design, Mauro & Morley, *supra* note 15, at 278, 283–85; that individuals may have had very different prior experience with and expectations of visual design, *id.* at 287; and that lawyers may unduly bias the observer’s perceptions by cueing the observer to pay attention to particular design features, *id.*; *cf. Bartholomew, Nonobvious Design, supra* note 4, at 611–12 (making the opposite claim that current law places too much emphasis on the design as a whole).

rely on neuroscientific methods.<sup>18</sup> It seems likely that work on the neuroscience of the ordinary observer will continue.<sup>19</sup>

B. ANTICIPATION MAY BE A MORE ATTRACTIVE TOOL FOR REFORM

There's a second reason to wonder whether obviousness doctrine, as opposed to anticipation doctrine, is the most promising target for reform: it's not clear that the current law of anticipation must be understood as being so "rote and inflexible" as Professor Bartholomew describes.<sup>20</sup> To be sure, there is abundant Federal Circuit rhetoric—especially in older decisions—for the proposition that a prior art reference anticipates a claimed design only if the reference and the design are "identical in all material respects."<sup>21</sup> This language is a carryover from utility patent law.<sup>22</sup> But the leading case on design patent anticipation today, *International Seaway*, calls for the fact finder to determine whether the prior art reference and claimed design are substantially similar to the ordinary observer,<sup>23</sup> a formulation that sharply diverges from modern utility patent law, where anticipation demands element-by-element identity.<sup>24</sup> According to *International Seaway*, "[j]ust as 'minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement,' so too minor differences cannot prevent a finding of anticipation."<sup>25</sup>

In light of this tension in the cases, views on the present state of the law of design patent anticipation vary. Some, like Professor Bartholomew, see the

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18. Mauro & Morley, *supra* note 15, at 293; *cf.* Braun Inc. v. Dynamics Corp. of Am., 975 F.2d 815, 821 (Fed. Cir. 1992) (declaring that, in design patent cases, "[t]he desirability of or necessity for presentation of [survey] evidence might vary depending on the circumstances of a particular case . . .").

19. This in turn raises broader theoretical questions about whether the point of the ordinary observer construct (and, by extension, the ordinary designer construct for obviousness) is or should be to elaborate an empirical assessment of consumer behavior, or whether it is or should be in part a normative vehicle. See generally Graeme B. Dinwoodie, *Trade Mark Law as a Normative Project*, SINGAPORE J. LEGAL STUD., July 2023 (identifying and analyzing the phenomenon in trademark law); Timothy R. Holbrook & Mark D. Janis, *How the Supreme Court Ghosted the PHOSITA: Amgen and Legal Constructs in Patent Law*, 109 IOWA L. REV. ONLINE 83 (2024) (noting the empirical and normative elements of patent law's person of ordinary skill in the art) (commenting on Laura Pedraza-Fariña & Ryan Whalen, *The Ghost in the Patent System: An Empirical Study of Patent Law's Elusive "Skilled Artisan,"* 108 IOWA L. REV. 247 (2022)).

20. Bartholomew, *Nonobvious Design*, *supra* note 4, at 608.

21. Door-Master Corp. v. Yorktowne, Inc., 256 F.3d 1308, 1312 (Fed. Cir. 2001) (quoting Hupp v. Siroflex of Am., Inc., 122 F.3d 1456, 1461 (Fed. Cir. 1997)); *Hupp*, 122 F.3d at 1461.

22. *Hupp*, 122 F.3d at 1461 (stating that "the factual inquiry is the same as that which determines anticipation by prior publication of the subject matter of a utility patent").

23. *Int'l Seaway Trading Co. v. Walgreens Corp.*, 589 F.3d 1233, 1239–40 (Fed. Cir. 2009). The ordinary observer perspective is critical here; the ordinary observer might overlook differences that would be apparent to the ordinary designer.

24. See, e.g., MARK D. JANIS & TED M. SICHELMAN, *PATENT LAW: AN OPEN-SOURCE CASEBOOK* 404–06 (Mark D. Janis & Ted M. Sichelman eds., 2023) (describing the all-elements rule for anticipation in utility patent law).

25. *Int'l Seaway*, 589 F.3d at 1243 (citation omitted) (quoting *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984)).

design patent anticipation rule as narrow and rigid, akin to its utility patent law counterpart.<sup>26</sup> Conversely, one prominent commentator has argued that *International Seaway* transforms the anticipation inquiry into something more closely resembling the obviousness analysis.<sup>27</sup>

This ferment about anticipation is subject to a further complication: the *SurgiSil* problem.<sup>28</sup> In *In re SurgiSil, L.L.P.*, the court ruled that where a design patent application specified in the title and claim (and drawings) that the design was for a lip implant, the claimed design was not anticipated by prior art disclosing an art tool.<sup>29</sup> According to the court, “[a] design claim is limited to the article of manufacture identified in the claim,” such that the Board’s anticipation finding was premised on a legally erroneous interpretation of the design claim’s scope.<sup>30</sup> The claim, the court said, “is limited to lip implants and does not cover other articles of manufacture.”<sup>31</sup>

*Nonobvious Design* doesn’t cite *SurgiSil*, but the decision is relevant to Professor Bartholomew’s arguments in several ways. Understood as an anticipation case, *SurgiSil* supports Professor Bartholomew’s position that anticipation is almost never an obstacle to patentability. But *SurgiSil* could (and should) be understood instead as a case about claim scope—i.e., how to construe what a design patent covers.<sup>32</sup> If that’s correct, then *SurgiSil* affects not only anticipation, but also nonobviousness, because determining claim scope is an antecedent step for both. Obviousness reform proposals in design patent law ought to grapple with this issue.<sup>33</sup>

In sum, Professor Bartholomew may be assuming that the relationship between obviousness and anticipation familiar from utility patent law—in which anticipation is rigid and narrow and obviousness is flexible and contextual, making obviousness a more attractive vehicle for fine-tuning the system—applies equally to design patent. It’s not clear that the relationship between anticipation and obviousness works quite that way in design patents. Perhaps,

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26. See, e.g., Christopher Buccafusco, Mark A. Lemley & Jonathan S. Masur, *Intelligent Design*, 68 DUKE L.J. 75, 104–05, 124–25 (2018) (proposing that anticipation should be found “[w]hen prior art discloses a design that substantially anticipates the principal features of the claimant’s design”); Bartholomew, *Nonobvious Design*, *supra* note 4, at 608. But cf. Sarah Burstein, *Intelligent Design & Egyptian Goddess: A Response to Professors Buccafusco, Lemley & Masur*, 68 DUKE L.J. ONLINE 94, 106–107 (2019) (criticizing the substantial anticipation proposal as likely to “add confusion and uncertainty”).

27. Perry J. Saidman, *Design Patents are Sinking in International Seaway: Rethinking Design Patent Anticipation 10–12* (Feb. 20, 2020), <https://ssrn.com/abstract=3532376> [<https://perma.cc/W89T-68NR>] (arguing that the Federal Circuit conflated anticipation with obviousness in *International Seaway*).

28. *In re SurgiSil, L.L.P.*, 14 F.4th 1380, 1382 (Fed. Cir. 2021).

29. *Id.* at 1382.

30. *Id.*

31. *Id.*

32. Unfortunately, in the *SurgiSil* opinion, after the Federal Circuit laid out its conclusions about scope, the court dispensed with the anticipation analysis as mere *ipse dixit*, without acknowledging that anticipation requires application of an ordinary observer test, which can have its subtleties. *Id.*

33. See *infra* Section III.E.3 (taking up this issue in the context of *LKQ*).

then, Professor Bartholomew is too quick to dismiss anticipation in design patent law as a lost cause for achieving reform goals.<sup>34</sup>

C. *DESIGN PATENT OBVIOUSNESS IS NOT QUITE AS DEAD AS PROFESSOR BARTHOLOMEW ASSERTS*

A final reason that obviousness is a curious target for reforming the design patent system relates to Professor Bartholomew's assertion that obviousness under the current design patent law is a dead letter.<sup>35</sup> He attributes the doctrine's demise primarily "to three doctrinal moves[;]" (1) the adoption of a primary reference requirement (the first step of the *Rosen-Durling* framework); (2) rhetoric pinning the obviousness analysis to the design as a whole, an approach that assertedly "refuses to declare some visual elements more important than others[;]" and (3) overreliance on commercial success evidence as an indicum of nonobviousness.<sup>36</sup> I'm not entirely persuaded by this diagnosis. To paraphrase Monty Python,<sup>37</sup> obviousness might not be dead just yet.

Arguments about the effects of the first doctrinal move—the primary reference requirement—lie at the heart of the Federal Circuit's en banc rehearing in *LKQ*. Those arguments warrant their own treatment, which I provide in Part III.

The other two doctrinal moves don't provide nearly as compelling a justification for obviousness reform. As to the argument that the focus on the design as a whole unduly constrains the analysis, Professor Bartholomew takes the design-as-a-whole judicial rhetoric too seriously. This is a common species of judicial doubletalk in design patent cases,<sup>38</sup> also showing up in trademark cases that forbid "dissecting" a composite mark into components, but at the same time acknowledging that a proper analysis might isolate components for individual assessment because some components may be more salient to consumers than others.<sup>39</sup>

As for commercial success, Professor Bartholomew may be overstating the problem. To be sure, Professor Bartholomew's argument aligns with a longstanding scholarly tradition of expressing skepticism over the use of commercial success evidence to show nonobviousness for utility patents.<sup>40</sup> The

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34. See Bartholomew, *Nonobvious Design*, *supra* note 4, at 631–32 (rejecting the assertion that infringement doctrine—and, presumably, anticipation doctrine, by extension—could be used as the tool for reforms that add stringency to design comparisons).

35. *Id.* at 608–09.

36. *Id.*

37. MONTY PYTHON AND THE HOLY GRAIL (Python (Monty) Pictures 1975).

38. See, e.g., *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1332–33 (Fed. Cir. 2014) (invoking the rule that obviousness requires a showing that the prior art creates the same overall visual appearance as the claimed design, but proceeding to analyze whether individual features in the alleged *Rosen* reference were significantly different from those in the claimed design, and concluding that they were not).

39. See, e.g., GRAEME B. DINWOODIE & MARK D. JANIS, TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY 50 (6th ed. 2022) (noting the concept used in connection with composite word marks).

40. See, e.g., Robert P. Merges, *Commercial Success and Patent Standards: Economic Perspectives on Innovation*, 76 CALIF. L. REV. 803, 805–06 (1988).

chief limitation on the use of that evidence—and perhaps the chief doctrinal response to the skepticism—is the nexus requirement. Courts require evidence of a nexus between the commercial success evidence and the features of the claimed invention,<sup>41</sup> although the Federal Circuit has been willing to presume a nexus where the commercial success evidence relates to the patentee’s product and that product is “coextensive” with the claimed invention.<sup>42</sup>

Design patent cases discussing commercial success evidence are rare, which may itself undermine Professor Bartholomew’s assertion of overreliance. Regardless, in one of those rare cases, *Campbell Soup Co. v. Gamon Plus, Inc.*,<sup>43</sup> the Federal Circuit took an exceptionally hard-nosed view of the nexus requirement as applied to commercial success evidence in design patents. The court ruled that the nexus could not be presumed because the design patentee’s product included significant functional features that (of course) were not part of the claimed design, and hinted that for this reason the presumption would virtually never apply in a design patent case.<sup>44</sup> The court also ruled that the patentee had failed to prove a nexus-in-fact because the commercial success evidence was linked only to a feature of the design that concededly was known in the prior art.<sup>45</sup>

*Nonobvious Design* does not contend with the *Campbell Soup* case, and so may greatly overstate the likelihood that commercial success evidence will figure prominently in future obviousness determinations involving design patents. In any event, I am not aware of persuasive empirical evidence showing that it is common for patent applicants or patentees to invoke commercial success arguments to prevail against obviousness in design patent matters.

## II. CONCERNS ABOUT THE NORMATIVE UNDERPINNINGS OF THE “AESTHETIC MIDDLE” AS A BASIS FOR OBVIOUSNESS ADJUDICATION

Professor Bartholomew’s primary normative argument is that design patent law should be recalibrated to reward designs that diverge from the “aesthetic middle.” This is a provocative, interesting argument, one that draws on Professor Bartholomew’s deep understanding of relevant aspects of neuroscience.<sup>46</sup> It is also an argument that does not necessarily depend on accepting Professor Bartholomew’s views on particular reforms to obviousness doctrine.

As Professor Bartholomew explains it, the aesthetic middle reflects the optimization of three sets of characteristics that connect with an observer’s

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41. See, e.g., *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019) (stating that “there must be ‘a legally and factually sufficient connection’ between the evidence and the patented invention” (quoting *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1332 (Fed. Cir. 2019))).

42. *Id.*

43. *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1276-79 (Fed. Cir. 2021).

44. *Id.* at 1277 n.1 (“We do not go so far as to hold that the presumption of nexus can never apply in design patent cases. It is, however, hard to envision a commercial product that lacks any significant functional features such that it could be coextensive with a design patent claim.”).

45. *Id.* at 1278.

46. Bartholomew, *Nonobvious Design*, *supra* note 4, at 621–26 (explaining the neuroscientific basis for the aesthetic middle).



fluency in regards to a particular design: (1) complexity (observers prefer—aesthetically—that it be moderate, not too simple nor too complicated); (2) familiarity (observers prefer a design that is visually typical—only a modest departure from prevailing designs); and (3) fit or congruity (observers prefer that the design evokes the product category, even if it may rely on some elements that are incongruous with the product category).<sup>47</sup> In turn, Professor Bartholomew frames his normative vision for a reformed obviousness inquiry in terms of whether it diverges from the aesthetic middle, and how that affects observer fluency with the design: “A difference from the prior art that tilts away from the aesthetic middle by making the design harder to process should be considered relevant to the nonobviousness determination. A difference from the prior art that enhances a design’s perceptual, repetition, or conceptual fluency should not.”<sup>48</sup> In other words, Professor Bartholomew is proposing that design patent obviousness should be retooled to incentivize designs falling *outside* the aesthetic middle, a realm of designs, where, by definition, designs “[begin] to trigger aesthetic distaste as mental processing of the design becomes more challenging.”<sup>49</sup> It would seem that under this standard, designs that are likely to have the greatest value—because they have the ideal level of aesthetic appeal to consumers—must be denied design patent protection as obvious. Designs that are distasteful to consumers’ aesthetic preferences would survive, by virtue of their very distastefulness.<sup>50</sup>

For me, the normative proposal triggers two chief concerns. First, Bartholomew’s account of aesthetics—or, more precisely, the aesthetics that design patent law does or should care about—is contestable, more so than *Nonobvious Design* lets on. As I read him, Bartholomew assumes that aesthetics equates to beauty, and, particularly, consumers’ perceptions of beauty.<sup>51</sup> That assumption may seem safe enough, and it certainly lines up with conventional judicial rhetoric about promoting advancement in the decorative arts.<sup>52</sup>

But achieving greater beauty might not quite be what design patent is all about—or, at least, there’s room to contest that assumption. Design patent law could be said to be seeking to encourage the decorative arts through humbler means: by promoting visual difference, which is agnostic as to a design’s beauty.

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47. *Id.* at 626–31.

48. *Id.* at 631. “Perceptual fluency influences aesthetic preference without any recognition or memory of the stimulus,” *id.* at 625. While repetition fluency influences via multiple past exposures, and conceptual fluency “triggers the appropriate product category in someone’s mind.” *Id.* at 626.

49. *Id.* at 605.

50. The potential dynamics of this standard over time may also be troubling. Designs considered unorthodox and thus eminently patentable at the time of patenting might be considered ubiquitous and hence unpatentable a short time later, and thus likely to be relegated to the aesthetic middle. Does the aesthetic middle thus keep expanding? Or does it shift, capturing the previously unorthodox while ejecting the previously orthodox? Given the rapid product cycles in some design-heavy industries, this shifting could be going on very quickly relative to the fifteen-year design patent term.

51. Bartholomew, *Nonobvious Design*, *supra* note 4, at 617.

52. See *Gorham Co. v. White*, 81 U.S. 511, 524 (1871) (asserting that “[t]he acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts”).

In this sort of a regime, the role of obviousness is to ensure a degree of difference, which I'd regard as considerably less ambitious than ensuring greater beauty.

Or, perhaps neither of these ambitions alone quite capture it. Instead, perhaps it's best to understand the goal of design patent in the negative: it is to promote endeavors that we know are not directed to product utility, such that product aesthetics in the context of design patents should be understood as an imperfect catchall to capture imbuing visual appearance that isn't dictated by the use. Such an exercise might be about beautification, differentiation, or something else entirely that we lump in under the imprecise label "aesthetics."

A second concern derives from the history of obviousness jurisprudence in utility patent law in the twentieth century, and some lessons that I think ought to be drawn from it. Some Supreme Court justices deciding obviousness cases before the 1952 Act espoused a vision of the obviousness criterion that might have substantially raised the bar for patentability.<sup>53</sup> Similar views persisted even after the 1952 Act.<sup>54</sup> These cases could be read for the proposition that the patent system ought to reward only those inventions that are truly pathbreaking and should thus be unavailable for wide swaths of more modest innovation. Bartholomew's suggested revisions of obviousness in design patents suggests to me a similar normative vision at work: it would seem to tune the design patent system to reward the *avant-garde*, but to cast aside designs lying in the aesthetic middle that some may consider banal.

Setting aside the larger question—whether such a vision appropriately harnesses patent incentives—"inventive genius" rules run counter to a conventional intellectual property narrative. That narrative expresses deep skepticism about whether such rules (or their counterparts in copyright law which call for assessments of degrees of artistic merit) cannot be implemented reliably. Such rules place too much faith in decisionmakers' abilities to make extraordinary qualitative judgments about whether an invention deserves to be on the "greatest of all time" list without lapsing into subjectivity. Where the invention is a design and the qualitative judgment concerns aesthetics, the risk of subjectivity (and, particularly, the prospect of elitism) is magnified, according to the conventional narrative. To be sure, such a narrative has its critics,<sup>55</sup> and this dispute may persist in intellectual property

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53. See, e.g., *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 154 (1950) (Douglas, J., concurring) (asserting that the claimed invention must "serve the ends of science—to push back the frontiers of chemistry, physics, and the like; to make a distinctive contribution to scientific knowledge," and that this is why the Court has used "'inventive genius' as the test" (quoting *Reckendorfer v. Faber*, 92 U.S. 347, 357 (1875))); *Cuno Eng. Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 91 (1941) (stating that the claimed invention "must reveal the flash of creative genius, not merely the skill of the calling" to satisfy the standard of invention).

54. See *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282–83 (1976) (requiring evidence in the obviousness assessment that an invention composed of a combination of known elements display synergism between the elements); *Anderson's-Black Rock v. Pavement Salvage Co.*, 396 U.S. 57, 61 (1969) (requiring, similarly, evidence in the obviousness assessment that an invention composed of a combination of known elements display synergism between the elements).

55. See e.g., Barton Beebe, Bleistein, *The Problem of Aesthetic Progress, and the Making of American Copyright Law*, 117 COLUM. L. REV. 319, 319 (2017) (arguing that judges have

scholarship for generations to come. For present purposes, it's sufficient simply to note that the existence of the conventional narrative underscores how ambitious Bartholomew's proposed and quite contrarian normative shift really is. Perhaps he is asking obviousness doctrine to do too much.

### III. LOOKING AHEAD—THE *LKQ* PROBLEM

*Nonobvious Design* offers three prescriptions for reforming the design patent nonobviousness inquiry: (1) altering the analysis to “aid the trier of fact in deciding when a difference is material”;<sup>56</sup> (2) “abandoning the primary reference rule and considering a greater array of prior art”;<sup>57</sup> and (3) “disclaim[ing] any reliance on a design's commercial success.”<sup>58</sup> I have quarrels with the first<sup>59</sup> and the third,<sup>60</sup> but the second has now become crucial in light of the Federal Circuit's en banc rehearing in *LKQ*. Accordingly, that is the focus of my attention in this Part.

The *LKQ* cases<sup>61</sup> originated from *LKQ*'s petitions for *inter partes* review of design patents owned by General Motors, based in part on assertions of obviousness. The Patent Trial and Appeal Board instituted review but concluded

misconstrued Justice Holmes's opinion in *Bleistein* to mean that “judges should refrain from judging aesthetic merit”).

56. Bartholomew, *Nonobvious Design*, *supra* note 4, at 644.

57. *Id.* at 646.

58. *Id.* at 648.

59. Bartholomew argues that courts are not empowered under the current test to consider the materiality of differences between the claimed and prior art designs. *Id.* at 638–39. I disagree. See *supra* note 38 and accompanying text (discussing *MRC Innovations*). It may be that the real point of divergence between Bartholomew's view and mine lies in differences in what constitutes “material.” For example, Bartholomew suggests that “[w]hile design choices reflecting the familiar should be given little weight, design choices that detract from repetition fluency should be considered material.” Bartholomew, *Nonobvious Design*, *supra* note 4, at 641. But this does little more than reask the question that is fundamental in any obviousness inquiry: what should count as “familiar?” Elsewhere, Bartholomew argues that “[a] design choice away from symmetry should be presumed a material difference” and that “a choice to reduce the contrast between design features” should likewise trigger a presumption. *Id.* at 639. One wonders whether these inquiries might be reduced to raw value judgments preferring some types of aesthetic choices over others, carrying with them the prospects of subjectivity and unpredictability.

60. I have noted that Bartholomew's arguments for eliminating commercial success evidence from the obviousness calculus do not seem to account for caselaw that may already reduce substantially the role of that evidence in design patent cases. See *supra* Section I.C. Bartholomew also suggests that the jurisprudence of trademark law's aesthetic functionality doctrine supports his commercial success argument. Bartholomew, *Nonobvious Design*, *supra* note 4, at 648. But the roles of commercial success in the respective doctrines are unrelated. Commercial success is used in obviousness cases as a consideration cutting in favor of protection. Evidence of commercial success was used in some older aesthetic functionality cases for the opposite purpose: to justify *refusing* protection for aesthetic design features on the ground that they were essential to competition (as shown by their commercial success). See, e.g., *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 80 (2d Cir. 1990) (discussing, and, rejecting, the “important ingredient in the commercial success” test of *Pagliero v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952)). The treatment of commercial success in aesthetic functionality law is not pertinent to its treatment in design patent obviousness.

61. *LKQ Corp. v. GM Glob. Tech. Operations LLC*, No. 2022-1253, 2023 WL 330605 (Fed. Cir. Jan. 20, 2023); *LKQ Corp. v. GM Glob. Tech. Operations LLC*, No. 2021-2348, 2023 WL 328228 (Fed. Cir. Jan. 20, 2023).

that *LKQ* had not established obviousness, ruling that *LKQ* had failed to identify an appropriate primary reference under the *Rosen-Durling* framework.<sup>62</sup> On appeal to the Federal Circuit, *LKQ* argued that the *Rosen-Durling* framework could not be sustained as a matter of law in view of *KSR*, although *LKQ*'s arguments focused primarily on step one, the requirement to identify a *Rosen* reference.<sup>63</sup> Similarly, *Nonobvious Designs* argues that *KSR* should apply to design patents and seems to suggest that this means that the primary reference requirement should be abandoned.<sup>64</sup>

In a pair of non-precedential panel opinions, a split Federal Circuit panel affirmed.<sup>65</sup> According to the *LKQ* panel opinions, *KSR* did not overrule *Rosen-Durling*, because: (1) “*KSR* did not involve or discuss design patents;”<sup>66</sup> (2) the court had decided numerous design patent cases since *KSR* without entertaining any serious challenge to the vitality of *Rosen-Durling*; and (3) it would be improper for a panel to overturn binding circuit precedent without a clear directive from the Supreme Court.<sup>67</sup> In additional views appended to the panel opinions, Judge Lourie commented that because utility inventions and designs inherently differed, determining obviousness for the respective types of subject matter called for “different considerations.”<sup>68</sup> Judge Stark would have concluded that *LKQ* forfeited its challenge to the legality of the *Rosen-Durling* framework,<sup>69</sup> but he noted that reasonable minds could differ on the merits of such a challenge.<sup>70</sup>

*LKQ* sought rehearing en banc, and the Federal Circuit granted *LKQ*'s petition.<sup>71</sup> The court's order laid out six en banc questions, asking about the effect of *KSR* on *Rosen-Durling*,<sup>72</sup> what test should replace *Rosen-Durling* if it is

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62. *LKQ Corp.*, 2023 WL 330605, at \*1.

63. *Id.* at \*3–6.

64. Bartholomew, *Nonobvious Design*, *supra* note 4, at 644–46 (discussing the proposal to revise obviousness “to move away from the primary reference requirement”).

65. The panels in both cases consisted of Judges Lourie, Cleverger, and Stark. The opinions were filed per curiam, with Judge Lourie offering “additional views” in both cases and Judge Stark concurring in part and concurring in the judgment. *LKQ Corp.*, 2023 WL 330605, at \*6, 8; *LKQ Corp.*, 2023 WL 328228, at \*7, 9.

66. *LKQ Corp.*, 2023 WL 330605, at \*5; *LKQ Corp.*, 2023 WL 328228, at \*6.

67. *LKQ Corp.*, 2023 WL 330605, at \*5; *LKQ Corp.*, 2023 WL 328228, at \*6.

68. *LKQ Corp.*, 2023 WL 330605, at \*7; *LKQ Corp.*, 2023 WL 328228, at \*8 (asserting that whereas “[o]bviousness of utility patents requires considerations such as unexpected properties, utility, and function,” designs instead are assessed based on “overall appearance, visual impressions, artistry, and style of ornamental subject matter”).

69. *LKQ Corp.*, 2023 WL 330605, at \*8 (Stark, J., concurring); *LKQ Corp.*, 2023 WL 328228, at \*9 (Stark, J., concurring).

70. *LKQ Corp.*, 2023 WL 328228, at \*14 (Stark, J., concurring) (concluding that it would be reasonable to decide that *KSR* implicitly overruled *Rosen/Durling*, but it would also be reasonable to decide that differences between utility and design patents might justify using a different test for design patent obviousness).

71. *Id.*; *LKQ Corp. v. GM Glob. Tech. Operations LLC*, 71 F.4th 1383, 1384 (Fed. Cir. June 30, 2023) (mem.) (order granting petition for rehearing en banc).

72. Specifically, asking whether *KSR* overruled or abrogated *Rosen/Durling*, or otherwise demands that *Rosen/Durling* be eliminated or modified (questions A and B). *Id.*

necessary to do so,<sup>73</sup> whether *Rosen-Durling* has been clarified or become sufficiently settled such that eliminating it would cause uncertainty,<sup>74</sup> and whether differences (if any) between the utility patent and design patent obviousness inquiry should influence the test for obviousness in design patents.<sup>75</sup>

In my view, the Federal Circuit should rule that *KSR* does apply to design patent obviousness, but that this does not require that the *Rosen-Durling* framework be wholly reworked, nor does it mean that the requirement for a *Rosen* reference in step one of the framework should be dropped.<sup>76</sup> Instead, the Federal Circuit should retain the framework but make some refinements to it, and highlight guardrails that already may exist. I explain these conclusions below.

A. *KSR APPLIES TO DESIGN PATENT OBVIOUSNESS, BUT DOES NOT PREEMPT THE FEDERAL CIRCUIT FROM USING THE ROSEN-DURLING FRAMEWORK*

As noted, *LKQ* asserted before the Federal Circuit panel that *KSR* overrules the *Rosen-Durling* framework for design patent obviousness, and the panel's per curiam opinions responded by asserting that *KSR* is inapplicable to design patents.<sup>77</sup> The Federal Circuit en banc should reject both propositions.

*KSR* is applicable to design patents. The objection raised in the per curiam panel opinions—that *KSR* doesn't discuss design patents—is pretty thin gruel. The Supreme Court's watershed *Graham v. John Deere* opinion<sup>78</sup> interpreting the obviousness provision likewise did not "involve or discuss design patents," but there is no serious argument that *Graham* therefore does not apply to design patents. The objection in Judge Lourie's additional views that the differences between design and utility inventions dictate that *KSR* not apply to design patents presents policy considerations that transcend obviousness doctrine and may begin to bear on legislative choices. At a minimum, the argument must contend more forthrightly with the subtleties of the statutory command that "[t]he provisions of [Title 35] relating to patents for inventions shall apply to patents for designs, except as otherwise provided."<sup>79</sup> For the obviousness inquiry, that would mean that, at minimum, design patents, like utility patents, are subject to the language of 35 U.S.C. § 103. But it would also be plausible to say that by virtue of § 171(b)'s incorporation language, design patents are subject to the utility patent caselaw interpreting 35 U.S.C. § 103, with accommodations made for the fact that not every ruling in every utility

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73. *Id.* (question C).

74. *Id.* at 1384–85 (questions D and E).

75. *Id.* at 1385 (question F).

76. *Cf.* Bartholomew, *Nonobvious Design*, *supra* note 4, at 646 (urging that the *Rosen* reference requirement be discarded).

77. *See* notes 66–75 and accompanying text.

78. *See generally* *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

79. 35 U.S.C. § 171(b) (2018).

patent case will be illuminating for design patent cases.<sup>80</sup> Likewise, it would be plausible to say that Congress has already decided that the similarities between design and utility inventions are sufficient to justify incorporating much of utility patent law into design patent law.

But saying that *KSR* applies to design patents is not the equivalent of saying that *Rosen-Durling* must go. *KSR* does not require that all obviousness inquiries be utterly structureless. Nor does *KSR* impose the slightly more modest requirement that the only permissible structure to interject into the obviousness analysis is the *Graham v. John Deere* factor test<sup>81</sup>— as if the law of obviousness were irretrievably frozen when *Graham* was handed down in 1966. To the contrary, *KSR* should be understood as endorsing the use of the *Graham* factors along with the ongoing development of subsidiary rules for applying those factors in particular settings. After all, that is exactly what *KSR* itself did. Confronted with the teaching-suggestion-motivation test—a gloss on the *Graham* factors—the Court accepted that the test might capture “a “helpful insight,”<sup>82</sup> and proceeded to lay out guidance to ensure that the test was not applied with undue rigidity. The Court did not abrogate the teaching-suggestion-motivation test as a matter of law. It did not rule that the very existence of the teaching-suggestion-motivation test indicated an analysis having undue rigidity, but rather that “[h]elpful insights . . . need not become rigid and mandatory formulas” and that when the teaching-suggestion-motivation test “is so applied” it is problematic.<sup>83</sup>

*KSR*, therefore, does not perforce rule out subjecting the obviousness inquiry to a structured two-part analysis such as the *Rosen-Durling* framework. Indeed, the Federal Circuit has added significant structure to the obviousness analysis in the chemical area, without apparent offense to *KSR*. That inquiry is remarkably similar to the *Rosen-Durling* framework.<sup>84</sup>

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80. Some would undoubtedly object that § 171(b)'s reference to “provisions” should be read to be limited to statutory commands and should not extend to caselaw interpreting those commands. Courts have routinely debated whether to apply utility patent caselaw to design patent issues without mentioning the § 171(b) incorporation clause. *Pacific Coast Marine Windshields, Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 700–02 (Fed. Cir. 2014) (borrowing elements of the utility patent doctrine of prosecution history estoppel); *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679–81 (Fed. Cir. 2008) (en banc) (debating and declining to borrow the full set of canons of utility patent claim construction).

81. *Graham*, 383 U.S. at 17–18 (specifying that obviousness should be analyzed by considering the scope and content of the prior art; the differences between the claimed invention and the prior art; and the level of ordinary skill in the art; and that secondary considerations may also be relevant). Experience with the *Graham* factors has shown that they help decisionmakers order the obviousness analysis, but by themselves do relatively little to guide decisions.

82. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

83. *Id.* at 419.

84. *See, e.g.*, *Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280, 1291–93 (Fed. Cir. 2012) (describing the “lead compound” analysis applicable to chemical composition claims). The lead compound analysis is often carried out as a two-step analysis in which the court first “determines “whether a chemist of ordinary skill would have selected the asserted prior art compounds as lead compounds, or starting points, for further development efforts,” and then next assesses “whether the prior art would have supplied one of ordinary skill in the art with a reason or motivation to modify a lead compound to make the claimed compound with a reasonable expectation of success.”

This is not to suggest that the *Rosen-Durling* test has achieved perfection. Opponents of the test, including Professor Bartholomew, have pointed out a number of shortcomings in the test. But those arguments are directed mostly to the way the test is (or might be) applied. The remedy is for the Federal Circuit to do in *LKQ* what the Supreme Court did in *KSR*: Give guidance about applying the existing test with appropriate flexibility. I lay out below a few aspects of the *Rosen-Durling* framework that are most in need of such guidance from the en banc Federal Circuit.

*B. THE TWO-STEP STRUCTURE OF THE ROSEN-DURLING FRAMEWORK SHOULD BE  
RETAINED, WITHOUT THE "HARD-STOP" PRACTICE*

One objection raised against the *Rosen-Durling* framework is that it encourages (or even mandates) decisionmakers to make a “hard stop” upon concluding that no reference satisfies the step one requirements for a *Rosen* reference.<sup>85</sup> This, it is alleged, is a source of undue rigidity. But the existing *Rosen-Durling* framework does not demand that approach, and the Federal Circuit should say as much en banc in *LKQ*.

To be sure, the very act of imposing a two-step analysis implies that the analysis might end at step one. And it is fair to claim that the *Rosen-Durling* framework can be (and no doubt has been) applied that way.

But the hard-stop argument lapses into caricature to the extent that it suggests that decisionmakers who are determining whether prior art qualifies as a *Rosen* reference for step one assess only the candidate reference and must necessarily ignore all else. The fact that the design patent obviousness analysis is structured in two steps does not mandate that the step one analysis be done with blinders on.

To guard against such an eventuality, the Federal Circuit should remind decisionmakers that obviousness analysis is always to be undertaken against the backdrop of the prior art as a whole.<sup>86</sup> Applied to design patent obviousness under the *Rosen-Durling* framework, that means that in determining whether a given reference is “basically the same” as the claimed design for purposes of step one, a decisionmaker should take into account facts that are evident from studying the prior art as a whole. The Federal Circuit already requires an analogous exercise in the infringement analysis, where the ordinary observer

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*Id.* For purposes of the first step, a lead compound is “a compound in the prior art that would be most promising to modify in order to improve upon its . . . activity and obtain a compound with better activity.” *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1357 (Fed. Cir. 2007).

85. For example, in the panel opinion, Judge Stark asserted that unless the first step of the framework is satisfied, no other information can be considered, which “appears to prevent consideration of the ordinary designer’s creativity, at least in cases like the one before us now.” *LKQ Corp. v. GM Glob. Tech. Operations LLC*, No. 2021-2348, 2023 WL 328228, at \*13 (Fed. Cir. Jan. 20, 2023) (Stark, J., concurring).

86. See, e.g., *Uber Techs., Inc. v. X One, Inc.*, 957 F.3d 1334, 1341 (Fed. Cir. 2020) (“precise breadth” of individual references did not alter the court’s conclusions about the prior art properly viewed as a whole); *E.I. DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1011 (Fed. Cir. 2018).

is deemed to be familiar with the prior art, such that the observer compares the patented and accused designs “in light of the prior art.”<sup>87</sup>

C. *THE “BASICALLY THE SAME” INQUIRY IN ROSEN-DURLING STEP ONE SHOULD BE CONDUCTED AGAINST THE BACKDROP OF THE ART AS A WHOLE*

Along similar lines, opponents of the *Rosen-Durling* framework worry that decisionmakers systematically take a severely constrained view of the “basically the same” criterion, resulting in truncated prior art searches and an obviousness analysis that is little more than a rehash of the anticipation inquiry.<sup>88</sup> Here again, the argument has some merit, but it does not follow that the only or best remedy is to trash step one of the framework altogether. Instead, the Federal Circuit should emphasize that the lens through which decisionmakers undertake the design patent obviousness analysis—applicable to both of its steps—is that of the ordinary designer. *KSR*’s teachings are relevant here: the ordinary designer, like the ordinary artisan in utility patent law, ought to be deemed to possess an ordinary level of creativity.<sup>89</sup> A putative ordinary designer may, for example, notice visual details too subtle for the ordinary observer. An ordinary designer (unlike an ordinary observer) may grasp how the design features of a potential *Rosen* reference fit within or diverge from a larger artistic trend or tradition. The Federal Circuit should make clear that the ordinary designer brings that background knowledge and experience to step one of the design patent obviousness analysis. The court has already demonstrated in some prior cases that the *Rosen-Durling* framework can be applied flexibly at step one<sup>90</sup> and step two.<sup>91</sup>

When it highlights these refinements, the Federal Circuit should take some assurance that it is invoking concepts that are already familiar in the design law of other major intellectual property jurisdictions. For example, in the law of Community designs,<sup>92</sup> a design must be shown to have “individual character” to be protectable,<sup>93</sup> meaning that “the overall impression” the design provides to an “informed user” is different “from the overall impression” provided by previously

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87. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 676–77 (Fed. Cir. 2008); *see also id.* at 679 (referring to this prior art as the “comparison prior art”).

88. Bartholomew, *Nonobvious Design*, *supra* note 4, at 644–46 (making a similar assertion).

89. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

90. *Campbell Soup Co. v. Gamon Plus, Inc.*, 939 F.3d 1335, 1341 (Fed. Cir. 2019) (“ever-so-slight differences” between the claimed design and the prior art design did not disqualify prior art design as a *Rosen* reference “in light of the overall similarities”).

91. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1334–35 (Fed. Cir. 2014) (fact that claimed design had an ornamental feature not disclosed in the prior art did not disqualify prior art design from being “so related” under *Rosen-Durling* step two).

92. Council Regulation 6/2002, 2001 O.J. (L 003) 12 (EC) (“Community Design Regulation”).

93. *Id.* at art. 4(1) (design protectable if it has novelty and “individual character”); *id.* at art. 6(1) (“A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public [as further specified].”).



known designs.<sup>94</sup> The “informed user” in this inquiry is, by definition, a user, not a “designer, technical expert, manufacturer or seller,”<sup>95</sup> and thus, it would seem, has *less* familiarity with the design enterprise than the designer of ordinary skill. Yet the informed user is deemed to have knowledge of the “design corpus and of the design features normally included in the designs existing in the sector concerned.”<sup>96</sup> The designer of ordinary skill in the art for purposes of the obviousness inquiry under U.S. law should be deemed to have at least that level of familiarity with the art as a whole. The Federal Circuit en banc should state that the designer of ordinary skill is understood to bring that familiarity into the assessment of whether a reference qualifies as a *Rosen* reference.

#### D. GUIDANCE ON OTHER ASPECTS OF THE DESIGN PATENT OBVIOUSNESS ANALYSIS

So rarely does the Federal Circuit take the opportunity to speak en banc, particularly in design patent cases, that the Federal Circuit should consider signaling its views on other aspects of the design patent obviousness inquiry beyond those strictly required for resolving the obviousness issue in *LKQ*. The Federal Circuit’s final en banc question is broad enough to invite such discussions. Below, I briefly note three areas in which Federal Circuit input could be helpful.

##### 1. Flexibility in the “So Related” inquiry in *Rosen-Durling* Step Two

If the en banc Federal Circuit retains the *Rosen-Durling* framework, even with some modifications to highlight the flexibility that can be built into step one, the court should ensure that undue rigidity does not slip back into the analysis via step two. The same general approach already described for step one—undertaking the analysis from the perspective of a designer of ordinary skill who brings a knowledge of the prior art, a reasonable level of creativity, and experience to the analysis—should also apply to step two of the design patent obviousness analysis, and the Federal Circuit would do well to say so en banc in *LKQ*.

##### 2. Resolving the “Fifty-Fifty Problem”

The *Rosen-Durling* framework, even when modified as I’ve described above, is not easy to apply to cases presenting what might be called the “fifty-fifty problem.”<sup>97</sup> *LKQ* does not present such a scenario, but *Whitman Saddle*, a Supreme Court case decided over a century ago, did.<sup>98</sup> The Court resolved the case on noninfringement,<sup>99</sup> and it arose long before obviousness was codified

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94. *Id.* at art. 6(1) (“A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public [as further specified].”).

95. *Samsung Elecs. (UK) Ltd. v. Apple Inc.* [2012] EWHC 1882 (Pat) [34].

96. *Id.*

97. Credit to Chris Carani for this very useful label.

98. *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 675–81 (1893).

99. *Id.* at 682.

in § 103, but the fact pattern is nonetheless instructive. According to the Court, the saddle design claimed in the patent-in-suit included a low pommel and a high-backed cantle, as did the accused infringing product. One prior art saddle, the Granger, had a low pommel similar to that of the patented design, except that the patented design had a “drop” at the rear of the pommel.”<sup>100</sup> A different prior art saddle, the Jenifer-McClellan, had a high-backed cantle.<sup>101</sup> Accordingly, except for the drop, the patented design could be described as the result of putting the two halves of the prior art saddles together.<sup>102</sup> The dilemma for modern courts applying the *Rosen-Durling* framework is that it could be argued that neither the Granger nor the Jenifer-McClellan prior art would qualify as a *Rosen* reference, even though both contributed significantly to the appearance of the claimed design.

But there are ways to approach such a fifty-fifty scenario, and the evidence in *Whitman Saddle* is useful in this regard. The evidence in the case showed (not surprisingly) that there were several hundred prior art saddle designs at the time.<sup>103</sup> More importantly, the evidence established “that it was customary for saddlers to vary the shape and appearance of saddle-trees in numerous ways according to the taste and fancy of the purchaser.”<sup>104</sup> A designer of ordinary skill in the saddle art at the relevant time should be deemed capable of taking those facts into account in determining whether Granger or Jenifer-McClellan should qualify as a *Rosen* reference. There should be no objection to recognizing that level of flexibility in the design patent obviousness analysis on the facts of *Whitman Saddle*, and doing so would be helpful in cases that approach the fifty-fifty scenario.

This approach might not resolve the true fifty-fifty case. For example, perhaps, even after accounting for all of the facts, a decisionmaker would still be loath to conclude that either prior art saddle design in *Whitman Saddle* is “basically the same” as the claimed design. Some might see this as a good result that prevents decisionmakers from reconstructing the claimed design in hindsight by way of indiscriminate mixing and matching of design features. Others might see this as a bad result. If it is a bad result, then the Federal Circuit may need to craft an exception to the *Rosen-Durling* framework. The en banc court could acknowledge that future possibility while leaving resolution of the issue for another day.

### 3. Explaining the Reach of *SurgiSil* and the Applicability of the Analogous Art Doctrine

As previously noted, *SurgiSil*, although ultimately resolved on anticipation, depended for its resolution on a ruling that the scope of a design patent claim is limited by the identified article of manufacture.<sup>105</sup> Because design patent

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100. *Id.* at 681.

101. *Id.* at 680.

102. *Id.* at 681.

103. *Id.*

104. *Id.*

105. *See supra* Section I.B.

claims incorporate the disclosure, it would seem to follow from *SurgiSil* that the scope of what a design patent *discloses* must likewise be limited by the identified article of manufacture. Design patent law differs in this regard from utility patent law, and the en banc Federal Circuit should consider how, if at all, *SurgiSil* affects the design patent obviousness analysis.

In particular, where the prior art references forming the basis for an obviousness theory are themselves design patents, *SurgiSil* might be understood to say that what those design patents disclose is limited to the identified article of manufacture. And this, in turn, could affect whether a reference could qualify as a *Rosen* reference at step one, or whether secondary references could be usable at step two. To take the facts of *SurgiSil* as an example, if a design patent claims a design for a lip implant, could a prior art design patent disclosing a design for an art pencil fail to qualify as a *Rosen* reference? Would it be deemed not “basically the same” as a matter of law, or ought this to be a matter for case-by-case consideration, given the skills of the ordinary designer? The same questions could be asked regarding the “so related” inquiry of step two.

Existing caselaw on the doctrine of analogous art dating back to the United States Court of Customs and Patent Appeals (“CCPA”) further muddies the picture. In utility patent law, prior art references are deemed analogous if they are either (1) within the patentee’s field of endeavor; or (2) reasonably pertinent to the problem that the patentee seeks to solve.<sup>106</sup> Prior art references that fail this test cannot be used in an obviousness combination, because, as a matter of law, they are not part of the scope and content of the prior art.

In design patent law, the CCPA’s *In re Glavas*<sup>107</sup> decision, which preceded *Rosen* and *Durling*, adopted a separate analogous art doctrine for design patents. Some aspects of the *Glavas* analogous art doctrine should be understood to have been subsumed into the *Rosen-Durling* framework,<sup>108</sup> while other aspects cannot be squared with *SurgiSil*.<sup>109</sup> The Federal Circuit has raised questions about the current viability of some aspects of *Glavas*,<sup>110</sup> but has not explicitly

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106. *In re Clay*, 966 F.2d 656, 658–59 (Fed. Cir. 1992).

107. *In re Glavas*, 230 F.2d 447, 450 (C.C.P.A. 1956) (asserting that the analogous art doctrine “cannot be applied to design cases in exactly the same manner as to mechanical cases”).

108. *Id.* (asserting 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”).

109. Specifically, according to the court in *Glavas*, if the claimed design was surface ornamentation, the nature of the article to which the ornamentation was applied in the prior art references was “immaterial”—meaning that such prior art references would be deemed analogous and thus usable in an obviousness combination. *Id.* On the other hand, the court argued that if the claimed design is product shape, “the nature of the articles involved “is a definite factor” in determining” obviousness. *Id.* Complicating matters further, *Glavas* treated the analogous art determination as a matter affecting the weight to be given to a prior art reference, whereas modern utility patent cases treat it as disqualifying a reference from use as an element of an obviousness combination. *Id.* at 451.

110. *Cf. Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1343 (Fed. Cir. 2019) (suggesting that some comments in *Glavas* are in tension with the adoption of the ordinary observer test for anticipation and infringement).

interred the *Glavas* commentary on analogous art. The en banc Federal Circuit should do so.

#### CONCLUSION

Professor Bartholomew makes a persuasive case for the broad proposition that design patent law should pay attention to neuroscience, and that the effect of doing so could be transformative. He makes a less persuasive case that obviousness is the ideal vessel for bringing neuroscience into the realm of design patents. As for his specific prescriptions for reforming design patent obviousness law (animated by the concept of the “aesthetic middle”), one of them—the suggestion to revisit the *Rosen* reference requirement in the *Rosen-Durling* framework—is set to receive en banc consideration by the Federal Circuit in a case that seems likely to have important ramifications for design patent law for some time to come.