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Obviousness Analysis in Design Cases – Update

美国外观设计创造性分析的最新发展

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Case Cite
案件引述

- *LKQ Corp. et al. v. GM Global Technology Operations LLC – May 21, 2024*
  - Petitioners, LKQ Corporation and Keystone Automotive Industries, Inc. (collectively, “LKQ”) sell automotive body repair parts
  - LKQ was granted a license by General Motors (“GM”) to many of GM’s design patents

申请人LKQ公司和Keystone汽车工业股份有限公司（合称‘LKQ’）销售汽车车身修理零件。LKQ获得了通用汽车公司（‘GM’）许多GM外观设计专利的许可。

Background
背景

- Among various licensed designs was U.S. Patent No. D797,625 (“the ’625 patent”), which claims the appearance of a front fender for a vehicle
- The license expired in February 2022
- Thereafter, GM asserted that the replacement parts being sold by LKQ were infringing GM’s patents
  - The lawsuit included the ’625 patent

被许可的外观设计中，包括了美国专利号D797,625（‘625专利）的外观设计专利，该专利保护了车辆前挡泥板的外观。该许可于2022年2月到期，之后通用汽车公司（GM）主张LKQ销售的替换零件侵犯了GM的专利，其中包括了‘625专利。

Background
背景

- In response, LKQ petitioned the Patent Trial and Appeal Board (PTAB) for an *inter partes* review of the ’625 patent
- LKQ asserted that the ‘625 patent was invalid as anticipated by U.S. Patent No. D773,370 (“Lian”)
- PTAB was unconvinced by LKQ’s arguments and subsequently concluded that the ’625 patent remained valid
- LKQ appealed the decision

LKQ向专利审判和上诉委员会（PTAB）对’625专利提出无效请求，主张 ’625 专利无效，因为其已被美国专利 No. D773,370 (Lian) 预见公开了。PTAB对LKQ的论点并不采纳，认为’625专利仍然有效。LKQ对这一决定提出了上诉。

Obviousness Analysis
创造性分析

- In the *inter partes* review, the PTAB applied the established and controlling *Rosen-Durling* tests for obviousness
  在无效复审中，PTAB 采用了既定主导的 *Rosen-Durling* 测试
  - *Rosen* has two criteria for design patent obviousness
    - First, there must be a primary reference that is basically the same as the claimed design to support a holding of obviousness
    - Second, if a sufficient primary reference exists, the court must consider whether an ordinary designer would have modified the primary reference to achieve the claimed design

Rosen 对外观设计专利的显而易见的判断提出了两个标准：首先，必须有一个与所要求保护的外观设计权利“基本相同”的主要对比设计。其次，如果存在一个主要对比设计，法院必须考虑普通外观设计者是否会修改主要对比设计实现所要求保护的外观设计。

Obviousness Analysis
创造性分析

- In the *inter partes* review, the PTAB applied the established and controlling *Rosen-Durling* tests for obviousness
  - *Durling* contributed an additional condition
    - Secondary references may only be used to modify the primary reference, if the two references are so related that the "appearance of certain ornamental features in one would suggest the application of those features to the other"

Durling 的附加条件：次要对比设计需要与主要对比设计**"高度相关"**，以至于其中一者的特征会暗示另一者，次要对比设计才能用于修改主要对比设计。

Obviousness Analysis
创造性分析

- The PTAB ruled: PTAB 裁定
  - LKQ failed to identify a sufficient primary reference and, thus, failed to prove obviousness of the claimed design of the ’625 patent under the *Rosen-Durling* test for obviousness
- LKQ appealed the PTAB decision to the CAFC arguing that the *Rosen-Durling* tests were implicitly overruled by *KSR*

LKQ 未能找到一个充分的主要对比设计，因此未能通过 *Rosen-Durling* 测试证明’625 外观专利设计显而易见不具创造性。LKQ 对 PTAB 的裁决结果向CAFC提出了上诉，称 KSR 间接推翻了 *Rosen-Durling* 测试。

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Prior Ruling
先前裁决

- LKQ took issue with two aspects of the PTAB's decision
  - The first challenge involved the PTAB's method of determining anticipation of the '625 patent
  - As GM is a car manufacturer, LKQ disagreed with the PTAB's finding that the ordinary observer of the design would include only retail consumers looking to buy replacement fenders and commercial replacement part buyers

LKQ 对 PTAB 裁决的两个方面提出疑问：第一项挑战涉及 PTAB 判定 '625 专利预见公开的方法。由于GM是一家汽车制造商，LKQ 不同意 PTAB 的裁定，即该外观的普通设计者仅包括希望购买替换挡泥板的零售消费者和商业替换零件买家。

Prior Ruling
先前裁决

- LKQ took issue with two aspects of the PTAB's decision
  - In the second challenge, LKQ argued that the tests used by the PTAB to determine obviousness in design patents – referred to as the *Rosen-Durling* tests – were no longer valid since they had been implicitly overruled by the Supreme Court's decision in KSR Int'l Co. v. Teleflex Inc., ("KSR")

在第二项挑战中，LKQ 主张PTAB 使用的*Rosen-Durling* 测试已不再有效，因为其已被最高法院在 *KSR Int'l Co. v. Teleflex Inc.*, ("*KSR*") 的判决间接推翻了。

Appeal
上诉

- LKQ contended: LKQ 辩称
  - The analysis and reasoning of KSR should have been applied to the obviousness analysis of the ’625 patent
    KSR 分析跟论证应该应用于 ’625 专利的创造性分析
- GM asserted: GM 主张
  - LKQ forfeited this argument by not raising it before the PTAB, and
  - *KSR* does not overrule *Rosen* or *Durling*
    LKQ在 PTAB 审理过程中没有提出这些主张，
    而且*KSR* 没有推翻 *Rosen* 或 *Durling*

Appeal
上诉

- The CAFC's initial opinion stated: CAFC 的初步意见指出
  - Since *KSR* was decided by the U.S. Supreme Court, more than fifty appeals involving obviousness of design patents have been decided using the *Rosen-Durling* tests
  - Of those appeals, only two cases raised the issue of the correctness of the current design obviousness guidelines in light of *KSR*

自 *KSR* 由美国最高法院裁决以来，已有超过 50 起涉及外观设计专利创造性的上诉使用 *Rosen-Durling* 测试进行裁决，在这些上诉中，只有两起案件根据 *KSR*，对当前外观设计创造性指导方针的正确性提出了质疑

Appeal
上诉

- The three-judge panel of the CAFC concluded that they cannot overrule *Rosen* or *Durling* without a clear directive from the Supreme Court
- Ultimately, the court affirmed the PTAB's decision that LKQ failed to show that the '625 patent would have been obvious over the cited references based on the *Rosen-Durling* tests for obviousness of design patents

CAFC 的合议庭得出结论，在没有最高法院明确指示的情况下，他们不能推翻 *Rosen* 或 *Durling* 的判决。最终，法院维持 PTAB 的判决，即 LKQ 未能证明，根据 *Rosen-Durling* 外观设计专利创造性测试，'625 专利相对于所提及的对比设计而言是显而易见的。

Request for *En Banc* Rehearing
全庭重审请求

- In response, LKQ petitioned the CAFC for a rehearing *en banc* requesting:
  - *Rosen* and *Durling* be overruled and replaced with a test consistent with *KSR*
    LKQ 向 CAFC 申请全庭重审要求
- The petition for rehearing *en banc* was granted in an order dated June 30, 2023
  全庭重审的请求在 2023 年 6 月 30 日的命令中被批准
- The *en banc* decision issued May 21, 2024
  全庭重审决定于 2024 年 5 月 21 日发布

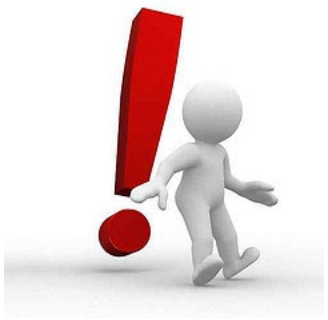
Question Presented to CAFC
向CAFC提出的问题

- KSR made obviousness easier to prove
  - Replacing the rigid "teaching, suggestion, and motivation" ("TSM") test with a more flexible standard for analyzing obviousness
  - When assessing patentability of claims under KSR
    - Considerations such as: common sense, hindsight, and level of ordinary skill of a person skilled in the art of the invention are permitted
    - The question presented to the CAFC is:
      - What is the proper test for the determination of obviousness in design patents?

KSR用更灵活的标准取代严格的"教导、建议和动机"（"TSM"）测试来分析创造性，一些考虑比如：常识、后见之明和本领域普通技术人员的技术水平是被允许的，*但是审查设计专利中创造性的合适测试是什么？*

En Banc Decision Rendered
全院庭审作出决定

- The U.S. Court of Appeals for the Federal Circuit (CAFC) has decided an *en banc* rehearing of the case
  - All twelve (12) of the sitting judges of the CAFC heard and ruled on the case 十二名现任法官都审理并裁定此案
  - The *en banc* ruling changes the way obviousness is determined in design patents
    - The CAFC overruled three decades of precedent
    - The CAFC adopted a new standard for assessing the obviousness of design patents



全庭裁决推翻三十年的判例，采用新的设计专利创造性判定标准

En Banc Decision Rendered
全院庭审作出决定

- In the *En Banc* Rehearing Decision:
  在全庭重审决定中：
- *Rosen* and *Durling was* overruled as being inconsistent with *KSR* and the Supreme Court's decision in Smith v. Whitman Saddle Co. ("Whitman Saddle" – 1983)
  Rosen 和 Durling 被推翻，因为其与 KSR 和最高法院在1983年的 Smith v. Whitman Saddle Co. 一案中的判决不一致
- Central to the CAFC's decision was the "reason to combine" requirement

CAFC 判决的核心是对于对比文献"合并理由" 的要求

Reason to Combine Requirement
合并理由的要求

- From the Supreme Court's KSR decision: 最高法院的 KSR 裁决
  - Obviousness turns not only on whether the all of the elements of a claim are present in prior art references
    创造性不仅取决于所要求保护特征是否都存在于现有技术对比文件中
  - Obviousness is also based on whether one skilled in the art finds *a reason or motivation to combine* the prior art references to obtain the claimed invention
    还取决于本领域技术人员是否*有理由或动机结合*现有技术对比文件以创造所要求保护的发明
  - The reason or motivation to combine *can come from any source, including common sense*
    合并的理由或动机可*以来自任何来源，包括公知常识*
  - While related to utility patents, the patent statute discussed in KSR applies to design patents as well
    虽然与发明专利有关，但 KSR 中讨论的专利法规也适用于外观设计专利

En Banc Rehearing
全庭重审

- The CAFC analyzed the KSR decision and concluded that the Rosen-Durling test was inconsistent with KSR's rejection of *rigid rules that deny factfinders recourse to common sense*

  CAFC 分析了 KSR 并得出结论，Rosen-Durling 测试与 KSR 否决*"拒绝事实调查者诉诸常识"*的僵化规则不一致

- The Federal Circuit also ruled that the Rosen-Durling test conflicted with Whitman Saddle, the Supreme Court's seminal case on design-patent obviousness

  Rosen-Durling 测试与最高法院关于外观设计专利创造性的开创性案件 Whitman Saddle 相冲突

Whitman Saddle Review
Whitman Saddle案件的回顾

- In Whitman Saddle, the Supreme Court considered whether an ornamental design for a saddle was patentable in view of two prior art saddles
- The Supreme Count found the patented design to be little more than a combination of the front half of one saddle and the back half of the other and held that it was not inventive to merely 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*

Whitman Saddle 一案有关一种马鞍装饰设计是否可以在现有两种马鞍的情况下获得专利。最高法院认定，该专利设计不过是一个马鞍前半部分和另一个马鞍后半部分的组合，仅仅将这两个马鞍的两半放在一起，并按照业内的普通技能和通常方式组装起来，因此并不具有创造性。

Whitman Saddle Review
Whitman Saddle案件的回顾

- The CAFC noted that, in Whitman Saddle, the Supreme Court did not attempt to determine whether either saddle had "basically the same" design as the patented design, or whether the two saddles were "so related … that the appearance of certain ornamental features in one would suggest the application of those features to the other"
- In fact, because each prior art saddle disclosed only half of the "new" saddle design, neither one could have been said to have "basically the same" design as the new design
- Thus, the requirements of the Rosen-Durling test conflict with the Supreme Court's analysis in Whitman Saddle

Rosen-Durling 测试*基本相同、高度相关*的要求与最高法院在 *Whitman Saddle* 案中的分析相冲突

En Banc Decision
全院庭审的决定

- After overturning the Rosen-Durling test, the CAFC ruled that design-patent obviousness should be assessed going forward using the factors set forth in the Supreme Court's decision in Graham v. John Deere Co. ("Graham" - 1966)

推翻Rosen-Durling测试后，CAFC 裁定今后应使用最高法院在 Graham v. John Deere Co. 案中的因素来评估外观设计专利的创造性

- The Graham factors include: Graham因素包括：
  - the scope and content of the analogous prior art; 现有设计的范围和内容
  - the differences between the prior art designs and the patented design; 现有设计与争议设计之间的差异
  - the level of skill of an ordinary designer in the field;本领域普通设计者的水平 and
  - secondary considerations of non-obviousness, such as: commercial success, long-felt but unsolved needs, failure of others, etc.
    非显而易见的次要考虑因素，例如：商业成功、长期存在但未解决的需求、他人的失败等

En Banc Decision
全院庭审的决定

- Regarding whether a designer of ordinary skill had a reason to combine the prior art, consistent with KSR, the CAFC held that the reason *need not come from the references themselves*

  关于普通设计者是否有理由结合现有技术，与 KSR 一致，CAFC 认为理由*不必来自对比设计本身*

- There only must be *some record-supported reason* (not based on improper 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

  只需有一些记录支持的理由，本领域的普通设计者会使用次要对比设计中的特征修改主要对比设计就足够

En Banc Decision Ramifications
全院庭审决定的影响

- Obtaining design patents may be more challenging
  获得设计专利可能更具挑战性
  - By overturning the Rosen-Durling test, the criteria for obviousness *during examination* of design patent applications has been broadened to coincide with the KSR criteria
    通过推翻*Rosen-Durling*测试，设计专利的创造性审查标准已扩大到与KSR标准一致
  - By doing so, Examiners will now be able to more easily reject design patent applications in the future
    通过这样做，审查员现在可以更容易驳回外观设计专利申请

En Banc Decision Ramifications
全院庭审决定的影响

- However, this is analogous to the examination of utility patents since KSR was decided
  - The Supreme Court in KSR held that the TSM test was "too rigid" and that Examiners should have the ability to combine prior art based on any reasonable rationale
  - Similarly, the Rosen-Durling test was also found to be "too rigid" and other considerations can be used
  - Now, there is a more flexible test for obviousness

类比KSR 对发明专利的审查标准，*Rosen-Durling* 测试也被认定"过于僵化"，因此，现在有了一个更灵活的创造性判断标准。

Questions

Thank You

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