

No. 22-1253

**United States Court of Appeals
for the Federal Circuit**

LKQ CORPORATION, KEYSTONE AUTOMOTIVE INDUSTRIES, INC.,

Appellants,

v.

GM GLOBAL TECHNOLOGY OPERATIONS LLC,

Appellee.

ON APPEAL FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE,
PATENT TRIAL AND APPEAL BOARD IN INTER PARTES REVIEW NO.
PGR2020-00055

**APPELLEE GM GLOBAL TECHNOLOGY OPERATIONS LLC'S
RESPONSE TO APPELLANTS' REQUEST FOR REHEARING EN BANC**

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Dated: May 10, 2023

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 22-1253
Short Case Caption LKQ Corporation v. GM Global Technology Operations LLC
Filing Party/Entity GM Global Technologies Operations LLC

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Name: Joseph A. Herriges

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INTRODUCTION

This case is about the Board’s factual determination that LKQ failed to make even the most basic presentation of evidence that would allow for an adequate comparison between the claimed design and the prior art. It is about a failure of evidence, not an unduly rigid approach to obviousness. And while LKQ did not raise the issue before the Board, it now seeks to leverage this loss into a rewrite of design patent obviousness framework that has otherwise remained unchallenged for decades, including since *KSR*. The Court should reject that invitation.

Fundamentally, *KSR* does not address the unique obviousness issues present in design patents and does not overrule *Rosen* or the *Durling* framework for design patent obviousness, expressly or otherwise. As the panel noted, in the more than fifteen years since *KSR*, the Court “has decided over fifty design patent appeals,” consistently applying *Rosen* and *Durling*. PD at 13. *Rosen* and *Durling* provide a framework for assessing the unique issues in design patent cases; nothing in *KSR* precludes the use of such a framework.

Even if the *Durling* framework could be applied in an overly rigid way, as LKQ suggests with its *Whitman Saddle* argument, that most certainly did not happen here. LKQ chose to rely on a limited view of the Leopard reference, in which many of the claimed features were not visible at all. *See* Appx0018; *see*

also Appx0042; Appx0050. Even under the most flexible obviousness test, factual findings about such evidentiary deficiencies pose no issue.

Simply put, nothing in LKQ’s petition raises an issue that merits rehearing. The petition should be denied, and the majority’s decision based on the facts in this case should be left intact.

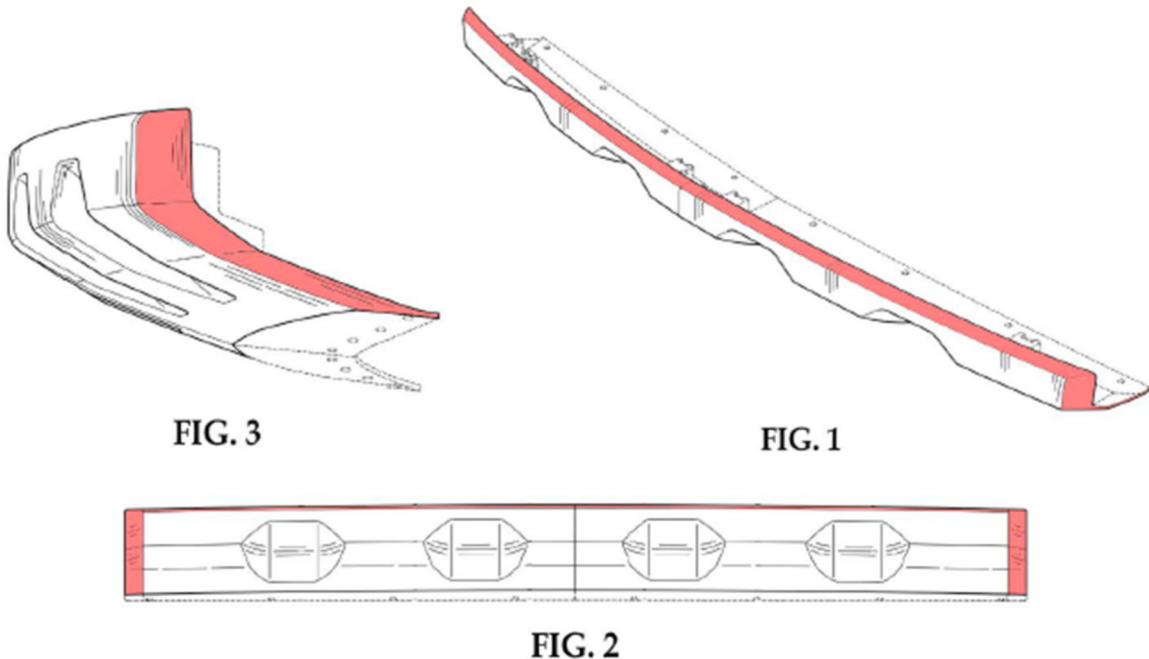
BACKGROUND

I. THE BOARD FINDS GM’S INNOVATIVE SKID BAR DESIGN NOT OBVIOUS.

This is a highly factual case about GM’s innovative skid bar design, and the Board’s repeated finding that LKQ’s evidence was “not sufficient to enable an objective comparison” of the prior art and the claimed design. *See* Appx0018; *see also* Appx0042 (“[T]he evidence produced is not sufficient to enable an objective comparison with the claimed bottom and side views, and the bottom of the front view is unclear in the images of the Leopaard.”); Appx0050 (same).

GM is a leader in vehicle design and automotive engineering. One of its innovations relates to the skid bar design used in the 2020 Chevrolet Silverado HD, and claimed in the ’508 Design. Appx0066-0071. This design includes a cohesive set of features that contribute to its unique overall appearance, including a prominent front surface, outwardly projecting top and side surfaces, distinctive front recesses, and significant side-to-side curvature. Appx0713-718. These features create an “imposing appearance” of “strength, durability, and capability.”

Appx0724; *see also* Appx0045-0046; Appx0713-714. Below is the claimed design:



Appx0731.

Before the Board, LKQ’s invalidity analysis focused on a publication showing a limited view of the Leopaard reference, which the Board found did not “enable an objective comparison [of the Leopaard] with the claimed bottom and side views” of the ’508 Design. Appx0042. Given this deficiency, the Board found for many of the ’508 Design’s relevant features that LKQ had failed to provide adequate evidence to compare the appearances of the claimed design and the prior art. Appx0043 (“These failures in evidence impact both the ordinary observer and the designer of ordinary skill analysis whereas *the overall claimed design cannot be accurately compared to the Leopaard vehicle.*”) (emphasis

added). Beyond that, the Board also made the factual determination, relying on testimony from both GM and LKQ's experts, that what was shown in the Leopard reference created "an overall ornamental design that is not basically the same" as the '508 Design. Appx0058.

In conducting its analysis, the Board relied on the prevailing *Rosen* standard, which was the standard that both parties advocated. Appx0057; *see also* Appx0207 (LKQ arguing that "[t]he Leopard is 'a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design.'") (citation omitted). Indeed, while LKQ now claims that *KSR* overruled the *Rosen* primary reference requirement, it did not raise this issue before the Board. Instead, it only made cursory mention of the *second* step in the *Durling* test—the "so related" test. And even then, LKQ did not claim the "so related" test was facially inconsistent with *KSR*, but instead objected to the test being applied in an "overly restrictive" manner. Appx0187 ("To the extent the 'so related' test operates to unduly limit the scope of design patent obviousness, such an overly restrictive view would run afoul of *KSR*'s proscription against rigid restrictions on the scope of an obviousness analysis."). Further, LKQ did not mention the *Whitman Saddle* argument it raises now.

II. THE PANEL PROPERLY AFFIRMS THE BOARD'S VALIDITY DETERMINATION.

Although LKQ did not raise the issue before the Board, its appeal contended that *KSR* implicitly overruled *Rosen*'s primary reference requirement. The panel majority declined to find that LKQ forfeited its *KSR* argument. PD at 12.

However, the majority held that “*KSR* did not involve or discuss design patents.” *Id.* at 12-13. It also stated that in the “more than fifteen years since *KSR* was decided, this court has decided over fifty design patent appeals[,]” and has “continually applied *Rosen* and *Durling*” framework with only rare and tangential challenge to its application. *Id.* at 13. LKQ's challenge was “therefore an outlier” amidst the accepted *Rosen* and *Durling* framework. *Id.* Because *KSR* did not present a “clear directive” that it overruled *Rosen* or *Durling*, the majority applied the existing framework and concluded the Board's non-obviousness determination was supported by substantial evidence. *Id.* at 13-15. In particular, the majority credited the Board's determination that LKQ's deficient evidence “amounts to a failure of proof.” *Id.* at 15.

Providing additional views, Judge Lourie wrote to address (and reject) the merits of LKQ's argument that *KSR* overruled the *Durling* framework.

Specifically, Judge Lourie noted that design patents are “distinct types of patent[s]” that present different considerations when determining obviousness, which *KSR* did not address. Lourie, J. additional views at 2-3. Judge Lourie also

stated that *Rosen*'s primary reference requirement "hardly reflects the rigidity that Court was condemning in *KSR*," and, indeed, presents a necessary starting point. *Id.* at 4 ("One has to start from somewhere.") Judge Stark, as he did in the companion appeal concerning the '625 Design, would have found that LKQ had forfeited the *Rosen* argument by failing to raise it before the Board. Stark, J. concurring at 1-2.

REASONS FOR DENYING THE PETITION

There are no "exceptional circumstances" or contrary precedents to justify *en banc* review. Rather, the panel correctly applied the prevailing *Rosen* standard to uphold a highly factual determination that LKQ failed to prove GM's '508 Design was obvious. Now LKQ claims that the panel's application of the *Rosen* standard was inconsistent with *KSR*. Not so. *KSR* did not address design patents and this Court has consistently (and correctly) continued to apply *Rosen* to assess the unique issues in design-patent obviousness for the last fifteen years since *KSR*. At bottom, this case came down to factual determinations that LKQ failed to meet its burden, not the application of an unduly restrictive test for obviousness. Indeed, because of LKQ's evidentiary deficiencies, its obviousness bid would fail under any obviousness test, making this case a poor vehicle for *en banc* review.

I. *KSR* DID NOT ADDRESS DESIGN PATENTS OR OVERRULE *ROSEN*

The Court should first reject LKQ’s request for *en banc* review because *KSR* did not address design patents and does not speak to the test for design patent obviousness.

In *KSR*, the Supreme Court addressed this Court’s longstanding requirement in the utility patent context that the prior art must provide a “teaching, suggestion, or motivation” to combine references and find claims obvious. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419-22 (2007). Notably, this teaching, suggestion, and motivation test was historically only applied to utility inventions, not design patents. As such, when the Supreme Court rejected this test as overly “rigid,” it was not speaking to obviousness law generally—it was rejecting a specific test, applied to a specific type of patent. *KSR*, 550 U.S. at 419. Indeed, *KSR* does not even mention design patents, much less address the different obviousness considerations at play in the design patent context. Lourie, J. additional views at 2-4.¹ As Judge Lourie aptly recognized, “[s]urely [the Supreme Court] did not intend to speak to obviousness of designs, and what was said about a test long applied to

¹ LKQ claims that *Titan Tire* recognized that *KSR* “likely applies to design patents.” LKQ Br. at 16. What the Court actually stated, in *dicta*, was a far cry from what LKQ represents: “it is not obvious that the Supreme Court necessarily intended to exclude design patents from the reach of *KSR*.” *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1385 (Fed. Cir. 2009).

utility inventions was not indicated to apply to design patents.” *Id.* That is particularly true because design patents had their own longstanding test for obviousness—the *Durling* test—which was not once mentioned or discussed in *KSR*. The Supreme Court thus cannot “reasonably be held to have overruled a precedent of one of [this Court’s] predecessor courts involving a type of patent it never mentioned.” *Id.*

Given *KSR*’s focus on utility patents, it is unsurprising that “in the more than fifteen years since *KSR* was decided, this court has decided over fifty design patent appeals. . . [and] has continually applied *Rosen* and *Durling* just as it had in the decades preceding.” PD at 13; *see also, e.g., Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275-76 (Fed. Cir. 2021) (*Campbell II*) (Moore, J.) (applying the *Rosen* and *Durling* framework); *Spigen Korea Co., Ltd. v. Ultraproof, Inc.*, 955 F.3d 1379, 1383-85 (Fed. Cir. 2020) (Reyna, J.) (same); *Apple, Inc. v. Samsung Elecs. Co., Ltd et al.*, 678 F.3d 1314, 1329-32 (Fed. Cir. 2012) (Bryson, J.) (same). While perhaps not determinative, this uninterrupted application of the *Durling* framework, with no substantive mention of *KSR* or objection from the parties that litigated these matters, indicates that *KSR* does not speak to design patent obviousness at all.

II. ***ROSEN AND DURLING PRESENT A PROPER FRAMEWORK FOR DESIGN PATENTS, NOT A RIGID PREVENTATIVE RULE***

Even if *KSR* applied to design patents, *Rosen* and *Durling* are consistent with *KSR* as a general matter and as applied in this case.

A. **The *Durling* Framework Does Not Run Afoul of *KSR*.**

Likely recognizing that the evidentiary deficiencies in this case preclude any legitimate claim that the Board applied *Rosen* in an unduly restrictive way, LKQ focuses on whether the *Durling* framework is per se inconsistent with *KSR*. It is not.

1. ***KSR* Permits The Use of Frameworks for Assessing Obviousness.**

Nothing in *KSR* precludes the use of parameters in the obviousness analysis. Indeed, *KSR* only disapproved of a particular type of rigidity: one that “den[ies] factfinders recourse to common sense.” *KSR*, 550 U.S. at 421. Consistent with those teachings, this Court has often implemented frameworks to address obviousness in a variety of contexts to guide the inquiry and avoid the traps of hindsight reconstruction. For example, in the utility context, a reference can only be considered as prior art if it is analogous to the claimed invention. *See 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.”); *Jurgens v. McKasy*, 927 F.2d 1552, 1559 (Fed. Cir. 1991) (“And if we presume that the Dacian windsock is not analogous art, it has no bearing on the

obviousness of the patent claim”). In the context of new chemical compounds, post-*KSR*, the lead-compound test requires a “known compound” as a starting point, and a reason to modify that compound in order establish prima facie obviousness. See *Takeda Chem. Indus. Ltd. et al. v. Alphaparm Pty., Ltd.*, 492 F.3d 1350, 1357 (Fed. Cir. 2007) (holding, post-*KSR*, that “in cases involving new chemical compounds, it remains necessary [after *KSR*] to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound.”); *Eisai Co., Ltd. et al. v. Dr. Reddy’s Lab’ys, Ltd.*, 533 F.3d 1353, 1359 (Fed. Cir. 2008) (“Teva cannot create a genuine issue of material fact on obviousness through the unsupported assertion that compounds other than lansoprazole might have served as lead compounds.”). As shown above, this Court has used these frameworks, post-*KSR*, to reject obviousness challenges based on the failure to identify a proper primary reference.

2. The *Durling* Framework is not Unduly Rigid, but Presents a Proper Framework for Addressing Design Patents.

The *Durling* framework, like other obviousness frameworks this Court has endorsed, is an appropriate way to address the unique obviousness issues that design patents present.

Unlike the mechanical patent at issue in *KSR*, design is an unpredictable and subjective art. A design patent does not contain an articulation of the claim

elements, but instead relies on subjective considerations “such as the overall appearance, visual impressions, artistry, and style of ornamental subject matter.”

Lourie, J. additional views at 3. As the *Durling* court stated, this subjectivity makes the analysis “more complicated because it involves an additional level of abstraction not required when comprehending the matter claimed in a utility patent.” *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996).

When assessing the obviousness of design patents, the ultimate issue is “whether one of ordinary skill would have combined teachings of the prior art to create the same *overall* visual appearance as the claimed design.” *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1380-81 (Fed. Cir. 2009) (emphasis added) (quotation marks omitted). To answer this question, *Durling* articulates a framework in which the factfinder answers two primary questions: (1) whether there is a *Rosen* reference—one that creates “basically the same visual impression” as the claimed design; and (2) if a *Rosen* reference exists, whether there are one or more secondary references that 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 (quotation marks omitted). This framework serves as an objective anchor to the analysis—one that even LKQ must concede is “helpful” and “rationally motivated,” LKQ Br. at 14—focusing

the inquiry on the “overall visual appearance” of the design, and avoiding a pick-and-choose cobbling of prior art infected by hindsight. As Judge Lourie observed, “in any obviousness analysis, the question is whether the claimed invention was obvious, but obvious over *what*. One has to start from somewhere.” Lourie, J. additional views (emphasis in original). This sentiment is echoed by Professor Burstein, whom LKQ cites in its brief:

The primary reference requirement performs the valuable function of focusing the nonobviousness inquiry on the design ‘as a whole.’ If a new design is so different from other products of its type that no primary reference can be found, that would generally be strong evidence of nonobviousness.

SARAH BURSTEIN, VISUAL INVENTION, 16 LEWIS & CLARK L. REV. 169, 200 (2012).

At the same time, however, the test permits significant flexibility, allowing a fact finder to rely on common sense to find obviousness, even where ornamental features are “entirely absent” from the prior art. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1335 (Fed. Cir. 2014) (“[O]n numerous occasions we have invalidated design patents despite the inclusion of ornamental features that were entirely absent from prior art designs.”)

In arguing against the *Durling* framework, LKQ significantly overstates its rigidity. Far from imposing rigid limitations, *Rosen* posits an open-ended question, asking a fact finder to determine “almost instinctively” whether two designs create

“basically the same visual impression”—whether any differences are slight or substantial. *Id.* (quotation marks omitted).

Rosen itself refers to the primary-reference requirement as merely “an adequate starting point, a basic reference which embodies similar design concepts.” *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A 1982). More recently, the *Campbell II* decision framed *Rosen*’s “basically the same” analysis as one that looks for “substantial differences” or differences that would require “major modifications.” 10 F. 4th at 1273 (quotation marks omitted).

The test also allows consideration of the ordinary designer’s creativity, and leaves ample room for the kind of common sense that *KSR* was worried about. As the Court recognized in *Campbell I*, a factfinder can still find a reference to be a proper *Rosen* reference even if the claimed design elements are not expressly shown. *Campbell Soup Co. v. Gamon Plus, Inc.*, 939 F.3d 1335, 1340-41 (Fed. Cir. 2019) (*Campbell I*) (holding that the prior art was a proper *Rosen* reference, despite the absence of a claimed can). Other post-*KSR* decisions have similarly illustrated the flexibility and fact-intensive nature of *Rosen*’s primary reference requirement. *See Golden Eye Media USA, Inc. v. Evo Lifestyle Prods. Ltd.*, 2021-2096, 2022 WL 2232517, at *4 (Fed. Cir. 2022) (non-precedential) (“Despite Doyle having a different handle design and location, horizontal rods that differ in length and design, and a less rectangular shape [than the patented design], the court

concluded that the two designs created ‘basically the same’ visual impression.”); *MRC*, 747 F.3d at 1333 (“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.”) Simply put, *Rosen* merely requires an “adequate starting point” for the obviousness analysis, *Rosen*, 673 F.2d at 391, and this requirement (particularly as applied in this case) “hardly reflects the rigidity the [Supreme] Court was condemning in *KSR*,” Lourie, J. additional views at 4.

LKQ also waxes about *KSR*’s emphasis on “design need” or “market pressure” that might inform an obviousness analysis, LKQ Br. at 11, but cites nothing to support its argument that *Rosen* precludes reliance on such facts. Further, nothing in *KSR* mandates (or even permits) finding obviousness based on such vague arguments without at least one supporting reference in an analogous art to supply the relevant limitations, nor does LKQ cite any case that would permit such an unhinged analysis. See LKQ Br. at 11; see also *K/S Himpp v. Hear-Wear Techs., LLC*, 751 F.3d 1362, 1366 (Fed. Cir. 2014) (finding that an examiner may not rely on his common knowledge without a supporting prior art reference) (citing M.P.E.P. § 2144.03); *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1361 (Fed. Cir. 2016) (“[C]ommon sense is typically invoked to provide a known *motivation to combine*, not to supply a missing claim limitation.”) (emphasis in original).

Second, while LKQ largely gives the second step of *Durling* the back of the hand, it too poses no problem. The second step of *Durling* asks whether any secondary references exist that 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 (brackets in original). As with the first step, this step merely recognizes the ease with which hindsight can dominate the design patent analysis and combats that with a principled approach to evaluating secondary references; namely, by looking to secondary references that are “closely akin” to the claimed design. *MRC*, 747 F.3d at 1334-35 (quotation marks omitted). As this Court has explained, the “mere similarity in appearance” between two designs can provide the motivation to “apply certain features” of one design “to another design.” *Id.* As such, this step allows for ample flexibility because it simply requires a fact finder to determine whether a secondary reference is similar enough to the primary reference to warrant combination, without any strict requirements on how to make that determination. Indeed, this Court has upheld obviousness findings where the primary and secondary reference combination does not describe all of the claimed design elements, further evidencing the flexibility in the *Durling* test. *See id.* (noting that “no prior art reference” contained the ornamental stitching of the claimed design but upholding

the obviousness determination because the stitching “was not a ‘substantial’ difference”).

In short, the *Durling* test appropriately balances the unique considerations of design patents with the need for a flexible approach to obviousness and thus does not run afoul of *KSR*.

B. *Rosen* was not applied in an overly restrictive manner here.

Even if *Rosen* could be applied in an overly rigid manner, as LKQ suggests with its *Whitman Saddle* argument, that most certainly did not happen in this case. Instead, LKQ’s case before the Board failed because of significant evidentiary deficiencies. LKQ chose to rely on a limited view of the Leopaard reference, in which many of the claimed features were not visible at all. *See* Appx0018; *see also* Appx0042; Appx0050. The Board’s finding that such a deficient reference did not depict “basically the same” design as the claimed design should not be, and is not, controversial under even the most flexible application of the *Rosen* test.

III. THIS CASE IS A POOR VEHICLE FOR *EN BANC* REVIEW.

In addition to the intensely factual nature of the Board’s decision, LKQ’s failure to raise this issue before the Board makes this case a poor vehicle for review. As Judge Stark recognized in the companion appeal on the ’625 Design, should this Court decide to evaluate the “vitality of the *Durling* test post-*KSR*” it should do so “most preferably [in] a case in which [this Court] has the benefit of

the tribunal of first instance's analysis." Stark, J. concurring at 13. That is not this case.

Nor is this a case where the outcome is likely to change depending on this Court's ultimate decision on *Durling*. The Board made factual findings independent of the obviousness inquiry that the prior art on which LKQ relied did not allow for an adequate comparison between it and the claimed design. Appx0018; Appx0042; Appx0050. No matter what test is applied, if the differences between the prior art the claimed design cannot be discerned, then there is no way to evaluate whether an ordinary designer would have found it obvious to modify the prior art to achieve the claimed design. In short, LKQ falls well short in its burden to prove obviousness under any test, making this case a poor vehicle for *en banc* review.

CONCLUSION

For the reasons discussed, the Court should deny LKQ's Petition.

Dated: May 10, 2023

Respectfully submitted,

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Technology Operations LLC*

CERTIFICATE OF COMPLIANCE

The foregoing document is submitted in accordance with the type-volume limitation of Fed. Cir. R. 32(b). The Response brief contains 3,758 words, excluding the parts of the brief exempted by Fed. R. App. P. 5(c), Fed. R. App. P. 21(d), Fed. R. App. P. 27(d)(2), Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b)(2). This Response brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in Times New Roman, 14 Point.

Dated: May 10, 2023

/s/ Joseph A. Herriges
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