

No. 21-2348

**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.
IPR2020-00534

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

Joseph A. Herriges
John A. Dragseth
FISH & RICHARDSON P.C.
60 South 6th Street
Suite 3200
Minneapolis, MN 55402
(612) 335-5070

Nitika Gupta Fiorella
FISH & RICHARDSON P.C.
222 Delaware Avenue, 17th Floor
Wilmington, DE 19801
(302) 652-5070

*Attorneys for Appellee
GM Global Technology Operations LLC*

Dated: May 10, 2023

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

CERTIFICATE OF INTEREST

Case Number 21-2348

Short Case Caption LKQ Corporation v. GM Global Technology Operations LLC

Filing Party/Entity GM Global Technologies Operations LLC

Instructions:

1. Complete each section of the form and select none or N/A if appropriate.
2. Please enter only one item per box; attach additional pages as needed, and check the box to indicate such pages are attached.
3. In answering Sections 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance.
4. Please do not duplicate entries within Section 5.
5. Counsel must file an amended Certificate of Interest within seven days after any information on this form changes. Fed. Cir. R. 47.4(c).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 05/10/2023

Signature: /s/ Joseph A. Herriges

Name: Joseph A. Herriges

FORM 9. Certificate of Interest

Form 9 (p. 2)
March 2023

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input type="checkbox"/> None/Not Applicable</p>
<p>GM Global Technology Operations LLC</p>		<p>General Motors Company</p>

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable Additional pages attached

Dorothy P. Whelan	Craig Deutsch	Grace Kim
Jennifer Huang	Fish & Richardson P.C.	

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

Yes (file separate notice; see below) No N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable Additional pages attached

TABLE OF CONTENTS

	Page
INTRODUCTION	1
BACKGROUND	2
I. The Board Finds GM’s Innovative Fender Design Not Obvious.	2
II. The Panel Properly Affirms the Board’s Validity Determination.	4
REASONS FOR DENYING THE PETITION	5
I. <i>KSR</i> Did Not Address Design Patents or Overrule <i>Rosen</i>	6
II. <i>Rosen</i> and <i>Durling</i> Present a Proper Framework for Design Patents, Not a Rigid Preventative Rule.....	8
A. The <i>Durling</i> Framework Does Not Run Afoul of <i>KSR</i>	8
1. <i>KSR</i> Permits The Use of Frameworks for Assessing Obviousness.	8
2. The <i>Durling</i> Framework is not Unduly Rigid, but Presents a Proper Framework for Addressing Design Patents.	10
B. <i>Rosen</i> was not applied in an overly restrictive manner here. ...	15
III. This Case is a Poor Vehicle for <i>En Banc</i> Review.....	16
CONCLUSION	16
CERTIFICATE OF COMPLIANCE.....	18

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple, Inc. v. Samsung Elecs. Co., LTD et al.</i> , 678 F.3d 1314 (Fed. Cir. 2012)	7
<i>Campbell Soup Co. v. Gamon Plus, Inc.</i> , 10 F.4th 1268 (2021)	7, 13
<i>Campbell Soup Co. v. Gamon Plus, Inc.</i> 939 F.3d 1335 (Fed. Cir. 2019)	13
<i>Durling v. Spectrum</i> , 101 F.3d 100 (Fed. Cir. 1996)	<i>passim</i>
<i>Eisai Co. v. Dr. Reddy’s Lab’ys, Ltd.</i> , 533 F.3d 1353 (Fed. Cir. 2008)	9
<i>Golden Eye Media USA, Inc. v. Evo Lifestyle Prods. Ltd.</i> , 2021-2096 2022 WL 2232517 (Fed. Cir. 2022)	13
<i>Jurgens v. McKasy</i> , 927 F.2d 1552 (Fed. Cir. 1991)	9
<i>In re Klein</i> , 647 F.3d 1343 (Fed. Cir. 2011)	9
<i>In re Rosen</i> , 673 F.2d 388 (C.C.P.A. 1982)	<i>passim</i>
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	<i>passim</i>
<i>MRC Innovations, Inc. v. Hunter Mfg., LLP</i> , 747 F.3d 1326 (Fed. Cir. 2014)	12, 14
<i>Spigen Korea Co., Ltd. v. Ultraproof, Inc.</i> , 955 F.3d 1379 (Fed. Cir. 2020)	7
<i>Takeda Chem. Indus. Ltd. et al. v. Alphaparm Pty., Ltd.</i> , 492 F.3d 1350 (Fed. Cir. 2007)	9

Titan Tire Corp. v. Case New Holland, Inc.,
566 F.3d 1372 (Fed. Cir. 2009)7, 10

Other Authorities

Sarah Burstein, Visual Invention, 16 Lewis & Clark L. Rev. 169, 200 (2012)11

INTRODUCTION

This case is about the Board’s factual determination that LKQ’s chosen prior art was simply too different to anticipate or render obvious the ’625 patent design. It is about LKQ’s failure to meet its burden, 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 evaluating 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 reference that the Board properly found had multiple, immediately apparent differences from the claimed design. *See*

Appx0053-0057. Even under the most flexible obviousness test, factual findings about prior art differences pose no issue.

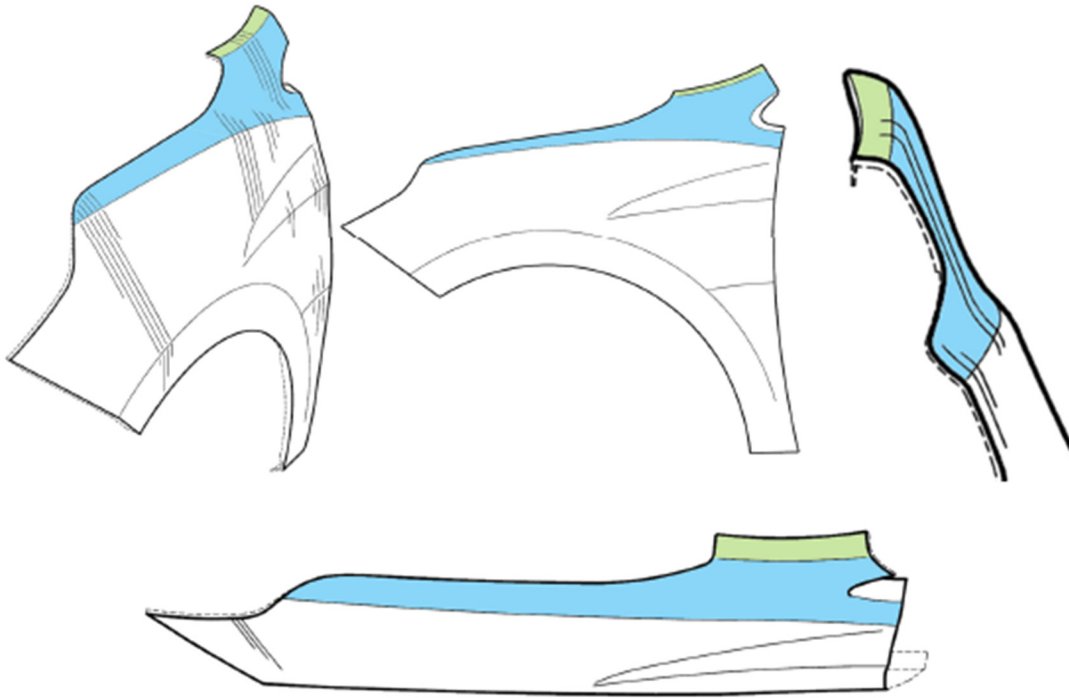
Simply put, nothing in LKQ's petition raises an issue that merits rehearing. The petition should be denied, and the majority's decision based on the facts in this case should be left intact.

BACKGROUND

I. THE BOARD FINDS GM'S INNOVATIVE FENDER DESIGN NOT OBVIOUS.

This is a highly factual case about GM's innovative front fender design claimed in the '625 Design, and the Board's supported finding that LKQ did not meet its burden on anticipation or obviousness.

GM is a leader in vehicle design and automotive engineering. One of its innovations relates to a unique design for a car's front fender, used in GM's 2018-2020 Chevrolet Equinox. Appx0882-0884. This design includes a cohesive set of features that contribute to its unique overall appearance, including a prominent wheel arch, a smooth, curved door cut line and protrusion, and distinctive sculpting and creases. Appx0713-718. These features evoke a smooth, continuous, and curved look—as opposed to, for example, a more angular design like the prior art. Appx0901-0907. The claimed '625 Design is shown below:



Appx0823.

Before the Board, LKQ’s invalidity analysis focused on the Lian patent, which the Board found was different in multiple key respects from the claimed design. Appx0030-0045. Relying on testimony from both GM and LKQ’s experts, the Board made the factual finding that “a complete visual comparison of the overall appearance of both designs sufficiently shows that the two designs are quite different.” Appx0053.

In conducting its analysis, the Board relied on the prevailing *Rosen* standard, which was the standard that both parties advocated when briefing and arguing the issue. Appx0048-0058. 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. Appx0174 (“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 12-13. However, the majority held that “*KSR* did not involve or discuss design patents.” *Id.* at 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*” with only rare and tangential challenge to its application. *Id.* 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

design-patent obviousness framework and concluded the Board’s non-obviousness determination was supported by substantial evidence. *Id.* at 13-15.

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 stated he would have found that LKQ forfeited the *Rosen* argument by failing to raise it before the Board. Stark, J. concurring at 1-10.

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 ’625 Design was obvious. Now, in an argument that it did not raise before the Board, 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 by the Board that LKQ failed to meet its burden, not the application of an unduly restrictive test for obviousness. Indeed, because of the multiple and significant differences between the prior art and the claimed design, LKQ’s 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 based on *KSR* 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, 418-22 (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 utility inventions was not indicated to apply to design patents.” *Id.* at 3. That is particularly true given that design patents had their own longstanding test for obviousness—the *Durling* test—which was not once mentioned or discussed by the Supreme Court 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.* at 4.

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*

¹ LKQ claims that *Titan Tire* recognized that *KSR* “likely applies to design patents.” LKQ Br. at 19. 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).

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.

Because *KSR* does not speak to design patents and does not overrule this Court's longstanding *Durling* framework, this Court should reject LKQ's petition.

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 significant differences between Lian and the claimed design 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).

The first question encompasses two steps: one must first “discern the correct visual impression created by the patented design” and second “determine whether there is a single reference that creates ‘basically the same visual impression’ as the claimed design.” *Id.*

This framework serves as an objective anchor to the analysis—one that even LKQ concedes is “helpful” and “rationally motivated,” LKQ Br. at 17—focusing the inquiry on the “overall visual appearance” of the design as a whole, and steering the analysis away from a pick-and-choose cobbling of prior art infected by hindsight. As Judge Lourie explained, “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 at 4 (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. The first prong of the *Rosen* test—requiring a correct discernment of the visual impression of the claimed design—merely requires that all aspects of a patented design be evaluated as a prerequisite to finding the design obvious. That is not controversial, much less contrary to *KSR* or *Markman*;² rather, it is similar to the well-established rule requiring each claim element be evaluated in a utility patent case.

On the second *Rosen* prong, far from imposing rigid limitations, it posits an open-ended question, asking a fact finder to determine “almost instinctively”

² LKQ’s complaint appears to be with the Board’s application of this prong; namely, that the Board put the burden on LKQ to discern the correct visual impression and found it failed to do so. LKQ Br. at 11-12. But the Board went on to find LKQ failed in its burden on the second prong of the *Rosen* requirement as well. Appx0050-0051. The Board’s treatment of an issue that was not necessary to resolving the case cannot supply the exceptional circumstances necessary to warrant *en banc* review.

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 it has been applied, “hardly reflects the rigidity the [Supreme] Court was condemning in *KSR*,” Lourie, J. additional views at 4.

Second, while LKQ largely gives the second step of *Durling* the back of the hand, it too poses no problem under *KSR*. 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 holdings 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 chose to rely on reference with not just a few differences from the claimed design, but multiple identifiable differences that the Board properly found based on expert testimony were meaningful in assessing the designs’ overall appearance. Appx0014-0017; Appx0053-0058. The Board’s finding that such a 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, 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 that the prior art was simply too different in too many ways to anticipate or render the claimed design obvious. 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,

/s/ Joseph A. Herriges

Joseph A. Herriges

John A. Dragseth

FISH & RICHARDSON P.C.

60 South 6th Street, Suite 3200

Minneapolis, MN 55402

(612) 335-5070

herriges@fr.com; dragseth@fr.com

Nitika Gupta Fiorella

FISH & RICHARDSON P.C.

222 Delaware Avenue, 17th Floor

Wilmington, DE 19801

(302) 652-5070

fiorella@fr.com

*Attorneys for Appellee GM Global
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 3,609 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

Joseph A. Herriges