

**COULDA, SHOULDA, WOULD: WHY FEDERAL COURTS
CAN AND SHOULD APPLY A WOULD STANDARD TO THE
NON-OBVIOUSNESS REQUIREMENT OF DESIGN PATENT
LAW**

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I. INTRODUCTION

Design patent law has long been treated as a “trivial anomaly,”¹ an “awkward offspring of the utility patent system,”² and a “red-headed

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1. Charles E. Colman, *Design and Deviance: Patent as Symbol, Rhetoric as Metric*, 55 JURIMETRICS J. 419, 420 (2015).

2. Janice M. Mueller & Daniel Harris Brean, *Overcoming the “Impossible Issue” of Nonobviousness in Design Patents*, 99 KY. L.J. 419, 423 (2011).

stepchild of the intellectual property world.”³ Until recently, policymakers, courts, and legal scholars have afforded little attention to design patents.⁴ In 2016, the Supreme Court broke its 123-year silence in design patent law with its decision in *Samsung Electronics Co. v. Apple Inc.*⁵ This decision, along with the initial jury verdict of over one billion dollars,⁶ garnered new interest among academics and patent filers in design patent law⁷ and ended the historic shortage of academic writing in this area of law.⁸

The United States Patent and Trademark Office (USPTO) issues three types of patents: utility patents, design patents, and plant patents.⁹ Utility patents are by far the most common type of patent granted.¹⁰ In fact, utility patents accounted for approximately 90.5% of patents granted in 2020, compared to design patents at approximately 9% and plant patents at approximately 0.5%.¹¹ This Note will not focus on plant patents due to the small number granted.

The statutory requirements for utility and design patents differ in a critical way. For an invention to be protected by a utility patent, the invention must be useful,¹² meaning capable of providing some

3. Clare O'Connor, *Fashion's 'Apple Vs. Samsung': Spanx Patent War Could Change How Brands Fight Copycats*, FORBES (Apr. 10, 2013, 1:57 PM), <https://www.forbes.com/sites/clareoconnor/2013/04/10/fashions-apple-vs-samsung-spanx-patent-war-could-change-how-brands-fight-copycats/?sh=4f45c1f52b66> [<https://perma.cc/T65Z-2Q44>].

4. Mueller & Brean, *supra* note 2, at 423–24.

5. *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53 (2016).

6. Josh Lowensohn, *Jury Awards Apple More than \$1B, Finds Samsung Infringed*, CNET (Aug. 24, 2012, 3:53 PM), <https://www.cnet.com/tech/tech-industry/jury-awards-apple-more-than-1b-finds-samsung-infringed/> [<https://perma.cc/PDJ7-HLNX>]. *But see* *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983 (Fed. Cir. 2015) (upholding a reduction in damages to nearly \$400 million); *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53 (2016) (remanding to determine damages consistent with its opinion); Jack Nicas, *Apple and Samsung End Smartphone Patent Wars*, N.Y. TIMES (June 27, 2018), <https://www.nytimes.com/2018/06/27/technology/apple-samsung-smartphone-patent.html> [<https://perma.cc/P4LJ-E8D7>] (describing a jury verdict of \$538 million, and that Apple and Samsung settled about a month later).

7. Andrew Beckerman-Rodau, *Design Patent Evolution: From Obscurity to Center Stage*, 32 SANTA CLARA COMPUT. & HIGH TECH. L.J. 53, 54 (2015).

8. *Id.*

9. *See Patent Process Overview*, USPTO, <https://www.uspto.gov/patents/basics/patent-process-overview#step3> (last visited Mar. 19, 2023) [<https://perma.cc/X29A-XURU>].

10. Patent Technology Monitoring Team, *U.S. Patent Statistics Chart*, USPTO (May 2021), https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm [<https://perma.cc/3XWL-GUDJ>].

11. *Id.*

12. 35 U.S.C. § 101.

identifiable benefit.¹³ In contrast, design patents lack the usefulness requirement.¹⁴ Designs must be ornamental, meaning not solely determined by function.¹⁵ A design is functional and not protected by design patent law if the appearance is “‘dictated by’ the use or purpose of the article.”¹⁶ The distinction between functionality and ornamentality underlying the usefulness requirement is the central difference between utility and design patent eligibility.¹⁷

Despite the fundamental differences between utility and design patent eligibility, the statutory requirements of novelty¹⁸ and non-obviousness¹⁹ apply to both utility and design patents.²⁰ The novelty requirement bars patentability if the invention or design to be patented is not new, meaning every claimed limitation or feature of the invention or design can be found in a single piece of prior art.²¹ Non-obviousness bars patentability if the claimed invention or design “would have been obvious...to a person having ordinary skill in the art.”²² Many argue that non-obviousness should not be applied to design patent law at all.²³ Others argue that courts should apply the non-obviousness requirement to design patent law with flexibility.²⁴

13. *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1366 (Fed. Cir. 1999).

14. *Seiko Epson Corp. v. Nu-Kote Int’l, Inc.*, 190 F.3d 1360, 1368 (Fed. Cir. 1999).

15. *Id.*

16. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (quoting *In re Caletti*, 328 F.2d 1020, 1022 (C.C.P.A. 1964)).

17. See David L. Schwartz & Xaviere Giroud, *An Empirical Study of Design Patent Litigation*, 72 ALA. L. REV. 417, 423–24 (2020).

18. 35 U.S.C. § 102.

19. *Id.* § 103.

20. See *id.* § 171(b) (stating that the requirements for utility patent eligibility should apply to design patents unless otherwise provided).

21. *In re Smith Int’l, Inc.*, 871 F.3d 1375, 1381 (Fed. Cir. 2017).

22. 35 U.S.C. § 103.

23. See, e.g., Nicholas P. Mack, Note, *Breaking the Status Quo of International Design Law: How the United States’ Design Law Frustrates the Purpose of the Hague Agreement*, 54 VAND. J. TRANSNAT’L L. 1293 (2021) (arguing that the non-obviousness requirement should be eliminated from U.S. design patent law to allow the U.S. to move closer to uniformity in substantive patent law with other contracting parties to the Hague Agreement). See also Mueller & Brean, *supra* note 2 (noting that the current non-obviousness requirement is misaligned with the creative process and objectives of designers and arguing that combining prior art features to establish obviousness should be restricted or eliminated).

24. See, e.g., Christopher Buccafusco, Mark A. Lemley, & Jonathan S. Masur, *Intelligent Design*, 68 DUKE L.J. 75, 125 (2018) (proposing that the obviousness bar should be raised by eliminating the rigid primary reference requirement of having design characteristics which are basically the same as the claimed design). See also Gregory Mandel, *The Non-Obvious Problem: How the Indeterminate Nonobviousness Standard Produces Excessive Patent Grants*, 42 U.C. DAVIS L. REV. 57 (2008) (arguing that different inventions should have distinct bases of non-obviousness).

The central inquiry for non-obviousness in patent law is whether an invention *would* have been obvious at the time of invention.²⁵ However, modern courts and administrative review agencies are stretching this requirement as applied to design patent law by considering whether a designer of ordinary skill *could* or *should* have changed the prior art to arrive at the claimed invention rather than whether the designer *would* have done so.²⁶

This Note examines the current application of the non-obviousness requirement to design patents in federal courts and post-grant proceedings and argues that courts have drifted impermissibly far from the fundamentals of patent law jurisprudence. The application of a *would* standard to the non-obviousness requirement in utility patent law correctly balances incentives for inventors with the interests of the USPTO in granting patents for new technology. The emerging trend in design patent law of applying a *could* or *should* standard to the non-obviousness requirement decreases the incentives for designers to advance designs in a given field while constructing higher barriers for design patent eligibility. It is not in the interest of the USPTO or public policy to use a *could* or *should* standard for the non-obviousness requirement. Under such a standard, almost nothing would be patentable, which completely thwarts the goals of patent law.

Part II of this Note traces the history of the non-obviousness requirement through utility patent law.²⁷ It also explains the differences in the application of the non-obviousness requirement to design patent law and the reasons that underlie those differences.²⁸ It further discusses recent decisions of the Federal Circuit related to the non-obviousness requirement of design patent law.²⁹ Part III analyzes the legal standard for non-obviousness being applied at the Federal Circuit and argues that modern courts have drifted impermissibly far from established precedent.³⁰ It also proposes modifications to the application of the non-obviousness requirement in design patent law to better align it with the statutory language and goals of the patent law system.³¹ Part IV concludes

25. 35 U.S.C. § 103.

26. *See, e.g.,* MRC Innovations, Inc. v. Hunter Mfg., LLP, 747 F.3d 1326, 1334 (Fed. Cir. 2014) (holding that the mere similarity in appearance between the claimed design and the prior art provides the suggestion that an ordinary designer should apply features of the prior art to the claimed design).

27. *See* discussion *infra* Parts II.A–B.

28. *See* discussion *infra* Part II.C.

29. *See* discussion *infra* Part II.D.

30. *See* discussion *infra* Parts III.A–B.

31. *See* discussion *infra* Part III.C.

that courts should be cautious to apply the correct standard of non-obviousness to avoid inconsistency and illogical results.³²

II. BACKGROUND

A. History of the United States Patent Law System

The United States Constitution grants Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”³³ The First Congress immediately acted upon this grant of power and enacted the Patent Act of 1790.³⁴ This Act granted a limited monopoly, also known as a utility patent, to any applicant that invented or discovered a new and useful “art, manufacture, engine, machine, or device, or any improvement therein.”³⁵ Congress included the statutory requirements of utility and novelty in this Act.³⁶

It was not until 1842, over fifty years after the passage of the Patent Act of 1790, that Congress extended patent protection to designs.³⁷ The Patent Act of 1842 granted a limited monopoly, also known as a design patent, to any applicant that “invented or produced any new and original design for a manufacture.”³⁸ Unlike utility patents, designs to be patented do not need to meet a usefulness requirement.³⁹

Patent protection for designs was further codified in 1952 in 35 U.S.C. § 171.⁴⁰ For a design to be patentable, it must be “novel, original, and ornamental.”⁴¹ The design also must be applied to an article of manufacture,⁴² meaning that design patent law does not protect designs in the abstract, it only protects designs for an identified article.⁴³ Additionally, this statute expressly provides that the requirements for patentability of utility inventions also apply to designs unless otherwise

32. See discussion *infra* Part IV.

33. U.S. CONST. art. 1, § 8, cl. 8.

34. Patent Act of 1790, 1 Stat. 109 (1790) (repealed 1793).

35. *Id.* ch. 7, § 1.

36. See *id.*

37. Patent Act of 1842, ch. 263, § 3, 5 Stat. 543 (1842) (repealed 1952).

38. *Id.*

39. *Id.*

40. 35 U.S.C. § 171.

41. *Id.* § 171(a).

42. *Id.*

43. *Curver Lux., SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1340–41 (Fed. Cir. 2019).

provided.⁴⁴ Thus, a design must satisfy the statutory non-obviousness requirement to be patentable.⁴⁵

Because the non-obviousness requirement in utility and design patent law is based on the same statutory language,⁴⁶ the history of non-obviousness in utility patent law is a helpful tool when evaluating design patent law. Non-obviousness judicial precedent was born out of utility patent law⁴⁷ and later applied to design patents.⁴⁸ Thus, the principles and rationale of the non-obviousness requirement can be more clearly seen through historical utility patent law cases.

B. Statutory Non-Obviousness Requirement for Patentability of Utility Patents

1. History of the Non-Obviousness Requirement

Prior to the codification of non-obviousness in 1952, usefulness and novelty were the only statutory requirements for patentability of a utility invention.⁴⁹ Courts developed the non-obviousness doctrine, with the most notable early example being the Supreme Court case of *Hotchkiss v. Greenwood*.⁵⁰ Although *Hotchkiss* is largely credited as the birth of non-obviousness, lower courts had applied a non-obviousness-type requirement for several years before the Supreme Court decision.⁵¹

In *Hotchkiss*, the patented utility invention was a doorknob made of clay.⁵² The prior art contained doorknobs made of metal and wood.⁵³ Thus, the creator of the clay doorknob simply substituted one material for another.⁵⁴ Although the Court did not use the term obviousness, it held the invention unpatentable even though the claimed invention satisfied the statutory requirements for patentability in place in 1851.⁵⁵ The Court characterized the substitution of material as lacking in ingenuity, and held

44. 35 U.S.C. § 171(b).

45. *Id.* § 103.

46. *Id.*

47. *See Hotchkiss v. Greenwood*, 52 U.S. 248 (1851).

48. *See e.g., In re Nalbandian*, 661 F.2d 1214, 1216 (C.C.P.A. 1981) (applying the non-obviousness requirement to design patents and noting that the approach is consistent with utility patent case law).

49. *See Patent Act of 1870*, ch. 230, § 24, 16 Stat. 198 (1870) (repealed 1952).

50. *Hotchkiss*, 52 U.S. 248 (1851).

51. N. Scott Pierce, *Common Sense: Treating Statutory Non-obviousness as a Novelty Issue*, 25 SANTA CLARA COMPUT. & HIGH TECH. L.J. 539, 613–14 (2009).

52. *Hotchkiss*, 52 U.S. at 264.

53. *Id.* at 265.

54. *Id.*

55. *Id.* at 266.

that the grant of a utility patent was inappropriate unless the inventor displayed more ingenuity than that of an ordinary mechanic.⁵⁶

In the years following *Hotchkiss*, courts grew increasingly hostile to patents due to economic difficulties and a general distrust of monopolies.⁵⁷ The Supreme Court's skepticism was on display in *Cuno Engineering Corp. v. Automatic Devices Corp.*,⁵⁸ where the Court articulated a far stricter non-obviousness test.⁵⁹ The Court held that a utility invention must be useful, novel, and contain a "flash of creative genius" to be patentable.⁶⁰ This decision received criticism from the patent bar⁶¹ because the Court effectively raised the patentability standard to a nearly unattainable level.⁶² Patentable inventions are created in a variety of ways including monotonous labor, experimentation, or even by accident.⁶³ Thus, requiring that the inventor have a "flash of creative genius" for the invention to be patentable is contrary to the very nature of the invention process.⁶⁴ Patent law does not require that the invention be conceived in a particular manner; it grants an exclusive right to the first inventor to file a patent application.⁶⁵

In 1952, Congress finally codified the non-obviousness requirement in 35 U.S.C. § 103:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.⁶⁶

56. *Id.* at 266–67.

57. George M. Sirilla, *35 U.S.C. § 103: From Hotchkiss to Hand to Rich, The Obvious Patent Law Hall-of-Famers*, 32 J. MARSHALL L. REV. 437, 473 (1999).

58. *Cuno Eng'g Corp. v. Automatic Devices Corp.*, 314 U.S. 84 (1941), *superseded by statute*, 35 U.S.C. § 103.

59. *Id.* at 91.

60. *Id.*

61. Giles S. Rich, *Why and How Section 103 Came to Be*, 14 FED. CIR. B.J. 181, 186 (2005).

62. Sirilla, *supra* note 57, at 481.

63. Craig A. Nard, *Patent Law's Purposeful Ambiguity*, 87 TENN. L. REV. 187, 198 (2019).

64. *See id.*

65. *Id.* (citing *Earle v. Sawyer*, 8 F. Cas. 254, 256 (C.C.D. Mass. 1825)).

66. 35 U.S.C. § 103.

It was not until 1966 that the Supreme Court interpreted the statutory non-obviousness requirement in a utility patent case, *Graham v. John Deere Co.*⁶⁷ The Court held that the 1952 Act intended to codify the innovation requirement of *Hotchkiss*.⁶⁸ This decision effectively discarded the stringent flash of genius standard from *Cuno*.⁶⁹ Additionally, the Court outlined a three-step test to determine obviousness, otherwise known as the *Graham* factors.⁷⁰ First, determine the “scope and content of the prior art.”⁷¹ Second, ascertain the “differences between the prior art and the claims at issue.”⁷² Third, resolve “the level of ordinary skill in the pertinent art.”⁷³

The patent at issue in *Graham*, US Patent No. 2,627,798 (hereinafter ‘798), was for a spring clamp applied to a vibrating shank plow.⁷⁴ The clamp caused the shanks to be pushed upwards when an obstruction was hit, then spring back once the obstruction was cleared.⁷⁵ The claimed invention was a new combination of known mechanical elements.⁷⁶ An infringement suit brought by Graham led to validity challenges to the ‘798 patent under the statutory non-obviousness requirement.⁷⁷

The Court first determined the scope and content of the prior art.⁷⁸ Prior art refers to any evidence of knowledge relating to the claimed invention that was available before the applicant filed the claimed invention at the Patent Office.⁷⁹ A prior art reference can be almost anything, including documents like patents and printed publications, physical objects, processes, methods, and public disclosures.⁸⁰ The Patent Office and courts use prior art references to find a claimed invention

67. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

68. *Id.* at 3–4.

69. *Id.* at 15 n.7.

70. *Id.* at 17.

71. *Id.*

72. *Id.*

73. *Id.*

74. *Id.* at 19.

75. *Id.* at 19–20.

76. *Id.* at 4.

77. *Id.*

78. *Id.* at 22.

79. Lucas R. Yordy, Note, *The Library of Babel for Prior Art: Using Artificial Intelligence to Mass Produce Prior Art in Patent Law*, 74 VAND. L. REV. 521, 526–27 (2021).

80. See 35 U.S.C. § 102(a); see also Vic Lin, *What is Prior Art?*, PATENTTRADEMARKBLOG, <https://www.patenttrademarkblog.com/what-is-prior-art/> (last visited Apr. 16, 2023) [<https://perma.cc/Q2ST-XV3P>].

unpatentable for obviousness and lack of novelty.⁸¹ In *Graham*, the Supreme Court reviewed the prior art references cited by the applicant and the examiner at the Patent Office, as well as the arguments made by the applicant during prosecution.⁸² The Court focused on two prior art references that disclosed similar characteristics to the claimed invention in the '798 patent.⁸³

Next, the Court ascertained the differences between the prior art and the claimed invention.⁸⁴ The sole difference that *Graham* relied on was interchanging the shank and hinge plate.⁸⁵ The Court then resolved the level of ordinary skill in the art.⁸⁶ The Court determined that a person with ordinary skill in the art would have realized that the shank would be more effective using the claimed arrangement in the '798 patent and, thus, would have created *Graham's* invention.⁸⁷ The Court held the '798 patent to be invalid for obviousness.⁸⁸

In the years following *Graham*, the Federal Circuit expanded the first step of the *Graham* analysis, determining the scope and content of the prior art,⁸⁹ to include a rigorous teaching-suggestion-motivation test (TSM test).⁹⁰ Under the TSM test, a patent is invalid for obviousness only if there is a specific teaching, suggestion, or motivation in the prior art to combine known elements and arrive at the claimed invention.⁹¹

For example, if a claimed invention in a challenged patent is composed of element A and element B, under the TSM test, the challenger would

81. *Genetics Inst., LLC. v. Novartis Vaccines & Diagnostics, Inc.*, 655 F.3d 1291, 1302 (Fed. Cir. 2011) (citing *Oakley, Inc. v. Sunglass Hut Int'l*, 316 F.3d 1331, 1339 (Fed. Cir. 2003)) ("Anticipation and obviousness require the court to compare the properly construed claims to the available prior art.").

82. *Graham*, 383 U.S. at 22.

83. *Id.*

84. *Id.* at 23.

85. *Id.*

86. *Id.* at 25.

87. *Id.*

88. *Id.* at 4.

89. *Id.* at 17; see also Kate M. Lesciotto, Note, *KSR: Have Gene Patents Been KO'd? The Non-obviousness Determination of Patents Claiming Nucleotide Sequences when the Prior Art has Already Disclosed the Amino Acid Sequence*, 86 WASH. U. L. REV. 209, 220 (2008) (explaining that the TSM analysis occurs during the first step of the *Graham* test and requires finding each element of the claimed invention in the prior art and locating an explicit reason why combining the elements would lead to the claimed invention).

90. Sarah A. Geers, Comment, *Common Sense and the Fact Finder Without Skill in the Art: The Role of Objective Evidence in Achieving Proper Technology Specificity*, 40 SETON HALL L. REV. 225, 232 (2010).

91. See, e.g., *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572 (Fed. Cir. 1984) (finding the patent was valid because no prior art reference provided a suggestion or incentive to combine the known elements in the way the patentee did).

need to point to a specific teaching, suggestion, or motivation that element A should be combined with element B. For instance, the challenger might find a printed publication, like a scientific journal or magazine article, that indicates that element A would be improved by combining it with element B. This evidence would support finding the challenged patent obvious under the TSM test. But, absent an indication in the prior art that element A would benefit from being combined with element B, the claimed invention would be found non-obvious, and the patent would be upheld as valid.

Without the TSM test, the challenger would still need to find both element A and element B in the prior art, but would not need to locate a specific teaching, suggestion, or motivation that element A should be combined with element B. The challenger still needs to articulate some reason that element A would be combined with element B, but unlike the TSM test, that reason does not need to be specifically mentioned in an existing piece of prior art. Thus, the TSM test makes it more difficult for courts to invalidate patents for obviousness by placing stringent requirements on what a challenger must prove.

The Supreme Court addressed the TSM test in 2007 in *KSR International Co. v. Teleflex Inc.*, another utility patent case.⁹² The Court found the TSM test to be helpful, but noted that the obviousness analysis should not be confined to a “rigid and mandatory formula.”⁹³ The Court did not approve of the overemphasis on published literature⁹⁴ and cautioned against using only explicit teachings, suggestions, and motivations to find obviousness, because a variety of other factors, including market demand and common sense, may drive technological advancement.⁹⁵

The Court also indicated its approval of using common sense to prove obviousness in limited circumstances.⁹⁶ Although courts can use common sense, the Supreme Court emphasized it may still be important to state why someone with “ordinary skill in the art” would have combined the elements found in the prior art references in the way the claimed invention does.⁹⁷ The Court reasoned that many inventions rely on known elements, so almost all claimed discoveries will be combinations of what is already

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

93. *Id.* at 419.

94. *Id.*

95. *Id.*

96. *Id.* at 421 (explaining that when there are a “finite number of identified, predictable solutions,” someone with ordinary skill in the art has a reason to explore all options; if this leads to success, it is likely the product of ordinary skill and common sense, not the product of innovation).

97. *Id.* at 418.

known.⁹⁸ Ultimately, the Court rejected the rigid application of the TSM test in favor of increased flexibility.⁹⁹ Thus, after *KSR*, lower courts can use the TSM test to gain helpful insights,¹⁰⁰ but may still use common sense to find obviousness if there is no specific teaching, suggestion, or motivation in the prior art to combine known elements and arrive at the claimed invention.¹⁰¹

Following *KSR*, the Federal Circuit applied a flexible TSM test in utility patent law cases. For example, in *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, the Federal Circuit confronted the technological problem of maximizing space in an airplane cabin.¹⁰² The prior art included a wall with a recess situated behind an airplane seat so that the seat can tilt back into the recess of the wall.¹⁰³ The claimed invention included a wall with a first recess for an airplane seat to tilt back into as well as a second recess for receiving the airplane seat support.¹⁰⁴

Under the rigid TSM test, the claimed invention would not have been obvious because there was no teaching, suggestion, or motivation in the prior art to add a second recess to the prior art.¹⁰⁵ However, the court held that it was common sense to incorporate a second recess into the wall.¹⁰⁶ Here, the court relied on expert testimony stating that a low recess was a known solution to allow a seat to be located further back and to maximize space in the airplane cabin.¹⁰⁷ Under the flexible approach to the TSM test, the court found this invention obvious in light of the prior art and therefore invalid,¹⁰⁸ where the court probably would have found the invention non-obvious and valid under the rigid approach to the TSM test.

In 2018, the Federal Circuit explained that a party challenging a patent for obviousness must prove by clear and convincing evidence that a person having ordinary skill in the art “*would* have selected and combined and modified the subject matter of the references in the manner of the claimed invention.”¹⁰⁹ Thus, the judicial application of the non-obviousness requirement for utility patents remains consistent with the statutory

98. *Id.* at 418–19.

99. *Id.* at 415.

100. *Id.* at 418–19.

101. *Id.* at 418.

102. *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1375 (Fed. Cir. 2020).

103. *Id.* at 1377.

104. *Id.* at 1375.

105. *See id.* at 1380–81 (explaining that the claim limitation of “second recess” was absent from the prior art).

106. *Id.* at 1381.

107. *Id.* at 1380.

108. *Id.* at 1381.

109. *Orexo AB. v. Actavis Elizabeth LLC*, 903 F.3d 1265, 1271 (Fed. Cir. 2018) (emphasis added).

language.¹¹⁰ The inquiry is whether the claimed invention *would* have been obvious.¹¹¹

2. Analogous Art Requirement in Utility Patent Law

In utility patent law non-obviousness analysis, only references that are analogous to the claimed invention qualify as prior art.¹¹² These references are referred to as analogous art.¹¹³ A prior art reference qualifies as analogous art if the reference is from the same field as the claimed invention.¹¹⁴ A reference from a different field can still be analogous art if it addresses the same problem as the claimed invention.¹¹⁵ In making non-obviousness determinations, courts only consider analogous art and ignore other non-analogous references.¹¹⁶

The doctrine of analogous art can be traced back to 1929 when the United States Court of Customs and Patent Appeals, the predecessor of the Federal Circuit, decided *In re McLaughlin*.¹¹⁷ The claimed invention was a method of making chocolate cakes.¹¹⁸ The prior art cited against the patentee included a method of making a yeast cake.¹¹⁹ The patentee unsuccessfully argued that the process of making a cake with chocolate and the process of making a cake with corn meal belonged to non-analogous arts.¹²⁰ The court held that because both patents focused on the art of baking, the cited prior art was analogous art.¹²¹ The court then used the analogous art reference to find the claimed invention unpatentable.¹²² This finding was only possible because the prior art reference was analogous art.¹²³ Absent that determination, the court would not have used a prior art reference that was non-analogous art to find the claimed invention unpatentable.

110. See 35 U.S.C. § 103.

111. *Id.*

112. *Innovention Toys, LLC v. MGA Ent., Inc.*, 637 F.3d 1314, 1321 (Fed. Cir. 2011) (citing *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992)).

113. *Id.*

114. *Id.* at 1321 (quoting *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004)).

115. *Id.*

116. See, e.g., *Innovention Toys, LLC v. MGA Ent., Inc.*, 637 F.3d 1314 (Fed. Cir. 2011).

117. *In re McLaughlin*, 17 C.C.P.A. 739, 741–43 (C.C.P.A. 1929).

118. *Id.* at 740.

119. *Id.* at 741.

120. *Id.* at 741–42.

121. *Id.* at 742.

122. *Id.* at 743.

123. *Id.* at 742.

A reference from the same field of endeavor is analogous art, regardless of the problem addressed.¹²⁴ Courts and the Patent Office determine the field of endeavor by evaluating the material in the patent application for the claimed invention.¹²⁵ For example, in *In re Asset Guard Products Inc.*, the court reviewed the structure and function of the claimed invention included in the patent application and determined that the proper field of endeavor was support structures for storage systems.¹²⁶ The primary reference included a support structure for a water-filled spa.¹²⁷ The court found that the primary reference was analogous art that could be considered in the obviousness analysis.¹²⁸

A reference from a different field of endeavor still may be analogous art if it addresses the same problem as the claimed invention.¹²⁹ Courts consider whether an inventor would have directed attention to the reference in question when addressing the problem solved by the claimed invention.¹³⁰ If so, the reference is analogous art that can be considered in the obviousness analysis.¹³¹

Following the Supreme Court's decision of *Graham v. John Deere Co.*,¹³² courts have applied the analogous art requirement to the *Graham* factors.¹³³ Under the first step of the *Graham* analysis, determining the scope and content of the prior art,¹³⁴ only references that are analogous art to the claimed invention will qualify as prior art, and are applicable to the non-obviousness analysis.¹³⁵ Thus, the analogous art requirement is a threshold determination that needs to be satisfied before continuing past step one of the *Graham* analysis.¹³⁶ But, it does not follow that the patent

124. *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979).

125. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

126. *In re Asset Guard Products Inc.*, 2022 WL 1097363, at *3 (Fed. Cir. 2022).

127. *Id.*

128. *Id.* at *5.

129. *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979).

130. *See Asset Guard*, 2022 WL 1097363, at *4.

131. *See id.* at *5.

132. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

133. *See, e.g.*, *Innovention Toys, LLC v. MGA Ent., Inc.*, 637 F.3d 1314, 1321 (Fed. Cir. 2011) (analyzing analogous art under the first *Graham* factor (scope and content of the prior art)); *Donner Tech., LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 1359 (Fed. Cir. 2020) (same); *Circuit Check, Inc. v. QXQ Inc.*, 795 F.3d 1331, 1335 (Fed. Cir. 2015) (same).

134. *Graham*, 383 U.S. at 17.

135. *See In re Clay*, 966 F.2d 656 (Fed. Cir. 1992); *see also Sci. Plastic Prods. v. Biotage AB*, 766 F.3d 1355, 1360 (Fed. Cir. 2014) (holding that the King and Strassheimer references addressed the same problem as the claimed invention and were therefore available as prior art in a non-obviousness analysis).

136. *See Innovention Toys, LLC v. MGA Entm't, Inc.*, 637 F.3d 1314, 1321 (Fed. Cir. 2011) (citing *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992)) ("A reference qualifies as

at issue is necessarily invalid on obviousness grounds simply because a reference in an analogous art exists.¹³⁷ Once the court determines that a prior art reference qualifies as analogous art, the court must then undertake a qualitative inquiry and follow the *Graham* analysis to determine whether the claimed invention *would* have been obvious to one of ordinary skill in the art in view of that reference.¹³⁸

C. Application of the Non-Obviousness Requirement to Design Patent Law

The statutory requirements for patentability apply to both utility and design patent law.¹³⁹ These requirements include novelty and non-obviousness.¹⁴⁰ However, some fundamental differences between utility and design patents complicate the application of the non-obviousness requirement to design patent law. Utility patent non-obviousness focuses on whether a specific technical solution would have been obvious to one of ordinary skill in the art.¹⁴¹ In contrast, design patents always relate to the same problem—creating a more attractive design.¹⁴² By definition, a design must be purely ornamental and not functional.¹⁴³ This fundamental difference between utility and design patents caused the courts to develop an ancillary body of case law applying the non-obviousness requirement to design patent law.¹⁴⁴

A design patent is obvious, and therefore invalid, if the design *would* have been obvious to an ordinary designer.¹⁴⁵ Unlike in utility patent law where obviousness is determined from the perspective of a person having

prior art for a determination under § 103 when it is analogous to the claimed invention.”); see also *In re Asset Guard Prods. Inc.*, 2022 WL 1097363 (Fed. Cir. 2022) (analyzing first whether the references qualified as analogous art, then considering whether the claimed invention would have been obvious to one of ordinary skill in the art in view of those references).

137. See, e.g., *In re Asset Guard Prods. Inc.*, 2022 WL 1097363, at *9, *11, *17 (Fed. Cir. 2022) (finding first that the Noble, Heinz, and Flam references were analogous art, then holding that the claimed invention was non-obvious in view of the prior art).

138. *Id.*

139. See 35 U.S.C. § 171(b).

140. See *id.* § 102 and § 103.

141. See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 3 (1966).

142. See Donald S. Chisum, 1 CHISUM ON PATENTS § 23.03 ¶6 (Matthew Bender ed., 2023).

143. See 35 U.S.C. § 171(a).

144. See, e.g., *In re Glavas*, 230 F.2d 447, 450 (C.C.P.A. 1956).

145. See 35 U.S.C. § 103; see also *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996).

ordinary skill in the art,¹⁴⁶ in design patent law, obviousness is determined from the perspective of an ordinary designer of the articles involved.¹⁴⁷

The Federal Circuit developed a two-part test for determining obviousness in design patent law.¹⁴⁸ First, the court must locate a primary reference (*Rosen* reference).¹⁴⁹ Then, the court can use secondary references to modify the *Rosen* reference to create an overall visual appearance that is the same as the claimed design to show obviousness.¹⁵⁰

1. The *Rosen* Reference

The first step of the non-obviousness analysis in design patent law is locating a *Rosen* reference.¹⁵¹ A *Rosen* reference is something that has design characteristics that are “basically the same as the claimed design.”¹⁵² The *Rosen* reference with basically the same design characteristics must already exist in a single reference.¹⁵³ It is impermissible for courts to create something new by selecting and combining independent features from the prior art to satisfy the *Rosen* reference requirement.¹⁵⁴

The Court of Customs and Patent Appeals created the *Rosen* reference requirement in *In re Rosen*.¹⁵⁵ The court found that a prior art reference disclosing a desk did not qualify as a primary reference against a claimed design for a coffee table.¹⁵⁶ The court reasoned that a table and a desk do not share the same design characteristics and are conceptually very different.¹⁵⁷ Because this prior art reference was not a proper *Rosen* reference, the obviousness analysis ended and the patent was not invalidated on obviousness grounds.¹⁵⁸

146. See 35 U.S.C. § 103.

147. *In re Nalbandian*, 661 F.2d 1214, 1216 (C.C.P.A. 1981).

148. See *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996).

149. See *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982).

150. See *Durling*, 101 F.3d at 103.

151. *Rosen*, 673 F.2d at 391.

152. *Id.*

153. See *id.*

154. *Id.*

155. See *id.*

156. *Id.*

157. *Id.*

158. *Id.*

2. *The Glavas Requirement*

If a court locates a proper *Rosen* reference, it may then proceed to the second step of the obviousness analysis.¹⁵⁹ In step two, the court can use secondary references to modify the *Rosen* reference to create an overall visual appearance that is the same as the claimed design to find obviousness.¹⁶⁰ But, the *Glavas* requirement means that a court may only use a secondary reference to modify a primary reference if there is an indication to modify.¹⁶¹ There is an indication to modify if the designs “are so related that the appearance of certain ornamental features in one *would* suggest the application of those features to the other.”¹⁶² If the secondary reference may be used under this test in combination with the primary reference to create a visual appearance that is the same as the claimed design, then the court must determine whether it *would* have been obvious to do so.¹⁶³

In some cases, even if a suggestion to combine prior art references is present, it may be necessary to make changes to the prior art to arrive at the claimed design. The courts created a *de minimis* analysis to fill in the gaps when a design element from the claimed design is still missing after the *Rosen* reference and the secondary references are combined.¹⁶⁴ The Federal Circuit has held that if prior art references need to be modified in more than one way, “those modifications must be ‘*de minimis*’ in nature and unrelated to the overall aesthetic appearance of the design.”¹⁶⁵

However, there are no concrete rules or standards that guide the *de minimis* analysis, causing this test to be highly subjective with no limit to what is considered a *de minimis* and permissible modification.¹⁶⁶ For example, in the case *In re Carter*, the court held that “[t]he elimination of the end portions of the waistband and of any cinching of the waist portion” was a *de minimis* change in an infant’s garment.¹⁶⁷ In the case *In re Chung*, the court held that two depressions in a cigarette packet liner was a *de minimis* change that did not create a patentably distinct design.¹⁶⁸ Due to

159. See *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996).

160. *Id.*

161. See *In re Glavas*, 230 F.2d 447, 450 (C.C.P.A. 1956).

162. *Id.* (emphasis added).

163. See *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996).

164. See, e.g., *In re Harvey*, 12 F.3d 1061, 1065 (Fed. Cir. 1993).

165. *Id.* (citing *In re Carter*, 673 F.2d 1378, 1380 (C.C.P.A. 1982)).

166. See *Mueller & Brean*, *supra* note 2, at 505.

167. *In re Carter*, 673 F.2d 1378, 1380 (C.C.P.A. 1982).

168. *In re Chung*, 2000 U.S. App. LEXIS 24916, *9–10 (Fed. Cir. 2000).

the lack of guidance from the Federal Circuit, the lower courts have almost complete discretion over the *de minimis* analysis.¹⁶⁹

The Federal Circuit applied the *Rosen* reference requirement, *Glavas* requirement, and *de minimis* doctrine in *In re Harvey* and found that there was no suggestion to combine the prior art references.¹⁷⁰ Harvey's claimed design was "a vase formed by the intersection of an 'oblate ellipsoid with a pentagonal cylinder.'"¹⁷¹ A primary reference prior art design was a vase "formed by the intersection of a sphere with a cube."¹⁷² A secondary reference prior art design was a bowl that had an oblate ellipsoid shape.¹⁷³ The Board of Patent Appeals and Interferences (Board) held that the claimed design was obvious in view of the combined primary and secondary references.¹⁷⁴

But the Federal Circuit found that the Board improperly characterized the primary reference as a *Rosen* reference.¹⁷⁵ Because a designer would need to make major changes to the primary reference vase for it to look like the claimed design, the court reasoned that the primary reference was not "basically the same" as the claimed design.¹⁷⁶

The Federal Circuit then found that even if the primary reference was a proper *Rosen* reference, the Board improperly combined the secondary reference with the primary reference to show obviousness.¹⁷⁷ The Board substituted the shape of the secondary reference bowl with the shapes in the primary reference vase to create the same overall visual appearance as the claimed design and show obviousness.¹⁷⁸ The Federal Circuit found the Board's reasoning to be improper.¹⁷⁹ Although the individual components present in the claimed design could be found in the prior art, there was no suggestion in the prior art to combine those individual components to create the claimed design.¹⁸⁰ The court observed that under the Board's reasoning, every shape present in a publicly disclosed bowl or vase would render obvious any subsequent bowl or vase that incorporated

169. See Mueller & Brean, *supra* note 2, at 505.

170. *In re Harvey*, 12 F.3d 1061, 1064–66 (Fed. Cir. 1993).

171. *Id.* at 1062.

172. *Id.*

173. *Id.*

174. *Id.*

175. *Id.* at 1063–64.

176. *Id.* at 1063.

177. *Id.* at 1065.

178. *Id.*

179. *Id.*

180. *Id.*

that shape.¹⁸¹ The Federal Circuit concluded that “[c]learly, this cannot be the case.”¹⁸²

The court further found that even if there was a suggestion in the prior art to combine primary and secondary references, the court would need to make several changes to arrive at the claimed design.¹⁸³ The necessary modifications included changing the shape of the vase and eliminating a lip from the prior art vase.¹⁸⁴ The court found that these design changes were not *de minimis* because the modifications significantly impacted the overall visual impression of the claimed design.¹⁸⁵

Although courts continue to cite the *Glavas* requirement,¹⁸⁶ its original context and development often gets overlooked.¹⁸⁷ The *Glavas* court noted that the non-obviousness inquiry in design patents relates to combining appearances of prior art designs, unlike in utility patent law, where the court combines uses of prior art inventions.¹⁸⁸ The court then explained 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.”¹⁸⁹ Thus, analogous art cannot be applied to design cases in the same way as utility cases.¹⁹⁰

The language from *Glavas* indicates that a secondary reference may only be considered in combination with the *Rosen* reference during the obviousness inquiry if the design of one reference *would* suggest combination with another reference.¹⁹¹ Like the analogous art requirement in utility patent law, this language from *Glavas* relates to the threshold determination of whether a prior art reference can be considered available for combination with a primary reference in the obviousness analysis.¹⁹² Simply because features from a secondary reference can be combined with

181. *Id.*

182. *Id.*

183. *Id.*

184. *Id.*

185. *Id.* at 1066.

186. *See, e.g.,* MRC Innovations, Inc. v. Hunter Mfg., LLP, 747 F.3d 1326, 1334 (Fed. Cir. 2014).

187. *See In re Glavas*, 230 F.2d 447 (C.C.P.A. 1956).

188. *See id.* at 450.

189. *Id.*

190. *See id.*

191. *See id.*

192. *See e.g.,* Innovention Toys, LLC v. MGA Ent., Inc., 637 F.3d 1314 (Fed. Cir. 2011); *see also* discussion *supra* Part II.B.2.

the *Rosen* reference to create the claimed design, it does not mean that it *would* have been obvious for a designer of ordinary skill to do so.¹⁹³

Therefore, the issue of whether a prior art reference is a proper secondary reference is separate from the issue of whether the combination of references would have been obvious to a designer of ordinary skill.¹⁹⁴ As emphasized in *Glavas*, a court must first consider whether a reference is a secondary reference.¹⁹⁵ If so, the court must then assess whether it would have been obvious to modify the *Rosen* reference with features from the secondary reference to create the claimed design.¹⁹⁶ This is a two-step process that some modern courts in design patent cases treat as one.¹⁹⁷

D. Modern Federal Circuit Application of the Non-obviousness Requirement in Design Patent Law

In the 2014 case *MRC Innovations, Inc. v. Hunter Mfg., LLP*, the Federal Circuit held a design patent was obvious and, therefore, invalid.¹⁹⁸ In the years leading up to this decision, it seemed almost impossible for a design patent to be invalid for obviousness.¹⁹⁹ After *MRC*, it was again possible.²⁰⁰

MRC was the patentee of two design patents: US Design Patent No. D634,487 S (hereinafter ‘487) and US Design Patent No. D634,488 S (hereinafter ‘488).²⁰¹ ‘487 claimed a design for a baseball jersey for a dog, and ‘488 claimed a design for a football jersey for a dog.²⁰² *MRC* sued

193. See, e.g., *In re Glavas*, 230 F.2d 447, 451 (C.C.P.A. 1956) (finding that the Patton and Knecht references could be combined with the Armstrong reference to create the claimed design, then finding that there is no suggestion in the prior art to modify the Armstrong design with elements from the Patton or Knecht references to form the claimed design).

194. See *id.*

195. See *id.* at 449.

196. See *id.* at 451.

197. See discussion *infra* Part II.D; see, e.g., *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1334–35 (Fed. Cir. 2014) (merging the issues of whether a reference is a proper secondary reference and whether the combination of references would have been obvious to a designer of ordinary skill).

198. *MRC*, 747 F.3d at 1330.

199. Jason Rantanen, *Design Patent Nonobviousness Jurisprudence—Going to the Dogs?*, PATENTLYO (Apr. 3, 2014), <https://patentlyo.com/patent/2014/04/design-nonobviousness-jurisprudence.html> [<https://perma.cc/9TQU-EVU9>]; see also *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301 (Fed. Cir. 2013); *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.2d 1314 (Fed. Cir. 2012).

200. See Rantanen, *supra* note 199.

201. *MRC*, 747 F.3d at 1328.

202. *Id.*

Hunter for infringement of both patents, and Hunter challenged the validity of the patents as invalid for obviousness.²⁰³

The court first discussed the existence of a primary reference.²⁰⁴ The district court used an “Eagles” pet jersey as the *Rosen* reference.²⁰⁵ In explaining its conclusion, the district court relied on five similarities between the Eagles jersey and the claimed design.²⁰⁶ The district court then pointed out three design characteristics that were different in the claimed design than the prior art.²⁰⁷ The district court concluded that the claimed design “created ‘basically the same’ overall visual impression” as the prior art reference.²⁰⁸ The Federal Circuit agreed and characterized the Eagles jersey as a proper *Rosen* reference.²⁰⁹

The district court further concluded that the “V2” jersey, another pet jersey, was a secondary reference.²¹⁰ The Federal Circuit acknowledged that it could only consider a secondary reference if the prior art suggested modification of the *Rosen* reference with features from the secondary reference.²¹¹ The Federal Circuit then applied the *Glavas* requirement.²¹² More notably, the Federal Circuit followed the *Glavas* requirement with an explanatory phrase: “In other words, it is the *mere similarity in appearance* that itself provides the *suggestion* that one *should* apply certain features to another design.”²¹³ The Federal Circuit noted that the “striking similarity in appearance” between the primary and secondary references provided the motivation for a designer of ordinary skill to combine the features of the references to arrive at the claimed design.²¹⁴

However, combining the primary and secondary references did not completely lead to the claimed design.²¹⁵ The ‘488 patent included

203. *Id.* at 1330.

204. *Id.* at 1331.

205. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 921 F. Supp. 2d 800, 809 (N.D. Ohio 2013).

206. *Id.* (identifying five similarities, including 1) a jersey with an opening at the collar, 2) a jersey with two openings in the body with sleeves stitched on for a dog’s legs, 3) a jersey with a football logo applied to the body of the jersey, 4) a jersey made of mesh and interlock fabric, and 5) a jersey with ornamental surge stitching).

207. *Id.* (identifying three differences, including 1) a V-neck collar on the jersey of the claimed design, 2) additional ornamental stitching on the jersey of the claimed design, and 3) a panel of interlock fabric on the side of the jersey of the claimed design).

208. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1332 (Fed. Cir. 2014).

209. *Id.*

210. *MRC*, 921 F. Supp. 2d at 809.

211. *MRC*, 747 F.3d at 1334 (citing *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996)).

212. *Id.*

213. *Id.* (emphasis added).

214. *Id.* at 1334–35.

215. *Id.*

“additional ornamental surge stitching” down the jersey.²¹⁶ This feature was completely absent from any prior art reference.²¹⁷ Yet, the court concluded that “adding ornamental surge stitching on top of a preexisting seam was an insubstantial change that would have been obvious to a skilled designer.”²¹⁸ In a footnote, the court reasoned that the change was *de minimis* because it highlighted an existing design feature found in the prior art.²¹⁹ Because the addition of ornamental stitching was a *de minimis* modification, the court held the patent invalid for obviousness.²²⁰

In *LKQ Corp. v. GM Global Tech. Operations LLC*,²²¹ the Federal Circuit held that the Supreme Court’s ruling in *KSR International Co. v. Teleflex Inc.*²²² only pertained to utility patents and did not change design law non-obviousness precedent.²²³ In *KSR*, the Supreme Court held that obviousness of utility patents cannot be determined solely by a teaching, suggestion, or motivation contained in the prior art.²²⁴ The Court emphasized the need for increased flexibility in the obviousness analysis²²⁵ and approved of the use of common sense.²²⁶ The Federal Circuit reasoned that because *KSR* involved a utility patent and did not discuss design patents at all, the Court’s holding in *KSR* will not apply to design patent law.²²⁷

III. ANALYSIS

Established precedent for the non-obviousness requirement in design patent law clearly indicates how courts should analyze obviousness.²²⁸ A court must locate a *Rosen* reference, meaning a primary reference that discloses design characteristics that are very similar to the claimed design.²²⁹ Once a *Rosen* reference is located, there is an established two-step framework for using a secondary reference to modify the *Rosen*

216. *Id.* at 1335.

217. *Id.*

218. *Id.*

219. *Id.* at n.6.

220. *Id.* at 1336.

221. *LKQ Corp. v. GM Global Tech. Operations LLC*, 2023 WL 328228 (Fed. Cir. 2023).

222. See discussion *supra* Part II.B.

223. *LKQ*, 2023 WL 328228, at *6.

224. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007).

225. *Id.*

226. *Id.* at 421.

227. *LKQ*, 2023 WL 328228, at *6.

228. See discussion *supra* Part II.C.

229. *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982).

reference to arrive at the claimed design and show obviousness.²³⁰ A court must first determine whether a prior art reference is a proper secondary reference using the *Glavas* requirement.²³¹ If, and only if, the court determines that a prior art reference is a proper secondary reference, can the court assess whether it would have been obvious to modify the *Rosen* reference with features from the secondary reference to create the claimed design.²³²

Modern Federal Circuit decisions, like *MRC*,²³³ display the lack of clarity and consistency in the judicial application of the non-obviousness requirement of design patent law. These decisions stray from established precedent by treating the secondary reference analysis as a single step.²³⁴ Further, modern courts are misapplying the *would* standard of non-obviousness in favor of a *should* standard.²³⁵ The skewed application of non-obviousness principles to design patent law results in invalid patents and is weakening the protection of intellectual property.²³⁶ The issue appears to stem from a deviation from the language governing the statutory non-obviousness requirement²³⁷ and a misguided interpretation of design patent non-obviousness precedents.²³⁸

230. See *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996).

231. *In re Glavas*, 230 F.2d 447, 450 (C.C.P.A. 1956) (explaining that a court may only use a secondary reference to modify a primary reference if there is an indication to modify, meaning the designs “are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.”).

232. See *id.*

233. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326 (Fed. Cir. 2014).

234. See discussion *infra* Part III.A.

235. See discussion *infra* Part III.A.

236. See, e.g., *MRC*, 747 F.3d at 1336 (invalidating design patent on obviousness grounds).

237. See 35 U.S.C. § 103 (emphasis added) (“A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole *would have been obvious* before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.”).

238. See, e.g., *MRC*, 747 F.3d at 1334 (citations omitted) (citing *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996)) (“[T]he teachings of prior art designs may be combined only when the designs are ‘so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.’ In other words, it is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design.”).

A. MRC Innovations, Inc. v. Hunter Mfg., LLP Applied the Wrong Legal Standard to the Non-Obviousness Requirement

In the English language, there is a distinction between would, could, and should. According to Merriam-Webster Dictionary, would, when used in the context of “would have,” means “probability or likelihood in past or present time.”²³⁹ Dictionary.com defines “could” as being used “to express conditional possibility or ability.”²⁴⁰ By contrast, Dictionary.com defines “should” as “must; ought (used to indicate duty, propriety, or expediency).”²⁴¹

The statute governing the non-obviousness requirement in both utility and design patent law specifies that the applicable standard for determining obviousness is whether “the differences between the claimed invention and the prior art are such that the claimed invention as a whole *would* have been obvious” to one of ordinary skill in the art.²⁴² Therefore, the statute directs the courts to consider whether it was “probable” or “likely” that the claimed design was obvious to a designer of ordinary skill.²⁴³ The obviousness inquiry is not whether it was “possible” that the claimed design was obvious to a designer of ordinary skill.²⁴⁴ And the obviousness inquiry is most certainly not whether a designer of ordinary skill had some affirmative “duty” to create the claimed design in view of the prior art.²⁴⁵

Yet in *MRC Innovations, Inc. v. Hunter Mfg., LLP*, the Federal Circuit considered what a designer *should* do in view of the prior art.²⁴⁶ The Federal Circuit first quoted the familiar language from *In re Glavas*.²⁴⁷ In *Glavas*, the court stated that prior art references may be combined only when the designs are “so related that the appearance of certain ornamental features in one *would* suggest the application of those features to the other.”²⁴⁸ This is a threshold determination, like the analogous art analysis

239. *Would*, MERRIAM-WEBSTER DICTIONARY, <https://www.merriam-webster.com/dictionary/would> (last visited Feb. 5, 2023) [<https://perma.cc/R6J3-4YMH>].

240. *Could*, DICTIONARY.COM, <https://www.dictionary.com/browse/could> (last visited Feb. 5, 2023) [<https://perma.cc/G5YA-3N9X>].

241. *Should*, DICTIONARY.COM, <https://www.dictionary.com/browse/should> (last visited Feb. 5, 2023) [<https://perma.cc/L32T-JDFE>].

242. 35 U.S.C. § 103 (emphasis added).

243. *Id.*; see *Would*, DICTIONARY.COM, <https://www.dictionary.com/browse/would> (last visited Feb. 5, 2023) [<https://perma.cc/FDA4-QCEP>].

244. See 35 U.S.C. § 103; see also *Could*, *supra* note 240.

245. 35 U.S.C. § 103; see *Should*, *supra* note 241.

246. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1334 (Fed. Cir. 2014).

247. *Id.*; see discussion *supra* Part II.D.

248. *In re Glavas*, 230 F.2d 447, 450 (C.C.P.A. 1956) (emphasis added).

in utility patent law.²⁴⁹ Simply because a reference qualifies as a secondary reference does not mean that obviousness is proved.²⁵⁰ The Federal Circuit then attempted to clarify the *Glavas* language and stated “[i]n other words, it is the mere similarity in appearance that itself provides the suggestion that one *should* apply certain features to another design.”²⁵¹

This analysis is an erroneous interpretation of the *Glavas* language that is both inconsistent with design patent law non-obviousness precedent and the plain language of the statutory non-obviousness requirement. First, *Glavas* requires that the designs be “so related that the appearance of certain ornamental features” in one design suggests application of those features to another design.²⁵² Conversely, the court in *MRC* stated that it is the “mere similarity in appearance” that requires similar application.²⁵³ The requirement that designs be related is different than mere similarity in appearance.²⁵⁴ For example, in *Glavas*, the court found that prior art references that included a concave portion, like the claimed design, were not related designs.²⁵⁵ Thus, it is not mere similarity in appearance that suggests application of certain features of one design to another.²⁵⁶ The correct standard is related designs.²⁵⁷

In applying the standard of “mere similarity in appearance,” the *MRC* court relied on *In re Borden*.²⁵⁸ In *Borden*, the claimed design was an “Ornamental Design for a Twin Neck Dispensing Container.”²⁵⁹ The court located a *Rosen* reference, but the reference had two missing design elements from the claimed design.²⁶⁰ The court found those missing elements in secondary references and used the secondary references to modify the *Rosen* reference to create the claimed design.²⁶¹ The court emphasized that the missing design elements were “not taken from unrelated references, but [were] found in other dual-chamber containers.”²⁶² Thus, the court concluded that it was proper to use

249. See discussion *supra* Parts II.C and II.D.

250. See *id.*

251. *MRC*, 747 F.3d at 1334 (emphasis added).

252. *Glavas*, 230 F.2d at 450.

253. *MRC*, 747 F.3d at 1334.

254. *Glavas*, 230 F.2d at 450; *cf.* *MRC*, 747 F.3d at 1334.

255. *Glavas*, 230 F.2d at 451.

256. See *id.*

257. See *id.*

258. *In re Borden*, 90 F.3d 1570 (Fed. Cir. 1996).

259. *Id.* at 1571.

260. *Id.* at 1575.

261. See *id.*

262. *Id.*

secondary references to modify the Rosen reference to create the claimed design.²⁶³

In *MRC*, the claimed design, *Rosen* reference, and secondary reference were all football jerseys to be worn by dogs.²⁶⁴ The court concluded that, like in *Borden*, the secondary reference was so related to the *Rosen* reference that “the striking similarity in appearance across all three jerseys would have motivated a skilled designer to combine features from one with features of another.”²⁶⁵

However, the *MRC* court failed to discuss a central aspect of the *Borden* court’s reasoning. In *Borden*, the claimed design, *Rosen* reference, and secondary reference were all dual-chamber designs.²⁶⁶ But, the secondary reference container was listed in the *Rosen* reference container’s brochure as an example of a container that the manufacturer could create.²⁶⁷ The brochure also listed other variations to the container including the modifications to the *Rosen* reference container that were embodied in the claimed design.²⁶⁸ The claimed design, *Rosen* reference, and secondary reference were not merely the same type of design, but there was an express indication to modify the *Rosen* reference to create the claimed design.²⁶⁹ This express indication to modify provides the needed motivation that an ordinary designer *would* modify the reference to arrive at the claimed design, not simply that a designer *could*.²⁷⁰

The *MRC* court completely misapplied the *Borden* reasoning.²⁷¹ In *MRC*, the court relied solely on the “mere similarity in appearance” of the prior art references to conclude that it would have been obvious for a designer of ordinary skill to modify the *Rosen* reference to create the claimed design.²⁷² This reasoning plainly contradicts established Federal Circuit precedent.²⁷³

Second, under the *Glavas* language, “the appearance of certain ornamental features in one [reference] *would* suggest the application of those features to the other [reference].”²⁷⁴ This standard applicable to the

263. *Id.*

264. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1334 (Fed. Cir. 2014).

265. *Id.* at 1334–35.

266. *Borden*, 90 F.3d at 1575.

267. *Id.*

268. *Id.*

269. *Id.*

270. *See id.*

271. *See supra* notes 264–70 and accompanying text.

272. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1334–35 (Fed. Cir. 2014).

273. *See In re Glavas*, 230 F.2d 447 (C.C.P.A. 1956); *see also supra* notes 246–57 and accompanying text.

274. *Glavas*, 230 F.2d at 450 (emphasis added).

non-obviousness requirement in design patent law, especially the use of the word *would*, is consistent with the non-obviousness inquiry in utility patent law²⁷⁵ and the language of the statutory non-obviousness requirement.²⁷⁶ The central inquiry is whether one with ordinary skill in the art *would* have combined the prior art references to arrive at the claimed design.²⁷⁷

The *MRC* court stated that similarity in appearance suggests that “one *should* apply certain features to another design.”²⁷⁸ Using *should* in this sentence has a starkly different meaning than the word *would*, which is included in the statutory non-obviousness requirement.²⁷⁹ When applied to the non-obviousness context, *MRC* suggests that similarity in appearance between prior art references means that a designer has an affirmative duty to apply features from one design to the other. This reasoning is entirely inconsistent with both utility and design patent law non-obviousness precedent.

The statute 35 U.S.C. § 103 states that a patent may not be obtained “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole *would* have been obvious...to a person having ordinary skill in the art.”²⁸⁰ The non-obviousness statute clearly indicates that the standard applicable to the non-obviousness requirement is whether the invention or design *would* have been obvious,²⁸¹ not whether the invention or design *could* have been created or *should* have been created. The use of the word *should* by the *MRC* court²⁸² is a departure from the language of the statutory non-obviousness requirement that completely skews the non-obviousness analysis.²⁸³

Historically, the Federal Circuit and its predecessor court were careful to adhere to the *would* standard as applied to the non-obviousness requirement.²⁸⁴ For example, in *In re Harvey*, the Patent Board of Appeals

275. See discussion *supra* Part II.B.

276. See 35 U.S.C. § 103 (“A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole *would have been obvious* before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.”) (emphasis added).

277. See *id.*

278. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1334 (Fed. Cir. 2014) (emphasis added).

279. See *supra* notes 242–45 and accompanying text.

280. 35 U.S.C. § 103 (emphasis added).

281. *Id.*

282. *MRC*, 747 F.3d at 1334.

283. See 35 U.S.C. § 103.

284. See, e.g., *In re Harvey*, 12 F.3d 1061, 1065 (Fed. Cir. 1993).

and Interferences concluded that the shape of the Carder reference rendered the claimed design obvious because the Carder shapes were “well-known and frequently used in vase designs.”²⁸⁵ The Federal Circuit rejected this reasoning and noted that “each and every prior art bowl or vase shape ever publicly disclosed would render obvious any generally similar vase shape.”²⁸⁶ The court concluded that clearly the Board’s reasoning cannot stand.²⁸⁷ The Federal Circuit emphasized that there was no suggestion in the prior art to combine the prior art references to arrive at the claimed design.²⁸⁸ Because there was no suggestion, there was no reason that a designer *would* have combined those designs.²⁸⁹ The inquiry is not whether a designer *could* have combined prior art references; the proper analysis is whether a designer *would* have.²⁹⁰

Similarly, the standard employed by the court in *MRC* that similarity in appearance suggests that “one *should* apply certain features to another design” is illogical.²⁹¹ This reasoning indicates that designers must or ought to apply features of one design to other designs that are similar in appearance.²⁹² Nearly all designs would be unpatentable under this logic. As noted in *In re Glavas*, almost every design is comprised of elements that already exist.²⁹³ If the non-obviousness requirement in design patent law is determined under a *should* analysis, no new combination of design elements would be patentable because a designer simply *should* combine features from designs with similar appearances.²⁹⁴ Because designs are primarily composed of existing elements arranged in new ways, the *MRC* court’s reasoning would result in very few designs being patentable. This is clearly an illogical result.

B. The De Minimis Analysis is too Subjective

Even if a design element from the claimed design is still missing after a court combines the Rosen reference and the secondary references, a court may still find the design obvious if the missing element is a *de minimis*

285. *Id.*

286. *Id.*

287. *Id.*

288. *Id.* at 1064–65.

289. *Id.*

290. *See id.*

291. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1334 (Fed. Cir. 2014) (emphasis added).

292. *See id.*

293. *In re Glavas*, 230 F.2d 447, 450 (C.C.P.A. 1956).

294. *See supra* notes 278–83 and accompanying text.

change to the combined prior art.²⁹⁵ However, this analysis is largely subjective because of the lack of concrete rules that guide the analysis.²⁹⁶

MRC Innovations, Inc. v. Hunter Mfg., LLP, illustrates the primary fault of the *de minimis* analysis.²⁹⁷ In *MRC*, the court determined that the only difference between the claimed design and the combined *Rosen* and secondary references was additional ornamental stitching on the claimed design.²⁹⁸ In a footnote, the court reasoned that the change was *de minimis* because it merely highlighted a design feature found in the prior art.²⁹⁹ There is no precedent for this interpretation of the *de minimis* doctrine and the court's reasoning reflects an entirely subjective analysis.

Because of the lack of guiding principles, courts are given huge discretion to determine what modifications qualify as *de minimis* and what modifications do not.³⁰⁰ Because the *de minimis* analysis is the final part of the non-obviousness inquiry, the conclusion of non-obviousness, and ultimate validity of the patent, can hinge on a court's subjective analysis.³⁰¹ For example, in *MRC*, if the court found that the addition of ornamental stitching was a substantial, not *de minimis*, change to the combination of the prior art, the court likely would have concluded that the patented design was non-obvious to a designer of ordinary skill and the patent likely would have been upheld as valid. Conversely, the court actually found that the change was *de minimis*,³⁰² and thus held the patent invalid.³⁰³ Therefore, the entire validity of the patent depended on an overly subjective *de minimis* analysis.³⁰⁴

It is unclear what qualifies as a *de minimis* change and how a court reaches that conclusion. Is changing the color of a design a *de minimis* change? Is changing the shape of a design element *de minimis*? The court is also unclear about how many *de minimis* changes a design may include before it is obvious. Ultimately, the courts have too much discretion when applying the *de minimis* standard, or lack thereof, because even if the prior art references in combination do not create the claimed design, the courts

295. See, e.g., *In re Harvey*, 12 F.3d 1061, 1065 (Fed. Cir. 1993).

296. See, e.g., *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326 (Fed. Cir. 2014); see also *supra* notes 164–68 and accompanying text.

297. *MRC*, 747 F.3d 1326.

298. *Id.* at 1335.

299. *Id.* at n.6.

300. See *supra* notes 164–68 and accompanying text.

301. See *MRC*, 747 F.3d at 1335 (finding that the addition of ornamental stitching was a *de minimis* change that would have been obvious to a designer with ordinary skill).

302. *Id.*

303. *Id.* at 1338.

304. See *id.*

can still find the claimed design obvious.³⁰⁵ There still needs to be some reason why a designer *would* have made the alleged *de minimis* change. This final step of the non-obviousness inquiry that affects the validity of a patent should not be so subjective. Courts and/or the legislature should create additional principles that help guide the *de minimis* analysis.

C. Proposed Changes to the Application of the Non-Obviousness Requirement to Design Patent Law

The very nature of design patent eligibility creates difficulty in applying the non-obviousness requirement to design patent law.³⁰⁶ Designs must be ornamental and not solely determined by function.³⁰⁷ Unlike utility patent law inventions, patented designs subjectively improve the aesthetic appearance of an object.³⁰⁸ Because designs relate to aesthetic appearance, the statutory non-obviousness requirement does not translate well to design patent law.³⁰⁹ It is difficult to discern what would have been obvious to a designer of ordinary skill.³¹⁰ However, design patent law non-obviousness precedent lays out a framework for evaluating obviousness of claimed designs.³¹¹ The existing framework can be improved in three ways to increase judicial consistency and avoid restricting the development of designs.

First, courts should be able to find obviousness through a designer's very simple modification to existing designs. The current *de minimis* standard employed by courts is too subjective and unpredictable.³¹² Courts should be limited to applying one *de minimis* modification to arrive at a claimed design. What qualifies as a *de minimis* modification should be fact-dependent and will vary based on the design in question. Some examples of *de minimis* modifications could be changing the color, shape, pattern, or size of the design. But these examples may not be *de minimis* in every case. Courts should also articulate a reason why a *de minimis* modification would have been obvious to a designer of ordinary skill in the specific factual situation. Limiting courts to applying one *de minimis* modification and requiring a well-reasoned analysis will increase the predictability of the *de minimis* doctrine. It will also limit the subjectivity

305. See, e.g., *In re Harvey*, 12 F.3d 1061 (Fed. Cir. 1993) (reversing a finding of obviousness).

306. See *supra* notes 139–47 and accompanying text.

307. *Seiko Epson Corp. v. Nu-Kote Int'l, Inc.*, 190 F.3d 1360, 1368 (Fed. Cir. 1999).

308. See *Mueller & Brean*, *supra* note 2, at 425.

309. See *Mueller & Brean*, *supra* note 2, at 425.

310. See *id.* at 442.

311. See discussion *supra* Part II.C.

312. See discussion *supra* Parts II.C.2 and III.B.

of the analysis because courts will be prevented from completely altering the prior art in an unreasonable manner to find obviousness.

Second, courts should construe unclaimed subject matter of a prior art design patent as an invitation for subsequent designers to modify such subject matter. For example, consider a prior art design patent that discloses a design for a body of a water bottle, but does not disclose a design for a cap of a water bottle. Standing alone, there is no reason that a designer would subsequently modify the design of the body of the water bottle. However, courts should construe the unclaimed cap of the water bottle as an invitation for subsequent designers to design a cap and combine it with the prior art body of the water bottle.

But this construction alone should not be used to prove obviousness. It should simply serve as a starting point in the court's analysis of obviousness. Once the "invitation to modify" threshold is met, courts should still articulate a reason why a designer of ordinary skill *would* have been motivated to modify the prior art to arrive at the claimed design. Applying this "invitation to modify" threshold to the design of the water bottle, it should simply be more likely than not that a designer would modify the unclaimed cap of the water bottle.

Third, courts should begin the obviousness analysis with a presumption of non-obviousness where a subsequent designer modified claimed subject matter of a prior art design patent. For example, using the water bottle scenario, consider a subsequent designer who modifies the disclosed body of the water bottle in the prior art patent. Courts should apply a presumption of non-obviousness in this scenario. Claimed designs stand as a unitary concept.³¹³ Because the designer of the prior art body of the water bottle claimed the entire design of the body, this design stands as a whole and should be presumed non-obvious for a subsequent designer to modify that claimed design.

A patent challenger should be able to overcome a presumption of non-obviousness by demonstrating a clear reason why a designer of ordinary skill *would* have been motivated to modify the claimed subject matter of the prior art design patent. Absent a successful rebuttal of the presumption of non-obviousness, courts should conclude that the subsequent design is non-obvious in view of the prior art.

These three proposed modifications will help increase judicial consistency in the application of the non-obviousness requirement to design patent law. Modern courts are misapplying established precedent to the detriment of patent owners.³¹⁴ These modifications will increase

313. See *Durling v. Spectrum Furniture Co.*, 101 F.3d 101, 104–05 (Fed. Cir. 1996) (explaining that claimed designs protect the design's "visual appearance as a whole").

314. See discussion *supra* Part III.A.

predictability and help to better align non-obviousness design patent law with the statutory language of the non-obviousness requirement.³¹⁵

IV. CONCLUSION

Courts and administrative review agencies are misapplying the current design patent law non-obviousness requirement in contradiction with prior precedents and statutory language.³¹⁶ Unfortunately, design patent law jurisprudence often gets overshadowed by utility patent law and brushed to the side.³¹⁷ Non-obviousness is awkward to apply in the context of design patents because it is inherently more difficult to discern what is obvious when designs, by their very nature, cannot have functionality.³¹⁸ Nonetheless, non-obviousness is a statutory requirement for both utility and design patent law.³¹⁹

Courts have drifted impermissibly far from the language of the statutory non-obviousness requirement and non-obviousness judicial precedent.³²⁰ The statutory non-obviousness requirement very clearly imposes a *would* standard.³²¹ The courts have completely abandoned the plain language of the statute by applying a *should* standard.³²² Under the current trend, fewer designs are likely to survive invalidity challenges, which imposes severe consequences on designers who genuinely meet the statutory requirements of patentability.³²³

Creating a U.S. patent law system was a top priority in the early stages of the country, evidenced by the passage of the first Patent Act in 1790.³²⁴ Granting limited monopolies to inventors is an effective method of

315. *See id.*

316. *See* MRC Innovations, Inc. v. Hunter Mfg., LLP, 747 F.3d 1326 (Fed. Cir. 2014); Sealy Tech., LLC v. SSB Mfg. Co., 2020 WL 5033045 (Fed. Cir. 2020); LKQ Corp. v. GM Global Tech. Operations LLC, IPR2020-00064 (P.T.A.B. Apr. 15, 2021).

317. *See supra* notes 1–4 and accompanying text.

318. *See* Seiko Epson Corp. v. Nu-Kote Int'l, Inc., 190 F.3d 1360, 1368 (Fed. Cir. 1999).

319. 35 U.S.C. § 103 (explaining the non-obviousness requirement); 35 U.S.C. § 171(b) (applying the statutory requirement of non-obviousness to design patent law).

320. *See* cases cited *supra* note 316.

321. 35 U.S.C. § 103 (“A patent for a claimed invention may not be obtained...if the differences between the claimed invention and the prior art are such that the claimed invention as a whole *would* have been obvious...to a person having ordinary skill in the art.”) (emphasis added).

322. *See e.g.*, MRC Innovations, Inc. v. Hunter Mfg., LLP, 747 F.3d 1326, 1334 (Fed. Cir. 2014) (“[I]t is the mere similarity in appearance that itself provides the suggestion that one *should* apply certain features to another design.”) (emphasis added).

323. *See* 35 U.S.C. § 271(a) (imposing the requirements of novelty, originality, ornamental design, and applied to an article of manufacture to designs to be patented); 35 U.S.C. § 103 (imposing the requirement of non-obviousness on designs to be patented).

324. Patent Act of 1790, 1 Stat. 109 (1790) (repealed 1793).

progressing technological advancements. Application of an unpredictable standard to the non-obviousness requirement in the context of design patents creates uncertainty in judicial validity challenges. The courts need to return to the language of the statutory non-obviousness requirement in favor of the *would* standard. Application of a *could* or *should* standard renders almost every design unpatentable. A design is necessarily made up of preexisting elements. Under a *could* analysis of the non-obviousness requirement, combining any prior art references to arrive at the claimed design would render the design obvious, because a designer *could* have created the design. Application of a *should* standard goes even further. This standard imposes an affirmative duty on a designer to combine prior art designs, which is logically inconsistent with the goals of patent law.

The non-obviousness requirement in design patent law and utility patent law are governed by the same statutory language.³²⁵ Any differences that exist in the application of the non-obviousness requirement to design patent law are due to the inherent differences between designs and inventions. There is no compelling reason to alter the *would* standard in design patent law to make it more difficult for designers to meet the requirements for patentability. The proposed modifications in this Note would contribute to judicial consistency and predictability while better aligning the current non-obviousness analysis with the statutory language and utility law precedent.³²⁶

Ultimately, recent court decisions have eroded the non-obviousness requirement to an unrecognizable level that is inconsistent with patent law principles and generally illogical. Courts must be careful to apply the correct analysis of the non-obviousness requirement to preserve the delicate balance of rewarding designers with limited monopolies while ensuring the patented designs meet the statutory requirements of patentability.

325. 35 U.S.C. § 103.

326. See discussion *supra* Part III.C.