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Design Patent Obviousness After LKQ v. GM

A Short Guide to Accompany the Program Preview

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What the Preview Shows

The preview runs seven and a half minutes and is cut from the eighty-minute program *Design Patent Obviousness after LKQ v. GM*. It takes four passages in order: the fenders in *LKQ* itself and the gate that fell with them; the analogous art requirement that took the place of the two similarity tests; a complete prosecution file argued and allowed under the new test; and the three ways a challenger or examiner can explain why a designer would have selected a particular feature. This guide follows the same four passages, states in a page or two what each one holds, and ends with a description of what the full program and its sixty page companion paper cover.

The governing authority is 35 U.S.C. § 103; *LKQ Corp. v. GM Global Technology Operations LLC*, 102 F.4th 1280 (Fed. Cir. 2024) (en banc); the Supreme Court's decisions in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), and *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); and the USPTO's Updated Guidance and Examination Instructions of May 22, 2024. Pin citations in this guide are to *LKQ*.

1. The Fenders: What LKQ Changed and What It Kept

GM owns U.S. Design Patent No. D797,625, the front fender of the 2018 through 2020 Chevrolet Equinox. LKQ, a seller of replacement body parts whose license had expired, petitioned for inter partes review over a primary reference, the Lian design patent for an entire vehicle, and a secondary reference, a brochure showing the front fender of the 2010 Hyundai Tucson. The Board compared Lian with the claimed fender, catalogued the differences in the wheel arch, the door cut line, the protrusion, the creases, and the concavity line, and held that Lian was not "basically the same" as the claimed design. Under the test of *In re Rosen* and *Durling v. Spectrum Furniture*, which had governed for forty-two years, that finding ended the inquiry. The Board never reached the Tucson fender or the question of motivation.

The en banc Federal Circuit overruled that test. Two things changed. The primary reference no longer must be basically the same as the claimed design; it must still be identified, and it will ordinarily be the closest prior art, but visual similarity is now a matter of degree rather than a gate. 102 F.4th at 1298. And the reason to combine no longer must come from the references being "so related" that one suggests the other; consistent with *KSR*, it may come from outside the references, but "there must be some record-supported reason (without hindsight) that an ordinary designer in the field of the article of manufacture would have modified the primary reference with the feature(s) from the secondary reference(s) to create the same overall appearance as the claimed design." *Id.* at 1299.

Four things did not change. The four *Graham* inquiries govern. Every reference must be analogous art to the claimed design. A primary reference is still required, as a guard against hindsight. And the designs are compared as a whole, through the eyes of an ordinary designer in the field, not feature by feature. *Id.* at 1295-1300.

The practical consequence is visible in the fenders themselves. Under the old test GM prevailed at the threshold. Under the new test Lian is at least a strong candidate for a primary reference, the analysis begins easily, and the outcome turns on questions the Board never reached: whether the catalogued differences, viewed as a whole, are significant, and whether the record supplies a reason, independent of GM's design, to reshape Lian with features of the Tucson fender. The parties settled on remand, so no tribunal has answered those questions for these fenders. In the decisions since, most challenges that have failed have failed on the reason to combine.

2. Analogous Art: The Requirement That Replaced the Two Similarity Tests

Under *Rosen-Durling* the analogous art requirement did almost no work. The primary reference had to be basically the same as the claimed design, so it necessarily came from the same field, and the secondary reference had to be so related to the primary reference that one suggested the other, which took the place of asking what field it came from. Removing both tests created a risk: if any design from any field could be cited, almost any design could be assembled from something, and the only way to find the scattered pieces would be to use the claimed design as the map. *LKQ* met that risk with an express analogous art requirement applied to each reference. Each reference, primary and secondary, must be analogous to the claimed design; the references need not be analogous to each other. 102 F.4th at 1296-98.

The court held that a design from the same field of endeavor as the article of manufacture is analogous art, declined to say whether anything else qualifies, and observed that the utility test's second prong, whether a reference is reasonably pertinent to the problem the inventor faced, does not translate cleanly to designs. That left the line to be drawn case by case, and so far it has been drawn by examiners. Two files show where.

In Application No. 29/771,650, the claimed design was a pad for a vaporizer or diffuser. The Office rejected it over a menstruation pad in view of a sanitary napkin, reasoning that a pad is "a device used to absorb liquids" and that a designer of pads for scented liquids would look to catamenial pads for their absorbency. The applicant amended the title to "Vapor Pad for Vaporizer, Diffuser, Humidifier, or the Like," appealed, and argued that the field is vaporization, not menstrual hygiene. The examiner reopened and allowed, accepting "that the Smith and Jones references relating to menstruation pads are both nonanalogous art." Same shape, similar material, uses so different that no designer of one would look at the other.

In Application No. 29/882,266, the claimed design was a medical control console. The Office rejected it over patient monitors, and the applicant argued that a console that controls operative instruments in an operating room is a different article from a monitor that displays data in a recovery room. The examiner allowed on another ground but rejected that argument: the claimed design and the references "are all directed to monitor/console devices that are located in a medical setting and are all therefore analogous," and "the fact that they are all used in similar spaces for hospitals/patients is proof of analogousness."

Read together, the files show examiners defining the field by the setting in which the article is used and the user it serves, not by the article's name. An article-level argument wins where the uses are unrelated and loses where the articles share a setting and a user. A title amendment can narrow the field, but it does not change the setting, and it narrows the claim in later enforcement as well. No Board decision has yet drawn the line in a design appeal.

3. The Prosecution File: A Response Argued and Allowed Under the New Test

Application No. 29/877,958 claimed the ornamental design for a seat. In December 2025 the Office rejected it over a West Elm loveseat as the primary reference, in view of two secondary references said to supply the side frames, the cylindrical legs, the piped cushions, and the cushioned backrest. The stated reason to combine was that the modification would have been a simple combination of prior art elements according to known methods to yield predictable results.

The applicant's response made three arguments, and they are the three that the new test rewards. First, there was no record-supported reason for the combination: the action did not explain why an ordinary designer would select those side frames, those legs, those cushions, or that backrest from among all the alternatives in the prior art, or why the designer would take only those features from each reference and leave the rest. Second, the rejection had not identified all the differences; the response listed five it had not addressed, including the height of the front frame member, the taper of the legs, and the height and tilt of the backrest cushion. Third, the combination did not produce the claimed appearance, because the claimed backrest is tall, tilted, and curved, producing a reclined impression that the short, planar backrests of all three references lack.

The examiner withdrew the rejection and the patent issued as U.S. Design Patent No. D1,143,623 in August 2026. The reasons for allowance credited the combination of specific elements without saying which argument carried the day. That is typical of the files read for the program: examiners rarely concede that the reason to combine was deficient, and instead allow on a visual gap the combination leaves. The lesson is to make all three arguments in every response, and to name the fewest features that carry the overall impression, because under *Top Brand LLC v. Cozy Comfort Co.*, 143 F.4th 1349 (Fed. Cir. 2025), every feature an applicant identifies as distinguishing the prior art is discounted in a later infringement comparison.

4. A Sufficient Reason: Explaining the Selection, Not Merely the Availability

LKQ requires a record-supported reason, without hindsight, that a designer would have made the modification. The decisions that have rejected proffered reasons identify what was missing, and four elements can be assembled from them: a finding about who the ordinary designer is and what art that designer consults; a reason grounded in the field and proven with background art, such as market demand, industry custom, or the prevalence of a feature; an explanation of why the designer would have selected the specific claimed configuration rather than merely showing that the general feature was available; and a showing that the combination produces the same overall appearance as the claimed design.

The third element has decided the Board's institution denials. In *Next Step Group, Inc. v. Deckers Outdoor Corp.*, IPR2024-00525, Paper 16 (P.T.A.B. Aug. 6, 2024), a petitioner's showing that pull tabs were commonplace did "not offer adequate reasoning why a designer would select, from all the possible design options, the specifically configured pull tab of the claimed design." In *A&A Global Imports, Inc. v. Lerman Container Corp.*, IPR2024-01138, Paper 7 (P.T.A.B. Jan. 22, 2025), the petitioner had not explained why a designer "would have chosen to use the particular proportions claimed . . . as opposed to all other possible configurations." Showing that a feature existed does not explain the choice of the claimed version of it.

The explanation can be supplied in at least three ways: by showing that the specific configuration, and not merely the general feature, was prevalent in the field; by showing that the primary reference constrains the choice, so that a designer applying the feature to that reference would arrive at the claimed configuration; or by showing a convention or standard that dictates it. In examination the reason is now supplied almost uniformly by a form paragraph stating that the modification "is no more than a simple substitution of one known design element for another" and would have been "within the skill of an ordinarily skilled designer." That paragraph supplies availability and capability and never states why. It has been before the Board once, in *Ex parte Dascola*, Appeal No. 2025-003515 (P.T.A.B. Feb. 10, 2026), and the Board reversed for want of "any findings" that a designer would make the modification, "much less adequate reasoning as to why a designer would do so."

Six Things to Do in the Next Response

Test every reference, primary and secondary, against the article of manufacture of the claimed design. The analogous art requirement runs from each reference to the claim, not from one reference to another.

Find the sentence in the rejection that says why the primary reference would have been modified, and measure it against the requirement of a record-supported reason without hindsight. If the sentence is the simple-substitution paragraph, say so.

Ask whether the stated reason explains the selection of the specific claimed configuration or only the availability of a general feature.

Identify every visual difference between the claimed design and the proposed combination and explain how they combine into a different overall impression. An overlay of the whole combination on the claimed design lets the examiner verify the argument by looking.

Do not argue that the primary reference fails because it is not "basically the same," and do not treat a recitation that the references are "so related" as a finding. Both belong to the abrogated test.

Name the fewest features that carry the overall impression, and choose them with the likely accused products in mind. Argument-based prosecution history disclaimer applies to design patents.

What the Full Program and Companion Paper Cover

The program, *Design Patent Obviousness after LKQ v. GM*, runs eighty minutes and is accredited in Texas for 1.25 hours of MCLE credit. It is available at designpatentpro.com/cle-courses/. The companion paper, *Design Patent Obviousness After LKQ v. GM*, is sixty pages, updated September 12, 2026, with every citation checked against the underlying document. It is organized as follows.

Section	What it covers
Quick Reference Guide	Eleven things to do and ten things not to do in a design obviousness response, each tied to the authority behind it.
Part 1. Introduction and Theory	Why nearly every design can be assembled from prior art elements, why that makes hindsight the central danger, and how obviousness differs from anticipation.
Part 2. The Doctrinal Foundation	In re Jennings, In re Rosen, In re Glavas and Durling; the two problems LKQ identified; the facts and procedural history of LKQ; what the decision changed; what it kept; the record-supported reason and the ordinary designer's creativity.
Part 3. The Current Framework	The four Graham steps as applied to designs, including why analogous art now does independent work, the level of ordinary skill, the reason to combine and objective indicia (with the examination record on commercial success, copying, and long-felt need), and the Office's May 22, 2024 guidance.
Part 4. Affirmative Rebuttal Principles	Teaching away; destruction of the primary reference's fundamental characteristics; characteristics, not concepts; the combination must account for every material visual aspect; crowded field and design complexity.
Part 5. The Prosecution History Library	Eleven file histories read from the wrappers and organized by the step on which each turned: the primary reference (mug); analogous art (wireless tracking device, grooved mandrel, vapor pad, plasma processing ring, medical control console, knee support); the reason to combine (dual speedometer interface); the overall appearance (massage device attachment, delivery robot indicators); amendment (radial menu interface); and a complete file (seat).
Part 6. LKQ in Litigation and Post-Issuance Proceedings	The four forums; what can supply the reason to combine (similarity between the references, the patentee's own market development, functional reasons and their claim-scope consequences, evidence about the field, and what a sufficient reason would establish, including the examination record on the simple-substitution paragraph); what a challenger must prove; how LKQ reaches matters that appeared settled; current status and open questions.
Appendix 1	Response checklist for a design obviousness rejection.
Appendix 2	Questions and answers.
Appendix 3	Limitations of these materials.

Section	What it covers
Appendix 4	Table of authorities with the key holding of each: statutes and guidance; Supreme Court and Federal Circuit decisions; district court decisions; Patent Trial and Appeal Board decisions; and the prosecution histories discussed.

The paper is revised as the decisions and the examination record develop; the date on its title page is the date of the last revision. Questions about the program or the paper may be directed to Design Patent Pro at designpatentpro.com.