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Intellectual Property Update

Not So Obvious: The Future of the Design Patent Obviousness Inquiry

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Since 1996, the Rosen-Durling test has been applied to determine the obviousness of claimed designs during examination of design patent applications and in invalidity proceedings concerning issued design patents. In its first en banc hearing on a patent matter since 2018, the Court of Appeals for the Federal Circuit issued a decision mandating abandonment of the nearly 30 year-old Rosen-Durling test on May 21, 2024. The decision was issued in LKQ Corp. v. GM Global Technology Operations LLC, No. 2021-2348 (Fed. Cir. May 21, 2024) (LKQ).

Combining factors articulated in two different decisions issued in 1982 and 1996, the Rosen-Durling test establishes that a claimed design is obvious when two conditions are met. First, there must exist an earlier design that has "basically the same" visual impression as the claimed design. Second, it must have been obvious for a designer to arrive at the claimed design by modifying the earlier design through the use of additional designs that are "so related" to the earlier design that the appearance of features in one suggests using them in the other. Rosen-Durling established a significantly less flexible standard for deeming a claimed design to be obvious in comparison to the obviousness test applied to inventions claimed in utility patents and utility applications. In LKQ, the Federal Circuit went so far as to deem the Rosen-Durling test "improperly rigid."

Nine of the ten Federal Circuit judges who heard the LKQ case agreed that the Rosen-Durling test must be abandoned in light of the more flexible approach that is applied when determining obviousness in utility patents, specifically, the flexible approach established by the Supreme Court in the KSR v. Teleflex (KSR) case. Given that design patents and utility patents are both subject to the obviousness provisions of 35 USC §103 and that the Supreme Court explicitly rejected a rigid test for obviousness in utility patents in KSR, perhaps the abandonment of Rosen-Durling was inevitable.

While the exact scope of the effect that the LKQ decision will have on the design patent landscape is unclear, what is clear is that design patent applicants and practitioners will require a great deal more guidance in order to confidently seek protection for claimed designs and in order to defend against invalidity claims going forward.

The LKQ court acknowledged that the test used to determine what constitutes analogous art in utility patent matters cannot be applied in its entirety to design patent matters. The two questions considered in determining what constitutes analogous art in utility patent matters are: (1) whether the art is from the same field of endeavor as the claimed invention; and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. While the first question is fairly straightforward to apply to a design patent matter, the second question is essentially inapplicable to design patent matters. Regarding the second question, the LKQ court stated, "how to translate this part of the test into the design context is less apparent," since a design patent is directed to an overall visual impression with no substantive written description. The court declined to clarify how the second question can be applied or adapted for application in the design patent context, and only proceeded to state that the question of

whether a prior art design is analogous to the claimed design for an article of manufacture is a fact question to be addressed on a case-by-case basis.

Naturally, in addition to design patent applicants and practitioners, design patent examiners will also have to chart a new path forward post-LKQ. Kathi Vidal, the Director of the United States Patent and Trademark Office (USPTO), issued a memorandum (the Memo) one day after the LKQ decision was issued to provide guidance to design patent examiners in light of the newly mandated obviousness standard. Stating that the USPTO will issue further guidance and training as it continues to study LKQ in the context of existing precedent, the Memo provides examination instructions that should be followed until further guidance is issued. The Memo describes four factual inquiries to be conducted by an examiner, which pertain to ascertaining the scope and content of the prior art, the knowledge of an ordinary designer in the relevant field, and the differences between the prior art and the claimed design.

Of particular significance is a note in the Memo stating that motivation to combine primary and secondary references need not come from the references themselves, "[but] there must be some record-supported reason (without impermissible 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." Given that the Memo is directed toward examination of applications and that design patent applications contain no substantive written description begs the question: how realistic is it that there will exist any record-supported reasons for including any aspects of a claimed design in most design applications?

While much is uncertain, for now, there seems to be a real possibility that the newly mandated increased flexibility in design patent obviousness analyses may lead to longer examination times, increased prosecution history, and reduced issuance rates for design patent applications, as well as increased rates of issued design patents being deemed invalid during litigation.

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This Intellectual Property Update is intended to keep readers current on developments in the law. It is not intended to be legal advice. If you have any questions, please contact Maya Cheriyan at 412.566.2586 or mcheriyan@eckertseamans.com, or Nate Wilks at 412.566.6993 or nwilks@eckertseamans.com, or any other attorney at Eckert Seamans with whom you have been working.