

Patents Alert

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New Standard for Assessing Design Patents Replaces Long-Standing Test

In a recent en banc decision (*LKQ Corp., et al. v. GM Glob. Tech. Operations LLC*), the Court of Appeals for the Federal Circuit overruled the decades-old *Rosen-Durling* test for assessing nonobviousness in design patents under Section 103. The Federal Circuit found the old test to be overly rigid and incompatible with the U.S. Supreme Court's more flexible approach used for utility patents. The court opted instead to introduce a new approach meant to provide the same conditions for utility and design patentability, and which will likely make design patents more difficult to attain and defend.

The New Nonobviousness Test for Design Patents

The Federal Circuit's new test for design patents is aligned with the traditional *Graham* factors used in assessing utility patents. Most notably, all prior art need merely be "analogous" to the claimed design to be considered in the obviousness analysis. This "analogous art" approach does away with the *Rosen-Durling* test's requirement for a primary prior art reference to be "basically the same" as the claimed design. Thus, while a primary reference must still be identified, the new test lowers the bar for identifying that reference. Similarly, secondary references no longer need to be "so related" to the primary reference that features in one would suggest application of those features to the other, as required under *Rosen-Durling*. Instead, secondary references may also be any reference analogous to the claimed design.

As before, once the prior art is identified, the obviousness inquiry still asks whether an ordinary designer in the field would have been motivated to modify the primary reference to create the same overall visual appearance as the claimed design. But, as with utility patents, to combine primary and secondary references there must



be some record-supported reason (without hindsight) that an ordinary designer in the field would have modified the primary reference with features of the secondary reference to create the same overall appearance as the claimed design. Examiners and patent challengers will need to articulate this reasoning to make a case for combining references.

From a practical standpoint, the new approach outlined by the Federal Circuit will likely broaden the scope of prior art cited against design patents, potentially making existing design patents more susceptible to challenges and increasing obviousness rejections during patent examination. But while the Federal Circuit's decision provides some new guidelines for assessing design patent validity, it leaves several questions unresolved that will need further exploration by district courts and the U.S. Patent and Trademark Office (USPTO).

Open Questions in the Wake of the Federal Circuit's Decision

In view of this new standard and the potentially broader scope for invalidating design patents, an uptick in challenges to existing design patents is likely in the near

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future. As the Patent Trial and Appeal Board (PTAB) and the district courts work through those challenges, a clearer picture will form regarding how design patents will be treated moving forward. Some questions addressed in those proceedings will be:

What references will be considered “analogous” to a claimed design?

■ The Federal Circuit applied the traditional two-part test for utility patents for determining analogous art in design patents: (1) whether the art is from the same field of endeavor as the claimed invention; and (2) if not, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. While the first part of this test makes sense, the second part is less applicable because design patents are not generally considered to be solving any “particular problem.” Indeed, even the Federal Circuit conceded that “the second part of the two-part analogous art test for utility patents would not seem to apply to design patents in the same way, and how to translate this part of the test into the design context is less apparent.” Overall, the Federal Circuit concluded that the question of what qualifies as analogous art for design patents “is a fact question to be addressed on a case-by-case basis and we leave it to future cases to further develop the application of this standard.”

What qualifies as “motivation to combine” primary and secondary references?

■ The Federal Circuit stated that “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.” But, compared to utility patents, the “record” in design patents is normally quite sparse. For example, unlike utility patents, design patents do not include a detailed description that may be referenced to identify motivation to combine references.

How will the USPTO apply the new test during prosecution?

- Due to the Federal Circuit’s fact-specific and open-ended test for analogous art, applicants and examiners will likely disagree over which references are considered “analogous” to the claimed invention. Based on the Federal Circuit’s opinion, the USPTO issued new guidance to examiners outlining a four-part factual inquiry generally consistent with the *Graham* factors:
1. Identify a primary reference and secondary reference(s) (if necessary) that are analogous art. If art is not in the same field of endeavor, consider the degree to which an ordinary skilled designer would be motivated to consider other fields.
 2. Determine the differences between the identified prior art designs and the design claim by comparing the visual appearance of the claimed design with the prior art designs from the perspective of an ordinary designer in the field of the article of manufacture.
 3. Determine the level of ordinary skill in the art by considering the knowledge of a designer of ordinary skill who designs articles of the type being examined.
 4. Consider secondary considerations as indicia of obviousness or nonobviousness.

We will, of course, stay abreast of developments that address these and other questions left unresolved by the Federal Circuit’s new design patent test and how they may affect our clients’ design patent portfolios.

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