5 KEY TAKEAWAYS

Key Takeaways: A New Era Dawns for Design Patent Validity - How the Federal Circuit Has Rewritten Design Patent Obviousness Law

Kilpatrick partners Megan Bussey, Nicki Kennedy, and Michael Bertelson recently presented at the 20th annual KTIPS **(Kilpatrick Townsend Intellectual Property Seminar)** on the topic of **"A New Era Dawns for Design Patent Validity - How the Federal Circuit Has Rewritten Design Patent Obviousness Law."** The panel discussed U.S. design patents and how they have historically been very difficult to invalidate. For decades, the Rosen-Durling test has been used to assess obviousness of U.S. design patents. The test's rigid standard resulted in few design patents being invalidated as obvious. The Federal Circuit's May 2024 en banc decision in *LKQ Corporation v. GM Global Technology Operations LLC* overruled the Rosen-Durling test, paving the way for a more flexible approach to demonstrating design patent obviousness. This shift will impact how patent owners and patent challengers approach U.S. design patents in the future.

Megan, Nicki, and Michael provide these key takeaways from their presentation:

1

In May, 2024, the Federal Circuit, in an *en banc* decision, changed the obviousness standard for design patents. Now, instead of the more rigid *Rosen-Durling* test, the KSR analysis is used. This may result in a lower bar for finding design patents obvious in both prosecution and litigation.

2

Don't fear: design patents are still valuable! But be aware of this change to strategically manage design portfolios. The Federal Circuit left a lot for the lower courts and USPTO to work through so it remains to be seen how the application of KSR analysis affects design patents in practice. Much of the utility patent obviousness analysis may be difficult to apply to design patents.

3

For existing cases, consider fallback positions (e.g., child applications) to have options if one of your older designs is challenged under the new standard. Continue to consider both entire articles and portions thereof for coverage. And don't forget that design patent applications can be filed across a variety of fields, including for GUIs.

4

Be proactive: collect evidence related to secondary considerations (in particular before enforcement). Again, it remains to be seen how much the KSR analysis will change the outcome of design patent challenges in practice but secondary considerations will likely be an important piece of rebutting an obviousness argument.

5

Consider Post Grant Proceeding challenges to design patents that are currently road blocks. Such proceedings were previously underutilized with less than 100 total challenges files since 2013. And such proceedings were largely based on unusual fact patterns. But Post Grant Proceedings now present an attractive option that can complement other prosecution and litigation strategies.

For more information, please contact: www.ktslaw.com

Megan Bussey, mbussey@ktslaw.com
Nicki Kennedy, nkennedy@ktslaw.com
Michael Bertelson, mbertelson@ktslaw.com