IP Alert | The USPTO Issues New Guidance to Examiners for Applying Obviousness in Design Filings in View of the LKQ Corporation v. GM Global Technology Operations LLC Decision

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In light of the Federal Circuit's en banc decision in LKQ Corporation v. GM Global Technology Operations LLC, the U.S. Patent and Trademark Office ("USPTO") has issued updated guidance and examination instructions in a Memorandum ("Memo") dated May 22, 2024 and signed by Director Vidal to design examiners and the Patent Trial and Appeals Board ("PTAB"). Specifically, the Memo provides guidance to patent examiners and the PTAB for determining whether design patents are invalid for obviousness or the combination of previous designs, which is referred to as prior art. In a significant shift from previous examination procedures, the new guidance and examination instructions attempt to align USPTO procedures with the Federal Circuit's conclusion that the previous Rosen-Durling two part test was too rigid, where the Rosen-Durling two part test required a primary reference be"basically the same" as the claimed design, and secondary references be "so related" to the primary reference that the features of the secondary references suggest a combination with the primary reference in order to prove design patent obviousness.

The Memo provides examination guidance for applying the new test which is more aligned with utility patent law precedent and specifically as recited in the Manual of Patent Examining Procedure ("MPEP") 2141 et seq. dealing with utility patents.

The Memo espouses the new flexible framework for examiners to apply in determining obviousness in design patents:

- The scope and content of the prior art;
- Differences between the prior art and the design as claimed at issue;
- The level of ordinary skill in the art;
- Secondary considerations, "such as commercial success might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented and may be relevant as indicia of obviousness or nonobviousness, when evidence of such considerations is presented" (internal quotes omitted).

Noteworthy in the application of the above factors, the Memo advises examiners in reviewing the first factor—the scope and content of the prior art—that a primary reference must still be identified, but it is not required that the primary reference is "basically the same" as the claimed design as in the previous Rosen-Durling test. The primary reference must be something in existence and not something that "might be brought into existence by selecting individual features from prior art and combining them." The Memo also indicates the primary and secondary references will typically be in the same field of endeavor as the claimed article of manufacture, but this is not required if it is analogous art. The USPTO's approach to determine whether prior art is analogous is whether an ordinary skilled design would be motivated to consider other fields. Also, for the second factor—differences between the prior art and the claimed design—examiners should consider differences between the claimed design and the prior art from the perspective of an ordinary designer in the same field as the claimed article of manufacture.

In evaluating obviousness, the Memo notes that after determining the scope and content of the prior art, the examiner must determine whether an ordinary designer in the same field of the claimed design would have been motivated to modify the prior art design to create the same overall appearance as the claimed design. Also, the primary and secondary references do not need to be "so related" that features in one would suggest application to the other, provided the primary and secondary references are analogous art. Finally, there must be a "record-supported reason" that an ordinary skilled designer would have modified the primary reference with features from the secondary references to create the same overall appearance as the claimed design without relying on impermissible hindsight.

Takeaways

The guidance is a substantial shift in the determination of obviousness in design patents from the expansion of the scope and content of the prior art and the new emphasis on the rationale to combine primary and secondary references. The new analogous art consideration as the degree to which an ordinarily skilled designer would be motivated to consider other fields art has no articulated standard at this stage. Moreover, there seems to be a limited definition of a "record-

supported reason” for combining of references in the design context. As such, the application of the new test will likely lead to inconsistencies in examination, but the USPTO may issue additional guidance. We expect there may be a need for more examiner interviews if examiners cite analogous art as a basis for a secondary reference or to address examiner rationale for the combining of prior art. Furthermore, in light of the Memo, applicants should consult with patent counsel to consider the closest prior art, prior art searching, and enhanced strategic pre-filing claim scope determination in order to avoid potential obviousness rejections.

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