Herda in IP Law Daily: 'Rigid' Obviousness Test for Design Patents Jettisoned for 'Flexible' Approach

May 24, 2024 Alan Herda

PRACTICES Intellectual Property, Patents, Patent Litigation

Haynes Boone Partner Alan Herda spoke with *IP Law Daily* after the Federal Circuit overturned its longstanding *Rosen-Durning* test, eschewing its requirement that primary prior art be "basically the same" as a challenged design.

According to Herda, this decision will make it easier to challenge design patents for obviousness. "It is likely that more design patents will be found invalid as obvious because of the abandonment of the *Rosen-Durning* test," Herda said. "As a design patent application prosecutor, I'm worried about pending design patent applications, especially allowed applications—will I receive Notices of Withdrawal from Issuance?

Herda also cautioned that design patent practitioners might now need to take additional drafting steps. "When drafting new design patent applications, adding illustrations of unclaimed structures should be considered because, during prosecution, the structures may need to be claimed to overcome obviousness rejections," he said. "It may be necessary to consider the filing of multiple design patent applications having different design claims, to increase the likelihood that at least one design claim will withstand an obviousness attack."

Regarding the impact of the Federal Circuit's decision, Herda also said, "Now that the *Rosen-Durning*test has been abandoned and design patent obviousness is super unclear, the scope of analogous art for a claimed design is more important than ever – consequently, when drafting a new design patent application, design patent counsel must work with their client to understand the article of manufacture that is most important to the client."

Added Herda, Questions to ask include:

- What is the specific article that the client does not want copied by others?
- Does the client plan to implement the article in different applications or products?
- Should the specification of the design application set forth examples of different applications or products and, if so, do the solid lines in the figures illustrate a claimed design that is broad enough to encompass all the examples?
- Should the specification provide additional context for the article of manufacture?

To read the full article in *IP Law Daily*, click here.
Herda also spoke with *The National Law Journal* on this topic, which can be found here.
Haynes Boone Partner Vera Suarez and Herda authored an alert, which can be found here.