

Design Patent ProGuide – Prosecution History Estoppel and Disclaimer

Updated August 20, 2015

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1. Introduction and Theory

Prosecution history estoppel and prosecution history disclaimer are doctrines that can significantly impact the scope and enforceability of design patents. Both doctrines arise from statements or actions made during prosecution, but they operate in different ways. Prosecution history disclaimer limits claim scope through claim construction, effectively narrowing the meaning of the design claim based on what the applicant “clearly and unmistakably” disavowed to obtain allowance. Prosecution history estoppel, by contrast, bars a patentee from later recapturing through litigation subject matter that was surrendered during prosecution, often by amendment or argument.

For design patents, the risk of triggering these doctrines is heightened because arguments are typically made in visual terms, often focusing on specific features of the design. If the applicant places heavy emphasis on a particular element, such as the shape, location, or proportion of a feature, the courts may later construe that feature as central to the claim. This can severely limit the scope of protection and reduce the value of the patent.

Recent cases illustrate this risk. In *Top Brand v. Cozy Comfort*, the Federal Circuit applied prosecution history disclaimer where the applicant repeatedly emphasized the size and shape of a garment pocket, the slope of a hem, and the placement of armholes as dispositive differences over the prior art. The court held that these arguments clearly disclaimed claim scope, preventing the patentee from asserting infringement based on those features later. Conversely, in *Design Ideas, Ltd. v. Target Corp.*, a district court declined to apply estoppel because the applicant’s references to multiple features (such as “seamless corners” in a wire mesh basket) were framed as illustrative examples of overall visual differences, rather than as essential claim-defining elements.

The lesson for prosecutors is clear. The way arguments are framed during prosecution can either preserve or erode the enforceability of a design patent. Applicants should emphasize the overall visual impression of the claimed design rather than isolating individual features as dispositive. Specific differences may be used as supporting examples, but they should not be characterized as essential to patentability. Avoiding absolute language, limiting reliance on annotated figures, and thinking ahead to potential litigation are critical strategies for minimizing the risk of narrowing the claim through disclaimer or estoppel.

At its core, the theory behind these doctrines is to hold applicants accountable for representations made to secure allowance. Courts will not permit patentees to recapture, in litigation, what they explicitly surrendered during prosecution. For design patents, this means prosecutors must strike a careful balance: arguments must be strong enough to overcome rejections but nuanced enough to avoid inadvertently disavowing valuable claim scope.

2. Principles and Rules

The principles governing prosecution history estoppel and prosecution history disclaimer in design patents largely mirror those in utility patents but apply uniquely in the visual design context. Both doctrines operate to prevent patentees from asserting rights broader than what they secured at the USPTO.

A. Prosecution History Disclaimer (Claim Construction Rule)

Disclaimer arises when an applicant makes clear and unmistakable statements during prosecution that limit claim scope. In design cases, disclaimer most often occurs when the applicant identifies a particular feature as critical to distinguishing the claimed design from the prior art. By elevating that feature above others, the applicant effectively disavows broader coverage. Courts require that the disclaimer be “clear and unmistakable.” Ambiguous statements or general references to overall appearance are not enough.

B. Prosecution History Estoppel (Amendment/Argument Rule)

Estoppel arises when an applicant narrows a claim by amendment or argument to secure allowance. The applicant cannot later reclaim the surrendered territory in litigation. For design patents, estoppel typically results from adding or emphasizing claim limitations in response to prior art. For example, if an applicant argues that a square base rather than a circular base is what makes the design patentable, estoppel may bar asserting infringement against a circular-base design. Estoppel applies even if the applicant did not intend to surrender claim scope, so long as the narrowing was material to allowance.

C. Ordinary Observer and the Overall Visual Impression

Both doctrines must be understood in light of the ordinary observer test from *Egyptian Goddess*. Courts are hesitant to allow disclaimers or estoppel to eliminate the central focus on the overall design. However, if prosecution history indicates that the applicant relied on specific features as decisive, those features may control in later litigation.

D. High Bar for Courts, High Risk for Applicants

Courts emphasize that prosecution history disclaimer and estoppel are narrow exceptions, applied sparingly and only when the record leaves no doubt. Nevertheless, the practical risk for design applicants is high, because arguments often focus on individual visual elements. Statements about relative proportions, placement of features, or the absence/presence of details may all be construed as disclaimers.

E. Key Rule of Practice

Prosecutors should always tie arguments back to the overall visual impression of the design, and when citing particular features, present them as examples of how the overall impression differs from the prior art, not as essential limitations.

3. Recommended Form

When responding to design patent prosecution rejections under 35 U.S.C. § 102 (anticipation) and 35 U.S.C. § 103 (obviousness), and distinguishing prior art, try to avoid triggering prosecution history disclaimer or estoppel by focusing your arguments on the *overall visual impression* of the claimed design. Arguments that overemphasize specific elements, especially with definitive language and annotated figures, risk being construed as a narrowing of claim scope. To minimize this risk:

A. Consider framing your arguments on the designs *as a whole*. Emphasize how the totality of visual elements combine to create a distinct overall appearance.

B. Consider using individual features as illustrative examples only. If you must reference specific differences, make clear they are not essential but merely support the broader ornamental distinction.

C. Consider avoiding absolute language. Phrases like “for this alone, the design is patentable” or “this feature is significantly different” may suggest that a particular element defines the claim.

D. Consider de-emphasizing annotated drawings. While visual aids certainly can help, making them the focal point of a specific feature-by-feature comparison rather than an overall visual impression risks overemphasizing the importance of individual design elements.

E. Consider thinking ahead to litigation. If a feature is repeatedly and strongly emphasized in prosecution, it may be deemed disclaimed or surrendered later in court, even if it wasn’t strictly necessary to distinguish the prior art.

Carefully crafted arguments can preserve the full scope of the claim while still overcoming rejections. The goal is to persuade the examiner without limiting future enforcement options. The three cases discussed below show how differences in arguments can significantly impact the enforceability and litigation value of a design patent.

4. Most Common Rejections

A. § 102 anticipation rejections

(ordinary observer standard, one-to-one comparison with a prior art design).

B. § 103 obviousness rejections

(motivation to combine references, less feature-focused, but still risky if overemphasized).

5. Prosecution History Rejections and Responses

Prosecution history estoppel and disclaimer typically arise not from the examiner's wording but from the applicant's own responses to rejections. The record of exchanges between the examiner and the applicant can later be invoked in litigation to narrow the scope of the claimed design.

A. Nature of Rejections.

The underlying rejections that give rise to estoppel or disclaimer are generally anticipation (§ 102) or obviousness (§ 103) rejections. These rejections are framed in terms of whether the claimed design creates a substantially similar overall visual impression to prior art. Unlike utility cases, design examiners rarely issue express "indefiniteness" or "disclaimer" rejections. The danger arises in how the applicant chooses to argue against the cited references.

B. Typical Responses That Create Estoppel or Disclaimer.

Typical responses that create estoppel or disclaimer include feature-based distinctions, such as when an applicant argues that the distinguishing feature of the claimed design is the shape of the spout or that the critical difference is the contour of the base. Courts may later treat such statements as disclaimers. Absolute language, such as "the only difference" or "essential element," can narrow claim scope even if not intended. Over-reliance on broken lines to distinguish prior art solely by reference to what is in solid versus broken lines can be construed as a concession that the claimed design is limited to those elements. Annotated submissions, such as highlighting or circling differences on figures submitted in prosecution, may also be viewed as narrowing arguments.

C. Safer Forms of Response.

Safer forms of response involve framing distinctions in terms of overall visual impression, consistent with *Egyptian Goddess* and subsequent Federal Circuit guidance. Illustrative phrasing may be used, such as stating that the cumulative effect of the contouring, proportions, and relative placement of elements produces an overall visual impression distinct from the cited prior art. When citing specific features, it is important to make clear that they are examples rather than exclusive distinctions.

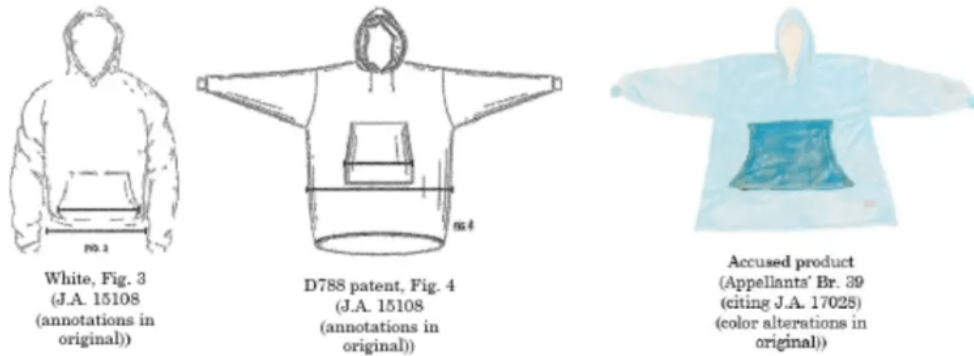
D. Impact on Litigation.

Courts have repeatedly relied on prosecution history to narrow claim scope in design cases. Statements made in response to rejections can be invoked under the doctrines of prosecution history disclaimer or prosecution history estoppel, reducing the design's enforceable scope. For this reason, responses should be crafted with an eye not only toward allowance but also toward preserving claim breadth for enforcement.

6. Prosecution History Case Examples and/or Cases

- A. *Top Brand v. Cozy Comfort*, 2024-2191, 2025 U.S. App. LEXIS 17670 (Fed. Cir. 2025)

In *Top Brand*, the Federal Circuit applied prosecution history disclaimer to a design patent for an oversized hoodie with a front pocket (the difference between prosecution history disclaimer and prosecution history estoppel is explained in the comments below). During prosecution, Cozy Comfort distinguished its claimed design from prior art by emphasizing several specific features, such as the width and shape of the marsupial pocket, its position relative to the armholes, and the slope of the bottom hem.



The court found that these detailed arguments constituted a clear and unmistakable disavowal of claim scope and construed the claim as not including these features. Since *Top Brand*'s accused products included the very features Cozy Comfort had disclaimed to obtain allowance, the court held that Cozy Comfort could not rely on those features to argue for infringement.

Why did the argument in *Top Brand* trigger prosecution history disclaimer? The applicant repeatedly focused on individual design elements (e.g., pocket position, pocket width, armhole placement, hem slope) and presented them as distinctive and dispositive. The phrase “[f]or this alone, the claimed design [was] allowable” was particularly damaging because it signaled to the examiner, and later, to a court, that certain features were essential to patentability. Using visual side-by-side annotated figures to call out these features on an individual basis, rather than collectively, added weight and specificity to the arguments. Finally, other than a conclusory statement, there was little effort to substantively argue that the overall combination of features created a different look. Instead, the applicant’s approach parsed the design into separable, isolated features.

How might the argument in *Top Brand* been improved? Since in *Top Brand* the accused design appears to be closer to the prior art than to the patented design, avoiding prosecution history disclaimer ultimately may not have made a difference in the outcome of the case. However, to increase the chances of the case not being decided as a matter of law based on disclaimer, the following type of argument might be considered. This argument emphasizes overall appearance rather than individual elements, recasts specific differences as examples, not claim-defining features, and avoids definitive or absolute statements. This type of argument probably would at least make it harder for a court to find prosecution history disclaimer.

Claim 1 has been rejected under 35 U.S.C. § 102 in view of U.S. Patent No. D728,900 (“White”). Applicant respectfully submits that the overall visual impression of the claimed design is distinct from the reference and that an ordinary observer would not be deceived into purchasing one thinking it is the other. Accordingly, Applicant requests withdrawal of the rejection.

Although both designs generally reflect a hooded over-garment, the claimed design conveys a different and exaggerated ornamental impression, in part due to its overall proportions and styling. These differences arise from several aspects of the visual presentation, viewed in combination and in context.

For example, the claimed design includes a centrally positioned marsupial pocket that contributes to the overall look by visually dividing the elongated torso. In contrast, the reference places the pocket differently, integrated near the hemline, which alters the torso’s visual rhythm. The relative size and position of this pocket, along with its proportional relationship to the torso, supports a distinct ornamental appearance.

Other aspects that contribute to the differing visual impression include the relationship between the armhole openings and the pocket, as well as the configuration of the lower hem, which in the claimed design slopes in a different direction than in White. These characteristics, along with the overall exaggerated silhouette, produce a combination of visual effects that distinguish the claimed design in the eyes of an ordinary observer.

While certain features such as the hood and general structure are shared, these are common to many garments in this field and do not define the design’s overall visual impression. The claimed design’s collective arrangement and proportioning of familiar elements results in a distinct appearance, especially when considered in light of prior art.

Accordingly, Applicant respectfully requests that the § 102 rejection be withdrawn so that the application may proceed toward allowance.

B. *Design Ideas, Ltd. v. Target Corp.*, No. 20-cv-3231, 2021 U.S. Dist. LEXIS 243072 (C.D. Ill. 2021)

In *Design Ideas*, a district court rejected a defendant’s attempt to apply prosecution history estoppel to bar a finding of infringement. The design at issue was a wire mesh basket, and during prosecution of a parent application, the applicant distinguished prior art by listing nine features, including “seamless corners,” as reasons the claimed design created a different visual impression.

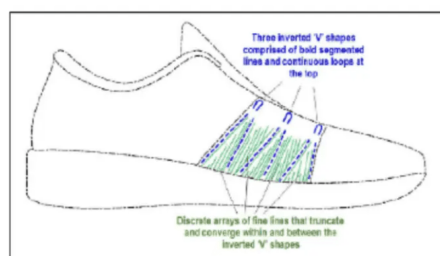
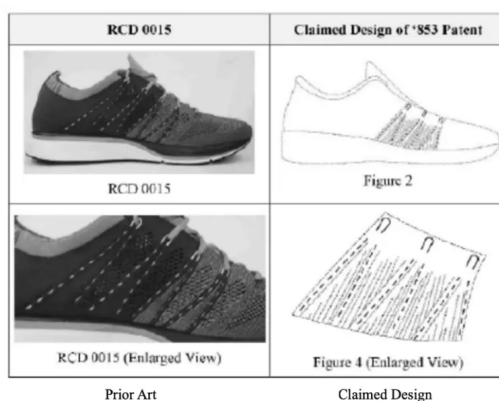


Defendant Target argued that this amounted to a surrender of all designs lacking seamless corners. But the court disagreed, emphasizing that argument-based estoppel requires a “clear and unmistakable” surrender, *id.* at *9, and that merely identifying multiple visual differences to overcome a prior art rejection does not amount to an explicit disavowal of any one feature. As a result, the court declined to apply prosecution history estoppel and allowed the infringement claim to proceed.

Why did the argument in *Design Ideas* not trigger prosecution history estoppel? The court found that the applicant’s statements during prosecution did not amount to a “clear and unmistakable” surrender of claim scope. Although the applicant distinguished prior art by listing nine visual features of the claimed wire mesh basket, including “seamless corners,” those features were not emphasized as essential or dispositive. Instead, the applicant argued that the *overall visual impression* of the claimed design differed from the prior art, and the listed features were offered collectively to support that point. The applicant did not single out any one feature as required for patentability. The court emphasized that argument-based estoppel requires far more than simply identifying visual distinctions. Since the applicant’s remarks were framed as only *examples* of differences contributing to the total appearance, the court declined to apply estoppel.

C. *Nike, Inc. v. Skechers U.S.A., Inc.*, No. LA CV17-08509, 2020 U.S. Dist. LEXIS 257711 (C.D. Cal October 26, 2020)

In *Nike*, a district court applied prosecution history estoppel to bar some of Nike’s design patent infringement claims. During inter partes review proceedings before the PTAB, Nike had repeatedly distinguished its asserted design patents from the prior art by emphasizing specific visual features, particularly “discrete arrays of converging and truncated lines of substantially the same width.” *Id.* at *19.



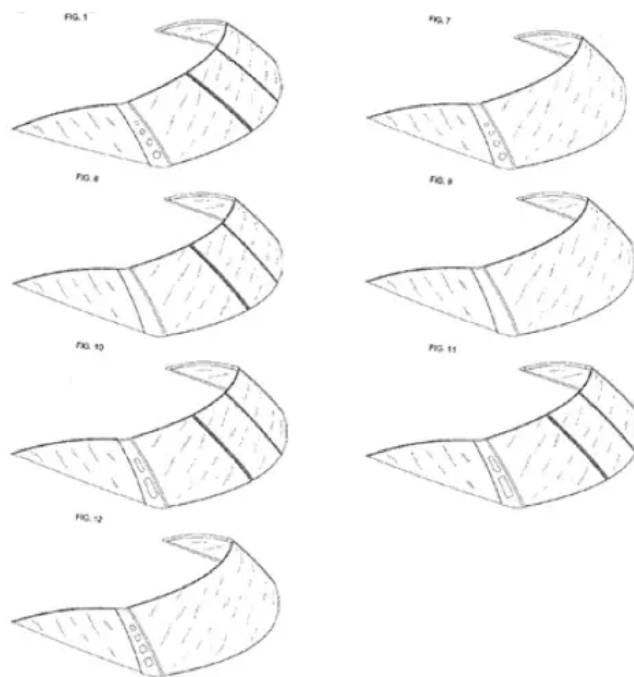
These arguments were made to oppose institution of review and were repeated across multiple filings and against several prior art references. The court found these statements to be clear and unmistakable assertions about the claimed design's visual scope, made in support of patentability. Although Nike argued that it had relied on a variety of distinguishing features, the court held that estoppel is not limited to what was strictly necessary to overcome prior art.

Why did the argument in *Nike v. Skechers* trigger prosecution history estoppel? The court found that Nike repeatedly and unambiguously emphasized specific visual features as the basis for distinguishing its claimed designs from the prior art during inter partes review (IPR) proceedings before the PTAB. In particular, Nike relied heavily on the presence of “discrete arrays of converging and truncated lines of substantially the same width” as defining elements of the claimed designs. These statements were not isolated or incidental; they appeared across multiple Patent Owner Preliminary Responses (POPRs), were supported by annotated images, and were invoked in opposition to various prior art references. The court concluded that Nike had clearly and unmistakably surrendered claim scope encompassing designs lacking those particular line arrays.

Although Nike argued that it had relied on a variety of distinguishing features, the court applied argument-based estoppel and held that estoppel is not limited to what was strictly necessary to overcome prior art. Instead, estoppel may apply where a reasonable competitor would understand certain subject matter to have been surrendered based on the applicant's repeated and specific representations. While this language may resemble prosecution history disclaimer doctrine, courts have used similar reasoning when evaluating argument-based estoppel, particularly where the patentee's statements were clearly made in support of patentability and repeatedly emphasized particular features. Because Nike had consistently portrayed the converging and truncated line arrays as central to patentability, the court held that prosecution history estoppel applied, barring Nike from asserting infringement against designs that lacked those specific features.

D. *Pacific Coast Marine Windshields v. Malibu Boats, LLC*, 739 F.3d 694 (Fed. Cir. 2014)

As recognized in *Pacific Coast Marine Windshields*, estoppel may result from a restriction requirement when the applicant elects one embodiment and fails to pursue the non-elected embodiments. In *Pacific Coast*, a case involving a boat windshield design, the patentee filed an application with various embodiments having different vent hole configurations.



The examiner determined that the drawings included five patentably distinct designs and required the patentee to select one group for prosecution. The patentee made the selection and ultimately continued prosecution of only two of the five design groups.

The patented windshield design sued upon contains a hatch with four circular vent holes. One of the design groups the patentee did not prosecute contains a hatch with two rectangular vent holes. The accused design contains a hatch with three trapezoidal vent holes.

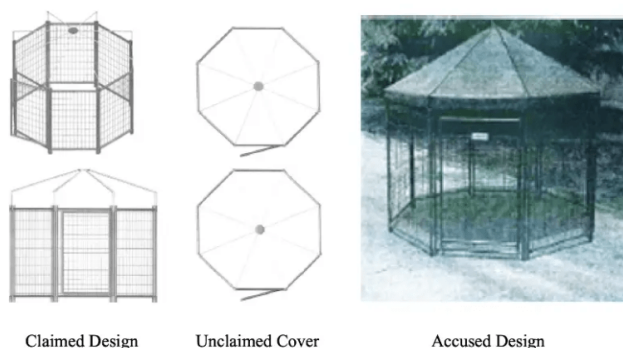


The district court concluded that by failing to separately prosecute the cancelled embodiment, the patentee put the public on notice that the subject matter was surrendered and dedicated to the public. Although the abandoned design had two rectangular holes and the accused design had three trapezoidal vent holes, the district court found the accused design within the territory between the original claim and the amended claim and held the patentee estopped from claiming infringement. The Federal Circuit reversed, reasoning that although the applicant surrendered the claimed design with two holes on the windshield corner post, the applicant neither submitted nor surrendered any three-hole design.

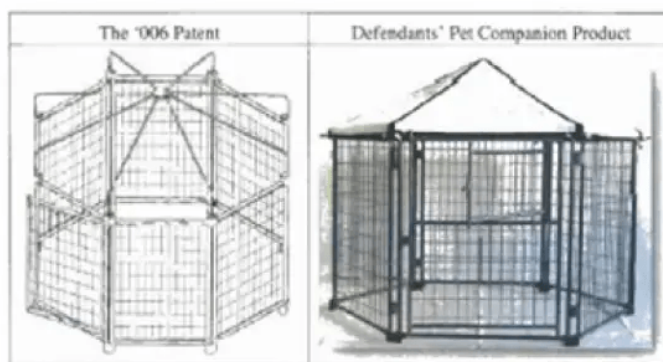
Note that even though an election following restriction is not technically an amendment, the court held that such a choice in response to a patentability requirement effects a surrender of claim scope analogous to an amendment, and estoppel applies accordingly.

- E. *Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co.*, 898 F.3d 1210 (Fed. Cir. 2018).

In *Advantek*, the examiner issued a restriction requirement between a frame design with a cover and a frame design without a cover. The applicant elected the frame design without a cover.

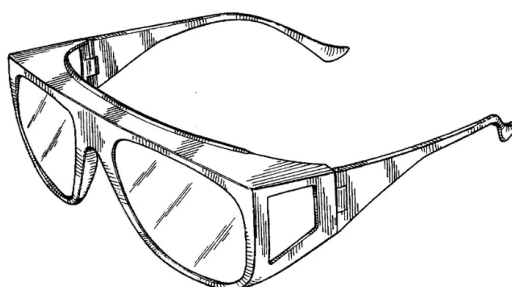


The defendant, who was selling an accused frame design with a cover, argued that prosecution history estoppel applied because the applicant did not pursue the frame with a cover. The district court found estoppel based on an election of species, but the Federal Circuit reversed, concluding that even if there had been a surrender, the accused product fell outside the scope of the purported surrender. The Court reasoned that Advantek elected to patent the ornamental design for a kennel with a particular skeletal structure and a competitor who sells a kennel embodying the patented design infringes, regardless of extra features like a cover that might be added to the design.



- F. *Australia Vision Services Pty., Ltd. v. Dioptics Medical Products, Inc.*, 29 F. Supp. 2d 1152 (C.D. Cal. 1998)

In *Australia Vision Services*, the court applied prosecution history estoppel in a design patent case where the applicant submitted amended drawings to correct a rejection but was then required to remove newly added features after the examiner issued a new matter rejection under § 112. The applicant had introduced side panel lenses in revised drawings, which were rejected as impermissible new matter. To overcome the rejection, the applicant deleted the side lenses and the patent issued without them.



Patented Design

The court held that the sequence of adding and then withdrawing claim content to gain allowance constituted a surrender of claim scope. Because the accused sunglasses included the very side lenses that had been removed during prosecution, the court held that prosecution history estoppel barred the patentee from successfully asserting infringement.

F. *Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334 (Fed. Cir. 2019)

In *Curver*, the applicant changed the title from “Furniture (Part of-)” to “Pattern for a Chair” in response to an examiner’s rejection that the original title was too vague to define a specific article of manufacture.

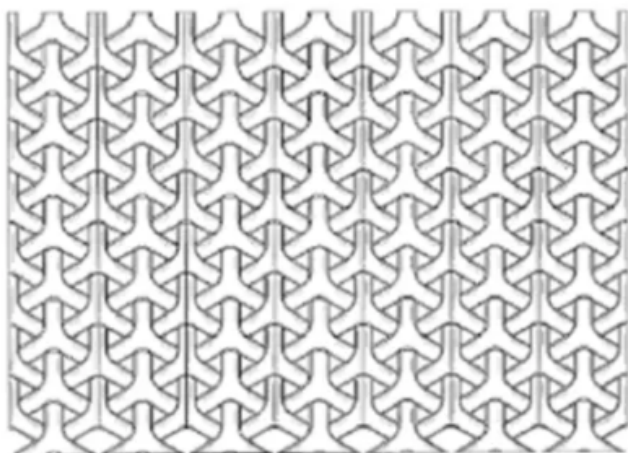


FIG. 1

Claimed Design



Accused Product

The Federal Circuit held this amendment constituted a narrowing of claim scope and gave rise to prosecution history estoppel, regardless of the lack of amendment to the drawings. The court ruled there was no infringement because the design was limited to patterns applied to chairs and not baskets, even though the accused baskets shared the same ornamental design pattern.

G. *Egyptian Goddess v. Swisa*, 543 F.3d 665, 680 (Fed. Cir. 2008) (en banc)

While primarily known for articulating the ordinary observer test, this case is also relevant for understanding how arguments about prior art may influence later claim interpretation. Although the decision did not explicitly apply prosecution history estoppel, it underscored the importance of framing distinctions in terms of overall impression rather than isolated features.

H. *High Point Design v. Buyers Direct*.

The Federal Circuit reiterated that prosecution history can play a role in design patent scope, even though the focus remains on the ordinary observer test. Statements in the record may serve to confirm or limit the visual impression asserted by the patentee.

7. Questions and Answers

A. What is the difference between prosecution history estoppel and prosecution history disclaimer?

Prosecution history estoppel generally arises from amendments that narrow the scope of a design claim to secure allowance, and it prevents the patentee from later reclaiming the surrendered subject matter under the doctrine of equivalents. Prosecution history disclaimer, on the other hand, arises from arguments made to distinguish the claimed design from prior art, and it prevents the patentee from asserting a broader scope than what was represented during prosecution.

B. Can both estoppel and disclaimer apply in the same case?

Yes. If an applicant both amends drawings and makes narrowing statements to overcome rejections, courts may find both estoppel and disclaimer, restricting enforcement from multiple directions.

C. How can practitioners avoid triggering disclaimer or estoppel?

Practitioners should avoid absolute or feature-based arguments and instead emphasize the overall visual impression. When amendments are unavoidable, they should document clearly that the changes are made for procedural reasons rather than substantive narrowing of claim scope, whenever possible.

D. Does the USPTO examiner intend for applicant statements to create disclaimer?

No. Examiners generally view applicant statements as advocacy, not binding disclaimers. However, courts in later litigation may treat them differently, which is why applicants must be cautious in framing responses.

E. Are design patents more vulnerable to disclaimer than utility patents?

In some respects, yes. Because design patents are judged by overall visual impression, isolated statements about “critical” or “essential” features can more easily be used against the patentee to limit scope. The visual nature of the claim means courts often look closely at what the applicant emphasized during prosecution.

8. Checklist

A. Review amendments carefully to determine whether they could later trigger prosecution history estoppel by narrowing claim scope.

B. Avoid language in responses that singles out individual features as “essential,” “critical,” or “distinguishing,” since such statements may be treated as prosecution history disclaimer.

C. When responding to prior art, frame arguments around the overall visual impression rather than dissecting individual elements of the design.

D. Document reasons for amendments, clarifying when they are procedural (e.g., restriction requirements) rather than substantive, to reduce risk of later estoppel.

E. Consider consistency across multiple related applications and divisionals to prevent conflicting statements that may create unintended disclaimers.

F. Regularly review prosecution records of design patents being enforced to identify any potential estoppel or disclaimer issues before litigation.

G. Practical Interview/Recordkeeping Tips – Carefully document examiner interviews and follow-up letters to control the record.

9. MPEP, CFR, and Statutory References

A. MPEP § 2111.01.

This section discusses claim interpretation in light of the prosecution history and is applicable to both utility and design patents. It highlights how statements made during prosecution may limit claim scope.

B. MPEP § 1504.01(c).

This section addresses restriction practice in design applications. Amendments made in response to restriction requirements may have estoppel implications if they remove claim scope.

C. MPEP § 1503.01.

This section explains the form and content of design drawings. Amendments to drawings that eliminate certain embodiments may later give rise to prosecution history estoppel.

D. MPEP § 1490.

This section emphasizes the importance of a complete record, including applicant statements, which courts may later review when determining the scope of a design claim.

E. 37 C.F.R. § 1.111.

This rule governs replies to Office actions and emphasizes that amendments and arguments become part of the official prosecution record, potentially supporting estoppel or disclaimer in later proceedings.

F. 37 C.F.R. § 1.121.

This rule governs the manner of making amendments in patent applications. Amendments that narrow or alter claim scope, including design drawings, may later be interpreted as a basis for estoppel.

G. 37 C.F.R. § 1.153.

This rule addresses requirements for design patent applications, including the single-claim format. Limitations or changes to the design claim during prosecution can later carry disclaimer implications.

H. 37 C.F.R. § 1.56.

This rule on the duty of candor and disclosure requires applicants to be truthful and complete in submissions. Statements or omissions in the record may be scrutinized in litigation and potentially viewed as disclaimer.

I. 35 U.S.C. § 171.

This statute defines the scope of design patents, requiring the design to be new, original, and ornamental. Amendments or arguments that narrow the claimed design during prosecution may limit enforcement under estoppel or disclaimer principles.

J. 35 U.S.C. § 102.

This statute sets forth the novelty requirement. Applicant arguments distinguishing prior art under § 102 may later be treated as prosecution history disclaimer if they emphasize particular features of the design.

K. 35 U.S.C. § 103.

This statute establishes the non-obviousness requirement. Amendments or statements made to overcome obviousness rejections can give rise to estoppel if they surrender certain aspects of the claimed design.

L. 35 U.S.C. § 282.

This statute provides defenses to infringement. Prosecution history estoppel and disclaimer can be raised by defendants to limit the scope of the asserted design patent.

10. Tables and Miscellaneous Notes

A. Shift from Estoppel to Disclaimer

In *Top Brand*, the Federal Circuit departed from the more commonly invoked doctrine of prosecution history estoppel by instead grounding its noninfringement holding in prosecution history disclaimer. Although estoppel traditionally has served as the primary mechanism for limiting claim scope based on amendments, elections, or arguments made during prosecution of design patents, *Top Brand* treated the applicant's statements as a clear and unmistakable disavowal, invoking disclaimer as a matter of claim construction. This refinement in doctrinal focus warrants careful attention, as it highlights a meaningful distinction in the way courts may limit the scope of design patent claims.

B. Distinction between Disclaimer and Estoppel

Prosecution history disclaimer is a rule of claim construction. It limits the literal scope of the claim based on clear and unmistakable statements made by the patentee during prosecution. This doctrine is grounded in principles of public notice and is not equitable in nature. If the applicant distinctly and clearly disavows certain subject matter to obtain allowance, courts will interpret the claim as excluding that subject matter. This protects the public's reliance on definitive statements made during prosecution. In *Egyptian Goddess v. Swisa*, 543 F.3d 665, 680 (Fed. Cir. 2008) (en banc), the Federal Circuit recognized that a trial court can construe a design patent claim by assessing and describing the effect of any representations made during patent prosecution.

Prosecution history estoppel, by contrast, is an equitable doctrine. It prevents a patentee from recapturing through the doctrine of equivalents that which was surrendered to obtain the patent. In utility patent law, the doctrine of equivalents is analyzed separately from literal infringement. However, in design patent law, both literal and equivalent infringement are determined under the unified *Egyptian Goddess* ordinary observer test: whether, in light of the

prior art, the accused design is substantially the same as the claimed design in the eye of an ordinary observer.

In sum, both disclaimer and estoppel are trying to prevent patentees from asserting claims more broadly than what was justified in prosecution. But they function differently. Disclaimer narrows the literal claim. Estoppel limits what is equivalent to the claim.

C. Different Ways Prosecution History Estoppel May Arise

Prosecution history estoppel may arise in several different ways in design patent prosecution. In addition to estoppel by argument discussed above, it may result from a narrowing amendment made during prosecution in response to a rejection, such as amending a title. Estoppel also can arise if an applicant attempts to add to a drawing figure in response to a rejection and then has to remove the drawing addition due to a new matter rejection. Finally, estoppel may result from a restriction requirement when the applicant elects one embodiment and fails to pursue the non-elected embodiments. Note that even though an election following restriction is not technically an amendment, the court held that such a choice in response to a patentability requirement effects a surrender of claim scope analogous to an amendment, and estoppel applies accordingly.

Importantly, the Federal Circuit has not applied “election type” prosecution history estoppel when a restriction requirement is issued between combination and subcombination claims, and only the subcombination claim issues as a patent and is enforced in litigation.

D. Differences in the Standards

Disclaimer requires a clear and unmistakable disavowal of claim scope. Courts are reluctant to apply disclaimer unless the prosecution record is unambiguous. Estoppel, however, applies where the surrender was made for reasons of patentability and the accused design falls within the scope of the surrender. The three-part test from *Pacific Coast Marine* asks: (1) was there a surrender; (2) was it made for reasons of patentability; and (3) does the accused design fall within the scope of that surrender?

Importantly, prosecution history disclaimer does not require that the statement be made for reasons of patentability. A statement made to distinguish the invention from the prior art, even if not strictly required, can trigger disclaimer. That’s because disclaimer is about public notice, what the patentee told the public the claim does not cover. Estoppel, being equitable, is more concerned with fair play: did the patentee narrow the claim to get the patent, and is it fair to now try to recapture that scope?

E. Differences in Responding to a Section 102 Rejection and a Section 103 Rejection

Note that *Top Brand* (where prosecution history disclaimer was found) involved a Section 102 anticipation rejection and *Design Ideas* (where prosecution history estoppel was not found) involved a Section 103 obviousness rejection. One of the important takeaways for prosecutors is the increased danger of prosecution history disclaimer when responding to anticipation

rejections under § 102. This is due to several reasons. First, an anticipation rejection typically will involve prior art that is very close in appearance to the claimed design. Second, the prior art will consist of a single reference so the comparison will be one to one. Third, the anticipation standard closely mirrors the ordinary observer test used to assess design patent infringement. These three factors create an increased risk that whatever distinctions the applicant emphasizes to overcome the prior art may later be construed as implicit limitations on the claim during litigation.

In contrast, responding to obviousness rejections under § 103 may pose a lower risk of triggering disclaimer, since the analysis typically involves combining multiple prior art references that are not as close in appearance to the claimed design and applying a different standard than the ordinary observer test. Nonetheless, applicants must still be cautious not to characterize their design in limiting terms that may later be construed as disclaimers of claim scope.

F. Potential Confusion Caused by Reference to *Pacific Coast Marine Windshields*

In *Top Brand*, the Federal Circuit cited *Pacific Coast Marine Windshields* as a basis to apply prosecution history disclaimer to design patents. The Court stated “[w]e see no reason to distinguish between disclaimer by amendment and disclaimer by argument and conclude that a patentee may surrender claim scope of a design patent by its representations to the Patent Office during prosecution.” *Id.* at *9. However, *Pacific Coast* was not a prosecution history disclaimer case. Rather, it was the Federal Circuit’s foundational design patent decision applying prosecution history estoppel. In *Pacific Coast*, the court evaluated whether the patentee had surrendered claim scope through elections in response to a restriction requirement, applying the traditional three-part estoppel framework derived from *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2002). By importing *Pacific Coast* into a disclaimer analysis without distinguishing its equitable context, the *Top Brand* opinion risks conflating the two doctrines. This blending may obscure the distinct procedural timing, evidentiary burdens, and legal consequences that separate disclaimer, a rule of claim construction grounded in public notice, from estoppel, which serves as an equitable bar to recapturing subject matter surrendered during prosecution.

G. Practical Differences in Litigation

Prosecution history disclaimer is applied during claim construction. It is a matter of law for the court to decide, typically in a *Markman* hearing. Because design patents are usually construed by referring to the figures without verbal elaboration, a finding of disclaimer may substitute for or accompany claim construction. Importantly, if a court construes the claim narrowly based on disclaimer, that limitation applies to both literal infringement and equivalents, because the reach of substantial sameness under the ordinary observer test cannot expand beyond what the claim covers.

Prosecution history estoppel, on the other hand, is generally considered during the infringement analysis and is typically a factual question resolved at summary judgment or trial. If the accused product is not identical to the claimed design but is alleged as substantially the

same, the patentee may argue infringement exists under the ordinary observer test. Estoppel may preclude such an argument if there is surrender of subject matter by the patentee either by amendment or argument and the accused design falls within the scope of the surrender.

Procedurally, the doctrines differ in how and when they must be raised. Because prosecution history disclaimer is a rule of claim construction, it must be raised during the claim construction phase (typically at or before a Markman hearing). Failure to raise it at that stage may result in waiver. In contrast, prosecution history estoppel is typically raised during the infringement analysis. It can be presented at summary judgment or at trial. However, like other defenses, if estoppel is not raised in a Rule 50(a) motion for judgment as a matter of law, it may be deemed waived for purposes of post-trial motions or appeal. Courts are generally stricter about waiver when estoppel is raised late in litigation, especially if the factual record has not been developed to address it.