

Quick Reference Guide

DO:

- Use an appendix when it serves a legitimate, identifiable purpose (see Section 1.1)
- File an appendix as a separate paper with a clear “APPENDIX” heading
- Use CAD drawings or photographs in an appendix to support interpretation of line drawing contours, shading, or proportions
- Treat appendix material as part of the original disclosure for written description purposes and continuation or divisional strategy
- Remove all specification references to the appendix if the examiner raises any objection
- If appendix embodiments are included, clearly indicate whether they are intended to be patentably indistinct variations of a single inventive concept (see MPEP § 1504.05)
- Before canceling an appendix, evaluate whether a continuation or divisional application should be filed to preserve rights in the appendix content

DON'T:

- Do not reference the appendix in the specification or claim language
- Do not use an appendix to define claim boundaries or design features
- Do not include appendix drawings showing visually distinct, independent design embodiments unless you intend to pursue them in a continuation or divisional
- Do not assume disclaimer language (“informational purposes only”) will reliably prevent examiner treatment of the appendix as claim-relevant disclosure
- Do not cancel an appendix without first considering prosecution history estoppel or continuation options

1. Introduction and Theory

Design patent practice is grounded in a fundamental principle: the claim is defined by the drawings. Unlike utility patents, where written claim language establishes the legal boundaries of the invention, a design patent protects the ornamental appearance as shown in the drawing views, with written description playing only a limited supporting role. Claim scope is evaluated from the perspective of the ordinary observer and must be ascertainable from the drawings themselves, not from explanatory text or extrinsic materials. *See* MPEP § 1504; *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc).

Appendices have a legitimate role in design patent practice and, when used correctly, carry manageable risk. The MPEP expressly recognizes appendices as procedurally acceptable, and actual examination experience confirms that they are regularly filed and allowed without incident. *See* MPEP § 1503.01; *Ex parte Spiegel*, 1919 C.D. 112, 268 O.G. 741 (Comm’r Pat. 1919). The problems that arise are not inherent to appendices as a tool—they are the product of how appendices are used.

Two categories of appendix use warrant different assessments. The first, appendices that supplement or reference the formal drawing disclosure in ways that affect claim interpretation, can create substantive examination problems and prosecution history risk. The second, appendices that serve a discrete, non-claim-defining function such as providing CAD reference material or photographs to support interpretation of line drawings, carries much lower risk and often serves a legitimate strategic purpose.

Practitioners should understand both categories clearly, approach appendix use with thoughtful consideration of the risks, and match their choice of strategy to the specific needs of the application. The analysis that follows is intended to support that judgment, not to discourage appendix use categorically.

Note: This ProGuide is subject to certain limitations, which are set forth in Appendix 3.

1.1 Legitimate Uses for Appendices

Appendices serve several recognized, low-risk purposes in design patent practice. The following uses have been employed effectively without generating the examination complications described later in this guide:

CAD Drawings as Contour and Shading Reference - Where the formal drawing set consists of line drawings, questions sometimes arise about surface contours, depth transitions, or shading interpretation. Submitting CAD renderings in an appendix provides a visual reference baseline that can support examiner or court inquiry without expanding or altering claim scope. Because CAD drawings in an appendix are not incorporated into the claim, they do not redefine

what is protected, they clarify what the line drawings depict. This is a well-grounded use with manageable risk, provided the appendix is not referenced in the specification.

Photographs of Physical Prototypes or Products - Where line drawings were derived from a physical object, photographs in an appendix can clarify ambiguities about surface transitions, proportions, or three-dimensional relationships. As with CAD drawings, photographs used in this manner do not alter claim scope but provide a reference that may assist in prosecution or, if needed, in litigation over claim construction.

Color or Texture Reference Material - Where the formal drawings are black-and-white line art, supplemental reference material in an appendix, such as color images or surface texture illustrations, may provide contextual information about the design without modifying the claimed appearance.

Supporting Written Description for Continuations - Appendix material filed with the original application preserves written description support for later amendments, continuation applications, or divisional filings directed to related designs. This is a recognized strategic purpose. Practitioners who anticipate future continuation activity may include appendix material at the outset specifically to establish this support.

Manufacturing or Technical Specifications - Technical or manufacturing specifications submitted as appendix material may explain physical implementation without defining ornamental scope. Where the specification text is entirely silent as to the appendix, this type of supplemental material carries limited examination risk.

1.2 Where Appendix Risk Is Concentrated

The examination complications documented in this guide are concentrated in a specific category of appendix use: appendices that disclose alternative design embodiments, variations, or modified forms, particularly where those embodiments differ visually from the primary drawing set or are later canceled without being pursued in a continuation or divisional application.

When appendix content crosses from “reference material” into “alternative design disclosure,” it interacts with examination principles in ways that regularly produce substantive problems. Examiners have consistently treated appendices of this kind as disclosures affecting claim scope, triggering indefiniteness findings, multiple-embodiment objections, and scope-clarity requirements. Once such an appendix is canceled in response to an examiner objection, the cancellation itself creates a prosecution record that may limit the enforceable scope of the issued patent.

The distinction between these two categories, reference material versus alternative embodiment disclosure, is the central risk-management principle in appendix practice. The rules and examples that follow address primarily the second category, where risk is highest.

1.3 The Core Tension and Public-Notice Principles

Even for legitimate reference appendices, a baseline tension remains. Design patent claims are defined by drawings, and any additional disclosed material introduces some risk that it will be perceived as affecting claim scope. Modern examiner behavior reflects this tension. Appendices are tolerated, rarely endorsed, and their inclusion even for benign purposes can invite examiner attention.

Beyond examination, once design information is disclosed in an application, whether in drawings, specification text, or an appendix, it becomes part of the public record. If that disclosed material is later canceled, abandoned, or simply never claimed through a continuation or divisional application, accused infringers may plausibly argue that the patentee has surrendered or foregone exclusive rights to that subject matter. Courts have applied analogous public-notice doctrines such as prosecution history disclaimer and estoppel to limit asserted design scope. *See Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694 (Fed. Cir. 2014); *Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co.*, 920 F.3d 819 (Fed. Cir. 2019).

The disclosure-dedication doctrine, originating in utility patent law, has not been squarely applied by the Federal Circuit to design patent appendices. *See Johnson & Johnston Assocs. Inc. v. R.E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002) (en banc). But the underlying principle that the public is entitled to rely on what an applicant discloses but does not claim, remains relevant in the design patent context, particularly for appendices depicting alternative configurations that are later abandoned.

2. Recommended Form

If an appendix is filed, the following approach may minimize examination complications:

- 2.1 File the appendix as a separate paper with a clear “APPENDIX” heading
- 2.2 Include NO reference to the appendix in the specification
- 2.3 Include NO incorporation-by-reference language

- 2.4 If the appendix is intended as reference material (e.g., CAD drawings), include only: “This appendix is submitted as part of the original disclosure for written description purposes only”
 - 2.5 If the appendix is intended to support future continuation filings, document this intent internally but do not state it in the application
 - 2.6 Assume the appendix may require cancellation or de-linking during prosecution if it draws examiner attention
3. Rules and Guidance for Appendices

3.1 An Appendix Is Procedurally Permissible and Serves Legitimate Purposes

A design patent application may include descriptive material submitted separately from the drawings, including in the form of an appendix. This procedural permissibility is recognized in the MPEP and traces back to early USPTO practice. *See* MPEP § 1503.01; *Ex parte Spiegel*, 1919 C.D. 112, 268 O.G. 741 (Comm’r Pat. 1919).

Appendices serve legitimate functions, including submission of CAD drawings or photographs to support interpretation of formal line drawings, preservation of written description support for continuation or divisional filings, and provision of supplemental reference material that does not define or alter claim scope.

The risk profile of an appendix depends significantly on its content and how it is used. Reference material that is not incorporated into the specification or claim, and that does not depict visually distinct alternative designs, carries substantially lower risk than appendices disclosing alternative embodiments or variations. Practitioners should assess the specific content and purpose of any proposed appendix and tailor their strategy accordingly.

3.2 Appendix Content Cannot Expand Claim Scope Beyond the Drawings

Appendix content that describes embodiments, modified forms, or design features not shown in the drawing views renders the claim indefinite and non-enabling if incorporated into the specification or claim. 37 C.F.R. § 1.73; MPEP § 1503.01; MPEP § 1504. The MPEP consistently emphasizes that the scope of a design patent is defined by what is shown in the drawings, and that descriptions of embodiments not illustrated are improper and may render the claim indefinite. Application 29/903,635 (indefiniteness rejection based on appendix describing unshown embodiments).

3.3 An Appendix Cannot Be Used to Define Claim Boundaries

An appendix may not be relied upon to clarify claim boundaries, surface transitions, or the extent of claimed subject matter unless those features are shown in the drawings or explicitly incorporated into the specification through a proper amendment. If claim clarity depends on appendix text or images, the examiner will require cancellation of appendix references or amendment of the drawings or specification. Application 29/903,635.

Note: This is distinct from the legitimate use of an appendix as reference material. A CAD drawing that provides visual context for understanding an already-clear line drawing feature does not define claim boundaries, it illustrates them. The concern addressed here is an appendix that is necessary to understand what is claimed.

3.4 Appendix Material May Support Later Amendments, But Only If Originally Filed

Appendix material that is part of the original filing may serve as written description support for later amendments to drawings or the specification, provided the amendment does not introduce new matter. Any later drawings must find direct visual support in the originally filed appendix images to avoid a new matter rejection. Applications 29/904,863; 29/695,608.

Appendix material does not automatically become claim-limiting and must be affirmatively added to the specification or drawings to affect claim scope. However, even where appendix material does not become claim-limiting, its inclusion and subsequent removal may create prosecution history disclaimer or estoppel that limits the scope of the design for enforcement purposes.

3.5 Appendix Figures May Trigger a De Facto Multiple-Embodiment Objection

Including appendix drawings that depict visually distinct designs can cause the examiner to treat the appendix as disclosing multiple embodiments, even where the applicant intends the appendix to be informational only, resulting in objections requiring removal or election. This risk is concentrated in appendices depicting alternative design configurations, not in reference material such as CAD renderings of the same design shown in the formal drawings. Applications 29/946,074; 29/929,866.

3.6 Appendix Content Can Create an Implicit Election Even Without a Formal Restriction

When appendix material is removed in response to an examiner objection (without a formal restriction requirement), the applicant's acquiescence may function as an implicit

election, limiting the claim to the remaining drawings. Applications 29/917,737; 29/902,119. Practitioners should evaluate this risk before canceling appendix material and consider filing a continuation or divisional directed to the removed content if it has independent commercial significance.

3.7 Appendix Use Increases Prosecution History Disclaimer Risk Even Without § 112 Rejections

Even where no § 112 rejection is issued, references to or subsequent removal of appendix material can create prosecution history disclaimer limiting later infringement arguments to the issued figures only. See *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694 (Fed. Cir. 2014); *Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co.*, 920 F.3d 819 (Fed. Cir. 2019). This risk is most acute for appendices disclosing alternative embodiments that are later canceled without being pursued in a separate filing.

3.8 Strategic Considerations

For alternative design embodiments with independent commercial significance, continuation or divisional applications supported by separate drawing disclosures generally provide stronger and cleaner protection than appendices. Practitioners should assume that appendix material not claimed in an issued design patent may later be treated as disclaimed or dedicated to the public.

For reference material such as CAD drawings, photographs, or supplemental context that supports the formal drawing set without depicting independent design alternatives, appendix use is appropriate and the risks described above are substantially reduced.

Practitioners pursuing continuation or divisional applications to protect appendix content should be aware that the standard for design patent obviousness has materially changed. In *LKQ Corp. v. GM Global Technology Operations LLC*, 102 F.4th 1280 (Fed. Cir. 2024) (en banc), the Federal Circuit abrogated the long-standing *Rosen-Durling* framework and held that design patent obviousness is governed by the same flexible *Graham v. John Deere* factors applied in utility patent practice, without requiring that a primary reference be "basically the same" as the claimed design before secondary references may be applied.

The practical consequence for appendix strategy is this: a continuation or divisional directed to an appendix design that is a visible variation of the parent's primary drawing set may face a more readily constructed obviousness rejection under *LKQ* than it would have under prior law. This does not diminish the strategic value of pursuing such filings as a patentably distinct design remains protectable, but practitioners should evaluate the obviousness exposure of

appendix-derived continuation claims under the post-*LKQ* framework before assuming that visual variation from the parent design will be sufficient to support allowance. Note that the same flexibility that makes obviousness rejections easier to construct may also provide applicants with broader grounds to distinguish prior art combinations, and practitioners should approach post-*LKQ* prosecution with both risks and opportunities in mind. Early prior art searching against proposed continuation claims is advisable.

3.9 Disclosure–Dedication Risk

Where design-related subject matter is disclosed in an appendix but not ultimately claimed, whether because the appendix is canceled, abandoned, or simply not pursued through a continuation or divisional application, there is a material risk that such subject matter will later be treated as surrendered, disclaimed, or effectively dedicated to the public. This risk is proportional to the distinctiveness of the appendix content: the more clearly the appendix depicts a standalone design alternative, the more likely that cancellation or abandonment will be treated as a strategic surrender.

No Federal Circuit decision has squarely applied the disclosure-dedication doctrine to design patent appendices. The doctrine originates in utility patent law. *See Johnson & Johnston Assocs. Inc. v. R.E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002) (en banc). Nevertheless, courts have repeatedly applied analogous public-notice doctrines to limit design patent claim scope, and accused infringers can reasonably be expected to make these arguments where appendix material is disclosed and then abandoned.

4. Application of Rules and Guidance to Objections and Rejections

This section provides representative examples of how appendix-related objections and rejections arise in practice and how they are typically cured during prosecution. Each example is drawn from actual prosecution histories.

4.1 Appendix Incorporation Creates § 112 Indefiniteness as to Claim Scope

In Application 29/904,863, the examiner rejected the claim under § 112(a) and § 112(b) because the specification referenced appendix material in a manner that made it unclear whether the claimed design included appendix embodiments or appendix images. To overcome the rejection, the applicant canceled all specification references to the appendix and affirmatively confirmed that the claim relied solely on the formal drawing disclosure. The application was subsequently allowed. Rule 3.1, Rule 3.2, Rule 3.3, Rule 3.7.

4.2 Appendix References to Unshown Embodiments Treated as Improper Multiple-Embodiment Disclosure

In Application 29/903,635, the examiner objected to appendix language describing embodiments, variations, or modified forms not depicted in the drawing views. The examiner required cancellation because design patent practice does not permit written disclosure of alternative embodiments that are not illustrated in the drawings, and because such material created ambiguity regarding whether multiple designs were being disclosed. The applicant cured the objection by canceling the appendix language and removing all references suggesting unshown embodiments. Rule 3.1, Rule 3.2, Rule 3.5.

4.3 Appendix Drawings Treated as Alternative Embodiments Requiring Cancellation

In Application 29/946,074, the appendix included additional drawings depicting variations in surface contours and proportions that were visually distinct from the main drawing figures. The examiner objected that the appendix drawings suggested alternative embodiments or multiple designs. The applicant canceled the appendix in its entirety and proceeded solely on the originally filed drawing figures. Following cancellation, the application was allowed. Rule 3.2, Rule 3.5.

4.4 Appendix Cancellation Operates as an Implicit Election Narrowing the Disclosure

In Application 29/917,737, the appendix included variant views that differed visually from the design depicted in the elected drawing set. The examiner required removal. The applicant canceled the appendix without requesting restriction and without filing a divisional application directed to the appendix content. Allowance issued thereafter, effectively limiting the record to the elected drawings. Rule 3.6, Rule 3.7.

4.5 Appendix Removed Without Formal § 112 Rejection but Still Functions as a Limiting Event

In Application 29/881,173, the appendix included alternative configurations that were arguably within the same general design concept. Even without issuing a formal § 112 rejection, the examiner informally indicated that appendix content should be removed to maintain clarity of claim scope. The applicant canceled the appendix to expedite prosecution, creating a prosecution record that clearly distinguished the issued design from the removed appendix variants. Rule 3.1, Rule 3.7.

4.6 Appendix GUI Variants Required to Be Removed as a Condition of Allowance

In Application 29/776,949, the appendix contained graphical user interface variants not shown in the primary drawing disclosure. The examiner required removal prior to allowance because the appendix material introduced additional visual embodiments that created ambiguity as to claim scope. The applicant canceled the appendix in full and did not file a continuation directed to the removed variants. Rule 3.2, Rule 3.5, Rule 3.7.

5. Practice and Enforcement Notes

5.1 Appendices Are Tolerated and Rarely Endorsed, But They Serve Real Purposes

Examiners signal that appendices are acceptable so long as they do not affect claim interpretation. Reference material such as CAD drawings, photographs, supplemental context, filed without specification cross-reference rarely draws the kind of examiner attention described in Section 4. The risk profile rises sharply when appendix content appears to depict alternative designs or explain claim scope.

5.2 Appendix Removal Without Continuation Is Substantive, Not Cosmetic

Across multiple applications, examiners allowed cases only after appendix cancellation, without any indication that appendix material remained relevant. Practitioners should treat appendix removal, particularly of content depicting design alternatives, as a substantive narrowing event, not a clerical fix. Before canceling appendix content with independent commercial value, evaluate whether a continuation or divisional should be filed.

5.3 Brief Counterargument to the Disclosure-Dedication Argument

Practitioners faced with an argument that material in the appendix has been dedicated to the public might argue as follows: The disclosure-dedication doctrine should not be applied to appendix material in design patent applications. That doctrine arises from utility patent claim-construction and equivalents jurisprudence and presupposes an attempt to recapture unclaimed subject matter through claim interpretation. Design patents operate under a fundamentally different framework, in which claim scope is defined exclusively by the drawings and evaluated under the ordinary observer test. Appendix material that is never incorporated into the drawings, never relied upon for allowance, and later removed for procedural compliance does not constitute a clear and unmistakable surrender of design scope. Absent controlling precedent extending disclosure-dedication doctrine to design patents, appendix disclosures should be treated as latent support material and not as subject matter irrevocably dedicated to the public.

Appendix 1 – Checklist

A. Pre-Filing Checklist

Before including an appendix in a design patent application, confirm the following:

- Does the appendix serve a legitimate, identifiable purpose (e.g., CAD reference, photographic clarification, written description support)?
- Does the appendix contain drawings or images that differ in overall visual impression from the main drawing set? (If yes, evaluate whether a continuation or divisional is preferable.)
- Does the appendix describe alternative embodiments, variations, or configurations not shown in the drawings? (If yes, the risk profile is elevated.)
- Is the appendix being included solely for original written description support, rather than to define or explain the claimed design?
- Have you considered whether the appendix content could later be treated as disclaimed or dedicated to the public if not pursued in a continuation or divisional?
- If continuation or divisional filings are anticipated from appendix content, has the obviousness exposure of those claims been evaluated under the post-*LKQ* framework?

B. Drafting Checklist

If an appendix is included:

- File the appendix as a separate paper, not embedded in the specification
- Avoid any reference to the appendix in the specification or claim language
- Do not use incorporation-by-reference language
- Do not suggest that appendix content defines, clarifies, or supplements the drawings in a claim-relevant way
- Assume the appendix will be treated as part of the original disclosure for all future purposes

C. Prosecution Checklist

If the examiner raises an objection or concern regarding the appendix:

- Immediately assess whether the appendix is creating indefiniteness, multiple-embodiment, or scope-clarity issues

- Remove all specification references to the appendix if required
- Consider whether cancellation of the appendix will function as an implicit election or disclaimer
- Before canceling, evaluate whether a continuation or divisional should be filed to preserve rights in the appendix content
- Treat appendix removal as a substantive narrowing event, not a clerical correction
- Evaluate potential prosecution history estoppel or disclaimer risks (e.g., Pacific Coast Marine, Advantek) before canceling any appendix material

D. Post-Allowance Checklist

After allowance following appendix removal:

- Assume appendix material may be used against the patentee in non-infringement or estoppel arguments
- Do not assume appendix material remains “neutral” or unused simply because it was canceled
- Document the strategic decision regarding appendix treatment in the prosecution record

Appendix 2 – Questions and Answers

Q1. Are appendices allowed in design patent applications?

Yes. Appendices are procedurally permissible and acknowledged in the MPEP as allowable descriptive material submitted separately from the drawings. *See* MPEP § 1503.01; *Ex parte Spiegel*, 1919 C.D. 112. Procedural permissibility does not eliminate the substantive risks discussed in this guide, which depend primarily on the content and purpose of the appendix.

Q2. What are legitimate uses for an appendix?

Common legitimate uses include: (1) CAD drawings submitted to support interpretation of line drawing contours or shading; (2) photographs of physical prototypes clarifying surface transitions or proportions; (3) color or texture reference material not shown in the formal black-and-white drawings; (4) written description support for anticipated continuation or divisional filings; and (5) technical or manufacturing specifications that do not define ornamental scope.

Q3. If an appendix is not referenced in the specification, can it still cause problems?

Yes, if the appendix depicts visually distinct designs or alternative embodiments. Reference material that mirrors the formal drawing disclosure (such as CAD renderings of the same design) carries much lower risk. Appendices that introduce independent design variants are more likely to attract examiner concern even without specification cross-reference.

Q4. Can an appendix be used to explain or clarify the drawings?

It depends on the nature of the explanation. Reference material such as CAD drawings that provide a three-dimensional basis for understanding line drawing contours, can provide useful context without defining claim boundaries. An appendix may not be used to define claim scope or clarify surface transitions that are genuinely ambiguous in the formal drawings. If claim clarity depends on the appendix, an examiner will require that the information be added to the specification or drawings directly.

Q5. Does appendix material automatically limit the claim?

No. Appendix material does not automatically become claim-limiting. However, it may create prosecution history disclaimer or estoppel, even if it never formally becomes part of the claim. This is particularly true for appendices depicting alternative design embodiments that are later canceled.

Q6. If I cancel the appendix during prosecution, is the problem cured?

The immediate examination issue may be resolved, but cancellation can function as an implicit election or disclaimer. Where the canceled appendix depicted design alternatives with commercial significance, consider whether a continuation or divisional should have been filed before cancellation.

Q7. Is appendix material still considered part of the disclosure after it is canceled?

Yes. Once filed, appendix material remains part of the original disclosure and the prosecution record. Cancellation does not erase it or eliminate its potential relevance for estoppel, dedication, or claim construction arguments.

Q8. Can appendix material be used later to support amendments?

Yes, but cautiously. Appendix material that was part of the original filing may provide written description support for later amendments, provided no new matter is introduced. Any later drawings must find direct visual support in the originally filed appendix images.

Q9. What happens if appendix embodiments are disclosed but never claimed?

If appendix embodiments are disclosed, canceled, and not pursued in a continuation or divisional application, they may be argued to be disclaimed or effectively dedicated to the public. While the disclosure-dedication doctrine is more fully developed in utility patents, analogous public-notice principles may be asserted in design patent disputes through prosecution history estoppel or disclaimer arguments.

Q10. When is an appendix most advisable?

An appendix is most useful when it serves a legitimate reference or support function—particularly where CAD drawings or photographs would assist in clarifying the formal line drawing set. Where the goal is to protect alternative design embodiments, a separate continuation or divisional filing generally provides cleaner and more defensible protection.

Q11. What is the safest default rule for practitioners?

Understand the purpose of the appendix before filing it. If it serves a legitimate reference or support function and does not depict independent design alternatives, it can be filed with modest risk. If it discloses alternative designs, evaluate whether a separate filing is preferable. If you do

file an appendix with alternative designs, do not cancel it without first considering whether a continuation or divisional is warranted.

Appendix 3 – Limitations

This ProGuide is intended to provide practical, examiner-practice-driven guidance regarding the use of appendices in U.S. design patent applications. It is not intended to be exhaustive, and the following limitations should be understood.

1. Scope Limited to U.S. Design Patent Practice

This guide addresses appendices only in the context of U.S. design patent applications governed by 35 U.S.C. § 171 and examined under USPTO practice. It does not address utility patent practice, plant patents, or foreign or international design regimes, including Hague applications, EU Community designs, or other non-U.S. systems.

2. Examiner Practice May Vary

The rules, examples, and observations in this guide are derived from actual USPTO prosecution histories and reflect recurring examiner behavior, not formal USPTO policy statements. Individual examiners or art units may apply these principles differently, and outcomes may vary based on the specific facts of a given application.

3. No Guarantee of Examination or Litigation Outcomes

This ProGuide does not guarantee allowance of any application, nor does it predict how courts will resolve infringement, validity, or estoppel issues in any particular case. Prosecution history effects, including disclaimer, estoppel, or dedication, are inherently fact-dependent and may be evaluated differently by different tribunals.

4. Limited Treatment of Post-Grant and Litigation Issues

While this guide discusses prosecution history disclaimer, estoppel, and dedication risks, it does so only at a high level and only insofar as those issues arise from appendix practice during prosecution. It is not a comprehensive treatment of design patent enforcement, claim construction, or litigation strategy.

5. No Substitute for Case-Specific Legal Judgment

This guide is not legal advice and is not a substitute for independent legal analysis. Decisions regarding whether to include, retain, cancel, or rely upon an appendix should be made in view of the specific design, prosecution posture, client objectives, and risk tolerance involved in each matter.

6. Examples Are Illustrative, Not Exhaustive

The prosecution examples cited in this guide are intended to illustrate common patterns and risks associated with appendix use. They do not represent all possible scenarios, and the absence of a particular fact pattern or outcome should not be interpreted as endorsement or safe harbor.

7. This Guide Does Not Discourage Appendix Use Categorically

This guide reflects the reality that appendices serve legitimate purposes in design patent practice and that the risk profile of an appendix depends substantially on its content and purpose. Alternative strategies such as continuation or divisional applications are preferable in specific circumstances, not universally. Practitioners should use judgment based on the specific needs of each application.

8. Subject to Change in Law and Practice

USPTO examination practices, MPEP guidance, and case law evolve over time. This guide reflects examination behavior and legal principles as of its stated update date and may require revision as new authority or practice developments emerge.

9. Professional Responsibility

Practitioners remain responsible for complying with all applicable statutes, regulations, ethical obligations, and professional standards. This guide does not address duty of disclosure, inequitable conduct, or other professional responsibility issues that may arise in connection with appendix practice.

10. Intended Use

This ProGuide is intended as a reference and risk-identification tool to assist practitioners in spotting potential issues early and making informed strategic decisions. It should be used in conjunction with, not in place of, the practitioner's own experience, judgment, and review of the relevant application record.

Appendix 4 – Selected MPEP, CFR, Statutory, and Case Law References

MPEP § 1503.01 – Specification [R-01.2024]

No description of the design in the specification beyond a brief description of the drawing is generally necessary, since as a rule the illustration in the drawing views is its own best description. *In re Freeman*, 23 App. D.C. 226 (App. D.C. 1904). While not required, such a description is not prohibited and may be incorporated, at applicant's option, into the specification or may be provided in a separate paper. *Ex parte Spiegel*, 1919 C.D. 112, 268 O.G. 741 (Comm'r Pat. 1919).

(A)(1) Description of the appearance of portions of the claimed design which are not illustrated in the drawing disclosure. Such a description, if provided, must be in the design application as originally filed, and may not be added by way of amendment after the filing of the application as it would be considered new matter.

Case Law

Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC, 739 F.3d 694 (Fed. Cir. 2014) – Applies prosecution history estoppel principles to design patents, including surrender of canceled embodiments.

Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co., 920 F.3d 819 (Fed. Cir. 2019) – Holds that prosecution history and election of embodiments can limit asserted design patent scope.

In re Rubinfeld, 270 F.2d 391 (CCPA 1959) – Addresses multiple embodiments in design applications and patentable distinctness.

Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008) (en banc) – Discusses claim scope and the ordinary observer test.

Richardson v. Stanley Works, Inc., 597 F.3d 1288 (Fed. Cir. 2010) – Discusses prosecution history in design patents.

Ethicon Endo-Surgery, Inc. v. Covidien, Inc., 796 F.3d 1312 (Fed. Cir. 2015) – Addresses claim construction.

Johnson & Johnston Assocs. Inc. v. R.E. Service Co., 285 F.3d 1046 (Fed. Cir. 2002) (en banc) – Origin of the disclosure-dedication doctrine in utility patent law; relevant background for design patent appendix risk analysis.

LKQ Corp. v. GM Global Technology Operations LLC, 102 F.4th 1280 (Fed. Cir. 2024) (en banc) - Abrogates the *Rosen-Durling* framework and holds that design patent obviousness is governed by the *Graham v. John Deere* factors.