

Design Patent ProGuide – Claims
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Quick Start Guide

DO:

Do use the required formal claim format. Always draft the claim as:
“The ornamental design for [the article] as shown,”
or, when appropriate,
“The ornamental design for [the article] as shown and described.”

Do confirm whether “and described” is required. Include “and described” only when the specification contains a proper descriptive statement, modified form, or other descriptive matter beyond the drawings.

Do ensure the claim and title identify the same article. The article named in the claim must correspond exactly to the article named in the title, using consistent terminology.

Do identify a single, specific article of manufacture. The claim must be tied to one definite article and cannot claim a design in the abstract.

Do keep the claim visually anchored to the drawings. The claim cannot expand, supplement, or cure ambiguity in the drawings. Scope is controlled by what is visually disclosed.

Do use neutral, non-functional article names. Identify the article by what it *is*, not by what it *does* or how it is used.

Do maintain singularity. Design patent applications permit only one claim, and that claim must consistently identify a single article.

Do review the claim whenever drawings or the specification are amended. Even small drawing or specification changes may require corresponding claim correction.

DON'T

Don't claim a design in the abstract. A design cannot be claimed apart from the article to which it is applied.

Don't use functional, use-based, or purpose-driven language. Avoid phrasing such as “configured for,” “for use with,” or descriptions of operation or intended function.

Don't include environmental or contextual limitations in the claim. Surroundings, placement, and interaction with other objects belong in the drawings (e.g., broken lines) or descriptive statements, not in the claim.

Don't rely on open-ended or catch-all language. Phrases like "or the like," "or similar article," or "and equivalents" render the claim indefinite.

Don't switch between singular and plural articles. Inconsistent plurality creates ambiguity and invites §112(b) objections.

Don't identify a component or sub-part unless the drawings clearly show a stand-alone part. If the drawings depict a whole article, the claim must not recite only a portion.

Don't attempt to use the claim to fix unclear drawings. Claim language cannot rescue ambiguity, inconsistency, or indefiniteness in the visual disclosure.

Don't describe abstract systems, kits, or functional assemblies. Design patent claims must be directed to a single article of manufacture or a single coordinated set shown as a unified design. Claims that attempt to cover functional systems or unrelated collections of articles are improper.

Don't assume examiner latitude is unlimited. While examiners afford flexibility in wording, misdescriptive, inaccurate, or unclear claim language will still be objected to or rejected.

1. Introduction and Theory

A design patent claim defines the scope of the patented ornamental design as it is embodied in, or applied to, a specific article of manufacture. Unlike utility patents, which may contain multiple claims of varying scope, a design patent application is limited to a single claim expressed in a standardized formal format. This singularity elevates the importance of precision and consistency in the claim language, particularly as it relates to the article identified in the title and depicted in the drawings.

The claim must be written in formal terms to "The ornamental design for [the article] as shown," or "as shown and described" when the specification includes proper descriptive statements.

Design patent protection does not extend to a design in the abstract. Rather, the claimed design must be inseparable from the article to which it is applied. Long-standing precedent and current Federal Circuit authority confirm that a design exists only as an ornamental appearance of a specific article of manufacture, not as free-standing surface ornamentation divorced from an article context. As a result, the claim must clearly and accurately identify the article embodying the design, consistent with both the title and the visual disclosure.

The claim operates in close coordination with the drawings. Full lines define the claimed ornamental features, while broken lines serve limited, well-defined purposes and do not alter the fundamental principle that the design is a unitary whole. Because the claim defines “the subject matter which the inventor regards as the invention,” examiners are instructed to afford applicants substantial latitude in claim phrasing. However, that latitude is not unlimited. Claim language that is unclear, inaccurate, internally inconsistent, or misdescriptive of the drawings may give rise to objections or rejections under 35 U.S.C. § 112(b) and the applicable regulations.

This ProGuide focuses on how to properly draft, review, and amend design patent claims to ensure formal compliance, consistency with the title and drawings, and resilience against common examiner objections while preserving the broadest defensible scope of protection.

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

2. Recommended Form

The claim must be written in formal terms to “The ornamental design for [the article] as shown,” or “as shown and described” when the specification includes proper descriptive statements.

3. Rules and Guidance for Claims

A careful analysis of design patent prosecution histories reveals that Examiners are not entirely consistent in their application of the rules regarding claims. To acknowledge these inconsistencies and to avoid errors such as representing a variable practice as a mandatory rule, this ProGuide classifies title rules and requirements into four tiers based on their legal force and consistency of examiner practice. Understanding these tiers helps practitioners identify which requirements are absolute, which allow strategic choices, and how to navigate Examiner discretion effectively

TIER	DESCRIPTION
MANDATORY	Statutory or regulatory requirements with no flexibility. Violations result in rejection or objection that MUST be cured by amendment. No examiner discretion.
ESTABLISHED PRACTICE	Official USPTO guidance that examiners are instructed to follow consistently. Deviations are rare and typically corrected on appeal or supervisor review.
VARIABLE PRACTICE	Common patterns exist, but examiner interpretation varies within acceptable bounds. Multiple approaches may be acceptable depending on the examiner.

EXAMINER DISCRETION	Outcomes genuinely vary by examiner judgment. Wide range of acceptable approaches exists. Strategic flexibility is greatest here.
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3.1 A Design Claim Is Limited to a Specific Article of Manufacture

MANDATORY A design claim must identify a particular article of manufacture and cannot claim a design in the abstract. The ornamental design is legally inseparable from the article named in the claim and title. Claim language that implies a design divorced from a specific article is improper. [Example 4.3](#)

3.2 Only One Claim Is Permitted in a Design Patent Application

MANDATORY A design patent application may include only a single claim. Multiple claims, alternative claim formats, or dependent-style variations are not permitted. All scope must be captured through the drawings, descriptive statements (when appropriate), and the single formal claim.

3.3 Multiple Embodiments not Patentably Distinct allowed in a Single Claim

VARIABLE PRACTICE A design patent claim may encompass more than one embodiment only if the embodiments are directed to a single inventive concept and are not patentably distinct from one another. Multiple embodiments that are patentably distinct constitute multiple inventions and may not be examined in a single design application. *See In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959); *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967). [Example 4.10](#)

3.4 The Title, Preamble, and Claim Must Match Exactly

MANDATORY The title, preamble (specification heading), and claim must correspond exactly. The article of manufacture must be identified consistently throughout the application for proper search, classification, and public notice purposes. Even minor differences, such as switching between singular and plural forms, changing articles (“a” vs. “an”), or using alternate wording (e.g., “earbud” vs. “earphone”), can trigger an objection. Since the claim and title work together to identify the claimed article of manufacture, applicants should treat the title, preamble, and claim as a single coordinated identification statement. If the title is amended, the preamble and claim must also be amended in the same response to conform to the corrected article name. [Example 4.7](#), [Example 4.9](#)

3.5 “As Shown” vs. “As Shown and Described” Is Determined by the Specification

MANDATORY Use “as shown” only when the specification contains no descriptive matter affecting the scope of the claimed design beyond standard figure descriptions. The phrase “as shown and described” is required whenever the specification contains descriptive matter that

forms part of the claimed design beyond the drawings alone. Common examples include statements that identify specific surface treatment, contrast, texture, or color as part of the claimed design. For example, if the specification states that a particular color or contrast feature forms part of the claimed design, the claim should use “as shown and described” to incorporate that descriptive matter. [Example 4.1](#)

3.6 The Correct Pronouns “I claim” or “We claim” Must be Used

MANDATORY The design patent claim must use the correct pronoun form (“I claim” or “We claim”) based on the number of inventors. If there is a single inventor, the claim must begin with “I claim.” If there are multiple inventors, the claim must begin with “We claim.” Use of an incorrect pronoun is improper claim form and will be objected to by the USPTO and must be corrected by amendment. [Example 4.2](#)

3.7 Examiner Discretion Is Broad but Not Unlimited

VARIABLE PRACTICE Examiners are instructed to allow substantial latitude in claim wording, recognizing that design claims are inherently concise and standardized. However, amendment may be required when claim language is clearly misdescriptive, inaccurate, or unclear such that it would fail to particularly point out the claimed design under 35 U.S.C. § 112(b). [Example 4.3](#)

3.8 Ambiguous or Open-Ended Claim Language Is Improper

MANDATORY Language such as “or the like,” “or similar article,” or other open-ended formulations is improper in design claims because it obscures the specific article of manufacture and introduces indefiniteness. [Example 4.8](#)

3.9 The Claim Must Use “For,” Not “Of”

MANDATORY The claim must use the phrase “The ornamental design for [article]” as prescribed by regulation. Use of “of” instead of “for” is a formal defect under 37 CFR § 1.153, even if the meaning is otherwise clear. [Example 4.11](#)

3.10 Use of the Indefinite Article “a” is Preferred

VARIABLE PRACTICE As a general matter, the indefinite article “a” is preferred in design patent claim drafting. For example, the preferred form is “The ornamental design for a [article], as shown and described.” Although use of the definite article “the” is not always treated as improper, it may be objected to in some cases because it can suggest that the claim is directed to a specific preexisting object rather than a general article of manufacture.

3.11 The Claim Must Not Include Functional or Use-Based Characterizations

MANDATORY The claim must identify the article of manufacture by name only and must not describe what the article does, how it is used, or what it is configured to do. Functional or use-based language renders the claim misdescriptive or indefinite. [Example 4.4](#)

3.12 The Claim Must Not Recite Environmental or Contextual Limitations

MANDATORY The claim may not describe environmental placement, surrounding structure, or interaction with other articles. Environmental context must be conveyed, if at all, through broken lines or descriptive statements, and not in the claim itself. [Example 4.5](#)

3.13 Component or Sub-Part Claims Require Clear Stand-Alone Disclosure

ESTABLISHED PRACTICE The claim may identify a component or sub-part of an article only when the drawings clearly depict the claimed design as a stand-alone article of manufacture. Ambiguity between a whole article and a part renders the claim indefinite. [Example 4.6](#)

3.14 Claim Language Cannot Cure Drawing Ambiguity or Inconsistency

MANDATORY Claim language cannot be used to resolve ambiguity, inconsistency, or indefiniteness arising from the drawings. Drawing defects must be corrected in the drawings themselves before conforming the claim.

3.15 The Claim Must Be Conformed After Any Title Amendment

MANDATORY When the title of the application is amended, the claim must be amended to match the revised title exactly. Failure to conform the claim constitutes an independent defect under 37 CFR § 1.153. [Example 4.7](#)

3.16 The Claim Must Be Supported Solely by the U.S. Disclosure

MANDATORY Claim language may not rely on incorporated-by-reference foreign priority documents to define or clarify the claimed design. Only the U.S. drawings and specification determine claim scope.

3.17 Claim Must Not Implicitly Expand the Article Beyond the Drawings

VARIABLE PRACTICE Even when using formally correct claim language, a claim is improper if the named article implicitly suggests a broader or different article than what is actually depicted in the drawings. An examiner may object where the claim terminology reasonably encompasses structures, configurations, or contexts not visually supported.

3.18 Claim Language Cannot Rely on Examiner Assumptions About Intended Use

VARIABLE PRACTICE A design claim may not rely on examiner or reader assumptions regarding intended use, orientation, or installation to reconcile ambiguities between

the claim and drawings. If the article name requires assumptions about function or use to make sense of the drawings, the claim is improper. [Example 4.3](#)

3.19 Claim Terminology Must Be Narrowed When Drawings Omit Required Structural Context

VARIABLE PRACTICE Where drawings intentionally omit surrounding structure (e.g., via broken lines or isolation), the claim terminology must be correspondingly narrowed to avoid implying that omitted structure is part of the claimed article.

4. Application of the Rules in Rejections and Objections

Many rejections to design patent claims are common and typically result from language choice that fails to satisfy the formal requirements of 37 CFR § 1.153 or fails to maintain consistency with the title and drawings. Common rejections and recommended forms to overcome them are set forth below.

4.1 Using the incorrect formal phrase regarding the specification content. For example, using "as shown" when the specification includes descriptive statements, or "as shown and described" when no descriptive matter is present. [Rule 3.5](#)

In Application 29/857,618, the original claim was for “[t]he ornamental design for a detail bucket assembly, as shown.” The Application included figure descriptions and a broken line statement. The Examiner objected to the claim statement because it did not include the phrase "and described" and stated “[f]or proper form (37 CFR 1.153), the claim must be amended to read: We claim: The ornamental design for a detail bucket assembly as shown and described.”

4.2 Using incorrect inventor pronouns. Use "we claim" for multiple inventors or "I claim" for a single inventor. [Rule 3.6](#)

In Application 29/883,946 the original claim stated “We claim” when there just a single inventor. The Examiner objected and stated the claim must be amended to read “I claim.”

In Application 29/868,084 the original claim stated “I claim” when there were multiple inventors. The Examiner objected and stated the claim must be amended to read “We claim.”

Note that if inventorship is corrected during prosecution (for example, through a petition under 37 C.F.R. § 1.48), the claim pronoun may need to be amended to reflect the correct number of inventors. A claim that states “We claim” may be improper if inventorship is corrected to a single inventor, and a claim that states “I claim” may be improper if inventorship is corrected to multiple inventors. Whenever inventorship is changed, practitioners should confirm that the claim pronoun remains consistent with the corrected inventorship record.

4.3 Identifying an improper or overly broad article of manufacture. For example, using overly generic or abstract names that create ambiguity as to the specific article depicted in the drawings. [Rule 3.1](#), [Rule 3.7](#), [Rule 3.18](#)

In Application 29/810,746, the Examiner rejected the claim under 35 U.S.C. § 112(b) as indefinite because the claim and title failed to clearly identify the specific article of manufacture in which the design was embodied. The Examiner explained that the title wording “Design for Display on a Surface of a Footwear Sole, Insole, Sole Insert, Sock Liner or Sole of a Sock” (and similar variants used throughout the application) created ambiguity as to whether the applicant was claiming:

- (1) a flat design displayed on a surface, or
- (2) a physical three-dimensional article, such as a footwear sole, insole, or sock.

The Examiner further stated that the ambiguity could not be rectified by the specification or drawings because the drawings did not clearly convey dimensionality or contour, and therefore did not clarify whether the claimed subject matter was a two-dimensional image or a three-dimensional physical object. The Examiner concluded that the subject matter was not understood as presented and that the claim was indefinite due to multiple possible interpretations requiring examiner speculation.

To overcome the rejection, the applicant amended the claim to remove the improper “Design for Display on” language and to clearly identify the claimed article as a specific physical article of manufacture. The amended claim recited:

“The ornamental design for a surface of a footwear sole, insole, sole insert, sock liner or sole of a sock as shown and described.”

The applicant further explained that deletion of the words “Display on” clarified that the claimed design was directed to the surface of the identified article of manufacture, and requested withdrawal of the §112(b) rejection.

4.4 Including functional or use-based language. For example, describing what the article does, how it is used, or what it is configured to do. [Rule 3.11](#)

In Application 29/934,280, the Examiner rejected the claim under 35 U.S.C. § 112(b) as indefinite because the title “Anxiety Relief Toy” was directed to the functional aspect or intended purpose of the article rather than identifying the article itself. The Examiner stated it was uncertain whether the claimed design was directed to a game controller, a toy device, or a rubber simulation of a controller intended to relieve anxiety. The Examiner further stated that the title must identify the article in which the design is embodied by the name generally known and used by the public.

To overcome the rejection, the applicant amended the title throughout the application to “Toy,” thereby removing the functional and intended-use terminology. The Examiner later confirmed that, for correct search and classification purposes, the claimed design was a simulation toy rather than an actual game controller.

4.5 Improperly introducing environmental or contextual limitations. For example, reciting environmental placement, surrounding structure, or interaction with other objects in the claim. [Rule 3.12](#)

In Application 29/674,643, the Examiner objected to the title as being misdescriptive and inaccurate under MPEP § 1503.01, because the title, “Mobile Mapping Device Mounted on Vehicle,” improperly suggested that the claimed design was directed to an assembly including both a mobile mapping device and a vehicle. The Examiner explained that the drawings did not include a vehicle in either solid or broken lines, and therefore the title improperly introduced environmental or contextual structure that was not shown as part of the claimed design.

The applicant amended the title to “Mobile Mapping Device for Vehicle,” which removed the environmental placement language and identified only the claimed article itself.

It is worth noting that the amended title in this example "Mobile Mapping Device for Vehicle" retained a reference to the vehicle as context. Examiners accepted this framing because "for Vehicle" was read as describing the intended application of the article rather than incorporating the vehicle as part of the claimed design. However, this outcome reflects variable examiner practice, and practitioners should not assume that "for [environmental context]" language is universally acceptable. In cases where such phrasing could be read as suggesting that the claimed design is incomplete without the referenced object, an examiner may still object. The safest approach is to identify the article by what it is, without reference to the environment in which it operates, and to relegate contextual structure to broken lines in the drawings or descriptive statements in the specification.

4.6 Reciting a component or sub-part without clear stand-alone disclosure. For example, identifying a portion of an article when the drawings do not clearly depict a stand-alone part. [Rule 3.13](#)

In Application 29/892,624, the original claim statement was “I claim the ornamental design of a child co-walk leash apparatus or portion thereof, as shown and described.” The Examiner objected to the claim statement for multiple reasons, including that the claim improperly attempted to cover an unspecified “portion” of the article. The Examiner explained that, under design patent practice, the claim must be directed to the ornamental design for the article (specifying the name) as shown or as shown and described, and that the claim must be amended to remove “or portion thereof” and conform to proper form.

Separately, the Examiner also objected to the title “Child Co-Walk Leash” because “Child Co-Walk” was treated as a trade name/marketing term and not the name generally known and used by the public. The Examiner suggested generic alternatives, including “Animal Leash” or “Leash.” The applicant amended the title to “Animal Leash” throughout the application.

After the title was amended, the claim was required to be conformed to the corrected article name and proper claim form, resulting in a claim directed to the ornamental design for an “Animal Leash”, as shown and described, with the improper “or portion thereof” language removed.

4.7 Claim language that is inconsistent with the title. For example, the article named in the claim does not match the article named in the title. [Rule 3.4](#), [Rule 3.15](#)

In Application 29/886,306, the applicant's title and specification consistently identified the article as a "Silicone Cake Pan." However, the claim recited "Silicone Cake Pans," which improperly suggested multiple types of silicone cake pans and was inconsistent with the singular title. The Examiner objected to the claim because a design application may contain only one claim, and the claim must correspond with the title. The Examiner required amendment of the claim language to conform to the title, recommending that the claim be amended to recite the singular form "Silicone Cake Pan" for consistency with the title and in accordance with 37 C.F.R. § 1.153 and MPEP § 1503.01. The applicant subsequently amended the claim statement to replace "Silicone Cake Pans" with "Silicone Cake Pan," thereby resolving the inconsistency.

4.8 Using open-ended or indefinite language. For example, using phrases such as "or the like" or "or similar article". [Rule 3.8](#)

In Application 29/781,797, the Applicant's original title and claim language included open-ended and indefinite wording by reciting "Outsole with Wear Off Indication for Footwear, Boot, Shoe, or the Like." In the Office Action, the Examiner objected to the title and claim on the ground that the phrase "or the Like" suggested an indefinite scope and failed to clearly designate a single identifiable article of manufacture. The Examiner explained that a design patent claim must be directed to a particular article, and that the inclusion of "or the Like" improperly introduced ambiguity as to what article was being claimed.

To overcome the objection and clarify the scope of the claimed article, the Applicant amended the title, specification, and claim to remove the indefinite language "or the Like" and to identify only the article itself. Specifically, the Applicant amended the article designation throughout the application to "Outsole," eliminating the open-ended environmental language.

4.9 Switching between singular and plural articles. For example, inconsistent use of singular and plural forms within the application. [Rule 3.4](#)

In Application No. 29/752,781, the applicant originally used inconsistent singular and plural terminology to describe the article of manufacture throughout the application. For example, the claim recited "We claim the ornamental design for an Insoles as shown and described," and the specification similarly stated that the inventors "have invented a new design for an Insoles." However, the drawings disclosed only a single insole, not a pair or set of insoles.

The Examiner objected that the application improperly alternated between plural and singular identification of the article, creating inconsistency and ambiguity as to what was being claimed. The Examiner specifically required the title and claim language to be amended to the singular form "Insole" for clarity and consistency with the drawing disclosure. The Examiner further required corresponding amendments in the preamble and specification, explaining that the plural term "Insoles" was inconsistent with the remainder of the application and should be corrected throughout to the singular "Insole."

4.10 Multiple Embodiments Treated as a Single Inventive Concept (Patentably Indistinct Variations) [Rule 3.3](#)

In Application 29/931,148, the Examiner determined that the application included multiple embodiments, but that a restriction requirement was not necessary because the embodiments were patentably indistinct. The Examiner identified Embodiment 1 as Figure 1 (a singular flat side of a mattress cover with an organic radial flower pattern and a dark background) and Embodiment 2 as Figure 2 (a singular flat side of a mattress cover with a two-tone organic radial flower pattern and a dark background). The Examiner explained that multiple embodiments may be included in a single design application only if they reflect a single inventive concept and are not patentably distinct, citing *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959) and *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The Examiner concluded that the two embodiments presented overall appearances that were basically the same, with only minor tonal and background pattern differences, and therefore constituted obvious or de minimis variations.

The Examiner further stated that because the embodiments were deemed part of a single inventive concept, any rejection of one embodiment over the prior art would apply equally to the other embodiment, citing *Ex parte Appeal* No. 315-40, 152 USPQ 71 (Bd. App. 1965). The Examiner also warned that no argument asserting patentability based on the differences between the embodiments would be considered once the embodiments had been determined to lack patentable distinction, and that failure to traverse the Examiner's determination would be treated as an admission that the embodiments were not patentably distinct. Accordingly, the Examiner retained both embodiments for examination in the same application.

4.11 Improper to use Design Of instead of Design For

In Application No. 29/873,545, the Examiner objected that the claim was not in proper form because it used the phrase "design of" instead of the required phrase "design for." The Examiner explained that "of" is improper in design patent claim language, and that the claim must be amended to comply with proper USPTO claim format under MPEP § 1503.01. To overcome the objection, the Examiner required the applicant to amend the claim so that it read in proper form as "the ornamental design for a smoke detector, as shown and described," thereby replacing the improper "of" wording with the correct "for" wording. [Rule 3.9](#)

5. Practice and Enforcement Notes

5.1 Claim language in a design patent rarely drives infringement outcomes in the same manner as utility patent claim construction. However, claim language remains legally significant because it identifies the article of manufacture to which the design is applied. In *Curver Luxembourg, SARL v. Home Expressions, Inc.*, 938 F.3d 1334 (Fed. Cir. 2019), the Federal Circuit confirmed that the article named in the claim and title can limit the scope of the design patent, meaning that a design claimed for one article may not be enforceable against an accused product that is a different type of article, even if the ornamental appearance is otherwise similar. This has a direct practical consequence. If the claim identifies the article too narrowly, an

infringer may avoid liability simply by applying the same design to a different product category. Accordingly, practitioners should treat claim drafting as a scope-preservation exercise rather than a mere formality, selecting the broadest defensible article name that is clearly supported by the drawings and consistent with the title.

5.2 When the claim is amended during prosecution, practitioners should assume that any narrowing change to the named article may later be characterized as an intentional surrender of broader article scope. Although the drawings remain the primary determinant of design scope, claim amendments may provide litigation opponents with an argument that the applicant conceded a narrower understanding of what article the design is “for.” For this reason, claim amendments should be made cautiously, and whenever possible should be framed as clarifying formal compliance rather than altering the substantive nature of the claimed article.

5.3 Practitioners should also avoid using claim language as a substitute for correcting drawing problems. Where the drawings contain inconsistent line work, unclear boundaries, or uncertain dimensionality, amending the claim will not cure the defect and may instead create an additional record of inconsistency that can later be used against the patentee. If the drawings are unclear, the safest prosecution strategy is to correct the drawings first and only then conform the claim to the corrected disclosure.

5.4 Practitioners should recognize that design patent enforcement often depends on the ability to argue that the accused product is the same type of article identified in the claim. Overly specific article naming may unnecessarily narrow enforcement flexibility, while overly broad naming may invite §112(b) indefiniteness objections or §171 challenges that the design is being claimed in the abstract. The best practice is to select the broadest defensible article name that is clearly supported by the drawings and that corresponds precisely to the title, avoiding functional, environmental, or purpose-driven terminology.

5.5 Hague Practice Note

When a Hague international design application designates the United States, the U.S. claim format requirements apply. Accordingly, the U.S. designation must include a proper design claim in the form required by 37 C.F.R. § 1.153, and the claim must correspond with the title and drawings. Practitioners should not assume that international filing format alone satisfies U.S. claim requirements.

Appendix 1
(Claim Evaluation Checklist)

1. Single-Claim Requirement
 - Only one claim is included in the application
 - No alternative, dependent, or multiple claim formats are used
2. Formal Claim Language
 - Claim uses the required formal phrasing (“The ornamental design for...”)
 - Claim ends with “as shown” or “as shown and described,” as appropriate
3. “As Shown” vs. “As Shown and Described”
 - Specification reviewed for descriptive statements or modified forms
 - “And described” included only when required
4. Article of Manufacture
 - Claim identifies a specific article of manufacture
 - Claim does not attempt to cover a design in the abstract
5. Title Consistency
 - Article named in the claim matches the title exactly
 - Terminology is consistent across the title, claim, and specification
6. Clarity and Definiteness
 - Claim language is clear and not misdescriptive
 - No ambiguous or open-ended phrases (e.g., “or the like,” “or similar”)
7. Relationship to Drawings
 - Claim scope is fully supported by the drawings
 - Claim does not attempt to expand beyond what is visually disclosed
8. Broken Line Principles
 - Claim does not reference broken lines or characterize portions as immaterial or unimportant
 - Solid lines in the drawings define the claimed ornamental features

Where broken lines are used to illustrate claimed design features (e.g., stitching lines, fold lines), this use is consistent with applicable USPTO guidance and does not improperly disclaim portions of the design

9. Regulatory Compliance

Claim complies with 37 CFR 1.153

Claim terminology aligns with MPEP § 1503.01 guidance

Appendix 2
(Claim Questions and Answers)

Q1. How many claims are permitted in a design patent application?

Answer: Only one claim is permitted in a design patent application. Multiple claims, alternative claims, or dependent-style claims are not allowed. All scope must be captured through the drawings and the single formal claim.

Q2. What is the required form of a design patent claim?

Answer: The claim must be in formal terms to: “The ornamental design for [the article] as shown,” or, when appropriate, “The ornamental design for [the article] as shown and described.” This format is prescribed by regulation and differs from utility patent claim requirements.

Q3. When must the phrase “and described” be included in the claim?

Answer: “And described” must be included when the specification contains a proper descriptive statement of the design, modified forms of the design, or other descriptive matter beyond what is shown in the drawings. If no such descriptive matter is present, the claim should recite “as shown” only.

Q4. Does the claim define the scope of a design patent the same way it does in a utility patent?

Answer: No. While the claim formally defines the invention, the drawings primarily control the scope of a design patent. The claim cannot broaden or supplement what is visually disclosed in the drawings.

Q5. Can a design patent claim cover a design in the abstract?

Answer: No. A design patent claim must be limited to an ornamental design applied to a specific article of manufacture. Designs cannot be claimed independently of an article.

Q6. Must the article named in the claim match the title of the application?

Answer: Yes. The article identified in the claim must correspond to the article identified in the title. Any inconsistency between the title and claim may result in an objection requiring correction.

Q7. How much flexibility does an applicant have in the title in claim language?

Answer: Applicants are afforded substantial latitude in the title in claim language. However, examiners may require amendment if the claim language is clearly misdescriptive, inaccurate, or unclear, such that it would fail to particularly point out the claimed design.

Q8. Is it acceptable to use open-ended language such as “or the like” or “or similar article” in a claim?

Answer: No. Open-ended or ambiguous language is improper because it obscures the specific article of manufacture and may render the claim indefinite.

Q9. Can broken lines be used in the claim to identify unimportant portions of the design?

Answer: No. Broken lines are not used in the claim itself and cannot be used to characterize portions of the design as immaterial or unimportant. A design is a unitary whole, and all claimed portions contribute to the overall appearance.

Q10. If the drawings are clear, can claim defects be overlooked?

Answer: No. Even when drawings are clear, the claim must still comply with formal requirements, correspond to the title, and accurately identify the article of manufacture. Claim defects are not cured solely by compliant drawings.

Appendix 3 (Limitations of this ProGuide - Claims)

This ProGuide is intended to provide practical guidance on drafting, reviewing, and amending design patent claim language in compliance with USPTO formal requirements and examiner practice. However, this ProGuide is subject to the following limitations.

A. No Substantive Infringement or Validity Analysis

This ProGuide does not analyze claim scope for purposes of infringement, validity, or enforceability. While proper claim drafting is essential to preserving defensible scope, ultimate questions of infringement and validity depend on application of the ordinary observer test, comparison to accused designs, and consideration of prior art, none of which are addressed here.

B. No Evaluation of Drawing Sufficiency

This ProGuide does not determine whether the drawings adequately disclose the claimed design. The claim must be supported by compliant drawings, but assessment of drawing sufficiency—including line quality, shading, view completeness, consistency, and compliance with drawing rules—is outside the scope of this guide.

C. No Determination of Proper Article Identification Beyond Formal Consistency

This ProGuide addresses formal consistency between the claim and title but does not determine whether a particular article designation is optimal, strategically desirable, or legally preferable in view of potential prior art, prosecution history estoppel, or enforcement considerations.

D. No Substitution for Examiner Judgment or Office Policy Variations

Although the ProGuide reflects common examiner objections and USPTO practice, individual examiners may apply claim formalities differently or raise objections not captured here. This ProGuide cannot predict or control examiner discretion in marginal or fact-specific situations.

E. No Guidance on Strategic Claim Narrowing or Broadening

This ProGuide does not provide strategic advice on whether to narrow or broaden claim language in response to prior art, restriction practice, or litigation considerations. It focuses solely on formal correctness and consistency, not strategic claim scope decisions.

F. No Coverage of International or Foreign Claim Practice

This ProGuide is limited to U.S. design patent claim practice. It does not address claim requirements, terminology, or conventions applicable to foreign design systems or international

design applications beyond their conformity to U.S. requirements when designating the United States.

G. No Automated Detection of Claim Defects

This ProGuide does not automatically detect claim defects. It is intended as a reference and checklist for practitioner review. Proper application requires human judgment and careful comparison of the claim against the title, drawings, and specification.

H. No Replacement for Governing Statutes, Regulations, or the MPEP

This ProGuide is not a substitute for the governing statutes, regulations, or the Manual of Patent Examining Procedure. In the event of any inconsistency, controlling law, regulations, and official USPTO guidance govern.

Appendix 4
(Selected MPEP, CFR, and Statutory References)

Design is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation. It must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method. See *In re SurgiSil, L.L.P.*, 14 F.4th 1380, 1382, 2021 USPQ2d1008 (Fed. Cir. 2021) (“A design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract.”); *Curver Luxembourg, SARL v. Home Expressions, Inc.*, 938 F.3d 1334, 1340, 2019 USPQ2d 341902(Fed. Cir. 2019) (noting “that long-standing precedent, unchallenged regulation, and agency practice all consistently support the view that design patents are granted only for a design applied to an article of manufacture, and not a design per se”).

Design patent applications include only a single claim, while utility patent applications can have multiple claims.

A claim in a specific form is a necessary element of a design patent application. See MPEP § 1503.01, subsection III.

The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

Since 37 CFR 1.153 requires that the title must designate the particular article, and since the claim must be in formal terms to the “ornamental design for the article (specifying name) as shown, or as shown and described,” the title and claim must correspond. When the article named in the title does not correspond to the article named in the claim, the examiner should object to the inconsistency under 37 CFR 1.153 and require correction.

However, it is emphasized that, under 35 U.S.C.112(b) , the claim defines “the subject matter which the inventor or joint inventor regards as the invention” (emphasis added); (or for applications filed prior to September 16, 2012, under the second paragraph of pre-AIA 35 U.S.C. 112 the claim defines "the subject matter which the applicant regards as his invention"), that is, the ornamental design to be embodied in or applied to an article. Thus, the examiner should afford the applicant substantial latitude in the language of the title/claim. The examiner should require amendment of the title/claim if the language is clearly misdescriptive, inaccurate, or unclear (i.e., the language would result in a rejection of the claim under 35 U.S.C. 112(b),(or for applications filed prior to September 16,2012, pre-AIA 35 U.S.C. 112, second paragraph);see MPEP § 1504.04, subsection II). The use of language such as “or the like” or “or similar article”

III. DESIGN CLAIM

The requirements for utility claims specified in 37 CFR 1.75 do not apply to design claims. Instead, the form and content of a claim in a design patent application filed under 35 U.S.C. chapter 16 is set forth in 37 CFR 1.153:
37 CFR 1.153 ... claim...

(a) ... The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

A design patent application may only include a single claim. The single claim should normally be in formal terms to “The ornamental design for (the article which embodies the design or to which it is applied) as shown.” The description of the article in the claim should be consistent in terminology with the title of the invention. See MPEP § 1503.01, subsection I.

When the specification includes a proper descriptive statement of the design (see MPEP § 1503.01, subsection II), or a proper showing of modified forms of the design or other descriptive matter has been included in the specification, the words “and described” must be added to the claim following the term “shown”; i.e., the claim must read “The ornamental design for (the article which embodies the design or to which it is applied) as shown and described.”

Full lines in the drawing show the claimed design. Broken lines are used for numerous purposes. Under some circumstances, broken lines are used to illustrate the claimed design (i.e., stitching and fold lines). Broken lines are not permitted for the purpose of identifying portions of the claimed design which are immaterial or unimportant. See *In re Blum*, 374 F.2d 904, 907, 153 USPQ 177, 180 (CCPA 1967) (there are “no portions of a design which are ‘immaterial’ or ‘not important.’ A design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design.”). See also MPEP § 1503.02, subsection III.

The form and content of a claim in an international design application designating the United States is set forth in 37 CFR 1.1025, which mirrors the claim requirements set forth in 37 CFR 1.153. See also MPEP Chapter 2900 for international design applications.

¶ 15.62 Amend Claim “As Shown”

For proper form (37 CFR 1.153 or 37 CFR 1.1025), the claim [1] amended to read: “[2] claim: The ornamental design for [3]as shown.”