

Design Patent ProGuide – Prosecution History Estoppel and Disclaimer  
Updated February 10, 2026

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Quick Reference Guide

DO:

Frame arguments around overall visual impression

Use features as illustrative examples only

Employ descriptive, holistic language

Document procedural reasons for amendments

DON'T:

Don't use phrases like "for this alone" or "essential element"

Don't rely heavily on annotated figures highlighting single features

Don't use geometric measurements to define patentability

Don't make repeated statements emphasizing one feature

Don't delete drawing features in response to a new matter rejection without first arguing that the features were inherently disclosed.

Don't distinguish prior art by expressly disclaiming equivalents (e.g., "unlike the reference, the claimed design lacks X"), as such statements may bar reliance on the doctrine of equivalents through prosecution history estoppel.

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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.

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

## 2. Recommended Form and Drafting Notes

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 as emphasized by *Egyptian Goddess, Inc. v. Swisa, Inc.* 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:

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

2.2 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.

2.3 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.

2.4 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.

2.5 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.

2.6 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 differences in arguments can significantly impact the enforceability and litigation value of a design patent.

2.7 Consider not using mathematical or geometric terms (e.g., "radius," "degree of overlap," "angle of slope") to distinguish a design from prior art. Such precision can be used by courts to "clearly and unmistakably" disavow any design that deviates from those specific measurements.

Original Statement: "The claimed design is patentable because it maintains a constant 0.5-inch radius at the corners, whereas the prior art radius changes constantly."

Suggested Statement: "The claimed design provides a soft, uniform corner appearance that contributes to a stable, rectangular visual theme, which contrasts with the inconsistent, tapering appearance of the prior art."

Note: In some cases, the claimed design may inherently involve geometric precision, such as architectural elements, measuring tools, or technical components. Where geometric description is unavoidable, practitioners must frame such features as contributing to the overall aesthetic effect of the design rather than as precise dimensional limitations.

2.8 When arguing that prior art "teaches away," consider focusing on the *visual direction* of the prior art rather than a tally of different features. Framing a "teaching away" argument around a single feature (like the size of a circle) can potentially trigger estoppel for that specific feature.

Original Statement: "The prior art teaches away because its circles are significantly larger and overlap more than the circles in the claimed design."

Suggested Statement: "The prior art teaches toward a clustered and dense visual arrangement, whereas the claimed design is characterized by an open, airy, and minimalist aesthetic."

2.9 Consider not using overly descriptive or functional titles in the specification, as these can be used to limit the scope of the design to a specific functional subspecies.

2.10 When converting solid to broken lines, consider stating explicitly that it is for clarity and not to surrender scope to mitigate prosecution history estoppel risks.

Practitioners should be aware that courts assess the substance of a line-type change rather than its stated rationale. If the conversion is made to overcome a rejection, the response should explain how the change clarifies what was already disclosed rather than surrendering claim scope. In some cases, maintaining the feature in solid lines and arguing its ornamental contribution may better preserve enforceable scope than converting it to broken lines. Note that courts have not uniformly treated solid-to-broken line conversions as surrenders and the outcome is highly fact-dependent.

#### 2.11 Interview Best Practices

Statements made during examiner interviews may later be treated as part of the prosecution history if memorialized in the record. Practitioners should consider always filing their own interview summary, framing discussions in terms of overall visual impression rather than feature-specific distinctions. If an examiner's interview summary includes narrowing language, a supplemental submission may be advisable to reframe the discussion in holistic terms.

Recommended interview summary format:

During the interview held on [date], Applicant and Examiner discussed the visual characteristics that contribute to the overall ornamental impression of the claimed design as compared to [reference]. Applicant explained that the claimed design creates a distinct visual impression through the cumulative effect of its proportions, arrangements, and ornamental features, including but not limited to [list features discussed].

The phrase "including but not limited to" helps signal that listed features are examples, not exclusive limitations.

Avoid in interviews: Do not use phrases like "the key difference is...", "what makes this patentable is...", or "the critical feature here is..." These statements are likely to appear in the examiner's summary and create disclaimer risk.

#### 2.12 Characterize *Quayle* and Formal Drawing Amendments as Non-Substantive

When responding to *Quayle* actions or formal drawing objections, applicants should expressly state that amendments are made solely for clarity, consistency, or compliance with drawing conventions, and not for reasons of patentability.

Drafting Note: Where appropriate, also clarify that no feature is being characterized as critical and that no subject matter is being surrendered beyond what is necessary to resolve the formal issue.

### 2.13 Optional Record-Hygiene Statement Regarding Silence

In responses addressing limited or formal issues, applicants may include a brief statement clarifying that silence as to other matters should not be interpreted as agreement with examiner characterizations.

### 2.14 Avoid Pure Boilerplate “Overall Impression” Statements

While it is important to frame prosecution arguments in terms of overall visual impression, generic boilerplate statements are not a reliable safe harbor. Courts evaluate what the applicant actually argued to secure allowance, not merely whether the applicant included the phrase “overall visual impression.” Practitioners should ensure that “overall impression” language is supported by substantive explanation showing how multiple ornamental characteristics collectively distinguish the design, rather than presenting one feature as the sole basis for patentability.

### 2.15 Consider Record-Clarifying Statements in Complex Prosecutions

In some prosecutions, feature-specific discussion may be unavoidable, particularly where the examiner requires annotated figures or demands direct responses to feature-level objections. In such cases, applicants may reduce disclaimer risk by including a clarifying statement that expressly anchors the discussion to overall visual impression.

Suggested language:

“While Applicant has identified specific ornamental characteristics for purposes of explaining distinctions over the cited prior art, Applicant does not intend to limit the claim to any particular feature in isolation. Rather, the claim is directed to the overall visual impression of the ornamental design shown in the drawings, and the discussed characteristics are provided as illustrative examples of how the overall impression differs from the cited reference.”

Note: This type of statement is not a guarantee against disclaimer and should not be used as pure boilerplate. However, when feature-specific discussion is genuinely necessary, this approach can help resist later arguments that the applicant treated one feature as essential.

## 3. Rules for Prosecution History Estoppel and Disclaimer

The rules 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.

### 3.1 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. This risk is increased where the applicant uses absolute language such as “essential,” “critical,” “required,” or “for this alone,” or where the applicant repeatedly distinguishes multiple references using the same identified feature. Disclaimer risk is also heightened where the applicant submits annotated drawings or marked-up figures that emphasize a specific design feature as the basis for patentability. 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.

### 3.2 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. Prosecution history estoppel also can arise from elections in restriction requirements and PTAB statements.

#### 3.2(a) Estoppel Arising from Restriction Elections

Prosecution history estoppel may arise when an applicant elects one embodiment or species in response to a restriction requirement and does not pursue the non-elected embodiments. Although such elections are not amendments in form, courts have treated them as surrender of claim scope for purposes of estoppel where the election was made for reasons of patentability.

#### 3.2(b) Estoppel Arising from PTAB Proceedings

Estoppel may also arise from statements made during post-grant PTAB proceedings, including IPR preliminary responses, Patent Owner Responses, reply briefs, and oral hearing transcripts. Because these statements are made in an adversarial context and are often repeated across multiple filings, they may be treated as part of the prosecution history and used to support narrowing claim construction or estoppel theories in later district court litigation.

### 3.3 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.

### 3.4 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.

### 3.5 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.

### 3.6 Doctrine of Dedication to the Public

Distinct from prosecution history estoppel and disclaimer, the doctrine of dedication to the public may apply where an applicant discloses but does not claim certain embodiments. Where figures or embodiments are shown but not pursued, courts may treat that unclaimed subject matter as dedicated to the public. Unlike estoppel, dedication does not require a narrowing amendment or argument; it arises from the failure to claim disclosed subject matter.

### 3.7 Avoid Absolute or “Differences Alone” or “Sufficient by Themselves” Language When Identifying Design Distinctions

When distinguishing a claimed design from prior art during prosecution, applicants should avoid framing any identified difference as independently sufficient, standing alone, or dispositive of patentability, and should instead present differences as contributing collectively to a different overall visual impression. Absolute phrasing such as “alone,” “by itself,” or “sufficient in itself” risks being construed as a clear and unmistakable representation that particular features define the scope of the claimed design. Such language may later be used to argue prosecution history disclaimer by treating enumerated differences as claim-defining limitations rather than illustrative aspects of the overall appearance.

### 3.8 Feature-Based Arguments Must Be Anchored to Overall Visual Impression

When applicants discuss specific ornamental features to distinguish a claimed design from prior art, those features must be consistently framed as examples of how the overall visual

impression differs, rather than as isolated or claim-defining elements. While feature-by-feature discussion may be necessary to respond to examiner rejections, arguments that emphasize individual features without expressly anchoring them to the cumulative overall appearance may later be characterized as narrowing statements that redefine the claimed design by its constituent parts.

### 3.9 Formal Drawing Amendments Should Be Expressly Characterized as Non-Substantive

When responding to Quayle actions or other formal drawing objections, applicants should expressly state that any drawing amendments are made solely for clarity, consistency, or compliance with drawing conventions, and not for reasons related to patentability. Explicitly characterizing amendments as formal rather than substantive helps prevent later arguments that the applicant narrowed claim scope or conceded the importance of particular features during prosecution.

### 3.10 Line-Type Changes May Give Rise to Estoppel if Not Properly Contextualized

Changes converting features from solid lines to broken lines during prosecution should be treated as potentially narrowing amendments and carefully contextualized to avoid creating prosecution history estoppel. Although line-type changes are often described as clarifications, converting solid-line features to broken lines may be argued to remove those features from the claimed design. Without careful explanation, such amendments may later be characterized as surrendering claim scope.

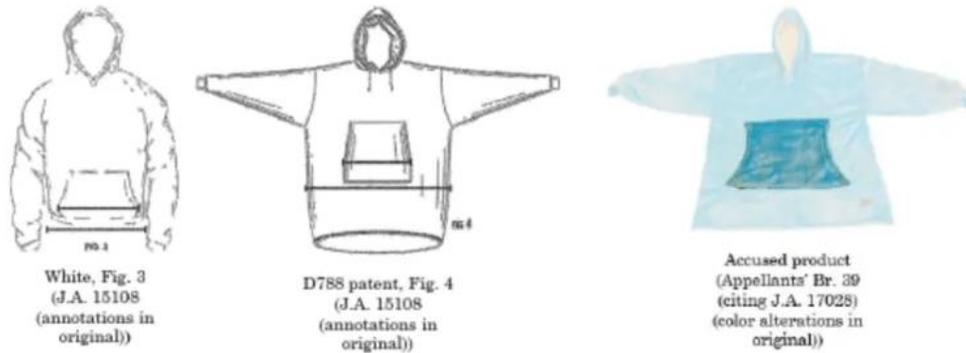
### 3.11 Silence During Prosecution Should Not Be Interpreted as Agreement

In responses addressing limited or formal issues, applicants may clarify that silence as to other matters should not be interpreted as agreement with examiner characterizations or conclusions. Although silence alone does not necessarily create estoppel or disclaimer, an express clarification may help prevent later arguments that unaddressed examiner statements were implicitly conceded.

## 4. Application of the Rules in Case Examples

### 4.1 *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.

4.2 *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.

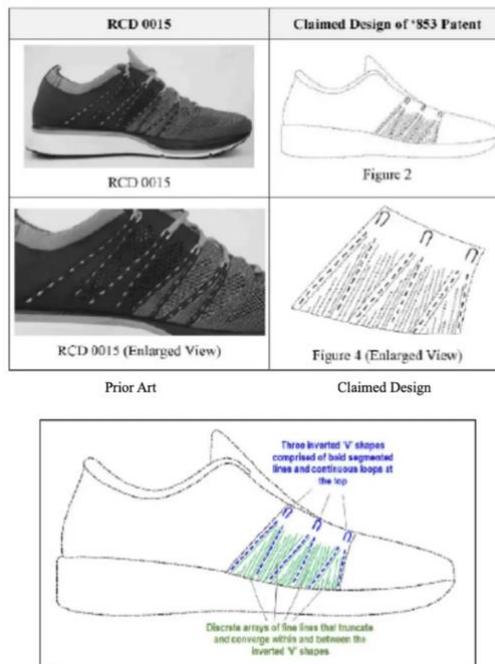


Defendant Target argued that this amounted to a surrender of all designs lacking seamless corners. But the court disagreed, emphasizing that argument-based estoppel requires a "clear and unmistakable" surrender, *id.* at \*9, and that merely identifying multiple visual differences to overcome a prior 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.

4.3 *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.



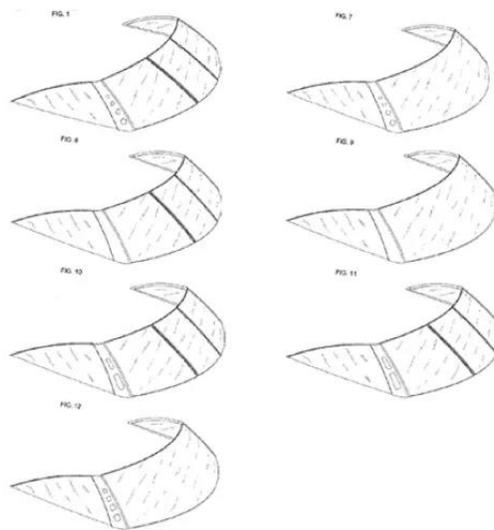
These arguments were made to oppose institution of review and were repeated across multiple filings and against several prior art references. The court found these statements to be clear and unmistakable assertions about the claimed design’s visual scope, made in support of patentability. Although Nike 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.

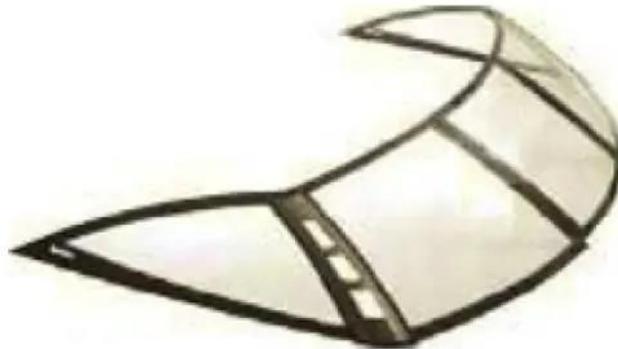
4.4 *Pacific Coast Marine Windshields v. Malibu Boats, LLC.*, 739 F.3d 694 (Fed. Cir. 2014)

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.



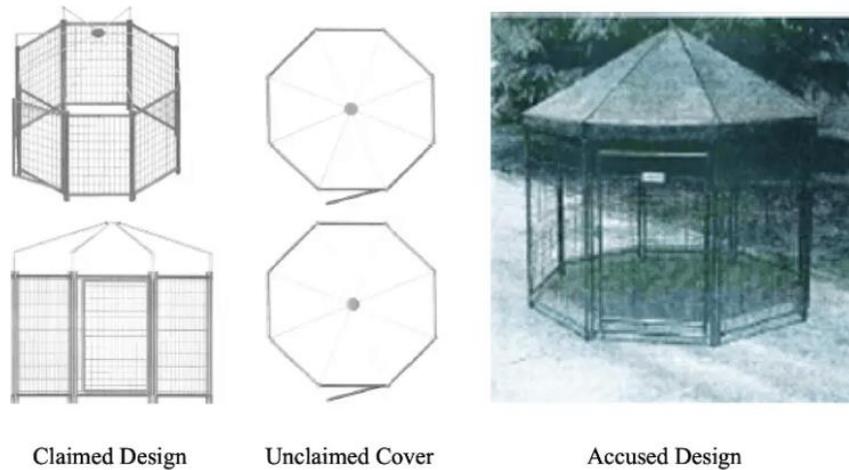
The district court concluded that by failing to separately prosecute the cancelled embodiment, the patentee put the public on notice that the subject matter was surrendered and dedicated to the public. Although the abandoned design had two rectangular holes and the accused design had three trapezoidal 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.

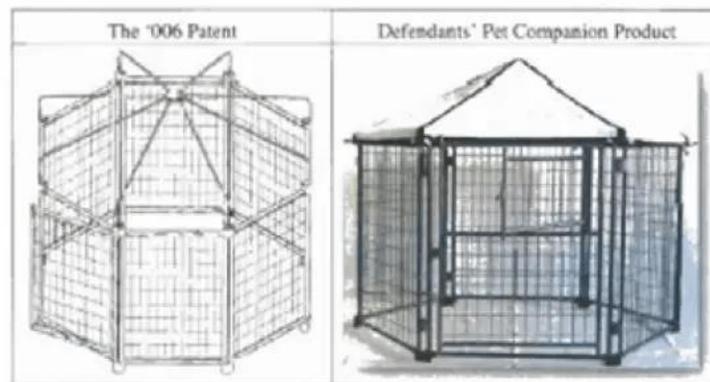
Note that even though an election following restriction is not technically an amendment, the court held that such a choice in response to a patentability requirement effects a surrender of claim scope analogous to an amendment, and estoppel applies accordingly.

4.5 *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.

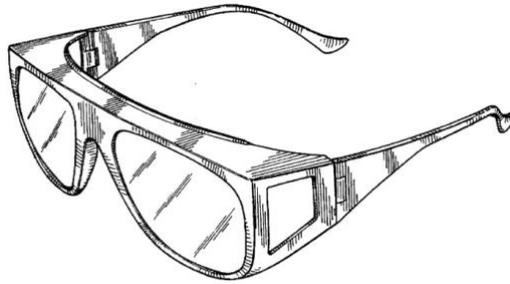


The defendant, who was selling an accused frame design with a cover, argued that prosecution history estoppel applied because the applicant did not pursue the frame with a cover. The district court found estoppel based on an election of species, but the Federal Circuit reversed, concluding that even 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.



4.6 *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.

Practice Tip: If an examiner issues a "new matter" rejection on a drawing, consider arguing that the feature was *inherent* in the original disclosure rather than simply deleting it. Deletion is a "clear surrender" that can instantly limit the patent's value.

4.7 *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.

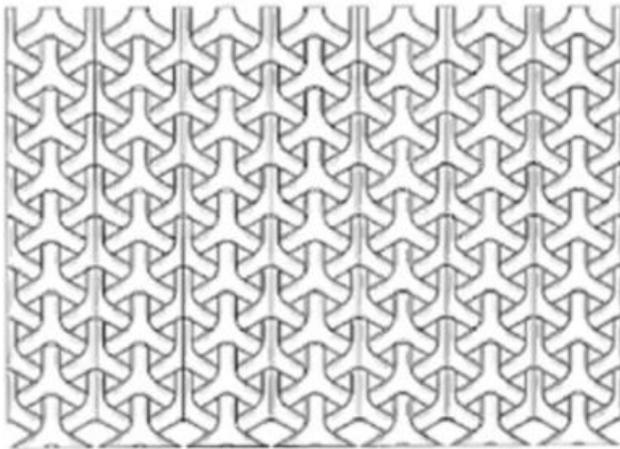


FIG. 1

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. Unlike feature-based disclaimer cases, *Curver* involved a category-defining limitation on the article of manufacture itself, rather than a surrender of specific ornamental features within the design.

#### 4.8 *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.

### 5. Practice and Enforcement Notes

#### 5.1 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.

#### 5.2 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, which is whether, considering the prior art, the accused design is substantially the same as the claimed design in the eye of an ordinary observer.

Although *Egyptian Goddess* unified the infringement framework by eliminating the point of novelty test, it did not eliminate prosecution history disclaimer or prosecution history estoppel as defenses. Prosecution history disclaimer remains a claim construction doctrine, and prosecution history estoppel remains a limitation doctrine that can bar a finding of infringement even under the ordinary observer test.

Subsequent case law (like *Pacific Coast*) still apply the three-part prosecution history estoppel test to determine the scope of a surrender. Therefore, while the *standard* for infringement is unified, the *legal bar* of estoppel still requires a distinct three-step analysis: (1) Was there a surrender? (2) Was it for patentability? (3) Does the accused design fall within that scope?

Also note that in design patent cases, courts occasionally have labeled narrowing effects as “prosecution history estoppel” even where the analytical reasoning more closely resembles prosecution history disclaimer, particularly when the focus is on public notice rather than equitable reliance.

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.

### 5.3 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. Estoppel also 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. Finally, statements made by a design patent owner during PTAB proceedings, including IPR preliminary responses and briefing, are routinely treated by courts as part of the prosecution history for purposes of prosecution history disclaimer and argument-based estoppel.

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.

*Pacific Coast Marine* establishes that an election of species or embodiment in response to a restriction requirement constitutes a surrender for purposes of prosecution history estoppel. The patentee prevailed in that case only because the accused design fell outside the scope of the surrendered subject matter, not because the election itself was non-narrowing.

#### 5.4 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?

#### 5.5 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. However, § 103 responses can present comparable disclaimer or estoppel risk in certain circumstances. Specifically, when: (1) the primary reference is very close to the claimed design and secondary references add only minor variations, (2) the applicant frames a single feature as dispositive in overcoming the motivation to combine, or (3) a 'teaching away' argument focuses exclusively on one feature rather than overall visual direction. In such circumstances, the practical distinction between § 102 and § 103 rejections becomes less meaningful for purposes of disclaimer risk, and practitioners should apply the same cautious approach recommended for anticipation rejections.

#### 5.6 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 Marine Windshields* itself was an estoppel case, not a disclaimer case. The Federal Circuit there applied a traditional prosecution history estoppel framework based on an election following a restriction requirement. When *Top Brand* cited *Pacific Coast*, the court relied on it for the broader proposition that representations made during prosecution can limit design patent scope, rather than for *Pacific Coast*’s specific three-part estoppel analysis. Practitioners should nevertheless continue to distinguish between disclaimer and estoppel in practice, as the doctrines differ in timing, procedural posture, and evidentiary focus.

Note that while the court in *Top Brand* stated they see "no reason to distinguish between disclaimer by amendment and disclaimer by argument," practitioners should consider still treating them as separate for procedural reasons. Disclaimer must be argued at the Markman phase, whereas estoppel can often be raised later at summary judgment.

#### 5.7 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 ultimately a question of law for the court, although its application may depend on underlying factual determinations regarding the scope of the alleged surrender and the relationship of the accused design to that surrendered subject matter. Prosecution history estoppel is often 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 should typically be raised during the claim construction phase (typically at or before a Markman hearing). While courts have discretion to consider disclaimer arguments raised later if purely legal and requiring no additional fact development, failure to raise it at the claim construction stage may result in waiver depending on circuit law and local practice. In contrast, prosecution history estoppel is typically raised during the infringement analysis. It can be presented at summary judgment or at trial. If, however, estoppel is intertwined with issues submitted to the jury as part of the infringement analysis, failure to raise it in a Rule 50(a) motion may result in waiver for post-trial

or appellate review. 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.

## 5.8 Amendment Versus Argument Strategy

When faced with close prior art, practitioners must weigh whether to amend or argue. Amendments may provide clearer paths to allowance but carry greater estoppel risk. Where possible, arguing based on overall visual impression may better preserve scope. In some cases, filing a continuation to pursue broader protection while amending the present application may be the most prudent approach.

### Decision Framework: When to Argue vs. Amend

As a practical matter, the closer the cited reference is to the claimed design, the more pressure exists to narrow the claim through amendment, but the greater the risk of creating prosecution history estoppel.

In general:

If the cited prior art differs in multiple significant visual aspects, applicants should favor argument based on overall visual impression, because amendments are more likely to create unnecessary narrowing.

If the cited prior art differs in only one or two aspects but the overall impression remains distinct, applicants should generally argue first. If unsuccessful, applicants should consider filing a continuation before making any narrowing amendment.

If the cited prior art is nearly identical in overall appearance, amendment may be unavoidable. In such cases, filing a continuation prior to amendment is often advisable to preserve broader claim scope.

A key red flag is the temptation to distinguish the prior art using measurements, angles, geometric terminology, or highly specific feature language. When prosecution arguments require that level of feature precision, the risk of disclaimer or estoppel increases substantially.

## 5.9 Continuation and Family Practice Considerations

When prosecuting related design applications, practitioners should assume that prosecution statements made in a parent application may be used to construe the scope of child applications, particularly where the designs are substantially similar. Although each design patent issues from a separate application, courts may look to the family prosecution history to understand what subject matter was surrendered or disclaimed.

In continuation and divisional practice, narrowing arguments, amendments, or elections made in a parent application may therefore affect enforcement of later-issued patents in the same family. Where possible, practitioners should consider filing continuation applications before

making narrowing arguments in order to preserve broader protection. Consistency across related applications is critical; conflicting positions taken during prosecution may undermine enforcement of the entire portfolio.

#### 5.10 Post-Grant and PTAB Considerations

Statements made during prosecution may also be considered in post-grant proceedings, including inter partes review, where prosecution history is admissible as evidence relevant to claim interpretation and scope. Practitioners should therefore assume that arguments made during examination may be scrutinized not only by courts, but also by the PTAB in later proceedings.

Appendix 1  
(Checklist for Prosecution History Estoppel and Disclaimer)

- 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. Practitioners should assume that examiner interview summaries and follow-up letters memorializing feature-specific discussions may be treated as prosecution history statements capable of supporting disclaimer arguments in later litigation. Anything said in an interview can be "prosecution history disclaimer" if the examiner includes a specific feature-based distinction in their Interview Summary. Consider always filing a supplemental summary to "re-frame" those discussions in holistic terms.

Appendix 2  
(Questions and Answers)

Q1: What is the difference between prosecution history estoppel and prosecution history disclaimer?

A: Prosecution history estoppel generally arises from amendments or arguments made during prosecution that narrow the scope of a design claim in order 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.

Q2: Can both estoppel and disclaimer apply in the same case?

A: 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.

Q3: How can practitioners avoid triggering disclaimer or estoppel?

A: 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.

Q4: Does the USPTO examiner intend for applicant statements to create disclaimer?

A: 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.

Q5: Are design patents more vulnerable to disclaimer than utility patents?

A: 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.

### Appendix 3 (Limitations of this ProGuide)

This ProGuide is intended to provide practical guidance on prosecution history estoppel and prosecution history disclaimer in design patent practice. It is designed to help practitioners identify common prosecution behaviors that may later be argued to narrow claim scope in litigation and to provide drafting strategies that reduce that risk. However, the doctrines discussed in this ProGuide are applied retrospectively and depend heavily on the specific record and litigation posture. The following limitations therefore apply.

#### A. This ProGuide Is Risk-Reduction Guidance, Not a Guarantee

This ProGuide does not and cannot guarantee that a prosecution record will be free from estoppel or disclaimer arguments. Courts decide prosecution history estoppel and disclaimer based on the full prosecution record and the facts of the infringement dispute. Even well-crafted, cautious prosecution responses may be characterized as narrowing in later litigation, especially when the prior art is close or when the applicant's arguments are repeatedly focused on particular visual features.

#### B. Estoppel and Disclaimer Are Record-Dependent and Case-Specific

Prosecution history disclaimer requires “clear and unmistakable” disavowal, while prosecution history estoppel focuses on whether subject matter was surrendered for reasons of patentability and whether the accused design falls within the scope of that surrender. The application of these doctrines depends on the specific wording, context, repetition, and purpose of statements made during prosecution. This ProGuide cannot anticipate all fact patterns, examiner practices, or litigation theories that may arise in a particular case.

#### C. This ProGuide Does Not Evaluate or Validate the Underlying Prosecution Strategy

This ProGuide evaluates how certain *types of arguments and amendments* may later be used in litigation; it does not judge whether the applicant's prosecution strategy was optimal for obtaining allowance in a given case. In some cases, particularly where the cited prior art is close, a practitioner may reasonably decide that stronger feature-focused arguments are necessary to secure allowance. This ProGuide is not intended to second-guess those case-specific strategic choices; it is intended to make the downstream risk more visible and manageable.

#### D. “Overall Visual Impression” Language Is Helpful but Not Dispositive

While courts emphasize the ordinary observer test and overall visual impression, courts often look past boilerplate references to “overall appearance” and examine what the applicant actually argued as the basis for allowance. Accordingly, using “overall visual impression” language does not, by itself, prevent a later finding of disclaimer or estoppel if the record otherwise reflects repeated, definitive, or feature-dispositive representations.

#### E. The ProGuide Does Not Address All Sources of Prosecution History

This ProGuide focuses primarily on the written prosecution record. It does not comprehensively address all other sources that may become relevant in later disputes, including but not limited to: examiner interview summaries, interview agendas, informal examiner communications that were later memorialized, IDS submissions and related statements, terminal disclaimers and related statements, reissue or reexamination records, or PTAB records (e.g., IPR preliminary responses and briefing) except where specifically discussed. These materials can also be used to argue surrender or disavowal.

#### F. Litigation Posture and Procedural Context Can Change the Impact of the Same Record

The practical effect of prosecution history arguments varies depending on litigation posture, including claim construction timing, summary judgment standards, how close the accused design is to the asserted design, and what prior art is before the court. A prosecution statement that appears innocuous in isolation may become outcome-determinative if it aligns closely with the accused design's distinguishing characteristics. This ProGuide cannot predict how a future court will weigh a given prosecution statement in a particular procedural context.

#### G. This ProGuide Does Not Replace a Full Litigation-Focused Record Review

This ProGuide provides principles, rules, and illustrative examples, but it is not a substitute for a matter-specific prosecution history audit when a design patent is being prepared for enforcement, licensing, or litigation. Before asserting a design patent, counsel should review the complete prosecution record (including any related family members) to identify statements or amendments that a defendant could plausibly characterize as surrender or disavowal.

#### H. The Law in This Area Continues to Develop

The Federal Circuit's treatment of prosecution-history-based narrowing in design patent cases has evolved, and further refinement should be expected. This ProGuide reflects the current doctrinal landscape as of its last update, but future decisions may adjust how courts analyze "clear and unmistakable" disavowal, the scope of argument-based estoppel in design cases, or the interaction between disclaimer and the ordinary observer test.

Appendix 4  
(Selected 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. MPEP § 1504.02

Rejoinder of Restriction Requirements (Relevant to estoppel risks arising from restriction elections and later enforcement of non-elected subject matter)

F. MPEP § 1504.03

Election by Examination (Relevant to scope surrender and prosecution history estoppel resulting from election practice)

G. MPEP § 2121.02

Overcoming Rejections (Argument Strategies) (Relevant to argument-based estoppel and disclaimer arising from feature-specific prosecution arguments)

H. 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.

I. 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.

J. 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.

K. 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.

L. 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.

M. 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.

N. 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.

O. 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.