

Design Patent ProGuide – Appendices

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Cases, MPEP sections, rules, statutes and design application file histories cited in this guide link to the documents in ProSearch. A free Design Patent Pro account is all that is needed to open them.

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Quick Reference Guide

DO

- Use an appendix when it serves a legitimate, identifiable purpose (see Section 1.1)
- File an appendix as a separate paper with a clear “APPENDIX” heading (a practice-based approach; the MPEP addresses an optional description in a separate paper, not image appendices as such)
- Consider CAD drawings or photographs in an appendix as reference material for line drawing contours, shading, or proportions, after a case-specific assessment of the risks
- Treat appendix material as possible, not assured, written description support for later amendments, continuations, or divisionals, and assess priority and new matter claim by claim
- Remove all specification references to the appendix if the examiner raises any objection
- If an appendix would depict other embodiments, decide before filing whether they are patentably indistinct variations of a single inventive concept that could be shown in the

formal drawings, or distinct designs better pursued in a separate application (see [MPEP § 1504.05](#); *In re Rubinfeld*, 270 F.2d 391 (CCPA 1959))

- Before canceling an appendix, evaluate whether a continuation or divisional application should be filed to preserve rights in the appendix content

DON'T

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

1. Introduction and Theory

Design patent practice is grounded in a fundamental principle: the claim is defined by the drawings. Unlike utility patents, where written claim language establishes the legal boundaries of the invention, a design patent protects the ornamental appearance as shown in the drawing views, with written description playing only a limited supporting role. Claim scope must be ascertainable from the drawings themselves, not from explanatory text or extrinsic materials, and infringement is judged from the perspective of the ordinary observer. See [MPEP § 1503.01](#), subsection II; *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc).

Appendices have a legitimate role in design patent practice and, when used correctly, carry manageable risk. The MPEP permits an optional description of the design in a separate paper rather than in the specification, and appendices are filed in practice. See [MPEP § 1503.01](#), subsection II; *Ex parte Spiegel*, 1919 C.D. 112, 268 O.G. 741 (Comm’r Pat. 1919). That passage concerns descriptive text. It does not expressly approve image appendices, which are a practice-based option requiring case-specific assessment. The problems that arise are not inherent to appendices as a tool. They are the product of how appendices are used.

Two categories of appendix use warrant different assessments. The first, appendices that supplement or reference the formal drawing disclosure in ways that affect claim interpretation, can create substantive examination problems and prosecution history risk. The second, appendices that

serve a discrete, non-claim-defining function such as providing CAD reference material or photographs to support interpretation of line drawings, generally carries lower risk and can serve a legitimate strategic purpose, although no categorical non-limiting effect is assured.

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

Note: This ProGuide is subject to certain limitations, which are set forth in [Appendix 3](#).

1.1 Legitimate Uses for Appendices

The following are practice-based options for appendix use. The MPEP expressly addresses only an optional description of the design in a separate paper, not image appendices, so each use requires a case-specific assessment:

CAD Drawings as Contour and Shading Reference - Where the formal drawing set consists of line drawings, questions sometimes arise about surface contours, depth transitions, or shading interpretation. Submitting CAD renderings in an appendix can provide a visual reference for the examiner or a court. An unreferenced appendix is not itself a substitute for the claimed drawing views, but its contents and the prosecution record may be relevant to disputes about what those views disclose; no categorical non-limiting effect is assured. An accused infringer, for example, may rely on appendix images to argue that the claimed design is narrower than the line drawings alone would suggest. The risk is lower when the appendix is not referenced in the specification.

Photographs of Physical Prototypes or Products - Where line drawings were derived from a physical object, photographs in an appendix can show the surface transitions, proportions, and three-dimensional relationships that the line drawings depict. They should not be needed to resolve an ambiguity in the drawings (see Section 3.3). As with CAD drawings, photographs used in this manner may assist in prosecution or in litigation over claim construction, but no categorical non-limiting effect is assured. Photographs also raise drawing-medium questions. "Photographs and drawings must not be combined in a submission of the visual disclosure of the claimed design in one application." [MPEP § 1503.02](#), subsection V; *see also* [37 C.F.R. § 1.84\(b\)](#). Placing photographs in a separate paper does not necessarily avoid those rules, and whether and how they apply to a particular submission should be checked.

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

drawings are permitted in design applications, but they must meet the requirements of 37 C.F.R. § 1.84(a)(2), including the required statement in the specification, and color photographs must also satisfy § 1.84(b)(2). See MPEP § 1503.02, subsection V. Color images filed in an appendix alongside black-and-white drawings may draw an objection or invite argument about whether color is part of the claimed design.

Supporting Written Description for Continuations - Appendix material filed with the original application may furnish written description support for later amendments, continuation applications, or divisional filings directed to related designs. Support depends on whether the material was properly part of the original application and clearly conveys possession of the particular later-claimed design, and priority and new matter must be assessed claim by claim. No reported decision has addressed appendix images specifically, although examiners have accepted appendix images as support for continuation priority and drawing amendments in particular applications (see Sections 3.4 and 4.10). Practitioners who anticipate future continuation activity sometimes include appendix material at the outset for this purpose.

Manufacturing or Technical Specifications - Technical or manufacturing specifications submitted as appendix material may explain physical implementation without defining ornamental scope. Where the specification text is entirely silent as to the appendix, this type of supplemental material appears to carry limited examination risk, although that assessment rests on observed practice rather than express authority.

1.2 Where Appendix Risk Is Concentrated

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

When appendix content crosses from “reference material” into “alternative design disclosure,” it interacts with examination principles in ways that can produce substantive problems. In the prosecution histories reviewed for this guide, the problems usually arose when the specification referred to or incorporated such an appendix, and examiners then treated appendices of this kind as disclosures affecting claim scope, triggering indefiniteness findings, multiple-embodiment objections, and scope-clarity requirements. Canceling such an appendix in response to an examiner objection creates a prosecution record that an accused infringer may invoke to argue for a narrower enforceable scope; whether it has that effect depends on the particular record.

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

1.3 The Core Tension and Public-Notice Principles

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

Beyond examination, once design information is disclosed in an application, whether in drawings, specification text, or an appendix, it becomes part of the public record. If that disclosed material is later canceled, abandoned, or simply never claimed through a continuation or divisional application, accused infringers may plausibly argue that the patentee has surrendered or foregone exclusive rights to that subject matter. The Federal Circuit has held that prosecution history estoppel principles apply to design patents, and the prosecution record can otherwise bear on asserted design scope. See *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694 (Fed. Cir. 2014) (estoppel principles apply after cancellation of embodiments in response to a restriction requirement, but the accused design was outside the surrender); *Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334 (Fed. Cir. 2019) (article of manufacture limitation drawn from claim text and amendments); *Top Brand LLC v. Cozy Comfort Co.*, 143 F.4th 1349 (Fed. Cir. 2025) (prosecution history disclaimer, including disclaimer by argument, applies to design patents). None of these cases involved an appendix. See also *Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co.*, 898 F.3d 1210 (Fed. Cir. 2018) (no estoppel where the accused design embodied the elected design).

The disclosure-dedication doctrine, developed in utility patent law as a limit on the doctrine of equivalents, has not been squarely applied by the Federal Circuit to design patent appendices. See *Johnson & Johnston Assocs. Inc. v. R.E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002) (en banc); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098 (Fed. Cir. 1996). A party might nonetheless assert the underlying principle, that the public is entitled to rely on what an applicant discloses but does not claim, by analogy in the design patent context, particularly for appendices depicting alternative configurations that are later abandoned. Whether that analogy applies to design appendices remains unestablished.

2. Recommended Form

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

2.1 File the appendix as a separate paper with a clear “APPENDIX” heading (a practice-based approach, not one the MPEP expressly addresses)

2.2 Include NO reference to the appendix in the specification

2.3 Include NO incorporation-by-reference language

2.4 Do not rely on a legend in the appendix to establish its legal effect

Whether to include any legend (for example, one identifying the appendix as reference material) should be decided case by case, because no legend can determine how the appendix will be treated.

2.5 If the appendix is intended to support future continuation filings, document this intent internally but do not state it in the application

2.6 Assume the appendix may require cancellation or de-linking during prosecution if it draws examiner attention

3. Rules and Guidance for Appendices

3.1 An Appendix Is Procedurally Permissible and Can Serve Legitimate Purposes

A design patent application may include descriptive material submitted separately from the drawings, including in the form of an appendix. The MPEP permits an optional description of the design in a separate paper rather than in the specification, a practice that traces back to early USPTO practice. See [MPEP § 1503.01](#), subsection II; *Ex parte Spiegel*, 1919 C.D. 112, 268 O.G. 741 (Comm’r Pat. 1919). That passage does not, by itself, establish a rule permitting every proposed image-appendix use.

Appendices may serve legitimate functions, including submission of CAD drawings or photographs as reference material for formal line drawings, possible written description support for continuation or divisional filings, and supplemental reference material not intended to define claim scope. These are practice-based uses, not uses the MPEP expressly authorizes, and each requires case-specific assessment.

The risk profile of an appendix depends significantly on its content and how it is used. Reference material that is not incorporated into the specification or claim, and that does not depict visually distinct alternative designs, carries substantially lower risk than appendices disclosing alternative

embodiments or variations. Practitioners should assess the specific content and purpose of any proposed appendix and tailor their strategy accordingly.

3.2 Appendix Content Cannot Expand Claim Scope Beyond the Drawings

Appendix content that describes or suggests embodiments or modified forms of the design that are not shown in the drawing views is improper if incorporated into the specification, and may render the claim indefinite. MPEP § 1503.01, subsection II, lists as impermissible "[s]tatements which describe or suggest other embodiments of the claimed design which are not illustrated in the drawing disclosure, except one that is a mirror image." See also 35 U.S.C. § 112; MPEP § 1504.04. A design patent is indefinite "if one skilled in the art, viewing the design as would an ordinary observer, would not understand the scope of the design with reasonable certainty based on the claim and visual disclosure." *In re Maatita*, 900 F.3d 1369 (Fed. Cir. 2018). By contrast, a description of the appearance of portions of the claimed design that are not illustrated is permitted if it is in the application as originally filed. MPEP § 1503.01, subsection II. Applications 29/903,635 and 29/695,608 (§ 112(a) and (b) rejections where the specification incorporated or relied on an appendix whose language referred to embodiments or modified forms not shown in the drawings; the examiners also cited MPEP § 1503.01 and 37 C.F.R. § 1.73, and in 29/695,608 also § 1.71).

3.3 An Appendix Cannot Be Used to Define Claim Boundaries

An appendix may not be relied upon to clarify claim boundaries, surface transitions, or the extent of claimed subject matter that the drawings do not themselves show. A later amendment cannot introduce new matter, so incorporating appendix content into the specification or drawings is not a general cure for a deficient drawing disclosure. The relevant inquiry is whether the original application adequately disclosed the particular claimed appearance and whether permissible amendments make the claim clear. See *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013). If claim clarity depends on appendix text or images, the examiner may require cancellation of appendix references or amendment of the drawings or specification. Application 29/903,635 (examiner: "If Applicant's intent is to claim material that is shown in the appendix, Applicant must amend the drawings/specification to include that material.").

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

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

Appendix material that is part of the original filing may serve as written description support for later amendments to drawings or the specification, provided the amendment does not introduce new matter. Any later drawings must find direct visual support in the originally filed appendix images to avoid a new matter rejection. See *In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998); *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013); cf. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991) (drawings in an earlier design application can, depending on what they convey to a skilled artisan, provide written description support for later claims). None of these decisions decides whether material filed as an appendix is part of the relevant disclosure, and no reported decision has addressed that question. In one non-precedential decision, the Board referred to a color image from an application's appendix in describing the claimed design, without deciding the appendix's status. *Ex parte Carrigan*, Appeal No. 2021-001189 (PTAB 2021) (Application [29/606,389](#)). Support depends on whether the material was properly part of the original application and clearly conveys possession of the particular later-claimed design, and priority and new matter must be assessed claim by claim. *Owens* also holds that disclosure of a whole design does not necessarily show possession of a newly bounded part of it. Compare Applications [29/946,074](#) and [29/917,737](#) (examiners stating that an appendix "may form antecedent basis for certain amendments" but is not part of the disclosure or the drawing disclosure) and [29/904,863](#) (applicant removed the specification's reference to the appendix but expressly kept the appendix as a possible basis for drawing amendments), with Application [29/695,608](#) (drawing amendments removing broken-line features objected to as new matter although a 40-figure appendix was on file). See also Section 4.9 (examiner refusing to extend a feature shown in an appendix to embodiments the appendix did not show) and Section 4.10 (examiners accepting appendix support for continuation priority and drawing amendments).

Three questions should be kept separate. First, whether the existing claim includes appendix material: an appendix ordinarily does not itself define the existing claim, but referring to or incorporating it in the specification may create a dispute or rejection about claim scope (compare Section 4.1 with Section 4.4). Second, whether appendix material can provide antecedent basis or written description support for a later amendment or claim: possibly, assessed claim by claim. Third, whether a particular amendment is permissible: it may not add new matter, whatever the appendix shows (see Section 4.7). Possible support for a later claim is not a determination that the existing claim includes the appendix, or that a particular amendment will be entered. However, even where appendix material does not become claim-limiting, its inclusion and subsequent removal may support an argument of prosecution history disclaimer or estoppel limiting the scope of the design for enforcement purposes.

3.5 Specification References to Appendix Embodiments May Draw Embodiment or Scope Objections

When the specification described an appendix as showing additional views, embodiments, or designs, examiners in the applications reviewed for this guide treated the statement as suggesting embodiments not shown in the drawings or as broadening the claim, and objected to or rejected the application until the statement was removed. Application [29/946,074](#) (specification stated that "[a]dditional views and embodiments" were shown in an appendix of 32 additional figures; the examiner found that the statement broadened the claim to designs not shown, and noted that the applicant "may cancel the Appendix"); Application [29/902,119](#) (objection to a specification reference to an appendix because statements describing or suggesting other embodiments are not permitted). In neither application did the examiner require removal of the appendix itself. An unreferenced appendix can, however, draw an objection on its own: in Application [29/660,112](#), where the specification as it appears in the file did not mention the appendix, the examiner stated that "[t]he application is improper because it contains appendices" and required their cancellation (Section [4.8](#)). The risk is greater for appendices depicting alternative design configurations than for reference material such as CAD renderings of the same design shown in the formal drawings.

3.6 Appendix Cancellation May Invite an Implicit Election Argument Even Without a Formal Restriction

When appendix material is removed in response to an examiner objection (without a formal restriction requirement), an accused infringer may argue that the applicant's acquiescence functioned as an implicit election, limiting the claim to the remaining drawings. None of the prosecution histories reviewed for this guide shows such an election. In Application [29/902,119](#), for example, the applicant canceled a specification statement referring to the appendix in response to an objection, but the election in that case was made in response to a formal restriction requirement directed to embodiments in the drawings. This is a possible litigating argument, not an established doctrine. No reported decision has adopted it. The closest authority is *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694 (Fed. Cir. 2014), which held that prosecution history estoppel principles apply where embodiments are canceled in response to a restriction requirement, but found the accused design outside the surrender. Whether cancellation of an unreferenced appendix in response to an objection to form is a surrender "for reasons of patentability" is an open question. Practitioners should evaluate this risk before canceling appendix material and consider filing a continuation or divisional directed to the removed content if it has independent commercial significance.

3.7 Appendix Use May Raise Prosecution History Estoppel and Disclaimer Arguments Even Without § 112 Rejections

Even where no § 112 rejection is issued, references to or subsequent removal of appendix material may support prosecution history estoppel or disclaimer arguments or otherwise bear on the scope a court will give the issued figures. See *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694 (Fed. Cir. 2014); cf. *Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334 (Fed. Cir. 2019). Prosecution history disclaimer also applies to design patents, and it "can occur through claim amendments or arguments made to the PTO." *Top Brand LLC v. Cozy Comfort Co.*, 143 F.4th 1349 (Fed. Cir. 2025). Arguments about what an appendix shows, or about why appendix content differs from prior art, should be made with that in mind. Estoppel is not automatic, however. It depends on "(1) whether there was a surrender; (2) whether it was for reasons of patentability; and (3) whether the accused design is within the scope of the surrender." *Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co.*, 898 F.3d 1210 (Fed. Cir. 2018) (quoting *Pacific Coast Marine*). In both cases the court found the accused design outside any surrender. This risk is most acute for appendices disclosing alternative embodiments that are later canceled without being pursued in a separate filing.

3.8 Strategic Considerations

For alternative design embodiments with independent commercial significance, continuation or divisional applications supported by separate drawing disclosures generally provide stronger and cleaner protection than appendices. Practitioners should anticipate that an accused infringer may argue that appendix material not claimed in an issued design patent was disclaimed or dedicated to the public, although no court has applied either theory to a design appendix. Prosecution history disclaimer itself applies to design patents. *Top Brand LLC v. Cozy Comfort Co.*, 143 F.4th 1349 (Fed. Cir. 2025).

For reference material such as CAD drawings, photographs, or supplemental context that supports the formal drawing set without depicting independent design alternatives, appendix use may be appropriate after a case-specific assessment, and the risks described above are generally reduced.

Practitioners pursuing continuation or divisional applications to protect appendix content should be aware that the standard for design patent obviousness has materially changed. In *LKQ Corp. v. GM Global Technology Operations LLC*, 102 F.4th 1280 (Fed. Cir. 2024) (en banc), the Federal Circuit overruled the long-standing *Rosen-Durling* test, including its requirements that a primary reference be "basically the same" as the claimed design and that secondary references be "so related" to the primary reference, and held that design patent obviousness is governed by the same flexible *Graham v. John Deere* factors applied in utility patent practice.

LKQ did not address double patenting or appendix-derived continuations, so its effect on appendix strategy is a question to evaluate rather than a settled consequence. If a continuation is entitled to the parent's filing date for the particular claimed design, the parent's own drawings are not intervening prior art against that claim. Whether an appendix supports that entitlement must be assessed separately. Even so, a continuation directed to an appendix design that is a visible variation of the parent's design may face a nonstatutory (obviousness-type) double patenting rejection over the parent. For designs, that inquiry asks whether the two designs are patentably distinct, an obviousness-type analysis. See [MPEP § 1504.06](#). In Application 29/961,689, for example, the examiner accepted amended drawings adding side-door contouring supported by an appendix filed in the parent application, and in the same action provisionally rejected the claim for nonstatutory double patenting over a co-pending application, citing "the contour lines included in the side doors of the vehicle" as an example of differences that were "minimal to the overall design." Whether *LKQ*'s more flexible framework makes such rejections easier to sustain remains to be seen. The 35 U.S.C. § 121 safe harbor against double patenting is tied to the statutory restriction and divisional requirements, see [MPEP § 804.01](#), so it should not be assumed for a voluntary continuation or for a filing that does not meet those requirements. Third-party prior art may also support a more readily constructed obviousness rejection under *LKQ* than it would have under prior law. This does not diminish the strategic value of pursuing such filings as a patentably distinct design remains protectable, but practitioners should evaluate the obviousness and double patenting exposure of appendix-derived continuation claims under the post-*LKQ* framework before assuming that visual variation from the parent design will be sufficient to support allowance. Note that the same flexibility that makes obviousness rejections easier to construct may also provide applicants with broader grounds to distinguish prior art combinations, and practitioners should approach post-*LKQ* prosecution with both risks and opportunities in mind. Early prior art searching against proposed continuation claims is advisable.

3.9 Disclosure–Dedication Risk

Where design-related subject matter is disclosed in an appendix but not ultimately claimed, whether because the appendix is canceled, abandoned, or simply not pursued through a continuation or divisional application, an accused infringer may argue that such subject matter was surrendered, disclaimed, or effectively dedicated to the public. The argument is likely to be stronger the more clearly the appendix depicts a standalone design alternative.

No Federal Circuit decision has squarely applied the disclosure-dedication doctrine to design patent appendices. The doctrine developed in utility patent law as a limit on the doctrine of equivalents. See *Johnson & Johnston Assocs. Inc. v. R.E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002) (en banc). See also *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098 (Fed. Cir. 1996); *PSC Computer Prods., Inc. v. Foxconn Int'l, Inc.*, 355 F.3d 1353 (Fed. Cir. 2004). Each of these decisions concerns

utility patent equivalents. A party might assert the doctrine by analogy, but its applicability to design appendices remains unestablished. Accused infringers can reasonably be expected to make these arguments where appendix material is disclosed and then abandoned.

4. Application of Rules and Guidance to Objections and Rejections

This section provides representative examples of how appendix-related objections and rejections arise in practice and how they are typically cured during prosecution. Each example is drawn from the prosecution history of the cited application as reviewed in ProSearch on October 1, 2026, with the issued patent number where the file shows one. In most of the appendix-related objections and rejections documented in the applications reviewed here, the examiner identified a specification statement referring to or incorporating the appendix. In Applications [29/903,635](#), [29/904,863](#), and [29/946,074](#), the examiner also criticized language in the appendix itself (Sections [4.1](#) and [4.3](#)), and in Application [29/660,112](#) the examiner required cancellation of an appendix that the specification, as it appears in the file, did not mention (Section [4.8](#)). An unreferenced appendix is therefore not immune from objection.

4.1 Appendix Incorporation Creates § 112 Indefiniteness as to Claim Scope

In Application [29/904,863](#) (vehicle taillamp), the specification stated that an appendix of digital images was "[i]ncorporated by reference herein." The examiner treated the appendix as part of the formal disclosure and rejected the claim under § 112(a) and (b) because it was unclear whether the claim covered the appendix images, and because the appendix language referred to embodiments and modified forms not shown in the drawings. The examiner recommended canceling the incorporation statement. The applicant deleted the statement and amended the drawings, but stated that it was "not cancelling the Appendix, which is part of the application file and may be used as a basis for amendments to the drawings during prosecution." A Notice of Allowance followed. Application [29/903,635](#) (vehicle headlamp, same applicant) followed the same course. Rule 3.1, Rule 3.2, Rule 3.3, Rule 3.4.

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

In Application [29/902,119](#) (display screen with graphical user interface), the specification stated that an appendix depicting display screens with user interfaces incorporating the design was included with the filing, and that the paragraph was "to be removed once the application is in a condition for allowance." The examiner objected "because statements which describe or suggest

other embodiments of the claimed design not shown in the drawings are not permitted" and required the statement to be canceled. The applicant canceled it, and the application issued as D1,110,338. Rule 3.1, Rule 3.2, Rule 3.5.

4.3 Specification Reference to Appendix Embodiments Treated as Broadening the Claim

In Application [29/946,074](#) (beverage container cap), the appendix contained 32 unclaimed figures, described as "additional drawings and renderings" of the cap, and the specification stated that "[a]dditional views and embodiments" of the design were shown in the appendix. The examiner objected to the specification and rejected the claim under § 112, finding that the statement broadened the claim to designs not shown. The examiner separately identified language in the appendix itself as an "impermissible disclaimer that is considered indefinite and non-enabled," which "places the drawings and Specification in conflict." The examiner noted that the appendix "may form antecedent basis for certain amendments" but "may not constitute a part of the disclosure," and that the applicant "may cancel the Appendix." The applicant removed the reference to the appendix from the specification; the file does not show that the appendix itself was canceled. The record therefore does not establish that deleting the specification reference alone would have cured every concern identified in the office action. The application issued as D1,110,110. Rule 3.2, Rule 3.4, Rule 3.5.

4.4 Unreferenced Appendix Noted Without Objection

In Application [29/917,737](#) (vaping device), the examiner noted that the appendix "is understood to form no part of the claim or its disclosure" and that, "although the appendix may form antecedent basis for certain amendments to the application, it may not constitute a part of the drawing disclosure." The examiner raised no objection or rejection based on the appendix, and did not require restriction between the two embodiments shown in the drawings, citing *In re Rubinfeld*. The application issued as D1,110,595. Rule 3.1, Rule 3.4.

4.5 Appendix Deleted by Preliminary Amendment Before Examination

In Application [29/881,173](#), the application as filed included 168 figures and an appendix, incorporated by reference, of alternative figures of electronic devices, stands, and mounts. By a preliminary amendment, the applicant canceled Figures 1-160 and deleted the appendix. The examiner acknowledged the amendment as received after the filing date but before examination, noted that it was therefore "NOT part of the original disclosure," and raised no appendix issue. The application issued as D1,110,313. The deletion was voluntary, but the deleted material remains in the file history. Rule 3.4, Rule 3.7.

4.6 GUI Appendix Canceled by Preliminary Amendment

In Application [29/776,949](#) (electronic device with graphical user interface), the application as filed included Figures 1-125, Figures A-I, and an appendix of additional images incorporated by reference. By a preliminary amendment, the applicant replaced the drawings with five figures drawn from the originals and canceled the appendix. The examiner acknowledged the amendment, and the application issued as D1,110,332. The file does not show that the examiner required the cancellation. Rule 3.4, Rule 3.7.

4.7 Drawing Amendment Drew a New-Matter Objection Despite an Appendix

In Application [29/695,608](#) (cooking appliance), the specification stated that the applicant considered the disclosure to include an appendix of 40 additional figures (line drawings, photographs, and renderings), and reserved the right to amend the drawings based on it. The examiner rejected the claim under § 112(a) and (b), finding that the statement attempted "to broaden the claim's scope to include undefined types of other designs that cannot be determined from the drawings." The applicant removed the references to the appendix and amended the drawings, including by removing broken-line features. The examiner then objected to the drawing amendments as new matter because there was "no support in the original disclosure that permits the complete removal of broken line features from the drawing disclosure." The application was later allowed. Rule 3.2, Rule 3.4.

4.8 Unreferenced Appendix Required to Be Canceled

In Application [29/660,112](#) (fluid applicator tip), the specification as it appears in the file does not mention the appendix. The examiner nonetheless stated: "The application is improper because it contains appendices. The appendices in the application must be cancelled." The office action gives no further reason. The applicant canceled the appendix, and the application was later abandoned for failure to reply to a later Office letter. Rule 3.1, Rule 3.5.

4.9 Appendix Feature Could Not Be Applied to New Embodiments

In Application [29/883,057](#) (vaping device), the applicant added three embodiments by preliminary amendment, arguing that a transparent window shown in the appendix supported them. The examiner disagreed: the appendix showed the window only on two other embodiments, and "the appendix does not show this feature applied to such designs as embodiments four, five and six." The examiner concluded that "applying such a 'feature' to other embodiments/designs that were not disclosed in either the original papers or the appendix is not supported." The applicant canceled the added figures, and the application issued as D1,094,862. Rule 3.4.

4.10 Examiners Accepted Appendix Support for Priority and Drawing Amendments

Examiners have accepted appendix images as support in several applications. In Application [29/962,418](#) (garment), the examiner found that "[b]asis for a continuation under 35 U.S.C. 120 is supported by the appendix originally filed in" parent Application [29/813,813](#), while noting that "[t]he question of patentability rests upon that which is shown and described in the drawing disclosure and specification, not what is shown and described within the appendix." It issued as D1,087,532. In Application [29/961,689](#) (automobile), amended drawings adding side-door contouring were found "supported by the appendix (12/18/2023) filed in the parent application" (see Section [3.8](#) for the double patenting rejection in the same action); it issued as D1,123,720. In Application [29/725,758](#) (welding machine), the examiner accepted removal of a detail as "supported by the appendix dated 02/27/2020 as not being visible in the appendix views." In Application [29/936,079](#) (vaping device), proposed figure amendments were "found to be supported by the appendix and acceptable by the examiner, though no exact agreements were made," at an interview; it issued as D1,135,082. These are examiner determinations, not holdings, and each turned on what the particular appendix showed. Rule 3.4.

5. Practice and Enforcement Notes

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

In the prosecution histories reviewed for this guide, examiners appeared to accept appendices that did not affect claim interpretation, and reference material such as CAD drawings, photographs, or supplemental context filed without specification cross-reference did not draw the kind of examiner attention described in Section [4](#). See, e.g., Applications [29/917,737](#) (examiner noted that the appendix formed no part of the claim or its disclosure, without objection); [29/929,866](#) (examiner advising that a photograph showing unclaimed areas "may be filed as an appendix but should not be included in the specification"); [29/989,952](#) (examiner's amendment canceling a specification paragraph about an appendix of CAD images of the same design because "the appendix will not be part of the published patent"; issued as D1,142,316). *But see* Application [29/660,112](#) (Section [4.8](#)). These are observations from practice, not MPEP rules, and image appendices remain a practice-based option requiring case-specific assessment. The risk profile rises sharply when appendix content appears to depict alternative designs or explain claim scope.

5.2 Appendix Removal Without Continuation May Be Substantive, Not Merely Cosmetic

In the applications reviewed for this guide, examiners allowed cases after the specification's references to the appendix were removed, and in two of them applicants deleted the appendix voluntarily by preliminary amendment. In others, applicants removed the reference while

expressly keeping the appendix as possible support for amendments (Applications [29/903,635](#); [29/904,863](#)). Practitioners should treat appendix removal, particularly of content depicting design alternatives, as a potentially substantive event that an accused infringer may characterize as narrowing, not a clerical fix. Before canceling appendix content with independent commercial value, evaluate whether a continuation or divisional should be filed.

5.3 Brief Counterargument to the Disclosure-Dedication Argument

Practitioners faced with an argument that material in the appendix has been dedicated to the public might argue as follows: The disclosure-dedication doctrine should not be applied to appendix material in design patent applications. That doctrine arises from utility patent jurisprudence on the doctrine of equivalents and presupposes an attempt to recapture unclaimed subject matter through equivalents. *Johnson & Johnston Assocs. Inc. v. R.E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002) (en banc). Design patents operate under a fundamentally different framework, in which claim scope is defined exclusively by the drawings and evaluated under the ordinary observer test. Because that test already reaches designs that are substantially the same rather than identical, design patent infringement does not depend on a doctrine of equivalents for disclosure-dedication to limit. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc). Appendix material that is never incorporated into the drawings, never relied upon for allowance, and later removed for procedural compliance was not disclosed as an alternative with the specificity the doctrine requires, see *PSC Computer Prods., Inc. v. Foxconn Int'l, Inc.*, 355 F.3d 1353 (Fed. Cir. 2004), and its removal to satisfy an objection to form is not a surrender for reasons of patentability, which estoppel requires, see *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694 (Fed. Cir. 2014); *Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co.*, 898 F.3d 1210 (Fed. Cir. 2018), nor an argument distinguishing prior art of the kind that produced disclaimer in *Top Brand LLC v. Cozy Comfort Co.*, 143 F.4th 1349 (Fed. Cir. 2025). Absent controlling precedent extending disclosure-dedication doctrine to design patents, appendix disclosures should be treated as latent support material and not as subject matter irrevocably dedicated to the public.

Appendix 1 – Checklist

A. Pre-Filing Checklist

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

- ☐ Does the appendix serve a legitimate, identifiable purpose (e.g., CAD reference, photographic clarification, written description support)?

- ☐ Does the appendix contain drawings or images that differ in overall visual impression from the main drawing set? (If yes, evaluate whether a continuation or divisional is preferable.)
- ☐ Does the appendix describe alternative embodiments, variations, or configurations not shown in the drawings? (If yes, the risk profile is elevated.)
- ☐ Is the appendix being included solely for original written description support, rather than to define or explain the claimed design?
- ☐ Have you considered whether an accused infringer could argue that the appendix content was disclaimed or dedicated to the public if not pursued in a continuation or divisional?
- ☐ If continuation or divisional filings are anticipated from appendix content, has the obviousness and double patenting exposure of those claims been evaluated under the post-[LKQ](#) framework?

B. Drafting Checklist

If an appendix is included:

- ☐ File the appendix as a separate paper, not embedded in the specification
- ☐ Avoid any reference to the appendix in the specification or claim language
- ☐ Do not use incorporation-by-reference language
- ☐ Do not suggest that appendix content defines, clarifies, or supplements the drawings in a claim-relevant way
- ☐ Assume the appendix will remain part of the prosecution record for all future purposes, but do not assume it will supply written description support; that must be assessed claim by claim (see Section [3.4](#))

C. Prosecution Checklist

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

- ☐ Immediately assess whether the appendix is creating indefiniteness, multiple-embodiment, or scope-clarity issues
- ☐ Remove all specification references to the appendix if required
- ☐ Consider whether an accused infringer could characterize cancellation of the appendix as an implicit election or disclaimer
- ☐ Before canceling, evaluate whether a continuation or divisional should be filed to preserve rights in the appendix content
- ☐ Treat appendix removal as potentially substantive, not a clerical correction

- ☐ Evaluate potential prosecution history estoppel or disclaimer risks (e.g., [Pacific Coast Marine](#); [Advantek](#)) before canceling any appendix material

D. Post-Allowance Checklist

After allowance following appendix removal:

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

Appendix 2 – Questions and Answers

Q1. Are appendices allowed in design patent applications?

Yes. The MPEP permits an optional description of the design in a separate paper, and appendices are filed in practice, although the MPEP does not address appendices by name or expressly approve image appendices. See [MPEP § 1503.01](#), subsection II; *Ex parte Spiegel*, 1919 C.D. 112. Procedural permissibility does not eliminate the substantive risks discussed in this guide, which depend primarily on the content and purpose of the appendix.

Q2. What are legitimate uses for an appendix?

Practice-based uses, each requiring case-specific assessment, include: (1) CAD drawings submitted to support interpretation of line drawing contours or shading; (2) photographs of physical prototypes showing surface transitions or proportions (subject to the drawing-medium caveat in [Section 1.1](#)); (3) color or texture reference material not shown in the formal black-and-white drawings (subject to the color caveat in [Section 1.1](#)); (4) possible written description support for anticipated continuation or divisional filings; and (5) technical or manufacturing specifications that do not define ornamental scope.

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

Possibly, if the appendix depicts visually distinct designs or alternative embodiments, although most examiner objections and rejections in the prosecution histories reviewed for this guide arose from specification references to the appendix (see [Section 4.8](#) for an exception). Reference

material that mirrors the formal drawing disclosure (such as CAD renderings of the same design) carries much lower risk. Appendices that introduce independent design variants may be more likely to attract examiner concern even without specification cross-reference.

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

It depends on the nature of the explanation. Reference material such as CAD drawings that provide a three-dimensional basis for understanding line drawing contours, can provide useful context without defining claim boundaries. An appendix may not be used to define claim scope or clarify surface transitions that are genuinely ambiguous in the formal drawings. If claim clarity depends on the appendix, the examiner may require amendment, but an amendment cannot add new matter, and incorporation alone will not cure a deficient drawing disclosure.

Q5. Does appendix material automatically limit the claim?

No. Appendix material does not automatically become claim-limiting. However, an accused infringer may argue prosecution history disclaimer or estoppel based on it, even if it never formally becomes part of the claim. Both doctrines apply to design patents (see Section 3.7). This is particularly true for appendices depicting alternative design embodiments that are later canceled.

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

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

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

As part of the prosecution record, yes. Appendix material that was properly part of the original application remains in the record after cancellation. Cancellation does not erase it or eliminate its potential relevance for estoppel, dedication, or claim construction arguments. Whether it supplies written description support for a later claim is a separate question, assessed claim by claim, and no reported decision has addressed appendix images specifically.

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

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

on whether the material was properly part of the original application and clearly conveys possession of the particular later-claimed design, and priority and new matter must be assessed claim by claim. No reported decision has addressed whether appendix images, as opposed to formal drawings, supply that support.

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

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

Q10. When is an appendix most advisable?

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

Q11. What is the safest default rule for practitioners?

Understand the purpose of the appendix before filing it. If it serves a legitimate reference or support function and does not depict independent design alternatives, it can generally be filed with lower risk after a case-specific assessment. If it discloses alternative designs, evaluate whether a separate filing is preferable. If you do file an appendix with alternative designs, do not cancel it without first considering whether a continuation or divisional is warranted.

Appendix 3 – Limitations

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

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

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

2. Examiner Practice May Vary

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

3. No Guarantee of Examination or Litigation Outcomes

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

4. Limited Treatment of Post-Grant and Litigation Issues

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

5. No Substitute for Case-Specific Legal Judgment

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

6. Examples Are Illustrative, Not Exhaustive

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

7. This Guide Does Not Discourage Appendix Use Categorically

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

8. Subject to Change in Law and Practice

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

9. Professional Responsibility

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

10. Intended Use

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

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

MPEP § 1503.01 – Specification [R-01.2024]

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

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

Case Law

Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC, 739 F.3d 694 (Fed. Cir. 2014) – Holds that prosecution history estoppel principles apply to design patents where embodiments are canceled in response to a restriction requirement, but reverses the estoppel-based noninfringement judgment because the accused three-hole design was not within the surrender.

Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co., 898 F.3d 1210 (Fed. Cir. 2018) – Reverses a holding that prosecution history estoppel barred infringement; the patentee's election of the kennel structure without a cover did not surrender coverage of an accused kennel embodying that structure.

In re Rubinfield, 270 F.2d 391 (CCPA 1959) – Rejects a blanket ban on showing more than one embodiment in a design application where the embodiments involve a single inventive concept.

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

Richardson v. Stanley Works, Inc., 597 F.3d 1288 (Fed. Cir. 2010) – Addresses design patent claim construction, including factoring out functional elements, and the ordinary observer test. Background authority, not a rule about appendices.

Ethicon Endo-Surgery, Inc. v. Covidien, Inc., 796 F.3d 1312 (Fed. Cir. 2015) – Addresses design patent functionality and claim construction. Background authority, not a rule about appendices.

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

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

Curver Luxembourg, SARL v. Home Expressions Inc., 938 F.3d 1334 (Fed. Cir. 2019) – Relies on amendments to the title, claim, and figure descriptions made during prosecution to limit design patent scope to the article recited; not an appendix case.

In re Daniels, 144 F.3d 1452 (Fed. Cir. 1998) – Addresses written description support in a parent application for amended design drawings; does not address appendix images.

In re Owens, 710 F.3d 1362 (Fed. Cir. 2013) – Applies the written description requirement to a continuation design claim; disclosure of a whole design does not necessarily show possession of a newly bounded part of it.

Maxwell v. J. Baker, Inc., 86 F.3d 1098 (Fed. Cir. 1996) – Applies the disclosure-dedication rule to subject matter disclosed but not claimed (utility patent).

Top Brand LLC v. Cozy Comfort Co., 143 F.4th 1349 (Fed. Cir. 2025) – Holds that prosecution history disclaimer applies to design patents and can arise from arguments distinguishing prior art as well as from amendments; not an appendix case.

In re Maatita, 900 F.3d 1369 (Fed. Cir. 2018) – States the indefiniteness standard for design patents, judged from the perspective of an ordinary observer.

Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991) – Drawings in an earlier design application can provide written description support for later claims, depending on what they convey; does not address appendices.

Ex parte Carrigan, Appeal No. 2021-001189 (PTAB 2021) (non-precedential) – In reversing an obviousness rejection, refers to a color image from the application's appendix in describing the claimed design, without deciding the appendix's status.

PSC Computer Prods., Inc. v. Foxconn Int'l, Inc., 355 F.3d 1353 (Fed. Cir. 2004) – The disclosure must be specific enough that one of ordinary skill could identify the subject matter disclosed and not claimed (utility patent).