

Design Patent ProGuide – Declarations Under 1.132 (Functionality and Ornamentality)

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Cases, MPEP form paragraphs, statutes and the 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:

- Treat the § 1.132 declaration as sworn evidence that will be read twice: by the examiner now and by an accused infringer later
- Identify which kind of § 171 rejection was made (primarily functional, or hidden in use) and answer that theory directly
- Have the declaration signed by the designer or by a representative of the company that commissioned the design, and state that person's role in creating the claimed design
- State expressly that the declarant has personal knowledge, and the basis for it
- Explain, feature by feature, which solid-line features were chosen for their appearance and why
- Confine the testimony to the claimed portion as the drawings define it
- Show alternative designs as images and present them as evidence of design freedom
- For a hidden-in-use rejection, show a specific occasion when the design is seen, with corroborating evidence
- Identify each exhibit by label, source and date
- Compare the declaration with the related utility patents, the application itself, foreign filings and the client's marketing before it is signed

DON'T:

- Don't attribute functional advantages (grip, strength, fit, comfort, airflow, ease of use) to the claimed appearance unless necessary to answer the rejection, and then state them accurately
- Don't use absolute or negative statements the declarant cannot fully support ("any," "only," "necessary," "equally well," "serves no function")
- Don't distinguish the prior art feature by feature in the declaration
- Don't characterize broken-line or unclaimed portions beyond the context needed to explain the claimed design
- Don't offer opinions on infringement, claim scope or the functional superiority of the product
- Don't rely on bare conclusions such as "the design was created for the purpose of ornamenting"
- Don't have the inventor testify to why customers buy unless the inventor sells to or works with those customers
- Don't concede that any claimed element is dictated by function

- Don't file a declaration after a final rejection without a showing under 37 C.F.R. § 1.116(e) or an eligible continued prosecution application (requests for continued examination are not available in design applications)

1. Introduction and Theory

A declaration under 37 C.F.R. § 1.132 is the applicant's main tool for overcoming a § 171 rejection for lack of ornamentality. The MPEP is explicit that attorney argument is not a substitute for evidence, and that the rejection may be overcome by evidence from the inventor or from a representative of the company that commissioned the design. [MPEP § 1504.01\(c\)](#), subsection III.

This ProGuide addresses § 1.132 declarations filed to answer § 171 rejections for lack of ornamentality, whether the examiner contends the design is primarily functional or that it is not visible in its normal and intended use. It does not address § 1.132 declarations offered on obviousness, such as evidence of commercial success, copying or the views of a designer of ordinary skill. Those declarations have different requirements and are reserved for a later section (see Section 5.8).

These declarations are read by two audiences. The examiner reads the declaration to decide whether the claimed design was "created for the purpose of ornamenting." Years later, an accused infringer reads the same declaration looking for admissions that claimed features are functional, so that a court will discount them in claim construction or in the infringement comparison. Courts have relied on a patentee's own statements in utility patents and advertising for exactly that purpose. [Sport Dimension, Inc. v. Coleman Co.](#), 820 F.3d 1316 (Fed. Cir. 2016); [Range of Motion Prods., LLC v. Armaid Co.](#), 166 F.4th 981 (Fed. Cir. 2026). A sworn statement by the designer in the file history of the patent itself is at least as useful to an accused infringer.

The drafting problem is therefore two-sided. A declaration that is too general fails in prosecution, because examiners require a specific, feature-by-feature explanation backed by evidence. A declaration that emphasizes functional advantages may fail to establish ornamentality, and may create statements that later affect claim construction or the infringement comparison. The rules in this ProGuide are aimed at the space between: specific facts about why the design looks the way it does, stated by someone who knows, without functional characterizations of the claimed features.

The rules are drawn from design applications in which a § 171 rejection drew a § 1.132 declaration, from PTAB decisions, and from litigation in which prosecution statements were

later used against the patentee. Application numbers are cited so the practitioner can review the file histories.

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

2. Recommended Form

A § 1.132 ornamentality declaration should be short, factual and confined to the claimed design. Two to four pages of sworn narrative is usually enough; exhibits are additional.

2.1 Core Contents and Recommended Foundation

This list combines a formal declaration requirement (item 10, 37 C.F.R. § 1.68) with recommended contents that examiners look for and evidence that depends on the rejection and the facts. Not every item applies in every case; consult the cited rule.

1. Identity and role of the declarant. The declarant's name, position, and relationship to the applicant, and the declarant's role in creating the claimed design (designer, joint inventor, or representative of the company that commissioned the design). Rule 3.4.
2. Personal knowledge. An express statement that the declarant has personal knowledge of the facts stated, followed by the basis for that knowledge. Rule 3.5.
3. Relationship and interest. A plain statement of the declarant's employment or contractor status and any compensation for the declaration. Rule 3.7.
4. The rejection being answered. Identification of the Office action and the § 171 theory relied on (primarily functional, or not visible in normal use). Rule 3.2.
5. The claimed portion. A statement that the testimony concerns the claimed design as shown in solid lines, referring to portions shown in broken lines only as needed for context. Rule 3.9.
6. Ornamental considerations, feature by feature. The ornamental considerations that entered into the design, and which visible features of the claimed design meet them. [MPEP Form Paragraphs 15.08 and 15.08.01](#). Rule 3.8.
7. Design freedom. Alternative configurations that were considered or that exist, shown as images, presented as evidence that the appearance was not dictated by function. Rule 3.11.
8. Visibility during normal and intended use (hidden-in-use rejections). An occasion after completion of manufacture or assembly and before ultimate destruction, loss or

disappearance when the appearance is observed in a manner showing that ornamentality is a matter of concern, with corroborating evidence, dated where possible. Rule 3.12.

9. Exhibits. Each exhibit identified by label, described, and authenticated, with its source and date. Rule 3.13.

10. Declaration language. The two statements required by 37 C.F.R. § 1.68, and a proper signature. Rule 3.3.

2.2 Drafting Approach

Write about why the design looks the way it does, not about what its features do. Each paragraph should answer one question: who decided, what visible feature, what appearance was sought, and what else could have been done. Address function and performance only as far as the rejection requires, leave legal argument and prior art analysis to the remarks, and review both for limiting representations.

The best source material is the designer's own record: sketches, rejected concepts, and notes on why one appearance was chosen over another. Designers should keep these as they work. Where cost or performance pointed one way and appearance won, that choice is strong evidence and worth stating.

2.3 Preferred Phrasing

The left column lists phrasing that tends to create risk; the right column lists phrasing that makes the same point more safely.

Avoid	Prefer
"The design could have taken any form."	"The functional requirements of the article did not require this appearance."
"Other designs work equally well."	"Other configurations could have served the same function."
"The edge is contoured to improve grip."	"I chose a continuous contour along the edge because of how it looks from the front and side."
"The only reason for this shape was appearance."	"Appearance was the main consideration in choosing this shape."
"The design is ornamental." (standing alone)	"I chose [feature] because [appearance reason], as shown in Exhibit B."
"Unlike the cited reference, our design has X."	Leave comparisons with the prior art to the remarks.
"Customers buy it because of how it looks." (from the designer)	A declaration from a customer, or from a person who sells to customers, stating what that person knows.

Avoid	Prefer
"The design is not purely functional."	"The design is primarily ornamental," or quote the MPEP's language exactly when relying on it.
"No other design was considered."	State only what the declarant knows was considered.

2.4 Sample Declaration Language

DECLARATION UNDER 37 C.F.R. § 1.132

I, [NAME], declare that:

1. I am [POSITION] at [COMPANY] ("[SHORT NAME]"), the assignee of U.S. Design Patent Application No. [APP NO.] (the "Application"). [I am a named inventor of the claimed design.] [I am the representative of [COMPANY], which commissioned the design, responsible for [ROLE].]
2. I have personal knowledge of the facts stated below. They are based on [my own design decisions in developing the claimed appearance / my participation in the design review meetings in which the appearance was selected / other basis].
3. [I am employed by [COMPANY].] [I provide services to [COMPANY] as an independent contractor.] [I am / am not compensated for my time in preparing this declaration.]
4. I have read the Office action dated [DATE], which rejects the claim under [35 U.S.C. § 171](#) on the ground that [STATE THE EXAMINER'S THEORY IN NEUTRAL TERMS].
5. My testimony concerns the claimed design as shown in solid lines in the drawings of the Application. I refer to portions shown in broken lines only for context. Nothing in this declaration is intended to describe, define or limit the scope of the claimed design, which is defined by the drawings.
6. The ornamental considerations that entered into the design were [e.g., a distinctive and recognizable appearance for the product line, a unified look with related products, a particular visual impression]. [STATE THE BUSINESS REASON IF TRUE: e.g., to increase demand for the product and develop consumer recognition.]
7. The following visible features of the claimed design were chosen to meet those considerations: (a) [FEATURE], which I chose because [APPEARANCE REASON]; (b) [FEATURE], which I chose because [APPEARANCE REASON]. [Add one entry per feature.]

8. Other configurations could have served the same function. Exhibit A shows [NUMBER] alternative configurations that [were considered during development / appear in [SOURCE, DATE]]. The functional requirements of the article did not require the appearance shown in the Application.
9. [Hidden-in-use rejections only:] The claimed design is seen by purchasers and users [during sale / on the product packaging / during installation / during replacement / on another identified occasion after completion of manufacture or assembly]. Exhibit B is [DESCRIPTION], [obtained from / captured on] [SOURCE] on [DATE], and is a true and accurate copy.
10. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: _____

Signature: _____

[NAME], [TITLE]

2.5 Decision Tree

Should I answer the § 171 rejection with a § 1.132 declaration?

1. Is the rejection supported by evidence, such as the appearance of the design, a utility patent, the specification or a brochure?
 - NO → Argue that no prima facie case was made ([MPEP § 1504.01\(c\)](#), subsection II). Consider filing a declaration anyway if the examiner is likely to supply evidence in the next action.
 - YES → Continue to #2.
2. Can the designer or a representative of the commissioning company testify, from personal knowledge, to specific appearance-driven choices?
 - NO → A declaration is unlikely to succeed. Consider amending to a portion of the design that was chosen for appearance, or a different claim strategy.
 - YES → Continue to #3.
3. Is the rejection based on lack of visibility in normal use?

- YES → Gather evidence, dated where possible, of an occasion when the design is seen. Without visibility evidence, the declaration is unlikely to overcome the rejection. Continue to #4.
 - NO → Continue to #4.
4. Do the related utility patents, the application itself, foreign filings or the client's marketing describe the claimed features in functional terms?
- YES → Investigate the statements and any apparent inconsistency. State the relevant facts accurately, explain material distinctions, and evaluate disclosure obligations under Rule 3.18. Avoid unnecessary repetition of functional characterizations, but do not alter truthful testimony merely to conform to an earlier statement. Expect the examiner to cite them.
 - NO → Continue to #5.
5. Is the application under final rejection?
- YES → File with a showing under 37 C.F.R. § 1.116(e), or consider an eligible continued prosecution application under § 1.53(d) (Rule 3.20). A request for continued examination is not available.
 - NO → File with the response.

3. Rules and Guidance for Declarations Under 1.132 (Functionality and Ornamentality)

Part A. Evidence and Responsiveness

3.1 The Declaration Is Evidence; Attorney Argument Is Not

Once the examiner makes a prima facie case of lack of ornamentality, the burden of coming forward shifts to the applicant, and attorney arguments are not a substitute for evidence. [MPEP § 1504.01\(c\)](#), subsection III; Ex parte Webb, 30 USPQ2d 1064, 1067-68 (Bd. Pat. App. & Int. 1993). Facts about the design process stated only in the remarks will be treated as argument. Every fact the response relies on should appear in the sworn declaration or in an exhibit the declaration incorporates.

Prosecution history support: Application [29/878,512](#) (examiner repeated that attorney arguments are not a substitute for evidence before accepting an inventor declaration).

3.2 Identify the Theory of the Rejection and Answer It

Section 171 ornamentality rejections fall into two categories: (A) a design visible in its end use that is primarily functional, and (B) a design not visible in its normal and intended use, offered as evidence that its appearance is not a matter of concern. [MPEP § 1504.01\(c\)](#), subsection III. The declaration should identify which theory was applied and answer it directly. For a category (B) rejection, the MPEP calls for two kinds of evidence: evidence of a period in the commercial life of the article when its appearance matters, and a declaration showing "thought of ornament." [MPEP Form Paragraph 15.08.01](#). A declaration that answers only one of the two will not overcome the rejection.

Where the examiner's case rests on a particular source, such as the applicant's utility patent, specification or product page, the declaration should account for the appearance-related facts without debating the source's functional statements.

Prosecution history support: Application [29/863,360](#) (interview summary noting that the proposed declaration did not address the examiner's argument directly). Application [29/865,470](#) (examiner's case relied on the applicant's own PCT publication and on the fan being hidden in use; a declaration answering both overcame the § 171 rejection).

3.3 Formal Requirements

The declaration must comply with 37 C.F.R. § 1.68. The declarant must be warned, on the same document, that willful false statements are punishable under 18 U.S.C. § 1001 and may jeopardize the validity of the application or any patent issuing on it, and must state that statements of the declarant's own knowledge are true and statements on information and belief are believed to be true. Both elements are required. An S-signature must comply with 37 C.F.R. § 1.4(d)(2).

Prosecution history support: Application [29/863,360](#) (interview summary noting that the proposed declaration was missing the signed willful false statement warning).

Part B. Declarant and Foundation

3.4 The Declarant Should Be the Designer or a Representative of the Commissioning Company

The MPEP provides that a § 171 rejection may be overcome by evidence from the inventor or from a representative of the company that commissioned the design, stating the motivating factors behind the creation of the design. [MPEP § 1504.01\(c\)](#), subsections III and IV(A), (D). The declaration should state the declarant's role in creating the claimed design. A named

inventor is the usual declarant. A non-inventor company representative may also succeed where the declaration explains the ornamental considerations and how the design is seen.

Outside industry witnesses can corroborate the designer's account, for example by explaining how the design is perceived in the market, but they cannot supply the designer's motivating factors.

Prosecution history support: Application [29/918,931](#) (declaration by the company's design intellectual property manager, not a named inventor, accepted). Applications [29/683,965](#) and [29/683,966](#) (examiner first found the inventor's declaration insufficient, citing Power Controls for the point that only the applicant or a representative of the commissioning company can provide evidence of motivating factors; the claims were allowed after the applicant added declarations from three bottle-packaging industry participants and evidence of alternative designs). Application [29/734,075](#) (response including a declaration by a named inventor whose current role was marketing overcame the rejection).

3.5 State Personal Knowledge and Its Basis Expressly

The declaration should say, in so many words, that the declarant has personal knowledge of the facts stated, and then explain the basis: the declarant's own design decisions, participation in design reviews, or direct involvement in sales. A description of the declarant's participation that only implies personal knowledge leaves a gap the examiner, or later an accused infringer, can exploit.

3.6 Statements About Why Customers Buy Require a Competent Declarant

Unless the declarant is directly involved with the sale of the design or works with its users, he or she cannot provide factual evidence of the reasons for purchase. [MPEP § 1504.01\(c\)](#), subsection V (citing MPEP § 716.03(b) and *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996)). Evidence that appearance matters to purchasers should come from customers or users, or from a declarant who sells to or works with them and says so.

Prosecution history support: Application [29/911,657](#) (examiner explained the limits of the inventor's testimony about purchasers and invited customer or user declarations; the applicant added a declaration from a company director who regularly works with customers, and the claim was allowed). Application [29/866,288](#) (declaration from a service consultant in close contact with customers, with evidence that appearance matters when bedding is purchased, overcame a hidden-in-use rejection).

3.7 Disclose the Declarant's Relationship and Interest

The declaration should state plainly whether the declarant is an employee, contractor or owner, and whether the declarant is compensated for the declaration. No regulation requires this statement in a § 1.132 declaration, but omitting an interest the opposing party later discovers invites an inequitable conduct theory. In [Luv N' Care, Ltd. v. Laurain](#), 98 F.4th 1081 (Fed. Cir. 2024), the accused infringer faulted declarations for failing to disclose the declarants' financial interests, and the court noted that intent is measured by the applicant's intent, not the declarants'. The court vacated and remanded for further findings; it did not hold that failing to disclose compensation is itself inequitable conduct. Stating the relationship costs nothing.

Part C. Content

3.8 Explain Specifically and in Depth Which Features Were Chosen for Appearance

The declaration should explain, "specifically and in depth, which features or area of the claimed design were created with" a concern for saleable value or demand, or primarily for appearance. [MPEP § 1504.01\(c\)](#), subsection IV(A). The MPEP form paragraphs ask for two things: the ornamental considerations that entered into the design, and identification of what aspects of the design meet them. [MPEP Form Paragraphs 15.08 and 15.08.01](#). Name each visible solid-line feature and give the appearance reason for it. A list of features with reasons is far more persuasive than a general statement of aesthetic intent.

Prosecution history support: Application [29/839,637](#) (declaration identified specific aesthetic features of the mating interfaces; examiner found it established that the design was created to enhance demand through a recognizable appearance). Application [29/837,405](#) (declaration explaining that a stepped profile was chosen for its appearance accepted). Application [29/797,856](#) (declaration explaining deliberate appearance choices for an aftermarket accessory credited). Applications [29/878,511](#) and [29/878,512](#) (declaration describing the inventor's ornamental considerations found persuasive). Application [29/911,657](#) (examiner first found the inventor's declaration did not explain in depth why the features were created for the purpose of ornamenting; a revised declaration stating the motivating factors and identifying the features that met them was accepted).

3.9 Confine the Testimony to the Claimed Portion

The declaration should state that it concerns the claimed design as shown in solid lines and should focus the ornamentality showing there. Refer to portions shown in broken lines only as needed for context, and do not attribute purposes to them. Statements about unclaimed portions add little to the ornamentality showing and can later be read as statements about scope.

3.10 Facts, Not Conclusions

Statements that the design "is ornamental" or "was created for the purpose of ornamenting" are legal conclusions. They may close a declaration but cannot carry it. There must be some clear and specific indication of the ornamentality of the design in the evidence for it to be given probative weight. [MPEP § 1504.01\(c\)](#), subsection V (citing [Berry Sterling Corp. v. Pescor Plastics, Inc.](#), 122 F.3d 1452 (Fed. Cir. 1997)).

Prosecution history support: Application [29/702,680](#) (examiner applied the "clear and specific indication" standard in a final rejection; the claim was later allowed in a continued prosecution application).

3.11 Present Alternative Designs as Evidence of Design Freedom

Where the rejection asserts that the design is dictated by function, the applicant may show alternative designs that could have served the same function. [MPEP § 1504.01\(c\)](#), subsection IV(E) (citing [L.A. Gear, Inc. v. Thom McAn Shoe Co.](#), 988 F.2d 1117 (Fed. Cir. 1993)). The Federal Circuit treats alternative designs as an important, if not dispositive, factor. [Ethicon Endo-Surgery, Inc. v. Covidien, Inc.](#), 796 F.3d 1312 (Fed. Cir. 2015). One district court found that un rebutted evidence of alternative designs "strongly suggests that the claim elements are not purely functional or dictated by function." [Apple Inc. v. Masimo Corp.](#), 2024 U.S. Dist. LEXIS 185270 (D. Del. Oct. 10, 2024). Show the alternatives as images, preferably concepts the designer actually considered or the applicant's own related applications, and explain and support why they provide the same or similar functional capabilities (Rule 3.14).

Examiners have also stated that the mere existence of alternatives is not dispositive, because alternatives may improve utility without regard to appearance. Pair the alternatives with the designer's explanation of why the claimed appearance was chosen among them.

Prosecution history support: Applications [29/652,149](#) and [29/652,150](#) (declarations relying on alternative designs claimed in co-pending applications accepted). Application [29/752,962](#) (concurrently filed alternative design with the same function and a different appearance, with visibility evidence, accepted). Application [29/837,405](#) (examiner first stated that alternatives alone are not dispositive, then accepted a declaration explaining the appearance choice). [Ex parte Cantor](#), Appeal No. 2024-000008 (PTAB June 18, 2024), Application [29/690,145](#) (Board reversed, relying on an inventor declaration and on alternative arrangements that would change the overall appearance).

3.12 For Hidden-in-Use Rejections, Prove a Specific Point of Visibility

Normal and intended use begins after completion of manufacture or assembly and ends with the article's ultimate destruction, loss or disappearance. [In re Webb](#), 916 F.2d 1553, 1557-58

(Fed. Cir. 1990). For a hidden-in-use rejection, identify an occasion in that period when the article's appearance is observed in a way that shows its ornamentality is a matter of concern. [MPEP § 1504.01\(c\)](#), subsections IV(F) and V. The declaration should identify the point (sale, display, packaging, installation, replacement), describe what the purchaser or user sees, and attach corroborating evidence, dated where possible. Visibility alone does not establish ornamentality, so this evidence must be paired with the feature-by-feature explanation under Rule 3.8.

Prosecution history support: Application [29/752,962](#) (photographs of the panel in a warehouse, visible to purchasers). Application [29/918,931](#) (video stills showing the connector seen by consumers during installation). Application [29/839,637](#) (declaration explaining that users see the interfaces when inserting the module; rejection withdrawn after a continued prosecution application). Application [29/866,288](#) (evidence that appearance matters during the purchase of bedding).

3.13 Identify and Incorporate Every Exhibit

Each exhibit should be labeled, described in the declaration, and identified by source and date, with a statement that it is a true and accurate copy. Advertisements that emphasize the ornamentality of the article are proper evidence ([MPEP § 1504.01\(c\)](#), subsection IV(B)), but display at trade shows or inclusion in catalogs, without more, is insufficient (subsection V).

Prosecution history support: Application [29/993,098](#) (response organized as a declaration, alternative-design drawings, marketplace materials and advertisements, each separately labeled).

Part D. Statements That Create Risk

3.14 Avoid Unnecessary Functional Characterizations of Claimed Features

Examiners may supplement a functionality analysis with a brochure emphasizing functional features, an analogous utility patent, or information in the specification. [MPEP § 1504.01\(c\)](#), subsection II. Courts use the same kinds of statements, by the patentee, to treat claimed features as functional and discount them in the infringement comparison. In [Dyson, Inc. v. SharkNinja Operating LLC](#), No. 14-cv-779 (N.D. Ill. Oct. 13, 2016), the court quoted the patentee's co-pending utility patent, which said the handle orientation "ensures that the user's wrist is not strained," and held the pistol-grip element functional. In [Sure Fit Home Prods., LLC v. Maytex Mills Inc.](#), No. 21-cv-2169 (S.D.N.Y. Oct. 14, 2021), the court relied on the patentee's advertisement saying the slits let the curtain be installed in seconds. A sworn statement by the designer that a claimed feature improves grip, fit, strength, comfort or ease of use is the same kind of evidence, placed in the file history of the patent.

The declaration should explain why features look the way they do. Avoid unnecessary statements attributing functional advantages to the particular claimed appearance. Where functional facts are necessary to answer the rejection, state them accurately and distinguish the article's useful purpose from the reasons for selecting its particular appearance. Support any assertion that alternative configurations provide the same or similar functional capabilities; a different shape alone is not a meaningful alternative. See *Range of Motion*, 166 F.4th 981. Never omit material facts or make the declaration misleading.

Watch for these patterns in drafts: purpose connectors tied to a feature ("allows," "so that," "enables," "serves as," "ensures," "configured to," "designed to"); benefit words (grip, stability, strength, comfort, fatigue, ergonomic, fit, airflow, drainage, durability); and testing or standards language ("tested," "standardized," "required by"). Review hedged benefit statements ("can provide," "helps") under the same standard: keep them only when relevant, accurate, supported and necessary to answer the rejection.

3.15 Avoid Absolute and Negative Statements the Declarant Cannot Fully Support

Words such as "any," "all," "only," "never," "necessary," "equally well" and "at least as" invite impeachment and can define scope. Repeated statements that claims required "only" one mode of operation supported prosecution disclaimer in *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353 (Fed. Cir. 2017). Negative statements, such as that a feature "serves no function" or that "no other design was considered," are hard for any declarant to know. An affirmatively false statement in a sworn declaration is the most serious risk, because an unmistakably false affidavit can be affirmative egregious misconduct under *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011) (en banc). State only what the declarant knows, in measured terms (see Section 2.3).

3.16 Do Not Distinguish the Prior Art Feature by Feature in the Declaration

A patentee may surrender design patent scope by its representations to the Patent Office during prosecution, not only by amendment. [Top Brand LLC v. Cozy Comfort Co.](#), 143 F.4th 1349 (Fed. Cir. 2025). In utility cases, statements in non-amendment papers such as an information disclosure statement or an inter partes review filing have supported disclaimer or estoppel. *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1304 (Fed. Cir. 1997); *Aylus*, 856 F.3d 1353. Statements in § 1.132 declarations themselves have supported prosecution history estoppel. In *Pharmacia & Upjohn Co. v. Mylan Pharmaceuticals, Inc.*, 170 F.3d 1373 (Fed. Cir. 1999), the court relied on an inventor's declaration stating that "[t]he key feature of the present invention is the particular type of lactose employed" in holding that formulations without that lactose were surrendered. See also *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325 (Fed. Cir. 2010) (using a § 1.132 declaration as intrinsic evidence of claim meaning). A § 171

declaration does not need prior art comparisons. Keep them out of the declaration. Place legal argument and prior art analysis in the remarks where appropriate, but review both the remarks and the declaration for limiting representations; Top Brand itself involved argument. Neither placement in the remarks nor a general statement of non-limiting intent (Section 2.4, paragraph 5) prevents an otherwise clear surrender of scope. Explain necessary distinctions accurately and in terms of the overall design.

3.17 Avoid Opinions on Scope, Infringement and Functional Superiority

The declaration should not opine on what the claim covers, whether any product infringes, or how the product performs compared with competitors. Distinctness from the prior art and an effort to develop consumer recognition are proper evidence of ornamentality ([MPEP § 1504.01\(c\)](#), subsection IV(C), citing [Seiko Epson Corp. v. Nu-Kote Int'l, Inc.](#), 190 F.3d 1360 (Fed. Cir. 1999)). Where competing products are shown, present them for differences in appearance. Address performance differences only when necessary to show that an alternative is meaningful, without unnecessary claims of functional superiority.

Prosecution history support: Application [29/878,514](#) (declaration presenting competitor products to show a different aesthetic impression).

3.18 Check the Declaration Against the Applicant's Other Statements

Before the declaration is signed, compare it with every statement the applicant has made about the same article: the design application's own specification and descriptive statements, foreign and priority filings, related utility patents, applications and provisionals, technical documents, product pages, packaging, advertising, and enforcement letters. Examiners cite these sources, and accused infringers seek them in discovery.

Under 37 C.F.R. § 1.56(b), information is material when it is not cumulative to information already of record or being made of record, and either establishes a prima facie case of unpatentability or "refutes, or is inconsistent with, a position the applicant takes" in opposing a rejection or asserting patentability. The duty runs to each inventor, each attorney or agent, and every other person substantively involved in the prosecution. 37 C.F.R. § 1.56(c). Investigate any apparent inconsistency. Correct inaccuracies, explain material distinctions or changed circumstances, and evaluate whether the other statement must be disclosed. Do not revise truthful testimony merely to conform to an earlier inaccurate or overbroad statement. Evaluate the disclosure duty separately from the judicial standard for inequitable conduct (Section 5.4).

Prosecution history support: Application [29/908,341](#) (examiner's prima facie case quoted the applicant's own product page; a declaration stating the design's motivating factors and showing alternative contours overcame it). Application [29/911,657](#) (examiner relied on the

applicant's corresponding utility application). Applications [29/734,075](#), [29/778,979](#), [29/928,973](#) and [29/844,399](#) (examiners quoted the applicants' own utility patents, applications or provisionals). Application [29/902,059](#) (examiner relied on the applicant's corresponding Japanese registration). Applications [29/878,514](#) and [35/513,763](#) (examiners relied on the applications' own descriptions).

3.19 Do Not Concede That Any Claimed Element Is Dictated by Function

The standard is whether the design is "primarily" functional, judged on the design as a whole. *L.A. Gear*, 988 F.2d at 1123; [MPEP § 1504.01\(c\)](#), subsection I. A design is not invalid because some elements have functional purposes. *Sport Dimension*, 820 F.3d 1316. The Board has rejected the argument that the test is "purely" or "solely" functional, and has also held that showing a component provides a function does not show that its appearance is primarily functional. [Appeal No. 2022-004479](#) (PTAB Dec. 23, 2022), Application [29/385,792](#). The MPEP's alternative-designs paragraph uses the phrase "not purely dictated by function" (subsection IV(E)); a declaration that relies on that paragraph should quote it accurately.

A concession that a particular appearance is dictated by function may affect later claim construction, but its consequences depend on the statement, the record and the design as a whole. In *Cantor* the Board reversed despite a concession about one element, but under *Ethicon* and *Sport Dimension* a conceded element is the first candidate for being discounted in claim construction. Argue the overall appearance, and address function only as far as the rejection requires (Rule 3.14).

Part E. Procedure

3.20 Declarations After Final Rejection

A declaration submitted after final rejection is not entered as of right. Under 37 C.F.R. § 1.116(e), it may be admitted on a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented, subject to the rule's timing requirements. Requests for continued examination under § 1.114 are not available in design applications or international design applications. 37 C.F.R. § 1.114(e). Where further prosecution is appropriate, consider an eligible continued prosecution application under § 1.53(d), or a continuing application under § 1.53(b). A CPA requires an eligible prior design application; it is not available where the prior application is an international design application. 37 C.F.R. § 1.53(d)(1). Watch the response and appeal deadlines; submitting after-final evidence does not by itself prevent abandonment. Reexamination decisions have refused declarations that did not respond to a newly raised issue and gave no reason for the delay. *In re Wong*, 2010 Commr. Pat. LEXIS 28

(Control No. 90/010,278); In re Fulton, 2010 Commr. Pat. LEXIS 27 (Control No. 90/008,995).

Prosecution history support: Application [29/839,637](#) (declaration filed with a continued prosecution application after a final rejection; rejection withdrawn and patent issued). Application [29/702,680](#) (continued prosecution application filed after a final rejection; claim later allowed).

3.21 Supplemental Declarations

Where an examiner identifies deficiencies, a supplemental declaration should refer to the earlier declaration, address each deficiency the examiner identified, and add any missing exhibits. An interview before filing is an efficient way to learn what the examiner considers missing.

Prosecution history support: Application [29/863,360](#) (examiner listed specific deficiencies in a proposed declaration during an interview; the claim was later allowed). Applications [29/911,657](#), [29/683,965](#) and [29/683,966](#) (supplemental declarations answering the examiner's stated deficiencies overcame rejections that the first declarations did not).

4. Applications of Rules and Guidance to Rejections

4.1 Hidden-in-Use Rejection Overcome After Final by Feature-Specific Declaration

In Application [29/839,637](#), the examiner made final a § 171 rejection on the ground that the mating interfaces of an opto-mechanical connector pair were hidden within the larger structure. The applicant filed a continued prosecution application with a declaration by the inventor, an employee of the assignee with decades of experience designing and marketing products in the field. The declaration identified specific aesthetic features of the male and female interfaces and explained that users see those interfaces when inserting the pluggable module. The examiner found the declaration established that the design was created to enhance demand by producing a recognizable appearance, withdrew the rejection, and allowed the claim. The application issued as D1,055,862. Rule 3.8. Rule 3.12. Rule 3.20.

4.2 Prima Facie Case Built on the Applicant's Own Product Page Overcome by Declaration

In Application [29/908,341](#), the examiner's prima facie case of lack of ornamentality quoted the applicant's own product page for the claimed crane outrigger pad, dated by a Wayback Machine capture, which described the contoured edge in terms of operator control. The applicant responded with an inventor declaration based on personal knowledge, stating that the

motivating factors were a distinctive appearance to enhance saleable value, increase demand and develop consumer recognition, explaining that a contoured edge was selected to meet those factors, and attaching an exhibit of alternative contour designs. The examiner found the declaration included evidence of ornamentality and withdrew the rejection. This file illustrates both how readily examiners use marketing statements and how a declaration focused on motivating factors and alternatives can answer them. Rule 3.8. Rule 3.11. Rule 3.18.

4.3 Non-Inventor Company Representative Accepted, With Installation Evidence

In Application [29/918,931](#), the declaration was signed not by the named inventor but by the person responsible for the assignee's global design prosecution and design strategy. The declaration explained the ornamental considerations reflected in the connector's contour lines, edge treatments and surface transitions, and used stills from a video shown at the interview to establish that consumers see the connector when installing the drive. The examiner found the § 171 rejection overcome by the declaration and allowed the claim. Rule 3.4. Rule 3.12. Rule 3.13.

4.4 Warehouse Photographs and a Concurrent Alternative Design

In Applications [29/752,957](#) and [29/752,962](#), the inventor's declaration attached photographs of the container panel in a warehouse, where it is visible to purchasers, and pointed to a concurrently filed alternative design that performs the same function with a different appearance. The examiner withdrew the rejection. The office actions in these files also spelled out the sales-literature type of evidence the Office wanted, which is a useful checklist for hidden-in-use responses. Rule 3.11. Rule 3.12.

4.5 Revised Declaration Overcomes Rejection Based on the Applicant's Utility Application

In Application [29/911,657](#), the examiner rejected the claim to a curtain rod component, relying in part on the applicant's corresponding utility application, which described the part's opening as shaped to mate with another part and showed it as an internal feature when assembled. The examiner found the first inventor declaration insufficient: it did not explain in depth why the features were created for the purpose of ornamenting, and the inventor could not testify to why purchasers chose the article. The examiner invited declarations from customers or users. The applicant responded with a revised inventor declaration and a declaration from a company director who regularly works with customers. The examiner then withdrew the rejection, finding that the inventor's declaration stated the motivating factors (a contemporary, modern and sophisticated appearance) and identified the features that met them. The file shows the

two-part structure of [Form Paragraph 15.08](#) working as intended. Rule 3.6. Rule 3.8. Rule 3.18. Rule 3.21.

4.6 Initial Rejection of Inventor Declaration Overcome With Supplemental Evidence

In Applications [29/683,965](#) and [29/683,966](#), the examiner first found that the appearance of a bottle strap was dictated by the bottles it holds and held the inventor's declaration insufficient, noting that the applicant had relied on its utility applications. The applicant responded with argument, declarations from three bottle-packaging industry participants, and declaration evidence addressing alternative designs and why the claimed features enhance the article's appearance and consumer appeal. The examiner then allowed both claims, describing the claimed design as a decorative arrangement of two horizontal segments and a central handle forming an octagonal shape. A first rejection of a declaration is not the end, and an article whose shape is constrained by a mating object can still be protected when the evidence identifies the appearance choices made within that constraint. Rule 3.4. Rule 3.11. Rule 3.21.

4.7 Cost Versus Appearance Choice Credited

In Application [29/797,856](#), the inventor's declaration explained that a hinge sold as an aftermarket accessory could have been made from square tubing at lower cost while performing the same function, but flat metal was chosen for its appearance, and that the tab shape could take other forms. The examiner found that the declaration explained intentional design decisions made for ornamentality and withdrew the rejection. A choice in which appearance won over cost is among the most persuasive facts a designer can offer. Rule 3.8. Rule 3.11.

4.8 Board Reverses With Credit to the Inventor Declaration

In [Ex parte Cantor](#), Appeal No. 2024-000008 (PTAB June 18, 2024) (Application [29/690,145](#)), the Board reversed a § 171 rejection of a pool safety frame. Applying the primarily functional standard to the design as a whole, the Board credited the inventors' declaration explaining appearance-driven choices in the interior grid and in the proportions of sleeves to segments, and found that alternative arrangements would change the overall appearance. The Board walked through the Berry Sterling factors and found they favored the applicant. Rule 3.8. Rule 3.11. Rule 3.19.

4.9 Applicant's Own Utility Patent Cited, Rejection Overcome

In Application [29/734,075](#), the examiner quoted the applicants' own utility patent, which described how the shape of the growing media lets the pieces entangle, as evidence that the design was dictated by function. The applicant responded with argument and a declaration

from a named inventor then working in marketing, and the examiner found the response persuasive and withdrew the rejection. The file shows that a utility patent's functional description need not be fatal if the declaration supplies specific appearance-driven facts, and that examiners will look for the utility patent. Rule 3.4. Rule 3.8. Rule 3.18.

4.10 Worked Example: Revising a Draft Before Filing

The following example comes from a recent prosecution matter, described without identifying information. A draft § 1.132 declaration prepared to answer a § 171 rejection was reviewed before signature. The review identified these issues, each of which was corrected:

- Two paragraphs said the alternative designs worked "equally well" and were "at least as practical," and that the design "could have taken any" form. These were replaced with statements that the functional requirements "did not require" the claimed appearance and that other configurations offer "the same or similar functional capabilities." Rule 3.15.
- A paragraph made a negative statement about a junction between two parts that the declarant could not fully support. The paragraph was not needed to answer the rejection and was deleted. Rule 3.15.
- An exhibit showing another patent was framed as a comparison of appearances. It was reframed as evidence of design freedom only. Rule 3.11. Rule 3.17.
- The paragraph on ornamental intent was general. A request went to the designer to identify the specific visible solid-line features and why each was chosen, and a sentence was added confining the testimony to the claimed portion. Rule 3.8. Rule 3.9.
- The foundation paragraphs did not say what the declarant actually knew, whether he was compensated, or what he had personally seen. They were revised to state his contractor status and to limit visibility testimony to what he had seen. In the revision, an express personal knowledge sentence was briefly lost and then restored. Rule 3.5. Rule 3.7. Rule 3.12.
- A bullet in the remarks relied on the applicant's related utility patent. It was removed, and a review of the utility prosecution and marketing for inconsistencies was added to the open items. Rule 3.18.

The lesson is that most risks in these declarations come from ordinary drafting habits, and a structured review before signature catches them.

5. Practice and Enforcement Notes

5.1 Write for the Second Reader

The declaration that overcomes a § 171 rejection becomes part of the intrinsic record of the patent. An accused infringer will read it alongside the related utility patents and the patentee's advertising, looking for statements that a claimed feature serves a purpose. Before signing, read the declaration as opposing counsel would and remove every functional characterization the ornamentality showing does not need.

5.2 How Courts Use Functional Statements

Functional elements are not removed from a design claim; the claim is limited to their ornamental aspects, and the factfinder focuses on what those elements contribute to the overall ornamentation. *Ethicon*, 796 F.3d 1312; *Sport Dimension*, 820 F.3d 1316; [Richardson v. Stanley Works, Inc.](#), 597 F.3d 1288 (Fed. Cir. 2010). Courts identify functional features using factors that include concomitant utility patents and advertising touting particular features as having specific utility. *Ethicon*; [Auto. Body Parts Ass'n v. Ford Global Techs., LLC](#), 930 F.3d 1314 (Fed. Cir. 2019).

The consequences can be decisive. In [Range of Motion Products, LLC v. Armaid Co.](#), 166 F.4th 981 (Fed. Cir. 2026), the court affirmed a construction that treated the shape of the arms as functional, relying in part on the patentee's own marketing statement that the arms provide significant leverage, and affirmed summary judgment of non-infringement. The court also rejected the argument that solid lines mark ornamental features and broken lines mark functional ones. Rehearing en banc was denied over a dissent. 2026 U.S. App. LEXIS 24128, 2026 WL 2318398 (Fed. Cir. Aug. 11, 2026).

5.3 Prosecution Disclaimer and Estoppel

Design patent scope may be surrendered by amendment, [Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC](#), 739 F.3d 694 (Fed. Cir. 2014), and by argument, *Top Brand*, 143 F.4th 1349. Disclaimer requires an unambiguous disavowal. *Top Brand* (citing *Grober v. Mako Prods., Inc.*, 686 F.3d 1335, 1341 (Fed. Cir. 2012)); *Avid Tech., Inc. v. Harmonic, Inc.*, 812 F.3d 1040, 1046 (Fed. Cir. 2016). The record is read as a whole. *Biogen Idec, Inc. v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1095 (Fed. Cir. 2013). Where a design patentee told the PTAB that its verbal descriptions of the designs were not proposed constructions and were not intended to modify claim scope, a district court found no clear and unambiguous disclaimer. [Apple Inc. v. Masimo Corp.](#), 2024 U.S. Dist. LEXIS 185270 (D. Del. Oct. 10, 2024).

Statements in § 1.132 declarations can affect later interpretation and enforcement of the claims. In *Pharmacia & Upjohn Co. v. Mylan Pharmaceuticals, Inc.*, 170 F.3d 1373 (Fed. Cir. 1999), the Federal Circuit relied on the inventor's § 1.132 declarations, which mirrored counsel's statement that a particular ingredient was critical, in affirming that formulations without it had been surrendered. In *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325 (Fed. Cir. 2010), the court used a § 1.132 declaration as intrinsic evidence of claim meaning. Other non-amendment papers have had similar effect (*Ekchian*, 104 F.3d at 1304 (information disclosure statement); *Aylus*, 856 F.3d 1353 (inter partes review)). For design patents, *Top Brand* establishes that prosecution representations can surrender scope. The authorities discussed here do not include a reported decision applying these doctrines to a declaration filed to overcome a design ornamentality rejection, but there is no reason to expect different treatment. Review every declaration for potentially limiting representations, and keep it about why the design was created.

5.4 Inequitable Conduct

Inequitable conduct requires but-for materiality, or affirmative egregious misconduct such as an unmistakably false affidavit, and specific intent to deceive as the single most reasonable inference. *Therasense*, 649 F.3d 1276. Before *Therasense*, the Federal Circuit described Rule 132 affidavits as inherently material because "an affidavit submitted to overcome a rejection is intended to be relied upon." *Refac Int'l, Ltd. v. Lotus Dev. Corp.*, 81 F.3d 1576, 1584 (Fed. Cir. 1996). Even under that standard, one court found a false statement in a declaration immaterial because the declaration's main point, that the product differed from the prior art, was true. *Abbott Labs. v. Sandoz, Inc.*, 529 F. Supp. 2d 893, 919-20 (N.D. Ill. 2007). The lesson for drafting is to keep every subsidiary statement as accurate as the declaration's main point. Theories based on declarations have been pleaded against design patents, including a claim that an inventor's declaration of sole inventorship was false (*Junker v. Medical Components, Inc.*, No. 13-4606 (E.D. Pa. Dec. 21, 2016), allowing the defense to proceed at the pleading stage). Under *Therasense*, they require clear and convincing proof of specific intent to deceive, a demanding standard, but defending them is costly. Consistency with the applicant's other statements (Rule 3.18) and measured, supportable language (Rule 3.15) are the best protection.

5.5 The Upside of a Strong Declaration

A factually supported prosecution declaration creates a record the patentee may invoke in later litigation. Allowance does not, however, bind a court's later analysis of functional and ornamental aspects or establish that every claimed feature is ornamental.

5.6 Build the Evidence While Designing

The strongest declarations rest on records made during design: dated sketches, rejected concepts, and notes on why one appearance was chosen over another. Designers should keep these, and should note where appearance won over cost, performance or convenience.

Advertising that emphasizes appearance is proper evidence of ornamentality; advertising that touts what a feature does is evidence of functionality. Where a related utility application is being prepared, its specification should support the utility claims without describing the design features as the only way to perform a function.

5.7 Matching and Standardized Articles

Articles whose shape is defined by a mating part, a vehicle, or an industry standard frequently draw § 171 rejections and functionality challenges in litigation. Declarations for these articles should identify the visible features that are not dictated by the mating part or standard and explain the appearance choices made within the constraints. Claiming the article without limitations drawn from a particular commercial embodiment's dimensions also helps. See *Berry Sterling*, 122 F.3d at 1455.

5.8 Reserved: Obviousness Declarations

Declarations under § 1.132 offered on obviousness, such as evidence of commercial success, copying or the views of a designer of ordinary skill, are not addressed in this edition. Two points from the authorities reviewed for this ProGuide will apply. Nexus between commercial success and a design is especially difficult to establish, and success must be attributable to the design rather than brand, performance or other factors. MPEP § 716.03(b). An inventor's opinion about why purchasers bought the product is insufficient to show nexus. In *re Huang*, 100 F.3d at 140.

Exhibit 1 (Checklist)

Use the following checklist to evaluate a § 1.132 declaration filed to overcome a § 171 rejection for lack of ornamentality. The checklist combines formal declaration requirements, applicable disclosure and procedural requirements, and recommended drafting practices. Not every item applies in every case; consult the cited rule and the circumstances of the rejection.

Formal and foundation

- ☐ Does the declaration language include both statements required by 37 C.F.R. § 1.68, and is the signature proper? (Rule 3.3)

- ☐ Is the declarant the designer, a named inventor, or a representative of the company that commissioned the design? (Rule 3.4)
- ☐ Is the declarant's role in creating the claimed design stated? (Rule 3.4)
- ☐ Does the declaration state expressly that the declarant has personal knowledge, and give its basis? (Rule 3.5)
- ☐ Are the declarant's employment or contractor status and any compensation disclosed? (Rule 3.7)

Responsiveness and content

- ☐ Does the declaration identify the Office action and the § 171 theory relied on? (Rule 3.2)
- ☐ For a hidden-in-use rejection, does it supply both visibility evidence and ornamental-intent evidence? (Rules 3.2, 3.12)
- ☐ Does it confine the testimony to the claimed portion shown in solid lines? (Rule 3.9)
- ☐ Does it state the ornamental considerations and identify, feature by feature, which visible features meet them? (Rule 3.8)
- ☐ Are conclusions supported by specific facts? (Rule 3.10)
- ☐ Are alternative designs shown as images and presented only as evidence of design freedom? (Rule 3.11)
- ☐ Is each exhibit labeled, described, and identified by source and date? (Rule 3.13)
- ☐ Are statements about why customers buy made only by customers or by a declarant who sells to or works with them? (Rule 3.6)

Risk review

- ☐ Are statements attributing functional advantages to the claimed appearance limited to what is necessary, accurate and supported? (Rule 3.14)
- ☐ Are absolute words and unsupported negative statements removed? (Rule 3.15)
- ☐ Is the declaration free of feature-by-feature distinctions over the prior art? (Rule 3.16)
- ☐ Is it free of opinions on scope, infringement and functional superiority? (Rule 3.17)
- ☐ Is it free of any concession that a claimed element is dictated by function? (Rule 3.19)
- ☐ Has it been compared with the application itself, foreign filings, related utility patents and applications, technical documents, marketing and enforcement letters? (Rule 3.18)

- ☐ Has any inconsistent statement been considered for disclosure under 37 C.F.R. § 1.56(b)(2)? (Rule 3.18)

Procedure

- ☐ If the application is under final rejection, is the declaration supported by a § 1.116(e) showing, or filed with an eligible continued prosecution application, with deadlines preserved? (Rule 3.20)
- ☐ Are the attorney's remarks consistent with the declaration?

Appendix 2 (Questions and Answers)

Q1. Can the attorney's remarks supply facts about the design process that the declaration leaves out?

A: No. Attorney arguments are not a substitute for evidence. [MPEP § 1504.01\(c\)](#), subsection III. Facts about who designed what and why must be in the sworn declaration or an exhibit it incorporates.

Q2. Who may sign the declaration?

A: The inventor, or a representative of the company that commissioned the design. [MPEP § 1504.01\(c\)](#), subsections III and IV. A non-inventor company representative has succeeded where the declaration explained the ornamental considerations and how the design is seen (Application [29/918,931](#)). Outside industry witnesses can corroborate, but should not be the only source of design-intent testimony (Applications [29/683,965](#) and [29/683,966](#)).

Q3. Is a statement that the design "was created for the purpose of ornamenting" enough?

A: No. That is a conclusion. The declaration must identify the ornamental considerations and which visible features meet them, specifically and in depth. [MPEP § 1504.01\(c\)](#), subsection IV(A); [Form Paragraphs 15.08 and 15.08.01](#).

Q4. Should the declaration explain what the claimed features do?

A: Only as far as necessary to answer the rejection. Examiners and courts use a patentee's functional descriptions to treat features as functional (Rule 3.14). Where functional facts are needed, state them accurately and separate the article's useful purpose from the reasons its particular appearance was chosen.

Q5. Are alternative designs enough by themselves?

A: Usually not. They are important evidence that the appearance was not dictated by function, but examiners have said their mere existence is not dispositive. Pair them with the designer's

explanation of why the claimed appearance was chosen (Rule 3.11).

Q6. What evidence answers a hidden-in-use rejection?

A: Two kinds: evidence of a point in commercial life when the design is seen, such as sales literature, packaging, warehouse display or installation, and a declaration showing thought of ornament. [MPEP Form Paragraph 15.08.01](#); [In re Webb](#), 916 F.2d 1553.

Q7. Can the inventor testify that customers buy the product because of its appearance?

A: Only if the inventor sells to or works with those customers. Otherwise the evidence should come from customers or users. [MPEP § 1504.01\(c\)](#), subsection V.

Q8. The examiner cited our client's utility patent. Must the declaration respond to it?

A: The declaration should supply appearance-driven facts that answer the rejection without debating or repeating the utility patent's functional statements. Rejections citing the applicant's own utility patents have been overcome on that basis (Application [29/734,075](#)). Investigate any apparent inconsistency with the utility patent and handle it under Rule 3.18; the concern is candor, not verbal consistency alone.

Q9. Can statements in the declaration narrow the patent later?

A: Yes. Statements in § 1.132 declarations have supported prosecution history estoppel (*Pharmacia & Upjohn v. Mylan*), and design patent scope can be surrendered by argument as well as amendment (*Top Brand*). Keep the declaration about why the design was created, and review both it and the remarks for limiting representations (Rules 3.14 through 3.17).

Q10. Should the declarant's compensation be disclosed?

A: Yes, as a matter of good practice. No rule requires it, but undisclosed interests have been raised as an inequitable conduct theory (*Luv N' Care*). State employment or contractor status and any payment for the declaration (Rule 3.7).

Q11. Can a declaration be filed after a final rejection?

A: It is not entered as of right. It may be admitted on a showing under 37 C.F.R. § 1.116(e), or filed with an eligible continued prosecution application under § 1.53(d). A request for continued examination is not available in a design application (37 C.F.R. § 1.114(e)). See Rule 3.20.

Q12. Does a declaration that succeeds help in later litigation?

A: It can. A factually supported declaration gives the patentee a record to invoke, though allowance does not bind a court's later functionality analysis (Section 5.5).

Appendix 3 (Limitations)

This ProGuide is intended as a practical resource based on design patent prosecution histories, PTAB decisions and litigation, and does not constitute legal advice. Outcomes depend on the facts, the examiner and the art unit.

This ProGuide addresses only § 1.132 declarations filed to overcome § 171 rejections for lack of ornamentality. It does not address declarations offered on obviousness, inventor oaths and declarations under 37 C.F.R. § 1.63, declarations under 37 C.F.R. § 1.130, or reissue declarations.

The prosecution examples reflect observed examiner behavior in individual applications, not binding precedent. The file histories were identified with AI-assisted search. The statements made about each cited application, and its outcome, were checked against the file history text in the ProSearch database on October 30, 2026. Practitioners should still review the cited files before relying on them.

Statements in § 1.132 declarations have supported prosecution history estoppel in utility cases (Section 5.3). The authorities discussed here do not include a reported decision applying these doctrines to a declaration filed to overcome a design ornamentality rejection, so the guidance in Part D of Section 3 applies those principles by reasoned extension.

[MPEP § 1504.01\(c\)](#) was last revised in July 2015 (R-07.2015) and does not reflect later case law. Future USPTO guidance or decisions may change current practice.

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

Note on citations: MPEP and CFR text was checked against uspto.gov and the e-CFR on October 30, 2026. Practitioners should verify current versions before relying on them.

A. MPEP and Form Paragraphs

[MPEP § 1504.01\(c\)](#) Lack of Ornamentality [R-07.2015]

- Subsection I: ornamental means "created for the purpose of ornamenting"; the design must be primarily ornamental, viewed in its entirety; distinction between functionality of an article and functionality of its particular design.
- Subsection II: the examiner's evidence may include a brochure emphasizing functional features, the specification of an analogous utility patent (the applicant's or another's), or information in the specification.

- Subsection III: two categories of rejection (primarily functional; not visible in normal and intended use); rebuttal by the inventor or a representative of the commissioning company; attorney arguments are not a substitute for evidence.
- Subsection IV: ways to overcome the rejection: (A) declaration explaining specifically and in depth which features were created for saleable value or appearance; (B) advertisements emphasizing ornamentality; (C) distinctness from the prior art and consumer recognition; (D) motivating factors from the commissioning company; (E) alternative designs that could have served the same function; (F) visibility at some point between manufacture and ultimate use.
- Subsection V: trade show display or catalog inclusion alone is insufficient; need a clear and specific indication of ornamentality; customer-concern evidence from customers or users; the applicant's competence to testify to purchase reasons.

[Form Paragraph 15.08](#) Lack of Ornamentality (Article Visible in End Use) and [Form Paragraph 15.08.01](#) Lack of Ornamentality (Article Not Visible in its Normal and Intended Use): declaration should state the ornamental considerations that entered into the design and identify what aspects of the design meet them; 15.08.01 also requires evidence of a period in commercial life when ornamentality is a matter of concern.

[MPEP § 1504.02](#): functional or hidden features may not support patentability over prior art unless the § 1504.01(c) ornamentality standard is first met.

[MPEP § 716.03\(b\)](#): commercial success must derive from the claimed design; nexus especially difficult in design cases; an inventor's opinion about purchasers' reasons is insufficient.

B. Regulations

- 37 C.F.R. § 1.132: evidence traversing a rejection or objection on a basis not otherwise provided for must be by oath or declaration.
- 37 C.F.R. § 1.68: declaration in lieu of oath; warning of 18 U.S.C. § 1001 consequences and possible effect on validity; statement that statements of own knowledge are true and statements on information and belief are believed true.
- 37 C.F.R. § 1.56(b) and (c): non-cumulative information is material if it establishes a prima facie case of unpatentability or is inconsistent with a position the applicant takes; individuals who owe the duty.
- 37 C.F.R. § 1.116(e): evidence after final rejection requires good and sufficient reasons. 37 C.F.R. § 1.114(e): requests for continued examination do not apply to design or international design applications. 37 C.F.R. § 1.53(d): continued prosecution applications.

- 37 C.F.R. § 1.4(d)(2): S-signature format.

C. Case Law

Functionality and claim construction

- [L.A. Gear, Inc. v. Thom McAn Shoe Co.](#), 988 F.2d 1117 (Fed. Cir. 1993)
- [Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.](#), 853 F.2d 1557 (Fed. Cir. 1988)
- [Berry Sterling Corp. v. Pescor Plastics, Inc.](#), 122 F.3d 1452 (Fed. Cir. 1997)
- [Egyptian Goddess, Inc. v. Swisa, Inc.](#), 543 F.3d 665 (Fed. Cir. 2008) (en banc)
- [Richardson v. Stanley Works, Inc.](#), 597 F.3d 1288 (Fed. Cir. 2010)
- [Ethicon Endo-Surgery, Inc. v. Covidien, Inc.](#), 796 F.3d 1312 (Fed. Cir. 2015)
- [Sport Dimension, Inc. v. Coleman Co.](#), 820 F.3d 1316 (Fed. Cir. 2016)
- [Auto. Body Parts Ass'n v. Ford Global Techs., LLC](#), 930 F.3d 1314 (Fed. Cir. 2019)
- [Range of Motion Prods., LLC v. Armaid Co.](#), 166 F.4th 981 (Fed. Cir. 2026), reh'g en banc denied, 2026 WL 2318398 (Fed. Cir. Aug. 11, 2026)
- [In re Webb](#), 916 F.2d 1553 (Fed. Cir. 1990)
- [In re Carletti](#), 328 F.2d 1020 (C.C.P.A. 1964)
- [Seiko Epson Corp. v. Nu-Kote Int'l, Inc.](#), 190 F.3d 1360 (Fed. Cir. 1999)
- [Dyson, Inc. v. SharkNinja Operating LLC](#), No. 14-cv-779 (N.D. Ill. Oct. 13, 2016)
- [Sure Fit Home Prods., LLC v. Maytex Mills Inc.](#), No. 21-cv-2169 (S.D.N.Y. Oct. 14, 2021)
- [Apple Inc. v. Masimo Corp.](#), 2024 U.S. Dist. LEXIS 185270, 2024 USPQ2d 1818 (D. Del. Oct. 10, 2024) (Markman opinion: alternative designs; no disclaimer from PTAB descriptions)

Disclaimer and estoppel

- [Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC](#), 739 F.3d 694 (Fed. Cir. 2014)
- [Top Brand LLC v. Cozy Comfort Co.](#), 143 F.4th 1349 (Fed. Cir. 2025)
- [Pharmacia & Upjohn Co. v. Mylan Pharms., Inc.](#), 170 F.3d 1373 (Fed. Cir. 1999); [Enzo Biochem, Inc. v. Applera Corp.](#), 599 F.3d 1325 (Fed. Cir. 2010); [Ekchian v. Home Depot, Inc.](#), 104 F.3d 1299 (Fed. Cir. 1997)
- [Aylus Networks, Inc. v. Apple Inc.](#), 856 F.3d 1353 (Fed. Cir. 2017)
- [Biogen Idec, Inc. v. GlaxoSmithKline LLC](#), 713 F.3d 1090 (Fed. Cir. 2013)

- *Avid Tech., Inc. v. Harmonic, Inc.*, 812 F.3d 1040 (Fed. Cir. 2016)
- *Grober v. Mako Prods., Inc.*, 686 F.3d 1335 (Fed. Cir. 2012)

Inequitable conduct and declarant evidence

- *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011) (en banc)
- *Luv N' Care, Ltd. v. Laurain*, 98 F.4th 1081 (Fed. Cir. 2024)
- *Refac Int'l, Ltd. v. Lotus Dev. Corp.*, 81 F.3d 1576 (Fed. Cir. 1996); *Abbott Labs. v. Sandoz, Inc.*, 529 F. Supp. 2d 893 (N.D. Ill. 2007)
- *Junker v. Medical Components, Inc.*, No. 13-4606 (E.D. Pa. Dec. 21, 2016)
- *In re Huang*, 100 F.3d 135 (Fed. Cir. 1996)

PTAB and Office decisions

- *Ex parte Webb*, 30 USPQ2d 1064 (Bd. Pat. App. & Int. 1993)
- *Ex parte Cantor*, Appeal No. 2024-000008 (PTAB June 18, 2024) (Application [29/690,145](#))
- *Appeal No. 2022-004479* (PTAB Dec. 23, 2022) (Application [29/385,792](#))
- *In re Wong*, 2010 Commr. Pat. LEXIS 28 (Control No. 90/010,278)
- *In re Fulton*, 2010 Commr. Pat. LEXIS 27 (Control No. 90/008,995)

[Note: Case law citations are illustrative. Practitioners should research current binding authority.]

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