

Title: Prosecution History Disclaimer Applies to Design Patents

Link: <https://www.bipc.com/prosecution-history-disclaimer-applies-to-design-patents>

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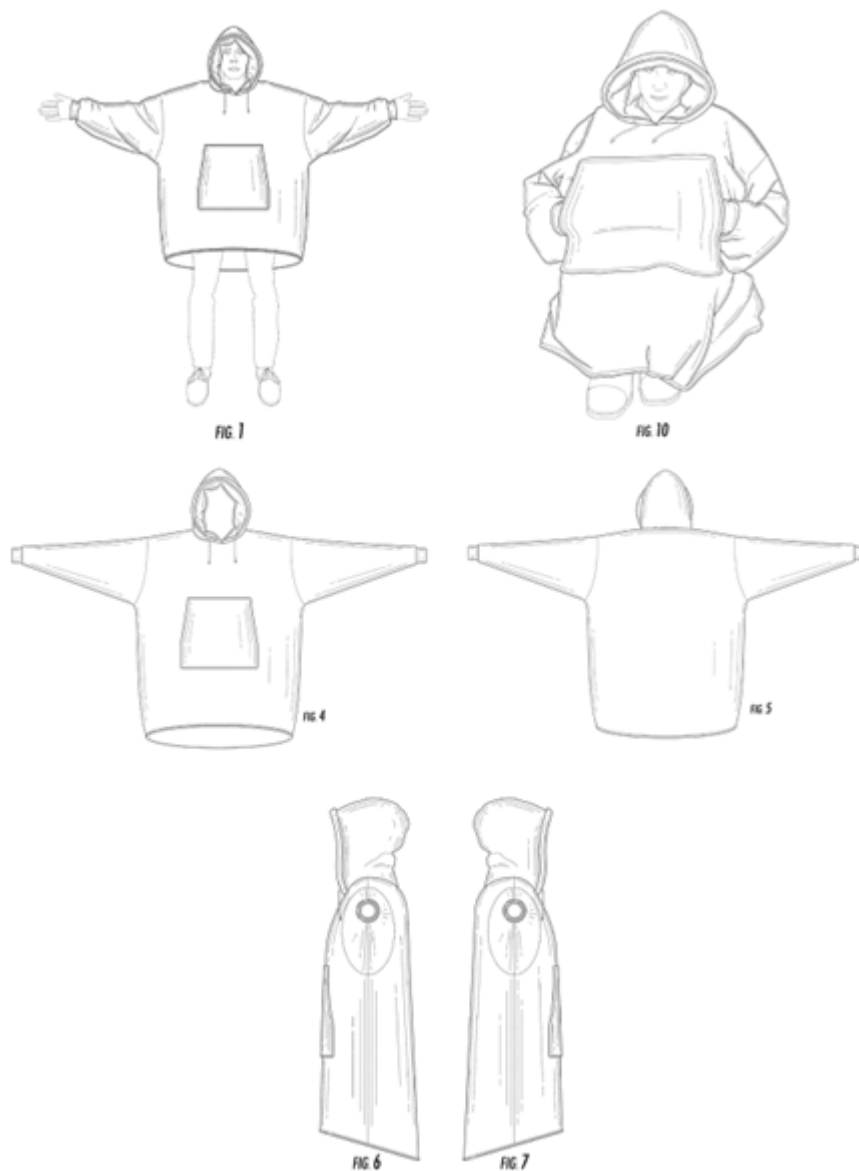
Article: On July 17, 2025, the U.S. Court of Appeals for the Federal Circuit issued a decision confirming that the principles of prosecution history disclaimer, which apply to utility patents, also apply to design patents. See *Top Brand LLC v. Cozy Comfort Company LLC*, No. 2024-2191, slip op. (Fed. Cir. July 17, 2025)

In general, U.S. design patents are given a narrow scope. See, e.g., *In re Mann*, 861 F.2d 1581, 1582 (Fed. Cir. 1988) explaining that “[d]esign patents have almost no scope.” However, design patents may be entitled to a range of equivalents in an infringement analysis. Thus, to infringe, an accused device does not necessarily have to be an exact copy of a patented design.

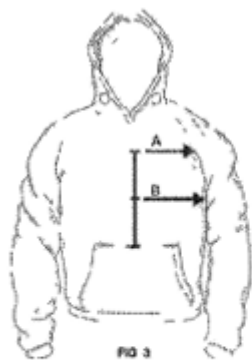
The range of equivalents may be diminished by arguments or amendments made by a patentee during the examination phase of a patent application. Traditionally, in the utility patent context, “the interested public has the right to rely on the inventor’s statements made during prosecution”. See, e.g., *Fenner Invs., Ltd. v. Cellco P’ship*, 778 F.3d 1320, 1325–26 (Fed. Cir. 2015). In the present case, the Court held that this principle applies equally to design patents. The Court held that it would be contrary to the very purpose of design patent prosecution to allow a patentee to make arguments in litigation contrary to the representations which led to the grant of the patent in the first place and thereby recapture surrendered claim scope.

While disclaimer by amendment is well recognized, the Court confirmed that a disclaimer may also be triggered by arguments made during the examination phase.

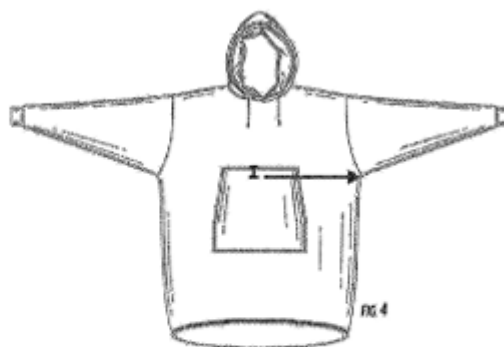
Cozy Comfort obtained U.S. Design Patent No. D859,788 (the ‘788 patent) for an “ENLARGED OVER-GARMENT WITH AN ELEVATED MARSUPIAL POCKET”. The following figures are representative:



During the examination phase of the application, the Examiner had rejected the application over U.S. Design Patent No. D728,900 (White). To convince the Examiner to allow the application, the patentee argued that “the pocket located on the front of the torso” in the claimed design was “substantially different in the claimed design and the White design” and that “[f]or this alone, the claimed design [was] allowable.” Specifically, the patentee explained that “[t]he pocket in the inventive design [was] approximately one-third of the width of the torso,” while White’s pocket “occupie[d] roughly 90% of the torso’s width,” and provided annotated comparisons of the two designs:



White, Fig. 3
(J.A. 15109
(annotations in
original))



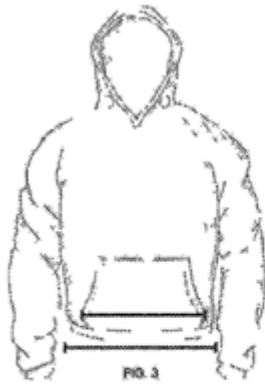
D788 patent, Fig. 4
(J.A. 15109
(annotations in
original))

However, the width of the pocket of the accused product more closely resembled the prior art White pocket, over which the patentee had distinguished its patent to obtain allowance. See the accused product below:

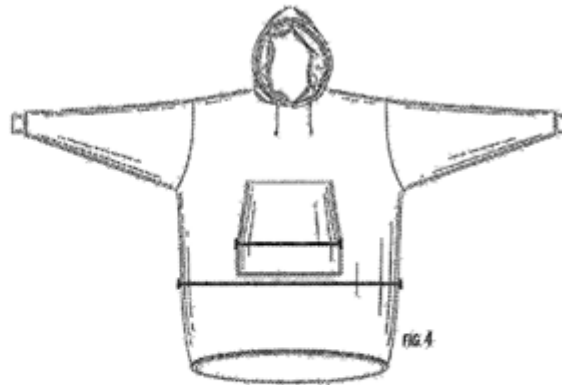


Accused product
(Appellants' Br. 39
(citing J.A. 17028)
(color alterations in
original))

In addition, during examination the patentee also argued the bottoms of the claimed armholes (i.e., armholes) in its design were "actually below the top of the marsupial pocket," in contrast to White's armholes that were "well above the top of the marsupial pocket," as shown in the annotated figures below:



White, Fig. 3
(J.A. 15108
(annotations in
original))



D788 patent, Fig. 4
(J.A. 15108
(annotations in
original))

However, like White's design, the Top Brand accused product also had armholes located above the top of the pocket.

These and other arguments made during the examination phase ultimately prevented the patentee Cozy Comfort from successfully arguing that the '788 patent was infringed.

Accordingly, U.S. design patent applicants should be cautious about the arguments made during the examination phase to secure the application's allowance.

