

Claim Construction or Claim “Constriction” – Should Words Matter in Assessing Design Patent Scope?



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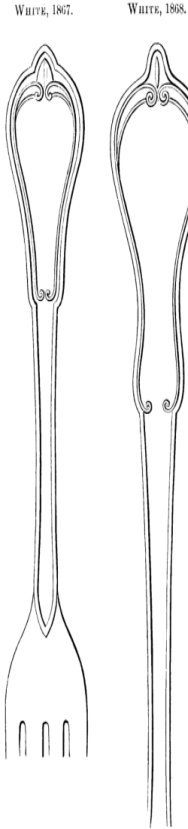
Evolution of Scope Rules

Historical Rules for Design Patent Scope

claimed



accused



“ . . .if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.” *Gorham Co. v. White* (US 1871)

Historical Rules for Design Patent Scope

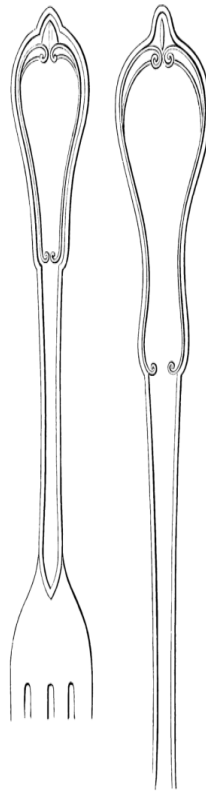
claimed

as shown



accused

White, 1867. White, 1868.



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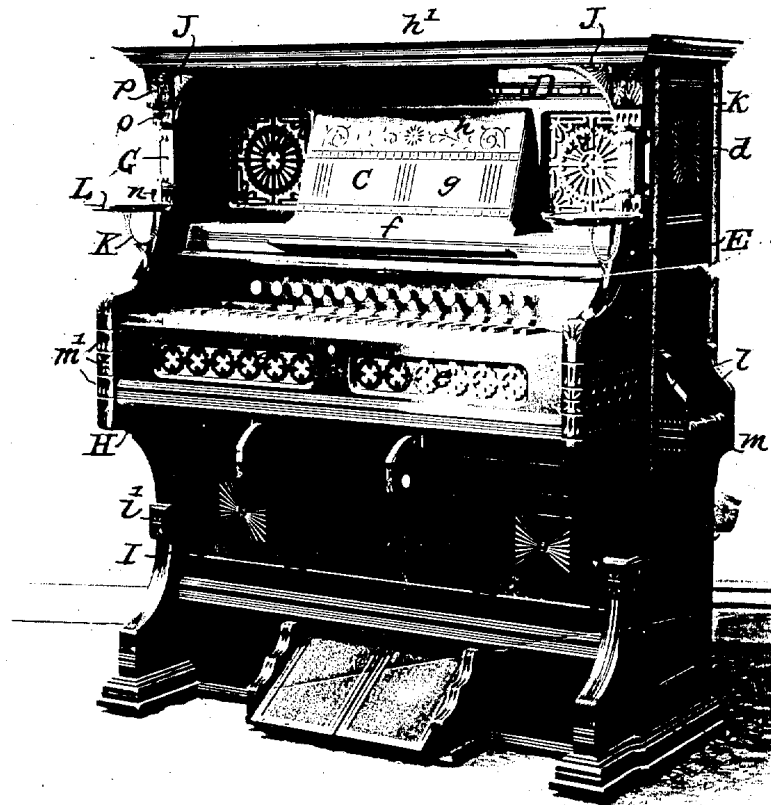
In utility patent law at the time:

- No clear division between literal infringement and DOE
- No developed peripheral claiming practice or corresponding claim construction rules
- No threshold claim construction process

In design patent law at the time:

- No requirement for a single, pro forma claim
- Many claims included extensive textual elements

U.S. D20,419 issued 1890



I claim as my invention—

1. The design for an organ-case, as herein shown and described. 40
2. In an organ-case, the design for the ornamentation of the front board A thereof, as shown and described.
3. In an organ-case, the design for the ornamentation of the front B of the key-board projection thereof, as shown and described. 45
4. In an organ-case, the design for the ornamentation of the music-desk C thereof, as shown and described.
5. In an organ-case, the design for the ornamentation of the back board D thereof, as shown and described. 50
6. In an organ-case, the design for the ornamentation of the ends E thereof, as shown and described. 55
7. In an organ-case, the design for the ornamentation of the front projection H of the ends thereof, as shown and described.
8. In an organ-case, the design for the ornamentation of the corners between the top and ends thereof, consisting of the brackets or corbels J, as shown and described. 60



Modern Rules of Scope

Modern Rules for Design Patent Scope

Requirement for a single pro forma claim:

The claim shall be in formal terms to the ornamental design for the article...as shown, or as shown and described. More than one claim is neither required nor permitted. 37 CFR § 1.153(a)

Modern Rules for Design Patent Scope

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Claim construction:

- “[t]he preferable course ordinarily will be for a district court not to attempt to “construe” a design patent claim by providing a detailed verbal description of the claimed design.”

- however, a trial court can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim,” including:

1. the role of drafting conventions (especially in the drawings)
2. the effect of any representations made in the prosecution history; and
3. “distinguishing between those features of the claimed design that are ornamental and those that are purely functional”

Egyptian Goddess v. Swisa (Fed. Cir. 2008) (*en banc*)



1. Drafting Conventions as a Scope Limitation

Drafting Conventions Can Inform “plain and ordinary meaning” for Design Patent Scope

Claim: “The ornamental design for an LED light panel, as shown and described.”

Description: States that “oblique shading lines visible in the front and perspective view denote transparency.”



FIG. 1



FIG. 2

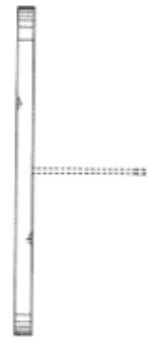


FIG. 3

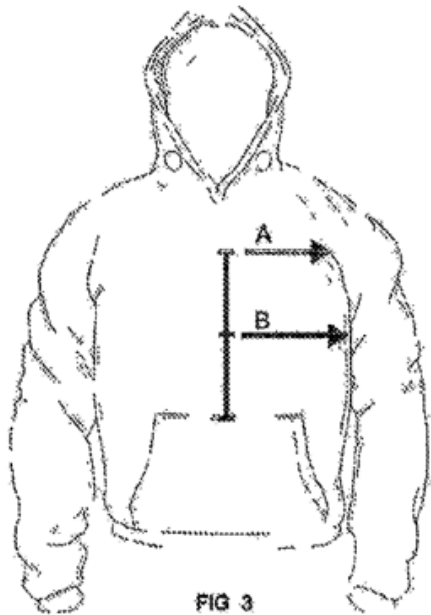
“where a design is claimed ‘as shown and described’...then the patent’s scope of protection is limited by the drawings and accompanying description in the patent.” *Smartrend Mfg. Group v. Opti-Luxx* (Fed. Cir. 2025)



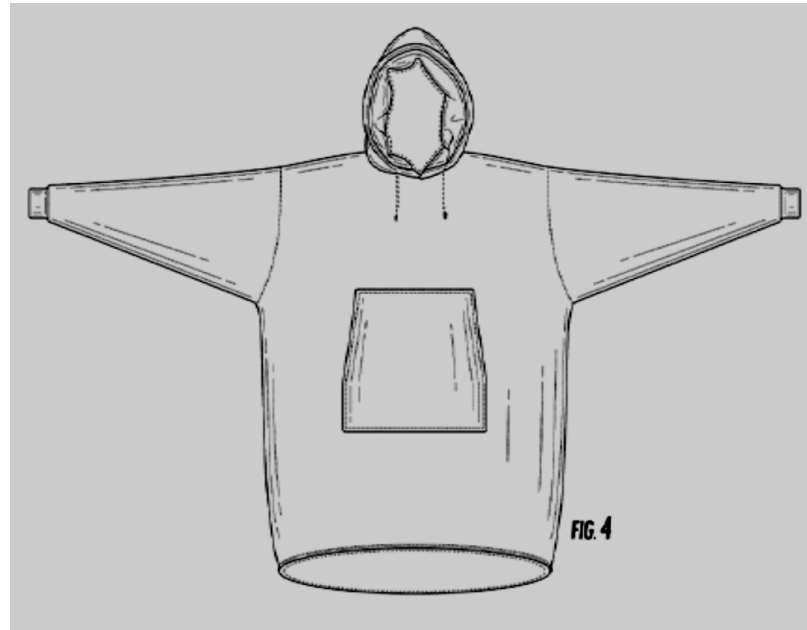
2. Prosecution History as a Scope Limitation

Prosecution History Can be a Source Of Disclaimer Or “Estoppel” In Design Patents

prior art



claimed



accused



“In considering whether the differing features of the accused product and the claimed design create a different overall impression to the ordinary observer, it is necessary to discount any features that were disclaimed during prosecution,” where disclaimer occurs when an applicant unambiguously surrenders design claim scope during prosecution (e.g. by distinguishing the prior art) *Top Brand LLC v. Cozy Comfort Company LLC* (Fed. Cir. 2025). See also *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC* (Fed. Cir. 2014) (referring to estoppel)

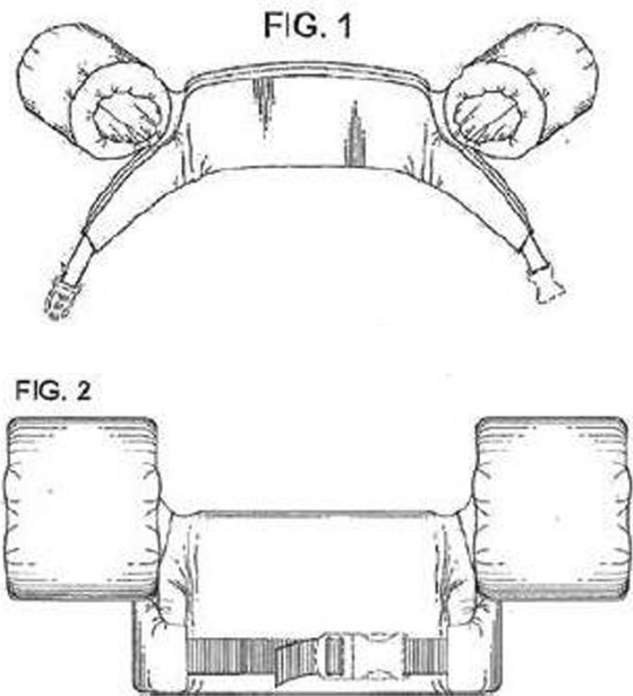


3. Functionality as a Scope Limitation

A Determination That a Design Element Serves a “Functional Purpose” Can Limit Design Patent Scope

- Where elements of a product serve a functional purpose, the fact finder determining design patent infringement should “focus on what these elements contribute to the design’s overall ornamentation.”
 - But it is error for the judge to “eliminate” those elements from the claimed design under the guise of claim construction.
- Sport Dimension, Inc. v. Coleman Co., Inc.* (Fed. Cir. 2016)

claimed



accused





4. Article of Manufacture as a Scope Limitation

The Article of Manufacture Identified in the Claim Limits Design Patent Scope for Infringement and Validity Determinations

statements in the design patent document and prosecution history regarding the article of manufacture can limit scope of design patent for infringement purposes - *Curver Luxembourg, SARL v. Home Expressions, Inc.* (Fed. Cir. 2019)

“[a] design claim is limited to the article of manufacture identified in the claim...” so for a prior art design to anticipate a claimed design, the prior art design must be applied to the article identified in the claim - *In re Surgisil* (Fed. Cir. 2021)

To qualify as comparison prior art for infringement purposes, the prior art design must be applied to the article of manufacture identified in the claim - “[a] design claim is limited to the article of manufacture identified in the claim...” so for a prior art design to anticipate a claimed design, the prior art design must be applied to the article identified in the claim – *Columbia Sportswear N.A., Inc. v. Seirus Innovative Accessories, Inc.* (Fed. Cir. 2023)

Thank you.

