Federal Circuit Tells Patent Office to Limit Scope of Design Patents, Overturning Patent Office Precedent

By Vera L. Suarez, Alan N. Herda | October 11, 2021

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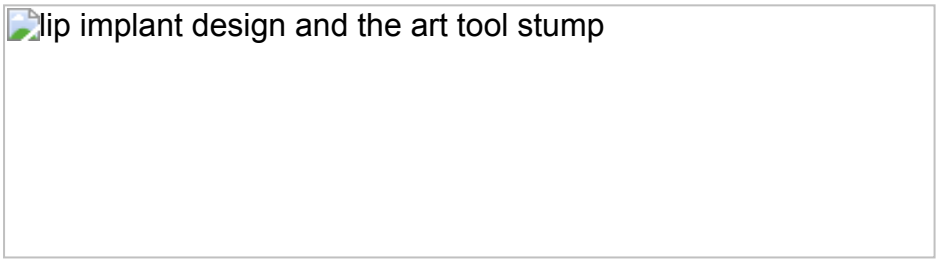
On October 4, 2021, the Court of Appeals for the Federal Circuit told the Patent Office that the way it has been reviewing design patent applications is wrong, and that a design patent claim must be limited to the article of manufacture identified in the claim. *In re: SurgiSil, L.L.P., et al*, No. 2020-1940, 2021 WL 4515275 (Fed. Cir. Oct. 4, 2021).

SurgiSil filed a design patent application claiming an "ornamental design for a lip implant as shown and described." The Patent Office rejected the claim as anticipated, or not novel, in light of an art tool called a stump. Images of the claimed lip implant design (first image) and the art tool stump (second image) are shown below.



In making the rejection, the Patent Office cited its own Manual of Patent Examining Procedure, MPEP § 1504.02, and a 1956 Court of Customs and Patent Appeals case, *In re: Glavas*, 230 F.2d 447 (CCPA 1956), to support its comparison of a nonanalogous, or unrelated, art tool stump to the claimed lip implant design. In doing so, the Patent Office ignored the "lip implant" article of manufacture identified in the claim, as well as the "art tool" article of manufacture of the asserted prior art. SurgiSil appealed the rejection to the Patent Trial and Appeal Board ("PTAB"), arguing that *In re: Glavas* was dictum and that the differences in articles of manufacture were relevant to the anticipation rejection. While noting that *In re: Glavas* was dictum, the PTAB still sustained the rejection, holding that it was "appropriate to ignore the identification of the article of manufacture in the claim language" and that the differences in the articles of manufacture were irrelevant with respect to anticipation.

SurgiSil then appealed to the Federal Circuit. The Patent Office maintained that there is no analogous art requirement for design patent anticipation. SurgiSil maintained that there is, and that the article of manufacture identified in the claim—the lip implant—limited the scope of the claim and thus an anticipation rejection could not be based on the art tool stump. The Federal Circuit agreed

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with SurgiSil and reversed the rejection, holding that “a design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract.”

This holding is significant because it limits the scope of a design patent to the article of manufacture identified in the claim, potentially impacting the examination of pending design patent applications, as well as the validity and infringement of issued design patents.

Haynes Boone partners Alan Herda and Vera Suarez were the lead patent attorneys for SurgiSil, and Haynes Boone associate Angela Oliver was the lead appellate lawyer arguing SurgiSil’s case before the Federal Circuit.

To read the full decision, click here.

For more information, please contact one of the attorneys listed below.

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