

A Cautionary Fed. Circ. Tale On Design Patents

By **John Hemmer** (May 27, 2025, 5:30 PM EDT)

On April 22, the U.S. Court of Appeals for the Federal Circuit issued a decision that highlights a risk in design patent prosecution — specifically, attempting to claim priority to a utility application.

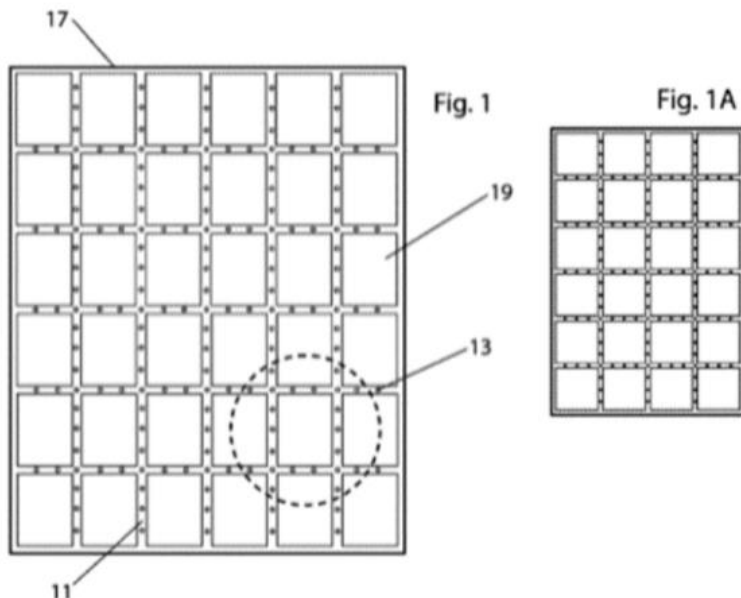
In *In re: Floyd*, the Federal Circuit affirmed the Patent Trial and Appeal Board's decision denying a design patent application the benefit of an earlier utility application's filing date. Ironically, the same utility application used for priority was then cited as prior art to reject the design for lack of novelty under Title 35 of the U.S. Code, Section 102.



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Background

The inventor Bonnie Iris McDonald Floyd initially filed a utility patent application, Application No. 15/004,938, on Jan. 23, 2016, for a cooling blanket featuring an integrated ventilation system and multiple sealed compartments. The application included figures depicting six-by-six and six-by-four arrays of compartments.



Figs. 1 and 1A from the parent utility application

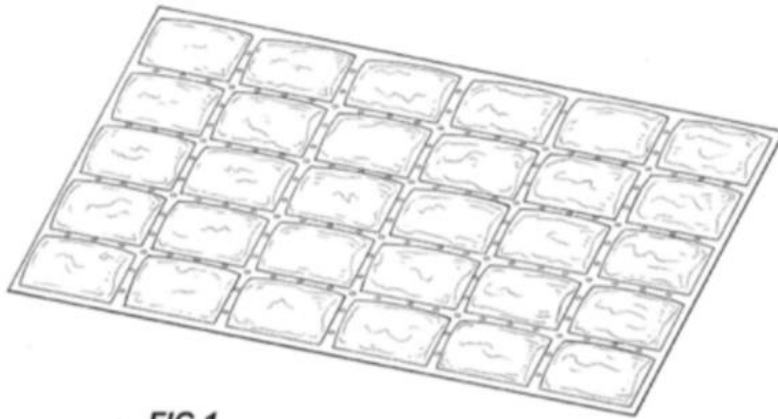


FIG.1

Fig. 1 from the design patent continuation

On March 27, 2019, Floyd filed a design patent application, Application No. 29/685,345, claiming an ornamental design for a cooling blanket with a six-by-five array configuration, asserting priority to the earlier utility application. Figures from the utility and design patent applications are shown below.

PTAB Decision

During prosecution, the examiner rejected the design application's priority claim, concluding that the claimed six-by-five configuration was not adequately supported by the utility application's disclosure. Because priority was denied, the utility application became prior art and was found to anticipate the claimed design under Section 102.

The PTAB affirmed the examiner's decision, emphasizing that while the utility application included general statements about the blanket being made in "any size," those statements did not sufficiently disclose the specific ornamental features, namely, the six-by-five array, claimed in the design application.

Federal Circuit Ruling

The Federal Circuit upheld the PTAB's decision, agreeing that the design application was not entitled to the earlier filing date of the utility patent. Importantly, the court also confirmed that the utility application could serve as prior art against the design application once priority was denied.

The court addressed the apparent contradiction of a reference being insufficient to support a continuation but still capable of anticipating it. The court explained that the legal standards for written description (focused on whether the inventor "possessed" the claimed design) and anticipation for a design application (whether the claimed design and prior art appear "substantially the same" to an ordinary observer) are distinct and operate independently.

The decision underscores that meeting the legal threshold for design priority demands more than similarity; it requires demonstrable possession of the specific ornamental features at the time of the initial filing.

Practical Implications

Filing a design patent with priority to a utility application can be a strategic move, especially when seeking aesthetic protection that wasn't appreciated or pursued at the time of the original filing. This tactic may be useful in mining additional patent protection from a utility application and even extending patent protection timelines, as design patents have a 15-year term from grant, not filing.

However, the Floyd case highlights an important caveat: A valid priority claim for a design application requires the parent utility filing to contain a clear and specific disclosure of the design's ornamental aspects. General statements or functionally oriented drawings are not enough.

Practitioners should anticipate that even minor discrepancies between the design claimed and what is shown in the utility filing could jeopardize both novelty and priority claims.

The consequences can be harsh. Without a valid priority claim, the earlier utility application may not only fail to support the design but also serve as prior art, resulting in a form of self-collision that can doom the design application.

Applicants should also remember the one-year statutory bar under Section 102(a)(1). If the product was publicly disclosed or sold more than a year before the design filing, and proper priority is not established, the design application could be time-barred, even if the utility application is still pending.

Best Practices Moving Forward

Consider Parallel Filings

Given the risks illustrated by the Floyd case, applicants may wish to pursue design and utility patents in parallel, rather than relying on continuation practice. This ensures independent support for both functional and ornamental aspects of an invention and may provide a broader enforcement strategy.

While the prospect of extending a patent term can be tempting, the reality is that most designs benefit from earlier and more robust patent protection rather than simply longer protection. If a design is important, a separate strategic design application with support for continuation and foreign filings, such as detailed figures, multiple views, proper shading, alternative shading techniques (e.g., stippling, gray scale and photorealistic views), breaks for partial designs, and photographs, may be the best practice.

Consider Including More Design Disclosure

If design protection is anticipated but not pursued at the time of filing the utility application, important ornamental features should be included if they may later become the subject of a design application.

Even including a picture of the product, such as a screenshot of a graphical user interface in the related system or software application with the important ornamental details of the commercial product, even if such details are not needed to support the utility claims, could help to provide sufficient written description support and preserve a design priority claim.

Understand Priority Limitations

While design patents can claim priority to nonprovisional utility applications, design patents cannot claim priority to provisional applications even if the nonprovisional utility application includes a claim to

a provisional application. Foreign priority may also only be available if design protection is pursued in parallel with the utility application. As a result, when relying on a utility application for priority, the design application's effective filing date may be later than expected. Practitioners must carefully track filing timelines to avoid losing rights due to miscalculated dates.

Perform a Priority Check Before Filing

Before submitting a design application that claims priority to a utility filing or a new nonprovisional application that they consider using as a priority application for a design filing, practitioners should critically review the parent disclosure with an eye toward written description support for the specific design to be claimed. Conducting an internal audit may avoid costly rejections or litigation exposure down the line.

Conclusion

The Floyd decision serves as a cautionary tale for patent practitioners: The interplay between design and utility applications is more than procedural — it can be determinative of patentability. Strategic foresight at the drafting stage is essential to preserving rights across patent types.

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