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DESIGN PATENT MEET PROSECUTION HISTORY ESTOPPEL

*Pacific Coast Marine Windshields Ltd. v. Malibu Boats
(Fed. Cir. 2014)*

*Chad D. Wells
January 22, 2014*

Question of the Day

- Chisum – Given the mode of claiming with design patents, that is, a claim that merely refers to the drawing(s) illustrating the design, and given the *Gorham* standard for determining infringement, that is, substantial similarity to an ordinary observer of the claimed and accused designs, . . . it can be questioned whether there is any need to apply to designs the general distinction between “literal” infringement of a patent and infringement under the “doctrine of equivalents.” Donald S. Chisum, *Chisum on Patents* § 23.05[7] (2013)

District Court Disposition

- District Court for the Middle District of Florida granted Malibu Boats motion for summary judgment of non-infringement of Design Patent No. D555,070 (the ‘070 patent’) on the basis that prosecution history estoppel barred the infringement claim.

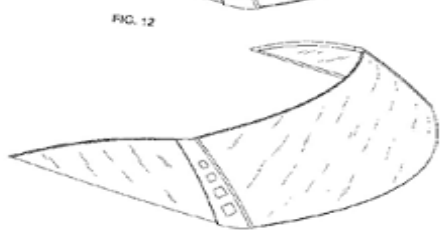
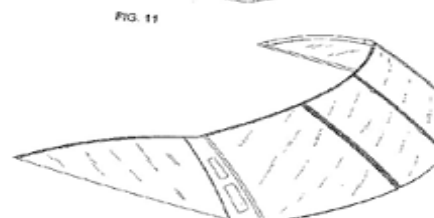
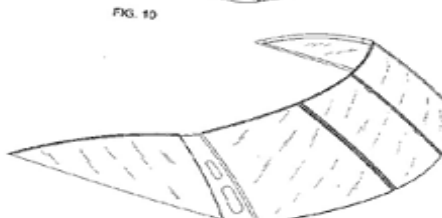
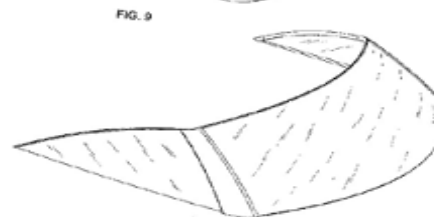
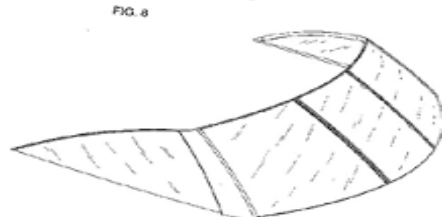
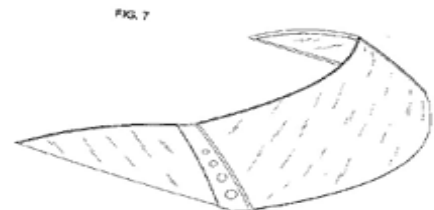
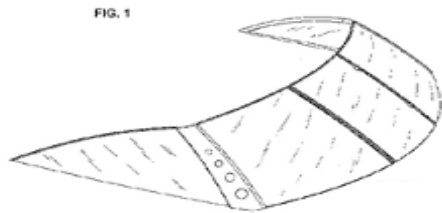
Fed. Cir. Disposition

- Fed. Cir. holds that the principle of prosecution history estoppel applies to design patents.
- Fed. Cir. reverses summary judgment of non-infringement of the '070 patent and remands for further proceedings.

History of the '070 Patent

- Inventor, Darren A. Bach, filed for a design patent on April 27, 2006.
- Claim stated “I claim the ornamental design of a **MARINE WINDSHIELD** with a frame, a tapered corner post with vent holes and without said vent holes, and with a hatch and without said hatch, as shown and described.”

Representative Figures Filed With Application



Restriction Requirement

- During Examination, the Examiner required restriction between five groups:
 - Group 1 – with hatch and four circular holes (Figs. 1-6);
 - Group 2 – with no hatch and either four circular or rectangular holes (Fig. 7 and 12);
 - Group 3 – with hatch and no holes (Fig. 8);
 - Group 4 – with no hatch and no holes (Fig. 9) and
 - Group 5 – with hatch and two oval or rectangular holes

Basis for Restriction

- 35 U.S.C. § 121 – If two or more independent and distinct inventions are claimed in one application, the director may require the application to be restricted to one of the inventions.
- “Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct.” *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959)
- “Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application.” *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967)

Response to Restriction

- Applicant elected group 1 and canceled Figs. 7-12.
- Applicant amended claim 1 to recite “I claim the ornamental design of a **MARINE WINDSHIELD** with a frame and a pair of tapered corner posts, as shown and described.”

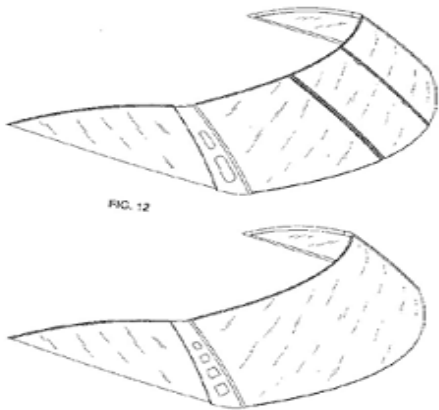
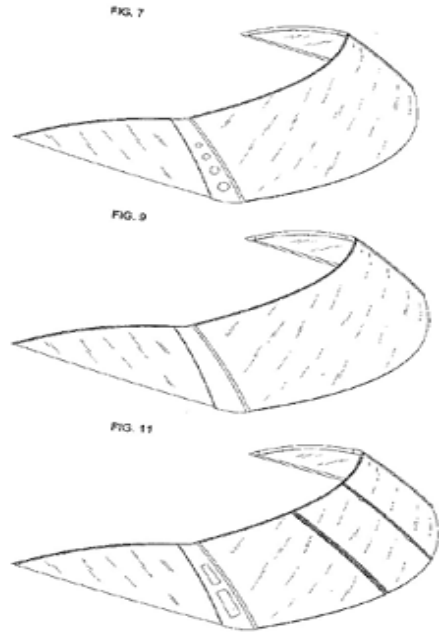
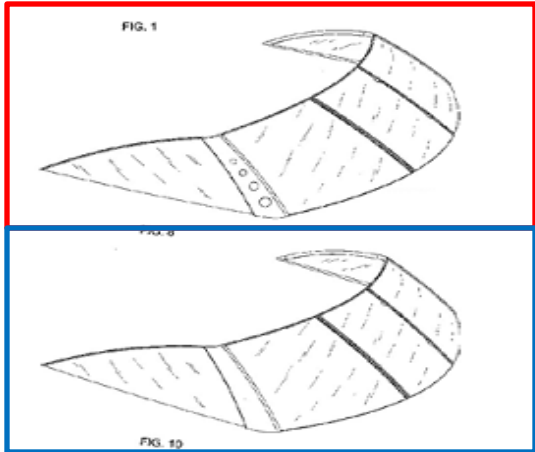
Notice of Allowance

- Examiner changed claim to “I claim:
The ornamental design for a MARINE
WINDSHIELD as shown and
described.”

After Allowance

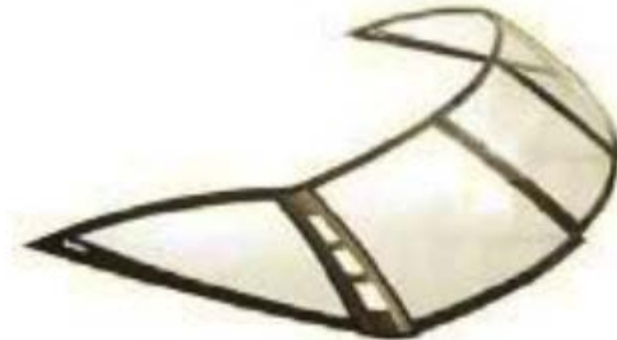
- First divisional application results in U.S. Design Patent No. D569,782 (the '782 patent)
 - Corresponds to Group 3 of original application (with hatch and no holes)
- Second divisional application results in U.S. Design Patent No. D593,024
 - Broader claims than the '782 patent because only claims the posts

Prosecuted Groups From Representative Figures



Middle District of Florida

- Pacific Coast sues Malibu for infringement of the '070 patent and also for inducing others to infringe the '070 patent.
- Accused product design includes a hatch and **three** trapezoidal holes on the corner posts:



District Court Holding

- Pacific Coast was estopped from asserting infringement because accused design has one fewer hole and fell within the territory surrendered between the original claim and amended claim – citing *Festo Corp. v. Shoketsu Kinzoku Kabushiki Co.*, 535 U.S. 722, 740 (2002).
- Patentee failed to overcome the presumption of prosecution history estoppel.

Fed. Cir.

- “Although treatises and district court decisions going back to 1889 have recognized that the concept of prosecution history estoppel applies to design patents as well as utility patents, this issue is one of first impression for our court.”

Fed. Cir. Compares Utility Patents to Design Patents

- Doctrine of prosecution history estoppel is well established for utility patents.
- Infringement may occur literally or under the doctrine of equivalents.
 - DOE – the accused and claim elements are equivalent if there are only insubstantial differences between them - citing *Warner Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 (1997).
 - DOE – alternative formulation, whether substitute element matches the function, way and result of the claimed element – citing *Warner Jenkinson* at 40.
- DOE conflicts with notice function when applied broadly and prosecution history estoppel limits bounds of what a patentee can claim as an equivalent.

Fed. Cir. Compares Utility Patents to Design Patents (continued)

- For design patents, the concepts of literal infringement and equivalents infringement are intertwined.
- Unlike utility patents, statute for infringement of design patent (35 U.S.C. § 289) does not require literal identity.
- *Gorham Mfg. v. White*, 81 U.S. 511 (1871) sets forth test for design patent infringement

35 U.S.C. § 289

- Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, **or any colorable imitation thereof**, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

Gorham

- Test for design infringement is whether “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.”
- Supreme Court said that if the test for infringement required the accused design to reproduce all of the elements of the patented design, there could never be infringement because “human ingenuity has never produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them.”

Test for Design Infringement

- Does not require identity, rather sufficient similarity.
- Colorable imitation standard involves the concepts of equivalents
- While the way/function/result test is not directly transferable to design patents, it has long been recognized that the principles of equivalency are applicable – citing *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189 (Fed. Cir. 1988)

Fed. Cir. Holds that Prosecution History Estoppel Apply to Design Patents

- During briefing, Pacific Coast argued that prosecution history estoppel should not apply to design patents.
 - However, at oral arguments, Pacific Coast conceded that a patentee should not be able to assert infringement against a particular design that was abandoned during prosecution **for purposes of patentability**.
 - Fed. Cir. – **This concession is well taken.**
- Same principles of public notice that underlie prosecution history estoppel apply to both design and utility patents
 - Promotes the clarity that is essential to promote progress

Fed. Cir. Holds that Prosecution History Estoppel Apply to Design Patents (continued)

- Refusing to apply prosecution history estoppel would undermine definitional and notice function of statutory claiming.
- Fact that scope of the claimed invention for design patent is defined by drawings rather than language does not argue against application of prosecution history estoppel principles here.

Really?

- One facet of DOE is that it is an equitable remedy that recognizes that language is imprecise.
 - What is imprecise about a figure?
- DOE is a non-statutory remedy when there is no literal infringement.
 - 35 U.S.C. § 289 specifically define infringement for when there is a “colorable imitation” of the patented design

Application of Prosecution History Estoppel to the '070 patent

- Whether prosecution history estoppel bars infringement of a design patent requires answering yes to the following questions:
 - Whether there was a surrender;
 - Whether it was for reasons of patentability; and
 - Whether the accused product is within the scope of surrender.

Was there a surrender?

- Fed. Cir. held there was a surrender of claim scope during prosecution.
 - In design patents, Figures are required because the drawings, and not the text of the claim, “constitute a complete disclosure of the appearance of the design.”
 - Utility Patent – look to the wording of the claims.
 - Design Patent – look to the drawings.

Surrender (continued)

- During prosecution, the applicant amended the claim by cancelling figures not associated with the elected group.
- By cancelling the figures showing corner posts with two holes and no holes, the applicant surrendered such designs and conceded that the claim was limited to what the remaining figures showed.
- By removing the broad claim language referring to alternate embodiments and canceling unelected embodiments, the applicant narrowed the scope of his original claim application, and surrendered subject matter.

Surrender (continued)

- It does not matter that the surrender involved the cancellation of claims rather than amendment.
 - *Honeywell Int'l Inc. v. Hamilton Sundstrand*, 370 F.3d 1131, 1147 – held that prosecution history estoppel is not limited to narrowing amendments, but extends as well to claim surrender
- By removing broad claim language referring to alternate configuration and cancelling the individual figures, the applicant narrowed the scope of the original application and surrendered subject matter.

Was surrender for purposes of patentability?

- Fed. Cir. held that the surrender was for purposes of patentability.
 - While not in response to prior art, it was made in response to a restriction requirement.

Patentability (continued)

- A design patent application may contain only a single claim. MPEP § 1503.01 and *In re Rubinfeld*.
- If a design application includes more than one patentable design, the Patent Office must require the applicant to restrict his claim to a single inventive design.
- In design patents, unlike utility patents, restriction requirements cannot be a **mere matter of administrative convenience**.

Patentability (continued)

- Pacific Coast argued that only surrenders to avoid the prior art are within the prosecution history estoppel doctrine.
- Fed. Cir. indicated that such argument was rejected in *Festo* stating that any narrowing amendment made to satisfy any requirement of the Patent Act may give rise to the estoppel.
 - Here, surrender resulting from the Restriction Requirement was to secure the patent.
 - Fed. Cir. expresses no opinion as to whether the same rule should apply with respect to utility patents in response to Restriction Requirements.

Is accused design within the scope of surrender?

- Prosecution history estoppel only bars infringement if the accused design falls within the scope of surrender.
- Determining reach of prosecution history estoppel requires an examination of the subject matter surrendered

Within the scope (continued)

- District Court held that the design of the accused design falls within the territory between the original claim and the amended claim
 - Accused design has three holes
 - Original claim had a four hole embodiment and a two hole embodiment
 - Canceling all but the four hole embodiment surrendered everything between four hole embodiment and the two hole embodiment

Within the scope (continued)

- Malibu argues that abandoning design with two holes and only obtaining patents on designs with four holes and no holes results in surrender of subject matter between four holes and zero holes.

Within the scope (continued)

- Fed. Cir. disagrees with Malibu's rationale
 - Notes that range concept does not work in context of design patents where ranges are not claimed
 - Claiming different designs does not suggest that the territory between those designs is also claimed
- Malibu conceded during oral arguments that Pacific Coast never claimed a design that has zero *to* four holes
- Because original design application never provided three hole design, there could be no surrender of the three hole design

Within the scope (continued)

- Malibu did not argue scope of surrendered two-hole embodiment extended to the three-hole embodiment because the three-hole embodiment was not a colorable difference from the two-hole embodiment.
- Pacific Coast does not argue that the accused design was within the scope of the surrendered two-hole embodiment, so no presumption of prosecution history estoppel could arise.
- Fed. Cir. finds accused product not within the scope of surrender and remands for further proceedings.

Considerations after *Pacific Coast*

- File design application with single embodiment
 - May require filing a new application for each embodiment
- What about line changes in drawings to secure design patents?

QUESTIONS