Check out Derek Fahey's firm website! CLICK HERE

Derek Fahey is a licensed and registered patent attorney at The Plus IP Firm. The Plus IP Firm helps businesses and inventors protect their ideas, concepts and creations with patents, trademarks and copyrights.

I cannot thank Derek Fahey and the entire Plus Firm team for such a wonderfully easy and thorough process in getting us our Nickel Trademark. Seriously, thank you!!!.

Blair Adams
Nickel Health

THE PLUS IP FIRM
Patents.Trademarks.Copyrights.

PROSECUTION HISTORY ESTOPPEL: THE POWERFUL EFFECT

Prosecution history estoppel in patent litigation can be a powerful tool or major obstacle, depending on one's perspective. In a recent Federal Circuit decision, the Court reversed the Eastern District of Virginia District Court's multi-million-dollar jury verdict, which included enhanced damages based for willful patent infringement. The Court ruled that prosecution history estoppel barred a finding that the accused infringing device infringed the patent at issue. *Cobalt Boats, LLC, v. Brunswick Corporation*, No. 2018-1376, 2019 WL 2323807, at *1 (Fed. Cir. May 31, 2019). This article discusses how Prosecution History Estoppel affected that case.

I. Types of Patent Infringement: Literal Infringement and Infringement Under the Doctrine of Equivalents

To understand how prosecution history estoppel affected the Court's ruling in *Brunswick*, a brief discussion of the types of patent infringement is necessary. Generally speaking, there are two types of patent infringement: 1) literal patent infringement; and 2) patent infringement under the "doctrine of equivalents." Literal patent infringement

means that an infringing device or method includes every element of a patent's claim. A patent's claim is the heart of a patent and defines the limits of what the patent does and does not cover. Patent infringement under the doctrine of equivalents occurs when, even though an infringing device or process does not include each and every claim element of a patent's claim, some other element of the infringing device or process performs substantially the same function, in substantially the same way, to achieve mainly the same result (is an "equivalent").

To better understand patent infringement under the doctrine of equivalents, take the following example. Patent Owner A owns Patent A. Patent A includes the following claim: "A stand-up desk comprising *titanium* having a two-tiered organizing system." Competitor B makes a Device B. Device B is a stand-up desk comprising *aluminum* having a two-tiered organizing system. In this example, Device B does not literally infringe on Patent A's claim because Device B is not comprising titanium and therefore lacks each and every limitation of Patent A's claim. However, Device B may still infringe under the doctrine of equivalents if it is determined that *aluminum* is an "equivalent" to *titanium* or is only a trivial substitution.

II. What Is Prosecution History Estoppel?

Armed with an understanding of patent infringement under the doctrine of equivalents, we turn to explain the meaning of prosecution history estoppel. Prosecution history estoppel is the principle that statements made by an

applicant's patent attorney to a USPTO Patent Examiner during the examination of a patent application may be used against the patent owner if the patent matures into an issued patent and is ever litigated. Typically, prosecution history estoppel applies when a patent owner narrows a claim's scope during prosecution either through amendments or arguments. Prosecution history estoppel prevents the patent owner from recapturing the surrendered claim's scope. This also includes preventing the patent owner from capturing subject matter during litigation that was "foreseeable," even if unclaimed, at the time the claim scope was narrowed.

To better understand prosecution history estoppel, let's use an example similar to the above example. Inventor A files a Patent Application A with the USPTO. Patent Application A includes the following claim: "A stand-up desk comprising metal having a two-tiered organizing system" ("Original Claim A"). The USPTO Patent Examiner then rejects Original Claim A based on a prior art reference that discloses a stand-up desk comprising *aluminum* (a type of metal) having a two-tiered organizing system. In order to circumvent the prior art reference that teaches *aluminum*, Inventor A argues that "A stand-up desk *comprising only iron* having a two-tiered organizing system" is different than a stand-up desk comprising *aluminum* for various reasons and narrows Original Claim A by amending it to the following: "A stand-up desk comprising ~~metal~~ only iron having a two-tiered organizing system" ("Amended Claim A"). Based on the arguments and amendments to Patent application B, USPTO Examining Attorney allows Amended claim A and issues a patent for the Amended Claim A. Competitor B makes a stand-up desk comprising *aluminum* having a two-tiered

organizing system ("Device B"). Competitor B can use prosecution history estoppel as a defense to allegations that Device B infringes on Amended Claim A. Competitor B would argue that Device B does not infringe on Amended Claim A under the doctrine of equivalents because Inventor A narrowed his claim and surrendered all stand-up desks other than stand-up desks having only iron having a two-tiered organizing system.

WHAT DID THE FEDERAL CIRCUIT SAY IN *COBALT BOATS, LLC, V. BRUNSWICK CORPORATION*?

With an understanding of the doctrine of equivalence and prosecution history estoppel, we turn to how prosecution history estoppel doctrine affected the outcome of the *Brunswick* case. In *Brunswick*, Inventor Cobalt ("Cobalt") filed a patent application ("Cobalt Application") with the USPTO. Cobalt's original patent's claim recited terms similar to the following: "a retractable swim step that no rotation at all was required" ("Cobalt's Original Claim"). The USPTO Patent Examiner rejected Cobalt's Original Claim because of a prior art reference that discloses a step "that was rotated 90°." To circumvent the USPTO Patent Examiner's rejection, Inventor Cobalt narrowed Cobalt's Original Claim by amending it to read "a retractable swim step that ~~no rotation at all was required~~ capable of being rotated 180°," and as a result, the USPTO subsequently granted Cobalt United States Patent Serial No. 8,375,880 ("880 Patent") based on Cobalt's amendments.

In litigation, Cobalt asserted that a competitor, Brunswick, made a swim step that rotated *between 172-179*°,

which infringed Cobalt's 880 Patent under the doctrine of equivalents. The Federal Circuit held that the "180°" language added during prosecution to overcome the rejection mentioned above, narrowed the scope of the 880 Patent and surrendered all angles other than 180° at which the retractable swim step is capable of being rotated. As a result, the Federal Circuit ruled that prosecution history estoppel barred Cobalt from asserting that Brunswick's swim step satisfied the "180 degrees" limitation under the doctrine of equivalents and found that the Brunswick device did not infringe on the 880 Patent's claims.

The result in Brunswick Corporation is an example of the powerful effects of Prosecution History Estoppel. The case highlights the importance of carefully drafting a patent's claims. A patent attorney should be careful not to disclaim more than is necessary when prosecuting a patent application. Additionally, a business owner should seek an experienced patent attorney's opinion when evaluating if a device may infringe on a patent's claims on how Prosecution History Estoppel might affect an infringement analysis. The patent attorneys at The Plus IP Firm have drafted thousands of patent applications, and patent infringement opinions and their experience will add value to your decision-making team. This article was written by William Furlow and Derek Fahey. To learn more about Derek Fahey, click HERE.