

Keywords: narrowing amendment; prosecution history estoppel

General: Narrowing amendment to independent claim at issue was not inadvertent, and was made for substantial reason related to patentability, namely, to avoid prior art; prosecuting attorney's declaration that narrowing limitation was added inadvertently cannot be considered in determining reason for amendment, since it is not part of the prosecution history, and prosecution history does not show that reason for amendment was inadvertent.

Pioneer Magnetics Inc. v. Micro Linear Corp.
65 U.S.P.Q.2d 1826 (Fed. Cir. 2003)
Decided February 12, 2003

I. Facts

Pioneer Magnetics (Pioneer) owns U.S. Patent No. 4,677,366 directed to a "unity power factor power supply." The patent describes circuitry designed to receive variant levels of input voltage and to emit a constant output voltage. The initial patent application included independent claim 1 and dependent claims 2-9. The Examiner initially rejected the original claims 1-5 and 8-9 in view of prior art, and rejected claims 6 and 7 as being indefinite. The prior art reference cited by the Examiner did not disclose a switching multiplier circuit or a pulse-width modulator. In the response, Pioneer amended claim 1 to include dependent claims 2-6, and amended claim 7 to depend from the amended claim 1. The amendment to claim 1 changed the "circuit means" limitation to "circuit means including a pulse width modulator." Also, the amendment changed the "multiplier" limitation to "switching analog multiplier circuit." In the remarks, Pioneer stated that the amended claim 6 is shown in independent form. Pioneer included the "switching analog" limitation, which was not in the original claims 1-6, without any explanation.

On December 14, 1995, Pioneer Magnetics brought an action for patent infringement against Micro Linear Corp. in the U.S. District Court for the Central District of California. In motions seeking to interpret the claims, the parties requested that the court identify the equivalents of the "switching multiplier" limitation, which Micro Linear asserted was barred by prosecution history estoppel. Pioneer Magnetics offered a declaration from the attorney who added the limitation to support that the addition of the limitation was inadvertent. The court concluded that a "non-switching multiplier" is outside the permissible range of equivalents because Pioneer narrowed claim 1 by adding the limitations. The parties stipulated that non-infringement should be granted on the grounds that the prosecution history bars Pioneer from asserting the doctrine of equivalents for the "switching analog multiplier circuit" limitation. Accordingly, the District Court granted a summary judgment of non-infringement, which was affirmed by the U.S. Court of Appeals, Federal Circuit. The U.S. Supreme Court granted Pioneer Magnetics petition for writ of certiorari, and remanded the case for reconsideration in light of its decision in *Festo Corp. v. Shoketsu Kinzko Kogyo Kabushiki Co.* On remand, the U.S. Court of Appeals, Federal Circuit, affirmed the noninfringement decision by the District Court.

II. Issues

- A. Did the District Court correctly apply prosecution history estoppel to the claimed limitation?

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- B. Did the District Court correctly determine that Pioneer failed to overcome the presumption that it surrendered the equivalent in question?

III. Discussion

- A. Yes.

To determine whether a claim gives rise to prosecution history estoppel, amendments to the claim must be examined to determine if the amendments narrowed the literal scope of the claim. Then, the court examines why the claim was amended. If no explanation is present, the court should presume that amendment was made for substantial reasons relating to patentability. With regard to the literal scope of the claims, the court held that the claim was clearly narrowed from “multiplier” to “analog switching multiplier,” which is a narrowing amendment. Then, the court examined why the amendment was entered. Pioneer argues that the limitation was inadvertent and unmotivated by any statutory requirements. To support this assertion, Pioneer relied on the declaration from the attorney, the remarks relating to the amendment including dependent claims 2-6 into independent claim 1, the redundancy of the “switching” limitation in view of claim 2, and the voluntary nature of the amendment.

However, the court did not find Pioneer’s arguments persuasive. First, the declaration from the attorney is not part of the public record and cannot be the basis of such a reason. Second, the prosecution history does not provide any reasons for the added limitations. While the remarks section does state that amended claim 1 incorporates dependent claims 2-6, it may have been inadvertent to leave out the reasons for the additional limitation. Thirdly, the “switching” limitation in claim 1 is not redundant because claim 2 includes additional limitations that are not recited in claim 1. Finally, the court held that the mere fact that an amendment is voluntary does not shield it from prosecution history estoppel. The court pointed out that the reference cited against the claims did include a power supply including a non-switching multiplier, which is the equivalent in question.

Accordingly, the Federal Circuit held that the lower court correctly applied prosecution history estoppel to the claimed limitation.

- B. Yes.

The U.S. Supreme Court has held that a presumption can be overcome if (1) the equivalent was unforeseeable at the time of the application; (2) the amendment bears no more than a tangential relation to the equivalent in question; or (3) some other reason exists that the patentee could not reasonably be expected to have described the insubstantial substitute in question.

First, as noted above, the reference cited against the ‘366 patent discloses a non-switching multiplier circuit. As such, the non-switching multiplier circuit is known in the art and would have been foreseeable. Secondly, the amendment was made to avoid prior art that contained the equivalent. Finally, because the equivalent was present in the art, there is no reason why the patentee could not describe the substitute in question.

Accordingly, the Federal Circuit held that the lower court correctly determined that Pioneer failed to overcome the presumption that it surrendered the equivalent in question.

IV. Conclusion

Any amendments to claims, which are made for reasons other than overcoming a prior art reference, should include a statement within the remarks that clearly indicates the reasons for the amendment.