

**Keywords: prosecution history estoppel; doctrine of equivalents; redraft dependent claim into independent form**

***Honeywell International Inc. v. Hamilton Sunstrand Corp.***

Fed. Cir., No. 02-1005, June 2, 2004

**I. Facts**

Honeywell sued Sunstrand for infringement of certain claims in two related patents. The Honeywell patents are directed to an aircraft auxiliary power unit (APU), which is a small gas-turbine engine usually located in the tail section of an airplane. The APU incorporates a compressor to provide compressed air to various systems in the aircraft. Because rapid changes in the demand for compressed air can produce a surge, which can damage the compressor, prior systems included a surge control that produced more air than was needed and vented excess air. However, such prior systems operated inefficiently. In contrast, the Honeywell APU is designed to be more efficient by establishing a “set point” that is selected “as a function of the position of [adjustable] inlet guide vanes” through which ambient air is drawn. The set point is compared to a “flow-related parameter” that represents airflow out of the compressor as determined by a sensor. The actual flow conditions are compared to the set point to control a bleed valve to prevent the buildup of excess pressure that may lead to a surge.

During prosecution, the original independent claims did not contain the inlet guide vane limitation, and these claims were rejected as being obvious in light of prior art. The dependent claims that included the inlet guide vane limitation were objected to as being dependent upon rejected independent claims, but were indicated as being allowable if rewritten into independent form. Accordingly, the limitations from the original independent claims were added to the dependent claims to place them into independent form, and the broader original claims were cancelled.

Sunstrand’s APU device also includes an active surge control system that compares a flow-related parameter to a set point and adjusts a bleed valve in response. However, the Sunstrand APU establishes a set point based upon ambient air temperature, rather than based on the measurement of inlet guide vane position. Before the district court, Sunstrand filed a motion of summary judgment on prosecution history estoppel, urging that Honeywell’s claims were narrowed by amendment and that prosecution history estoppel should bar equivalents for the inlet guide vane limitation under *Festo*. The district court denied Sunstrand’s motion, holding that the elements at issue were not amended because the claims were merely rewritten into independent form. At trial, the jury found that the asserted claims were infringed under the doctrine of equivalents, and Sunstrand appealed.

**II. Issues**

1. Does rewriting an otherwise allowable original dependent claim into independent form, coupled with the cancellation of the broader original independent claim, qualify as a “narrowing amendment” that gives rise to prosecution history estoppel?

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### III. Discussion

1. Yes. Following the Supreme Court's decisions in *Warner-Jenkinson* and *Festo*, along with the Federal Circuit's decisions in *Festo II*, *Deering Precision Instruments, LLC v. Vector Distribution Systems, Inc.* 37 Fed. 3d 1314 (Fed. Cir. 2003) and *Ranbaxy Pharmaceuticals, Inc. v. Apotex, Inc.*, 350 Fed. 3d 1235 (Fed. Cir. 2003), the Federal Circuit held that rewriting dependent claim into independent form coupled with the cancellation of the original independent claims creates a presumption of prosecution history estoppel.

First, the Federal Circuit addressed what type of limitations may give rise to estoppel. Citing the Supreme Court's decision in *Festo*, the Federal Circuit determined that prosecution history estoppel may bar the patentee from asserting equivalents if the scope of the claims has been narrowed by amendment during prosecution. Under *Festo*, "[e]stoppel arises when an amendment is made to secure the patent and the amendment narrows the patent's scope." A submission of an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim. The Federal Circuit relied on both the *Warner-Jenkinson* and *Festo* decisions by the Supreme Court in determining that a narrowing amendment may occur when either (1) a pre-existing claim limitation is narrowed by amendment or (2) a new claim limitation is added by amendment. The Federal Circuit noted that these decisions make no distinction between the narrowing of a pre-existing limitation and the addition of a new limitation, as either amendment will give rise to a presumptive estoppel if made for a reason related to patentability. The Federal Circuit noted that if only narrowing amendments to pre-existing claim limitations could give rise to the presumption, the purpose of preventing patentees from recapturing subject matter conceded during prosecution would be undermined, and astute practitioners, through clever claim drafting, could elect to treat most, if not all, amendments as merely adding new claim limitations rather than narrowing pre-existing ones. Therefore, the Federal Circuit held that an amendment adding a new claim limitation constitutes a narrowing amendment that may give rise to an estoppel.

Next, the Federal Circuit addressed whether rewriting a dependent claim into independent form, coupled with the cancellation of the original independent claim, constitutes a narrowing amendment when the dependent claim includes an additional claim limitation not found in the cancelled independent claim or circumscribes a limitation found in the cancelled independent claim. Again relying on the Supreme Court's holding in *Festo*, the Federal Circuit found that the proper focus is "whether the amendment narrows the overall scope of the claimed subject matter." When the *Festo* case was before the Supreme Court, the United States submitted an *amicus curiae* brief urging the court to adopt the position that rewriting a dependent claim into independent form cannot give rise to a presumption of surrender. The Federal Circuit noted that while the Supreme Court approvingly cited the United States' positions with respect to other issues, it rejected the position of the government in this respect, stating that rewriting a dependent claim in independent form creates a presumptive surrender if the amendment is "made to secure the patent." Thus, the Federal Circuit concluded, "the fact that the scope of the rewritten claim has remained unchanged will not preclude the application of prosecution history estoppel if, by canceling the original independent claim and rewriting the dependent claims into independent form, the scope of subject matter claimed in the independent claim has been narrowed to secure the patent."

The Federal Circuit found that this rule has been consistently applied in post-*Festo* decisions. First citing the *Deering* case, the Federal Circuit held that canceling a broader independent claim and replacing it with the dependent claim rewritten into independent form was a "clear surrender of the broader subject matter" that presumptively barred application of the doctrine of equivalents. Similarly, in the *Ranbaxy* case, the Federal Circuit noted that the original independent claim was rejected, but several dependent claims were indicated as being

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allowable if rewritten into independent form. The patentee responded by canceling the claims and submitting a claim identical to claim 1 and including the limitations from the various dependent claims into a single new independent claim. In the *Ranbaxy* case, the Federal Circuit held that if the amendment “surrendered subject matter that was originally claimed for reasons related to patentability,” there is a presumption of history estoppel.

The Federal Circuit noted that the approach in the *Deering* and *Ranbaxy* cases is consistent not only with the language of *Festo*, but also with its theory. Thus, when a claim is rewritten from dependent into independent form and the original independent claim is cancelled, the correct focus is on whether the amendments surrendered subject matter. Under such circumstances, the surrendered subject matter is defined by the cancellation of independent claims that do not include a particular limitation and the rewriting into independent form of dependent claims that do include that limitation. Equivalents are presumptively not available with respect to that added limitation. Accordingly, the Federal Circuit held that Honeywell is presumptively estopped from recapturing equivalents to the inlet guide vane limitation.

### **Dissent**

Judge Newman dissented in-part. Judge Newman argued that the Federal Circuit’s “new rule” would drive patent applicants away from dependent claims, raise the cost and increase the difficulty of patent examination, and erode the ability of inventors to protect their inventions. Newman argued that treating the act of placing a dependent claim in independent form as a narrowing amendment giving rise to estoppel is contrary to statute. Specifically, Newman relied upon 35 U.S.C. § 112, paragraph 4, which states that a dependent claim shall be construed to incorporate by reference all the limitations of the claim to which it refers. Restating a dependent claim in independent form does not change its content or scope--the claim is of identical content and scope before and after it is rewritten. Newman argued that the court in *Festo* did not change that law. Because a dependent claim rewritten in independent form is, by definition, identical in scope, such an amendment does not qualify as a “narrowing amendment” that may be used to invoke prosecution history estoppel. Other than this argument, Newman’s dissent seemed to be rather disorganized and conclusory.