

Keywords: doctrine of equivalents; prosecution history estoppel; on-sale bar; anticipation; obviousness; substantial evidence

General: The Federal Circuit holds that rewriting a dependent claim into independent form, coupled with the cancelation of its original independent claim, gives rise to prosecution history estoppel.

Honeywell International Inc. v. Hamilton Sundstrand Corp.
370 F.3d 1131, 71 U.S.P.Q.2d 1065 (Fed. Cir. 2004) (en banc)
Decided June 2, 2004

I. Facts

Plaintiff Honeywell owns the '893 and '194 patents, which are directed to an auxiliary power unit (APU), which provides the compressed air needed to start an aircraft's main engines and to control the environment of the aircraft's cabin during flight. Fluctuating compressed air requirements may cause an airflow surge that can damage the APU. Honeywell's APU efficiently controls airflow surge by using inlet guide vane position to determine whether to prevent surge by opening a surge bleed valve. Defendant Sundstrand manufactures an APU device that uses inlet guide vane position to determine whether to block control signals used to operate the surge bleed valve.

During the prosecution of the patents at issue, original independent claims 16 and 32 of the '893 patent and 48 and 49 of the '194 patent were rejected on grounds of obviousness. These independent claims did not include the inlet guide vane limitation. Accordingly, dependent claims 17 and 35 of the '893 patent and 51 of the '194 patent were not allowed because they depended on the aforementioned independent claims. These dependent claims included the inlet guide vane limitation. The patent examiner indicated that dependent claims 17, 35, and 51 would be allowed if they were rewritten in independent form. In response, Honeywell cancelled original independent claims 16, 32, 48, and 49, and rewrote dependent claims 17, 35, and 51 into independent form. The newly rewritten claims were allowed as claims 8 and 19 of the '893 patent and claim 4 of the '194 patent.

Honeywell sued Sundstrand, alleging infringement under the doctrine of equivalents of its '893 and '194 patents. Before the district court, Honeywell argued the doctrine of equivalents established infringement because Sundstrand's APU used inlet guide vane position to efficiently control surge, which is an equivalent function of the inlet guide vane position in the Honeywell APU. Sundstrand, on the other hand, argued the doctrine of equivalents did not establish infringement because the Sundstrand APU used inlet guide vane position for a different function—to determine when to block control signals used to operate the surge bleed valve. In the alternative, Sundstrand argued prosecution history estoppel barred all equivalents for the inlet guide vane limitation because claims 8 and 19 of the '893 patent and claim 4 of the '194 patent were narrowed by amendment. Sundstrand also asserted affirmative defenses and counterclaims that the '893 and '194 patents were invalid as anticipated, obvious, and barred by the on-sale bar. Sundstrand moved for summary judgment on its arguments. The district court denied Sundstrand's motion for summary judgment on prosecution history estoppel and held that Honeywell did not surrender equivalents to the inlet guide vane limitation because no amendment occurred when the dependent claims at issue were rewritten in independent form. The district court also denied Sundstrand's motions for summary judgment on infringement and invalidity because there were genuine issues of material fact.

The jury returned a verdict finding that claims 8 and 19 of the '893 patent (and associated dependent claims) and claim 4 of the '194 patent were infringed by Sundstrand under the doctrine

of equivalents. In addition, the jury found that all asserted claims of the patents at issue were not invalid.

II. Issues

- A. Does the addition of a new claim limitation constitute a narrowing amendment that may give rise to a presumption of prosecution history estoppel?
- B. Does canceling independent claims that omit a particular limitation and replacing them with dependent claims rewritten into independent form that include the particular limitation constitute a narrowing amendment that may give rise to a presumption of prosecution history estoppel?
- C. Was there substantial evidence to support the jury's verdict that the claims at issue were not invalid under the on-sale bar, anticipated, or obvious?

III. Discussion

- A. Yes, the addition of a new claim limitation constitutes a narrowing amendment that may give rise to a presumption of prosecution history estoppel. After noting Supreme Court precedent regarding the tension between the doctrine of equivalents and prosecution history estoppel, including *Warner-Jenkinson* and *Festo*, the court held that narrowing amendments such as (1) narrowing a preexisting claim limitation, or (2) adding a new claim limitation, if made in order to secure a patent, give rise to a presumption of prosecution history estoppel.
- B. Yes, canceling independent claims that omit a particular limitation and replacing them with dependent claims rewritten into independent form that include the particular limitation constitutes a narrowing amendment that may give rise to a presumption of prosecution history estoppel. Because the original independent claims were rejected on grounds of obviousness and indefiniteness, the court stated it was undisputed that the original independent claims were cancelled, and the claims dependent on those cancelled claims were rewritten into independent form, in order to secure a patent. As such, the court framed the remaining issue as whether such amendments constituted narrowing amendments that give rise to a presumption of prosecution history estoppel.

Honeywell argued there was no presumption of prosecution history estoppel because rewriting dependent claims into independent form does not constitute a narrowing amendment. The court disagreed with Honeywell. Specifically, the court argued a narrowing amendment occurred because the claims dependent on the original independent claims that were cancelled included an inlet guide vane limitation, which was absent from the original independent claims. According to the court, because the dependent claims included the inlet guide vane limitation, when they were rewritten into independent form, a new claim limitation, which constitutes a narrowing amendment, was effectively added to the claimed invention. As such, the court reasoned it was immaterial that the scope of the dependent claims did not change when they were rewritten into independent form. Thus, the court held the narrowing amendment gave rise to a "presumptive surrender of all equivalents to the inlet guide vane limitation." Accordingly, this issue was remanded to the district court to determine whether Honeywell could rebut the presumption of surrender.

- C. Yes, there was substantial evidence to support the jury's verdict that the claims at issue were not invalid under the on-sale bar, anticipated, or obvious. Sundstrand argued the claims at issue were invalid under the on-sale bar because certain drawings proved Honeywell's invention was ready for patenting prior to the critical date. A Honeywell expert, on the other

hand, testified that the drawings did not enable a person skilled in the art to practice the invention. The jury resolved this issue in favor of Honeywell. The court held there was substantial evidence to support the jury's verdict that the claims at issue were not invalid under the on-sale bar.

With respect to the anticipation issue, Sundstrand argued a single prior art reference anticipated all of the asserted claims. A Honeywell expert, on the other hand, testified that the prior art reference did not disclose a system capable of maintaining an essentially constant minimum flow rate, as required by Honeywell's claims. The jury resolved this issue in favor of Honeywell. The court held there was substantial evidence to support the jury's verdict that the claims at issue were not invalid on grounds of anticipation.

Finally, with respect to the obviousness issue, Sundstrand argued the claims at issue were obvious in view of the prior art. A Honeywell expert, on the other hand, testified that the Honeywell invention was structurally and functionally different from the invention disclosed in the prior art. In addition, Honeywell introduced evidence of commercial success and copying. The jury resolved this issue in favor of Honeywell. The court held there was substantial evidence to support the jury's verdict that the claims at issue were not invalid on grounds of obviousness.

IV. Conclusion

Narrowing amendments such as (1) narrowing a preexisting claim limitation, or (2) adding a new claim limitation, if made in order to secure a patent, can give rise to a presumption of prosecution history estoppel. Cancelling independent claims that omit a particular limitation and replacing them with dependent claims rewritten into independent form that include the particular limitation constitutes a narrowing amendment that may give rise to a presumption of prosecution history estoppel.

V. Dissent

Judge Newman dissented in part. According to Newman, the dependent claims, which included the inlet guide vane limitation, when rewritten into independent form were not altered in scope; as such, there was no resulting narrowing amendment. Thus, Newman argued, because there was no narrowing amendment, prosecution history estoppel did not apply. As a policy matter, Newman argued the court's holding will create an incentive for patentees to only draft independent claims, which are more expensive and more difficult to examine than dependent claims. Further, Newman argued that canceling a broad independent claim does not constitute a narrowing amendment that gives rise to prosecution history estoppel. According to Newman, this is especially true when the independent claim does not mention the element at issue for equivalency. Lastly, Newman argued the present case was distinguishable from precedent because the inlet guide vane limitation of the dependent claims was not surrendered during prosecution in order to obtain allowance.