

Keywords: prosecution history estoppel; doctrine of equivalents; scope of prosecution history estoppel; presumption of surrender.

General: A narrowing amendment to a claim, even if the amendment does not place the claim in condition for allowance, may result in prosecution history estoppel barring assertion of infringement under the doctrine of equivalents.

Felix v. American Honda

No. 2008-1367 (Fed. Cir. April 10, 2009)

I. Facts

Mark Felix, inventor and holder of U.S. Patent No. 6,155,625 (hereinafter, the “‘625 patent”), filed suit against Honda with the assertion that the Honda Ridgeline’s In-Bed Trunk infringed the ‘625 patent. Specifically, Felix asserted claim 6, which recites in relevant part:

- a) an opening formed in the vehicle bed... b) a compartment... c) said compartment being mounted on said bed... d) a lid assembly... e) a channel formed at the rim of said bed opening and including an inner flange; f) a weathertight gasket mounted on said flange and engaging said lid in its closed position; and g) a plurality of drain holes.

(Emphasis added). As illustrated in FIG. 4 and described in the specification, “gasket 18 is mounted on the inner flange 16 for weather sealing the storage system 2.” ‘625 patent, col. 3, lines 11-12. By comparison, the In-Bed Trunk’s gaskets are affixed not to a flange, but to the lid of the trunk.

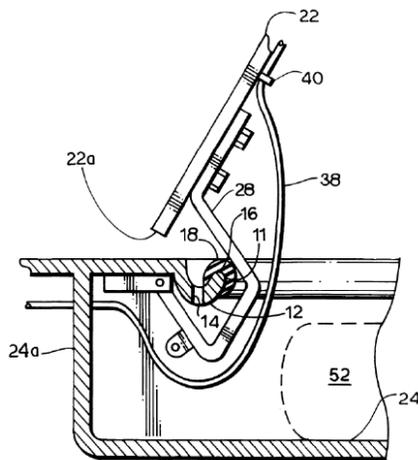


FIG. 4 of the ‘625 Patent

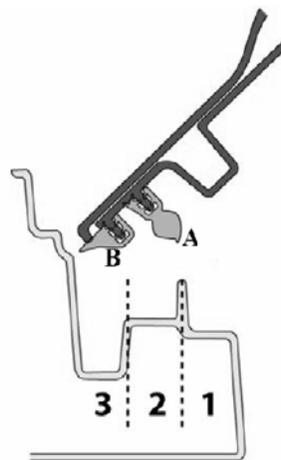


Diagram of In-Bed Trunk’s Gaskets

Issued claim 6 includes limitations originally recited in several original claims. In particular, original independent claim 1 recited limitations corresponding to limitations (a)-(d) of issued claim 6, original claim 7 recited limitations corresponding to limitations (a)-(f) of issued claim 6, and original claim 8 recited limitations corresponding to limitations (a)-(g) of issued claim 6. During prosecution, Felix first rewrote original claim 7 in independent form before rewriting claim 8 in independent form, which ultimately issued as claim 6.

In a first Office Action, the Examiner rejected claim 1 (limitations (a)-(d)) and claim 7 (limitations (a)-(f)) as obvious under Section 103, but indicated that claim 8 (limitations (a)-(g)) would be allowable if rewritten in independent form. Felix cancelled original claims 1 and 7, rewriting claim 7 in independent form as new claim 14 (limitations (a)-(f)) and amending original claim 8 to depend from new claim 14. Felix argued that new claim 14 was nonobvious.

In a second Office Action, the Examiner rejected claim 14 (limitations (a)-(f)) as obvious under Section 103 based on new prior art, and again indicated that claim 8 (limitations (a)-(g)) would be allowable if rewritten in independent form. In response, Felix cancelled claims 8 and 14, rewriting claim 8 as new claim 16 (limitations (a)-(g)). The Examiner allowed claim 16 in a third Office Action, which issued as claim 6.

During a *Markman* hearing, the district court construed the claim term “mounted” to mean “securely affixed or fastened to” and “engaging” to mean “coming together and interlocking.” Because the weatherstrip of Honda’s In-Bed Trunk is not affixed to a flange, the district court concluded Honda did not literally infringe the ‘625 patent. Because the parties had stipulated that prosecution history estoppel applied to the gasket limitation (f), the district court also concluded that Honda did not infringe the ‘625 patent under the doctrine of equivalents.

II. Issue

Does a narrowing amendment, which does not place a claim in condition for allowance, result in prosecution history that may estop an assertion of infringement under the doctrine of equivalents?

III. Discussion

Yes. In response to the first Office Action, Felix had cancelled original claim 1 (limitations (a)-(d)) and rewrote original claim 7 (limitations (a)-(f)) in independent form, thus introducing the channel (e) and gasket (f) limitations into an independent claim. Under *Honeywell Int’l, Inc. v. Hamiton Sundstrand Corp.*, “[t]he rewriting of dependent claims into independent form coupled with the cancellation of the original independent claims creates a presumption of prosecution history estoppel.” *Honeywell*, 370 F.3d 1131, 1134. Accordingly, the Federal Circuit court held that Felix’s amendments gave rise to a presumption of surrender of the channel (e) and gasket (f) subject matter. The court left open the question of whether prosecution history estoppel would have applied as to limitations (e) and (f) had Felix rewritten claim 8 in independent form instead.

Citing *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki*, the Federal Circuit court stated that “[t]he fact that the first amendment did not succeed and that a further amendment was required to place the claim in allowable form... is of no consequence as to the estoppel. It is the patentee’s response to a rejection – not the examiner’s ultimate allowance of a claim – that gives rise to prosecution estoppel.” Op. at 21; *See Festo*, 535 U.S. 722, 727. Thus, the Federal Circuit held in the instant case that “the presumption of prosecution history estoppel attaches when a patentee cancels an independent claim and rewrites a dependent claim in independent form for reasons related to patentability, *even if the amendment alone does not succeed in placing the claim in condition for allowance.*” Op. at 21-22 (emphasis added).

Regarding the scope of prosecution history estoppel brought upon by Felix’s amendment in response to the first Office Action, the Federal Circuit court held that equivalents were presumptively not available as to any of the subject matter in the amendment. Under *Lucent Techs., Inc. v. Gateway, Inc.*, for purposes of determining the scope of surrender of prosecution history estoppel, “It is not relevant... that the applicant did not need to amend the claims... in order to overcome the prior art.” *Lucent*, 525 F.3d 1200, 1218 (Fed. Cir. 2008). Thus, the court

reasoned, “[i]t is immaterial that Felix chose to add both the channel [(e)] and gasket [(f)] limitations, rather than just one.” Op. at 23.

A patent holder may rebut the presumption of prosecution history estoppel on a basis that (1) the alleged equivalent was “unforeseeable;” (2) the “objectively apparent” rationale of the amendment had merely a “tangential” relation to the equivalent at issue; or (3) “some other reason.” See *Honeywell*, 370 F.3d at 1140 (Fed. Cir. 2004). Felix argued unsuccessfully only that the amendment was tangential, and thus the presumption of prosecution history estoppel was not rebutted. Accordingly, the Federal Circuit affirmed the district court’s holding of no infringement by equivalents.

IV. Conclusion

When a patentee rewrites a dependent claim in independent form for reasons of patentability, even if such an amendment fails to place the claim in condition for allowance, prosecution history estoppel may apply to bar assertion of infringement under the doctrine of equivalents.