

**Keywords:** prosecution history estoppel; design patents

**General:** The concept of prosecution history estoppel from utility patents applies to design patents as well. Amendments made in response to a restriction for a design patent can result in prosecution history estoppel.

*Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*

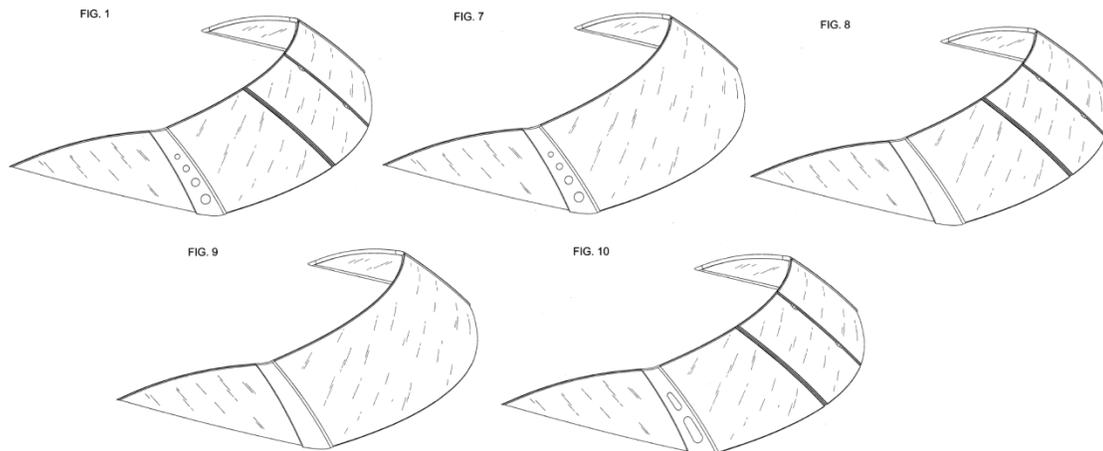
*U.S. Court of Appeals Federal Circuit*

*109 USPQ2d 1225*

*Decided January 8, 2014*

**I. Facts**

Pacific Coast filed a design patent application on April 27, 2006 illustrating various embodiments of a marine windshield with different vent hole configurations. Additionally, the embodiments also illustrated marine windshields that include or exclude hatches. The examiner issued a restriction requirement, identifying five patentably distinct groups of designs as shown below: 1) four circular holes and a hatch (FIG. 1); 2) four circular or square holes and no hatch (FIGS. 7 & 12); 3) no holes and a hatch (FIG. 8); 4) no holes and no hatch (FIG. 9); and 5) two oval or rectangular holes and a hatch (FIGS. 10 and 11).

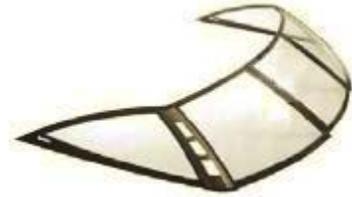


In the response, Pacific Coast elected the group corresponding to FIG. 1 with four circular holes and a hatch. Additionally, Pacific coast cancelled FIGS. 7-12 and amended the claim as follows:

1. (Currently Amended) I claim the ornamental design of a MARINE WINDSHIELD with a frame, and a pair of tapered corner posts ~~with vent holes and without said vent holes, and with a hatch and without said hatch,~~ as shown and described.

The amended application issued as the '070 patent in November 2007. Pacific Coast later obtained the '782 patent in May 2008 as a divisional of the '070 patent. The '782 patent covered the design with no holes and a hatch (FIG. 8). No other divisional applications were filed.

In 2011, Pacific Coast filed suit in the Middle District of Florida, asserting that Malibu Boats induced customers and distributors to infringe the '070 patent. The accused infringing design by Malibu Boats is a boat windshield (*see* right) with three trapezoidal holes on the corner post.



The district court granted Malibu Boats motion for partial summary judgment of non-infringement on the grounds of prosecution history estoppel. The district court found that Pacific Coast surrendered the designs shown in the cancelled figures and amended the claim “in order to obtain the patent.” The district court explained, citing *Festo*, that the accused design is clearly within the territory surrendered between the original claim and amended claim. The district court added that Pacific Coast failed to overcome the presumption of prosecution history estoppel. The district court entered a judgment of non-infringement based on the finding of prosecution history estoppel. Pacific Coast appealed.

## II. Issues

- A. Does the concept of prosecution history estoppel from utility patents applies to design patents?
- B. If yes, then does prosecution history estoppel bar Pacific Coast’s infringement claim?

## III. Discussion

- A. Yes. Prosecution history estoppel has long been recognized to apply to design patents, despite being an issue of first impression for the Federal Circuit. The Federal Circuit noted that with utility patents, prosecution history estoppel limits a patentee’s ability to recover under the doctrine of equivalents, but does not limit literal infringement. Citing *Festo*, the Federal Circuit noted that prosecution history estoppel prevents the patentee from recapturing in an infringement suit the very subject matter surrendered as a condition of receiving the patent. While literal infringement and equivalents infringement are intertwined for design patents<sup>1</sup>, the Federal Circuit noted that the same principles of public notice for prosecution history estoppel apply to both utility and design patents. It is not relevant to the application of prosecution history estoppel that the scope of design patents is defined by the drawings, whereas the scope of utility patents is defined by the claims.
- B. No. The Federal Circuit identified three issues regarding the application of prosecution history to design patents: (1) whether there was a surrender; (2) whether the surrender was to secure the patent; (3) whether the accused design is within the scope of the surrender. The Federal Circuit found that the amendment surrendered designs with two holes and no holes in the corner posts (FIGS. 8, 9, and 10), thereby limiting the design patent to windshields with four holes in the corner post, and colorable imitations thereof. Cancelling figures and deleting claim language referring to alternate configurations narrowed the scope and surrendered subject matter.

With respect to the second issue, the Federal Circuit concluded that Pacific Coast surrendered subject matter to secure the patent. Pacific Coast argued that only surrenders

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<sup>1</sup> See 35 U.S.C. § 289 (imposing liability for infringement of a design patent on anyone who “without license of the owner, (1) applies the patented design, or *any colorable imitation thereof*, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or *colorable imitation* has been applied.” (Emphases added).

to avoid prior art are subject to prosecution history estoppel. The Federal Circuit appeared to distinguish amendments in response to a restriction requirement under 35 U.S.C. § 121 from amendments for patentability (e.g., anticipation (§ 102), obviousness (§ 103), patentable subject matter (§ 101)). Citing *Festo*, the Federal Circuit noted that a narrowing amendment made to satisfy *any* requirement of the Patent Act may give rise to an estoppel. Design patents may only include a single claim,<sup>2</sup> and the examiner identified five patentably distinct groups. The amendments Pacific Coast made in response to the restriction requirement were made “to secure the patent,” as in *Festo*, thereby invoking prosecution history estoppel.<sup>3</sup>

As to whether the third issue on the scope of the surrender, the Federal Circuit held that the accused windshield of Malibu Boats is not within the scope of the surrender by Pacific Coast. The district court held that the three-hole design by Malibu Boats is clearly between the claimed four-hole embodiment and the surrendered two-hole embodiment. Malibu Boats argued that Pacific Coast abandoned the range between four holes and zero holes. However, the Federal Circuit noted that the original design application claimed individual designs rather than ranges. The Federal Circuit stated that “[c]laiming different designs does not necessarily suggest that the territory between those designs is also claimed.” Accordingly, the record only reflects the surrender of the two-hole embodiment. Malibu Boats failed to argue that the two-hole embodiment was not colorably different from the three-hole embodiment, so the Federal Circuit did not need to decide whether the scope of the surrender is measured by the colorable imitation standard.

#### IV. Conclusion

Prosecution history estoppel applies to utility patents and design patents. Under *Festo*, any amendment made for reasons “to secure the patent” may invoke prosecution history estoppel. It is irrelevant whether the amendment is not made to avoid prior art. Even amendments in response to restriction requirements for design patents may invoke prosecution history estoppel.

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<sup>2</sup> See MPEP § 1503.1

<sup>3</sup> The Federal Circuit expressly gave no opinion as to whether this rule would apply to utility patents with surrenders resulting from a restriction requirement.