

PACIFIC COAST MARINE DECISION CONFIRMS APPLICATION OF PROSECUTION HISTORY ESTOPPEL TO DESIGNS

By John M. Fleming

The Federal Circuit handed down a 3-0 decision on Jan. 8, 2014, in *Pacific Coast Marine Windshields Limited v. Malibu Boats, LLC et al.*, recognizing that the concept of prosecution history estoppel applies to design patents. The decision was authored by Judge Dyk, who was joined by Judges Mayer and Chen.

The Federal Circuit overturned a Middle District of Florida's grant of Malibu Boats' motion for summary judgment of non-infringement, finding that prosecution history estoppel barred the infringement claim. The Federal Circuit held that the principles of prosecution history estoppel apply to design patents, but reversed the district court's summary judgment of non-infringement because the accused infringing design was not within the scope of the subject matter surrendered during prosecution.

In April 2006, the owner and CEO of Pacific Coast filed a design patent application claiming "an ornamental design of a marine windshield with a frame, a tapered corner post with vent holes and without vent holes, and with a hatch and without said hatch." The originally filed figures included multiple embodiments with variations of including or not including a front hatch and including or not including various numbers and shapes of vent holes, as shown below.

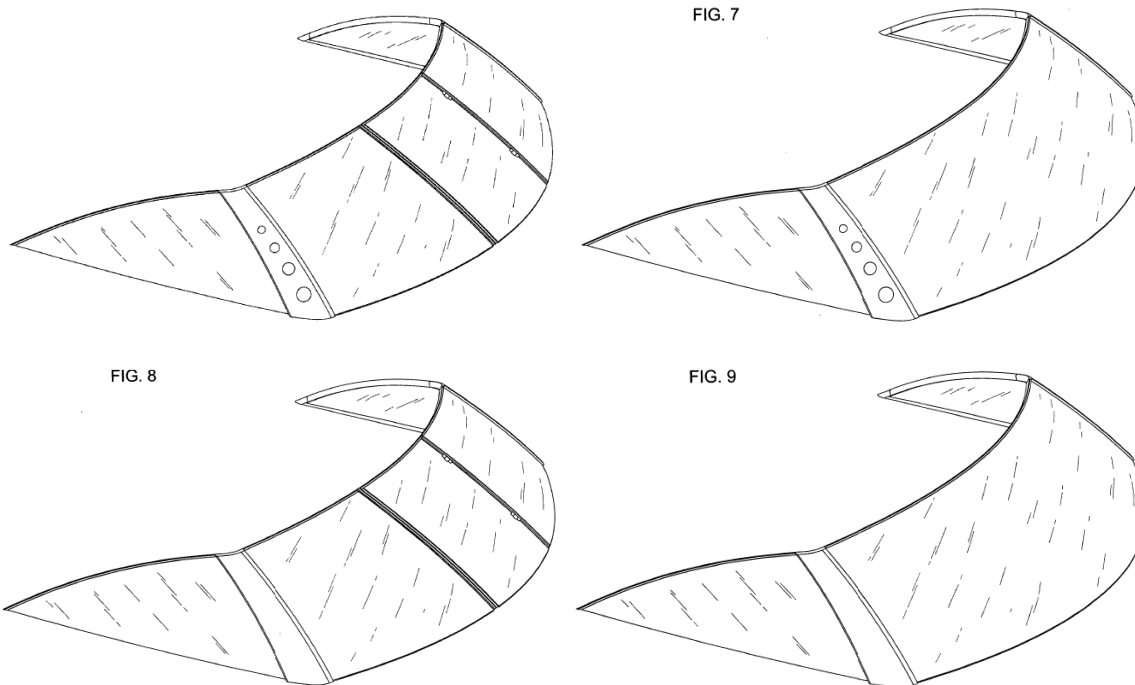
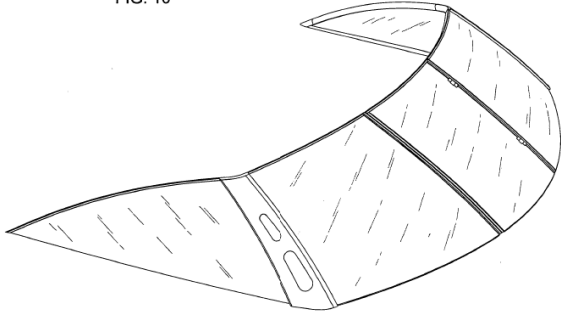
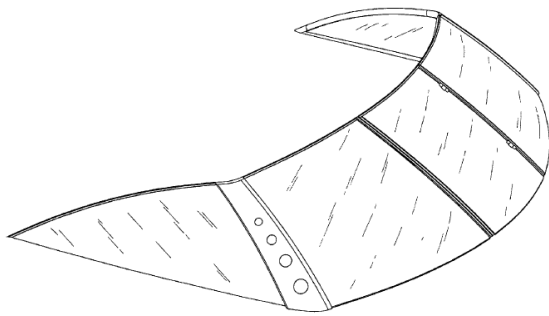


FIG. 10

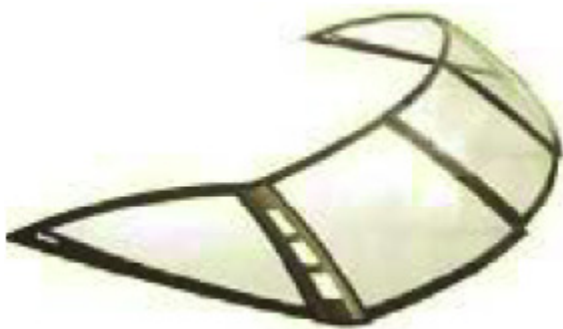


During prosecution, the Examiner issued a restriction requirement identifying five patentably distinct groups of designs. The applicant elected an embodiment having a front hatch and four circular vent holes, as shown below. The design patent issued as US D555,070 on Nov. 13, 2007.



The inventor later obtained a patent for the design with a hatch and no vent holes (FIG. 8 above) as a divisional of the originally-filed application. That issued as US D569,782 on May 27, 2008. No other application to the other non-elected embodiments was filed.

In 2011, Pacific Coast brought suit in the Middle District of Florida against Malibu Boats alleging infringement of the '070 patent based upon the below boat windshield having a hatch and three trapezoidal vent holes.



The district court granted Malibu Boat's motion for summary judgment of non-infringement on the ground of prosecution history estoppel because the applicant surrendered the designs reflected in the canceled figures, the accused design is within the territory surrendered between the original claim and the amended claim, and that the patentee failed to overcome the presumption of prosecution history estoppel.

The Federal Circuit started by recognizing that whether the concept of prosecution history estoppel applies to design patents is one of first impression. The Federal Circuit held that prosecution history estoppel clearly applies to design patents as well as utility patents.

Having determined that the principles of prosecution history estoppel apply to design patents, the Federal Circuit turned to answer three questions: (1) whether there was a surrender; (2) whether it was for reasons of patentability; and (3) whether the accused design is within the scope of the surrender. First, the Federal Circuit held that cancelation of figures showing corner posts with two vent holes and no vent holes was a surrender of those designs and that the applicant conceded that the claim was limited to what the remaining figure showed—a windshield with four vent holes in the corner post—and colorable imitations thereof. Then the Federal Circuit held that although the surrender was not made for reasons of patentability (e.g., anticipation, obviousness or patentable subject matter), the surrender was still made to secure the patent. Since the U.S. Patent & Trademark Office limits design patents to a single claim, a surrender resulting from a restriction requirement invokes prosecution history estoppel if the surrender is necessary to secure the patent. Within the design patent context, the Federal Circuit held that a surrender is necessary to secure the patent when a restriction requirement is invoked and not traversed by the applicant. Finally, the Federal Circuit found that prosecution history estoppel does not bar Pacific Coast’s infringement claim. Although the applicant obtained designs on a four circular vent hole configuration and another on a no vent hole configuration, and surrendered a design on a two vent hole configuration, the applicant neither submitted nor surrendered any three-hole design. “Claiming different designs does not necessarily suggest that the territory between those designs is also claimed.”

Having found that Pacific Coast’s infringement claim is not barred against Malibu Boat’s three vent hole configuration, the Federal Circuit reversed the motion of summary judgment of non-infringement and remanded back to the Middle District of Florida.