In a ruling of first impression, the Federal Circuit Court finds that the Doctrine of Prosecution History Estoppel applies to design patents; Doctrine can limit the scope of the design patent rights; and The common practice of presenting multiple versions of a design in a single design patent application to broaden scope may lead to potential estoppel issues.

In Pacific Coast Marine Windshields v. Malibu Boats (“Pacific Coast”), the Federal Circuit held in a case of first impression that the “principles of prosecution history estoppel apply to design patents.” Applying prosecution history estoppel to design patents may limit scope of enforcement of a design patent based on choices made during patent prosecution. An example of such a choice made during patent prosecution is presenting, and then withdrawing, certain permutations of a design in response to a U.S Patent and Trademark Office (“PTO”) restriction requirement, as was the case in Pacific Coast. Withdrawing a permutation of a design during prosecution that is similar to the design patented may limit the scope of enforcement of the design patent to exclude the withdrawn permutation.

The design patent in Pacific Coast was directed to a windshield for a motorboat. Initially, the applicant (“Pacific”) presented several versions of a windshield design. A first version illustrated four vent holes in the corner of the windshield, a second version illustrated two vent holes and a third version illustrated no holes. The PTO determined that the various versions were separate inventions (or designs) and issued a restriction requirement that required the applicant to elect one of the designs to pursue in that application. The applicant retained the option to file separate applications for the remaining designs if desired. The applicant chose to elect the four-vent-hole design, which then issued as a design patent. The applicant also chose to file a second application on the “no hole” design and obtained a patent for that design as well. However, the applicant did not file an application on its two-hole design.

Pacific sued Malibu Boats (“Malibu”), claiming that Malibu’s three-hole windshield infringed Pacific’s four-hole design patent. Malibu contended that it did not infringe because, under the Doctrine of Prosecution Estoppel, the four-hole design in Pacific’s patent was limited to include only windshields with four holes and could not be broadened under the Doctrine of Equivalents to include a three or two-hole design windshield. The District Court agreed and entered summary judgment for the alleged infringer, Malibu.

On appeal, the Federal Circuit had no trouble deciding that the principles of Prosecution History Estoppel that apply to utility patents also apply to design patents, but noted a significant difference in the infringement standards applicable to utility
Courts Rules That Design Patent Scope Can Be Limited By Prosecution History

patents and design patents. A utility patent either can be infringed literally or can be infringed under the Doctrine of Equivalents. If a patentee surrenders subject matter during prosecution, the patentee cannot assert infringement under the Doctrine of Equivalents for the surrendered subject matter and is estopped under principles of Prosecution History Estoppel from a claim scope that includes the surrendered subject matter. However, prosecution history estoppel does not affect the scope of a claim under the literal infringement standard. In contrast, the standard for finding infringement for a design patent encompasses both literal and Doctrine of Equivalents infringement in a single test. Specifically, infringement is found if the alleged infringing design is substantially similar to the patented design such that it could deceive an ordinary observer into supposing that the alleged infringing design is the same as the patent design. A patentee in a design patent is not required to show that the alleged infringing design is exactly the same as the patent, but only needs to show the designs are sufficiently similar. This is also known as the “colorable imitation” standard, which encompasses both literal and Doctrine of Equivalents infringement standards.

In Pacific Coast, the Court found that the patentee's response to the restriction requirement surrendered subject matter (i.e., the two-hole design) and the surrender was for reasons of patentability. However, because it had not been argued “that the accused design was within the scope of the surrendered two-hole embodiment, no presumption of prosecution history estoppel could arise” as to the three-hole design. Thus, the patentee did not automatically surrender the three-hole design and, implicitly, the design patent could encompass the three-hole windshield design under the “colorable imitation” standard.

Pacific Coast highlights the importance of avoiding estoppel issues by either carefully selecting designs to include in one design patent application or filing multiple design patent applications, either initially or in response to a restriction requirement.
Court Rules That Design Patent Scope Can Be Limited By Prosecution History

Brian Moriarty
Principal
Brian is a seasoned trial attorney, having extensive experience as lead trial counsel in patent and intellectual property cases, such as those concerning the billion-dollar drugs, including Prilosec® and Zofran®. He is one of only a handful of registered patent attorneys in the U.S. who also has served as an Assistant U.S. Attorney.

Brian.Moriarty@hbsr.com
T: 617.607.5900

Mary Lou Wakimura
Principal
Mary Lou has close to 30 years of experience with computer-related technologies and systems relating to imaging, video applications, medical systems, business or transactional methods, bio/chemical analysis and processing, alternative energy, social networks and associated operations, and electro-mechanical matters.

MaryLou.Wakimura@hbsr.com
T: 978.341.0036