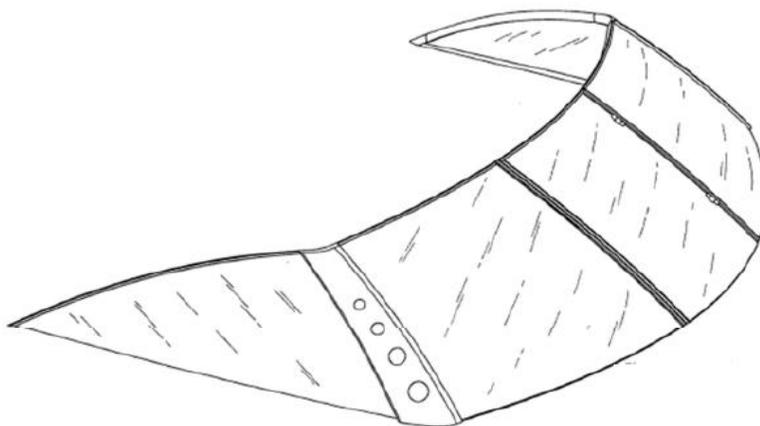


## Prosecution History Estoppel Applies to Design Patents By Alan Herda<sup>1</sup> and Vera Suarez<sup>2</sup>

The concept of prosecution history estoppel prevents a patent owner from later claiming infringement of subject matter that was surrendered to obtain the patent. In a case of first impression, the U.S. Court of Appeals for the Federal Circuit determined that the concept of prosecution history estoppel applies to design patents. *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694 (Fed. Cir. 2014).

Pacific Coast's owner Darren Bach filed a design patent application containing twelve figures illustrating different marine windshield designs. After reviewing the twelve figures, the examiner in charge of the application determined that there were five patentably distinct designs, and required Bach to elect one of the five designs. In response, Bach elected a design that had four vent holes and a hatch, and cancelled all figures that did not illustrate this design. U.S. Patent No. D555,070 (the "'070 Patent") was issued for the elected windshield design (shown below).

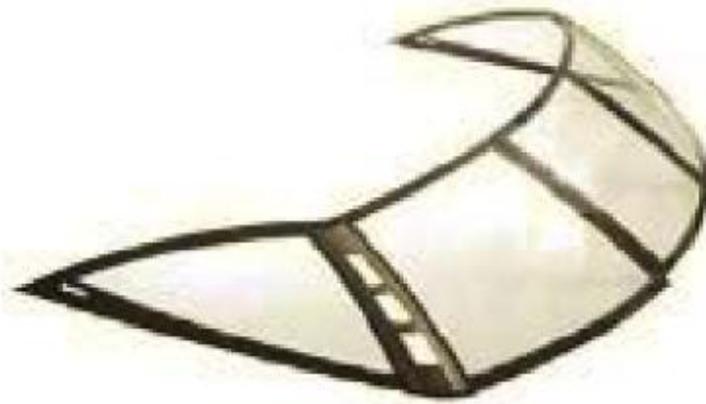


### Patented Design of the '070 Patent (Four Holes)

A few years later, Pacific Coast filed a patent infringement suit against Malibu Boats, claiming that Malibu Boats infringed the '070 Patent. The accused device involved a boat windshield with three vent holes and a hatch (shown below).

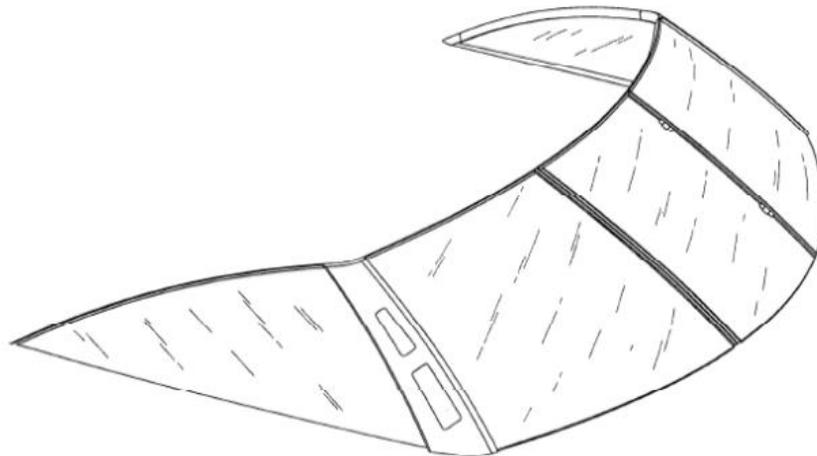
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**Accused Design (Three Holes)**

Malibu Boats filed a motion for partial summary judgment of non-infringement, arguing that due to the doctrine of prosecution history estoppel, Pacific Coast had surrendered its rights to a three vent-hole design when it cancelled the two vent-hole design (shown below). The district court granted the motion and held that, although no figures were cancelled that illustrated the three vent-hole design, the accused design was within “the territory [surrendered] between the original claim and the amended claim.” Therefore, the district court held that Pacific Coast was estopped from claiming that the accused design infringed the ‘070 Patent.



**Relevant Cancelled Design (Two Holes)**

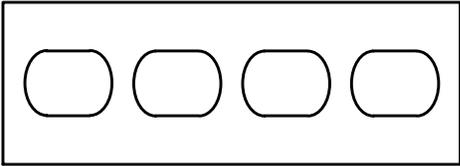
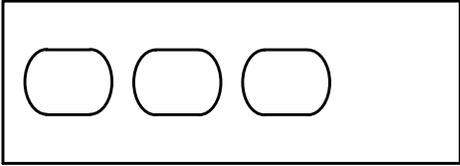
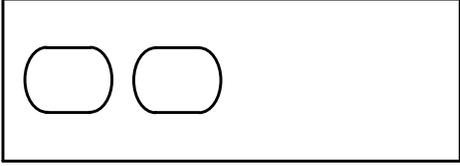
On appeal, the Federal Circuit held that, while the concept of prosecution history estoppel applies to design patents, Pacific Coast was not barred from its infringement claim. The court looked to whether Pacific Coast surrendered subject matter, whether the surrender was for reasons of patentability, and whether the accused design fell within the scope of the surrendered subject matter. The court found that Pacific Coast surrendered claim scope because figures illustrating other designs were indeed cancelled

from the application. Additionally, because the cancellation was in response to a restriction requirement, it was made to secure the patent and thus estoppel could apply. When evaluating whether the accused design fell within the scope of the surrendered subject matter, the court first noted that a design patent applicant cannot surrender “ranges” of a design. Therefore, Malibu Boat’s argument that Pacific Coast gave up the “range” between zero and four vent holes failed. The court provided a reminder that “[c]laiming different designs does not necessarily suggest that the territory between those designs is also claimed.” In this case, the relevant surrender related to the two vent-hole design. The court also noted that Malibu Boats did not argue that the three vent-hole design fell within the scope of the surrendered two vent-hole design based on the “colorable imitation” standard. Instead, Malibu Boats disclaimed this theory at oral argument. Therefore, the court did not have to determine whether the colorable imitation standard should be used when determining the scope of the surrender. In essence, neither party argued that the three vent-hole design fell within the scope of the surrendered two vent-hole design. Therefore, no presumption of prosecution history estoppel could arise, and Pacific Coast’s infringement claim was not barred.

The Federal Circuit’s decision is notable because it clarifies that the doctrine of prosecution history estoppel applies to design patents. Additionally, the cancellation of drawings—even in response to a restriction requirement—can trigger prosecution history estoppel in the design patent context. Whether the scope of surrendered subject matter is determined using the “colorable imitation” standard, however, remains an open issue.

**Hypothetical Designs in light of *Pacific Coast***

To try and make more sense of *Pacific Coast* and the ramifications thereof, set forth below are hypothetical designs, comments on what *Pacific Coast* tells us about the hypothetical designs, and comments on what *Pacific Coast* does not tell us about the hypothetical designs:

<p><b>Hypothetical <u>Claimed</u> Design in Design Patent  (“Four-Hole Design”)</b></p>	
<p><b>Hypothetical <u>Accused</u> Design  (“Three-Hole Design”)</b></p>	
<p><b>Hypothetical <u>Cancelled</u> Design/Surrendered-to- Public Design  (“Two-Hole Design”)</b></p>	

What we **do** know from *Pacific Coast*:

- The Two-Hole Design can never infringe the Four-Hole Design because the Two-Hole Design was cancelled from the original design patent application and thus surrendered to the public domain.
- The cancellation of the Two-Hole Design does not necessarily mean that the Three-Hole Design was also surrendered to the public domain.

What we do **NOT** know from *Pacific Coast*:

- Was the Three-Hole Design surrendered to the public domain because the Two-Hole Design was surrendered to the public domain?
- What is the test to determine whether the Three-Hole Design was surrendered to the public domain along with the Two-Hole Design?
- Does the Three-Hole Design infringe the Four-Hole Design?

#### **Recommendations in light of *Pacific Coast***

Several recommendations flow from *Pacific Coast*. First, an applicant should carefully analyze alternate designs when preparing an initial design patent application, to determine whether each and every alternate design needs to be illustrated in the application. A claimed design that is generic to all of the alternate designs should be considered. Second, an applicant should not depend on claiming “ranges” using figures; for example, if one, two, three, and four-hole designs are each important in and of themselves and a generic claim is not possible, then figures illustrating each of these designs should most likely be included in the initial design application(s). Third, an applicant should consider arguing against attempts by the Patent Office to divide an initial design patent application into two or more groups of designs. Finally, if a design must be cancelled from an initial design patent application, an applicant should **strongly consider** filing a divisional application covering that cancelled design (otherwise the applicant has given its competitors a clearly noninfringing design!).