

PACIFIC COAST MARINE WINDSHIELDS LTD. v. MALIBU BOATS, LLC, Appeal No. 2013-1199 (Fed. Cir. January 8, 2014). Before Dyk, Mayer, and Chen. Appealed from M.D. Fla. (Judge Antoon).

Background:

In response to a restriction requirement, Pacific Coast amended its design patent application to only include a boat windshield with four holes on a corner post. Therefore, Pacific Coast canceled figures in the application directed toward embodiments including two holes on the corner post and no holes on the corner post.

The amended application issued as a patent (the '070 patent), and Pacific Coast filed a divisional application directed toward the embodiment having no holes on the corner post. However, Pacific Coast did not file another divisional application with respect to the embodiment having two holes on the corner post. Pacific Coast sued Malibu Boats, alleging infringement of the '070 patent. Malibu Boats' accused infringing design includes a boat windshield with three holes on a corner post (a comparison of the '070 Patent and the Malibu Boats' design is attached).

The district court found that during prosecution, Pacific Coast surrendered designs in its application in order to obtain a patent. The court further found that Malibu Boats' windshield design is within the "territory" surrendered by Pacific Coast. Therefore, the district court held that Pacific Coast is now estopped from asserting infringement of the '070 patent against Malibu Boats' accused windshield design.

Issues/Holdings:

Did the district court err in holding that prosecution history estoppel applies to design patents? No, affirmed. Did the district court err in holding that Malibu Boats' windshield design is within the claim scope surrendered by Pacific Coast? Yes, reversed and remanded.

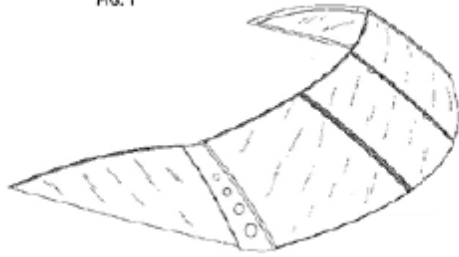
Discussion:

In a case of first impression, the Federal Circuit ruled that prosecution history estoppel applies to design patents. Specifically, the court held that when subject matter is surrendered during prosecution of a design patent, prosecution history estoppel prevents the patentee from "recapturing in an infringement action the very subject matter surrendered as a condition of receiving the patent." The court reasoned that prosecution history estoppel in design patents is necessary to serve the principles of public notice regarding the scope of the claimed invention.

The court then considered Pacific Coast's claim of infringement. The court first confirmed that Pacific Coast surrendered claim scope during prosecution by canceling figures showing corner posts with two holes, and that this claim scope was surrendered in order to secure the '070 patent. The court clarified that prosecution history estoppel is not limited to claim scope surrendered to avoid prior art, but can also include claim scope surrendered in response to a restriction requirement if the surrender was necessary to secure the patent.

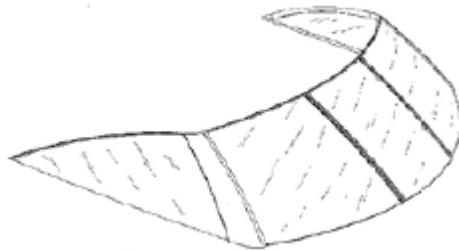
Finally, the Federal Circuit ruled that Malibu Boats' windshield design is not within the claim scope surrendered by Pacific Coast. Pacific Coast only surrendered designs with two holes on the corner posts, not designs including three holes. Accordingly, the Federal Circuit ruled that prosecution history estoppel principles do not bar Pacific Coast's infringement claim, and it remanded for further proceedings.

FIG. 1

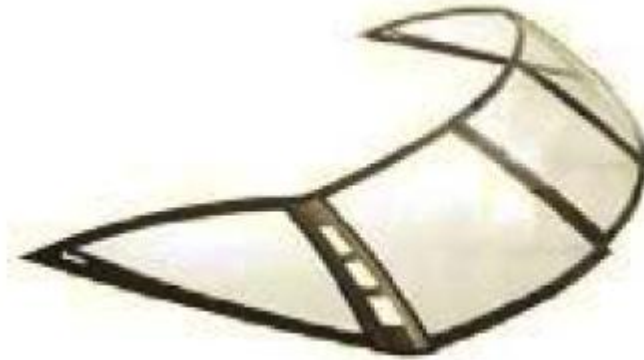


Pacific Coast's boat windshield design in the '070 Patent
(embodiment with four holes on the corner post)

FIG. 6



Pacific Coast's boat windshield design in the divisional application
(embodiment with no holes on the corner post)



Malibu Boats' accused infringing boat windshield design
(three holes on the corner post)