

COLIBRI HEART VALVE, LLC v. MEDTRONIC COREVALVE, LLC, Appeal No. 2023-2153 (Fed. Cir. July 18, 2025). Before Taranto, Hughes, and Stoll. Appealed from C.D. Cal. (Judge Carter).

Background:

Colibri sued Medtronic for patent infringement. Colibri's patent claims a method with a "*pushing-out*" step for deploying a valve. During prosecution of this patent, the Patent Office rejected, for lack of written description support, a separate independent claim (claim 39) involving a step of "*retracting*" the outer sheath to expose the valve. Colibri canceled this claim 39, and the claim that includes the "*pushing-out*" step (claim 34) was issued.

Medtronic contended that its product involved partial deployment by retracting, not pushing. In its answer, Medtronic raised defenses of invalidity and non-infringement based on prosecution history estoppel. That is, Medtronic argued for non-infringement because its product corresponded to cancelled claim 39, which Colibri disclaimed.

During trial at the district court, Colibri dropped its assertion of literal infringement and relied on the doctrine of equivalents (DOE) to establish infringement. The district court found Medtronic liable for infringement and awarded \$106 million in damages to Colibri. Medtronic filed for JMOL on the ground that Colibri's DOE claim was barred by prosecution history estoppel, which was denied. Medtronic appealed the judgment.

Issue/Holding:

Is infringement based on DOE barred by prosecution history estoppel? Yes. Reversed.

Discussion:

The Federal Circuit held that cancellation of a claim may give rise to prosecution history estoppel. In view of Calibri's acknowledgement that there is substantive linkage between the cancelled and retained claims, the Federal Circuit held that claim 34 (issued claim 1) and canceled claim 39 are substantially related. In this regard, the Federal Circuit held that the cancellation of claim 39 and prosecution of claims that already appeared in retained claim 34 (issued claim 1) effectively amounts to a narrowing amendment, for the purpose of prosecution history estoppel.

The Federal Circuit further held that there is no need for claim 1 itself to be amended for prosecution history estoppel to apply. The Federal Circuit indicated that "*Colibri's own basic-physics logic for its affirmative assertion of equivalence, is enough to cross the estoppel threshold.*" Therefore, the cancellation of claim 39 gave rise to prosecution history estoppel.

Accordingly, the Federal Circuit held that Medtronic was entitled to JMOL of noninfringement.