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Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC

739 F.3d 694 (Fed. Cir. 2014)

BRIAN KOBASHIGAWA*

BACKGROUND

In April 2006, Plaintiff Pacific Coast Marine Windshields Ltd. (“Pacific Coast”) filed a design patent application for a boat windshield. The application contained multiple designs, each with different vent hole and hatch configurations. The patent examiner determined that the various configurations represented at least five patentably distinct groups of designs and issued a restriction requirement.

In response, Pacific Coast selected one of the designs and removed the other four from the application. The patent examiner approved Pacific Coast’s application and issued U.S. Patent No. 555,070 (the “’070 patent”) for a windshield consisting of four circular holes on the corner post and a hatch on the front. Following the grant of the ’070 patent, Pacific Coast applied for and obtained a patent for one of the other four designs: a hatch with no vent holes. Pacific Coast did not pursue patents for any of the other designs.

In 2011, Defendant Malibu Boats, Inc. (“Malibu Boats”) manufactured and sold a boat windshield that included three trapezoidal holes on its corner posts. Pacific Coast brought suit against Malibu Boats, alleging that the trapezoidal windshield design infringed the ’070 patent. Pacific Coast also alleged that Malibu Boats had induced customers and distributors to infringe the ’070 patent.

The district court granted summary judgment in favor of Malibu Boats on the grounds of prosecution history estoppel. The court determined that Pacific Coast had surrendered the designs depicted in the cancelled drawings. The court noted that Malibu Boat’s windshield fell within the territory Pacific Coast had surrendered between its initial and amended application for the ’070 patent. Pacific Coast appealed.

ISSUE

On appeal, the Federal Circuit discussed two issues: (1) whether the doctrine of prosecution history estoppel applies to design patents and, if so, (2) whether the doctrine should bar Pacific Coast’s infringement claim.

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DECISION

The Federal Circuit held that the doctrine of prosecution history estoppel applies to design patents, but reversed the district court's grant of summary judgment after determining that the allegedly infringing design did not fall within the scope of the subject matter surrendered.

REASONING

The court began by noting that, although treatises and district courts have long recognized that the doctrine of prosecution history estoppel applies to design patents, this was an issue of first impression for the Federal Circuit.

Turning to public policy, the court observed that the doctrine of prosecution history estoppel is rooted in the public notice function of patent claiming requirements—namely, putting the public on notice as to what the patent does and does not cover. To effectuate that purpose, the patent is viewed in light of the proceedings of the application process. When an applicant surrenders patentable subject matter during the application process, prosecution history estoppel precludes the applicant from recapturing the surrendered material in an infringement action.

The court then discussed several differences between design and utility patents, ultimately concluding that the doctrine applies to both. First, while the two theories of infringement for utility patents, the doctrine of equivalents and literal infringement, are distinct (with prosecution history estoppel limiting recovery only under the latter), they are intertwined when it comes to design patents. In contrast to the strict standard of literal identity applied to utility patents, the test for infringement of design patents requires only that the accused and patented designs be sufficiently similar¹ or that the accused design be a colorable imitation² of the patented design. The Federal Circuit held that, despite these differences, the public notice function of prosecution history estoppel is still served when applying the doctrine to design patents. Allowing prosecution history estoppel to apply to design patents promotes the clarity that is necessary to encourage advancement in “Science and useful Arts.”³

Second, even though design patents define the scope of the patent through drawings, rather than claim language (as in utility patents), the court found that such a distinction should not prevent the application of the doctrine to design patents. Thus, the Federal Circuit held that the doctrine of prosecution history estoppel applies to design patents. To do otherwise, the court held, would undermine the public notice function of patent claiming requirements.

1. *Pac. Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 701 (Fed. Cir. 2014) (citing *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 683 (Fed. Cir. 2008)).

2. *Id.* (citing 35 U.S.C. § 289 (2012)).

3. U.S. CONST. art. I, § 8, cl. 8.

The Federal Circuit then turned its attention to three questions that would aid in the determination of whether the doctrine should bar Pacific Coast's infringement claim. Specifically, the court considered: (1) whether there was a surrender, (2) whether the surrender was for reasons of patentability, and (3) whether the accused design was within the scope of the surrender.

The Federal Circuit first determined there was a surrender. The court stated that courts must look to the requisite drawings of design patents, instead of the wording of the claims (as in utility patents), for purposes of prosecution history estoppel. The court then held that “[b]y cancelling figures showing corner posts with two holes and no holes, the applicant surrendered such designs and conceded that the claim was limited to what the remaining figure showed—a windshield with four holes in the corner post—and colorable imitations thereof.”⁴ Relying on *Honeywell International Inc. v. Hamilton Sundstrand*,⁵ the court found it of no importance that Pacific Coast had surrendered the alternative designs via cancellation rather than amendment; the designs had still been surrendered.

Reaching the second question, the Federal Circuit held that while the surrender was not made for common reasons of patentability (for example, obviousness), it was still “was made *to secure the patent*.”⁶ Unlike utility patents, design patents may have only one claim. Thus, if an application for a design patent includes more than one patentable design, the patent examiner must require the applicant to restrict the claims to a single design. Accordingly, the Federal Circuit determined that when the examiner imposed the restriction requirement, she did not do so as a mere matter of “administrative convenience,”⁷ and when Pacific Coast restricted its claims in response, it did so to secure a patent.

Pacific Coast argued that only surrenders to avoid prior art fall within the doctrine of prosecution history estoppel. But the Federal Circuit quickly dismissed this argument using the Supreme Court's ruling that “a narrowing amendment made to satisfy *any* requirement of the Patent Act may give rise to an estoppel.”⁸ Thus, the court held that a surrender of a design claim arising from a restriction requirement results in estoppel if the surrender was essential to securing the patent. The court made it clear, however, that it was expressing no opinion as to whether the same rule should apply to utility patents.

As to the third question, the Federal Circuit was not persuaded by Malibu Boats' argument that by initially submitting designs with zero, two, and, four holes, but later surrendering the two-hole design and obtaining a patent on the zero- and four-hole designs, Pacific Coast had surrendered the range between zero to four. The court found Malibu Boats' range concept

4. *Pac. Coast*, 739 F.3d at 703.

5. 370 F.3d 1131 (Fed. Cir. 2004) (en banc).

6. *Pac. Coast*, 739 F.3d at 703 (emphasis added).

7. *Id.*

8. *Id.* at 703–04 (citing *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 736 (2002)).

inapplicable in the context of design patents, where applicants claim individual designs, not ranges. Since claims to multiple designs do not necessarily imply that the territory between those designs are also claimed, surrendering claims to designs does not necessarily mean the territory between those designs is also surrendered. The court held that, although Pacific Coast had obtained patents on four-hole and zero-hole designs and had surrendered a two-hole design, Pacific Coast neither submitted nor surrendered any three-hole design.

Because it was never argued that the scope of the surrendered two-hole design extended to the three-hole design because the three-hole design was not colorably different from the two-hole design, the court did not reach the issue of whether the scope of surrender should be measured by the colorable imitation standard. Consequently, the Federal Circuit held that Pacific Coast's infringement claim against Malibu Boats' three-hole design was not estopped, reversed the motion of summary judgment finding of non-infringement, and remanded the case to the district court.