



Cancellation of Independent Claims in IPR Does Not Estop Doctrine of Equivalents Arguments for Surviving Dependent Claims

Jan 31, 2022

Reading Time : 1 min

By: Jason Weil, Rubén H. Muñoz, Megan Mahoney (Law Clerk)

Plaintiff Columbia University asserted patent infringement against Defendant Norton's antivirus software, including under the doctrine of equivalents. Defendant challenged the patents in an IPR, and the PTAB found unpatentable all independent claims of one of those patents. There was no motion to amend filed in the IPR. Later, in the district court, Defendant moved for partial summary judgment, arguing that amendment-based prosecution history estoppel forecloses a doctrine of equivalents argument related to the surviving dependent claims of that patent. Specifically, Defendant argued that cancellation of an independent claim to pursue dependent claims gives rise to a presumption of prosecution history estoppel. In response, Plaintiff noted that no court has ever applied amendment-based estoppel to the cancellation of independent claims in IPR proceedings.

The court explained that, under amendment-based estoppel, there is a presumption that a narrowing amendment made to achieve patentability during prosecution surrenders the entire subject matter—including any equivalents—between the original claim limitation and the amended claim limitation. Here, the court found that the mere fact of claim cancellation during IPR, without accompanying argument, could not give rise to amendment-based prosecution history estoppel. Accordingly, Plaintiff was not estopped by amendment-based estoppel from pursuing its infringement claim under a doctrine of equivalents theory.

Practice Tip: Patent owners seeking to assert infringement under the doctrine of equivalents should be mindful of possible estoppel resulting from patentability arguments and claim amendments. At least one court has found however, that mere cancellation of independent

claims in an IPR will not preclude a doctrine of equivalents theory for remaining dependent claims.

Trustees of Columbia University in the City of New York v. NortonLifeLock Inc., 3-13-cv-00808 (E.D.V.A. Dec. 23, 2021)

Categories

Patent Trial & Appeal Board

Inter Partes Review

Doctrine of Equivalents

© 2025 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. Prior results do not guarantee a similar outcome. Akin is the practicing name of Akin Gump LLP, a New York limited liability partnership authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG. For more information about Akin Gump LLP, Akin Gump Strauss Hauer & Feld LLP and other associated entities under which the Akin Gump network operates worldwide, please see our Legal Notices page.