



Federal Circuit: Cancellation of Closely Related Claims Triggers Prosecution History Estoppel and Limits Infringement Scope

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The Federal Circuit reversed a district court's denial of judgment as a matter of law on non-infringement, thereby setting aside a \$106 million jury verdict, after holding that prosecution history estoppel barred the patentee from asserting infringement under the doctrine of equivalents.

During prosecution of the asserted patent, which is directed to methods for implanting a prosthetic heart valve that permits partial deployment and recapture if it is incorrectly positioned, the patentee initially included two independent claims: one reciting deployment by “**pushing** out the valve from an outer sheath of the delivery apparatus” and another by “**retracting** the outer sheath to expose the valve.” The examiner rejected the “retracting” claim for lack of written description, and the patentee cancelled it. The remaining “pushing” claim issued.

In the district court, the parties disputed the construction of the “pushing out” term. The district court adopted the accused infringer's proposed construction, which required a force to move the pusher out of the sheath. The accused infringer moved for summary judgment of non-infringement, arguing that prosecution history estoppel precluded infringement under the doctrine of equivalents. The court denied summary judgment, reasoning that the cancelled claim was separate and distinct from the issued claim and that the patentee's proposed equivalent used a combination of pushing and retraction.

During trial, the patentee initially pursued literal infringement of the “pushing” claim but ultimately relied on the doctrine of equivalents after the accused infringer contended that

the accused product used “retraction,” not “pushing,” to deploy the valve. A jury found infringement and awarded the patentee over \$106 million in damages. Before and after the verdict, the accused infringer moved for judgment as a matter of law on non-infringement, but the district court denied it.

The Federal Circuit reversed. The Federal Circuit emphasized that the cancelled claim and the asserted claim differed only in how the valve was deployed—i.e., by “retracting” versus “pushing.” According to the Federal Circuit, the patentee’s cancellation of the “retracting” claim as well as the close relationship of the subject matter of the cancelled claim and the asserted claim triggered prosecution history estoppel, which limited the scope of the issued “pushing” claim.

In making its decision, the Federal Circuit rejected the district court’s formalistic approach that estoppel does not apply unless the asserted claim was amended during prosecution. Instead, the Federal Circuit focused on the public notice function of prosecution history estoppel and whether “[a] skilled artisan reading the prosecution history would understand that some narrowing [of the scope of the issued claim] had occurred” when the patentee cancelled a claim that was “closely related” to the issued claim. If so, then “the doctrine of equivalents [is] unavailable” because allowing the patentee to now argue that “retracting” is equivalent to “pushing” would effectively recapture subject matter that it had given up during prosecution. Accordingly, the Federal Circuit reversed the district court’s denial of judgment as a matter of law as to infringement.

Practice Tip: Practitioners should be aware that cancelling claims during prosecution—particularly ones closely related to the allowed claims—can limit the patentee’s ability to later assert that the subject matter of the cancelled claims is equivalent to or otherwise encompassed in the scope of the asserted claims. On the other hand, practitioners facing an allegation of infringement under the doctrine of equivalents should evaluate what claims the patentee cancelled or amended during prosecution to determine whether estoppel may apply.

Colibri Heart Valve LLC v. Medtronic CoreValve LLC, No. 23-2153 (Fed. Cir. July 18, 2025)

Categories

Federal Circuit

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