

Federal Circuit Ruling Broadens Reach of Prosecution History Estoppel to Include Canceled Claims

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Prosecution history estoppel typically arises when a claim is rejected during prosecution and is then amended (narrowed) to overcome the rejection. However, in *Colibri Heart Valve LLC v. Medtronic CoreValve, LLC*, No. 2023-2153 (Fed. Cir. July 18, 2025), the U.S. Court of Appeals for the Federal Circuit held that prosecution history estoppel can be triggered by simply canceling a claim — even when the canceled claim is a standalone independent claim that was not itself amended during prosecution. This decision broadens the reach of the prosecution estoppel doctrine by rejecting the notion that for estoppel to apply, the patentee must have amended the particular claim that ultimately issued.

U.S. Patent No. 8,900,294, owned by Colibri Heart Valve LLC (Colibri), claims a method for implanting a replacement heart valve. At the outset of prosecution, two independent claims were presented for examination: one that claimed “pushing” the valve from an outer sheath of a delivery apparatus, and the other that claimed “retracting” the outer sheath to expose the valve. The examiner rejected the “retracting” claim for lack of written description support under 35 U.S.C. §112, and Colibri canceled it without any amendment.

Colibri sued Medtronic CoreValve LLC (Medtronic), a manufacturer of replacement heart valves, in district court for infringement of the granted “pushing” claim, alleging that, under the doctrine of equivalents, Medtronic was inducing surgeons to perform the claimed method by using Medtronic’s heart valve product. Medtronic argued that its product involves “retracting,” not “pushing,” the valve, and sought judgment as a matter of law that prosecution history estoppel as to the canceled “retracting” claim precluded Colibri’s use of the doctrine of equivalents. The district court disagreed with Medtronic, on grounds that the canceled claim was “an independent claim separate from” the retained claim, and the case proceeded to trial. The jury found that Medtronic had induced infringement under the doctrine of equivalents and awarded more than \$106 million in damages to Colibri.

In reversing the jury verdict, the Federal Circuit concluded that prosecution history estoppel, based on the canceled “retracting” claim, bars application of the doctrine of equivalents. In arriving at its decision, the Federal Circuit determined that prosecution history estoppel goes beyond narrowing a particular claim’s terms; it can be triggered by canceling “closely related” claims and/or claims involving “intertwined terminology” when such cancellation would communicate to a person of skill in the art that the scope of the retained claims has also been narrowed. Here, it was determined that a skilled person would consider the canceled “retracting” claim to be closely related substantively to the retained “pushing” claim based on the similar language used in claims as well as Colibri’s own affirmative theory of equivalence that pushing necessarily accompanies retracting. Thus, the

court concluded that canceling the “retracting” claim conveyed a message that the scope of the “pushing” claim had been narrowed. It was further noted that if Colibri wished to capture subject matter involving “retracting” that was outside of the scope of the retained “pushing” claim, it could have filed a continuation application and there sought to show written description support.

This decision makes clear that prosecution history estoppel not only applies to claims that are amended but may also arise from claims that are canceled. Practitioners should be strategic in their claim cancellation decisions and further consider pursuing canceled claims in a continuing application to avoid creating a presumption of prosecution history estoppel as to the canceled subject matter. This decision further underscores the importance of presenting narrowly tailored claims at the outset of prosecution that anticipate possible grounds for future rejection and are drafted to avoid them.

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