

Prosecution History Disclaimer Decision Highlights Risk of Not Contesting Restriction Requirement

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In *Focus Products Group International, LLC v. Kartri Sales Co., Inc.*, No. 2023-1446 (Fed. Cir. Sept. 30, 2025), the Federal Circuit reversed patent infringement findings, holding that a patentee's failure to contest an examiner's restriction requirement can create an affirmative disclaimer of unelected subject matter, even for a claim that otherwise broadly covers the unelected subject matter. This decision demonstrates how restriction practice can be used to limit a broadly drafted claim and highlights the importance of challenging examiner-imposed claim restrictions.

Background

This case involved three related utility patents: U.S. Patent Nos. 6,494,248 ('248 patent), 7,296,609 ('609 patent) and 8,235,088 ('088 patent), which are owned by Focus Products Group International, LLC (Focus) and its predecessors.^[1] The patents cover "hookless" shower curtains, which do not require a hook to attach to a shower rod, but instead attach to the rod through a series of reinforced ring openings that are embedded within the curtain's top end.

During prosecution of the '248 patent, the patent examiner issued a restriction requirement identifying multiple patentably distinct species of shower ring openings and required election of one species for prosecution on the merits. Although the examiner did not describe what was distinct about each species, the examiner characterized the different groups by reference to the application figures, with different claimed species being drawn to different sets of figures. One species of rings was characterized by reference to figures 18-20, which depict rings as having a "finger configuration" and/or an "offset slit." Another species was characterized by reference to figure 21, depicting rings having a "flat upper edge."

'248 patent, Figures 18-21

Patentee responded to the restriction requirement by electing the species of rings based on figures 18-20, having the finger configurations and/or offset slit. The election was made "without traverse," and no statements objecting to the examiner's characterization of the claims were included in patentee's response. Instead, patentee canceled the claims that were pending and added new claims that patentee affirmed were all "directed to the elected inventions only." However, among the newly added claims was dependent claim 73 that recited a ring

having “a flat upper edge.”

The examiner reviewed the newly added claims and issued a non-final office action in which claim 73, among other claims, was identified as being improperly “drawn to a nonelected species” and was withdrawn. Notably, however, the examiner did not find independent claim 61, which claim 73 depended on, to be drawn to unelected subject matter, even though claim 73 was broadly encompassed by claim 61 and only differed from claim 61 by expressly reciting “a flat upper edge along at least a portion of said ring.” In its response to the non-final office action, the patentee did not clarify the scope of claim 61, *e.g.*, by identifying it as a generic claim that reads upon multiple embodiments illustrated in the application figures, including embodiments having a flat upper edge, nor did it otherwise contest the examiner’s characterization and withdrawal of claims.

Finally, in the notice of allowance, the examiner canceled claim 73 as being “drawn to a non-elected species without traverse.” The examiner invited the patentee to contest the cancellation should patentee find it “unacceptable.” Patentee did not object. The ‘248 patent issued with no claims reciting a flat upper edge.

During prosecution of the ‘609 patent, patentee also elected the species based on figures 18-20 without objecting to how the examiner characterized the species. Like the ‘248 patent, the ‘609 patent issued with no claims reciting a flat upper edge.

The ‘088 patent relates to shower curtain rings having a “projection edge” that projects from the ring’s outer circumference. Figure 31B illustrates an embodiment of the ‘088 patent:

‘088 patent, Figure 31B

During prosecution, the examiner rejected all the ‘088 claims “on the ground of nonstatutory obvious-type double patenting” in view of the claims of the ‘248 and ‘609 patents. In response, patentee amended the ‘088 claims to distinguish them from the other patents by reciting that the ring includes, among other things, “a flat upper edge.” The examiner then withdrew the double patenting rejection, stating: “as the claims have been amended to incorporate the limitation of the flat upper edge which is drawn to a species which is not encompassed with the species as set forth in the applicant’s prior patents[,] the double patenting rejection is no longer applicable.” Patentee did not object to the examiner’s characterization and the ‘088 patent issued with claims requiring a flat upper edge.

Focus sued Kartri Sales Co., Inc. and Marquis Mills, International, Inc. (collectively, Kartri), in district court for patent infringement of the ‘248, ‘609, and ‘088 patents based on Kartri’s “Ezy-Hang” shower curtains that contain rings having a flat upper edge.

Kartri’s Ezy-Hang Product^[2]

The district court granted summary judgement in favor of Focus on the patent infringement claims based on the

court's claim constructions.^{[3],[4]}

The Federal Circuit's Decision

In reversing the district court's patent infringement findings with respect to the '248 and '609 patents, the Federal Circuit determined that although the relevant claims were drafted broadly, without placing any restrictions on whether the rings have a flat upper edge or not, that patentee had "clearly disavowed" such feature during prosecution of its patents. Specifically, "by cooperating with the examiner's repeated demand to exclude rings with a flat upper edge from the '248 and '609 patents, in keeping with the initial restriction requirement, the patent owner made it clear that it accepted the narrowed claim scope for these patents." The court further interpreted the prosecution history of the '088 patent where patentee adopted the examiner's characterization to overcome a double patenting rejection, as confirming patentee's acceptance of the narrowed claim scope of the '248 and '609 patents, by showing that patentee understood the prior patents did not encompass a ring having a flat upper edge. Collectively, patentee's actions were determined to be a "clear and unmistakable" disavowal of rings having a flat upper edge.

The Federal Circuit distinguished the outcome in this case from its decision in *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343 (Fed. Cir. 2013), where a patentee's election without traverse in response to an examiner's restriction requirement did not create a disclaimer of unelected subject matter. In *Plantronics*, the court found the examiner's restriction to be "ambiguous" because neither the examiner nor patentee made "any particular remarks regarding the differences (e.g., in structure) of what the [examiner] found to be different inventions," and although the patentee did not traverse the examiner's restriction requirement, it did challenge the examiner's comments on a broad claim by identifying the claim as a generic claim that read on "all the embodiments illustrated in the application." This is in contrast to the findings in *Focus*, where the Federal Circuit determined there were "multiple instances" of the examiner expressly identifying the flat upper edge as a structural feature that is excluded from the claims and the patentee accepting the examiner's characterization.

Key Takeaways

1. Patent prosecutors should be strategic in how they respond to restriction requirements to avoid disclaiming claim scope that is otherwise encompassed by broadly drafted claims. Although silence in the face of an examiner's claim interpretation is usually not enough to result in a disclaimer, *Focus* illustrates that challenging an examiner's claim restrictions can be important. Had the patentee in *Focus* made it clear during prosecution that its species election and amendments were solely to expedite prosecution, and that they disagreed with the examiner's claim interpretations, and/or if the patentee in *Focus* had identified independent claim 61 of the '248 patent as a generic claim that covers more than one species of invention, the outcome of this case may have been different.
2. Because it is the exchange between the examiner and the patent prosecutor that can be determinative of whether claim scope has been disclaimed, applicants should not assume that disclaimer will not apply simply because the restriction requirement itself is "ambiguous" or fails to define different inventions based on their structure.
3. *Focus* provides increased opportunities for defendants to credibly raise prosecution history disclaimer based on an examiner's restriction requirement as a defense to claims of patent infringement. To do so effectively requires a detailed analysis of the prosecution history of the asserted patents and their family members and identification of potentially relevant statements made by the examiner and patentee and/or claim amendments that are suggestive of patentee's acceptance of examiner-imposed restrictions to the claims.

[1] The '609 and '088 patents are continuations of the '248 patent and all three patents have the same written description and drawings.

[2] Image sourced from: *Focus Prods. Grp. Int'l, LLC v. Kartri Sales Co., Inc.*, 454 F. Supp. 3d 229, 242 (S.D.N.Y. 2020), *aff'd in part, vacated in part, remanded*, No. 2023-1446, 2025 WL 2774853 (Fed. Cir. Sept. 30, 2025).

[3] The district court's infringement finding with respect to the '248 patent was based its determination that the accused shower curtain ring comprises an "approximately horizontal component when [the shower curtain] is hanging from the [curtain] rod."

[4] The district court's infringement finding with respect to the '609 and '088 patents was primarily based on its determination that the accused shower curtain ring comprises a "projecting edge."

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