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Failed Arguments, Lasting Consequences: Prosecution Disclaimer in *Puradigm v. DBG*

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The Federal Circuit recently issued a nonprecedential decision in *Puradigm, LLC v. DBG Group Investments LLC*, affirming summary judgment of noninfringement in a patent dispute involving air purification technology. The patent claims “specular UV reflectors” used in photocatalytic air purification cells. The district court held, and the Federal Circuit agreed, that the scope of the asserted claims was limited by prosecution history disclaimer, and that the accused products fell outside that narrowed scope.

This article provides practical takeaways for patent prosecutors and litigators.

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I. ABANDONMENT OF AN ARGUMENT IS NOT THE SAME AS RETRACTION

The core issue in *Puradigm* was the meaning of “specular UV reflector.” During prosecution, the applicant distinguished the prior art (Bigelow) by arguing

that Bigelow’s polished aluminum surfaces did not meet the claimed “specular UV reflector” limitation — asserting that Bigelow disclosed only UV “reflectivity,” not a “specular reflector.” In particular, the applicant argued that “[n]owhere in Bigelow is anything regarding a specular reflector disclosed — either expressly or inherently.” The examiner rejected that argument, but the applicant did not squarely withdraw or correct it. Instead, the applicant stopped relying on that theory and pursued other amendments and arguments.

The Federal Circuit held that, viewed as a whole, this record created a prosecution history disclaimer that narrowed the scope of “specular UV reflector” in line with the applicant’s distinction between specular reflectance and mere reflectivity. Under that construction, the polished aluminum surfaces disclosed in Bigelow — as well as the unpolished aluminum reflectors used in the accused products — fell outside the claim scope. The applicant’s decision to change strategy and obtain allowance on other grounds did not undo this narrowing, because it never expressly retracted or corrected its earlier characterization distinguishing the claimed “specular” reflector from the aluminum surfaces disclosed in Bigelow.

Takeaway

A clear, narrowing distinction made during prosecution can operate as a binding disclaimer — even

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if the applicant later abandons that line of argument and overcomes the rejection on other grounds — so long as the earlier characterization is never expressly disavowed or corrected.

2. ARGUMENTS THAT “DIDN’T WORK” CAN STILL NARROW THE CLAIM

In *Puradigm*, the patentee argued there could be no prosecution history disclaimer because the examiner rejected the applicant’s attempt to distinguish Bigelow, i.e., the examiner did not accept the applicant’s proposed narrow reading of “specular UV reflector.” *Puradigm* framed it as inequitable to hold them to a narrowing interpretation that the PTO itself had declined to adopt.

The Federal Circuit disagreed. The court emphasized that prosecution history disclaimer turns on what the applicant clearly represents about claim scope, not on whether the examiner ultimately accepts that argument. It is the applicant who surrenders subject matter through clear statements; the examiner’s rejection of those statements does not erase them.

Focusing on the applicant’s conduct, the Federal Circuit held that the applicant’s statements, such as asserting that “[n]owhere in Bigelow is anything regarding a specular reflector disclosed,” amounted to a clear and unmistakable disclaimer, even though that argument didn’t work at the PTO and the patent was allowed on a different theory.

Takeaway

Do not assume a failed argument is harmless. If it is clear and limiting, courts may treat it as binding even if the examiner rejected it and allowance came on a different ground.

3. SUMMARY JUDGMENT ON NONINFRINGEMENT REMAINS A REAL RISK WHEN CLAIM SCOPE IS NARROWED BY PROSECUTION

Because the district court construed “specular UV reflector” in light of the prosecution history to exclude the types of polished aluminum reflectors disclosed in Bigelow, and because there was no genuine dispute that the accused products employed unpolished variants of the material disclosed in Bigelow, the court granted summary judgment of noninfringement, which the Federal Circuit affirmed.

Takeaway

Narrowing statements in prosecution can directly enable early noninfringement rulings, especially where the accused products use different materials, geometries, or performance characteristics than what the patentee emphasized to distinguish prior art.

4. PRACTICAL GUIDANCE FOR PROSECUTION

This decision offers several practical lessons for drafting and prosecution strategy:

- Be cautious with strong, absolute technical characterizations. Describing a claimed feature in highly specific terms, or clearly excluding a class of materials, may later be treated as a definitional limitation.
- If an argument is rejected, consider cleaning up the record. If you no longer wish to be bound by an earlier narrow characterization, consider expressly clarifying or withdrawing it, rather than simply not repeating it.
- Use conditional framing where possible. Here, the applicant could have argued e.g., “Even if Bigelow’s polished aluminum is considered specular, the claims are still patentable because . . .” — so as not to bet everything on a binary characterization that can later become a disclaimer.
- Coordinate claim language and specification with prosecution strategy. If you need flexibility (e.g., a range of surface finishes or materials), make sure both the specification and your arguments support that breadth and avoid sharp dichotomies that invite disclaimer.

For accused infringers, *Puradigm* is another reminder that a careful review of the file history can be outcome-determinative.

5. LITIGATION STRATEGY: FILE HISTORY IS A POWERFUL TOOL

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- Look for disclaimer even when there are no claim amendments. In *Puradigm*, there was no narrowing amendment to “specular UV reflector”; the disclaimer arose purely from arguments such as “nowhere in Bigelow is anything regarding a specular reflector disclosed — either expressly or inherently.” When developing non-infringement positions, treat the patentee’s prosecution arguments as a potential source of narrowing: claims may be limited by argument-based disclaimer even in the absence of any claim amendments.
 - In claim construction briefing, emphasize the distinction between merely abandoning a failed argument and expressly withdrawing it. If there is no explicit disavowal, argue that the earlier narrowing statement continues to define the metes and bounds of the claim.
 - A strong disclaimer story can support early summary judgment. If the accused products use a feature the applicant clearly distanced itself from (e.g., unpolished aluminum instead of “specular” reflectors), push claim construction and summary judgment aggressively.
 - In *Puradigm*, the patentee’s expert tried to broaden “specular” to cover the accused aluminum reflectors, but the Federal Circuit held that the specification and file history controlled and disregarded the expert’s interpretation. Markman strategy should be built primarily on the intrinsic record; expert testimony cannot salvage a construction that conflicts with clear prosecution-history disclaimer.

CONCLUSION

While *Puradigm* is nonprecedential, it is a clear, current illustration of how prosecution history disclaimer can narrow claim scope and support early noninfringement judgments. For both prosecutors and litigators, the decision underscores the importance of deliberate, forward-looking argumentation during prosecution and rigorous use of the file history in claim construction.

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