

Prosecution History Estoppel Bars Patentee From Infringement Claim Under the Doctrine of Equivalents, Even if Multiple Grounds Were Used During Prosecution to Overcome the Prior Art

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Amgen Inc., Amgen Manufacturing Ltd. v. Coherus Biosciences Inc., No. 2018-1993 (Fed. Cir. July 29, 2019)

The district court granted the accused infringer's motion to dismiss infringement claims because the prosecution history showed a clear and unmistakable surrender of claim scope by the patentee. The Federal Circuit affirmed.

During prosecution, the patentee had distinguished the prior art over its claims directed at a combination of compounds used to separate and purify recombinant therapeutic proteins. The patentee successfully argued that a prior art reference cited by the USPTO did not disclose or suggest "this particular combination" of compounds recited in the pending claims.

During litigation, the patentee alleged infringement under the doctrine of equivalents because the combination of compounds used in the accused infringer's process did not match the expressly claimed combination of compounds in the asserted patent. The Federal Circuit agreed with the district court that the patentee's arguments during prosecution amounted to a clear and unmistakable surrender of any combination of compounds aside from the particular combination cited in the claims. Thus, argument-based prosecution history estoppel barred the patentee from succeeding on its infringement claim under the doctrine of equivalents. Significantly, even though the patentee had asserted other grounds to the examiner to distinguish the prior art, prosecution history estoppel applies to each argument when, as here, "the prior art was not distinguished based on the combination of [the] various grounds."

[A copy of the opinion can be found here](#)

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