

Welcome to Hauptman Ham, LLP's Case Law Review, a summary of recent important intellectual property decisions.

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PROSECUTION DISCLAIMER IN DESIGN PATENTS

[Top Brand LLC v. Cozy Comfort Company LLC](#)

Appeal No. 2024-2191 (Fed. Cir., July 17, 2025, Dyk, Reyna, Stark, precedential)

Author: *Reina Kakimoto*

Key Points:

- Prosecution history disclaimer applies to design patents.
- 審査历史免责声明原则同样适用于外观设计专利。
- 審査履歴禁反言は意匠特許にも適用される。
- 출원경과에 따른 권리범위 제한(Prosecution History Disclaimer) 원칙은 디자인 특허(design patent) 에도 적용된다.
- Under the doctrine of prosecution history disclaimer, in a design patent, features the patentee argued during prosecution were distinguished from the patented design cannot support a finding of infringement.
- 根据审查历史免责声明原则，在外观设计专利案件中，专利权人在审查过程中主张并据以与授权外观设计相区别的特征，不得作为支持侵权成立认定的依据。
- 審査履歴禁反言の法理の下、意匠特許において、審査中に特許権者が主張し意匠特許から差別化された特徴は、侵害認定の根拠とはなり得ない。
- 출원경과에 따른 권리범위 제한 원칙에 따르면, 디자인 특허에서 특허권자가 심사과정(prosecution) 중 등록된 디자인과 구별된다고 주장한 특징(features) 은 이후 침해(infringement)를 인정하는 근거로 사용할 수 없다.
- Descriptive marks like “THE COMFY” receive weak protection and require proof of secondary meaning for enforcement.

- 诸如“THE COMFY”之类的描述性商标通常仅获得较弱保护，且权利人主张救济时需证明该商标已取得“第二含义”。
- “THE COMFY”のような記述的な商標は弱い保護でありその権利行使には副次的な意味を持つという証拠が要求される。
- "THE COMFY" 와 같은 기술적 표장(descriptive mark) 은 상표법상 보호 범위가 약하며, 이를 집행(enforcement)하기 위해서는 2 차적 의미(secondary meaning) 가 형성되었음을 입증해야 한다.

Background:

Plaintiff Top Brand LLC, and affiliated companies, (“Top Brand”) and defendant Cozy Comfort Company LLC (“Cozy Comfort”) compete in the market for oversized hooded sweatshirts—often marketed as “wearable blankets.” Cozy Comfort owns U.S. Design Patent No. D859,788 (the “D788 patent”) entitled “Enlarged Over-Garment with an Elevated Marsupial Pocket” and two U.S. trademark registrations for “THE COMFY,” covering blanket throws and online retail services.

Top Brand sought a declaratory judgment of noninfringement and invalidity of the D788 patent. Cozy Comfort counterclaimed for infringement of both the design patent and the trademark. A jury found infringement and awarded \$15.4 million for infringement of the design-patent and \$3.08 million for infringement of the trademark. The district court denied Top Brand’s motion for judgment as a matter of law (JMOL) and entered judgment for Cozy Comfort. Top Brand appealed.

Holding:

The Court of Appeals for the Federal Circuit (CAFC) reversed the district court, holding that: (1) Prosecution history disclaimer applies to design patents, and under that doctrine, Top Brand was entitled to JMOL of noninfringement of the D788 patent; and (2) Substantial evidence did not support the jury’s finding of trademark infringement of “THE COMFY.” Accordingly, both infringement judgments and awards were reversed.

Discussion:

The Federal Circuit addressed two principal issues: (1) the applicability of prosecution history disclaimer in the design-patent context, and (2) the sufficiency of evidence supporting trademark infringement.

1. Design Patent — Prosecution History Disclaimer

During prosecution, the examiner rejected the design as anticipated by prior art (White, D728,900). To obtain allowance, Cozy Comfort distinguished White by emphasizing that its claimed design differed in (a) the width and shape of the front pocket, (b) the relative position of the pocket and armholes, and (c) the downward-sloping hemline.

The Federal Circuit held that these arguments constituted a clear and unmistakable surrender of claim scope. Applying the same reasoning as for utility patents, the court confirmed that prosecution history disclaimer applies equally to design patents, citing *Egyptian Goddess* and *Pacific Coast Marine Windshields*. Top Brand’s accused products included the features Cozy Comfort had argued distinguished White from its design. Having argued these features were not similar enough to anticipate its design, Cozy Comfort could not now argue the same features are similar enough to infringe its design. The reviewing court concluded that no

reasonable jury could find infringement of the properly construed claim. The district court had erred by failing to instruct the jury on the effect of the disclaimer, and JMOL of noninfringement was warranted.

2. Trademark — “THE COMFY”

Cozy Comfort’s trademarks “THE COMFY” were held weak and descriptive, as “comfy” directly conveys “comfortable,” the nature of the goods. Under the Sleekcraft factors, the Federal Circuit found that Cozy Comfort failed to show likelihood of confusion. Evidence showed that Top Brand used the term “Comfy” only descriptively on a website dropdown menu alongside other descriptors (“Snuggly,” “Mermaid Tail”), not as a source identifier. There was no evidence of use of the full phrase “THE COMFY.” Moreover, isolated customer comments on Amazon referencing “comfy” were deemed de minimis and insufficient to establish actual confusion. Cozy Comfort provided no evidence of secondary meaning that could elevate its descriptive term to protectable status. The court therefore reversed the jury’s verdict of trademark infringement.

LINKAGE BETWEEN CLAIMS UNDER THE DOCTRINE OF EQUIVALENTS

Colibri Heart Valve LLC v. Medtronic CoreValve LLC

Appeal No. 2023 (Fed. Cir., July 18, 2025, Taranto, Hughes, Stoll, precedential)

Author: Jay P. Beale

Key Points:

- Cancellation of an independent claim can affect the scope of equivalents that can be asserted, as to another independent claim, under the Doctrine of Equivalents where a substantive linkage exists between the canceled claim and the retained claim.
- 在被取消的独立权利要求与保留的独立权利要求之间存在实质性关联的情况下，取消前者可能影响专利权人依据等同原则就后者所能主张的等同范围。
- 独立クレームをキャンセルすることは、キャンセルされたクレームと残されたクレームとの間で実質的な関連性が存在する場合、均等論の法理の下、主張された他の独立クレームの均等の範囲に影響を与え得る。
- 독립항이 삭제될 경우, 균등론(Doctrine of Equivalents)에 따라 다른 독립항에 대해 주장할 수 있는 균등범위(scope of equivalents)에 영향을 미칠 수 있다. 특히, 삭제된 청구항과 유지된 청구항 사이에 실질적인 연계성(substantive linkage)이 존재하는 경우에는 그러하다.
- Narrowing can occur when cancelling a closely related claim involving such intertwined terminology that cancelling one claim necessarily communicated that the scope of the other claim had narrowed.
- 当被取消的权利要求与另一项权利要求关系密切，且所涉术语彼此交织，以致取消其中一项权利要求必然传达另一项权利要求范围已被限缩时，即可认定发生范围限缩。
- あるキャンセルされたクレームの用語と絡み合っている他のクレームの範囲が減縮されたことと必然的に連通する、そのクレームと密接に関連したクレームをキャンセルすると、範囲の減縮解釈が起り得る。

- 서로 밀접하게 관련된(closely related) 청구항에서 용어들이 서로 긴밀하게 얽혀(intertwined terminology) 있는 경우에는, 한 청구항을 삭제하는 것은 다른 청구항의 권리범위도 축소(narrowing)되는 것으로 해석될 수 있다.

Background:

Colibri Heart Valve LLC ("Colibri") sued Medtronic CoreValve, LLC ("Medtronic") for inducing infringement of U.S. Patent No. 8,900,294 ("the '294 patent") through Medtronic's sales of "CoreValve" transcatheter aortic valve replacement products. The District Court held the '294 patent was not shown to be invalid, and found that Medtronic induced infringement based on the Doctrine of Equivalents ("DOE"). The District Court awarded damages to Colibri.

Holding:

The Court of Appeals for the Federal Circuit (CAFC) reversed the District Court's finding of infringement, ruling that prosecution history estoppel prevented a finding of infringement under the DOE. The CAFC declined to consider validity of the '294 patent.

Discussion:

Reviewing the issue de novo as a question of law, the CAFC considered whether Colibri's cancellation of independent claim 39 during prosecution barred the application of DOE to independent claim 1, which Colibri had asserted against Medtronic, under the doctrine of Prosecution History Estoppel. Colibri argued that, because claim 39 and asserted claim 1 were independent, cancellation of claim 39 during prosecution did not impact the scope of claim 1 asserted under DOE.

The District Court had adopted the findings of the Technical Special Master that Colibri did not abandon claim coverage for the technique employed by Medtronic's CoreValve products when Colibri canceled claim 39. The Federal Circuit reversed the District Court, holding that prosecution history estoppel, namely Colibri's cancellation of application claim 39, prevented a finding of infringement of asserted claim 1 under the DOE.

The two claims being compared here are directed to methods of using a replacement heart valve device in a patent. Asserted claim 1 includes the element, "partially deploying a distal portion of the replacement heart valve device within the patient by *pushing out the pusher member* from the moveable sheath to expose the distal portion of the replacement heart valve device" (emphasis added). Canceled claim 39 included the element, "partially deploying the replacement heart valve device within the patient by *retracting the moveable sheath* to expose a portion of the replacement heart valve device" (emphasis added). In the District Court, Colibri argued that Medtronic's partial-deployment method of applying a force to hold a stent in place while retracting the movable sheath is equivalent to the method recited in claim 1.

The CAFC observed that Colibri removed the "retracting" element from the claims during prosecution. The reviewing court rejected Colibri's argument that the equivalent method of "pushing while retracting" is distinct from "merely retracting," as Colibri asserted was the removed scope of claim 39. Noting that Colibri had asserted, at trial and during appeal, that retracting necessarily requires pushing, that the two cannot be separated in these methods, the reviewing court concluded that the substance dropped when cancelling claim 39 is not separable from the scope asserted as equivalent, contrary to the holding of the District Court. The CAFC also held that the narrowing of claim scope that gives rise to estoppel need not be confined to a single claim. The reviewing court held that estoppel can apply to a patent claim where cancellation of a closely related claim, involving intertwined terminology, necessarily communicates that the scope of the retained claim has been narrowed. The reviewing court explained that the limitation of Prosecution History Estoppel proposed

here by Colibri would elevate form over substance, finding the doctrine of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002), not so limited.

‘IDENTICAL’ NOT THE SAME AS ‘IDENTICAL TO A PORTION’

Lab. Corp. of Am. Holdings v. Qiagen Sci., LLC

Appeal No. 2023-2350 (Fed. Cir., August 13, 2025, Lourie, Prost, Reyna)

Author: [Lingchuan Li](#)

Key Points:

- In a patent claim, the word “identical” cannot be construed as covering “identical to a portion” where both terms appear in the claims, since different claim terms cannot be construed to have the same scope under the doctrine of claim differentiation.
- 在专利权利要求中，如“identical（相同）”与“identical to a portion（与其中一部分相同）”两项表述同时出现，则前者不得被解释为涵盖后者，因为依据权利要求区分原则，不同的权利要求用语不应被解释为具有相同范围。
- 特許クレームにおいて、“identical”という用語を“identical to a portion”を、その両方の用語がクレーム内に存在する場合において、包含すると解釈することができない。その理由はクレーム差別化の法理 (doctrine of claim differentiation) の下、異なる用語を同じ範囲として解釈することができないからである。
- 특허 청구항에 개시된 두 용어, 즉, "identical(동일한)" 이라는 용어는 "identical to a portion(일부와 동일한)" 을 포함하는 것으로 해석될 수 없다. 청구항 차별 원칙(doctrine of claim differentiation)에 따라 서로 다른 청구항 용어는 동일한 범위를 갖는 것으로 해석될 수 없기 때문이다.
- In reference to DNA sequences, the word “target” in a patent claim was construed, based on description in the specification, to refer to DNA sequences that are the subject of analysis, not just any DNA sequence.
- 就DNA序列而言，根据说明书的记载，专利权利要求中的“target(靶标)”应解释为作为分析对象的特定DNA序列，而非泛指任何DNA序列。
- DNA配列に関し、特許クレームにおける語句“target”が、明細書の記載に基づき解析の対象であるところのDNA配列であり、いかなるDNA配列ということではない、と解釈された。
- DNA 서열(DNA sequences) 과 관련하여, 특허 청구항의 "target" 이라는 용어는 상세한 설명을 근거로, 단순히 아무 DNA 서열(any DNA sequence) 이 아니라 분석의 대상(subject of analysis)이 되는 DNA 서열 을 의미하는 것으로 해석된다.

Background:

Laboratory Corporation of America Holdings (“Lab. Corp.”) owns two U.S. patents—U.S. Patent No. 10,017,810 (“the ‘810 patent”) and U.S. Patent No. 10,450,597 (“the ‘597 patent”)—directed to preparing DNA samples for sequencing. Qiagen Sciences, LLC (“Qiagen”) sold kits containing materials for such preparation. Lab. Corp. sued Qiagen for infringement of various claims of the ‘810 patent. Before trial, when the ‘597 patent issued, Lab. Corp. filed an amendment complaint, adding infringement of the ‘597 patent. Following claim construction, a jury found that Qiagen willfully infringed certain claims of the ‘810 patent under the

Doctrine of Equivalents, and literally infringed certain claims of the '597 patent, and awarded \$4.7 million in damages. The District Court denied Qiagen's motion for JMOL and entered the judgment for Lab. Corp. Qiagen appealed.

Holding:

The Court of Appeals for the Federal Circuit held that the district court erred in construing the claim term "identical" with respect to the '810 patent, that the district court misapplied the elements of the DOE, and that insufficient evidence of infringement of the asserted claims of the '597 patent was presented at trial. The Federal Circuit reversed the holding of the district court and remanded for entry of JMOL that Qiagen did not infringe.

Discussion:

The core disputes were (1) how to construe the claim phrase "identical to a second sequencing primer;" (2) whether Qiagen's sample index primer (SIP) could satisfy the second target-specific primer limitation under the DOE; and (3) whether the jury heard sufficient evidence that Qiagen's products contain the "target-specific primer" recited in the claims of the '597 patent. The district court had erroneously allowed the jury to construe the term "identical," in the claims of the '810 patent, as if it could mean "identical to a portion." The district court had also erroneously adopted the jury's comparison of the Qiagen products to the claims under the DOE. Finally, the jury concluded infringement of the '597 patent based on insufficient evidence.

As a matter of claim construction, the reviewing court held that "identical" means the same—not "identical to a portion," pointing primarily to the definition of the word in the dictionary. The reviewing court also noted that the claims actually recite both "identical" and "identical to a portion, so that "identical" cannot be construed to cover the same scope as "identical to a portion" under the doctrine of claim differentiation. Noting that the accused nucleotide sequence contains 19 nucleotides, whereas the sequence recited in the asserted claims of the '810 patent contains 34 nucleotides, the Federal Circuit held that these two sequences cannot be "identical."

The Federal Circuit also held that equivalence was not properly established according to the elements of the Doctrine of Equivalents. Specifically, Qiagen's product has a different function, performed in a different way, leading to a different result, from the second target-specific primer recited in the asserted claims. The Federal Circuit thus held it was error for the district court to deny JMOL of non-infringement under DOE.

As to the '597 patent, the Federal Circuit held that the evidence relied upon by the district court to establish infringement did not show infringement of the asserted claims. The jury had relied upon expert testimony that Qiagen's "forward primer" targets a ligated adaptor, a sequence added to a DNA fragment that contains a target sequence. The jury had found that the forward primer was thus a "target-specific primer" because it targets a small sequence of DNA, albeit in the adaptor, not the target sequence of the probed DNA. The Federal Circuit found, however, that although a ligated adaptor may contain target and common sequences, it is not the case that any primer that simply anneals to any portion of a combined product can be a "target-specific primer" as that term is used in the claims of the '597 patent. Observing that the district court had construed "target nucleic acid" as "a nucleic acid molecule of interest," the Federal Circuit found that the '597 patent differentiates between target and non-target sequences, describing a "target" sequence as that which is "analyzed" or studies, as differentiated from utility or common sequences, such as adaptor sequences. Finding, thus, that a primer that anneals to an adaptor sequence does not amount to a "target-specific sequence" (emphasis added), as that term is used in the '597 patent, the Federal Circuit reversed the district court and remanded for grant of JMOL on infringement of the '597 patent.

Google LLC, v. Sonos, Inc.

Appeal No. 2024-1097 (Fed. Cir., August 28, 2025, Lourie, Prost, and Bumb¹)

Author: Subaru Ryan Kanesaka

Key Points:

- In reviewing prosecution of a patent claim for invalidity due to prosecution laches, prejudice to an alleged infringer cannot be established where the alleged infringer’s investment in infringing products began after publication of the application for the patent, where the application specification adequately supports the claim.
- 在以prosecution laches（审查懈怠）为由对专利权利要求提起无效时，若被控侵权人对侵权产品的投资始于该专利申请公开之后，且申请说明书对该权利要求已提供充分支持，则无法认定被控侵权人受到了prejudice（损害）。
- 審査懈怠を理由とする無効が争われている特許クレームの審査履歴を検討したところ、侵害被疑者の侵害品への投資が対象特許出願の公開後に始まっており、出願明細書がそのクレームを十分にサポートしている場合において、その侵害被疑者への不利益が立証されない。
- 출원지연(Prosecution Laches) 으로 인한 특허 무효(invalidity) 여부를 판단할 때, 특허출원이 공개된 이후에 침해 혐의자가 침해 제품에 대한 투자를 시작했고, 또한 출원 당시의 명세서가 해당 청구항을 충분히 뒷받침하고 있었다면, 침해 혐의자가 입었다고 주장하는 불이익(prejudice) 은 인정될 수 없다.
- Patentees are not required to prove their claims are patent-eligible under 35 U.S.C. § 101. The party challenging patent-eligibility of the claims bears the burden of proof.
- 특허권자는 청구항이 35 U.S.C. § 101에 따라 특허 가능성(patent-eligibility)을 증명할 필요가 없다. 청구항의 특허 가능성을 다투는 측이 증명 책임(burden of proof)을 부담한다.
- 专利权人无需证明其权利要求在35 U.S.C. § 101下具备专利资格。挑战权利要求专利资格的一方承担举证责任。
- 特許権利者には、彼らの特許クレームが米国特許法第101条下での特許適格性を有していることを証明する義務が課せられていない。その特許クレームに特許適格性がないと主張する当事者が、その挙証責任を負うのである。

Background:

Sonos owns U.S. Patent Nos. 10,469,966 (“the ‘966 patent”) and 10,848,885 (“the ‘885 patent”), collectively referred to herein as the “Zone Scene Patents,” and U.S. Patent No. 10,779,033 (“the ‘033 patent”), referred to herein as the “Direct Control Patent.” Google sued for declaratory judgment of noninfringement,

¹ United States District Court for the District of New Jersey, sitting by designation.

and Sonos counter-sued for infringement. The cases were consolidated at the U.S. District Court for the Northern District of California.

Prior to trial, Sonos moved for summary judgment of claim 1 of the '885 patent. Google cross-moved for summary judgment of non-infringement, arguing that claim 1 lacked written description support. Google did not, however, move for summary judgment of invalidity. The district court granted the motion. Google also moved for summary judgment that the Direct Control patent is invalid as obvious over Google's prior-released products. That motion was granted, removing the Direct Control patent from the trial. At trial, the jury found that Google infringes claim 1 of the '885 patent, does not infringe any claims of the '966 patent, and that claim 1 of the '885 patent was not shown to be invalid, awarding Sonos damages of just over \$32.5 million.

Post-trial, the district court ordered additional briefing on the question of written description support for claim 1 of the '885 patent, finally holding the Zone Scene patents unenforceable due to prosecution laches. The district court also found that an amendment to the description of Fig. 5B, made during prosecution of the '885 patent and critical to the written description of claim 1, was new matter. The district court, accordingly, found that the '885 patent, lacking priority to the original filings in the chain of applications, was anticipated by Google's products released before the filing date of the '885 patent. Sonos appealed.

Holding:

The Federal Circuit concluded that the district court erred in entering judgment that the asserted claims of the Zone Scene patents are invalid as lacking written description of overlapping zone scenes. The district court also erred in finding prosecution laches, since evidence at trial did not show prejudice. The Federal Circuit accordingly held that the district court abused its discretion in holding the Zone Scene patents unenforceable for prosecution laches.

The Federal Circuit finally affirmed the district court's judgment that the asserted claims of the Direct Control patent are invalid as obvious.

Discussion:

To determine whether the written description requirement is met, a court considers "whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." The Federal Circuit concluded that Figures 3A-3B in the original disclosure provide adequate support for the overlapping zone scene functionality recited in claim 1 of the '885 patent. Since this disclosure appeared in the earliest filings, the district court's conclusion that claim 1 of the '885 patent was anticipated by Google's products was erroneous.

Regarding prosecution laches, the Federal Circuit found the evidence of prejudice unconvincing. Prosecution laches "may render a patent unenforceable when it has issued only after an unreasonable and unexplained delay in prosecution that constitutes an egregious misuse of the statutory patent system under the totality of the circumstances" if the delay causes prejudice to the alleged infringer. To demonstrate prejudice, the alleged infringer must show evidence of intervening rights, that Google or others invested in, worked on, or used the claimed technology during the period of delay. In the post-trial briefing, although Google stated that its investment began in 2015, no evidence to support this statement was presented. Further, even if Google's investment began in 2014 or 2015, parents of the '885 patent were published in 2013, before Google's investment began. The reviewing court explained that Google could not be prejudiced by information that was published prior to its investment. The reviewing court also explained that it is not improper for an applicant to broaden his claims during prosecution in order to encompass a competitor's products, as long as the disclosure supports the broadened claims.

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