

# Design Patent Case Digest

[Pacific Coast Marine Windshields Limited v. Malibu Boats, LLC](#)



**Decision Date:** December 27, 2012

**Court:** D. Florida

**Patents:** [D555,070](#)

**Holding:** Defendants' motion for partial summary judgment of non-infringement GRANTED.

## **Opinion:**

Plaintiff, Pacific Coast Marine Windshields Limited, sued Malibu Boats, LLC *et al.* for infringement of U.S. Design Patent D555,070, entitled "Marine Windshield". Malibu sells a line of boats called the [WAKESETTER 20 MXZ](#), which feature a windshield with a hatch having three elongated rectangular vent holes along the sides.

At the time the '070 patent application was filed, it contained twelve different patent drawings. The Patent Examiner determined that the twelve drawings included five patentably distinct designs and required the patentee to select one group for prosecution:

- a marine windshield with a hatch and four circular vent holes,
- a marine windshield with no hatch and either four circular vent holes or four square vent holes,
- a marine windshield with a hatch and no vent holes,
- a marine wind shield with no hatch and no vent holes, and
- a marine windshield with a hatch and either two oblong vent holes or two rectangular vent holes.

The patentee elected the first group, canceled the others, and separately patented the design with no vent holes in a divisional patent. The other 3 designs were never pursued further.

Malibu moved for partial summary judgment of non-infringement on the basis that the patentee had narrowed the scope of the patent by canceling and never patenting the design which looked most like the Malibu windshield. The Patentee countered that the restriction requirement was merely "administrative" and cited to several decisions involving restrictions in utility patents. However, "restriction between plural, distinct

inventions is ... mandatory in design patent applications ...” because of the single claim requirement of design patents.<sup>1</sup> According to the court, allowing the patentee to claim infringement in this case “would violate the well-established rule that ‘subject matter disclosed but not claimed in a patent application is dedicated to the public.’”<sup>2</sup>

Further, the court observed that by acquiescing to the restriction requirement and then choosing not to patent the other designs, the patentee put the public on notice that he has surrendered the canceled subject matter. Although prosecution history estoppel is not a complete bar to asserting equivalents, the court, quoting [\*Festo Corp. v Shoketsu Kinzoku Kogyo Kabushiki Co.\*, 535 U.S. 722 \(2002\)](#), reasoned that the patentee’s decision to narrow his claim through amendment was a disclaimer of the “territory between the original claim and the amended claim.” Because the accused design was in the disclaimed “territory”, the court concluded that the patentee was estopped from claiming that the defendants’ accused design infringes the patent.

The case is currently on appeal to the Federal Circuit and is scheduled for oral argument on November 6th, 2013 at 10:00am.

If you have any questions or would like additional information on this topic, please contact:

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1 [MPEP § 1502.01\(D\)](#).

2 [Maxwell v. J. Baker, Inc.](#), 86 F.3rd 1098,1106 (Fed. Cir. 1996) (quoting [Unique Concepts, Inc. v. Brown](#), 939 F.2d 1558, 1562-63 (Fed. Cir. 1991)).

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