

## Axed Verdicts Put Spotlight On Patent Applicant Statements

By Ryan Davis

*Law360 (August 6, 2025, 8:39 PM EDT)* -- Recent Federal Circuit decisions overturning substantial patent judgments due to statements the patent owner made during the application process illustrate the importance of applicants carefully calibrating their arguments, particularly when seeking design patents, attorneys say.

In mid-July, the court reversed an over \$21 million infringement judgment won by Cozy Comfort Co., maker of a sweatshirt known as "The Comfy." The court said that when seeking the design patent, the company gave up some elements of the design to overcome a rejection, then improperly alleged that Top Brand LLC infringed based on those elements.

The next day, the appeals court overturned a more than \$125 million judgment against Medtronic for infringing a patent on implanting artificial heart valves. The Federal Circuit said that when Colibri Heart Valve LLC canceled one claim of the patent during the application process, it necessarily narrowed another claim, meaning Medtronic could not infringe it.

"These are both really good reminders, happening the same week, that you have to be very careful during patent prosecution," said John Hemmer of Morgan Lewis & Bockius LLP.

When working with the patent office during the examination process, "good prosecutors will try their best to couch their statements in a way that is workable or not too damaging for future litigation, but that can be tough," noted Franklin Chu of Gemini Law LLP.

The key takeaway from the decisions is the vital importance of considering all the possible effects of statements made during prosecution, "because what you say can and will be used against you," Chu's Gemini Law colleague Keith Zullo said.

The sweatshirt case involved the doctrine of prosecution history disclaimer, while the heart valve case involved the related concept of prosecution history estoppel. Each of them hold that statements made by applicants while prosecuting a patent can narrow its scope and limit available arguments in infringement litigation.

Both are long-standing concepts in patent law, but in the July cases, the Federal Circuit extended their reach to some degree.

In the sweatshirt case, the court rejected Cozy Comfort's contention that prosecution history disclaimer

doesn't apply to design patents. The Federal Circuit noted that it had previously held that amending a design patent during prosecution can narrow its scope, and concluded that arguments made by design patent applicants during the process can do the same.

In the heart valve case, the appeals court rejected Colibri's argument that prosecution estoppel applies only to claims that are themselves amended. The panel held that canceling a closely related claim can narrow the scope of the remaining claims for the purposes of the doctrine.

Both decisions illustrate the substantial consequences that can arise in infringement disputes from what applicants tell patent examiners during prosecution.

Disparaging comments by patent applicants about earlier inventions or statements about what they mean can all be used to limit the scope of the claim, Hemmer said, so "we often compare what we try to do during the prosecution to surgery."

"Meaning, you've got to be very precise thinking about all these things," he said. "What you say is going to be construed by a litigator, and every single word will be scrutinized."

### **Design Patent Impact**

That is becoming increasingly important to keep in mind in the field of design patents, Hemmer said. A Federal Circuit **decision** last year loosened the standard for finding design patents invalid as obvious based on prior art, and patent examiners are increasingly using image-based **search tools** that make it easier to find earlier designs.

As a result of those developments, "we've seen a huge spike in prior art rejections for design cases, so we have to be a lot more careful with how we're claiming things now and what statements are made of record to overcome prior art rejections," Hemmer said.

Many design patent disputes now play out in internal enforcement procedures operated by companies like Amazon that sell products online. The sweatshirt decision could make those disputes more complicated, said Zac Garthe of Copernicus Law, a firm focused on online intellectual property enforcement.

For instance, Amazon runs a program called the Amazon Patent Evaluation Express program, or APEX, through which utility patent owners can ask to have a third-party evaluator determine if products sold on Amazon likely infringe their patents, and the company removes products if infringement is found.

That process involves briefing by the parties, but Amazon handles complaints about design patents differently, Garthe explained. The company often just compares the allegedly infringing product to the image in the design patent, but the Federal Circuit ruling makes clear that there is more to the inquiry, he said.

"When you now open that up where it's not just the images, it's the statements describing the images, none of that exists in the process right now in the e-commerce space for enforcement," he said.

Garthe said he expects parties on both sides in design patent disputes at Amazon and elsewhere to cite the Federal Circuit sweatshirt ruling, and argue that deciding each case requires more detailed briefing. Many design patent cases begin in these e-commerce programs before they get to a lawsuit, so the

ruling "should have a pretty meaningful impact here," he said.

### **Practical Considerations**

One lesson patent applicants can take from the decision is that it is often worth saying only what is necessary during prosecution to avoid making statements that could prove problematic down the line, attorneys said.

"You're always going to try to do things in the narrowest way you can, so that the impact of this is as narrow as possible," Zullo said.

It is helpful for attorneys prosecuting patents to keep an eye toward ensuring that the patent will be useful in future litigation, Hemmer said, noting that "getting experience in litigation just shows you how important this is and how often it comes up, and how the prosecution history is used in construing the claims."

During prosecution, there may be a temptation to cite case law or make other arguments to examiners about why their rejection of an application is wrong, attorneys said. But that creates a record that may not be helpful in later litigation, and could give rise to future arguments by opponents.

Chu said it is also common for applicants to change a patent during prosecution and attempt to insulate against the estoppel effect by stating that they are not conceding that there was any problem with the original claims. But that may be futile in trying to persuade a court once the patent is asserted, he said.

"You can cancel the claim or amend the claim and say, 'I'm only doing this to move prosecution along, not because I agree with the patent office's rejection,'" he said. "But later on during litigation, a fact-finder might still look at that and say, 'Well, the patent office had a point.'"

The cases are Colibri Heart Valve LLC v. Medtronic Corevalve LLC, case number 23-2153, and Top Brand LLC et al. v. Cozy Comfort Company LLC et al., case number 24-2191, both in the U.S. Court of Appeals for the Federal Circuit.

--Editing by Alanna Weissman and Emily Kokoll.