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## *The Precedent: Federal Circuit Concludes that Cancelled Subject Matter Can Preclude a Doctrine of Equivalents Infringement Theory in Colibri Heart Valve LLC*

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In this edition of *The Precedent*, we outline the Federal Circuit's decision in *Colibri Heart Valve LLC v. Medtronic CoreValve, LLC*.

Authored by: [Michael Garvin](#) and [Brad Hough](#)

### Overview

This case addresses prosecution history estoppel and the doctrine of equivalence.

### Issue

Whether the cancelling of an independent claim during prosecution of a patent application can give rise to prosecution history estoppel for a separate independent claim.

### Holding

Yes, if the subject matter of the cancelled claim is later sought to be covered by the surviving independent claim under a doctrine of equivalents infringement theory, prosecution history estoppel applies and the subject matter cannot be used for a doctrine of equivalents infringement theory.

### Background and Reasoning

In May of 2025, Colibri Heart Valve LLC ("Colibri") sued Medtronic CoreValve, LLC ("Medtronic") for infringement of U.S. Patent No. 8,900,294, (the "'294 patent"). The '294 patent is directed to a method of implanting an artificial heart valve to replace a defective valve "that furnishes a do-over opportunity to the installer to get the positioning [of the artificial heart valve] right." Medtronic sells an "Evolut" product line of replacement heart valves. Colibri argued that the Evolut product infringed claim 1 under a doctrine of equivalents theory. Colibri's doctrine of equivalents theory implicated the following limitation of

claim 1:

“... 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;”

However, during prosecution of the '294 patent, there were two independent claims: claim 34 (which eventually became claim 1) and claim 39 (which was cancelled during prosecution). One of the limitations in claim 39, which was cancelled, recited a similar method of use as recited in current claim 1, and specifically recited the following:

“... 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;”

Colibri's doctrine of equivalents theory was based on the contention that the Evolut replacement heart valve infringed claim 1's limitation of “pushing out the pusher member from the moveable sheath” because retracting the movable sheath is equivalent to claim 1's “pushing out the pusher member from the moveable sheath.” In other words, Evolut infringed claim 1 under a doctrine of equivalents because it was directly infringing the limitation from cancelled claim 39.

At the district court level, Medtronic contended “that Colibri's assertion of infringement of claim 1 under the doctrine of equivalents was barred by prosecution history estoppel.” Specifically, that the cancelling of claim 39 (which recites “retracting”) during prosecution precluded Colibri from asserting that claim 1 covers the retracting step as performed by the allegedly infringing product. The district court held that Colibri was not estopped from pursuing this infringement theory because claim 1 (that is, claim 34 during prosecution) was independent of claim 39 and the subject matter of claims 34 and 39 were “separate and distinct.”

On appeal, the Federal Circuit disagreed with the district court. The Federal Circuit held that “Colibri's asserted equivalent [did not] distinctly differ[] from what was set forth in claim 39 such that the substance dropped when cancelling claim 39 is quite separate from the substance of retained claim 34” (issued claim 1). Thus, the cancelling of claim 39 constituted “a narrowing amendment” that gave “rise to prosecution history estoppel” for claim 1.

In holding that the subject matter for Colibri's doctrine of equivalents infringement theory was not lost in the cancelling of claim 39, the district court relied on the fact that claim 39 was independent of claim 34, so claim 34 was not amended and therefore there was no estoppel. The Federal Circuit faulted the district court for this, stating that this was just a “formality” and not determinative. Rather, it does not matter if the cancellation was to a different independent claim but what matters is whether a skilled artisan would understand the giving up of the subject matter of claim 39 communicated the scope of the retained independent claim. The Federal Circuit further explained that prosecution history “estoppel was not limited to the amendment of a particular claim” but that rather the inquiry is tailored to whether the “scope of the claims of the patent as a whole, pre- and post-amendment” changed.

The amending or cancelling of a first independent claim can affect the scope of a second, different independent claim. Here, the scope of claim 39 and the asserted equivalent under the doctrine of equivalents were the same so the cancelling of claim 39 forfeited the asserted equivalent. The court stated that “[a] skilled artisan reading the prosecution history would understand that some narrowing [of claim 1] had occurred through cancelling claim 39” and that “in the absence of further arguments about the scope of narrowing or exceptions to the presumption of estoppel, the doctrine of equivalents became unavailable to Colibri for the issued claim 1.” The court commented that “[i]f Colibri wished to capture territory involving retraction that was outside the literal scope of claim 1, it could have filed a continuation application (and there sought to show written description support).”