

# The Clear and Unmistakable Standard for Applying Prosecution Disclaimer

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The US Court of Appeals for the Federal Circuit found that a district court misconstrued claim terms based on a misapplication of the clear and unequivocal disavowal standard and vacated its noninfringement decision. *Maquet Cardiovascular LLC v. Abiomed Inc., Abiomed R&D, Inc., Abiomed Europe GMBH*, Case No. 23-2045 (Fed. Cir. Mar. 21, 2025) (**Reyna**, Taranto, Cunningham, JJ.)

Maquet owns a patent related to a system that provides greater precision in deploying a blood pump to a patient's circulatory system. The district court construed three patent terms. The district court construed the term "guide mechanism comprising a lumen" to include a negative limitation that the guidewire lumen "is not distal to the cannula." The court justified this limitation by citing to the prosecution history of a related patent where Maquet disclaimed the broader claim by merely accepting the examiner's proposed revisions. The district court also construed both guide wire terms in two other claims to include another negative limitation: "the guide wire does not extend through the free space in between the rotor blades." The district court similarly justified this negative limitation by citing to the parent patent's prosecution history, finding that Maquet had given up a broader version of the claim. The district court's construction effectively limited the scope of Maquet's claims to exclude the accused products, and the parties stipulated to the entry of a final appealable judgment of noninfringement. Maquet appealed.

Maquet argued that the district court erred in its construction of the three terms by misapplying the law of prosecution disclaimer. The Federal Circuit agreed, finding that the district court incorrectly relied on Maquet's prosecution history to reach its conclusions on claim construction. The district court cited to an amendment made in a different (but related) patent prosecution and a different claim. The Federal Circuit explained that although the prosecution history of a related patent may be relevant, the claim limitations in the two applications must be similar in order for the prosecution disclaimer doctrine to apply. Here, the Court found that the amendment in the related patent was not sufficiently similar to the limitation at issue to constitute a disclaimer for the claim at issue. The related case claim did not claim a guide mechanism, nor did it require the lumen be in a specific position. The Federal Circuit found that the district court erred in its construction by improperly applying prosecution disclaimer.

The Federal Circuit also determined that the district court erred in its construction of the guide wire claim terms by applying prosecution disclaimer and interpreting a restriction on their scope. The

Court found that while the prosecution history of the parent patent's claims was sufficiently similar and thus relevant, Maquet did not disavow either claim's scope during the relevant prosecution. The Court noted that mere silence in response to a notice of allowance typically does not rise to clear and unmistakable claim disavowal. The Court also observed that statements made during an *inter partes* review (IPR) proceeding may be used to support a finding of prosecution disclaimer, but they also must meet the clear and unmistakable standard. Here the Court concluded that Maquet's statements made in the IPR proceeding and throughout prosecution history did not rise to the stringent level required and thus did not limit the scope of the guide wire in the claims.

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