

Keywords: Reissue Patent Application (§ 251); Reissue Recapture Rule; Surrendered Subject Matter.

General: An expanded panel of the Board in a 5-4 decision held that in a reissue patent application, there is no *per se* prohibition against eliminating or broadening a claim limitation that was added during prosecution of the original patent to overcome a prior art rejection. A reissue claim that omits or broadens such a limitation may avoid the reissue recapture rule if the reissue claim is materially narrowed in other respects. Proper application of recapture rule thus requires fact-specific analysis in each case, not use of *per se* rule.

Ex parte Eggert
67 U.S.P.Q. 2d 1716 (Bd. Pat. App. & Inter. 2003)
Decided May 29, 2003

I. Facts

Applicants (Eggert et al.) filed a reissue patent application (35 U.S.C. § 251) within two years of the grant of the original patent, adding new independent claims 15 and 22, which are both broader than the independent claim 1 (twice amended) of the original patent. The two reissue claims 15 and 22 are broader than issued claim 1 in that a limitation added to claim 1 to overcome a prior art rejection during prosecution of the original patent is rewritten in more generic language in reissue claims 15 and 22. (The reissue claims 15 and 22 are also broader than the issued claim 1 in other respects not related to the claim 1 amendment made to overcome the prior art rejection.) However, the reissue claims 15 and 22 are not as broad as claim 1 as written prior to the final amendment of claim 1 made to overcome the prior art rejection. In other words, the reissue Applicants have not “retreated” all the way to claim 1 as it stood rejected during prosecution of the original patent. See claims and amendments on pp. 1733-34. Nevertheless, the Examiner rejected reissue claims 15-22 under the “reissue recapture rule.” Applicants appealed. A three-member panel of the Board reversed the rejection. An expanded panel of the Board granted the Examiner’s request for a rehearing. The Examiner asked the Board to impose a *per se* rule of reissue recapture to prevent Applicants (Appellants) from retreating from any claim limitation determined to have secured allowance of the original patent.

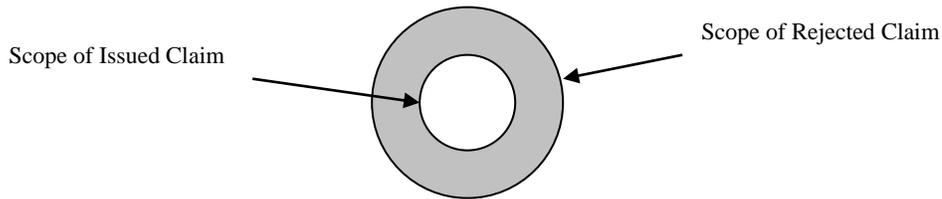
II. Issues

- A. In rejecting reissue claims 15-22, did the Examiner err in applying a *per se* rule of reissue recapture to prevent Applicants from retreating from any claim limitation determined to have secured allowance from the original patent?
- B. Are the reissue claims 15-22 precluded by the reissue recapture rule?

III. Discussion

- A. Yes. The Board declined to impose a *per se* rule of reissue recapture. Such a *per se* rule would be contrary to the language of 35 U.S.C. § 251 which permits broadened claims in a reissue patent.

Errors (such as claiming less than one has the right to claim) made without deceptive intent can be corrected after a patent has issued under § 251 in defined circumstances. Here, Applicants believe that in amending claim 1 in the original application, they overshot the mark in narrowing the claim, i.e., they claimed less than they had a right to claim, and they now wish to “retreat” back from the inner circle shown in drawing 1 (on the next page) into the shaded area between the circles.



DRAWING 1

Applicants cannot retreat all the way through the shaded area because rejected claim 1 (once amended) constitutes surrendered subject matter under the “reissue recapture rule.” However, the issued claim 1 (twice amended) and the shaded area do not constitute surrendered subject matter.

For example, if an outer circle claim contains elements ABC and the inner circle claim contains elements ABCDEF, a reissue applicant cannot recapture a claim directed to elements ABC (outer circle) or a claim entirely outside of the outer circle (e.g., AB, BC, AB-C_{BR}, etc.). However, the reissue recapture rule is not invoked for claims directed to elements ABCX, ABC-D_{BR}, ABCEF, and A_{BR}BCDEF. The focus for determining the reach of the reissue recapture rule is the claim from which the issued claim directly evolved, not the issued claim itself.

Reissue Applications versus Continuing Applications

Reissue provides the means and process for correcting errors (such as the drafting error in this case) in a manner consistent with the notice function of patent claims. Reissue provides for both (1) public notice that patent claims can be broadened within two years after issuance and (2) intervening rights. In addition, the public is notified by the USPTO when a reissue application is filed and has access to that application during its pendency. This is in contrast to the situation involving an applicant who may file a continuing application to pursue broader claims in relative secrecy without the two-year constraint and intervening rights provision provided for by the reissue statutes. The *per se* rule requested by the Examiner would motivate applicants to file otherwise unnecessary continuing applications to pursue broader claims and thereby avoid intervening rights. In contrast, focusing the starting point of a reissue recapture rule analysis on the claim that was amended to become the issued claim, i.e., the cancelled, outer circle claim of drawing 1, instead of the issued, inner circle claim, will result in the corrected patent rights of the patentee being resolved more quickly and in a more public manner.

Reissue Recapture Rule and Surrendered Subject Matter

The reissue statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally. However, error under the reissue statute does not include a deliberate decision to surrender specific subject matter in order to overcome prior art, a decision which in light of subsequent development in the marketplace might be regretted. Thus, the reissue statute cannot be construed in such a way that competitors, properly relying on prosecution history, become infringers when they do so. This is the underlying policy behind what has come to be known as the “reissue recapture rule.” In its simplest terms, this rule may be summarized as follows: *a patentee is precluded from recapturing and reissue that which he earlier conceded was unpatentable and abandoned or surrendered, whether by cancellation, amendment or argument of claims, for the purpose of obtaining the original patent.*

Accordingly, the reissue recapture rule focuses on that which the prosecution history indicates was given up or conceded to be unpatentable, i.e., the “surrendered subject matter.” This is the subject matter which cannot be recaptured in reissue. Indeed, the Examiner, Applicants, and the original Panel all appeared to be in agreement on this broad principle. The dispute is with the determination of surrendered subject matter. The Examiner contends that the recapture rule prohibits a patentee from obtaining in reissue any claim which does not include each and every limitation added to a claim or argued by an applicant during the prosecution of the original patent application in order to overcome a

rejection and obtain a patent. This approach, while simple in its application, has been expressly rejected by the CCPA and Federal Circuit. The proper focus is on the *scope* of the claims, not on the individual *feature* or *element* given up during prosecution.

Under the three-step test set forth in *Clement* by the Federal Circuit in 1997, the **first step** in applying the recapture rule is to determine whether and in what “aspect” the reissue claims are broader than the issued patent claims. The **second step** is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, one must look to the prosecution history. The **third step** is to determine whether the surrendered subject matter has crept into the reissue claim, and whether the reissue claim is materially narrowed in other respects to avoid the recapture rule. See p. 1725 and *Clement* principles on p. 1726.

Questions

If reissue claim is both narrower and broader in aspects germane to prior art rejections, then evidently a balance is performed to determine if the claim is impermissible under the reissue recapture rule. See p. 1726, first column. The Board emphasized that the Federal Circuit in 2001 “clearly leaves open the possibility that reissue claims which have been broaden in an aspect related to surrendered subject matter may avoid the recapture rule if they are materially narrowed in other respects.” See p. 1727.

Conclusion

The Board, after considering the Examiner’s request for rehearing in light of the cases addressing the reissue recapture rule, reached the conclusion that the original Panel did not err in the earlier decision refusing to apply a *per se* rule that a reissue claim which omits a limitation relied upon to overcome a prior art rejection in prosecuting the patent is always impermissible under the recapture rule. Rather, the Panel was correct in applying the fact-specific analysis set forth in *Clement*.

- B. No. In applying the analysis discussed above to the facts of this case, the Board reached the same conclusion that was reached by the Panel in the prior decision, namely, that the reissue claims in this case are *not* precluded by the reissue recapture rule.

In accordance with the **first step** of the *Clement* test, the Board compared the reissued claims with the issued patent claims to determine whether or what “aspect” the reissue claims are broader than the patent claims. The comparison revealed that each of claims 15 and 22 is broader than patent claim 1 in that several limitations have been omitted (see pp. 1730-31).

Having determined that the reissue claims have been broadened relative to patent claim 1, the Board then proceeded to the **second step** to determine whether those broadenings relate to surrendered subject matter. The prosecution history revealed that one of the omitted limitations [“said retaining member being generally bowl-shaped and convex toward said magnet”] had been added to claim 1 in order to overcome the prior art rejection. Thus, in adding that limitation, Applicants conceded that claim 1 prior to that amendment was not patentable, thereby surrendering the subject matter of that claim. Hence, the omission of this limitation in reissue claims 15 and 22 is an aspect germane to the prior art rejection.

The **third step** in the inquiry is to compare the rejected reissue claims 15 and 22 to the surrendered subject matter (rejected claim 1 before the second amendment) to determine in what aspects the reissue claims are broader or narrower than the surrendered subject matter. Here, the reissued claims are broader in that the limitations (p. 1731, second column) are omitted with respect to rejected claim 1. However, these omissions clearly relate to features which were not argued by Appellants as distinguishing over the applied prior art. Thus, these omissions are not germane to the prior art rejection. Next, the Board then determined that the reissue claims are narrower than the surrendered subject matter – the reissue claims having limitations (see p. 1731) that defined the claimed subject matter over the prior art and thus are germane to the prior art rejection. Thus, clearly surrendered subject matter has *not* crept into the reissue claims.

Conclusion

- The Board reaches the same conclusion of the earlier decision of the three-member Panel that reissue claims 15 and 22 (and hence claims 16-21 which depend from claim 15) are narrower than the surrendered subject matter in an aspect germane to the prior art rejection (i.e., the shape of the retaining member) and broader only in aspects unrelated to the rejection [*Clement* category (3)(b)]. Thus, in accordance with the principles in *Clement*, the recapture rule does not bar the present reissue claims.
- Based on the prosecution history, Applicants did not surrender anything narrower than the subject matter of rejected claim 1 (once amended) – the outer circle – which did not have the limitation “said retaining member being generally bold-shaped and convex toward said magnet.”
- In the reissue application, the Applicants simply corrected the error in the original application, which had limited the shape of the retaining member more narrowly than was required to overcome the prior art rejection. The Applicants had claimed less than they had a right to claim, and this is the type of error which can be corrected by reissue under 35 U.S.C. § 251. To hold otherwise would controvert the remedial nature of the statute.