

Keywords: Reissue Patents; Written Description Requirement; 35 U.S.C. § 251

General: Claims of a reissue patent are subject to a heightened written description requirement.

Forum US, Inc. v. Flow Valve, LLC
United States Court of Appeals for the Federal Circuit
No. 2018-1765
Decided June 17, 2019

I. Facts

Flow Valve owns U.S. Patent No. RE45,878 (“the Reissue patent”) which is a reissue of U.S. Patent No. 8,215,213 (“the ‘213 patent”). During prosecution of the Reissue patent, Flow Valve added seven claims but did not modify the written description or drawings of the ‘213 patent. The additional claims of the Reissue patent omitted certain features that were included in the claims of the ‘213 patent. Example claims of the Reissue patent and the ‘213 patent, along with figures illustrating the omitted features of the Reissue patent claims, are included in the Appendix.

Forum moved for summary judgment of invalidity of the Reissue patent in a suit in the Western District of Oklahoma. Forum contended that the new claims of the Reissue patent were invalid, because they did not comply with the written description requirement of 35 U.S.C. § 251. In opposition, Flow Valve argued that a PHOSITA would understand that the original patent disclosed multiple inventions, including embodiments without the omitted features of the Reissue patent claims. Flow Valve supported its argument with an expert declaration from an experienced machinist (e.g., a PHOSITA).

The District Court granted summary judgment of invalidity of the Reissue patent, because the written description and drawings of the original patent do not disclose the invention of the Reissue patent. Flow Valve appealed to the Federal Circuit.

II. Issue

Do the new, broader claims of the Reissue patent comply with the heightened written description requirement of § 251?

III. Discussion

No. The court agreed with the District Court’s determination that the new claims of the Reissue patent do not comply with the written description requirement of § 251.

The written description requirement of § 251 provides that “[w]henver any patent is, through error, deemed wholly or partly inoperative or invalid...the Director shall...reissue the patent *for the invention disclosed in the original patent*, and in accordance with a new and amended application...No new matter shall be introduced into the application for reissue.” 35 U.S.C. § 251(a) (emphasis added). Particularly, when broadening claims in a reissue patent, “it is not enough that an invention might have been claimed in the original patent because it was

suggested or indicated in the specification.” *U.S. Indus. Chems., Inc. v. Carbide & Carbon Chems. Corp.*, 315 U.S. 668, 676 (1942). The court emphasized that the specification of the original patent must do more than merely suggest or indicate the invention recited in the reissue claims, “[i]t must appear *from the face of the instrument* that what is covered by the reissue was intended to have been covered and secured by the original.” *Id.* Stated differently, the original patent “must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Antares*, 771 F.3d at 1362.

Flow Valve did not dispute that the ‘213 patent did not expressly disclose the embodiment of the Reissue claims (e.g., the arbor-less embodiment). Instead, Flow Valve argued that a PHOSITA would understand from the specification of the ‘213 patent that the arbors were an optional feature. Flow Valve relied on the expert declaration of a PHOSITA to assert that the PHOSITA would understand the embodiment of the Reissue claims as being *possible* in view of the specification of the ‘213 patent. The court emphasized that nowhere in the written description or drawings of the ‘213 patent are the omitted features from the Reissue claims described as optional. Thus, even though the PHOSITA would understand the embodiment as being possible, that is insufficient to meet the standard of § 251.

Additionally, the court distinguished *In re Amos*, where a reissue patent was ruled patent eligible. 953 F.2d 613 (Fed. Cir. 1991). There, the Patent Office denied the reissue application based on the lack of an “intent to claim” the new subject matter (e.g., the claims of the original application did not include subject matter of the reissue claims. The court it reversed, holding that the absence of an “intent to claim” was by itself an insufficient basis to deny the application and that instead, the “essential inquiry under the ‘original patent’ clause of § 251 . . . is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and *disclosed* by the patentees.” *Id.* at 618 (emphasis added). In the present case, the court held that such a disclosure of the subject matter in the broadening reissue claims is missing in the written description and drawings.

IV. Conclusion

The court affirmed the District Court’s grant of summary judgment of invalidity of the Reissue patent, because the new, broader claims of the Reissue patent do not comply with § 251. The court emphasized that the heightened written description requirement of § 251 requires that the written description actually disclose the embodiment of the reissue claims, rather than a PHOSITA understanding the embodiment as being possible based on the written description.

V. Appendix

The '213 patent:

1. A workpiece machining implement comprising:
 - a workpiece supporting assembly comprising:
 - a body member having an internal workpiece channel, the body member having a plurality of body openings communicating with the internal workpiece channel;
 - means supported by the body member for positioning a workpiece in the internal workpiece channel so that extending workpiece portions of the workpiece extend from selected ones of the body openings;
 - a *plurality of arbors* supported by the body member, *each arbor* having an axis coincident with a datum axis of one of the extending workpiece portions; and
 - means for rotating the workpiece supporting assembly about the axis of a selected *one of the arbors*.

The Reissue patent:

14. A workpiece supporting assembly for securing an elbow during a machining process that is performed on the elbow by operation of a workpiece machining implement, the workpiece supporting assembly comprising:
 - a body having an internal surface defining a channel, the internal surface sized to receive a medial portion of the elbow when the elbow is operably disposed in the channel; and
 - a support that is selectively positionable to secure the elbow in the workpiece supporting assembly, the body pivotable to a first pivoted position, the body sized so that a first end of the elbow extends from the channel and beyond the body so the first end of the elbow is presentable to the workpiece machining implement for performing the machining process, the body pivotable to a second position and sized so that a second end of the elbow extends from the channel beyond the body so the second end of the elbow is presentable to the workpiece machining implement for performing the machining process.

The omitted “arbors” of the Reissue patent:

