

Keywords: recapture, reissue

General: A reissue application cannot recapture claim scope which was surrendered to overcome a § 101 rejection.

In re McDonald

United States Court of Appeals for the Federal Circuit

No. 2021-1697

Decided: August 10, 2022

I. Facts

In 2008, McDonald filed a patent application for methods and systems for displaying primary and secondary search results in response to search queries. The original claims were rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. In response, McDonald amended the claims to include “a processor” performing the search queries. Moreover, McDonald argued that the new “processor” limitations overcame the § 101 rejection by tying a method to a particular machine, which imposed meaningful limits in the scope of the claims. The Examiner agreed.

While the 2008 application was pending, McDonald filed a continuation application which eventually issued as U.S. Patent No. 8,572,111 (“the ‘111 patent”). The ‘111 patent included “processor” limitations similar to those in the parent. In 2015, McDonald filed a reissue application for the ‘111 patent with amendments to remove the “processor” limitations. The Examiner rejected the amended claims as obvious. McDonald appealed to the Board.

The Board affirmed the obviousness rejection and introduced two new grounds of rejection:

1. The reissue claims impermissibly attempted to recapture subject matter that the patentee intentionally surrendered during prosecution to overcome the § 101 rejection.
2. The Inventor Reissue Declaration was defective, lacking an error correctable by reissue.

McDonald appealed this decision.

II. Issue

Does the recapture rule apply to subject matter surrendered to overcome a § 101 rejection?

III. Discussion

Yes. The Federal Circuit affirmed the Board's decision to reject the reissue application based on the recapture rule.

The reissue statute allows a patentee to correct errors in an issued patent if the patent is "through error, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." 35 U.S.C. § 251(a). At the same time, the recapture rule provides that a reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. As such, the recapture rule protects the public interest in finality and certainty of patent rights. Notably, the recapture rule considers a patent family's entire prosecution history. *See MBO Lab'ys*, 602 F.3d at 1318. Accordingly, it makes no difference whether the reclaimed subject matter was surrendered during prosecution of the parent or the continuation application.

The recapture rule follows a three-step analysis, determining (1) whether the reissue claims broaden the scope of the claims; (2) if so, whether the broadening aspect relates to surrendered subject matter; and (3) if so, whether the surrendered subject matter has crept into the reissue claim. By first adding the "processor" limitations to overcome a § 101 rejection, and then removing similar limitations in the reissue, McDonald attempted to reclaim a broader scope by including the surrendered subject matter. Moreover, McDonald deliberately amended the claim scope during prosecution, arguing that the "processor" limitations imposed meaningful limits. Therefore, the "processor" limitations were not an error, i.e., "inadvertence or mistake." *In re Youman*, 679 F.3d at 1343.

McDonald argued that the recapture rule is limited to amendments made to reclaim subject matter surrendered to "prior art" rejections. In particular, McDonald cited language from prior court decisions which explain the recapture rule in context of subject matter rejected under § 102 and § 103. *See, e.g., Medtronic, Inc. v. Guidant Corp.*, 465 F.3d 1360, 1372–73 (Fed. Cir. 2006); *Cubist Pharms., Inc. v. Hospira, Inc.*, 805 F.3d 1112, 1121 (Fed. Cir. 2015). However, the court found that merely because the previous cases involved prior art rejections, it does not mean that the recapture rule is limited to that context. That is, there is no precedent for *not* applying the recapture rule to amendments made to overcome a § 101 rejection. Instead, application of the recapture rule depends on whether there was an intentional surrender of claim scope. Therefore, the "processor" limitations were subject to the recapture rule, even though the scope was surrendered to a § 101 rejection instead of a § 102 or § 103 rejection.

Regarding the defective Inventor Reissue Declaration, the Board found therein a lack of error correctable by reissue based on the violation of the recapture rule. Accordingly, McDonald's argument regarding the Inventor Reissue Declaration fell with the argument of the recapture rule.

IV. Conclusion

While prior decisions have held that the recapture rule explicitly applies to claim scope surrendered to prior art rejections, the recapture rule may apply in any context where the patentee intentionally surrendered claim scope, including in response to a § 101 rejection.