

Patent Reissue after *Eggert*: Reclaiming the Ring

By Michael Messinger and Lori Gordon

When considering a broadening reissue application, patent owners often confront a recurring issue: Can a limitation added or argued during prosecution of an original patent to gain allowance over prior art later be broadened during reissue? Recent developments in case law at the Federal Circuit Court of Appeals and U.S. Patent and Trademark Office (“USPTO”) suggest a way to permissibly broaden such limitations through reissue and still avoid recapture. We call it reclaiming the ring.

Reissue practice is corrective. It allows a patent owner to correct one or more errors in a patent and is authorized by statute, 35 U.S.C. §251. One of the recognized errors that may be corrected is when a patent owner has claimed less than he had a right to claim. In this instance, a patent owner can file for broadening reissue and seek broader claims. Certain restrictions apply, however, such as the patent owner must be diligent (a broadening reissue application must be filed within 2 years from the original patent

issue date). In addition, filing requirements must be met, such as filing a reissue declaration signed by inventors, obtaining consent of an assignee, and remitting payment of reissue filing fees.

Recapture is frequently the chief obstacle to a broadening reissue strategy. The recapture rule is a judicial doctrine that prevents patent owners from impermissibly recapturing what was previously surrendered during prosecution of the original patent. Avoiding recapture is especially important in the scenario addressed here where a limitation added or argued during prosecution of an original patent to gain allowance over prior art (“added/argued limitation”) is sought to be broadened through reissue. Fortunately, the recent *Eggert* case, decided as a precedential opinion by the USPTO Board of Patent Appeals and Interferences (“BPAI”), outlines an approach where such added/ argued limitations may be broadened. See, *Ex parte Eggert*, 67 U.S.P.Q.2d 1716 (Bd. Pat. App. & Interf. 2003).

It is helpful to first review the broadening recapture rule, and then consider in more detail aspects of the *Eggert* Board opinion that relate to the argued/added limitation scenario.

Broadening Recapture Rule Involves a Three-Part Analysis

The Federal Circuit has endorsed a three-step process for applying the recapture rule. *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366 (Fed. Cir. 2001). The first step involves

determining whether, and in what aspects, reissued claims are broader than the original patent claims. The second step involves determining whether the broadened aspects of the reissue claim relate to surrendered subject matter. Subject matter may be considered “surrendered” for purposes of the recapture rule when claims are canceled or limitations are added to gain allowance over prior art rejections. Remarks made during prosecution can also act to surrender subject matter. *Hester Indus. Inc. v. Stein, Inc.*, 142 F.3d 1472, 1482 (Fed. Cir. 1998). Finally, the third step involves determining whether the reissue claims are materially narrowed in other respects to avoid the recapture rule. See, *Pannu* at 1371, and *Eggert* at 1723-1727.

In the context of a reissue application, any change to an original patent claim to add new limitations or omit limitations to independent claims is considered to be broadening. Therefore, to avoid impermissible recapture, the constraints of the second and third steps must be carefully considered. This frequently entails presenting a mix of broadening and narrowing reissue claim limitations compared to subject matter surrendered in the original patent. In practice, this analysis is often complex and fact specific. *Eggert* at 1727. For example, the analysis can involve evaluating broadening and narrowing aspects of reissue claims germane to canceled subject matter and prior art rejections.

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See, *In re Clement*, 131 F.3d 1464, 1470-1471 (Fed. Cir. 1997).

Broadening Limitations While Avoiding Recapture **Argued/Added**

In *Eggert*, the BPAI thoroughly considered prevailing Federal Circuit case law on recapture and permitted broadening of a limitation previously added to gain allowance over prior art. *Eggert* at 1730-31. Moreover, the BPAI provided a helpful framework and image to better understand this result. In the interest of brevity, we only highlight here relevant aspects of the *Eggert* case and its majority opinion analysis.

The original and reissue patent claims in *Eggert* related to a bit holder having a structure to retain a magnet in a bore. The specification disclosed two embodiments for the retaining structure, a flat circular disk and a bowl-shaped structure. During prosecution of the original patent, the claimed retaining structure shape was amended to be limited to a bowl-shaped structure in response to prior art rejections. At reissue, broader claims were submitted. Certain limitations such as "cylindrical," "axis" and others were omitted. These limitations were not the type of limitations that were argued or added to gain allowance, and indeed did not distinguish the invention over the cited prior art. This broadening to remove unnecessary limitations such as "cylindrical" and "axis" was considered by the BPAI to be broadening in an "aspect not germane to a prior art rejection." *Id.* at 1731.

The retaining structure shape limitation, germane to a prior art rejection, was also broadened. In particular, the limitation was broadened from a bowl-shaped structure to "substantially covering" in one independent reissue claim and "having a continuous outer periphery" in another independent reissue claim. This broadening of the bowl-shape limitation, while germane to the prior art rejection, did not constitute recapture since the broadening was *still narrower than what was*

surrendered earlier based on prior art. See, *Id.* at 1731-1732. The BPAI majority concluded, "[i]n this case, it appears appellants made an error in limiting the shape of the retaining member more narrowly than was required to overcome the prior art rejection, thereby claiming less than he had a right to claim ... and, in our view, this is the type of error which can be corrected by reissue." *Id.* at 1732.

The current Manual of Patent Examining Procedure provides another helpful example illustrating permissible reissue broadening of limitations previously added/argued during prosecution. In this example, consider a limitation "orange peel" added to a claim to gain allowance over prior art. An applicant may permissibly file and seek a broadening reissue application for a claim having the broadened limitation "citrus fruit peel" in place of the orange peel limitation. Such a citrus fruit peel limitation retains in broadened form the limitations argued or added to overcome the art rejection in the original prosecution but does not recapture the surrendered subject matter. See, M.P.E.P. §1412.02.C.2.(d).

To some, this tolerance for allowing limitations argued or added during prosecution to be broadened may seem surprising, and even contradictory, compared with recent developments in the area of prosecution history estoppel (PHE). In a PHE situation, adding or arguing claim limitation to gain allowance over prior art, now can give rise to a rebuttable presumption that equivalents extending beyond the literal claim scope are *not* permitted. See, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabusiki Co., Ltd.*, 535 U.S. 722 (2002). Attempts to carry over such limits on recapture in the PHE to broadening reissue recapture have not yet succeeded. See, *Eggert and Dethmers Manufacturing Co., Inc. v. Automatic Equipment Mfg. Co.*, 299 F.Supp. 2d 903 (N.D. Iowa 2004). This may be justified, since the policy grounds for prosecution history estoppel recapture and

reissue recapture are entirely different. Unlike PHE, the reissue context is remedial, the public is on notice of the filing of a reissued patent application, and intervening rights are available to protect the investments of others made prior to grant of a reissued patent. See, 35 U.S.C. §252. See also, the extensive discussion of reissue practice and trends in the reissue capture doctrine by then USPTO officials, Steven G. Kunin and Kenneth Schor, "The Reissue Capture Doctrine: Its Place Among the Patent Laws," 22 *Cardozo Arts & Ent. L.J.* 451, 2004.

Eggert highlights a ring of opportunity between surrendered subject matter and issued patent claims, and suggests one way in which patent owners may seek broader limitations on subject matter argued and added during prosecution. At present the *Eggert* approach is supported by the precedential Board opinion itself, and is consistent with Federal Circuit recapture law and policy. For patent owners seeking to enhance the value of their patent holdings, *Eggert* points a way to reclaim the ring.



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