

THE REISSUE RECAPTURE DOCTRINE: ITS PLACE AMONG THE PATENT LAWS

STEPHEN G. KUNIN* & KENNETH M. SCHOR**†

INTRODUCTION: THE MISSION OF THE RECAPTURE DOCTRINE ..	453
A. <i>Why Reissue?</i>	453
1. Broadening the Patent Claims.....	455
B. <i>Then Why Prohibit a Broadening Correction by the Recapture Doctrine?</i>	456
C. <i>The Significance of Understanding Recapture</i>	459
D. <i>Framework Charts</i>	461
I. HISTORICAL RECAPTURE DOCTRINE	462
A. <i>Shepard v. Carrigan</i>	463
B. <i>Topliff v. Topliff</i>	464
C. <i>In re Murray</i>	466
D. <i>Ex parte Lumbard</i>	468
E. <i>In re Byers</i>	469
F. <i>In re Willingham</i>	473
G. <i>In re Petrow</i>	474
H. <i>In re Richman</i>	476
I. <i>In re Wadlinger</i>	477
J. <i>Overview of Recapture History</i>	478
II. "MODERN RECAPTURE"	479
A. <i>Ball Corp. v. United States</i>	479
B. <i>Mentor Corp. v. Coloplast, Inc.</i>	481
C. <i>In re Clement</i>	485
1. The Facts	485
2. The Decision	487
3. General Guidelines Set Forth in <i>Clement</i>	488
4. The Canceled Claim as the Basis for Comparison	490
a. How the <i>Clement</i> Fact-Situation Was Resolved	490
b. Treatment of the <i>Ball</i> Ruling and Implications of Same	490

* Steven G. Kunin is the Deputy Commissioner for Patent Examination Policy of the U.S. Patent and Trademark Office.

** Kenneth M. Schor is a Senior Legal Advisor in the Office of Patent Examination Policy.

† [Author's note: The views and opinions expressed herein are solely those of the authors and do not necessarily reflect the views of the U.S. Patent and Trademark Office.]

c.	<i>Clement</i> and Broadening and Narrowing of the Canceled Claims in the Area of Surrender	492
d.	View Through a Model Fact Situation....	493
D.	Hester Industries, Inc. v. Stein, Inc.	499
E.	Pannu v. Storz Instruments Inc.	503
1.	The <i>Clement</i> three step recapture analysis, restated in <i>Pannu</i>	506
III.	SELECTED LOWER TRIBUNAL DECISIONS: FOR RECAPTURE ISSUES NOT YET CONSIDERED BY THE FEDERAL CIRCUIT	510
A.	Ex parte Eggert et al.	510
1.	The Facts	510
a.	Prosecution History, Briefly	510
2.	The BPAI's Decision	511
3.	Discussion of <i>Eggert</i>	512
4.	<i>Eggert</i> Simplified: A Model for an <i>Eggert</i> Factual Situation and Holding	512
a.	Approach #1. The Canceled Claim.....	513
b.	Approach #2. Also Use the Patent Claim.	513
B.	B.E. Meyers & Co. v. United States	514
C.	Ex parte Yamaguchi	516
IV.	THE NATURE OF THE STATEMENT OF SURRENDER.....	521
V.	THE PRESENT STATE OF RECAPTURE	523
A.	<i>The 3-Step Test for Recapture</i>	523
B.	<i>The Claims Used for Comparison of Broadening/ Narrowing</i>	524
C.	<i>Claim Limitations That Materially Narrow</i>	524
D.	<i>Broadening the Canceled Claim</i>	526
E.	<i>A Caveat</i>	526
VI.	LOOKING TO THE FUTURE: HOW PRESIDENT CAN WE BE?	527
A.	<i>If Reissue Broadening Eliminates Key Limitation,¹ but Narrowing Occurs in Other Areas, Will Recapture Be Avoided?</i>	529
B.	<i>What If Reissue Claim Eliminates a Key Limitation, Because It Recites an Entirely New Invention That Does Not Rely Upon (Nor Recite) the Aspect of the Claim Narrowed to Obtain the Original Patent?</i>	531
1.	Combination–Subcombination Scenario.....	531
2.	Multiple Embodiments Scenario	532

¹ Relied upon in the prosecution of the original patent to overcome the art.

2004]	THE REISSUE RECAPTURE DOCTRINE	453
	3. Different Categories of Invention Scenario . . .	533
C.	<i>What If a Reissue Claim Does Not Recite Specific Key Limitation but Does Recite Key Limitation in Broadened Form?</i>	534
	1. Nuances	535
D.	<i>What If a Reissue Claim Does Not Recite One of the Key Limitations Relied on to Define Over the Art, but Does Recite the Other Such Limitations?</i>	536
E.	<i>What Happens When the Patent Law Changes After the Patent Has Issued?</i>	536
F.	<i>Who Can Make a Statement/Argument That Affects Surrender?</i>	538
CONCLUSION	539
A.	<i>We Are “Here,” but We Must Be Aware of Where “Here” Is at Any Given Moment</i>	529
B.	<i>Trends in Recapture Law</i>	531
C.	<i>Is the Equitable Purpose of the Reissue Statute Being Served By the Recapture Doctrine?</i>	534
	1. The Recapture Doctrine, as It Is Currently Being Applied, Does Appear to Be Serving the Purpose of the Reissue Statute	535

INTRODUCTION: THE MISSION OF THE RECAPTURE DOCTRINE

A. *Why Reissue?*

People are not perfect; they make mistakes. That is why pencils have erasers and keypads have “delete” and “insert” buttons. This is especially true in the complex and highly technical area of patent drafting, which combines technology with law, and which is more an art than a science. In recognition of this, 35 U.S.C. § 251 and its predecessor statute² were enacted to permit a patent owner to correct errors in a patent after it is granted. Pursuant to 35 U.S.C. § 251, a patent owner may reissue its patent to correct an “error” in the patent if the error (1) was made without deceptive intention and (2) renders the patent “wholly or partially 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.”³ Furthermore, 35 U.S.C. § 251, paragraph

² 35 U.S.C. § 64, ch. 730 § 4916, 45 Stat. 732 (1928) (current version at 35 U.S.C. § 251 (2004)).

³ 35 U.S.C. § 251 (2004) is entitled *Reissue of defective patents* and states: Whenever any patent is, through error without any deceptive intention, 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

four, added that correction of a patent that is too narrow in claim coverage (claim scope) can be obtained if filed for within two years of the patent grant, and if in the form of a “reissue[d] patent . . . enlarging the scope of the claims of the original patent.”

The reissue statute effectuates the principle articulated by Chief Justice Marshall in *Grant v. Raymond*,⁴ who opined that “a defective patent was an inadequate exchange for the patentee’s disclosure of an invention and that a new patent should be issued, in appropriate circumstances, which secures to the patentee the benefits which the law intended.”⁵ Stated another way, the patent owner has given the public valuable information, and, as part of that bargain, the patent owner should be rewarded for that public disclosure. Thus, it is only fair that the patent owner receive the opportunity to correct an honest mistake made during the process of obtaining the protection to which the owner is entitled. In addition, it is axiomatic that fixing something to make it better is inherently a “good” thing, and should be fostered. Accordingly, the courts have consistently interpreted the reissue statute as remedial in nature.⁶ For example, in *In re Weiler*,⁷ the Federal Circuit stated, “[I]n enacting the statute, Congress provided a statutory basis for correction of ‘error.’ The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally.”⁸

had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

⁴ 31 U.S. (6 Pet.) 218, 244 (1832).

⁵ See also *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556, 1565 (Fed. Cir. 1989).

⁶ *In re Swartzel*, 36 U.S.P.Q.2d 1510 (Fed. Cir. 1995) (unpublished); *Hewlett-Packard*, 882 F.2d at 1556; *In re Oda*, 443 F.2d 1200 (1971). See also *Ex parte Hipkins*, 20 U.S.P.Q.2d 1694 (Bd. Pat. App. & Int. 1991) (“Our reviewing court has stated on several occasions that the reissue statute is remedial in nature and to be liberally construed.”).

⁷ 790 F.2d 1576 (Fed. Cir. 1986).

⁸ *Id.* at 1579.

1. Broadening the Patent Claims

It is also in the public interest to permit an owner to correct a patent by increasing its scope of protection, where such protection is equitable and the patent is relatively new. This is because it is the time when the patent owner is in a position to "try out the patent." The owner can attempt to commercialize the invention, and the competitors can take note of the patented invention and try to design around it, or otherwise respect it. While the patent is new, the patent owner should be permitted to perfect the claim protection obtained, and broaden the scope of the patent as needed (to the extent such is supported by the patent's disclosure). To accommodate this need, the reissue statute⁹ permitted, since its inception, correction of patents by permissible broadening. An unlimited time for enlarging the scope of the patent claims, however, would result in an undue burden on the public, who would wish to be secure in the knowledge that the patent protection will not be extended to the detriment or prejudice of a competitor who relied on the scope of the original patent claims. Accordingly, courts have limited broadening of the patent claims via reissue to a relatively brief window of time during which the patent is relatively new. After that window of opportunity has expired, the patent owner could no longer broaden its scope. The owner has sat on his rights too long and laches applies. To balance the interest of the public in having a security measure with the interest of the patent owner in being able to correct the patent, the 1952 statute set this window of opportunity at two years.¹⁰

⁹ First, in 35 U.S.C. § 64, Section 4916 R.S. (prior to the recodification of 1952) as the statute was interpreted by the case law (e.g., *Topliff v. Topliff*, 145 U.S. 156 (1892)), *Miller v. Brass Company*, 104 U.S. 350 (1881), and then explicitly in 35 U.S.C. § 251, the last paragraph.

¹⁰ See 35 U.S.C. § 251 (last paragraph); see also P.J. Federico, *Commentary on the New Patent Act* at 19, in 35 U.S.C.A. (1954 ed., discontinued in subsequent volumes) (reprinted in 75 *J. Pat. Trademark Off. Soc'y* 161, 205 (1993)).

While the old statute began with the word 'Whenever' and no time limitation was expressed, the courts developed a *rule of laches* according to which a *broadened reissue* could not be applied for more than two years after the grant of the original patent except under extraordinary circumstances excusing the delay, and the delay was seldom excused. This rule of laches had been applied in a few instances when the delay was less than two years, and, since 1939, when the former public use period of two years which served as an analogy for the time under the laches rule, was changed to one year, the period of laches has been taken as one year in some cases. The new statute enacts a fixed period of two years from the grant of the original patent, within which to apply for a reissue 'enlarging the scope of the claims of the original patent.' Such a reissue cannot be obtained on an application filed more than two years after the date of the original patent, and presumably is timely if applied for within two years as far as the reissue requirements are concerned.

Id. (emphasis added).

If the patent owner neglects to take advantage of this window of opportunity, the courts will not have sympathy for the owner when he later comes into court and tries to ask the court to extend the protection of the patent claims beyond their original scope. In *Graver Tank & Mfg. Co. v. Linde Air Products Co.*,¹¹ the Supreme Court sanctioned owners coming into court under the doctrine of equivalents for extension of the protection of the patent claims beyond their literal scope. However, in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*,¹² and in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*,¹³ this ability was significantly pared back to the point where negative inferences may be easily drawn from the prosecution history to deny access to the doctrine of equivalents (prosecution history estoppel). The ability of the owner to broaden within two years provides a rationale for the courts to stringently limit the protection of the patent claims, via the doctrine of equivalents, beyond their literal scope.¹⁴ However, a patentee who inadvertently fails to claim disclosed subject matter is not left without remedy. Within two years from the grant of the original patent, a patentee may file a reissue application and attempt to enlarge the scope of the original claims to include the disclosed but previously unclaimed subject matter.¹⁵ This is some comfort to the public, and is yet another benefit resulting from the option to broaden by reissue.

B. *Then Why Prohibit a Broadening Correction by the Recapture Doctrine?*

In spite of (a) the public interest in correction of patents, (b) the benefits of permitting broadening via reissue, and (c) the resulting liberal construction of the reissue statute, the courts gradually created a doctrine to prohibit impermissible recapture of claim scope via reissue, the doctrine known as the “recapture doctrine.” To wit, if a patent applicant narrowed the scope of the claims during the prosecution of an application to overcome art of record (i.e., to distinguish the claims from the art), the original scope of the claims has been surrendered and cannot be subsequently retrieved by way of reissue. In other words, if an aspect of the claims

¹¹ 339 U.S. 605, 606 (1950).

¹² 520 U.S. 17 (1997).

¹³ 535 U.S. 722 (2002).

¹⁴ See *Johnson & Johnston Associates Inc. v. R.E. Ser. Co.*, 285 F.3d 1046, 1055 (Fed. Cir. 2002) (holding the patent owner was barred from recovering the “steel” embodiment of the invention—in addition to “aluminum” embodiment actually claimed—via the doctrine of equivalents).

¹⁵ See 35 U.S.C. § 251 note (2000) (Persons entitled to reissue).

was relied upon during the prosecution of an application to overcome the art, that aspect of the claim can no longer simply be eliminated from the patent claim by way of reissue. Why not? If applicant intentionally narrowed his claims to avoid the art of record, should the patent owner be precluded from changing his mind? To answer this question, we must take a close look at the recapture doctrine.

The “error” that a reissue corrects must have been the result of “inadvertence, accident, or mistake” on the part of the applicant in the application for the patent to be reissued.¹⁶ As pointed out in *In re Weiler*, “[t]he reissue statute was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute *de novo* his original application.”¹⁷ Accordingly, the federal courts have held consistently that during the prosecution to obtain a patent, the narrowing of claims to distinguish a rejection based on prior art is not an “error” (as required by 35 U.S.C. § 251) in the patent.¹⁸ Rather, the patent applicant is deemed to have made an informed decision based upon the art of record to surrender a certain scope of the claim

¹⁶ See *In re Byers*, 230 F.2d 451, 454 (1956), which stated:

The use of the word ‘error’ in that sentence [of 35 U.S.C. § 251] instead of the words ‘inadvertence, accident or mistake,’ which appeared in the corresponding section, 35 U.S.C. § 64, ch. 730 § 4916, 45 Stat. 732 (1928) (current version at 35 U.S.C. § 251 (2000)) of the patent statutes prior to the recodification of 1952, does not involve a substantive change, and the same type of error is necessary to justify a reissue after the enactment of the Patent Act of 1952 as before.

When this issue again came before the Court of Customs and Patent Appeals (C.C.P.A.), via *In re Wadlinger*, 496 F.2d 1200, 1207 (C.C.P.A. 1974), the Court reviewed the legislative history of 35 U.S.C. § 251 and concluded that “in *Byers* this court was correct in noting that the substitution of ‘error’ in § 251 for ‘inadvertence, accident, or mistake’ did not involve a substantive change.” The Federal Circuit ratified the C.C.P.A.’s view via *Ball Corp. v. United States*, 729 F.2d 1429 (Fed. Cir. 1984).

¹⁷ 790 F.2d 1576, 1582 (Fed. Cir. 1986).

¹⁸ See, e.g., *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480 (Fed. Cir. 1998) (“The recapture rule ‘prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims.’”). See also *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997) (stating that “[t]he rule is rooted in the ‘error’ requirement in that “such a surrender is not the type of correctable ‘error’ contemplated by the reissue statute.”) (emphasis added); *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995 (Fed. Cir. 1993) (stating:

If a patentee tries to recapture what he or she previously surrendered in order to obtain allowance of original patent claims, that ‘deliberate withdrawal or amendment . . . cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the matter withdrawn.’)

See *Haliczer v. United States*, 356 F.2d 541, 545 (Ct. Cl. 1966); see also *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366 (Fed. Cir. 2001); *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997); *Ball Corp.*, 729 F.2d at 1436 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d at 1200, (C.C.P.A. 1974); *In re Richman*, 409 F.2d 269, 276 (C.C.P.A. 1969); *In re Willingham*, 282 F.2d 353 (C.C.P.A. 1960).

subject matter, and the public is entitled to rely on that decision made to narrow the claims to avoid the art.¹⁹ The patent owner cannot recapture (i.e., impermissibly recover), by way of reissue, claim subject matter that was deliberately surrendered (in an application for the patent) in order to distinguish over a prior art rejection of the claims.²⁰

The reissue statute provides a patent correction remedy only where the *equities* point in that direction.²¹ If an applicant has made an *informed* decision to surrender a scope of claim subject matter, the equities do not dictate permitting the applicant to recover exactly what it surrendered to obtain the patent after the patent is granted. If the rejected broader version of the claims becomes commercially important to the patent owner's competitor, the owner would try to recover the broader version, or some useful form thereof, by reissue. The patent owner could also wait to see what alternative disclosed limitation the public might choose other than the limitation actually added to define over the art, and then amend the claims to cover such activity accordingly. In these situations, the owner should not be permitted to unfairly prejudice the public.

On the other hand, it is also possible that the patent owner looked for a way to define over the art of record, and simply made *an honest mistake* in amending the claims too narrowly. For example, a patent owner amended the claims by "narrowing A," even though "narrowing B" would have better served patent owner's interests and was an equally viable way to overcome the art. The patent owner may simply not have thought of "narrowing B" instead of

¹⁹ See *Mentor*, 998 F.2d at 996, which stated:

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 developments in the marketplace might be regretted. It is precisely because the patentee amended his claims to overcome prior art *that a member of the public is entitled to occupy the space abandoned by the patent applicant*. Thus, the reissue statute cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so.

(emphasis added).

²⁰ See, e.g., *Pannu*, 258 F.3d at 1366; *Hester Industries, Inc.*, 142 F.3d at 1472; *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997); *Mentor Corp.*, 998 F.2d 992; *Ball Corp.*, 729 F.2d 1429; *In re Wadlinger*, 496 F.2d 1200 (C.C.P.A. 1974); *In re Richman*, 409 F.2d 269 (C.C.P.A. 1969); *In re Willingham*, 282 F.2d 353 (C.C.P.A. 1960).

²¹ As stated by the Supreme Court in *Miller v. Brass Company*:

[W]hilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of opinion that this can only be done when an actual mistake has occurred; not from a mere error of judgment (for that may be rectified by appeal), but a real bona fide mistake, inadvertently committed; such as a Court of Chancery, in cases within its ordinary jurisdiction, would correct.

104 U.S. 350, 355 (1881). A Court of Chancery provides relief based upon equity.

“narrowing A” at the time he addressed the art. Possibly, the owner overlooked that separate claims could have been presented, one with “narrowing A,” and one with “narrowing B.” Is it fair that the owner should now be “stuck” with narrowing A as a requirement of the claims? Based upon the interests identified above, the answer is no. The purpose of the reissue statute is to permit the patent owner to correct this type of error. This would appear to be so, even for substituting “narrowing C” in place of “narrowing A,” where “narrowing C” would overcome the prior art, even though “narrowing C” is not as narrow as “narrowing A.” In this situation, if the patent owner is able to show good faith by including “narrowing B” or “narrowing C” in place of “narrowing A,” he should be permitted to do so, thereby correcting his honest mistake.

Even in the situation of an honest mistake, however, there may be an additional complication. If the patent owner is only willing to proffer a replacement narrowing that is merely cosmetic, in that it could never define the claims over the prior art, then the owner is not giving the public a true *quid pro quo* for recovering “narrowing A” via reissue. In this instance, although the initial error was an honest mistake, a “correction” of the patent should be prohibited.

The recapture doctrine serves to police the reissue statute to ensure that it is applied equitably to correct patents and is not abused. When used for that purpose, the recapture doctrine is a legitimate and valuable tool for administering reissue. However, when the doctrine becomes a creature of “wooden rule” and mechanical analysis devoid of equity, application of the doctrine precludes a legitimate and fair correction of patents.

This article will discuss how the courts and the U.S. Patent and Trademark Office (“USPTO”) analyze the recapture-issue situations that they encounter. This article also will discuss whether the courts and the USPTO are applying the recapture doctrine consistent with its purpose, and will look specifically at how they investigate the patent owner’s intent, and how they determine whether the owner is providing the public with a true *quid pro quo* when seeking a broadened reissue. When the courts and the USPTO properly analyze recapture-issue situations and apply the recapture doctrine consistent with its purpose, then the court-created “recapture” doctrine deserves its legitimate purpose.

C. *The Significance of Understanding Recapture*

The issue of recapture arises when an application is filed with the USPTO for a reissue patent, when a surrender of claim subject

matter has been made during the prosecution of the patent, and when the claims are broadened in the reissue application. This issue can also arise when a federal court reviews a reissued patent for validity in an infringement suit under 35 U.S.C. § 271 (where the reissue patent contains broadened claims and there was surrender in the prosecution of the original patent). When the issue arises, the USPTO or the federal court must determine whether the broadening of the reissue claims recaptures the scope of claim subject matter that was surrendered in the application for patent. In such instances, the deciding official must look to, and analyze, the prosecution history of the patent to find the scope of the claim subject matter surrendered, and whether the reissue claims impermissibly recover that scope.

As will be discussed below, reissue claims cannot eliminate a claim limitation of the original patent that was argued to define over the art to obtain the original patent (to be referred to as the “key limitation”). Recently, an expanded panel of the Board of Patent Appeals and Interferences (“BPAI”) held in *Ex Parte Eggert*²² that a reissue claim might omit the specific key limitation, if the reissue claim contains a “replacement” for that key limitation which is simply a broadened version of the omitted key limitation. The *Eggert* opinion provided an extensive review of the recapture doctrine, as the BPAI perceives it, including a discussion of recovery of surrendered claim subject matter via reissue. As a result of *Eggert*, there is renewed interest in how much of the claim narrowing done in the prosecution of the original patent can be recovered via reissue without recapturing claim subject matter surrendered in order to obtain the original patent. What flexibility does a patent owner have in amending the patent claims by reissue, where prior art was applied to the claims in the prosecution of the original patent, and where the claims were amended/argued to distinguish over the prior art?

An awareness of what is, or is not, a surrender for purposes of recapture is important to a patent applicant prosecuting an application for patent, as it provides the applicant with notice of the ground rules and consequences for making statements and revising the claims, specifications and drawings in the course of prosecuting the application to allowance. It is equally important to a party who seeks to challenge the validity of a reissue patent, to pro-

²² Decision of the Board of Patent Appeals and Interferences, Patent No. 5,577, 426, paper No. 22, 34-35 (Bd. Pat. App. & Inter. 2003) (a precedential opinion of an expanded panel of the BPAI).

vide an indication of the probability of success of challenging the patent and whether to expend valuable resources in doing so. An awareness of how the patent can be fixed after a surrender has been made in the application for a patent is important to a patent owner who has honestly narrowed the claims more than needed in the face of the art.

This article will explore the latitude available to the patent owner to recover claim scope via reissue. An exploration of this matter will be made in the context of case law as it has developed to define the concept of surrender of claim subject matter, which cannot be recaptured. The article will study the trend of this case law, discuss future possibilities, and evaluate whether the recapture doctrine is serving a legitimate purpose. The article will begin with a description of the history of the recapture doctrine prior to the centralization of all appealed recapture cases in the Court of Appeals for the Federal Circuit. Then, the key recapture cases that the Federal Circuit heard and decided will be discussed and examined for their holdings, as well as guidance given by the Federal Circuit to the lower tribunals²³ and how the lower tribunals have interpreted that guidance. A brief look will also be provided as to the nature of a claim revision, statement, or argument that provides a surrender of claim subject matter that cannot be recaptured. The article will next summarize the current status, and then take a brief look at the future and reissue recapture questions in need of resolution by the Federal Circuit. Finally, a conclusion will explore whether the reissue recapture doctrine is fair and equitable.

D. *Framework Charts*

We have attached three charts to the end of this article. Two recapture table charts and a recapture flow chart furnish different mechanisms for viewing the overall recapture picture. These charts provide a framework for the discussion that follows as well as a reference for finding the place-marker in the recapture picture into which the below items of discussion and cases are believed to fit.

The table chart constitutes a grid that presents the feasible possibilities of claim broadening and narrowing that may be encountered when addressing recapture issues, i.e., the claim scope factors. This table chart also categorically presents the various per-

²³ The phrase "lower tribunals" encompasses the administrative bodies and officials, as well as the lower courts that decide patent issues in the United States.

mutations of the presence or absence of these factors and the resultant finding as to the recapture issue. The left-most column sets forth how the scope factors into how the reissue claims are related in scope to the patent claims and the "canceled" claims as appropriate. The "Categories" rows constitute the various permutations of claim broadening and narrowing that may be encountered when addressing recapture issues. To accompany this chart, we have included another table chart to show the impact of claim scope factors tending toward and away from a finding of recapture, and thereby show the effect of balancing the factors for each of the categories to provide an equitable result.

To furnish a mechanism for viewing the methodology of the overall recapture picture, we have attached a flow chart version of the first chart. The flow chart illustrates the directional analysis that one can follow in resolving reissue fact situations.

I. HISTORICAL RECAPTURE DOCTRINE

In *South Corp. v. United States*,²⁴ the Federal Circuit adopted as precedent the holdings of the U.S. Court of Claims and of the U.S. Court of Customs and Patent Appeals (C.C.P.A.).²⁵ It was noted in *Ball Corp. v. United States*,²⁶ that the Court of Claims, the C.C.P.A., and several circuit courts have ruled on the issues involved in recapture. Historical recapture, for the purposes of this article, is regarded as the body of recapture law represented by the holdings of those courts (and the Supreme Court), which was announced before the close of business on September 30, 1982, when the Court of Claims and Court of Customs and Patent Appeals ceased to exist, and by statute, appellate patent law was centralized in the newly established Court of Appeals for the Federal Circuit. Such pre-Federal Circuit decisions were relied upon in the early Federal Circuit decision regarding recapture issues, and it is worth reviewing them for background and to observe how early "recapture" developed and evolved. This section is directed to that body of law, which provides the historical foundation for the recapture doctrine. We will begin with two late nineteenth century Supreme Court recapture cases, and then look at how subsequent lower courts further developed the law.

²⁴ 690 F.2d 1368 (Fed. Cir. 1982).

²⁵ See *id.* at 1370.

²⁶ 729 F.2d 1429 (Fed. Cir. 1984).

A. Shepard v. Carrigan²⁷

Shepard involved infringement of a patent drawn towards a skirt protector formed with a waterproof material made of a plaited or fluted strip that would protect the lower edge of a skirt from contact with moisture on the ground. The defendant's alleged infringing skirt protector was made of waterproof material *without use of a fluted or plaited border*. Plaintiff insisted that the fluted or plaited border was merely a matter of preferred design and not an essential part of the invention, while defendants urged that by virtue of the absence of a fluted or plaited border, their product did not infringe the patent claims.²⁸

The original specification as filed described forming the moisture-proof material into pleats. That original specification was withdrawn and a substitute was provided, in which all references to pleats was omitted. The substitute application was rejected twice over a patent, which contained neither a plaited nor fluted (skirt) border. After the second rejection, an amended specification was filed, and the claim contained a recitation to a plaited or fluted border for a skirt.²⁹

The Supreme Court held that the recitation of a plaited or fluted border was an essential element of the claims, and without such an element, the patent would not have issued.³⁰ The Court stated:

Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent.³¹

The Court took a strict construction view of the claim limitations where an amendment has been made, relying on the following statement made in *Sargent v. Hall Safe and Lock Co.*,³²: "In patents for combinations of mechanisms, *limitations and provisos imposed by the inventor*, especially such as were introduced into an application

²⁷ 116 U.S. 593 (1886).

²⁸ *Id.* at 595.

²⁹ *Id.* at 596-97.

³⁰ The Court looked to evidence in the record of the case that, as far back as the year 1857, protectors were used without fluting or plaiting, and it looked at the file-wrapper for the rejection of the claim without the recitation of the fluting and plaiting. *Shepard*, 116 U.S. at 597.

³¹ *Id.* at 597.

³² 114 U.S. 63 (1885).

after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public, and looked upon as in the nature of disclaimers."³³

The Court also relied upon the theory that appeal rather than narrowing to obtain a patent followed by reissue, broadening was the proper procedure to follow. The court held, "[I]f an applicant, in order to get his patent, accepts one with a narrower claim than that . . . contained in his original application he is bound by it. If dissatisfied with the decision rejecting his application, he should pursue his remedy by appeal."³⁴

In *Shepard*, the patent owner tried to recover the surrendered claim subject matter by way of the doctrine of equivalents; *Shepard* was not a reissue case. However, the *Shepard* Court stated, "[U]nder the circumstances of this case, the inventor *could not even get a reissue* based on the broader claim which she had abandoned."³⁵ In addition, the *Shepard* case is the seminal case that subsequent recapture opinions either relied upon or distinguished. Thus, *Shepard*, in effect, is the fundamental case upon which reissue recapture is built.³⁶

B. Topliff v. Topliff³⁷

In *Topliff*, the lawsuit was for infringement of three patents. One of the three was a patent to Topliff that had been reissued twice. The defendant admitted to having manufactured and sold connecting rods for carriages substantially similar to those claimed by plaintiff in the Topliff patent. Defendant argued, however, that the Topliff patent had been reissued and was no longer claiming the same invention, as did the original patent.

Topliff had obtained a *first reissue* to correct a mistake in reciting how the connecting rods were to be attached. The sole origi-

³³ *Shepard*, 116 U.S. at 598 (emphasis added).

³⁴ *Id.*

³⁵ *Id.* (emphasis added).

³⁶ This is not to say that *Shepard* was the first to consider recapture or surrender issues. For example, in *Mahn v. Harwood*, 112 U.S. 354, 359 (1884), the Court stated:

[I]n *Leggett v. Avery*, . . . the reissued patent embraced a claim that had been presented on the application for the original patent and rejected. It was apparent, therefore, that the omission of that claim in the original was not, and could not have been, the result of inadvertence, accident or mistake, but was the result of design on the part of the Commissioner and acquiescence on the part of the patentee; and so far as that claim was concerned, the reissued patent was properly held to be void The proper remedy of the patentee when a claim applied for is rejected, is an appeal, and not an application for a reissue.

Shepard, however, is believed to provide the foundation due to the frequency that subsequent courts reviewing recapture issues have cited it.

³⁷ 145 U.S. 156 (1892).

nal patent claim recited that the connecting-rods were secured directly “to the front and rear axles,” while the first reissue claim provided that the connecting-rods should be “secured directly to the hind axle and front bolster.”³⁸ The language of the original claim was determined by the Court to be a “clear mistake,” since the original patent claim language would render turning impossible, and the original drawings showed the correct attachment as was set forth in the sole claim of the first reissue.

A second reissue resulted in two claims, with only one claim being relied upon by the plaintiff in the infringement suit. The relied-upon claim of the second reissue omitted the attachment requirement, that the connecting rod be secured directly to the hind axle and front bolster, and it contained a new limitation (added by the second reissue) relating to “half-elliptic springs.” This attachment requirement had been added by the first reissue to correct the original patent claims.

The Court upheld a second reissue. The Court stated:

In view of this [the infringing device did not appear until six years after second reissue was granted - so Topliff was not trying to perpetuate a fraud] and the fact that the second reissue was applied for within five months from the time the original patent was granted, and within thirty-seven days after the first reissue [so there was timeliness], and that it covers no more than the actual invention of the patentee . . . we think it should be upheld.³⁹

The Court considered the equities and the time elapsed, and did not “worry” about the fact that the attachment requirement, added to the claim via the first reissue, was omitted in the second reissue claims.

The Court dealt with the available prior art only as to the issue of whether the Topliff reissue patent was novel over a patent to Augur.⁴⁰ The Court did not otherwise address applying art to the claims. Rather, the attachment requirement omitted in the second reissue claims was stated by the Court to have been added in the first reissue to cure an operability problem as to how the connecting rods were to be attached. Today it is addressed under 35

³⁸ *Id.* at 164.

³⁹ 145 U.S. at 172.

⁴⁰ See *Topliff*, 145 U.S. at 163-64. Augur was another patent for which infringement was charged. The Court held that while the question of patentable novelty of Topliff over Augur, was “by no means free from doubt,” there was in Topliff a “deviation” from the Augur patent (a claim revision to address the Augur patent), and although “[t]rifling” as it seems to be, it was sufficient.

U.S.C. § 101 and 35 U.S.C. § 112, first paragraph. It is not stated in the decision that the attachment limitation, either in its original inoperative form, or in its form as amended by the second reissue, was added to the claims to define over any art. Apparently, the omission of the attachment limitation was not troublesome to the Court, because it had not been added to the claim to avoid the prior art. Given that factor, the Supreme Court found the *Topliff* reissues to be valid. The Court pointed out that as long as correction occurred swiftly,⁴¹ a patent claim may be enlarged by reissue “when an actual mistake has occurred; *not from a mere error of judgment (for that may be rectified by appeal)*, but a real *bona fide* mistake, inadvertently committed . . .”⁴² The *Topliff* fact situation was not one where the omission of the attachment limitation could have been secured by appeal of an examiner’s art rejection, since there was no such rejection. In that situation, based on equities and timeliness of action taken, the Court found the broadened *Topliff* reissue valid. Thus, one lesson that *Topliff* teaches is that a surrender for recapture will only occur where the claims are amended in the face of *an art rejection*.

In *Topliff*, the Supreme Court relied upon the theory announced in *Shepard*, and stated that *appeal* is the appropriate remedy where an applicant is being forced by the U.S. Patent Office to narrow the claim(s) to avoid the art, *and not subsequent broadening via reissue*. If an applicant chose not to challenge by appeal, the limiting/narrowing of the claims that the Patent Office called for was not an “inadvertence, accident, or mistake.”

Although this theory could be interpreted to bar any amendment that negates narrowing in order to avoid the prior art, the theory would subsequently be interpreted by the C.C.P.A. in its decision of *In re Richman*,⁴³ to provide a reissue applicant with some degree of latitude after narrowing a claim to avoid art, as will be discussed below. In addition, this theory has not been relied upon by the Federal Circuit in its decisions on the issue of recapture.

C. In re Murray⁴⁴

In *Murray*, claims 1, 3, and 4 were appealed in a reissue application, the claims being rejected in part based on the ground of estoppel, which is a precursor of the modern recapture doctrine.

⁴¹ More than two years were deemed to constitute abandonment of the broadened claim scope. *See Topliff*, 145 U.S. at 171, 172.

⁴² *Id.* at 167 (emphasis added).

⁴³ 409 F.2d 269 (C.C.P.A. 1969).

⁴⁴ 64 F.2d 788 (C.C.P.A. 1933).

The case reached the C.C.P.A. on appeal from the Patent Office. The C.C.P.A. found that claims 1 and 4 omitted features of substance from the disclosed information, which caused the claims to be for an invention not originally disclosed, and therefore claims 1 and 4 were not entitled to allowance. Reissue claim 3, while omitting some of what was originally *claimed*, added features that were disclosed in the original application, but still did not claim them. The court determined that the original disclosure supported claim 3, unlike claims 1 and 4, stating that the “invention claimed by said rejected claim 3 is not in any sense a broadening of the subject matter disclosed, but not claimed, in the original application and patent,”⁴⁵ i.e., claim 3 did not contain new matter.

To then evaluate whether claim 3 complied with the reissue statute, the C.C.P.A. reiterated the generally accepted notion that, “[I]f, however, the invention in question has been disclosed in the original or amended application, and claims incorporating, either broadly or specifically, such invention, have been withdrawn or canceled, before patent, then the applicant for reissue is estopped from further claiming such invention by way or reissue.”⁴⁶ In support of this, the court made reference to the *Shepard* case:

In *Shepard v. Carrigan*, 116 U.S. 593, 6 S. Ct. 493, 495, 29 L. Ed. 723, Mr. Justice Woods thus stated the rule: Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the patent-office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent.⁴⁷

The court then went further than merely acknowledging that the patentee could not reclaim the “identical, substantially the same, or broader than the abandoned claims”⁴⁸ invention previously given up. The court evaluated claim 3 as follows:

That the claim sought in the reissue is not as broad as the original claim [that was amended to obtain patentability], is of no consequence. It was included in it. When the applicant amended and limited that original claim, if he limited it to a

⁴⁵ *Id.* at 792.

⁴⁶ *Id.* at 791. The *Murray* court cited, as support, *Leggett v. Avery*, 101 U.S. 256 (1880), which noted the “immense frauds against the public” that occur where patentee comes back to the Office “under the pretense of inadvertence and mistake in the first specification, gets inserted into reissue letters all that had been previously rejected.” *Id.* at 259.

⁴⁷ *Murray*, 64 F.2d at 792.

⁴⁸ *Id.*

greater extent than was necessary, such extreme limitation may have been a mistake of judgment; but was certainly an *abandonment of all that was contained in the original claim and which was not contained in the original amendment*. There can be no middle ground. There can be no retrogression to take back part of what has been abandoned any more than to take back the whole . . . It may be that it was a mistake on the part of the applicant to limit the invention to the extent only of the claim contained in the specification annexed to the patent; but with this, of course, we have nothing to do here. The only question is whether the claim now put forward on his behalf was so far contained in his original claims that were abandoned by him as to be itself thereby necessarily abandoned. And this we must answer in the affirmative, for the abandonment of the whole necessarily implies and involves the abandonment of *all the parts except such as are expressly and specifically retained*.⁴⁹

The *Murray* court applied the above to claim 3 and found that claim 3 came within the scope of the reissue statute. The elements relied upon to constitute the patentable invention in claim 3 were stated by the court to not have been “included, either specifically or broadly,” within the scope of the canceled claims. Claim 3 was viewed to not be “in any sense a broadening of the subject-matter of said canceled claims,” but rather to constitute “a distinct subject-matter, disclosed, but not claimed, in the original application and patent.”⁵⁰ Effectively, the Court found that claim 3 was not recaptured *despite the broadening of the canceled claims*, because the canceled claims were also narrowed via claim 3. This was a very permissive view indeed.

While *Murray* contained some powerful language tending to strictly limit the patent owner’s ability to broaden via reissue after claim narrowing to obtain the original patent, this language all constituted *dicta*, since the court held Claim 3 to be within the scope of the reissue statute.

D. Ex parte Lumbard⁵¹

Ex parte Lumbard was a decision of the Patent Office Board of Appeals (“Board”). In *Lumbard*, the invention involved a cushion sole shoe having a lower stiff layer and an upper soft layer of different lengths. The patent claim required the upper layer to extend throughout the entire area of the sole, while the reissue claim re-

⁴⁹ *Id.* (emphasis added).

⁵⁰ *Murray*, 64 F.2d at 792.

⁵¹ 47 U.S.P.Q. 523 (Bd. App. 1940).

cited that the upper layer covered at least the forepart area of the sole.

The *Lumbard* Board looked to *Ex parte Lilienfield*.⁵² The *Lilienfield* invention was drawn to the curing of tobacco leaves. The original claims were amended to recite the previous aging and fermenting of the tobacco leaves and a specific period of time for treatment by a "machine-created ultra-violet ray," and that resulted in allowance of the patent. The rejected reissue claims were broader in scope than the patent claims by eliminating the time of exposure. The *Lilienfield* Board determined that the rejected reissue claims were more specific in scope than the claims that were "rejected and canceled," and thus reissue was avoided.⁵³

The *Lumbard* Board interpreted *Lilienfield* to permit an "applicant to present narrower claims in a reissue although they are broader than the claims of the original patent" and applied that concept to its decision.⁵⁴ The *Lumbard* Board stated, "[I]t is considered that applicant did not necessarily by his mistake in the prosecution of the original choose between very limited claims and the expedition of allowance of the patent"⁵⁵ The *Lumbard* Board saw no reason why the appellant should not present the narrowed and broadened claims for consideration in the reissue application, as there is no question of estoppel arising, due to the cancellation of broader claims (as was held in *Lilienfield*). Accordingly, the *Lumbard* Board determined that claim 6 of the original application was of sufficient scope to permit the reissue claim. Thus, *Lumbard* showed that the Board would be liberal where there is narrowing and broadening of the original patent claim in a reissue.

E. In re Byers⁵⁶

In the C.C.P.A.'s often-quoted decision of *In re Byers*, the claims were directed to a blasting unit. Claim 20 of the application for the original patent provided a base with a cavity with side-walls formed by two concentric downwardly diverging conical surfaces of revolution.⁵⁷ A detonator was claimed to be concentric with the conical surfaces of revolution. To obtain allowance of the patent claims, claim 20 was amended to specify the diameter of the cavity

⁵² 11 U.S.P.Q. 216 (Bd. App. 1931).

⁵³ See *Lilienfield*, 11 U.S.P.Q. at 217.

⁵⁴ *Lumbard*, 47 U.S.P.Q. at 525.

⁵⁵ *Id.*

⁵⁶ 230 F.2d 451 (C.C.P.A. 1956).

⁵⁷ One sidewall surface was conical, and one was frusto-conical.

to be approximately one-third of that of the base, and to specify the angles of the conical sidewalls with respect to the base. The original patent to *Byers* was then granted.

The *Byers*' reissue application provided claims 2 and 3, which omitted the limitation that a detonator is concentric with conical surfaces of revolution. In addition, claim 3 was broader than claim 2 by eliminating the specified angles of the conical sidewalls of the cavity, whose limitations were present in original claim 20. The reissue application claims were rejected as failing to comply with 35 U.S.C. § 251 (the reissue statute) since the failure to obtain the broadened claims present in the reissue was not due to inadvertence, accident or mistake, but rather there was a deliberate cancellation of subject matter from the claims in order to obtain the original patent. This rejection was affirmed by the Patent Office Board, and then appealed to the C.C.P.A. for review.

The Court initially pointed out that although the Patent Act of 1952 used the word "error" to replace "inadvertence, accident, or mistake," the replacement did not "involve a substantive change and the same type of error is necessary to justify a reissue after enactment of the Patent Act of 1952 as before."⁵⁸ The court then went on to state the basic premise of recapture:

It is well settled that the deliberate withdrawal or amendment of a claim in order to obtain a patent does not involve inadvertence, accident or mistake and is not an error of the kind which will justify a reissue of the patent including the matter withdrawn. Thus, in *Dobson v. Lees*, 137 U.S. 258, 11 S.Ct. 71, 73, 34 L.Ed. 652 (1890), the Supreme Court of the United States said:

A reissue is an amendment, and cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident, or mistake. Hence the reissue cannot be permitted to enlarge the claims of the original patent by including matter one intentionally omitted. Acquiescence in the rejection of a claim, its withdrawal by amendment, either to save the application or to escape an interference, the acceptance of a patent containing limitations imposed by the patent-office, which narrow the scope of the invention as at first described and claimed, are instances of such omission. (emphasis included).

Similarly in *Shepard v. Carrigan*,⁵⁹ the Court said:

⁵⁸ *Byers*, 230 F.2d at 454.

⁵⁹ 116 U.S. 593 (1886).

Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the patent-office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent.⁶⁰

The Court further pointed out:

It is evident that since the deliberate cancellation of a claim in order to obtain a patent constitutes a bar to the obtaining of the same claim by reissue, it necessarily also constitutes a bar to the obtaining of a claim which differs from that canceled only in being broader.⁶¹

The Court then noted the omission of the limitation in reissue claims 2 and 3 that the detonator be concentric with the surfaces of revolution, when claims 2 and 3 were compared with "original claim 20," i.e., claim 20 as it appeared prior to its amendment to obtain allowance of the patent. The court found that appealed claims two and three were broader in certain respects than original claim 20. Since original claim 20 had been deliberately withdrawn to obtain allowance of the patent, the reissue applicant could not obtain claims equal in scope to the original claim 20, and certainly not broader.⁶² The Board's decision was thus affirmed by the court. The fact situation in *Byers* is represented by category number one of the table chart.

The version of claim 20 that appeared prior to its amendment to obtain allowance of the patent was described as "canceled" to obtain allowance of the original patent; this terminology - "canceled claim"- would be adopted by future courts in analysis of recapture issues.

In the prosecution of the original patent in *Byers*, claim 20 was the "canceled claim" that surrendered the most claim scope. There were, however, other "canceled claims" that surrendered less claim scope. The applicant argued that since reissue claims 2 and 3 were intermediate in scope between claim 20 and these other claims, a proper correction of an error in the original patent was made. The

⁶⁰ *Byers*, 230 F.2d at 455 (citing *Shepard*).

⁶¹ *Id.* at 456.

⁶² The court stated:

[W]e are of the opinion that the appellant's action in limiting the scope of original claim twenty by amendment constituted a deliberate withdrawal of that claim as originally presented, in order to obtain a patent, and that such withdrawal is a bar to the obtaining by reissue of claim twenty as it originally stood, or of any claim differing therefrom only by being broader.

Id., (citing *In re Murray*, 64 F.2d 791).

Byers court completely rejected that theory.⁶³

It should be noted that the *Byers* court distinguished the *Lumbard* decision discussed above, characterizing *Lumbard* as involving a:

[r]eissue containing claims which were broader than those granted in the patent, *but narrower, in at least one respect, than a claim presented and canceled during the prosecution of the original application* on which the patent sought to be reissued was granted. In holding the claims of the reissue application allowable, the board noted that they were intermediate in scope between the broad claims withdrawn from the original application and the very limited claims allowed in the patent, and indicated that that cancellation of the broad claims did not necessarily act as an estoppel against the assertion of the more limited claims, intermediate between those canceled and those allowed in the patent.⁶⁴

The court noted that, unlike the situation of *Lumbard*, the *Byers* canceled claim 20 was “more limited than the claims of the reissue application.”⁶⁵

As a final point, the court served notice that the patent owner could not use the reissue statute as a vehicle for obtaining a commercial advantage; rather, reissue was designed to correct what is a true error. The court stated:

The appellant’s brief also stresses the argument that the limiting amendment of claim 20 resulted from the fact that appellant felt it necessary to obtain a patent quickly, from commercial considerations and did not wish to incur the delay incidental to seeking to obtain broader protection. Emphasis is also placed on the facts that the application for reissue was filed very promptly after the patent was granted and that the Board of Appeals reversed the holding by the Primary Examiner that the appealed claims were unpatentable over the prior art. However, since the error involved in failing to obtain the present appealed claims in appellant’s patent was not of the kind contemplated by 35 U.S.C. § 251, the specific circumstances under which it occurred, the diligence with which correction was sought and the question of patentability of the appealed claims over the prior art are not material.

The granting of reissues is limited by statute to cases in

⁶³ See *Byers*, 230 F.2d at 456. Many years later in *In re Clement*, a decision of the Federal Circuit, the applicant still had not learned the lesson that the courts would not be receptive to this theory. See discussion of *Clement*, *infra*, Part II.C.

⁶⁴ 230 F.2d at 456 (emphasis added).

⁶⁵ *Id.* at 457.

which an original patent is defective 'through error,' and 'error' as used in the applicable statute as above stated, means inadvertence, accident or mistake. Since the failure of the applicant to obtain the claims now sought by reissue in the original patent was not due to inadvertence, accident or mistake, a reissue cannot properly be granted.⁶⁶

The above principle has never been abandoned, and is a cornerstone for carrying out the purpose of reissue to permit correction where there was an honest mistake and not where the owner was trying to gain a commercial advantage.

F. In re Willingham⁶⁷

In *Willingham*, application claim 12, which was never rejected or otherwise acted upon by the Patent Office, was replaced by another claim, claim 15. There was nothing in the record to indicate that claim 12 had been held unpatentable over prior art by the examiner. After the patent had issued, a reissue application was filed, and the Patent Office rejected the reissue claims as based on reissue not being appropriate in view of the substitution of claim 15 for claim 12. When the case came before the C.C.P.A., the court noted that the "reissue claims while broader in scope than allowed claim 15, are somewhat narrower in scope than deleted claim 12."⁶⁸ The court then pointed out that the issue before it was "not the issue presented in many reissue cases in which an applicant cancels a claim to *secure the issuance of the patent* and then seeks to recapture it by a claim of the same scope in a reissue application."⁶⁹ The court proceeded to find that the *Willingham* issue was distinguishable from that of *Byers*, because claim 12 was not shown to have been rejected over the art. While applicant had given discretion to the examiner to substitute claim 15 for claim 12, the court refused to speculate as to *why* the examiner used that discretion to delete claims 12 and substitute claim 15. Accordingly, the court upheld the reissue claims.

Although the reissue was found proper, the court went on to provide *dicta*:

The *deliberate cancellation* of a claim of an original application in order to *secure a patent* cannot ordinarily be said to be an 'error' and *will in most cases prevent the applicant from obtaining the canceled*

⁶⁶ *Id.* (citations omitted).

⁶⁷ 282 F.2d 353 (C.C.P.A. 1960).

⁶⁸ *Willingham*, 282 F.2d at 356.

⁶⁹ *Id.* (emphasis added).

claim by reissue. The extent to which it may also prevent him from obtaining other claims differing in form or substance from that canceled necessarily depends upon the facts in each case and particularly on the reasons for the cancellation.⁷⁰

It was not entirely clear in which cases (that are not “most cases”) the deliberate cancellation to secure a patent *would not* prevent the applicant from obtaining the canceled claim by reissue. The case law has not yet provided an illumination as to this point.

G. In re Petrow⁷¹

In *Petrow*, the process claims that the original application presented were allowed and issued in the original patent. The product claim that was presented, however, was rejected and then replaced by a product-by-process claim,⁷² which was issued in the original patent.

After the patent was granted, a reissue application was filed to obtain a “true” product claim. This true product claim was rejected on the ground that appellants had given up true product claims during prosecution of their original application in order to obtain a patent containing product-by-process claims, and that this abandonment of true product claims created an estoppel, which prevents appellants from recapturing a true product claim by reissue.

On appeal from the Patent Office, the court determined that the examiner’s *rejection* of the product claim in the original application was that the examiner felt that “no true product claim could issue based upon this specification, but that a proper product-by-process claim would be allowable.”⁷³ On this point, the court noted that applicant argued in the appeal to the court

that claim 4 is clearly different from claim 10 because it [claim 4] is unpatentable under the tests laid down by the Board of Appeals in *Ex parte Brian*, 118 U.S.P.Q. 242, . . . Appellants’ argument that claim 4 was unpatentable is apparently based upon their conclusion reached after the interview with the examiner. Unfortunately, the record does not reveal what occurred at the interview between appellants’ attorney and the examiner. However, appellants’ belief then that no true product claim could issue based upon this specification appears to be shared by the

⁷⁰ *Id.* at 357 (emphasis added).

⁷¹ 402 F.2d 485 (C.C.P.A. 1968).

⁷² A “product-by-process claim” describes the product by stating that it is the product made by the process claimed, rather than describing the product by its characteristics.

⁷³ *Petrow*, 402 F.2d at 487.

examiner in the instant case, as noted in his Answer.⁷⁴

Even though the applicant and examiner appeared to share the opinion that true product claim 4 was “canceled” as it was not patentable, the court found recapture *not* to be present. The court stated:

It is significant, moreover, that claim 4 was never rejected for this reason and the board’s response to the examiner’s treatment of claim 10 was as follows:

Claim 10 also stands rejected as indefinite because it does not particularly point out and distinctly claim the compound. We find the claim presents sufficient of the distinctive properties and characteristics of the compound to adequately define the compound. See *Ex parte Brian et al.*, 118 U.S.P.Q. 242, quoted by appellants.

The appellants erred in believing that no true product claim could issue based upon this specification. Now they have convinced the Patent Office that product claim 10 is in allowable form. We do not think there are sufficient facts in the record to base a holding that the cancellation of claim 4 was in any sense an admission that claim 10 was not in fact patentable to appellants at the time claim 4 was canceled.

We have assessed the solicitor’s arguments and considered the numerous cases on reissue cited in support of the position of the board, but we feel that the substitution, as here, of a claim proper in form for a claim believed to be formally defective under 35 U.S.C. § 112 but not rejected by the examiner for this reason is distinguishable from the fact situation of these prior cases.⁷⁵

It is significant that, despite the cloudy record as to why applicant believed the claim could not be patentable and canceled it, the court refused to imply that the claims were deemed by applicant to be unpatentable over 35 U.S.C. §§ 102 or 103. The court also refused to admit unpatentability on the part of applicant. Accordingly, the court reversed the Board, and permitted the reissue patent. This appears to have signaled that the court would not accept anything less than cancellation of a claim due to the existence of specific identified prior art before a surrender was considered to have been made.

It is noteworthy that the court focused on the true product claim reciting “more inherent properties . . . so as to more fairly ‘fingerprint’ it, results . . . in a claim differing in form . . . as well as

⁷⁴ *Id.* at 487-88.

⁷⁵ *Id.* at 488.

presenting a claim having a different scope of legal protection.”⁷⁶ In other words, the court could have based its decision (that there was no recapture) upon the narrowing provided by reissue claim 10 as compared with the canceled claim. Yet, the court did not base its decision on narrowing to avoid the consequences of the surrender, but rather found “outright” that the record was not sufficient to find any surrender (despite the ambiguities in the record).

This policy of refusal to find a surrender for reissue recapture or accept anything less than cancellation of a claim due to the existence of specific identified prior art has not been abrogated to date.

H. In re Richman⁷⁷

In *Shepard* and *Topliff*, the Supreme Court stated a doctrine that where claims are narrowed in the face of the applied art, the choice to narrow is not an “inadvertence, accident, or mistake,” and the narrowing cannot be undone after the patent has issued. In *Richman*, the C.C.P.A. interpreted this theory to provide some degree of latitude to a patent owner who had narrowed a claim to avoid prior art.

The C.C.P.A. in *Richman* took note of the Patent Office Solicitor’s reliance on the C.C.P.A. statement in *In re Wesseler*⁷⁸ that *Shepard v. Carrigan* “may be support for the rule that one who deliberately adds a limitation to avoid the prior art cannot omit that limitation in reissue claims so as to encroach upon the prior art”⁷⁹ The C.C.P.A. then addressed the Solicitor’s reliance as follows:

Referring back to *Shepard*, however, it is apparent that the situation there was one in which the omission of the added limitation would have resulted in the claim being *drawn to the same subject matter as the original rejected claim, to which the limitation was added, thus making it unpatentable over the prior art for the same reason as the original claim*. We therefore find neither decision to be authority for the proposition that a limitation added to a claim in obtaining its allowance cannot be broadened, under present statutory law, by reissue if the limitation turns out to be more

⁷⁶ *Id.* at 488. Appellant had urged that the reissue product claim ten could only cover a single compound in view of the greater recitation of properties, while the cancelled claim could describe of plurality of compounds. *See id.*

⁷⁷ 409 F.2d 269 (C.C.P.A. 1969).

⁷⁸ 367 F.2d 838 (C.C.P.A. 1966).

⁷⁹ *Richman*, 409 F.2d at 274.

restrictive than the prior art required. Certainly *one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.*⁸⁰

Thus, in the *Richman* view, the *Shepard* and *Topliff* doctrine applies only to a claim canceled to avoid the prior art; only such a claim should have been appealed rather than trying to recover it by reissue. If, however, the patent owner makes the reissue claim more specific than the canceled claim to thereby avoid the prior art, then the patent owner has simply corrected an error in the way the claims were revised in the application to avoid the art. It is true that applicant's removal of the canceled claim to avoid the prior art was deliberate; however, via the replacement claim which applicant provided in the application to narrow the canceled claim, applicant inadvertently did the narrowing the wrong way, i.e., in a manner that now deprives the patent owner of the coverage to which the patent owner is entitled.

This, in effect, made the "canceled claim" the standard to which a reissue claim would be compared. If the reissue claim were equal in scope to the canceled claim, or broader than the canceled claim, recapture would be found. If the reissue claim were narrower than the canceled claim in some aspect, presumably the C.C.P.A. would never find recapture to exist. The Federal Circuit's decision of *Pannu v. Storz Instruments Inc.*, to be discussed later, would take issue with this *Richman* conclusion, without discussing what *Shepard* and *Wessler* meant to say on the point.

I. In re Wadlinger⁸¹

In *Wadlinger*, the applicant canceled the application claims directed to the use of crystalline zeolites, when those method-of-use claims were rejected as being the obvious use of the product *even though the product was patentable*. After the application matured into a patent, the opinion of *In re Kuehl*⁸² was issued, holding, in effect, that a patentable product cannot be used as part of the prior art in determining whether an applicant's process of using that product would have been obvious to one of ordinary skill in the art. A reissue application was then filed to add to the patent the previously canceled process claims of using the patentable zeolite. Notwith-

⁸⁰ *Id.* at 274-75 (emphasis added).

⁸¹ 496 F.2d 1200 (C.C.P.A. 1974).

⁸² 475 F.2d 658 (C.C.P.A. 1973).

standing the change in law announced in *Kuehl*,⁸³ the *Wadlinger* court did not end the controversy by simply permitting use of reissue to obtain the process-of-using claim previously canceled based on the case law in effect at the time. Rather, the court sought to ascertain whether the claimed process-of-using added via reissue was of the same or of a narrower scope as compared to that of the canceled claims.

The court noted appellant's arguments that the claims which were "canceled" in the original application were not similar in scope to the claims on appeal, and it pointed to *Willingham*, *Wesseler* and *Petrow* as broadly supporting "the proposition that claims of a scope narrower than claims canceled from the original application [but broader than the patent claims] may be obtained by reissue."⁸⁴ The court went on to determine that

[w]hile both the canceled claims and the appealed claims may be directed to the same process, *the scope of the canceled claims was indeed broader than the scope of the appealed claims* which, in more fairly fingerprinting the processes, results in claims which differ from the canceled claims in the scope of legal protection afforded.⁸⁵

Accordingly, the court found that there was no recapture.

J. *Overview of Recapture History*

The above case law represents the state of the recapture doctrine, just prior to the dawn of the Federal Circuit. While the Supreme Court had made some strong statements attempting to strictly limit the ability of a patent owner to recover claim narrowing that was done to avoid prior art in the prosecution of the original patent, the lower courts tended to apply the law to the facts presented to them in a somewhat liberal manner, to permit recovery of such claim narrowing. When the Federal Circuit was eventually formed, such application of the doctrine gradually changed.

⁸³ See *id.* (overruling *In re Saunders*, the court noted that *Saunders* had held that, "where an old method or process is used by an applicant in the administration of a new and analogous material, and the improved result was due solely to the quality of the material used, no inventive method or patentable process is involved . . .").

⁸⁴ *Wadlinger*, 496 F.2d at 1204.

⁸⁵ *Id.* at 1206 (emphasis added). This closely parallels language in *Petrow*, to which the court cited.

II. "MODERN" RECAPTURE

A. *Ball Corp. v. United States*⁸⁶

Ball was the first case to have any significant recapture issue that was decided by the Court of Appeals for the Federal Circuit.⁸⁷ The court analyzed the case law directed to the recapture doctrine that preceded the Federal Circuit's creation, such case law having been formulated by the various courts and other deciding officials that had jurisdiction over patent matters.

In *Ball*, the patent owner (Ball) sued the United States (the Government) seeking damages for infringement of its Krutsinger reissue patent relating to a dual slot antenna assembly for use on missiles. The Government moved for summary judgment, asserting that the reissue patent claims that were allegedly infringed were invalid, based upon, *inter alia*, impermissible recapture of surrendered subject matter. When the trial court denied the Government's motion, the Government appealed that denial to the Federal Circuit.

The original Krutsinger patent claimed a dual slot antenna assembly employing two concentric (cylindrical) conductors configured to strengthen the radiation pattern emitted by reducing "signal nulls." Dependent claim 8 included the single feedline requiring "at least one" conductive lead to be connected to the edge of one of the conductors. Dependent claim nine required that "a plurality of leads" be connected to the edge of one of the conductors at circumferentially spaced intervals. The examiner rejected claims 1 through 8 over prior art, and suggested the allowability of the plurality of feedlines claims if presented in independent form. In order to obtain allowance of the claims over the prior art applied to the claims, applicant (Ball) revised the claims to require that *a plurality of leads* be connected to an edge of the outer conductor. These leads were to be spaced apart at intervals substantially equal to one wavelength at the anticipated operating frequency of the antenna. The application claims directed to a single feedline and conductive lead were canceled, and a patent issued. Subsequently, Ball filed a reissue application, adding claims directed to the single feedline embodiment, and a reissue patent was granted. It is this reissue patent on which Ball's suit was based.

In its appeal to the Federal Circuit, the Government argued that Ball's deliberate cancellation of the single feedline claims was

⁸⁶ 729 F.2d 1429 (Fed. Cir. 1984).

⁸⁷ The previous case having significant recapture issues, *In re Wadlinger*, 496 F.2d at 1200, was decided by the Court of Customs and Patent Appeals.

not an error correctable via reissue, because that action was taken by Ball to avoid a prior art rejection. Accordingly, the Government urged that the claims added via the reissue that were directed to the single feedline embodiment were barred by the recapture rule. The *Ball* court held, however, that the claims to the single feedline embodiment were not barred by the recapture rule. The Court noted that, as determined by the trial court, “the reissue claims were intermediate in scope – broader than the claims of the original patent yet narrower than the *canceled claims*.”⁸⁸ The court pointed out that:

[t]he canceled claims, claims 7 and eight, define the invention quite broadly. Canceled claim eight requires feed means including at least one conductive lead. The reissue claims, in contrast, include limitations not present in the canceled claims: the cavity is filled with a dielectric material; and an electrical signal feed assembly replaces the feed means of the canceled claims . . . The *signal feed* assembly is more limited than the ‘*at least one*’ *feed means* limitation of canceled claim eight.⁸⁹

The court thus found that recapture was not present, because the reissue claims were narrower in scope than the “canceled claims.” In fact, the court later noted, “there is widespread agreement that reissue claims that are *narrower than the canceled claims* are allowable.”⁹⁰

In *Ball*, the Government argued that the trial court incorrectly failed to focus on “the *feature* that the patentee gave up during prosecution of the original application,”⁹¹ i.e., the right to claims with a single feedline. The court rejected this argument, stating “[t]he proper focus is on the *scope* of the claims, not on the individual *feature* or *element* purportedly given up during prosecution of the original application.”⁹²

As a side issue, the court acknowledged that the reissue claims

⁸⁸ *Ball*, 729 F.2d at 1437 (emphasis added) (citations omitted).

⁸⁹ *Id.* (emphasis added) (citations omitted). Claim 8 was dependent on independent claim 7. Canceled claim 7 recited an “electrical signal feed means connected with said conductor.” Canceled claim 8 required that the “feed means” of claim 7 include “at least one conductive lead.” Thus, the “canceled claims” in the original *Ball* application were directed to *one or more* electrical signal *feed means* having *one or more* conductive *leads*. The reissue claims were limited to *one* electrical signal *feed means*, which could have one or more conductive leads. Thus, the reissue claims were narrower than canceled claims 7 and 8 as to requiring one feed means. The Court never looked at the claims that were revised to define over the art and thus became the patent claims, which were directed to one or more electrical signal feed means having more than one (a plurality of) conductive leads, despite the reliance on more than one conductive lead for defining over the art. *See id.*

⁹⁰ *Id.* at 1438 (emphasis added).

⁹¹ *Id.* at 1437.

⁹² *Ball*, 729 F.2d at 1437.

were broader than the *canceled claims* in one respect, i.e., the canceled claims were limited to an antenna of cylindrical configuration, whereas the reissue claims were not so limited. The court, however, refused to apply the recapture rule to this broadening, stating: “[w]e decline to apply that rule here, where the broader feature relates to an aspect of the invention that is not material to the alleged error supporting reissue.”⁹³ Further, “[w]e find that the non-material, broader aspects of Ball’s reissue claims do not deprive them of their fundamental narrowness of scope relative to the canceled claims. Thus, the reissue claims are sufficiently narrower than the canceled claims to avoid the effect of the recapture rule.”⁹⁴

Ball appeared to lay down a principle that recapture was avoided if the reissue claims were narrower in scope than that of the claims “canceled” to obtain allowance of the original patent. It was not relevant that the applicant had added a specific feature in order to avoid the prior art. The reissue claims did not need to include that narrowing feature, as long as they included some other feature that narrowed the canceled claims. In *Ball*, the narrowing features added in via the reissue were material features, but the court did not address that point. *Ball* would fit within category number eight of the table chart; the reasoning behind this placement will be discussed later in this article.

Ball also pointed out that the “canceled claims” could be broadened, as long as the broader feature related to an “aspect” of the invention that was “not material” to the “error supporting the reissue.” The broadening should not deprive the reissue claims of their “fundamental narrowness of scope relative to the canceled claims.”⁹⁵ *Ball* did not, however, define the terms in quotes.

B. Mentor Corp. v. Coloplast, Inc.⁹⁶

Mentor came to the Federal Circuit by way of defendant Coloplast’s appeal from a District Court judgment holding, *inter alia*, that the claims of Mentor’s reissue patent were willfully infringed by the defendant and that the reissue patent was not invalid.

The patent claims in *Mentor* are directed to a device (condom catheter) that is used on male patients suffering from incontinence. In the examination of the original patent, the application

⁹³ *Id.* at 1438.

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ 998 F.2d 992 (Fed. Cir. 1993).

claims were rejected based upon a combination of prior art references. In response to the rejection of the claims based on prior art, Mentor, the applicant, amended the application claims in two stages to require that,

as the sheath member is rolled up, the pressure sensitive adhesive on the outer surface is in direct contact with the inner surface of an adjacent roll so that as the sheath member is unrolled, *the adhesive on the outer surface is transferred without rolling the catheter inside out . . .*⁹⁷

Mentor argued that “none of the references relied upon actually showed the transfer of adhesive from the outer surface to the inner surface as the sheath is rolled up and then unrolled.”⁹⁸ Mentor characterized the applied art “as disclosing the ‘transfer’ of adhesive from the outer to the inner surface solely by turning the sheath inside out so that the outer surface becomes the inner surface and the adhesive always remains on the same surface.”⁹⁹ The claims then issued as a result of Mentor’s amendment and argument.

Later, Mentor filed for and obtained a reissue patent adding new claims that omitted the requirement of transfer of adhesive from the outer to the inner layer as per the patent claims that had been amended to define over the applied prior art. Despite the absence of this limitation, Mentor obtained allowance of the new claims over the art by submitting “detailed information on commercial success.”¹⁰⁰

The court held that the new claims added by the reissue patent were invalid, as they were barred by the recapture doctrine. The court stated:

Coloplast correctly argues that reissue claim 6, which does not include the adhesive transfer limitation, impermissibly recaptures what Mentor deliberately surrendered in the original prosecution. Specifically, *the reissue claims do not contain the limitation that, during rolling and unrolling, the adhesive be transferred from the outer to the inner surface of the catheter.*¹⁰¹

At first glance, this appears to state that, regardless of what other limitation was added to the claims, any reissue claim that omitted the key limitation that was added to secure allowance of the origi-

⁹⁷ *Id.* at 993 (emphasis added).

⁹⁸ *Id.* at 995.

⁹⁹ *Id.* at 996.

¹⁰⁰ *Id.*

¹⁰¹ *Id.* (emphasis added).

nal patent claims would be invalid as being a recapture of the surrendered subject matter. The *Mentor* court, however, then went on to discuss the other narrowing limitations added in the new reissue claims as to their effect on avoiding recapture.¹⁰² The newly added reissue patent was materially narrower in some respects, albeit broader in others. The court first stated, as a rule, that:

Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule. If a reissue claim is broader in a way that does not attempt to reclaim what was surrendered earlier, the recapture rule may not apply. However, in this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. *Mentor* thus attempted to reclaim what it earlier gave up. Moreover, the added limitations do not narrow the claims in *any material respect* compared with their broadening.¹⁰³

The court then proceeded to explain why the narrowing limitations added to the new reissue claims were not “material.” As to the one new independent claim in the reissue patent: the new limitation requiring the catheter material to be “flexible” did not materially narrow the claims, because the patent claims already recited that the material was to be “resilient.” Likewise, a limitation that the catheter be rolled outward to form a “single” roll did not materially limit the claims because the catheter could only be rolled and applied from a single end to form a single roll, since the other end is connected to a urine collection means. Furthermore, the addition of “thereon,” referring to the location of the adhesive release layer on the outer surface prior to unrolling, and “only,” referring to the adhering of the adhesive to the inner surface after unrolling, did not materially narrow the claims, presumably¹⁰⁴ because that was inherent in the structure of the patent claims.¹⁰⁵

As to the dependent claims, they were not deemed to avoid recapture because they did not add any limitations, material in relation to the impermissible broadening, that distinguished them over the independent claim, which the court already determined to not provide material narrowing. One of the dependent claims recited a bulbous surge chamber, which the court stated to already

¹⁰² *Mentor*, 998 F.2d at 996. The court provided this discussion to address *Mentor*'s argument that recapture was avoided.

¹⁰³ *Id.* at 996 (emphasis added).

¹⁰⁴ In this instance, the court did not give the specific reason why there was no material narrowing. *See id.*

¹⁰⁵ *See generally id.*

have been in the prior art. As to another dependent claim, the recitation of the material of the adhesive release layer was stated to not materially narrow the claim.

Based on the court's analysis finding no materiality of the added claim limitations, *Mentor* would fit within category # 6 of the table chart. It appears from *Mentor* that an added limitation does not materially narrow a claim if: (1) The limitation added was inherent from the existing claim limitations (i.e., was inherent prior to the addition of the new limitation); (2) The addition to the requirements of the claim (e.g., to the claim structure, composition, or method) was *de minimis* in importance; and (3) The addition to the requirements of the claim is found in the prior art. The added limitation is not in the primary reference applied, and maybe not even in the secondary reference, but it is shown to be known or common in the prior art, it would have reasonably been combined with the primary reference to obtain the results of such a combination which was also known, and there is no evidence that anything unexpected would result from the combination.

Mentor only provided a piece of the puzzle: the analysis of the *Mentor* court as to the limitations added in the reissue claims regarding whether narrowing was provided thereby, despite the omission in the reissue claims of the key limitation, implied that the court would accept some limitation in replacement of the key limitation, as long as the "replacement" limitation was "material." The *Mentor* court gave examples of what was not "material." But what would be a "material" limitation, in the court's view? The patent community was left to guess at the answer to this question each time it added new claims in a reissue application, or considered voiding a reissue patent via litigation. In *Ball*, the reissue claims were held not to be recapture, because, in place of the omitted requirement of the patent claim, the reissue claims included limitations not present in the canceled claims identified (by the court) as, for example, a cavity filled with a dielectric material, and an electrical signal feed assembly which replaced the feed means of the canceled claims.¹⁰⁶ What was it about those replacement claim limitations that made them material? Was it the mere fact that such replacement claim limitations defined the claims over the prior art? The patent community simply could not be certain.

¹⁰⁶ 729 F.2d at 1437.

C. In re Clement¹⁰⁷

The next decision to shape (or reshape) the recapture doctrine was *Clement*. In *Clement*, the Federal Circuit began the process of defining what would be an acceptable, i.e., material, “replacement” limitation for a key limitation (i.e., limitation relied upon in the original prosecution to define over the art), which is omitted in the reissue patent application claims. The *Clement* court looked at a “material limitation” in terms of a limitation, which is related to the subject matter previously surrendered by applicant, (although the court did not state it in such terms), and it also began to define the term, “related.” The *Clement* opinion was lengthy, and it was the topic of much interpretation and construction by the case law that followed it.

1. The Facts

Clement came to the Federal Circuit by way of the reissue applicant’s appeal from a decision of the Board of Patent Appeals and Interferences (BPAI) sustaining the rejection of claims in a reissue application under 35 U.S.C. § 251. The *Clement* claims¹⁰⁸ were directed to a method for treating a mixture of printed and contaminated waste paper in order to produce pulps to be used in the manufacture of pulp and paperboards. The point of the method was to treat waste paper by removing “‘stickies,’ such as glues and plastics, under a first set of environmental conditions, before removing inks under a second set of environmental conditions.”¹⁰⁹ The specific method is complex, and a review of the method steps of patent claim 1 is needed for an understanding of the case. The steps are:

- (a) Forming a first aqueous fibrous suspension of said waste paper *at room temperature* by applying *specific mechanical energy lower than 50 KW.H/Ton* to form a pumpable slurry and to release the non-ink contaminants including the stickies from the surface of the paper; (b) removing the non-ink contaminants (including the stickies), which were released in the previous step, by screening and cleaning *at room temperature* to form a second aqueous fibrous suspension free of the non-ink contaminants (including the stickies); (c) softening the ink vehicles and weakening their binding to the surface of the fibers by submitting the fibrous suspension at a specified consistency to the simultaneous actions

¹⁰⁷ 131 F.3d 1464 (Fed. Cir. 1997).

¹⁰⁸ The patent was issued to Jean-Marie Clement. See *Clement*, 131 F.3d at 1466.

¹⁰⁹ *Id.*

of (A) *a high temperature between 85 [degrees] and 130 [degrees] C.*, (B) *high shear forces substantially corresponding to a specific mechanical energy of more than 50 KWH/Ton applied at the above-specified consistency and (C) at least one deinking agent under strong alkaline conditions having a pH of at least [nine]*; (d) *detaching the ink particles from the fibers and dispersing them into the fibrous suspension by submitting the suspension to the simultaneous actions of (A) high temperature between 85[degrees] and 130[degrees] C., (B) high shear forces corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the above-specified consistency and (C) at least one chemical dispersing agent, under strong alkaline conditions having a pH of at least [nine]*; (e) *limiting the duration of steps (c) and (d) to between 2 and 10 minutes, and (f) removing the detached ink particles from the fibrous suspension to provide a brightness of at least 59 ISO.*¹¹⁰

In the examination of the Clement application, the claims were rejected based on prior art, and narrowed a number of times to avoid art rejections applied to the claims. The limitations that the court stated to have been added during the prosecution of the Clement patent to avoid the applied Ortner reference that was applied were:

(1) *In steps (a) and (b), removal of all the non-ink contaminants including the stickies; (2) In steps (c) and (d), including strong alkaline conditions having a pH of at least [nine]; (3) In step (f), stating that the brightness of the final pulp was at least 59 ISO; and (4) In step (b), stating that the step takes place at room temperature.*¹¹¹

After the Ortner reference was withdrawn (in view of the above additions to the claims), Clement specifically argued that the Burns reference, which was applied at that point, failed to disclose the strong alkaline conditions having a pH greater than nine that was added to steps (c) and (d). Further, Clement continued to traverse the examiner's assertion that the reference disclosed removing the stickies at room temperature through the application of mechanical energy lower than 50 KWH/Ton. The Clement application claims were, however, further narrowed to define over Burns, including requiring a brightness of at least 59 ISO in the final pulp, and the claims were allowed.¹¹²

After the patent was granted, Clement filed a reissue application and then a reissue continuation of the first reissue application,

¹¹⁰ The critical limitations to be discussed are in italics.

¹¹¹ *Clement*, 131 F.3d at 1467.

¹¹² *Id.* at 1470.

in which *additional claims* were included that were broader than the patent claims. The examiner rejected the additional claims, and the rejection of the claims was ultimately appealed to the BPAI. The reissue application claims which were appealed to the BPAI omitted the “room temperature” and “mechanical energy lower than 50 KW.H/Ton” of patent claim 1, step (a), as well as the temperature, mechanical energy and pH conditions of steps (c) and (d) of patent claim 1.¹¹³

The BPAI found that during the prosecution resulting in the original patent, Clement added temperature, mechanical energy, and pH limitations to overcome prior art rejections. The BPAI noted that the temperature limitation in step (a) and the temperature and mechanical energy limitations in steps (c) and (d) were argued by Clement to be features not suggested by the applied prior art, and such argument was accepted by the examiner as distinguishing over the applied prior art. The BPAI found that the claims added via the reissue application did not include these key limitations, and it concluded that the added reissue claims sought to broaden the original patent in a manner directly pertinent to subject matter deliberately surrendered to overcome prior art rejections. Accordingly, the BPAI sustained the rejection of the added claims for failing to comply with 35 U.S.C. § 251. The case was then appealed to the Federal Circuit.

2. The Decision

The Court first determined that the BPAI correctly found that the reissue application claims broadened the original patent claims, and the BPAI “did not err by determining which limitations Clement deleted from the patent claims.”¹¹⁴ The Court next determined that the broadening of the reissue application claims was in the area of claim subject matter surrendered by Clement as follows. The added reissue application claims omitted the “room temperature,” and “mechanical energy lower than 50 KWH/Ton” limitations of step (a), and the “high temperature between 85 [degrees] and 130 [degrees] C,” mechanical energy of more than 50 KWH/Ton and “pH of at least 9” in steps (c) and (d), of the claim canceled to obtain allowance of the patent (claim 42, prior to the examiner’s amendment on May 16, 1988).¹¹⁵ The court held the reissue application claims having these omissions to be a recapture

¹¹³ *Id.* at 1471.

¹¹⁴ *Id.* at 1468.

¹¹⁵ *Id.* at 1471.

of surrendered subject matter. The court noted that “claim 49 is narrower in one area, namely, the brightness is ‘at least 59 ISO in the final pulp.’ This narrowing relates to a prior art rejection because, during the prosecution of the ‘179 patent, Clement added this brightness limitation in an effort to overcome Burns.’”¹¹⁶ The court found, however, that

[o]n balance, reissue claim 49 is broader than it is narrower in a manner directly pertinent to the subject matter that Clement surrendered throughout the prosecution. Even with the additional limitations, [dependent] claims 50-52 are also broader than they are narrower in a manner directly pertinent to the subject matter that Clement surrendered during prosecution.¹¹⁷

Thus, recapture was found to exist.

The *Clement* holding provided guidance in the situation where the reissue claims broadened the canceled claims in the area of surrender made as to one rejection, and did not narrow the canceled claims in the *same* area of surrender, but rather narrowed the canceled claims in the area of surrender made as to a second rejection. The Federal Circuit told the public that narrowing of the canceled claims in the area of surrender made as to a second rejection was not a narrowing significant to the first area of surrender, and accordingly, recapture was *not* avoided. See entry # 5 of the table chart.

3. General Guidelines Set Forth in *Clement*

In its discussion and analysis of the facts of *Clement*, the court provided general guidelines for analysis of recapture issues, in the form of a methodology to apply. The steps of the methodology include:

Step 1: [T]o determine whether and in what ‘aspect’ the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation’s aspect.¹¹⁸

Step 2: [T]o determine whether *the broader aspects* of the reissue claims *relate to surrendered subject matter*. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.¹¹⁹

¹¹⁶ *Clement*, 131 F.3d at 1470.

¹¹⁷ *Id.* at 1471.

¹¹⁸ *Id.* at 1468.

¹¹⁹ *Id.* at 1468-69 (emphasis added).

Step 3: Once we determine that an applicant has surrendered the subject matter of the canceled or amended claim, *we then determine whether the surrendered subject matter has crept into the reissue claim.* Comparing the *reissue claim* with the *canceled claim* is one way to do this . . . If the scope of the reissue claim is the same as or broader than that of the canceled claim, then the patentee is clearly attempting to recapture surrendered subject matter and the reissue claim is, therefore, unallowable . . . In contrast, a reissue claim narrower in scope escapes the recapture rule entirely . . . Some reissue claims, however, are broader than the canceled claim in some aspects, but narrower in others . . .¹²⁰ [T]he following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) *if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.*¹²¹

The first two steps were relatively straightforward. The third step was open to interpretation and much debate. Thus, it was asked, what exactly was an aspect “germane” to a prior art rejection? Furthermore, what is the result where the reissue claim is broader in an aspect germane to a prior art rejection, and narrower in an aspect germane to prior art rejection? The model fact situation that will be discussed below brings this issue into focus.

Much of the third step of the recapture analysis set forth is *dicta*, since it was not needed for the *Clement* holding. The patent community, however, embraced the entire analysis set out in *Clement*, as best it could be understood. As will be seen from the below discussion of the case law, tribunals deciding reissue recapture issues have struggled to apply the *Clement* analysis and provide some measure of guidance. The Federal Circuit, in *Pannu* (discussed below), would restate the third step of the *Clement* recapture analysis.

¹²⁰ *Id.* at 1469 (emphasis added) (citations omitted).

¹²¹ *Clement*, 131 F.3d at 1470 (emphasis added).

4. The Canceled Claim as the Basis for Comparison

a. How the *Clement* Fact-Situation Was Resolved

The court looked to the claims that the examiner had rejected based on *Burns*, which claims were “canceled” in favor of more specific claims, to thereby secure the withdrawal of *Burns* as a reference and a grant of the patent. Those canceled claims were found to contain the “room temperature,” and “mechanical energy lower than 50 KW.H/Ton” limitations of step (a), and the “high temperature between 85° and 130° C,” “mechanical energy of more than 50 KW.H/Ton” and “*pH of at least 9*” in steps (c) and (d), which limitations had previously been added to the claims to thereby secure the withdrawal of *Ortner* as a reference.¹²² Hence, *Clement* was found to have surrendered claims that omitted these key limitations of the canceled claims. Since these key limitations were found to be absent from the reissue claims, the court found recapture to exist. The court thus showed that it was the canceled claim that was to be compared with the reissue claims.

b. Treatment of the *Ball* Ruling and Implications of Same

In *Ball*, the patent owner had retreated from the narrowing done to obtain the patent. The patent owner retreated back to the “*canceled claim*,” and then narrowed it in a different manner (the narrowing was directed, however, to the same *general limitation* of the canceled claim). Was this still good law? The *Clement* court stated:

Similarly, in *Ball*, the issued claim recited “a plurality of feedlines” and a “substantially cylindrical conductor.” The *canceled claim* recited “feed means including *at least one conductive lead*,” and a “substantially cylindrical conductor.” The prosecution history showed that the *patentee added the “plurality of feedlines” limitation in an effort to overcome prior art*, but the cylindrical configuration limitation was neither added in an effort to overcome a prior art rejection, nor argued to distinguish the claims from a reference. The *reissue claim included limitations not present in the canceled claims that related to the feed means element*, but allowed for multiple feedlines.^[123] *On balance, the claim was narrower than the canceled claim with respect to the feed means aspect*. The reissue claim also deleted the cylindrical configuration limitation, which made the claim broader with respect to the configur-

¹²² See *Clement*, 131 F.3d at 1470-71.

¹²³ Actually, the reissue claims were directed to “a single signal feed assembly” (single feed line) while the cancelled claims permitted “electrical feed means” which could be one or more.

ation of the conductor. *We allowed the reissue claim because the patentee was not attempting to recapture surrendered subject matter.*¹²⁴

The *Clement* court also pointed out that *Ball* was an example of the situation where “the reissue claim is broader in some aspects, but narrower in others” and “the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection,” and thus, “the recapture rule does not bar the claim.”¹²⁵

Apparently, the *Clement* court considered *Ball* to still be good law. The court added, however:

We do not address whether the reissue claims in this case are broader than the canceled claims in a manner directly related to the alleged error supporting reissue because we see no dispositive significance in this inquiry. In *Ball*, we said that the recapture rule does not apply when the reissue claim is broader than the canceled claim in a manner unrelated to the alleged error supporting reissue, but did not address whether the recapture rule would apply if the broadening did relate to the alleged error. We can envision a scenario in which the patentee intentionally fails to enumerate an error so that he may eliminate a limitation that he argued distinguished the claim from a reference or added in an effort to overcome a reference and claim protection under *Ball*. We, therefore, think *Ball* is limited to its facts: the recapture rule does not apply when the broadening not only relates to an aspect of the claim that was never narrowed to overcome prior art, or argued as distinguishing the claim from the prior art, but also is not materially related to the alleged error. Accordingly, *Ball* does not require us to determine whether the broader aspects of the reissue claims are related to the alleged error supporting reissue.¹²⁶

This rather cryptic statement limited *Ball* to its facts. However, the court states that in *Ball*, the recapture rule does not apply when the reissue claim is broader than the canceled claim in a manner “unrelated to the alleged error supporting reissue.”¹²⁷ But what is this “alleged error supporting reissue?” In *Ball*, the reissue claims omitted “a plurality of leads be connected to” limitation of the electrical signal feed means that were added to obtain allowance of the original patent claims.¹²⁸ Thus, “alleged error supporting reissue”

¹²⁴ *Clement*, 131 F.3d at 1470 (emphasis added) (citations omitted).

¹²⁵ *Id.*

¹²⁶ *Clement*, 131 F.3d at 1471 (emphasis added) (citations omitted).

¹²⁷ *Id.*

¹²⁸ In *Ball*, the revised application claims that defined over the art and were thus allowed (and became the patent claims) were directed to one or more electrical signal feed means

apparently does not preclude narrowing of the “canceled claim” in an area that *fails to include the limitation relied upon to obtain the original patent*.

Stated another way, *Ball* can only be explained if the reissue claims are compared only to the canceled claims *and* the key limitation added to define patentability (over the art in the original application) can be replaced by a different limitation that defines patentability in a different way. There were those who thought such was the case.¹²⁹ Thus, the *Clement* court discussed the reissue claim as being narrower in an “aspect germane to prior art rejection.” A new unrelated reissue limitation, which now defines over the art in place of the omitted limitation can indeed be argued to be “germane to the rejection,” since that new limitation obviates the rejection. We will revisit *Ball* when we later discuss the *Pannu* case, because it is believed that *Ball*, when read through *Clement*, may be the key to understanding the state of the Federal Circuit recapture doctrine today.

c. *Clement* and Broadening and Narrowing of the Canceled Claims in the Area of Surrender

The *Clement* court found the added reissue application claims to be broader than the canceled claims in that a number of key limitations were eliminated that had been added to secure allowance of the original patent claims over the Ortner reference. Thus, the added reissue claims were broader in a manner *directly pertinent to the subject matter that the applicant surrendered* during the original prosecution (of the original patent). The added reissue claims contained a brightness limitation that narrowed the *canceled claims*. Since applicant added the narrowing aspect to define over the Burns reference, that limitation was argued to narrow the *canceled claims* in a manner directly pertinent to the subject matter that applicant surrendered during the original prosecution. From the court’s discussion of this matter,¹³⁰ it would *appear* that the court found that where a limitation that was added to define over a *first* reference is omitted in a reissue claim, narrowing of the claim as to

having more than one (a plurality of) conductive leads. The reissue claims were limited to *one* electrical signal feed means that could have one or more conductive leads, rather than requiring more than one lead. (The original patent claims requirement for plurality of conductive leads might be construed to be included within the single electrical feed assembly of reissue claim 5, but the Court did not so view it, nor include that point in its decision, so the point is not relevant as to this discussion.)

¹²⁹ For example, the Board of Patent Appeals and Interferences. See the below discussion of *Ex Parte Gilles Baudin*, Appeal No. 2001-1042, (Bd. Pat. App. & Inter. June 28, 2001).

¹³⁰ See *Clement*, 131 F.3d at 1470-71.

a limitation that was added to define over a *second* reference cannot save that reissue claim from the recapture doctrine. It is, however, troublesome that the court stated (as above quoted):

[o]n balance, reissue claim 49 is broader than it is narrower in a manner directly pertinent to the subject matter that Clement surrendered throughout the prosecution. Even with the additional limitations, [dependent] claims 50-52 are also broader than they are narrower in a manner directly pertinent to the subject matter that Clement surrendered during prosecution.¹³¹

This could imply that the court simply weighed the narrowing and broadening in what it considered to be the limitations pertinent to the surrendered subject matter; and the multiple broadenings (due to multiple omissions of key limitations) simply outweighed the single narrowing limitation. If so, the recapture analysis in this situation of broadening and narrowing (in the area of the surrendered subject matter) could be reduced to a case-by-case determination that would depend on which limitations should be deemed more important in an individual case. If so, both the Office and the public could have no degree of comfort as to limitations added and deleted in this type of situation.

In the *Clement* court's statement of the third step of the recapture analysis, the court stated:

if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.¹³²

The court never stated the result where the reissue claim is broader in an aspect germane to a prior art rejection, and narrower in an aspect germane to prior art rejection. That is the situation here, and it will be revisited in the section below directed to the future of the recapture doctrine.

d. View Through a Model Fact Situation

In order to look at the quandary in which the patent community found itself after *Clement*, and its statement of methodology

¹³¹ *Id.* at 1470 (emphasis added).

¹³² *Id.*

and treatment of *Ball*, it is advantageous to view the situation through a model fact situation.

Assume Claims 1-3 of an application are directed to the combination of elements A and B. After a rejection of the AB combination over prior art, the applicant adds element C to newly provide the claim combination of elements A, B and C (hereinafter ABC) which defines the claims over the art cited in the rejection. Claims 1-3 are then allowed, and a patent issues.

In an application for reissue of the patent, claims 4-6 are presented, and they are directed to the combination of ABX. In this instance, limitation C is omitted when compared to claims 1-3, and the added "replacement" limitation X is *not* related to limitation C.¹³³ Limitation X is deemed by the examiner to define the reissue application claims over the prior art, even though limitation C is not present. There are two approaches to resolve the recapture issue provided by this model fact situation.

Approach #1: It could be argued that the reissue claims to ABX are narrower than the canceled claims to AB, and thus recapture is avoided. In this approach, the reissue claim would be compared with the *canceled claims* to determine whether the reissue claims were broader than the canceled claims or equal in scope to the canceled claims. Since limitation X defined the claims over the *prior art*, X is "germane"¹³⁴ to the *prior art rejection*, and the canceled claim has been narrowed in a manner that is "material." Thus, recapture has been avoided by replacement of one germane limitation with another.¹³⁵

Approach #2: It could also be argued that, even though claims 4-6 do not provide recapture under the "canceled claim" test, claims 4 through 6 do not escape the recapture doctrine, because claims 4 through 6 *entirely* omit the limitation C which was added to the claims in the original application to define patentability, and any claim entirely omitting the limitation C was surrendered in the prosecution of the application. In this approach, the reissue claims

¹³³ If A is a cooler, B is a chopper, and C is a cooker, then key limitation C is replaced by a mixer X that is not related to cooker C. This analysis is not limited to the situation where each limitation is a separate element of the claim. It would also apply, for example, to multiple limitations within a single element of the claim. Thus, the claimed invention could be a car with a heater, where A could be a pump within the heater, B could be an infrared generator, and C could be a baffle configuration. In the reissue claims, where the baffle configuration C of the heater is replaced by filter X of the heater, the same issue arises.

¹³⁴ See *Clement*, 131 F.3d at 1470.

¹³⁵ The same analysis would apply if A is a cooler, B is a chopper, and C is a cooker, key limitation C is omitted and A is made more specific to be a liquid nitrogen cooler, and the combination of A (specific) B defines over the prior art.

would be compared with the original patent claims to determine whether the reissue claims were broader than the patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Recapture has not been avoided by replacement of the *entirely* omitted key limitation C by limitation X, which is not at all related to limitation C.

Which of these approaches did *Clement* advocate?

As pointed out above, the *Clement* fact-situation was resolved by looking to the claims that the examiner had rejected based on Burns, where claims were “canceled” in favor of more specific claims, to thereby secure the withdrawal of Burns as a reference and the grant of the patent. Those canceled claims were found to contain the “room temperature,” and “mechanical energy lower than 50 KW.H/Ton” limitations of step (a), and the “high temperature between 85° and 130° C,” “mechanical energy of more than 50 KW.H/Ton” and “*pH of at least 9*” in steps (c) and (d), which limitations had previously been added to the claims to thereby secure the withdrawal of Ortner as a reference. Hence, *Clement* was found to have surrendered claims that omitted these key limitations of the canceled claims, and the key limitations were found absent from the reissue claims, and the court found recapture to exist. The *Clement* court thus showed that it is the canceled claim that is to be compared with the reissue claims.

In addition, in its statement of the reissue recapture analysis to be generally applied to resolve recapture issues, the court stated:

The following principles flow: (1) if the reissue claim is as broad as or broader than *the canceled or amended claim in all aspects*, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.¹³⁶

Thus, again, the court pegged the recapture test to the canceled claim.

On the other hand, the *Clement* court also stated, “[o]nce we determine that an applicant has surrendered the subject matter of

¹³⁶ *Clement*, 131 F.3d at 1470 (emphasis added).

the canceled or amended claim, we then determine whether the surrendered subject matter has crept into the reissue claim. Comparing the reissue claim with the canceled claim is one way to do this."¹³⁷ This clearly states that comparison of the reissue claims with the canceled claims is not the only way to find the existence of recapture of surrendered claim subject matter.¹³⁸ The court went on to state:

We agree with the board's conclusion that the reissue claims are broader than *the patent claims* in a manner directly pertinent to the subject matter that Clement surrendered during prosecution. Therefore, it correctly applied the recapture rule, and we affirm the board's decision to sustain the examiner's rejection of claims 49-52.¹³⁹

Thus, the Board of Patent Appeals and Interferences (BPAI) comparison of the reissue claims to *the patent claims* for broadening was approved of by the *Clement* court. The court further stated:

Clement's assumption ignores the board's finding that the reissue claims delete the value of the high temperature and pH limitations in steps (c) and (d) and the room temperature limitation of step (b). It also ignores much of the prosecution history. The prosecution history shows that Clement abandoned the subject matter of claim 42, *as it existed before the examiner's amendment dated May 16, 1988, because he allowed the examiner to amend it to obtain allowance and no other evidence suggests that Clement did not intend to abandon it.* He also abandoned the subject matter of claim 42, as it existed before his June 29, 1987, amendment, as it existed before his December 23, 1986, amendment, and as it existed in his preliminary amendment.¹⁴⁰

This shows that the court was not only looking at "key" limitations present in the *canceled claims*, but, rather, it would also focus on limitations present in the *patent claim* that were added to obtain issuance of the patent.

These statements by the court, however, were *dicta*, since the *Clement* court decided the case by comparing the reissue claims to the canceled claims, *and nothing more was needed to decide that surrendered subject matter was being recaptured by the reissue claims.* There was no need to compare the reissue claims to the original patent claims

¹³⁷ *Id.* at 1469.

¹³⁸ As will be pointed out below, the *Hester* court seized on this statement of the *Clement* court to explain that comparison of the reissue claim with the *original patent claims* was *another way* to find recapture of surrendered subject matter.

¹³⁹ *Clement*, 131 F.3d at 1472 (emphasis added).

¹⁴⁰ *Id.* at 1471 (emphasis added).

for broadening in a manner directly pertinent to the subject matter surrendered during prosecution, and the court declined to do so. It is to be noted that, at pages 28 *et. seq.* of the Patent Office Solicitor's brief filed in *Clement*, the Solicitor addressed the merits of the patent owner's "main argument" that the "canceled claims" should always be the basis for comparison with the reissue claims, and if the reissue claim is narrower in any significant respect, no recapture is present.¹⁴¹

The Solicitor pointed out that "[e]ven if appellant's new argument is considered, the recapture rule applies since the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution."¹⁴² This point was emphasized in the Solicitor's Brief, and a side-by-side comparison of claims was provided to reveal that the reissue claim in question was broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Unfortunately, the *Clement* court never squarely addressed this argument. It is believed that the court never addressed this argument "head on" because it did not need to resolve the issue to decide the case. The canceled claims had been broadened in a manner directly pertinent to the subject matter surrendered during prosecution, and the canceled claims had not been narrowed in a manner that would compensate for that broadening. Thus, the court never had to look at whether the reissue claims were broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution.

Subsequent to *Clement*, the BPAI addressed this issue in *Ex parte Gilles Baudin*,¹⁴³ The BPAI's opinion in *Baudin* clearly showed that the BPAI believed any statement in *Clement* that the reissue claims were to be compared to the original patent claims for broad-

¹⁴¹ Brief for Appellee at 26, *In re Clement*, 131 F.3d 1464 (C.C.P.A 1997) (No. 97-1202). The brief goes on to state:

Appellant's main argument, made for the first time on appeal, is that the recapture rule does not apply since his reissue claims are narrower in scope in at least one significant respect than original application claim 1 prior to amendment. Br. at 18. Breaking appellant's argument into two parts, appellant first argues that (i) the recapture rule only requires that one compare the reissue claims with the original application claims prior to ever being amended due to a prior art rejection (i.e., the claims as of July 2, 1984)

Id.

¹⁴² *Id.* at 28, quoting *Mentor*, 998 F.2d at 996.

¹⁴³ Appeal No. 2001-1042, Application No. 09/292,334. Application filed April 15, 1999, for reissue of U.S. Patent No. 5,865,353 (Application No. 08/917,772, filed August 27, 1997), which patent issued on February 2, 1999. (Bd. Pat. App. & Inter. June 28, 2001) (Unpublished; Non-Precedential).

ening was unpersuasive *dicta*. The Board considered *Ball* to be good law and stated, “[t]he Court in *Ball* found that the reissue claims (which were broader than the *canceled claims* in one respect and narrower than the *canceled claims* in some respects) were valid.”¹⁴⁴ The BPAI then cited a statement in *Whittaker Corp. v. UNR Industries Inc.*,¹⁴⁵ which relied on *Ball*:

Since we hold that the claims of the reissue patent are narrower in scope than the *canceled* original claims of the application that resulted in the ‘882 patent, *the ‘453 patent cannot be held invalid under the recapture rule as described in Ball Corp. v. United States*, where the court stated, “the patentee is free to acquire, through reissue, claims that *are narrower in scope than the canceled claims.*”¹⁴⁶

Then, in its decision, the BPAI specifically relied on *Ball* and the statements in *Clement* directed to comparing the reissue claims with the “canceled claims” as follows:

In our view, the cases cited above in the PRECEDENT section of this decision establish the following three categories with respect to the recapture rule: (3) if the reissue claim is *broader than* the surrendered subject matter in some aspects and also narrower than the surrendered subject matter in others, then the recapture rule may bar the claim. In our view, for recapture purposes, analysis of the patent claim is only required when the reissue claim falls under this category.

We find reissue claim 15 before us in this appeal to be narrower in scope than the surrendered subject matter (i.e., original claim 1 in Application No. 08/917,772) for the reasons set forth by the appellant (brief, pages 3-6) [category (2) above]. We do *not* find, and the examiner has not asserted, that reissue claim 15 is as broad as, or broader in any aspect, than the surrendered subject matter of original claim 1 in Application No. 08/917,772

. . . . Since reissue claim 15 was applied for within two years from the grant of the original patent and is only narrower in scope than the surrendered subject matter, the recapture rule does not apply. Thus, the decision of the examiner to reject claim 15, and claims 16 to 18 dependent thereon, under 35 U.S.C. § 251 is reversed.

The examiner’s error in this case was in comparing reissue claim 15 with patent claim 1 to see what limitations may have

¹⁴⁴ *Id.*, at 20 (emphasis added) (citations omitted).

¹⁴⁵ 911 F.2d 709 (Fed. Cir. 1990).

¹⁴⁶ See *Baudin*, *supra* note 143, at 21 (quoting *Whittaker*, 911 F.2d at 713) (emphasis added) (citations omitted).

been deleted from the patent claim, instead of determining if the proposed reissue claim was as broad as or broader than the surrendered subject matter of original claim 1 in Application No. 08/917,772.¹⁴⁷

Thus, in a decision issued after *Clement*, the BPAI still believed that canceled claims were the sole basis for comparison in the recapture analysis, and not original patent claims. As pointed out above, however, although the Solicitor's Brief squarely presented the issue to the court, it is believed that the *Clement* court never decided the issue one way or the other. Rather, the court delayed a specific decision on this issue until a time when it would have to decide the issue. That time would arrive later in the form of *Pannu* when the Federal Circuit would in fact compare the reissue claims to the original patent claims for broadening (in a manner directly pertinent to the subject matter surrendered during prosecution), and would find recapture to be present in the reissue claims.¹⁴⁸ *Pannu* will be discussed below, but first, we will look at *Hester Industries, Inc. v. Stein, Inc.*, which can be viewed to have "ploughed new ground" in the recapture arena, and laid the foundation for *Pannu*.

D. *Hester Industries, Inc. v. Stein, Inc.*¹⁴⁹

In *Clement*, the court stated "[t]o determine whether an applicant surrendered particular subject matter, we look to the prosecution history for *arguments* and changes to the claims *made in an effort to overcome a prior art rejection*"¹⁵⁰ Thus, it could be viewed that the Federal Circuit assigned equal importance to establishing surrender to arguments and changes to the claims made in an effort to overcome a prior art rejection. On the other hand, the *Clement* court may simply have used loose language to state that argument must be considered in conjunction with changes to the claims made in an effort to overcome a prior art rejection. Even if the first interpretation were correct, it was merely a statement of *dicta*, since in *Clement*, there had been changes to the claims made in an effort to overcome a prior art rejection. This ambiguity was resolved within a year by *Hester Industries, Inc. v. Stein, Inc.*

¹⁴⁷ See *id.*, at 37-39 (emphasis added).

¹⁴⁸ It is to be noted that the BPAI's *Baudin* case was decided prior to *Pannu* and was not in line with *Pannu*. Subsequent to *Pannu*, the BPAI decided *Eggert*, which will also be discussed *infra*. In *Eggert*, there is *dicta* that echoes *Baudin*, but the holding of *Eggert* was not contrary to *Pannu*.

¹⁴⁹ 142 F.3d 1472 (Fed. Cir. 1998).

¹⁵⁰ In re *Clement*, 131 F.3d 1464, 1469 (Fed. Cir. 1997).

In *Hester*, the invention involved a food-cooking system in which the food was cooked solely with steam. The system included two sources of steam to provide the steam atmosphere. Characteristics of the steam atmosphere were claimed, and the cooking system was said to include a means for passing a conveyor belt through a cooker housing. The application claims were rejected based upon prior art and ultimately appealed to the BPAI. The claims were not amended to define patentability during the prosecution,¹⁵¹ but rather the applicant argued that the prior art failed to disclose applicant's invention where the claims required cooking "solely with steam," "two sources of steam," specific characteristics of the steam atmosphere, and a continuously running conveyor belt. Throughout the lengthy prosecution, the applicant relied vigorously on the "solely with steam" and "two sources of steam" claim limitations. As stated by the court:

[o]ver the almost seven years in which the application was prosecuted before the United States Patent and Trademark Office . . . inventor Williams, through his attorney, repeatedly emphasized the 'solely with steam' and 'two sources of steam' features of the claimed invention in attempting to establish patentability over the prior art.¹⁵²

When the BPAI reversed the examiner's prior art rejection in the original application, it stated:

We find no suggestion in the combined teachings of the references which would have led the ordinarily skilled worker in the art to an apparatus utilizing steam as the sole cooking medium; utilizing two separate sources of steam, one of which includes a pool of water in the cooking chamber with means for boiling the water; and wherein the atmosphere within the cooking chamber is maintained above atmospheric by the two sources of steam.¹⁵³

After the examiner's art rejection was reversed, the original patent issued.

Subsequently, the patent owner filed for and obtained a reissue patent with claims that omitted the "solely with steam" and

¹⁵¹ The claims were revised somewhat during the prosecution; however, as the court stated, "[f]or purposes here, this is substantially the same form in which the claim was first filed (as application claim 1) in the application for the original patent. Accordingly, we do not distinguish between the issued claim and the application claim, but instead simply refer to claim 1." *Hester*, 142 F.3d at 1475.

¹⁵² *See id.*

¹⁵³ *Bd. Pat. App. Int. Op.* of June 21, 1985 (quoted in *Hester*, 142 F.3d at 1476).

“two sources of steam” claim limitations. The case then came before the Federal Circuit by way of civil infringement action.

The Federal Circuit found the omission of the “solely with steam” and “two sources of steam” limitations in the reissue patent claims *to be a recapture of surrendered subject matter*, and thus held such claims to be invalid. The *Hester* court stated: We share the district court’s discomfort with Williams’ attempt to remove, through reissue, the ‘solely with steam’ and ‘two sources of steam’ limitations after having relied so heavily on those limitations to obtain allowance of the original patent claims over the prior art.¹⁵⁴

The court noted that in this case, the “solely with steam” and “two sources of steam” limitations (omitted in the reissue claims) were not *added* in the original prosecution to define the claims over the prior art; thus, there was no “canceled claim” in existence prior to the addition of the two limitations, and thus no “canceled claim” to be reviewed in a surrender-recapture analysis. However, the court concluded:

In a proper case, surrender can occur through arguments alone . . . When the surrender occurs by way of claim amendment or cancellation, ‘comparing the reissue claim with the canceled claim is one way to do this.’ This analysis is not available when the surrender is made by way of argument alone. Instead, in this case, we simply analyze the asserted reissue claims to determine if they were obtained in a manner contrary to the arguments on which the surrender is based.¹⁵⁵

The court further concluded that the reissue was obtained in a manner contrary to the arguments on which the surrender was based, stating that “[n]one of the asserted reissue claims include either the ‘solely with steam’ limitation or the ‘two sources of steam’ limitation. Thus, this surrendered subject matter – i.e., cooking other than solely with steam and with at least two sources of steam – *has crept into the reissue claims.*”¹⁵⁶

The court analyzed the reissue claims “to determine if they were obtained in a manner contrary to the arguments on which surrender is based.”¹⁵⁷ The court concluded that it was the *original claim excluding the claim limitation which applicant had argued to distinguish over the art* which was the “surrendered subject matter” that had “crept into the reissue claim” and gave rise to recapture.¹⁵⁸

¹⁵⁴ *Hester*, 142 F.3d at 1480 (citations omitted).

¹⁵⁵ *Id.* at 1482.

¹⁵⁶ *Id.* (emphasis added).

¹⁵⁷ *Id.*

¹⁵⁸ *Id.*

A simplified way of viewing the holding in *Hester* is as follows:

Assume Claims 1-3 of an application are directed to the combination of ABCD. After a rejection of the ABCD combination over the prior art, the applicant argues that element D of the combination of ABCD defines the claims over the prior art cited in the art rejection, pointing out why element D defines patentability. Claims 1-3 are then allowed, and a patent issues.

In an application for reissue of the patent, claim 4 is presented, and it is directed to the combination of ABC (i.e., limitation D is omitted when compared to Claims 1-3). Claim 4 does not escape the recapture doctrine, because claim 4 omits the limitation D which was argued, i.e., relied upon, in the original application to define patentability over the art, and any claim omitting the limitation D was surrendered in the prosecution of the application.¹⁵⁹

Thus, *Hester* answered the question of whether a surrender for recapture could be based solely on applicant's argument. At the same time, *Hester* pointed out that comparing the reissue claims to the corresponding claims in the application that were amended or "canceled" to overcome the art was not the only way to determine the existence of recapture. Recapture could also result (as it did in *Hester*) from comparing the reissue claims with the original patent claims and finding that a *key limitation* of the patent claims, i.e., a limitation which was relied upon to define over the art, is no longer present in the reissue claims. This would be an important consideration in the *Pannu* case, which is the next case that this article will discuss.

As a further contribution, *Hester* provided guidance as to avoidance of the recapture rule when the reissue claims are materially narrowed in "other respects" as a replacement for the omission of the key limitation. *Hester* discussed examples of what would *not be* "material narrowing" limitations, but rather would be inherent limitations. *Hester* provided first an example of the added limitation being "actually the same as" (i.e., inherent from) or "broader than" the limitation in the patent claims. Then, *Hester* provided an example of the added limitation, which was inherent from the patent claims by virtue of a means-plus-function clause drafted pursuant to 35 U.S.C. § 112, paragraph six, covering "the corresponding

¹⁵⁹ This fact situation in *Hester* is essentially that of category #1 of the table chart, except that the *Hester* reissue claim is of the same scope as the original application claim minus the limitation *argued* to define over the art, as opposed to the reissue claim being of the same scope as the original application claim minus the limitation *added* to define over the art. In both instances there is no narrowing "replacement" limitation.

structure . . . described in the specification and equivalents thereof¹⁶⁰ where the only corresponding structure described in the specification (more properly, the written description of the patent) was the limitation now added in the reissue.¹⁶¹ Thus, the *Hester* court showed that the “material narrowing” analysis set forth in *Mentor* was still alive and well.

E. *Pannu v. Storz Instruments Inc.*¹⁶²

As pointed out above, the *Hester* holding was based on the position that comparing the reissue claims to the “canceled claims” was not the only way to determine the existence of recapture or lack thereof. Also, recapture was found to result from comparing the reissue claims with the original patent claims and finding that a *key limitation* of the patent claims, i.e., a limitation which was relied upon to define over the art, was no longer present in the reissue claim. It still remained to be seen if the Federal Circuit would use this second basis for determining recapture where the first test was available. In *Hester*, there was no “canceled claim,” because the claim limitation relied upon to define over the art was always present in the claim; thus, there was no “canceled claim” to look at that existed prior to the addition of the limitation that defined over the art. Yet what would the Federal Circuit do if there were a “canceled claim” to look at? Would the court then rely solely on the “canceled claim” comparison and not resort to comparing the reissue claim with the original patent claim to find whether the *key limitation* of the patent claims was still present in the reissue claims? Three years passed before the Federal Circuit provided the answer to this question in *Pannu*.

Pannu came to the Federal Circuit for review of the district court’s grant of summary judgment (in an infringement suit) holding *Pannu*’s reissue patent to be invalid based on the issue of recapture. The basic *Pannu* invention is for an “optic” (lens) that focuses light on the retina of the eye, and two or more arc shaped supporting elements (strands) attached to the optic, with each supporting element terminating in a snag-resistant means (loop) for contacting internal tissue in the eye for the purpose of positioning and securing the optic within the eye.

In the prosecution of the original patent, a limitation directed to the arc of the supporting elements was added to the claims to

¹⁶⁰ *Hester*, 142 F.3d at 1482-83.

¹⁶¹ *See id.* at 1483.

¹⁶² 258 F.3d 1366 (Fed. Cir. 2001).

define over the examiner's prior art rejection, and the claims were allowed with minor amendments. In the reissue application that matured into the Pannu reissue patent, Pannu deleted the limitation directed to the arc of the supporting elements, which had been added to the claims to define over the examiner's prior art rejection. In its place, Pannu narrowed the claims by further defining the snag-resistant means and positioning it with respect to the arc shaped supporting strands.

The *Pannu* court first found that Reissue Claim 1 was broader than Claim 1 of the original patent; second, Claim 1 of the original patent had been amended to secure allowance over the art; and third, the reissue patent claims omitted a limitation that had been added to secure the allowance of the original patent.¹⁶³ Based upon these findings, the court ultimately held recapture to exist, and affirmed the lower court's grant of summary judgment that the reissue patent was invalid. The court noted that the fact that the patent "claims were materially narrowed in other respects" did not save the claims from recapture, since the limitation added to secure allowance of the original patent was omitted in the reissue patent claims (i.e., since the claims were broadened by virtue of omission of the limitation added to secure allowance of the original patent).¹⁶⁴

The *Pannu* court did *not* engage in an analysis of the claims "canceled" from the original application (to secure the original patent), i.e., the court did not use the claims as they existed prior to the critical amendment for comparison with the reissue claim. The court deemed such an analysis unnecessary where a limitation added to overcome the art was then later removed in its entirety.

Further, the court dismissed Pannu's argument that recapture

¹⁶³ The arc-of-the-supporting-elements claim limitation. *Pannu*, 258 F.3d at 1371-72.

¹⁶⁴ *See id.* (where the court finds:

Pannu argues, however, that because the reissued claims were materially narrowed in other respects, the '525 reissue avoids the recapture rule. Instead of being 'substantially greater' than the width of the haptics, the snag resistant means must now be 'at least three times greater' than the width of the haptics. In addition, the snag resistant means must now be 'substantially coplanar' with the haptics. Pannu argues that both modifications relate to the configuration of the haptics, and therefore, what is gained by the elimination of one limitation is given up by the addition of the other limitations. The 'continuous, substantially circular arc' limitation related to the shape of the haptics. The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening.).

(citations omitted).

was avoided by the addition of snag-resistant-means limitations¹⁶⁵ in the claims as reissued that were “narrower” than the original patent claims, because these narrower limitations were not related to the “surrendered subject matter;” the snag-resistant-means limitations simply were not related to the arc-of-the-supporting-elements claim limitation previously added to secure allowance of the original patent and then omitted in the reissue. The court would not accept the snag-resistant-means narrowing limitations (added in the reissue) as a replacement for the critically omitted limitation, *even though these added narrowing limitations did define the claims over the prior art applied in the original application to obtain the surrender.*

To avoid recapture, the court stated, “[t]he addition of the ‘continuous, substantially circular arc’ limitation to claim 16 and the statements made by Pannu to the examiner during prosecution of the ‘855 patent *limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc.*”¹⁶⁶ Furthermore, “[i]n prosecuting the ‘855 patent, Pannu specifically limited the shape of the haptics to a ‘continuous, substantially circular arc.’ On reissue, he is estopped from attempting to recapture *the precise limitation* he added to overcome prior art rejection.”¹⁶⁷ The *Pannu* court determined that the matter that is “surrendered” is the right to a claim that is broadened by omitting the specific limitation that was added to secure allowance of the original application. This has been the Federal Circuit’s last word on the subject thus far.

As early as 1886, the Supreme Court, in *Shepard v. Carrigan*,¹⁶⁸ stated:

Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the patent office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent.¹⁶⁹

Thus, the question remains whether *Pannu* added anything that the Supreme Court has not stated on this issue.

Returning to the model discussed earlier in connection with *Clement*, there is a simplified way of viewing the *Pannu* holding. In *Pannu*, the application claims concerned a lens (R), supporting el-

¹⁶⁵ Directed to the snag resistant means and its positioning with respect to the arc shaped supporting strands.

¹⁶⁶ *Pannu*, 258 F.3d at 1371 (emphasis added).

¹⁶⁷ *Id.* at 1372 (emphasis added).

¹⁶⁸ 116 U.S. 593 (1886).

¹⁶⁹ *Id.* at 597.

ements (S), and snag resistant means (T), all integrally formed. They will be referred to as the RST claims. After a rejection of the RST claims over prior art, applicant added limitation A, requiring that the supporting elements define a continuous, substantially circular arc,¹⁷⁰ to provide a new claim combination of R-S-(A)-T, which defined the claims over the art cited in the rejection. The claims were then allowed, and a patent issued.

In an application for reissue of the patent, the claims were revised to omit limitation A (the requirement that the supporting elements define a continuous, substantially circular arc), and add instead, limitation B, specifying a dimension of the snag resistant means and its positioning with respect to the arc shaped supporting strands. This resulted in the combination of R-S-T(B) (i.e., limitation A is omitted when compared to the original patent claims, and the added "replacement" limitation B is not directed to the subject matter surrendered). The examiner deemed limitation B to define the reissue claims over the prior art, even though limitation A was not present. The reissue claims to R-S-T(B) did not escape the recapture doctrine, because the reissue claims entirely omitted the limitation A that was added to the claims in the original application to define patentability, and any claim entirely omitting the limitation A was surrendered in the prosecution of the application. Thus, the question of the result in the model fact situation presented above in the discussion of *Clement* was resolved and answered in *Pannu*.¹⁷¹

1. The *Clement* Three Step Recapture Analysis, Restated in *Pannu*

Clement set forth a three-step test for recapture analysis, which was discussed supra. The *Pannu* court restated this test as follows:

Application of the recapture rule is a three-step process. The first step is to 'determine whether and in what 'aspect' the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissued

¹⁷⁰ In *Pannu*, more was added; however, this is a simplification of *Pannu* to illustrate the holding therein.

¹⁷¹ In *Pannu*, R, S, and T were integrally formed as a single element, the optic, and thus different items or limitations within a single element were involved. This analysis would also, however, apply to the situation where each limitation is a separate element of the claim. Thus, the claimed invention could be a combination where A is a cooler, B is a chopper, and C is a cooker; then key limitation C is replaced by a mixer X that is not related to cooker C. The *Pannu* court's decision should apply to any such situation where the reissue claims omit a key limitation that was relied upon to define over the prior art, as the decision was stated in non-limiting terms, and the third step of the *Clement* three prong test was re-stated in *Pannu* as will be discussed later in the text.

claim related to surrendered subject matter.’ Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.¹⁷²

While the first two steps were quotes from *Clement*,¹⁷³ the third was a reformulated statement of that step, presumably to emphasize that comparison with the canceled claims is not the only way to determine whether “the surrendered subject matter has crept into the reissue claim[s].”¹⁷⁴ It is envisioned that all future analysis of recapture issues will be stated in terms of these three steps.

The significance of this should not be overlooked. In *Clement* and *Mentor*,¹⁷⁵ the reissue claims were found to invoke the recapture doctrine because the reissue claims were broader than the canceled claims. Since the reissue claims were found to violate the recapture rule, the court did not need to determine what the decision would be if the reissue claims entirely omitted a limitation that was added/argued during the original prosecution to overcome an art rejection (such key limitation being present in the original patent claims), and the canceled claims were not broadened. It could not be determined from the *Clement* and *Mentor* holdings what the court would do in that situation. Further, the *Clement* court stated that *Ball* was still good law, and the *Ball* fact-situation was an example of the reissue claim being broader in some aspects than the canceled claim, but narrower in others, where “the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection”¹⁷⁶ In *Ball*, the reissue claims entirely omitted a limitation that was added/argued during the original prosecution to overcome a prior art rejection, and other unrelated limitations were added to define over the prior art. Thus, after *Clement*, there was no indication that the Federal Circuit would find recapture where the reissue claims entirely omitted a limitation that was added/argued during the original prosecution to overcome a prior art rejection, as long as the canceled claim was narrowed in some material manner “germane to prior art rejection.”¹⁷⁷

Hester then showed that the Federal Circuit would find recapture where the reissue claims entirely omitted a limitation that was

¹⁷² *Pannu*, 258 F.3d at 1371 (quoting *Clement*, 131 F.3d at 1468).

¹⁷³ *Clement*, 131 F.3d at 1468.

¹⁷⁴ See *Pannu*, 258 F.3d at 1371.

¹⁷⁵ In *Mentor*, 998 F.2d 992, the Court focused on the transfer of adhesive that was present in the cancelled claim.

¹⁷⁶ See *Clement*, 131 F.3d at 1464.

¹⁷⁷ *Id.*

added/argued during the original prosecution to overcome a prior art rejection, but that was in a situation where there was no canceled claim. It was not until *Pannu* that the Federal Circuit would find recapture where the reissue claims entirely omitted a limitation that was added/argued during the original prosecution to overcome a prior art rejection, and there was a canceled claim, and the reissue claims were narrower than the canceled claim. The *Pannu* court placed its restatement of the *Clement* three-step test toward the beginning of its discussion, and stated it in a way to include in the test for recapture (in addition to the “canceled claim” comparison analysis) the situation where the key limitation of the patent claim is omitted in the reissue claims. Then, the court applied the facts of the case to the analysis of the three-step test. It is to be noted, that while prior Federal Circuit decisions did refer to *Ball* as a good example of recapture analysis, *Pannu* only refers to *Ball* in one place in a reference having no relation to it being good law as to its fact situation.¹⁷⁸ Thus, one can argue that *Pannu* has *sub silentio* overruled *Ball*; on the other hand, perhaps *Pannu* did not overrule *Ball* after all.

As stated above, there were those who believed that the *Clement* court’s ratification of *Ball* (though limiting *Ball* to its facts) can only be explained if (a) the reissue claims are compared only to the canceled claims, and (b) the key limitation added to define patentability (over the prior art in the original application) can be replaced by a different limitation that defines patentability in a different way (to thus avoid recapture). A new unrelated reissue limitation, which defines over the prior art in place of the omitted limitation, would be germane to the rejection since that new limitation obviates the rejection.

If we are to understand that the *Clement* dicta ratified *Ball*, and would today permit a reissue claim to narrow the canceled claim in an area not related to the omitted key limitation, we must look deeper into *Ball* and perhaps discover the criteria under which the Federal Circuit would apply the *Ball* holding in a way that is not inconsistent with *Pannu*.

In *Ball*, “the *feature* that the patentee gave up during prosecution of the original application”¹⁷⁹ was the right to claims with a single feedline. To obtain allowance of the claims over the prior art applied to the claims, *Ball* revised the claims to require that a

¹⁷⁸ See *Pannu*, 258 F.3d at 1370 (“This legal conclusion can involve underlying findings of fact, which are reviewed for substantial evidence.”).

¹⁷⁹ *Ball*, 729 F.2d at 1437.

plurality of leads be connected to an edge of the outer conductor. *This limitation was omitted in the reissue claims.* The *Ball* court, however, emphasized *a number of substantial limitations* added via the reissue claims that replaced the omitted limitation. It may very well be that the court found *Ball* to have provided a new look to the claims by way of the limitations added via reissue that were not present in the canceled claims, and thus the reissue claims avoided the recapture doctrine. The applicant took something away from the patent claims that was substantial, but provided sufficient¹⁸⁰ *quid pro quo* to give the public something substantial in place of the omitted aspect of the claims. The *Ball* court could very well have been pointing that out when it stated, “[t]he proper focus is on the *scope* of the claims, not on the individual *feature* or *element* purportedly given up during prosecution of the original application.”¹⁸¹

In *Clement*, the court addressed reissue application claims that were broader than the canceled claims by omission of a number of key limitations added to secure allowance of the original patent claims over reference A, and narrower by addition of a limitation added to secure allowance of the original patent claims over reference B. The *Clement* court stated that “on balance,” the reissue claims were broader than they were narrower in a manner directly pertinent to the subject matter that was surrendered in the original prosecution.¹⁸² As pointed out above, this could imply that the court weighed the narrowing and broadening of limitations that it considered to be pertinent to the surrendered subject matter. The court also deemed the multiple broadenings (due to multiple omissions of key limitations) to simply outweigh the single narrowing limitation in the *Clement* reissue claims. The patent owner was deleting “a lot,” and only putting in “a little” to replace the “a lot.” On the other hand, the *Clement* court found *Ball* to be good law because the situation was reversed. In other words, *Ball* would fit within category number eight of the table chart.

Viewed in this light, maybe in *Pannu* the replacement limitation was simply not “enough” *quid pro quo* for that which was omitted. The *Pannu* court may have viewed the “replacement limitation” in the reissue, describing the specified dimension of the snag resistant means and positioning with respect to the supporting strands, as simply an escape by the patent owner from the undesirable surrender made in the original prosecution without

¹⁸⁰ *See id.*

¹⁸¹ *Id.*

¹⁸² *Clement*, 131 F.3d at 1471.

limiting the claims in a truly significant manner. Thus, it is quite possible that the patent owner is precluded from entirely omitting the key limitation only where the patent owner does not provide enough in the reissue to present the public with a significantly different claim. That is, the patent owner cannot shed the key limitation relied upon to define over the art, simply because the patent owner now (in the reissue) “throws in” a new limitation that does define over the art, but is not really that important commercially or in the context of the technology. Rather, the patent owner must show us that he really could have defined over the art by what was an important claim package to the patent owner, and the failure to do so was an inadvertence or error. *Pannu* would thus fit within category # 9 of the table chart. We will look at this again in the section below discussing the future of recapture.

III. SELECTED LOWER TRIBUNAL DECISIONS: FOR RECAPTURE ISSUES NOT YET CONSIDERED BY THE FEDERAL CIRCUIT

Part III discusses and evaluates the current status of the recapture doctrine as a result of recent case law.¹⁸³ But first, we will consider decisions from lower tribunal on recapture issues not yet considered by the Federal Circuit, as well as the “gloss” they have added to the doctrine.

A. Ex parte Eggert, et al.¹⁸⁴

1. The Facts

In *Eggert*, a reissue applicant appealed to the BPAI from the examiner’s rejection of claims based upon recapture, and a three-member panel of the BPAI reversed the examiner’s decision.¹⁸⁵ The examiner subsequently requested a rehearing of the BPAI’s decision, and the reissue applicant filed a response to that request. The Chief Administrative Patent Judge then expanded the panel by eleven members to decide the examiner’s request for rehearing. The decision of the expanded panel upheld the decision of the three-member panel in a seven to four decision.

a. Prosecution History, Briefly

Claim 1 of the *Eggert* patent was the focus of the appeal. Original claim 1 (of the *Eggert* application that matured into the patent) was directed broadly to a bit holder having a retaining structure

¹⁸³ See *infra* Part V, entitled “The Present State of Recapture.”

¹⁸⁴ 67 U.S.P.Q.2d 1716 (BNA) (Bd. Pat. App. & Inter. 2003).

¹⁸⁵ See *id.*

(retaining member) that retains (constrains) a magnet inside the bore of the bit holder, so that the magnet will retain the bit inside the bore. In response to a first Office action rejection of claim 1 based on a combination of prior art, *Eggert's* amended claim 1 (a first time) to narrow the claim, i.e., to additionally require that the retaining structure include a discrete retaining member friction fitted in the bore "outboard" of the magnet, so that the retaining member and the inner end surface cooperate to retain the magnet in between. A final rejection was then issued rejecting the once amended claim based on the same combination of prior art that was previously applied. Eggert then amended claim 1 (a second time) to further narrow the claim by requiring that the retaining member be bowl-shaped (convex toward the magnet), and a patent was granted.

In the reissue application, Eggert added claim 15¹⁸⁶ which deleted the requirement that the retaining member be bowl-shaped, and added in its place the requirement that the retaining member be discrete and friction fitted in the bore and substantially cover the outer surface of the magnet. This requirement in reissue claim 15, which demands that the retaining member be discrete and friction fitted in the bore and substantially cover the outer surface of the magnet will be referred to as the "replacement limitation."

2. The BPAI's Decision

The expanded panel of the BPAI found that the "replacement limitation" of the retaining-member in claim 15 of the reissue application was an "intermediate" limitation, being *broader than* the retaining member limitation that was added to obtain allowance of claim 1 of the Eggert patent ("said retaining member being generally bowl-shaped and convex toward said magnet"),¹⁸⁷ *but narrower than* the limitation of the retaining member that was present in the version of claim 1 that was "canceled from the original application" to obtain allowance of claim 1.

The BPAI then held that, because reissue claim 15 contained an "intermediate" limitation relating to the surrendered subject matter, claim 15 was *not* a recapture of surrendered subject matter. In the original application, *Eggert* had narrowed the retaining member limitation from that of the canceled claim to thereby obtain allowance of the original patent claim 1. Reissue claim 15 also

¹⁸⁶ Claim 22 was also added, but it is more specific than claim 15. Accordingly, claim 22 need not be addressed here, since an analysis of claim 15 is sufficient to show the permissive scope of the decision.

¹⁸⁷ *Id.*

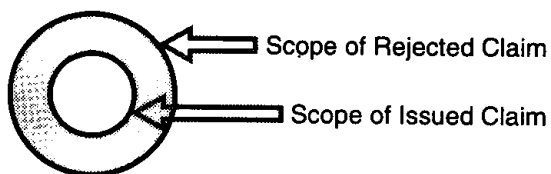
narrowed the retaining member limitation from that of the canceled claim (even though the reissue claim did not narrow the retaining member limitation as much as the original patent claim did).

3. Discussion of *Eggert*

The *Eggert* fact situation is more complicated than that of the Federal Circuit's *Pannu* decision. In *Pannu*, the key limitation that had been added to secure allowance of the claims had been *entirely* omitted, and the claim narrowing of the reissue was thus *not related* to the subject matter surrendered in the original application. In *Eggert*, the BPAI found that the key limitation was still present in a broadened form, and thus, the canceled claim had been narrowed via the reissue in a manner that was related to the subject matter surrendered in the original application. Had the reissue narrowing in *Eggert* not been related to the surrendered subject matter, the Federal Circuit's *Pannu* decision would have controlled, and recapture would have been present.

4. *Eggert* Simplified: A Model for an *Eggert* Factual Situation and Holding

Assume a claim combination of element A and element B (hereinafter "AB") was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABC (after which the patent issued). A reissue application was then filed with claims directed to combination ABC_{broadened}. The ABC_{broadened} claims are in fact narrowed in scope when



DRAWING 1

compared with the "canceled" claim subject matter AB, since C_{broadened} is required in addition to AB. Further, the limitation C_{broadened} is related to the surrender, since it was element C that was added in the applica-

tion to overcome the art. There is no recapture in this situation, because ABC_{broadened} is narrower than the canceled claim subject matter of AB in an area related to the surrender.

An important issue discussed in *Eggert* is which approach is better to utilize as the basis for determining the surrendered subject matter. Two choices were discussed, as explained in the following.

a. Approach # 1. The Canceled Claim

The (broadened) reissue claim may be compared to the corresponding claim in the application that was amended to overcome the prior art, i.e., compared to the canceled claim. If the reissue claim is broader than, or as broad as, the canceled claim, there is recapture. *If the reissue claim is not as broad as the canceled claim, there is no recapture.* In the *Eggert* opinion, the BPAI made reference to “Drawing 1,” which is reproduced immediately below to illustrate this approach. Using the model set forth immediately above, the scope of the issued claim is ABC, the scope of the rejected claim is AB, and ABC_{broadened} is within the shaded area. Any claim directed to the shaded area, such as ABC_{broadened}, would always avoid recapture, according to the first approach. Recapture would exist only for a claim that was located on the outer circle or outside the outer circle.

b. Approach # 2. Also Use the Patent Claim

If the reissue claim is narrower than the canceled claim, i.e., is within the shaded area of the drawing, we next look at the original patent claim. The reissue claim is compared to the corresponding patent claim relied on to define over the art. In the patent claim, one or more critical limitations may have been added, or argued to be patentable, based on the critical limitation(s). If a limitation added via the patent claim, or a limitation of the patent claim argued to define over the art, is no longer present in the reissue claim, recapture will be found unless such limitation is replaced by a related limitation.

Depending on which approach is used, significantly different results occur where, for example, original application claim combination XY is amended to become issued claim combination XYZ, and a reissue is later filed with combination XYQ, and Q is not related to Z. Using Approach # 2, the complete elimination of the added limitation Z would be found, as no vestige of Z remains in the claims (since Q is not at all related to Z). This would result in recapture. On the other hand, using Approach # 1 would result in no recapture, since reissue claim XYQ is not as broad as canceled claim XY. Accordingly, an understanding of which choices are available for determining the presence and/or absence of recapture is critical.

These two approaches were identified above in the discussion of *Clement*. *Hester*, followed by *Pannu*, resolved the matter such that Approach # 2 is the correct approach. As pointed out above, when

using Approach # 1 it is impossible to arrive at the decisions rendered by the Federal Circuit in *Hester* and *Pannu*. The BPAI's *Eggert* opinion, however, appears to state that Approach # 1 is the correct approach. To the extent that the *Eggert* opinion does so state, such is dicta that is neither consistent nor compatible with *Hester* and *Pannu*.

The *Eggert* holding was designated as precedential and was adopted by the Patent Office. In *Eggert*, the key limitation which had been added to secure allowance of the claims, and which was thus present in the patent claims, was not *entirely* omitted in the reissue claims. Rather, the BPAI found the key limitation still present in a broadened form. Thus, when comparing the reissue claim with the patent claim, the patent claim had been narrowed via the reissue in a manner that was related to the subject matter surrendered in the original application. It is in this limited factual situation of broadening the patent claims (in the reissue) that recapture will not be found to be present in the reissue claims. The factual situation in *Eggert* is represented in category #3 of the table chart.

B. B.E. Meyers & Co. v. United States¹⁸⁸

The *Meyers* case addressed the situation where the reissue adds claims directed to a different embodiment or invention than that of the patent claims, while a surrender of claim subject matter was made (in obtaining the patent claims) for the existing embodiment/invention claimed in the patent. This is represented in Category #7 of the table chart.

In *Meyers*, the patent owner (Meyers) sued the United States seeking damages for infringement of its patents on certain night-vision devices. The Government moved for summary judgment, asserting that the patent claims that were allegedly infringed were invalid, based upon, *inter alia*, impermissible recapture of surrendered subject matter. The Meyers patent was directed to infrared (IR) illuminators that housed an IR Light Emitting Diode ("LED"), which projected an infrared beam through a lens system that focused the infrared light. The IR LED was designed to pulse on and off while in operation, to prevent the diode from burning out. To obtain allowance of the claims over the art applied to the claims, the applicant added two pulsing limitations to the claims, thereby surrendering claim subject matter to an IR illuminator having a generic pulsing circuit.

¹⁸⁸ 47 Fed. Cl. 200 (Fed. Cl. 2000).

In the *Meyers'* reissue application, claims were provided that contained a lens apparatus that produced a beam with a well-defined peripheral edge. This was deemed to be a separate invention, independent of whatever type of pulsing circuitry that might be used in combination with the lens system in any particular device, and Meyers deleted any reference to pulsing circuitry in the reissue claims. Accordingly, Meyers deleted the two pulsing limitations that had been added to its original claim to distinguish over the prior art, and the Government argued this to be an impermissible recapture of canceled subject matter. The U.S. Court of Federal Claims held that:

[the] deletion of the pulsing diode and substantial pulsing current limitations *did not effect an improper recapture of surrendered subject matter*. The subject matter protected in the new independent reissue claims dealt only with the lens system; it had nothing to do with any type of pulsing circuitry. During the original patent prosecution, the examiner made plaintiff aware that it could not receive protection for its basic pulsing circuit design because such pulsing circuitry was already taught by the prior art. In this regard, nothing changed after the reissue process. Plaintiff still cannot rely on its reissue claims to protect any type of pulsing circuit design that is taught by the prior art, and therefore plaintiff has not used the reissue process to . . . recapture subject matter surrendered during the original prosecution.¹⁸⁹

Thus, the United States Court of Federal Claims permitted the complete removal of a limitation that was added to obtain the patent, where the replacement limitation provided *a separate invention*. This was a broadening in the area of surrender coupled with a narrowing in an area unrelated to the surrender. *Meyers* never reached the Federal Circuit, and it was decided prior to *Pannu*. It remains to be seen whether the Federal Circuit will permit claim broadening where the limitation narrowed to obtain the patent is then entirely removed in the reissue, and replaced by a limitation that provides a separate invention, thereby carving out this exception to the rule established via *Clement*, *Hester* and *Pannu*.

In re Amos should be noted in connection with this issue.¹⁹⁰ In *Amos*, the claims were directed to a set of rollers mounted to hold down a work piece laid upon a moving table until the end of the table was reached, at which point the outside roller automatically

¹⁸⁹ *Id.* at 207 (emphasis added).

¹⁹⁰ 953 F.2d 613 (Fed. Cir. 1991).

lifted away from the table surface so that it did not fall off the end of the table. The specification disclosed that the roller was automatically lifted away from the table surface "either mechanically by the roller cams or electronically by the computer controlling the router."¹⁹¹ The original patent claims were directed to the mechanical embodiment (with two sub-embodiments of the same), and the reissue application added claims to the computer embodiment. The BPAI, based on its understanding of the substantive reissue law at the time, affirmed the examiner's rejection of the computer embodiment claims added via the reissue application, stating the original patent did not evidence any intent to claim the computer embodiment. The Federal Circuit reversed the BPAI, holding that the reissue claims were permitted in the *Amos* situation, and allowing claims to an embodiment different from that which was claimed in the original patent.¹⁹²

If the Federal Circuit does not affirm the result of the *Meyers* fact pattern when that situation appears before the court in the future, *Amos* will be severely limited. What would be the situation where the claims to the mechanical embodiment had been rejected based on art in the original application, and the roller-cam lifting means were narrowed to avoid the prior art? The computer embodiment would not include the roller-cam lifting means, since such is not used for the computer embodiment. Thus, the limitation that defined over the prior art in the original application would not be present in the added reissue patent. If the computer embodiment claims are barred (by the recapture doctrine) for presenting claims not containing the key limitation, the following situation results: although it would be permitted to provide a new invention via reissue, that new invention would always be required to contain the surrendered generating (i.e., relied-upon) limitation of the original invention that will function to limit the claims of the new invention as it did the old one. This does not appear to be equitable. Thus, it would seem desirable to adopt the *Meyers* holding.

C. Ex parte Yamaguchi¹⁹³

The *Yamaguchi* case is directed to what action or inaction by

¹⁹¹ U.S. Patent No. 4,610,582 (issued Sept. 9, 1986) (emphasis added).

¹⁹² See *Amos*, 953 F.2d at 618 (finding that "a lack of intent to claim" was not enough to bar the claim because the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing . . .").

¹⁹³ 61 U.S.P.Q.2d 1043 (B.P.A.I. 2001). *Ex parte Yamaguchi* is a reported but unpublished, precedential decision of the BPAI. Originally, the *Yamaguchi* decision was

an applicant will generate a surrender of claim subject matter. From the above review of the decisions and holdings of the Federal Circuit, it is clear that subject matter will be “surrendered” in an original application if an applicant presents a limitation to make the claims allowable over an art rejection made in the original application. But, what will the result be where the examiner makes a statement of reasons for allowance in an application, and that statement is not contested by the applicant? What is the result if applicant simply says nothing after the examiner makes a statement of reasons for allowance, either during the prosecution or at the allowance and issue of the claims?

In *Yamaguchi*, the patent examiner rejected the reissue claims as being an impermissible recapture of subject matter surrendered in the original application for patent. The recapture rejection was based on a finding that a surrender was made as a result of the applicant’s failure to reply to the examiner’s reasons for allowance set forth in the original patent. The examiner determined that a limitation (now omitted in the reissue application) had been established as a claim limitation which distinguished over the prior art by the statement of the reasons for allowance, and that because the applicant failed to reply and address the matter, the applicant surrendered claim subject matter that did not include that limitation. After the examiner’s rejection was made final, the applicant appealed to the BPAI. In its decision reversing the examiner’s rejection based on recapture, the BPAI first noted that, at the time the patent was issued, the last sentence of 37 C.F.R. 1.104(e) stated that “[f]ailure to file such a statement [commenting on the reasons for allowance] shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.”¹⁹⁴

Based on this provision of the rule, the BPAI held that failure to file a statement commenting on the examiner’s reasons for allowance did “not give rise to any implication that [applicant] agreed with or acquiesced in the examiner’s reasoning,” and there was no surrender in this instance (and thus, no recapture).¹⁹⁵ The BPAI then went on to state:

Moreover, even if present 37 CFR §1.104(e) [which no longer contains the above-quoted last sentence of § 1.104(e)] had been

reported as an unpublished non-precedential decision of the BPAI, but the BPAI, pursuant to their Standard Operating Procedure 2, Rev. 4, subsequently designated the opinion as a precedential opinion.

¹⁹⁴ 37 C.F.R. § 1.104(e) (1997) (prior to 2000 amendment).

¹⁹⁵ *Ex parte Yamaguchi*, 61 U.S.P.Q.2d 1043, 1046 (Bd. Pat. App. & Int. 2001).

in effect when appellants' original application was pending, we do not consider that the recapture rule would preclude them from obtaining the claims now on appeal.¹⁹⁶

Discussing what may constitute a surrender for purposes of the recapture rule, the Court in *Hester Industries* stated that:

[a]s a general proposition, in determining whether there is a surrender, the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding patentability . . . In this regard, claim amendments are relevant because an amendment to overcome a prior art rejection evidences an admission that the claim was not patentable . . . Arguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender . . . Logically, this is true even when the arguments are made in the absence of any claim amendment. Amendment of a claim is not the only permissible predicate for establishing a surrender.¹⁹⁷

In the present case, the claims in appellants' original application were, as noted previously, allowed in the first Office action. Consequently, the prosecution history of the original application contains none of the evidence relevant to surrender discussed in *Hester Industries*, *supra*, in that it contains neither any amendments to the claims, nor any arguments made by appellants to overcome prior art or for any other purpose.

*Appellants' only "argument" was their lack of response to the examiner's statement of reasons for allowance, and we know of no decision which holds that, under the recapture rule, a surrender may result from an applicant's failure to act, as opposed to taking a positive action such as changing the claims or presenting an argument.*¹⁹⁸

Accordingly, *Yamaguchi* provides a statement by the BPAI that a surrender of claimed subject matter cannot be based solely upon an applicant's failure to respond to, or failure to challenge, an examiner's statement made during the prosecution of an application. An applicant is bound only by the *applicant's* revision of the application claims¹⁹⁹ or a positive argument by the *applicant*. However, the

¹⁹⁶ See Changes to Implement Patent Business Goals, 65 Fed. Reg. 54,604, at 54,633 (2000); *Ex parte Yamaguchi*, 61 U.S.P.Q.2d at 1046.

¹⁹⁷ *Hester Industries v. Stein, Inc.*, 142 F.3d 1472, 1481 (Fed. Cir. 1998).

¹⁹⁸ See *id.* (emphasis added) (citation omitted) (footnote omitted).

¹⁹⁹ Such revision would include addition, cancellation, or amendment of claims, or even an amendment of the specification/drawings in a manner that changes the scope of the claims. Such revision would include an examiner's amendment consented to by applicant, even though it is the examiner who actively drafts the amendment.

actual *Yamaguchi* holding was directed to an examiner's statement of reasons made *prior to the rule change*, where the applicant was protected by the rule provision that failure to file a counter statement did not give rise to any implication that the applicant agreed with or acquiesced in the reasoning of the examiner. Accordingly, the portion of *Yamaguchi* that states that the result would have been the same even after the rule change is *dicta*. In making the *Yamaguchi* decision precedential, however, the BPAI has embraced even this *dicta* in *Yamaguchi*.

Applying the *Yamaguchi* principle, an applicant's failure to present on the record a counter statement to or comment about an examiner's reasons for allowance does *not* give rise, for purposes of reissue recapture evaluation, to any implication that the applicant agreed with or acquiesced in the examiner's rationale for allowance. The examiner's statement of reasons for allowance in the original application *cannot, by itself, provide the basis for establishing surrender and recapture*.

It is only in the situation where an applicant does file comments on the examiner's reasons for allowance that surrender *may have* occurred. Note the following two scenarios in which an applicant files such comments:

Scenario 1 - Surrender: The examiner's reasons for allowance in the original application stated that it was limitation C (of the combination of ABC) which distinguished over a combination of references X and Y, in that limitation C provided increased speed to the process. Applicant files comments on the reasons for allowance essentially *supporting the examiner's reasons*. The limitation C is thus established as relating to subject matter previously surrendered.

Scenario 2 - No Surrender: On the other hand, if applicant's comments on the reasons for allowance *contain a counter statement* that it is limitation B (of the combination of ABC), rather than C, which distinguishes the claims over the art, then limitation B was the limitation relied upon and is relevant to surrender, and limitation C is not.

The *Yamaguchi* decision confirmed that the *Changes to Implement Patent Business Goals* rule amendment²⁰⁰ did *not* establish that an applicant's failure to address an examiner's reasons for allowance constitutes surrender for purposes of reissue recapture. Rather, the case law cited in the preamble of the *Changes to Implement Patent Business Goals* package in support of the rule change is directed to prosecution history estoppel and the doctrine of

²⁰⁰ See *Changes to Implement Patent Business Goals*, 65 Fed. Reg. 54,604, 633 (2000).

equivalents. Thus, the rule change to remove the exculpation of the applicant's silence after an examiner's statement of reasons for allowance would provide for surrender only for the purpose of the doctrine of equivalents.²⁰¹

Whether surrender is generated by the applicant's silence for purpose of the doctrine of equivalents (which apparently was the focus of the rule change and its preamble) is a matter left to the courts, and the rule change and supporting preamble language were stated in that context.

Will the Federal Circuit adopt the BPAI's position that an applicant's silence after an examiner's statement of reasons for allowance can provide for surrender for the purpose of the doctrine of equivalents, but not for purposes of reissue recapture? It might. In *Shepard v. Carrigan*, the Supreme Court stated: "[u]nder the circumstances of this case, the inventor *could not even get a reissue based on the broader claim which she had abandoned.*"²⁰²

Further, in *Johnson & Johnston Associates Inc. v. R.E. Service Co.*,²⁰³ the patent owner was held to be barred from recovering the steel embodiment of the invention (in addition to the aluminum embodiment actually claimed) via the doctrine of equivalents. The Federal Circuit then went on to state:

A patentee who inadvertently fails to claim disclosed subject matter, however, is not left without remedy. Within two years from the grant of the original patent, a patentee may file a reissue application and attempt to enlarge the scope of the original claims to include the disclosed but previously unclaimed subject matter.²⁰⁴

This appears to state that reissue may be a refuge to a patent owner who has taken action that might be viewed as having surrendered an equivalent. While the patent owner was barred from recovering steel in addition to aluminum, the court was open to the possibility that this subject matter was not surrendered for purposes of reissue.

The statement by the court may very well have been the Federal Circuit's hint to the public that although a surrender might have been established for purposes of the doctrine of equivalents, it would not necessarily be surrender for purposes of reissue recapture. The Federal Circuit may have been telling the patent com-

²⁰¹ Perhaps it was in order to address the preamble language directed to the rule change that the BPAI decided to make *Yamaguchi* precedential.

²⁰² *Shepard v. Carrigan*, 116 U.S. 593, 598 (1886) (emphasis added).

²⁰³ 285 F.3d 1046 (Fed. Cir. 2002).

²⁰⁴ *Id.* at 1055 (citing 35 U.S.C. § 251 (2000)).

munity to reissue the patent to seek protection for the “equivalent” in order to remove any stigma of surrender in reaction to the teachings of the prior art.²⁰⁵ If so, the *Yamaguchi* panel’s apparent distinction, that an applicant’s silence can be a basis for surrender for purposes of the doctrine of equivalents but not a basis for surrender for purposes of reissue recapture, may be allowed to stand by the Federal Circuit.

On the other hand, in *Hester Industries*, the Federal Circuit stated:

Indeed, the recapture rule is quite similar to prosecution history estoppel, which prevents the application of the doctrine of equivalents in a manner contrary to the patent’s prosecution history. Like the recapture rule, prosecution history estoppel prevents a patentee from regaining subject matter surrendered during prosecution in support of patentability.

Hester argues that an analogy cannot be made with prosecution history estoppel because the reissue procedure and prosecution history estoppel are the antithesis of one another—reissue allows an expansion of patent rights whereas prosecution history estoppel is limiting. However, Hester’s argument is unpersuasive. The analogy is not to the broadening aspect of reissues. Rather, the analogy is with the recapture rule, which restricts the permissible range of expansion through reissue just as prosecution history estoppel restricts the permissible range of equivalents under the doctrine of equivalents.²⁰⁶

Of course, until the issue arises in a civil suit, e.g., for infringement, the Federal Circuit cannot provide its guidance on the issue.

Next, we will examine briefly the nature of the statement or argument that must have been made in the original application for a patent, in order for a reissue applicant to be considered to have surrendered claimed subject matter.

IV. THE NATURE OF THE STATEMENT OF SURRENDER

The Federal Circuit, in *Clement*, mentioned that argument

²⁰⁵ In *Ex parte Liliensfield*, 11 U.S.P.Q. 216 (Bd. App. 1931), the examiner’s argument that:

a limitation . . . could not be dropped especially when the limitation was placed in the claim in order to obtain a patent, was rejected by the Board because the decision relied upon to support the argument had to do with an infringement of a claim to a patent and, as such, was not considered applicable in the presentation of broad claims in a reissue within the two-year limit.

Id. This is an early statement that what constitutes surrender in an infringement context (to negate expansion of a claim by the doctrine of equivalents) may not necessarily constitute surrender in a reissue context.

²⁰⁶ *Hester*, 142 F.3d at 1481-82. (citations omitted).

alone can be a basis for surrendering claim subject matter. *Hester* focused on argument as a sole basis for surrendering claim subject matter and found recapture based on it. In addition, arguments are to be considered in conjunction with amendments made to avoid the prior art when determining the question of what, if anything, has been surrendered by an applicant.²⁰⁷

Section 1412.02 of the Manual of Patent Examining Procedure (MPEP)²⁰⁸ provides that where a limitation of the patent claims is omitted in the reissue claims, “[t]he argument that the claim limitation defined over the rejection must have been specific as to the limitation; rather than a general statement regarding the claims as a whole. A general ‘boiler plate’ sentence . . . will not be . . . sufficient to establish recapture”

MPEP 1412.02 then provides an example of one such “boiler plate” sentence as, “[i]n closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable.” The MPEP points out that this type of general “argument” will not, by itself, be sufficient to establish surrender and recapture.

Another example would be an argument that merely states that all the limitations of the claims define over the prior art, such as the following:

Claims 1-5 set forth a power-train apparatus, which comprises the combination of A+B+C†+E. The prior art of record does not disclose, or establish a motivation to provide for, a material-transfer apparatus as defined by the limitations of claim 1, including an A member and a B member, both connected to a C member, with all three being aligned with the D and E members.²⁰⁹

This situation was addressed by the BPAI in *Ex parte Yamaguchi*,²¹⁰ where the BPAI considered a statement of reasons for allowance with respect to what surrender of claim subject matter such statement of reasons might provide.²¹¹ The BPAI found

²⁰⁷ See, e.g., *Clement*, 131 F.3d at 1467 (discussing the limitations added by amendment during prosecution and arguments related to the amendments, in the context of surrender).

²⁰⁸ U.S. Patent and Trademark Office, U.S. Dep’t of Commerce, Manual of Patent Examining Procedure § 1400, at 1400-1 to 1400-14 (8th ed., rev. 2 2001) [hereinafter MPEP].

²⁰⁹ See *id.*

²¹⁰ 61 U.S.P.Q.2d 1043, 1046-47.

²¹¹ This statement of reasons for allowance was made by the examiner, and thus was held not to be a statement of surrender as will be discussed below; the BPAI, however, addressed the content of the statement to show that the statement itself would not provide a surrender of claim subject matter, even if an applicant had made it.

that such a statement would not provide any surrender of claim subject matter. The BPAI adopted the appellant's argument in the Appeal Brief that the statement of reasons for allowance was:

simply a restatement of the entirety of claim 1 as allowed, indicat[ing] that the examiner did not attribute patentability to any one or several features recited by the claim but, rather, found that the claim as a whole distinguished over the prior art, a conclusion which no applicant would want to dispute because it amounts to no more than a recognition that the whole of a claim must be considered in determining its patentability.²¹²

No measure of surrender could be gleaned from such a statement of reasons for allowance, even if that statement was made by the applicant.

In both of the above examples, the argument does not provide an indication of what specific limitations, e.g., specific element or step of the claims, cooperative effect, or other aspect of the claims, are being relied upon for patentability. Thus, the applicant has not surrendered anything.

V. THE PRESENT STATE OF RECAPTURE

In light of the previous discussion, Part V will conduct a "high level" overview of where the recapture doctrine has evolved to today, as well as the Federal Circuit case law adjudicating it.

A. *The 3-Step Test for Recapture*

The test for determining the presence of recapture or lack thereof has been clarified as a three-step process.²¹³ The first step is to determine whether, and in what aspect(s), the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspect(s) of the reissue claims relate to surrendered subject matter.²¹⁴ Finally, in the third step, it is to be

²¹² Ex parte Yamaguchi, 61 U.S.P.Q.2d 1043, 1047 (Bd. Pat. App. & Int. 2001) (citations omitted).

²¹³ See *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1371 (Fed. Cir. 2001) (reciting the Federal Circuit's statement of the three step process).

²¹⁴ Implicit in this step is a review of the record of the original patent to determine if there was *any* surrender made by the applicant. As pointed out above, there must have been an amendment to define over art, or a statement that provides an indication of what specific limitations, e.g., specific element or step of the claims, cooperative effect, or other aspect of the claims, are being relied upon for patentability. The statement must show what was surrendered; a general "boiler plate" sentence or a recitation of the entire claim (all limitations in the claim) arguing that the claimed invention is not shown by the art will not be sufficient to establish a surrender.

determined whether the reissue claims are materially narrowed in other respects to avoid the recapture rule.

B. *The Claims Used for Comparison of Broadening/Narrowing*

When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of testing analysis that must be performed. If the reissue claim fails either test, then recapture exists.

First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution to define over prior art.²¹⁵ Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue.

Second, it must be determined whether the reissue claim *entirely* omits²¹⁶ any limitation that was added/argued during the original prosecution to define over prior art. Such an omission in a reissue claim, even if the reissue claim includes other limitations making it narrower than the patent claim in other aspects, is impermissible recapture.²¹⁷

C. *Claim Limitations that Materially Narrow*

As pointed out, the third step of the recapture analysis is to determine whether the reissue claims are *materially* narrowed in other respects to avoid the recapture rule. Where the reissue claims omit a key limitation that was relied upon to define the original patent claims over the prior art, recapture may be avoided by adding to the reissue claims a replacement limitation directly pertinent to the omitted key limitation. Such a replacement limitation must *materially* narrow the reissue claims (in the area directly pertinent to the subject matter surrendered). *Mentor* and *Hester* have provided examples of what is not material narrowing.²¹⁸ Under *Mentor* and *Hester*, it appears that an added limitation does not ma-

²¹⁵ See generally *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997).

²¹⁶ If the reissue claim does not entirely omit the key limitation but rather retains it in broadened form, that is *Eggert*, and it remains to be seen whether the Federal Circuit will ratify the BPAI holding that this is not recapture. Thus, a statement of what the Federal Circuit presumably will do has only been made for the case of complete omission of the key limitation; the question of broadening the key limitation is "up in the air" as far as what the Federal Circuit will do. See the discussion below of the future of the recapture doctrine.

²¹⁷ See generally *Pannu*, 258 F.3d 1366.

²¹⁸ See, e.g., *Mentor*, 998 F.2d at 996; *Hester*, 142 F.3d 1472, 1482-83.

terially narrow a claim if: (1) the limitation added was inherent from the existing claim limitations; (2) the addition to the requirements of the claim (e.g., to the claim structure, composition, or method) was *de minimis* in importance; or (3) the addition to the requirements of the claim is found in the prior art.²¹⁹ Subsequent case law has not questioned these principles.

Another example of a non-material limitation is provided by *Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc.*²²⁰ In discussing whether “the claims of the original and reissued patents are identical” pursuant to 35 U.S.C. § 252, paragraph 1, the Federal Circuit noted that the district court cited and relied on *Austin v. Marco Dental Products, Inc.*,²²¹ and *Akron Brass Co. v. Elkhart Brass Manufacturing Co.*,²²² The Court went on to explain those two decisions:

Akron Brass and *Austin* permitted changes in a reissue patent’s claims, however, only if *without substance*. In *Akron Brass*, a reissued claim substituted the word ‘outlet’ for the word ‘inlet’ in the original claim. Since it was *already clear what was intended*, the court there noted, substitution of ‘outlet’ for ‘inlet’ in no way enlarged or modified the substance of the claim. In *Austin*, the court found a claim in the reissued patent ‘identical’ to one in the original patent where a modification was made to ‘make more precise the language used without substantive changes in the claims.’²²³

Any new reissue limitation that is *identical* to a limitation of the canceled claim cannot be a material limitation. Thus, where a replacement limitation is added to narrow the claims in a reissue, and the replacement limitation would be viewed as identical to an existing limitation in the canceled claims, the replacement limitation clearly cannot mitigate against recapture. From *Seattle Box*, we can glean that if it was already clear that the newly added replacement limitation in the reissue was intended by the original patent claim, then the replacement limitation cannot be viewed as a material limitation. Likewise, if the only effect of the newly added replacement limitation is to “make more precise the language used without substantive changes in the claims,”²²⁴ a material limitation

²¹⁹ See the discussion of *Mentor* and *Hester*, *supra* Part II for the specifics/nuances of these categories.

²²⁰ 731 F.2d 818, 828 (Fed. Cir. 1984).

²²¹ 560 F.2d 966 (9th Cir. 1977).

²²² 353 F.2d 704 (7th Cir. 1965).

²²³ *Id.* (emphasis added)(citation omitted).

²²⁴ *Id.*

has not been added.

The case law defines “material narrowing” in terms of what is *not* material narrowing. It is presumed that “material narrowing” is any narrowing which goes to the merits of the claimed invention, and is not within what the case law defines as not being material narrowing.

D. *Broadening the Canceled Claim*

In *Ball*, the Federal Circuit found that recapture could be avoided even though the reissue claims were broader than the canceled claims in an aspect. The *Ball* court stated that:

[t]he reissue claims are, however, broader in one respect. The canceled claims are limited to an antenna of cylindrical configuration, whereas the reissue claims are not so limited [W]e find that the non-material, broader aspects of Ball’s reissue claims do not deprive them of their fundamental narrowness of scope relative to the canceled claims. Thus, the reissue claims are sufficiently narrower than the canceled claims to avoid the effect of the recapture rule.²²⁵

Thus, a reissue claim was permitted to be broader than the canceled claim, as long as the broadening was not material. If *Ball* is followed, and to date there has been no indication that this aspect of *Ball* has been discarded, then the claim drafter might broaden the canceled claim as long as he/she can predict that a reviewing court will not consider the area where the claim is broadened to be critical to the invention. This can be viewed using the model discussed above. Assuming ABC is the canceled claim, and applicant added element D to define the claims over the art and obtain a patent, the reissue can claim ABD even though element C is not present. This would be so, unless element C was needed to define the claims over the prior art. This determination can be quite subjective; thus, the claim drafter should exercise care in broadening the canceled claim.

E. *A Caveat*

Recapture will exist if (1) a limitation of the patent claims is eliminated in a reissue application, and (2) the eliminated limitation was relied upon by applicant in the form of an amendment/argument of patentability made by applicant to define over the art. This is the general guidance provided by the case law. However, a

²²⁵ *Ball Corp. v. United States*, 729 F.2d 1429 (Fed. Cir. 1994).

recapture determination must be made for *each fact situation* on a *case-by-case basis*, looking to the prosecution history for blaze marks. The case law demonstrates the complexity of the determination, and there may be some redundant nuance that the courts will find important that may be overlooked, or simply not appreciated.

VI. LOOKING TO THE FUTURE: HOW PRESCIENT CAN WE BE?

Although the above discussion of the present state of recapture appears to be organized, in actuality there is little certainty in the area. From as far back as *Byers*, the courts have held that it was impermissible recapture for a reissue claim to be of the same scope as any claim that was canceled or amended in the original prosecution to define over the prior art. Certainly, a reissue claim cannot be broader in all aspects than a claim canceled or amended to define over the prior art. In addition we can state with a reasonable degree of certainty that if the claim limitation relied upon in the application to define over the prior art is entirely omitted and not replaced by a material limitation, recapture will result.²²⁶ Nothing more can be stated with absolute confidence.

We have postulated that if a reissue claim *entirely* omits a key limitation that was relied upon during the original prosecution to overcome an art rejection, a “replacement” limitation that is materially narrower than the canceled claim in an area *not* related to surrender cannot save the reissue claim from recapture.²²⁷ It is, however, possible that the Federal Circuit, to date, has believed that in the cases before it, the replacement limitation of the reissue claims simply did not provide the public with enough *quid pro quo* to substitute for the key limitation omitted. That being the case, the Federal Circuit may have decided that the owner was simply trying to recover the key narrowing done to obtain the patent, without giving back fair consideration. Accordingly, the court felt that the corrective relief, or remedy, sought by patent owner was simply not equitable, and thus refused to permit the recapture of the narrowing conducted to obtain the patent. This would fit within the above stated hypothesis that the remedial reissue statute was not enacted to reward a patent owner who attempts to obtain a broadened reissue patent other than through inadvertence, accident, or mistake without deceptive intent.

²²⁶ See discussion and accompanying notes, *supra* Part V.

²²⁷ See the above discussion of *Pannu* and *Hester* which showed the world that comparison with the “cancelled claim” is not the only way to find recapture, and that the relied upon limitation in the patent claim cannot be eliminated.

In *In re Clement*,²²⁸ the Federal Circuit addressed reissue application claims that were broader than the canceled claims by omission of a number of key limitations added to secure allowance of the original patent claims over reference X, and narrower by addition of a limitation added to secure allowance of the original patent claims over reference Y. The court stated that “on balance,” the reissue claims were broader than they were narrower in a manner directly pertinent to the subject matter that was surrendered in the original prosecution.²²⁹ As noted above, this could very well imply that the court simply weighed the narrowing and broadening in what it considered to be the limitations pertinent to the surrendered subject matter; and the multiple broadenings (due to multiple omissions of key limitations) were deemed to outweigh the single narrowing limitation in the *Clement* reissue claims. This balancing of limitations appears to be the court’s call for sufficient *quid pro quo* to substitute for the key limitation omitted. This balancing would also explain why the Federal Circuit declined to overrule *Ball* in its *Pannu* decision. In *Pannu*, the replacement limitation of the claims fell short of providing sufficient *quid pro quo* to substitute for the key limitation omitted, while the more extensive/detailed replacement limitation of the claims in *Ball* was found to provide sufficient consideration.

Looking at the case law in this manner, it is quite possible that this balancing of the importance or significance of the replacement limitation(s) *vis-à-vis* the omitted key limitation(s) is the Federal Circuit’s true focus, and all the existing decisions thus far are to be interpreted in terms of this balancing. In other words, the requirement to balance the limitations in the recapture analysis may very well be the proverbial “iceberg,” and the existing Federal Circuit decisions were based on resolutions of that balancing for one set of individual situations that did provide recapture and which represent only the tip of the “iceberg.”

If so, there are two possibilities as to the Federal Circuit’s approach to recapture to be considered:²³⁰

- (1) The court may create an entirely new set of rules in an *en banc* decision to govern how to balance the importance or significance of the “replacement limitation(s).”
- (2) The court may continue to evolve the law incrementally on

²²⁸ *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997).

²²⁹ *Id.* at 1471.

²³⁰ Although, there could, of course, be an approach intermediate of the two possibilities, the two poles are now considered, with a leaning toward the first as much as possible being desirable.

a case-by-case basis by weighing which limitations might be deemed more important in an individual case to tip the scales for or against recapture.

Clearly, the first approach is preferred, because, under the second approach, uncertainty would remain as to what limitations might be added and deleted via reissue to avoid the consequences of the recapture doctrine. If the Federal Circuit adopts the first approach, it will be in step with the equity principles of the reissue statute, and will make the application of the reissue doctrine a fair and important doctrine with which to address correction of patents.

Accordingly, we will now look into the future based on the first approach, and address some issues that should flow from the balancing of the importance or significance of the replacement limitation(s) in a reissue claim.

A. *If Reissue Broadening Eliminates Key Limitation, but Narrowing Occurs in Other Areas, Will Recapture Be Avoided?*

Where the broadening and narrowing limitations are such that a limitation that defined over the prior art is entirely omitted in the reissue, and one or two replacement limitations are placed in the claim to define over the prior art, but in an entirely different way than the omitted limitation did in the original application, *Pannu* should settle the matter. We should not view the new limitation to be in the area of the surrendered subject matter since it does not narrow the claims in the area omitted (comparison with the canceled claim is not the criteria here).

What if, however, the reissue claims omit *one* limitation Q that defined the claims over reference A in the original prosecution and newly adds *multiple narrowings* of *other limitations* X, Y, and Z that will define the claims over reference A? Would the Federal Circuit decide that the *many* narrowings far outweigh the single broadening omission (even though the multiple narrowings are not directed to the key surrender-generating limitation), and that recapture has thus been avoided? In the right fact situation, where the *many* narrowings provide sufficient *quid pro quo*, it is quite possible that the Federal Circuit would decline to find the presence of recapture.

Also, what would be the result where two rejections were applied in the original prosecution,²³¹ and the reissue claims now

²³¹ The first rejection was based on reference A, and the second rejection was based on reference B.

omit one limitation Q that defined the claims over reference A? If the reissue claims add narrowing of limitations X, Y, and Z that defined the claims over reference B, and which are also found to define the claims over reference A, would there be sufficient *quid pro quo* to avoid recapture? This case may be even more compelling than the above-mentioned scenario, because it can be argued that the public should be aware that surrender was made with respect to two rejections, and the patent owner might be expected to revise the claims (via reissue) to employ limitations X, Y, and Z in the second area of surrender that define the claims over both rejections, without the need for any surrender in the first area. It is also possible that the court could decide that reference A was not really so good, but rather the key to the case was to define the claims over reference B. Thus, the Q limitation could be dispensed with (and no recapture would result).²³²

As pointed out above, it may be that, in view of *Hester* and *Pannu*, the Federal Circuit has advanced to the point where the omission of *any* one key limitation that defined the claims over reference A cannot be replaced by a number of unrelated limitations, regardless of how many unrelated limitations are provided. If such a “wooden rule” has been adopted by the Federal Circuit, then no matter how many unrelated limitations are added in the reissue claims, or how good one rejection is relative to the other, the key limitation remains omitted, and recapture would exist. *On the other hand*, if the Federal Circuit will balance the importance of the broadening and narrowing, i.e., the omitted limitation and the added limitations, then recapture will be avoided. There is no assurance that the Federal Circuit will adhere to the “wooden” omission-of-key-limitation principle in a case where it feels avoidance of recapture to be compelling based upon the impact of the replacement limitations in the reissue claims and the equities. It is the opinion of the authors that eventually such a compelling case will come before the Federal Circuit, and the court will then decline to find recapture.

²³² We need not inquire into the case where the reissue claims omit one limitation that defined the claims over reference A in the original prosecution and adds a “replacement” for that same limitation which is simply a broadened version of the omitted limitation and thus continues to define the claims over reference A. That is the situation in *Ex parte Eggert et al.*, and until the Federal Circuit rules differently, *Eggert* is the only decision we have on the subject.

B. *What If Reissue Claim Eliminates a Key Limitation, Because It Recites an Entirely New Invention That Does Not Rely Upon (Nor Recite) the Aspect of the Claim Narrowed to Obtain the Original Patent?*

In some instances, the original patent will disclose multiple inventions but claim only one of the inventions, and claims to a different invention will be subsequently added via reissue. If there was a surrender of claim subject matter made in obtaining the original patent, can a separate invention newly claimed by reissue omit a limitation that was relied upon in the original patent to define the claimed invention over the prior art? The problem often encountered is that the new claims (to the different invention) will not have any mention of the aspect to which the surrender was directed. In these instances, the patent owner needed to modify (in the original prosecution) a specific aspect of the originally claimed *first invention* to define patentability, but the newly claimed second invention is not at all inclusive of that specific aspect and the second invention will stand as an entirely separate invention to define over the art. The Federal Circuit has not addressed this situation, as to whether the necessary (in view of the different nature of the second invention) omission of the “relied upon” limitation (for the first invention) will preclude the patent owner from adding the second invention via reissue. The old C.C.P.A. case of *In re Murray*, which was discussed in the historical recapture section above, is a possible example of a separate invention found not to be recapture *despite the broadening of the canceled claims*, because the “inventive elements” added by the reissue claim were “in no respect . . . included” in the canceled claims.²³³ As stated in *In re Murray*, “[t]he invention claimed by said rejected claim 3 is not in any sense a broadening of the subject-matter of said canceled claims, but constitutes a distinct subject-matter, disclosed, but not claimed, in the original application and patent.”²³⁴ *Murray*, however, was a decision of the C.C.P.A. under the old recapture standard, and cannot be looked to with any degree of certainty.

The following scenarios are examples of what may, in the future, be presented to the Court:

1. Combination–Subcombination Scenario

As pointed out above, the *B.E. Meyers & Co. v. United States*, reissue claims dealt only with the specifics of the lens system disclosed, i.e., a specific subcombination. That subcombination “had

²³³ *In re Murray*, 64 F.2d 788, 792 (C.C.P.A. 1933).

²³⁴ *See id.*

nothing to do with" the type of pulsing circuitry of the patent claims where the narrowing to generate surrender had occurred in the original patent prosecution, and the pulsing circuitry was present *in combination* with the lens in the IR illuminator of the original claims.²³⁵ Will the Federal Circuit confirm the *Meyers* holding that no recapture results, when it is presented with a similar set of facts?

2. Multiple Embodiments Scenario

Given the present state of the recapture law, what will the Federal Circuit do with a multiple embodiment (or multiple species) set of facts, similar to the one found in *In re Amos*?²³⁶ Where original patent claims are to an embodiment of automatically lifting mechanically by the roller cams and the surrender-generating narrowing was done to the roller cam system, what will the Federal Circuit do when reissue claims entirely omit the roller cam system, because the lifting is done electronically by a computer control (in the second embodiment)? In a more recent case, *In re Doyle*,²³⁷ the Federal Circuit permitted addition via reissue of new embodiments, where newly presented claims in the reissue application linked the invention elected (and patented) together with inventions not elected in the original application and inadvertently not filed as a divisional application.²³⁸ The Federal Circuit permitted the addition of the new embodiments in the reissue via the linking claims. Given *Doyle*, we may ask what the Federal Circuit will do where a patented species is obtained via surrender of an aspect of the claim directed specifically to that patented species, and a newly added linking genus claim in a reissue does not contain any limita-

²³⁵ See *Meyers*, 7 Fed. Cl. 200, 207 (Fed. Cl. 2000).

²³⁶ 953 F.2d 613 (Fed. Cir. 1992).

²³⁷ 293 F.3d 1355 (Fed. Cir. 2002).

²³⁸ In the examination that resulted in the original patent of Boyd, the examiner imposed a nine-way restriction requirement. Applicant elected group VI, a group of method claims directed towards using catalysts to *insert carbenes* (a carbene is a CR_2 fragment, where R represents a group bonded to the carbon atom) into carbon-hydrogen, oxygen-hydrogen, nitrogen-hydrogen, and silicon-hydrogen bonds. He cancelled the other pending claims. The groups that applicant did not elect that were relevant to the appeal included: (1) Group VII, drawn to a method of forming metal stabilized ylides using a chiral catalyst; (2) Group VIII, drawn to a method of adding a hydrogen atom using a chiral catalyst; and (3) Group IX, drawn to methods of adding silicon and hydrogen or boron and hydrogen using a chiral catalyst. The applicant did not file any divisional applications directed towards the non-elected groups prior to the issuance of the patent. In the reissue, the patent owner sought to broaden his claims to cover the reaction of his catalysts with a genus of prochiral molecules, i.e., not just insertion of a carbene. The reissue genus claims read on (but were broader than) the claims of non-elected Groups VII-IX. The court permitted this recovery of the embodiments of non-elected Groups VII-IX via the genus claims added to the patent in reissue. See *Doyle*, 293 F.3d at 1356.

tion directed to that aspect, because of the nature of the added species contained within the newly added genus claim. If such a genus claim contains a limitation to define it over the art, will the Federal Circuit permit it via reissue?²³⁹

3. Different Categories of Invention Scenario

An issue similar to that of scenarios 1 and 2 above will be encountered if the reissue claims present a new category of invention that omits a specific of the originally patented category of invention, and the omitted specific was added to define the claims over the art. Two examples are provided to illustrate this. Assume the original patent claim is to a method for making a plant food composition by grinding, heating at 200-210 degrees Farenheight, grinding, and cooling. The heating at 200-210 degress Farenheight was argued to define the claims over the plant-food method-of-making reference that was applied, *because such heating makes the method operate faster* than that of the prior art (even though same product is produced).

A first example exists where the added reissue claim is to a *product* of the actual plant food composition of components A, B, C, and D. Even if the 200-210 degrees Farenheight limitation is claimed in the product, it has no patentable weight to define over the art, since it does not change the product. Thus, the limitation might be viewed as if it was not there. What is the result as to the recapture issue if the temperature limitation is omitted in the product claims added by the reissue?

A second example exists where the added reissue claim is to an *apparatus* for making the plant food composition, the claims providing first grinding means, heating means, second grinding means and a cooling chamber. In this instance, the same apparatus, i.e., heating means, which heats to 200-210 degrees Farenheight will heat to 100-110 degrees Farenheight. Thus, again, the 200-210 degrees Farenheight limitation is effectively not in the apparatus claim even if placed there. And again, what is the result as to the recapture issue if the temperature limitation is omitted in the apparatus claims added by the reissue?

These two exemplary situations, where the new reissue claims

²³⁹ In *Doyle*, the examiner did reject the claims newly added via reissue based on recapture. The BPAI held that "the recapture doctrine [was] inapplicable here because the pertinent [non-elected] claims were not cancelled to overcome prior art. Rather, they were cancelled in response to a restriction requirement without prejudice to refiling." *Id.* at 1357-58. This does not, however, provide illumination on the fact-situation where the elected claims were amended to avoid the art in the original application.

omit the limitation that is relied upon for the patentability of the first invention due to the nature of the new invention, are logically the most compelling cases for recapture to be inapplicable. This is so because the patent owner gives the public a large *quid pro quo* (compensation) for the omission of the relied-upon limitation, and the previously relied-upon limitation might not contribute anything to defining the claims over the prior art. The patent owner is providing an entirely new invention, which he inadvertently and honestly forgot to put into the patent. Given the purpose of the reissue statute, the patent owner now should not be barred from claiming the new invention simply because the patent owner previously added something to a totally unrelated aspect of the other invention to define *the original claims* over the art (an aspect that does not fit within the new invention). Barring the patent owner from claiming the second invention would be inconsistent with the purpose of recapture.²⁴⁰

Assuming the Federal Circuit does permit adding a new invention by reissue after surrender was made as to the originally claimed invention, it remains to be seen what the Federal Circuit will do when different inventions are claimed via reissue. Will the court treat them all the same, and if not, what criteria will be provided for differentiating between fact situations?

C. *What If a Reissue Claim Does Not Recite Specific Key Limitation, but Does Recite Key Limitation in Broadened Form?*

As pointed out above, where a reissue claim entirely omits any limitation that was added/argued during the original prosecution as a key limitation to overcome a prior art rejection, such an omission is recapture. However, is it also recapture if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome a prior art rejection (and therefore does not entirely remove that key limitation)? The BPAI's *Eggert* decision held that the reissue claim may not be rejected under the recapture doctrine, even where there was no indication on the record that anything less than the complete scope of the key limita-

²⁴⁰ Providing a completely new invention (e.g., new embodiment) via reissue was expressly sanctioned in *In re Amos*. In many of the prosecutions to obtain a patent, there will be some manner of reliance on one or more claim limitations to define over the art. If a totally new invention is then added via reissue, it, in all probability, will omit the limitation added to narrow the first invention, since the content of the new invention is different than that of the first invention and relies on a different way of accomplishing the inventive concept that does not use the limitations of the first invention that were narrowed. It was not the purpose of the Federal Circuit to permit adding a new invention via reissue only in the rare cases where there was no surrender in the original patent.

tion could also be used to overcome the prior art. For example, if the key limitation added to overcome a prior art rejection was “an orange peel,” and the reissue claim instead recites “a citrus fruit peel,” the reissue claim has not recaptured surrendered subject matter. Based on the above discussion, it is believed that the Federal Circuit will adopt this view when it is presented with the issue in a civil suit.²⁴¹ In this instance, the applicant chose an appropriate limitation to add to the claim in the prosecution of the patent to define the claims over the art. The applicant simply made an honest mistake as to how specifically to recite the limitation, and the patent owner should be permitted to correct that mistake. Further discussion of the equities of this factual situation will be provided below.²⁴²

1. Nuances

In the *Eggert* patent’s prosecution history, Eggert expressly limited the claims to include the specificity of the key limitation and twice argued that specificity to define over the applied prior art.²⁴³ There are, however, other possibilities. Thus, an applicant might add a specific key limitation (for example, a species) to overcome a prior art rejection, while the applicant’s accompanying argument might be directed to the generic form of the limitation as to how it defines the art. Alternatively, the specific key limitation might be added without any argument by the applicant, and the examiner might base the allowance of the claims on the limitation (or the examiner might not say anything about the limitation upon allowance). In these instances, the description in the disclosure might designate the specificity of the limitation to be preferred, or even critical. On the other hand, the specific limitation might be disclosed as one of many of a group, all of which will work equally well. Thus, even if the Federal Circuit adopts the view that a generic or broadened form of the key limitation can be substituted for a specific key limitation to thereby avoid recapture, an analysis of the above nuances would still be needed to see how far the court went, i.e., where the court drew the line. The point is that even if the issue does reach the Federal Circuit, one decision might not be enough to provide a complete resolution of the issue, and it might take many years for a complete picture to emerge.

²⁴¹ This issue will not reach the Federal Circuit on appeal from the Patent Office, since the BPAI will always find that there is no recapture when presented with the issue and the patent will be granted.

²⁴² See *infra* Conclusion C.

²⁴³ See *Ex parte Eggert*, 67 U.S.P.Q.2d 1716, 1729 (BNA) (Bd. Pat. App. & Inter. 2003).

D. *What If a Reissue Claim Does Not Recite One of the Key Limitations Relied on to Define over the Prior Art, but Does Recite the Other Such Limitations?*

Assume claims 1-3 of an application are directed to the combination of A and B. After a rejection of the AB combination over the prior art, applicant amends AB to add elements C, D, and E; applicant argues C, D, and E define the claims over the prior art cited in the rejection. Claims 1-3 directed to ABCDE are then allowed, and a patent issues. In an application for reissue of the patent, new claims 4 and 5 are presented. Claim 4 is directed to the combination of ABCD (i.e., limitation E is omitted when compared to patent Claims 1-3). Claim 5 is directed to the combination of ABC (i.e., limitations D and E are omitted when compared to patent claims 1-3). This is represented in category # 4 of the table chart, and the question is: do claims 4 and 5 escape the recapture doctrine?

Assuming *Eggert's* holding survives Federal Circuit scrutiny when a similar issue comes before that court, we can make the following analysis: the retention of element C (one of the limitations added to define over the art) in claims 4 and 5 can be viewed in terms of *Eggert* as retaining, in the reissue claims, at least some vestige of what was added to define over the art. Thus, added claims 4 and 5 should both avoid recapture.

On the other hand, it is believed this situation is more complex. It would appear that an analysis of elements C, D, and E would be necessary in order to determine the relative importance of the limitations in defining over the prior art. If element C is sufficiently critical to avoid the prior art by itself, then both claims 4 and 5 escape the recapture doctrine. If element C is *not* sufficiently critical to avoid the art by itself, then claim 4 (directed to ABCD) will survive if D alone, or the combination of C and D, are important enough in their own right to overcome the prior art. Furthermore, claim 5 will not survive, since the retention of C is the mere retention of "window dressing." This is represented in category # 5 of the table chart, option (b) of footnote G. Once again, it will be up to the Federal Circuit to decide whether the recapture doctrine applies.

E. *What Happens When the Patent Law Changes After the Patent Has Issued?*

A situation may arise where an applicant surrenders claim subject matter in response to a prior art rejection, and after a patent is

issued, statutory revision provides that such a rejection can no longer be made. Can the “surrendered” claim subject matter be recovered by reissue, or is it barred by the recapture doctrine? For example, the Patent Office issued a notice in April of 2000 to clarify the Patent Office’s interpretation of certain issues.²⁴⁴ This notice pointed out that a reference qualifying as prior art under 35 U.S.C. § 103(c) via § 102(e), as it existed prior to the American Inventors Protection Act of 1999 (“AIPA”),²⁴⁵ was disqualified by the AIPA as prior art against a claimed invention if the reference and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”²⁴⁶ The notice further stated:

(2) . . . For reissue applications, the doctrine of recapture *may prevent* the presentation of claims that were canceled or amended to overcome such prior art applied in the application which matured into the patent for which reissue is being sought. See (4) below for further explanation.

. . . .

(4) The recapture doctrine *may prevent* the presentation of claims in reissue applications that were amended or canceled from the application which matured into the patent for which reissue is being sought, if the claims were amended or canceled to distinguish the claimed invention from 102(e)/103 prior art which was commonly owned or assigned at the time the invention was made.²⁴⁷

The Patent Office did not state that recapture would be present, but rather cautioned that the issue would arise. Further, there is currently no case law on this issue where a statutory revision following the issue of a patent disqualifies an applied reference.

Likewise, the use of a category of reference as prior art, or a type of prior art rejection, might be disqualified by a Federal Court’s decision after a patent issues. The question of recovery of claim subject matter surrendered in response to a rejection based on such a reference has likewise not been decided. It is noted that the CCPA apparently “ducked this issue” in *In re Wadlinger* by find-

²⁴⁴ See *Guidelines Concerning the Implementation of Changes to 35 USC 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors Protection Act of 1999*, Notice, 1223 OFF. GAZ. PAT. OFFICE 54 (April 11, 2000), available at <http://www.uspto.gov/web/offices/com/sol/og/2000/week15/patamin.htm> (last visited Oct. 22, 2004) [hereinafter *Guidelines*].

²⁴⁵ See Pub. L. 106-113, 113 Stat. 1501, 1501A-552 to 1501A-591 (1999). The AIPA was enacted November 29, 1999.

²⁴⁶ *Guidelines*, *supra* note 244, at 55.

²⁴⁷ *Id.* (emphasis added).

ing that the added reissue claims were narrower than the “canceled claim.”²⁴⁸ However, perhaps the CCPA went through the detailed broadening/narrowing analysis because it would not save the claim in reissue based on a change of case law after the patent issued. Eventually, these issues will be brought before the courts, but until that time, one can only guess as to the resolution of the same.

F. *Who Can Make a Statement/Argument That Affects Surrender?*

As mentioned above, the *Yamaguchi* panel of the BPAI held that an examiner’s statement of reasons for allowance which identifies a claim limitation as the basis for allowing the original application does *not* result in a surrender of claim subject matter that omits that limitation, and cannot serve as a basis for recapture. This is true whether the applicant later contests the examiner’s statement, or simply fails to address the examiner’s statement. Only an applicant’s statement, argument, or amendment (which might be made via an examiner’s amendment consented to by the applicant) can establish a surrender of claimed subject matter on which to base recapture. Again, the question is whether the Federal Circuit will ratify this decision when presented with the issue. In *Acco Brands, Inc. v Micro Security Devices, Inc.*,²⁴⁹ a prosecution history estoppel case, the Federal Circuit stated:

[t]he examiner then issued a Notice of Intent to Issue Reexamination Certificate, with a statement of Reasons for Allowance which reiterated his understanding that the pin is extended after the slot engagement member is in locked position . . . Kensington did not respond to this statement. Although there is no obligation to respond to an examiner’s statement of Reasons for Allowance, and the statement of an examiner will not necessarily limit a claim, *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1273, 59 USPQ2d 1865, 1874 (Fed. Cir. 2001), in this case the examiner simply repeated the arguments that the patentee had presented.²⁵⁰

Thus, it would appear that in the area of the doctrine of equivalents, where the courts have been more strict with the patent owner than in the area of reissue recapture, the *examiner’s* statement of reasons for allowance *will not be accepted as a basis for surrender, unless the applicant has provided some input to support that*

²⁴⁸ In re Wadlinger, 496 F.2d 1200, 1206 (C.C.P.A. 1974).

²⁴⁹ 346 F.3d 1075 (Fed. Cir. 2003).

²⁵⁰ *Acco*, 346 F.3d at 1078-79 (Fed. Cir. 2003).

*statement.*²⁵¹ To date, no court decision is directly on point as to silence as an admission that amounts to a surrender for reissue recapture. It seems reasonable, however, that an applicant should not be bound by what it did not state.

CONCLUSION

A. *We Are “Here,” but We Must Be Aware of Where “Here” Is at Any Given Moment*

The Federal Circuit’s position regarding what is considered surrender for reissue is truly the law of the land unless overruled by the Supreme Court, and the Supreme Court has not entered into the reissue recapture arena as of late. So, for the time being, we live by the Federal Circuit’s position, including any gloss added by the lower tribunals that is not inconsistent with the Federal Circuit. Case law shows the Federal Circuit’s position on the recapture doctrine is continually evolving, and practitioners should keep abreast

²⁵¹ Some other decisions discuss silence as an admission, but appear further removed from the area of reissue recapture doctrine. *See, e.g.,* Ajinomoto Co. v. Archer-Daniels-Midland Co., 228 F.3d 1338, 1350-51 (Fed. Cir. 2000):

It was ADM’s decision not to provide information about this change in its defense of non-infringement until after judgment was rendered, and indeed to provide explicit testimony that it was using the infringing strain. *ADM offered no explanation of its silence*, and simply argued that there was no evidence that . . . apparently referring to the time of the motion to amend.

Id. (emphasis added); *see also, Louis Vuitton S.A. v. Rags on Wheels*, 25 U.S.P.Q.2d 1391, 1393 (E.D. Cal. 1992):

Plaintiff’s basis for claiming that defendant sold three pieces of infringing merchandise per day for ten days is not supported by the evidence. Nevertheless, since defendant had the opportunity to oppose this contention as well as the remainder of plaintiff’s motion and failed to do so, *the court interprets defendant’s silence as an admission that plaintiff’s contentions are well founded.* This admission by silence also applies to plaintiff’s claim of gross sales in which defendant had the opportunity to present evidence of offsetting expenses but failed to do so.

Id. (emphasis added); *United Phosphorus, Ltd. v. Midland Fumigant, Inc.*, 205 F.3d 1219, 1236 (10th Cir. 2000):

The district court found the evidence presented at trial of Mr. Fox’s fraudulent behavior ‘abundant,’ but also stated none of that evidence tended to show damages separate and distinct from those sought under United’s other claims. United fails to direct us to one place in the trial transcript that refutes *the court’s finding We also note United does not advance a single argument on appeal*, other than pure speculation on how the jury reached its various verdicts, directly attacking the double recovery aspect of the district court’s ruling *The silence from United on this point is deafening.*

Id. (emphasis added); *Smith & Nephew, Inc. v. Ethicon, Inc.*, 276 F.3d 1304, 1317 (Fed. Cir. 2001):

Equally significant, S&N offered no evidence that could reasonably rebut the evidence showing that movement of an unsecured anchor would result in failed surgeries. The advertising materials that S&N did offer still do nothing to change this conclusion. For one thing, Ethicon itself did not draft these materials, so they do not even necessarily constitute a party-opponent admission, let alone a damaging admission.

Id. (Michel, J., dissenting).

of that evolution. As mentioned above, where the doctrine of equivalents is unavailable to broaden patent claims to prevent a competitor from practicing the patentee's invention, revision of the patent claims by reissue might still be available to accomplish that purpose. Thus, practitioners should be on guard not to make a claim revision and/or argument that will subsequently be viewed by the Federal Circuit as surrender, for purposes of reissue recapture, of some limitation that may be, or could reasonably become, important to the client in the future. Practitioners should be careful as to the limitations added and/or argued as being critical, so that the client will not be precluded in the future from removing such limitations from the claims in order to hold a competitor liable for literal infringement. Herein lies the importance of understanding the recapture doctrine.

And now, let us take a concluding look at how the recapture doctrine has evolved thus far, and try to answer the question whether the doctrine is serving its purpose and that of reissue in general.

B. *Trends in Recapture Law*

In *Ball Corp. v. United States*, the Federal Circuit permitted omission via reissue of the key claim limitation added to define over the prior art during the prosecution of the original application for patent. The *Ball* court found that recapture was avoided by substitution for the key limitation of another limitation that would be added to the canceled claims. This was in step with the historical reissue case law promulgated by the courts below the Supreme Court. In *Mentor Corp. v. Coloplast, Inc.*, the Federal Circuit announced that the limitation substituted for the key limitation must be a material limitation, and the court set forth some criteria for what is not material. Since a material limitation was *not* added via the reissue claims being considered, recapture was found to exist. The Federal Circuit then, in *In re Clement*, found recapture where a reissue applicant narrowed prior canceled claims, but did not narrow the most recent canceled claims. In *Clement*, the court also decided that narrowing of the patent claims in the area of defining over one rejection will not save the claims from recapture where the key limitation that defined over another rejection remains omitted. In addition, *Clement* set forth a structured analysis for recapture issues, and guidelines for handling cases of broadening and narrowing the canceled claims. Finally, *Clement* opened the door for the concept that comparing the reissue claims with the

“canceled claims” was not the only way to find that recapture is present.

In *Hester Industries, Inc. v. Stein, Inc.*, the Federal Circuit then compared the (broadened) reissue claim to the corresponding issued patent claim that had been argued (in the prosecution of the patent) to define over the prior art based on certain critical limitations. Since the limitation that had been argued to define over the art was no longer present in the reissue claim, recapture was found. In *Hester*, there was no canceled claim, so the Federal Circuit had to use the alternative test to find if recapture was present. Would the Federal Circuit use the alternative test even where there was a canceled claim present? *Pannu v. Storz Instruments, Inc.*, answered this question affirmatively, and this is where we now stand as to Federal Circuit decisions.

Modern recapture cases decided by the Federal Circuit show a trend in expanding the application of the recapture doctrine by defining what is considered to be a surrender of claim subject matter. If a limitation that is omitted in a reissue application or reissue patent was originally presented, argued, or stated in the original application to make the claims permissible over the art, the omitted key limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. What is sometimes lost in the Federal Circuit analysis of the recapture cases is that after the *Ball* decision finding recapture not to be present, *Mentor*, *Clement*, *Hester*, and *Pannu* found that recapture was present, with the Federal Circuit progressively adding more explanation of what would be recapture in reissue. However, this trend, however, has not been reflected in decisions by the lower tribunals.

The BPAI’s recent decisions in *Eggert* and *Yamaguchi* and the U.S. Court of Federal Claims decision in *Meyers* tend toward restricting the doctrine on what would constitute a surrender (while apparently staying within the bounds of Federal Circuit case law). In light of these cases, if a key limitation (i.e., a limitation relied upon to define over the art) is not entirely omitted in the reissue, but is rather replaced by a broadened version of the key limitation, such reissue claim subject matter has not been surrendered, and recapture would be avoided. Furthermore, surrender will only result from a revision of the claims by the applicant²⁵² or from an argument by the applicant. It will not result from an applicant’s silence as to what is said by the examiner (and presumably will not result from an applicant’s silence as to what is said by a third party

²⁵² Surrender can also result by giving the examiner consent to revise the claims.

entitled to participate in a proceeding, e.g., in a reexamination or interference proceeding). With respect to the presentation of a new embodiment/invention via reissue that does not contain the key limitation added in the application to define over the art, it is unclear whether the decision of the U.S. Court of Federal Claims will be followed.

In general, it is unclear whether the Federal Circuit will uphold the lower tribunal's tendency toward loosening the snare of the recapture doctrine; despite the trend in the "recent" Federal Circuit decisions to expand the snare.²⁵³

It is the authors' position that if the purpose of the reissue is to be served, the Federal Circuit should uphold the lower tribunal decisions. As discussed below, it is believed that the lower tribunal decisions are fair and consistent with the principle of permitting correction of an honest mistake by way of honest, i.e., equitable, correction. If, on the other hand, the Federal Circuit adheres to an inflexible "wooden rule," whereby a relied-upon limitation can *never* be omitted/broadened in reissue claims, the purpose of reissue would not be accomplished; since the equities of the specific fact situations would not be fairly considered in the court's administration of the remedial reissue statute. As mentioned above, it is not the purpose of recapture to prevent correction of an honest mistake by way of an honest correction, and it is hoped that the Federal Circuit will not extend the recapture doctrine beyond its purpose.

C. *Is the Equitable Purpose of the Reissue Statute Being Served by the Recapture Doctrine?*

One final matter to be addressed is the recapture package provided by the Federal Circuit and lower tribunal case law. Is the current composite recapture package, including the lower tribunal gloss,²⁵⁴ a fair package? Does the recapture doctrine, as it is cur-

²⁵³ With respect to Board of Patent Appeals and Interferences' decisions, it is possible that the Federal Circuit will give some deference to the Patent Office's interpretation of the law that it administers; however, past history shows that this is often not the case. *See Dethmers Mfg. Co., Inc., v. Automatic Equip. Mfg. Co.*, 272 F.3d 1365 (Fed. Cir. 2001) *reh'g and reh'g. en banc denied*, 293 F.3d 1364 (Fed. Cir. 2002), *cert. denied*, 123 S. Ct. 2637 (2003). The Patent Office's acceptance of applicant's "fix" to a reissue declaration as satisfying its own regulations was not accepted by the Federal Circuit, and the patent at issue was invalidated for failure to comply with a requirement of the Patent Office's regulations during the application process. The court refused to defer to the Patent Office's interpretation and application of its own regulation.

²⁵⁴ Until the fact-situations decided in the lower tribunals come before the Federal Circuit, the lower tribunal gloss on the recapture doctrine will presumably be followed. Thus, the lower tribunal case law is considered to be a living part of the recapture package.

rently applied, serve the purpose of the reissue statute? A strong argument can be made that the answer is “yes.”

As to the threshold issue of what action by an applicant will generate a surrender of claim scope, the Federal Circuit stated in *Clement* that “[t]o determine whether an applicant surrendered particular subject matter, we look to the prosecution history for *arguments and changes to the claims made in an effort to overcome a prior art rejection.*”²⁵⁵ Thus, it is not necessary that applicant amended the claims to add a particular limitation X to define over the prior art; argument as to the criticality of limitation X in defining over the art will also result in a surrender. The Federal Circuit provided a holding to that effect in *Hester*, as pointed out above. It is submitted that this is eminently fair and equitable. It should not matter how applicant’s reliance on a particular limitation X to define over the art is manifested, as long as there was reliance. No equitable reason to make a distinction as to the way the reliance is manifested can be envisioned, and it is submitted that nothing more be said on the matter.

As to the nature of surrendered claim subject matter that cannot be recaptured, this is more complicated. It is clear from all the Federal Circuit decisions thus far that a key limitation, i.e., a limitation relied-upon in the original patent to define over the prior art, cannot simply be omitted or replaced with anything, as was the case in *Hester*. This is so because the patent owner should have appealed (in prosecuting the original application) the claims not having the key limitation, if protection was truly desired for the same. This is a case of deliberate surrender of claim subject matter without any inadvertence or mistake. The patent owner knew what he was doing, and made an informed choice. If, on the other hand, the patent owner omits a key limitation in the reissue, but gives us some narrowing in replacement for the key limitation, then equities come into play, and we must examine and evaluate the nature of the “mistake” being corrected.

In *Mentor*, the Federal Circuit taught us that where the replacement for the omitted limitation is not a material replacement, recapture has *not* been avoided. This position appears to be quite reasonable, because the patent owner is not truly narrowing the patent claim in return for the critical broadening. Providing a claim “narrowing,” which is cosmetic or inherent is an attempt to make an “end run” around the reissue statute, and to thereby re-

²⁵⁵ *Clement*, 131 F.3d 1464, 1469 (emphasis added).

cover patent scope deliberately given up based on an informed decision of the patent owner.

In *Pannu*, the Federal Circuit taught us that where a replacement limitation of the claims falls short of providing sufficient *quid pro quo* to substitute for the key limitation omitted, recapture has *not* been avoided. This position also appears reasonable, in that a patent owner should not be permitted to shed a critical limitation without giving something of equal value in return.

In *Clement*, the patent owner eliminated limitations relied upon in the original patent to define over a rejection based on reference A, and tried to replace it with a limitation directed to a rejection based on reference B applied in the original prosecution. This replacement also should not avoid recapture, because it still does not address the omitted limitations directed to reference A, and the one narrowing limitation added (to address reference B) clearly does not counter-balance the reissue claim limitation omissions from the patent claims.

In *Clement*, the patent owner also argued that the key limitation could be eliminated, as long as the limitations of the earlier versions of the claims were still present. However, the retention of the limitations of the earlier claim versions does not address the damage that the patent owner has done by eliminating the key limitation, and thus, it rightly should not avoid recapture.²⁵⁶

On the other hand, in *Ball*, the replacement for the omitted key claim limitation was extensive and detailed, and it was appropriately found to provide sufficient pay-back for the omitted limitation to avoid recapture. Thus, if *Ball* has not been overruled (and a strong argument has been made to that effect above), a reasonable balancing is being applied, where the patent owner is providing us with a true *quid pro quo*. This would fit nicely with the *Clement* court's statement that "on balance," the reissue claims of *Clement* were broader than they were narrower "in a manner directly pertinent to the subject matter" that was surrendered in the original prosecution.²⁵⁷ The statement implies that if the *Clement* court had weighed the material claim narrowing and broadening and had

²⁵⁶ In essence, *Clement* held that recapture was not avoided by the patent owner's narrowing of an earlier version of the claim if the later version of the claim is still broadened, because the matter of the later version that was *intentionally* surrendered cannot be omitted. Likewise, recapture was not avoided by patent owner's narrowing of a later version to address rejection B, because the limitation that was added to define over rejection A resulted in an *intentional* surrender and was omitted, and adding the limitation directed to rejection B does not, at all, address the elimination of what was added to define over rejection A. The patent owner could not, in either situation, ignore the original surrender and turn to a new area that is not so important.

²⁵⁷ *Clement*, 131 F.3d at 1471.

found multiple/extensive narrowings to outweigh the broadening, there would have been *no* recapture, as there was none in *Ball*.

Next, in looking at the Federal Circuit decisions that found recapture to be present, we may observe that in *Pannu*, *Hester*, *Clement*, and *Mentor*, a key limitation relied upon to define over the art was *eliminated in its entirety*. This leaves unanswered the question of whether recapture would still be present where the key limitation is not eliminated in its entirety, but rather broadened. Turning to the lower tribunals, the BPAI provided its answer to the question in *Eggert*. The BPAI held that where the previously relied-upon key limitation was not eliminated, but rather broadened, the surrendered subject matter was not considered to have been recaptured.

In the *Eggert*-type situation, the patent owner added a limitation Q to define over the art, and the patent owner did *not* abandon limitation Q in favor of another limitation X. Thus, we need not make an analysis to see if a newly added limitation X is cosmetic or material, nor need we determine whether the patent owner is giving us something of value in return for abandoned limitation Q. In this instance, the owner is not trying to “switch horses,” but rather is simply broadening limitation Q to Q_{broadened}, and Q_{broadened} still does define over the art. In the prosecution of the patent, the owner looked at the art of record, and determined that limitation Q was needed to define over the art, so he added limitation Q to the claims. The owner, however, made an honest mistake as to how specific to make limitation Q when he added it. In keeping with the remedial nature of reissue, the owner should be able to rectify that mistake via reissue. Since the claims define over the art with either Q or Q_{broadened}, this situation is no different than any case of reissuing a patent claim where a patent claim limitation was inadvertently made too narrow (in the original prosecution). Correcting the unduly narrowed scope of limitation Q has nothing to do with recapture, but is rather a matter of correcting an inadvertent wrong choice by the patent owner.

The *Eggert* result should be examined for its consequences to the public. It was pointed out above that the applicant in the prosecution of an application for a patent makes an informed decision when adding a key limitation (chosen by applicant) to the claimed subject matter in order to define over the prior art of record. That decision by applicant is not error, and the public is entitled to rely on that decision, to the extent that a patent owner cannot, by reissue, remove or eliminate the key limitation. However, if the patent owner does not entirely remove the key limitation, but rather retreats to a broadened version of the key limitation as in *Eggert*, then

the claims still retain, in some form, the basic limitation added to obtain the patent.

Where the key limitation *is entirely eliminated* via reissue, the public may not be expected to envision (1) the complete elimination of the critical limitation, and (2) what other limitation (unrelated to the key limitation) might be substituted to define over the prior art, while otherwise retaining the essence and focus of the claimed invention. On the other hand, if a broadened form of the key limitation remains, the public may reasonably be expected to realize that the applicant could have relied on a broader form of the critical key limitation to obtain the patent,²⁵⁸ and thus be careful to not include broadened variations of that critical limitation in any research they are conducting. While there may be a number of broadening variations that could be placed in the reissue claims, these variations do not provide the onerous task of anticipating entirely new limitations where the key limitation is omitted. On balance, it seems fair to permit the patent owner to broaden the key claim limitation to the extent permitted by the prior art, especially when third parties' intervening rights under 35 U.S.C. § 252 are taken into account. Thus, *Eggert* appears to be a fair next step after the recent Federal Circuit decisions.²⁵⁹

As to the U.S. Court of Federal Claims' decision in *B.E. Meyers & Co. v. United States*, if the original patent contains multiple embodiments/inventions, it seems fair that the public be on guard for reissue correction of the patent to newly add a previously unclaimed embodiment/invention to thereby obtain protection for same. Adding a different invention (e.g., new embodiment or species) via reissue was expressly approved by the Federal Circuit in *Amos and Doyle*,²⁶⁰ and as such, is to be anticipated as a viable possibility. If the unclaimed different invention is then added (i.e., newly claimed) via reissue, it obviously will omit the limitation added to narrow the first invention, since the content of the newly claimed invention is different in nature than the first invention and relies on a different way of accomplishing the inventive concept that does not use the limitations of the first invention that was narrowed.

On the assumption that *Ball* stands for the proposition that

²⁵⁸ The patent file wrapper is available to the public to resolve any question as to this.

²⁵⁹ It is noted that *Eggert* included a discussion (limiting the finding of recapture to relying on the "cancelled claim" comparison test only) that would permit substitution of a totally unrelated limitation for the omitted key claim limitation, and that discussion of the BPAI would run contrary to what has just been stated. That discussion in *Eggert*, however, was dicta, and its consequences to the public need not be evaluated.

²⁶⁰ See supra Part VI.B.2.

the key limitation can be entirely eliminated if the replacement limitation provides sufficient *quid pro quo*, *Meyers* presents a very clear and favorable case of this because of the entirely new focus provided by the claims added by reissue. Even if *Ball* does not stand for this proposition, it is believed that the Federal Circuit will not find recapture in this scenario, because it is not fair to preclude a patent owner from adding a different invention via reissue, simply because he had to amend the first invention to avoid the art in the original application. To illustrate, assume there was claim narrowing as to aspect X of an invention/embodiment A (to avoid the prior art), and the patent owner now wishes to correct the patent by adding a different invention/embodiment B, that does not, and should not, include aspect X due to the nature of invention/embodiment B. Given the nature of invention/embodiment B, aspect X may very well be completely out of place in invention/embodiment B. It would be an exercise in futility to say that patent owner cannot correct the patent to include invention/embodiment B without also adding aspect X that cannot be fit into invention/embodiment B. It would simply not be fair to shut out the patent owner from adding an unrelated invention/embodiment, just because some unrelated surrender was made in the different invention of the patent.

In addition to the fairness issue, the public would never have expected patent owner to have included aspect X in the newly added invention/embodiment B (because aspect X would not fit into invention/embodiment B), and thus the public could not have relied to its detriment on such an inclusion. In *Doyle*, the Federal Circuit stated that:

[t]he public knows, or should know, that an issued patent can be broadened by reissue during a two-year period following issuance. The public is therefore on notice that at least some matter can be 'dedicated to the public' in error, and that the error, if caught in time, can be corrected by reissue. And if the patentee succeeds in obtaining a reissue that alters the scope of her right to exclude, then the public interest is protected through intervening rights.²⁶¹

The public is expected to be on guard for a reissue correction of the patent that is a fair correction of an honest mistake made it inadvertently not include an invention/embodiment different than that which was patented. Thus, it is right and equitable to

²⁶¹ In re Doyle, 293 F.3d 1355, 1364 (Fed. Cir. 2002).

permit the correction of the patent, and no one should be hurt by it. It would only be an inflexible “wooden” interpretation of the bar to eliminating the key limitation that could prevent this correction, and it is strongly believed that the Federal Circuit will not “go there” when faced with the issue.

Finally, as to the *Yamaguchi* decision of the BPAI, if an applicant is silent as to what is said by a patent examiner or a third party, it would be unfair to attribute any surrender to that silence, because it cannot be known what that silence is based upon. Such silence may be the result of simply overlooking the statement made by the examiner or third party, or its implications. Such silence may be the result of a decision to let the claims stand on their own merit, or stand on what an applicant has already stated to be the critical aspect. It would be unfair to make applicant provide an additional statement that could later prejudice the patent and could have far reaching consequences never envisioned. On the other hand, when the applicant does make a statement or a claim revision, then the applicant has the responsibility to analyze that statement/revision before it is made for the implications of the statement and potential consequences that may result.

The *Yamaguchi* decision also found that a general argument that merely states all the limitations of the claims to define over the prior art was not sufficient to establish recapture, since no measure of surrender could be gleaned from such a statement. This point is reflected in MPEP 1412.02,²⁶² which provides that where a limitation of the patent claims is omitted in the reissue claims, “[t]he argument that the claim limitation defined over the rejection must have been specific as to the limitation; rather than a general statement regarding the claims as a whole. In other words, a general ‘boiler plate’ sentence will not be sufficient to establish recapture.”²⁶³ As to this point of law, it appears quite reasonable to require, as a basis for surrender, that applicant’s argument provide some indication of what specific limitation(s), e.g., specific element or step of the claims, cooperative effect, or other aspect of the claims, are being relied upon for patentability. Otherwise, applicant has not surrendered anything.

1. The Recapture Doctrine, As It Is Currently Being Applied, Does Appear To Be Serving the Purpose of the Reissue Statute

Viewing the current recapture case law package in the context

²⁶² See MPEP, *supra* note 196, at 1400-14.

²⁶³ *Id.*

of the purpose of reissue, we can state the following. As pointed out above, public policy favors correction of an honest mistake made during the process of obtaining the protection to which a patent owner is entitled. The reissue statute embodies this policy. Thus, if an applicant looked for a way to define over the art of record in an application for patent, and he simply made *an honest mistake* as to what was the best way to accomplish that defining over the art, correction of that mistake should be permitted, and the case law should not hinder or thwart such correction. Further, if an applicant narrowed the scope of the claims in one area to define over the prior art, this should not prevent the patent owner from obtaining, via reissue, unrelated claims (e.g., to a different embodiment) which are not relevant to the narrowing, and which unrelated claims applicant inadvertently overlooked. On the other hand, if the applicant made an *informed* decision to surrender a scope of claim subject matter, the equities do not dictate permitting the applicant, after the patent is granted, to recover by reissue exactly what it surrendered to obtain the patent. Furthermore, if a patent owner is only willing to proffer a replacement narrowing that is cosmetic, or does not go to the heart of the invention, or that could never have survived the original examination, then the patent owner is not giving the public a true *quid pro quo* for his recovering the claim narrowing done in the original application, and again, equity does not favor permitting "correction" of the patent. The public is expected to be on guard for a reissue correction of the patent that is a fair correction of an of an honest mistake, not on guard for a reissue "correction" of a "mistake" deliberately made with a specific agenda, nor for a correction that really does not give up anything or is at best cosmetic.

The current recapture case law package appears to accomplish these principles and goals. Accordingly, it is submitted that the recapture doctrine, as it has been interpreted by the Federal Circuit and lower tribunals *thus far*, has served the purpose of the remedial reissue statute, and its principles of equity and fairness. To date, the recapture doctrine has been a valuable deterrent to prevent unwarranted use of reissue, and it deserves a prominent place in the patent case law.

ATTACHMENT: THREE CHARTS

CHART (1) - REISSUE RECAPTURE TABLE CHART -
FINDING RECAPTURE

Categories	#1	#2	#3	#4	#5	#6	#7	#8	#9
Reissue claims are:	Byers	N/A ^A	Eggert ^B	TBD ^C	Clement	Mentor	Meyers ^D	Ball	Pannu
1. Broader than patent claims	Y	Y	Y	Y	Y	Y	Y	Y	Y
2. Same/Broader (in all aspects) than canceled claims	Y	N	N	N	N	N	N	N	N
3. Broader than patent claims in area of surrender ^F		N	Y	Y	Y	Y	Y	Y	Y
4. Narrower than canceled claims in area of surrender ^F		Y	Y	Y	Y	N	N	N	N
—a. All relied-on limitations still in reissue claims, but in broadened form			Y	N	N				
—b. The relied-on limitations remaining in reissue claims are significant ^G				Y	N ^H				
5. Narrower than canceled claims in manner that is material ^I						N	Y	Y	Y
—a. Different Invention							Y	N	N
—b. Other sufficient narrowing to counter-balance broadening								Y	N
Is there recapture?	Y	N	N	N	Y	Y	N	N	Y

A. While no case is cited for this intuitively obvious category, the *Clement* court stated that “if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible . . .” 131 F.3d at 1470, 45 U.S.P.Q.2d at 1165.

B. BPAI decision.

C. To be determined (TBD) - At this time, there is no holding directly on point.

D. U.S. Court of Federal Claims decision.

E. This category includes the case where the reissue claims are broader than the patent claims in the area of surrender (*Pannu*), and certainly the case where the reissue claims are broader than the canceled claims (*Clement*).

F. Where there is no canceled claim, i.e., surrender is dependent on argument relying on a limitation to define over the art, the reissue claims must contain some remnant of the relied-upon limitation.

G. This requires that the limitation(s) - (a) must provide narrowing in the same area of surrender, and (b) must be significant in defining over the art directed to that same area of surrender.

H. In *Clement*, the narrowing was not provided in the same area of surrender; thus, the claims failed prong (a) of the above footnote and recapture was present. There is no case law yet for the failure of prong (b).

I. Where there is no canceled claim, i.e., surrender is dependent on argument relying on a limitation to define over the art, the limitation(s) added in the reissue claims in replacement for the relied-upon limitation must be material.

CHART (2) REISSUE RECAPTURE TABLE CHART - WEIGHT OF CLAIM SCOPE FACTORS

Categories	#1	#2	#3	#4	#5	#6	#7	#8	#9
Reissue claims are:	Byers	N/A ^A	Eggert ^B	TBD ^C	Clement	Mentor	Meyers ^D	Ball	Pannu
1. Broader than patent claims	+	+	+	+	+	+	+	+	+
2. Same/Broader (in all aspects) than canceled claims	+	-	-	-	-	-	-	-	-
3. Broader than patent claims in area of surrender ^E	+	-	+	+	+	+	+	+	+
4. Narrower than canceled claims in area of surrender ^F	+	-	-	-	-	+	+	+	+
—a. All relied-on limitations still in reissue claims, but in broadened form	+	-	-	-	+ ^H	+	+	+	+
—b. The relied-on limitations remaining in reissue claims are significant ^G									
5. Narrower than canceled claims in manner that is material ^I	+	-	-	-	-	+	-	-	-
—a. Different Invention	+	N/A	-	-	+	+	-	-	+
—b. Other sufficient narrowing to counter-balance broadening									
Choice of category 4 or 5	4/5	4/5	4/5	4/5	4/5	4/5	5	5	5
Total score	5	-3	-1	-1	1	3	-1	-1	1
Is there recapture?	Y	N	N	N	Y	Y	N	N	Y

Notes:

1. A plus is a factor contributing toward establishing a finding of recapture; a minus mitigates against it.
 2. A minus which contributes to avoiding recapture is counted once for the 2 indents which are both for narrowing the canceled claim in the *same* area of surrender, and once for the 2 indents which are both for *significant* narrowing. If either indent is minus, a minus is listed; only if both are plus, will a plus be entered.
 3. Use the better of categories 4 and 5 to avoid recapture, where there is a difference in result. Where it makes no difference, "4/5" is entered.
- A. While no case is cited for this intuitively obvious category, the *Clement* court stated that "if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible . . ." [131 F.3d at 1470, 45 USPQ2d at 1165].
- B. BPAI decision.
- C. To be determined (TBD) - At this time, there is no holding directly on point.
- D. U.S. Court of Federal Claims decision.
- E. This category includes the case where the reissue claims are broader than the patent claims in the area of surrender (*Pannu*), and certainly the case where the reissue claims are broader than the canceled claims (*Clement*).
- F. Where there is no canceled claim, i.e., surrender is dependent on argument relying on a limitation to define over the art, the reissue claims must contain some remnant of the relied-upon limitation.
- G. This requires that the limitation(s) - (a) must provide narrowing in the same area of surrender, and (b) must be significant in defining over the art directed to that same area of surrender.
- H. In *Clement*, the narrowing was not provided in the same area of surrender; thus, the claims failed prong (a) of the above footnote and recapture was present. There is no case law yet for the failure of prong (b).
- I. Where there is no canceled claim, i.e., surrender is dependent on argument relying on a limitation to define over the art, the limitation(s) added in the reissue claims in replacement for the relied-upon limitation must be material.

