

## *In re McDonald*, 43 F.4th 1340 (Fed. Cir. 2022) (Newman, Stoll, [Cunningham](#))

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In 2008, McDonald filed a patent application for methods and systems related to the display of primary and secondary search results in response to search queries. The examiner rejected McDonald's original application as being directed to patent ineligible subject matter under § 101. To overcome this rejection, McDonald amended the claims to add a "processor" to certain claim limitations. As a result, the examiner withdrew the § 101 rejection and the application issued as the '901 patent. While prosecuting the '901 patent, McDonald filed a continuation application, which ultimately issued as the '111 patent. The claims in the application also recited a "processor" limitation like the limitation added to the '901 patent to overcome the § 101 rejection.

In 2015, McDonald filed a reissue application for the '111 patent, seeking to broaden the claims by amendment. Some of those amendments included deletion of the "processor" limitations. In parallel, McDonald filed a reissue declaration, stating that there is "at least one error in the original patent by reason of the patentee claiming less than he had the right to claim." McDonald pointed to the "processor" limitations as the "error," explaining the "processor" limitations as "unnecessary to the patentability and operability of the inventions."

The Board rejected McDonald's reissue application claims as obvious and on two additional grounds: (1) the reissue claims were based on a defective reissue declaration lacking an error correctable by reissue; and (2) the reissue claims were an attempt to recapture subject matter that was surrendered during prosecution to obtain the original claims. McDonald appealed.

A patentee may seek reissue of a patent if she claimed less than she had the right to claim in the original patent due to error and without deceptive intent. However, the patentee cannot "recapture" subject matter that was surrendered during prosecution of the patent—or

The Federal Circuit determined that the recapture rule applies to amendments made to overcome § 101 rejections.

during the prosecution of related patents—to obtain the original claims. These rules, known as the reissue and recapture rules, strike a balance between the competing interest of allowing a patentee to correct errors of inadequate claim scope with the public interest in relying on a patent's prosecution history.

On appeal, the Federal Circuit held that the prosecution history of the '111 patent family showed that McDonald deliberately added the "processor" limitation to overcome a § 101 rejection and obtain the '901 patent claims. Accordingly, the amendment was not made "through error" and McDonald could not recapture claim scope he intentionally surrendered. See 35 U.S.C. § 251. The recapture rule prohibited McDonald from broadening claim scope by removing the "processor" limitations.

The court further clarified that the public interest in relying on the patent's public record is not limited to subject matter surrendered in light of §§ 102 and 103. The interest also extends to § 101 rejections: "The well-tailored scope of our prior decisions and the fact that many of our prior cases involved prior art rejections do not expressly preclude the application of the recapture rule to amendments made for other reasons."

Finally, the court addressed McDonald's defective declaration, noting that the so-called error could not be rectified by reissue because correcting the error—the alleged uselessness of the "processor" limitation—would violate that recapture rule.