

'Recapture' Pitfalls To Avoid During Patent Reissues

By **James Buchanan and Ross Hicks** (May 22, 2019, 1:19 PM EDT)

Reissue is a valuable tool for innovators to retailor the scope of a patent's claims to cover aspects of the invention the patentee may not have appreciated at the time of filing or during prosecution of the application.

As an innovator's market expands, these additional aspects of the invention may become apparent and may be exploited by later entrants to the market. Reissue permits patentees to correct "errors" in the original patent, including claiming more or less than the patentee was entitled to claim.

For example, if the patentee becomes aware of prior art that may impact the validity of the claims, the patentee can use reissue to amend the claim scope to avoid the newly discovered prior art. In some circumstances, reissue permits the patentee to expand protection to more broadly protect their invention. Thus, through reissue, innovators can improve the protection offered by their patent portfolio by broadening the scope of protection.

A broadening reissue takes two forms. The most straightforward form removes elements from the claims. For example, if the original patent claimed ABC, a broader reissue may claim AB. The second broadening form directs the claims to a different invention that was not originally claimed. These claims are generally described as those directed to "overlooked aspects" of the original disclosure. For example, the original patent may claim a mechanism for securing elevator doors, but may have overlooked claims directed to the elevator that includes the mechanism.

While reissue is an important tool for innovators to protect their invention from later arriving competitors, innovators should be aware of pitfalls that may be encountered during a broadening reissue. The most important consideration is the rule against recapture. This rule can be the harshest when a restriction requirement was issued during prosecution of the original application.

The Rule Against Recapture

The rule against recapture is a doctrine grounded in equity that prohibits the patentee from recapturing subject matter surrendered during original prosecution of the application. Put differently, the rule



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against recapture prohibits a patentee from recapturing, through reissue, “the subject matter that he surrendered in an effort to obtain allowance of the original claims.”[1]

The recapture analysis is premised on the prosecution of the original claims. Where, during prosecution of the original application, the applicant “clearly and unmistakably argue[d] that [the claimed] invention does not cover certain subject matter to overcome an examiner’s rejection based on prior art,”[2] the patentee is barred from pursuing claims that would otherwise cover that subject matter. Because the doctrine of recapture looks to the prosecution history of the original patent, the reissue Applicant needs to consider all the amendments and statements made during prosecution of the original patent.

The U.S. Court of Appeals for the Federal Circuit has set forth a three-step analysis to determine if the claims of a reissue application impermissibly recapture subject surrendered during prosecution. The three part analysis requires determining:

1. whether the reissue claims are broader in scope than the original patent claims;
2. whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution of the application; and
3. whether the surrendered subject matter has crept into the reissue claims.[3]

When facing a recapture rejection based on amendments or statements made during the prosecution of the original application, the reissue applicant needs to first consider whether the statement or amendment “clearly and unmistakably” disavowed patent scope. Most often this involves the applicant characterizing aspects of the prior art when responding to a rejection during prosecution of the original application. If the prior statement did not clearly and unmistakably state that the claims of the original application did not cover certain subject matter, the U.S. Patent and Trademark Office examiner’s recapture rejection may not be proper.

Additionally, examiners often assume that if claim elements added during prosecution of the original application are not present in the claims of the reissue application, the reissue claim violates the rule against recapture.

When facing this type of rejection, a reissue applicant should consider walking the examiner through the claims to show that the allegedly surrendered subject matter has not “crept” back into the reissue claims. While this inquiry is factual and specific to the claims at issue, this may involve showing the examiner that the same relationship between claim features exists in both the reissue claims and the original claims.

For example, if, during prosecution of the original application, the original applicant argued that the prior art does not show the claimed feature “A is located in the same plane as B,” an argument that the reissue claims — even if phrased differently — that also locate A in the same plane as B, should demonstrate that the allegedly surrendered subject matter has not crept into the reissue claims.

In addition to arguments or amendments made during prosecution of the original application, the rule against recapture also applies to claims restricted during prosecution of the original application.

Restriction in the Original Patent

If a restriction requirement was issued during prosecution of the original patent and the applicant failed to file a divisional application directed to the restricted invention, a reissue applicant cannot pursue claims directed to the restricted invention through reissue. This doctrine has its roots in *In re Orita*.^[4]

In *Orita*, the examiner required restriction in the original application between two sets of claims pursuant to § 121. The applicant elected one of the claim sets and the patent issued with the elected claim set. However, the applicant did not file a divisional application directed to the other, nonelected claim set.

Within two years, the applicant filed a reissue application “presenting therein the three compound claims of [the applicant’s original] patent and four additional claims substantially identical to the originally non-elected claims.”^[5] Through reissue, the applicant attempted to pursue claims directed to the nonelected claim set. The court held that the applicant’s failure to file a divisional application directed to the nonelected claim set did not establish error under § 251 sufficient “to justify granting a reissue patent containing claims substantially identical to those originally non-elected in” the original application.^[6] The *Orita* doctrine is thus limited to those “claims substantially identical to those originally non-elected in” the original application.^[7]

In *Ex parte Okamoto*, the examiner stated that “[t]he claims presented in the instant reissue application are drawn to the [sic, a] combination of one of the nonelected species (from the original election requirement) together with a carrier in a chromatographic column.”^[8] The examiner went on “to state that this original election requirement is tantamount to a restriction requirement for the instantly claimed combination and by not filing a divisional application, appellants had intentionally surrendered such claimed subject matter.”

The USPTO Patent Trial and Appeal Board reversed the examiner.^[9] The board noted that in the original application there was “no formal restriction requirement of claims drawn to a combination of a separating agent and a chromatographic column” — the two inventions sought to be patented through reissue — “was ever imposed by the examiner, or acquiesced by the appellants, since they were not presented in the appellants’ original application.”^[10] Therefore, according to the board, “it cannot be argued that the appellants’ failure to file a divisional application to such subject matter was a deliberate act and not an error under Section 251.”^[11]

The board also noted that § 251 is a “remedial statute which must be interpreted liberally” and “decline[d] to extend any per se or mechanical rule against reissue where the claims cover ‘statutorily different’ subject matter which have not been formally restricted or cancelled” in the original application.^[12]

Overlooked Aspects

Importantly, the rule against recapture does not apply to claims directed to overlooked aspects of the original disclosure. “Claims to separate inventions/embodiments/species that were disclosed but never covered by the claims in the original application prosecution are claims to overlooked aspects.”^[13] An “overlooked aspects” reissue claim is directed to “a separate invention or separate species or embodiment that was not covered by a claim (e.g., a generic claim) at any point during the prosecution of the original application.”^[14] Reissue claims directed to “overlooked aspects” of the invention are

“not subject to recapture” because they are, “by definition, unrelated to subject matter that was surrendered during the prosecution of the original application.”[15]

However, some examiners are of the position that if a restriction requirement or election of species was issued during prosecution of the original application, the patentee is subsequently barred from claiming “overlooked aspects” of the disclosure, even if those inventions were not related to the restricted inventions.[16] Although there appears to be no support for this position in case law, it is something that all reissue applicants should be prepared to address where there is a restriction requirement in the original patent.

Conclusion

Reissue is a valuable tool for innovators. Before filing for a reissue, however, patentees should consider the prosecution of the original patent to ensure that the subject matter they seek to protect will not violate the rule against recapture.

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[1] In re Clement, 131 F. 3d 1464, 1468 (Fed. Cir. 1997); see also In re Mostafazadeh, 643 F. 3d 1353, 1358 (Fed. Cir. 2011). Hester Industries, Inc. v. Stein, Inc., 142 F. 3d 1472, 1481 (1998) (citing Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 137 L.Ed.2d 146 1040 (1997)). (“[T]he recapture rule is based on principles of equity and therefore embodies the notion of estoppel. . . 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.”)

[2] MBO Laboratories, Inc. v. Becton, Dickinson & Co., 602 F.3d 1306, 1314 (Fed. Cir. 2010).

[3] In re Clement, 131 F. 3d at 1468-69; North American Container, Inc. v. Plastipak Packaging, Inc., 415 F. 3d 1335, 1349 (Fed. Cir. 2005); Pannu v. Storz Instruments, Inc., 258 F. 3d 1366, 1370-71 (Fed. Cir. 2001).

[4] In re Orita, 550 F. 2d 1277, 1280 (CCPA 1977).

[5] Id. at 1279.

[6] Id. at 1281.

[7] See Doyle, 293 F. 3d at 1361.

[8] Ex Parte Okamoto, Appeal No. 2000-000132 at p. 6 (BPAI 2002).

[9] Id. at p. 8.

[10] Id. at p. 7.

[11] Id.

[12] Id. at pp. 7–8.

[13] MPEP § 1412.01(II).

[14] Id.

[15] Id. (emphasis in the original).

[16] See e.g., Prosecution of Application No. 15/426,165, Final Rejection Mailed April 9, 2019 and Interview Summary mailed May 2, 2019.