

## Federal Circuit Ruling Clarifies Recapture Rule For Reissue Claims Of Intermediate Scope

On May 8, the Federal Circuit in *In re Youman*, No. 2011-1136, 2012 WL 1598089, clarified years of recapture law by vacating a decision of the Board of Patent Appeals and Interferences that rejected reissue claims being pursued by a Ropes & Gray client. The decision should significantly change how certain types of “intermediate scope” reissue claims are examined by the Patent Office.

### Background

The Recapture Rule generally prevents a patent owner from reissuing a patent to claim subject matter that was deliberately surrendered during the original prosecution. The Recapture Rule involves a three-step analysis: (1) determine whether and in what aspect the reissue claim is broader than the patent claim; (2) determine whether the broader aspects of the reissue claim relate to surrendered subject matter; and (3) if the reissue claim is broader relative to the patented claim in a manner related to the surrendered subject matter, determine whether the surrendered subject matter has crept back into the reissue claim. If the answer to the last question is “yes,” the Recapture Rule bars the reissue claim.

Impermissible recapture typically occurs when a patent owner, on reissue, attempts to remove entirely a claim limitation that was added or argued during the original prosecution to avoid prior art. Sometimes, however, a patent owner realizes that a claim in an issued patent was inadvertently narrowed too much during prosecution. In such a case, the patent owner might desire to reissue the patent to modify the added limitation to broaden it to some extent, but not eliminate it entirely. The result would be a claim that is intermediate in scope between the original patent application claim before the overly narrow limitation was added, and the claim as it issued in the original patent with the overly narrow limitation.

In years past, following the reasoning of *In re Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003), the Patent Office allowed reissue claims of intermediate scope. The Recapture Rule as applied to such claims was embodied in Section 1402.02(I)(C) of the Manual of Patent Examining Procedure (“MPEP”) (8<sup>th</sup> ed., rev. 5, Aug. 2006), which stated:

*if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. Ex Parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel," the reissue claim may not be rejected on recapture grounds.*

In 2008, however, the Patent Office promulgated a new rule that *per se* precluded any intermediate broadening on reissue of a claim limitation that, during the original prosecution, had been added to avoid the prior art. This new rule was based on the Patent Office’s reading of *N. Am. Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335 (Fed. Cir. 2005). The new rule, § 1402.02(I)(C) (8<sup>th</sup> ed., rev. 7, July 2008), stated in relevant part that “[if surrendered subject matter ... has been **in any way** broadened in a reissue application claim, then a recapture rejection under 35 U.S.C. § 251 is proper” (emphasis added).

### Youman’s Reissue Claims

In *Youman*, the patent owner sought to reissue a claim for an electronic television programming guide that had

originally recited, in pertinent part, a “selection means for allowing said user to select a title for display on said television receiver by selecting the first n characters of said title.” Following a prior art rejection, the applicants amended the claim to recite the selection means, “said selection means comprising means for causing each of said n characters to *cycle forward and backward* through a plurality of alphanumeric characters.” 2012 WL 1598089, at \*2 (emphasis added). The claims issued with this “cycling” limitation.

On reissue, filed for within the two year window for a broadening reissue, the patent owner sought a claim with a modified form of the cycling limitation. Specifically, the cycling limitation was modified to include a “changing” limitation, which read as follows: “*changing* from a first character to a second character.” *Id.* at \*3 (emphasis added).

### The PTO’s and Board’s Decisions

The Patent Office rejected Youman’s “changing” claim as an improper recapture of surrendered subject matter, and the Board affirmed. Relying on *N. Amer. Container* and the 2008 version of the MPEP rule, the Board applied the three-part recapture test and held that, because the reissue claim broadened the “cycling” limitation in the patented claim to an intermediate scope, it constituted an impermissible recapture of surrendered subject matter.

In so doing, the Board articulated the last step of the recapture analysis as allowing a reissue claim to escape the recapture only if the claim included a narrowing limitation directed to one or more overlooked aspects of the invention. As none of the other changes made to the claim on reissue that narrowed the claim were directed to overlooked aspects of the invention during prosecution, the Board affirmed the PTO’s rejection. Youman appealed to the Federal Circuit.

### The Federal Circuit’s Decision

The Federal Circuit reversed and remanded.

Rejecting the essentially *per se* rule against intermediate-scope reissue claims applied by the Board, the Federal Circuit held that “if the patentee modifies the added limitation such that it is broader than the patented claim yet still materially narrows relative to the original claim, the recapture rule does not bar reissue.” 2012 WL 1598089, at \*9. With respect to the Board’s reliance on *N. Am. Container* and on the 2008 version of the MPEP rule prohibiting reissue if a limitation added to avoid prior art during the original prosecution is “in any way broadened” on reissue, the Court said such reliance was “misplaced” and “inappropriate.” *Id.* at \*7.

The Federal Circuit went on to hold that “[I]n the case at bar, ... the Board has already determined that the added limitation – cycling – has not been eliminated; rather, it has been broadened to changing. Such modification does not instantly implicate the recapture rule bar, as the Board held; rather, such a broadening modification must be evaluated to determine if it materially narrows relative to the original claim such that surrendered subject matter is not entirely or substantially recaptured.” *Id.* at \*7 (citation omitted).

New York-based IP litigation partner [Laurence S. Rogers](#) obtained this significant decision. In an interview, Rogers told [Law360](#) “the decision should come as welcome news to those patent owners who are seeking to reissue their patents to obtain claims of intermediate scope, because of an error made during the original prosecution that inadvertently overly narrowed a claim.”

Please contact any Ropes & Gray attorney with whom you regularly work if you have any questions or would like to discuss this development.