

The opinion in support of the decision being entered today is
not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM P. APPS and GABRIEL A. GURRA

Appeal 2005-0801
Application 09/848,628¹
Technology Center 3600

ON BRIEF

Before: GARRIS, McQUADE, JERRY SMITH, FRANKLIN, and
MacDONALD Administrative Patent Judges.

PER CURIAM

DECISION ON APPEAL

AFFIRMED

¹ Application filed May 3, 2001, seeking to reissue U.S. Patent 5,899,468, issued May 4, 1999, based on application 08/887,238, filed July 2, 1997. The real party in interest is Rehrig Pacific Company, Appeal Brief (filed November 12, 2002), page 1.

A. INTRODUCTION

1. Appellants appeal from a final rejection entered April 17, 2002.
2. The reissue application on appeal seeks to reissue U.S. Patent 5,899,468, issued May 4, 1999, based on application 08/887,238, filed July 2, 1997.
3. The reissue application contains claims 1-13.
4. Claims 8-13 have been rejected under 35 U.S.C. § 251 on the grounds that these claims seek to recapture subject matter surrendered when the patent sought to be reissued was granted.
5. Claims 8-13 have also been rejected under 35 U.S.C. § 103 on the grounds that these claims are unpatentable over U.S. Patent 5,031,796, to Schafer et al. (Schafer) in view of U.S. Patent 3,342,368, to Matry.
6. Claims 1-7, the remaining claims, have been indicated as being allowable.
7. Appellants filed an Appeal Brief (the Brief) on November 12, 2002, a Reply Brief (the Reply) on January 29, 2003, and a Supplemental Reply Brief (the Supplemental Reply) on May 3, 2004.
8. The first issue before the Board is whether Appellants have established that the Examiner erred in rejecting claims 8-13 based on recapture.

9. The second issue before the Board is whether Appellants have established that the Examiner erred in rejecting claims 8-13 under 35 U.S.C. § 103.

B. FINDINGS OF FACT

The following findings of fact are believed to be supported by a preponderance of the evidence.

THE INVENTION

1. The invention relates to a wheeled waste cart, which allows air circulation in through lower vents, up through a hinged perforated false bottom, and out the top of the cart through a hooded vent in a hinged lid (U.S. Patent 5,899,468, at Col. 1, ll. 37-42).

2. The invention can be understood by reference to Figures 1 through 6 of the drawings of U.S. Patent 5,899,468, which are reproduced in Appendix 1 of this opinion.

3. Fig. 1 is a perspective view of the waste cart **20** including a hollow body **22**, an upper end **32**, a lid **40**, vents **50** near a base **24**, vents **52** in the upper end **32**, and hooded lid vent **54** in the lid **40**, according to the present invention (Col. 2, ll. 26-46).²

² We note that column 2, line 36, states that “[t]he body 22, also includes a lid 40” whereas the claims all recite that the body and lid are separate parts of the cart 20. Given that a reasonable artisan could interpret the body and lid in the figures as “separate parts.” We will treat column 2, line 36, as a typographical error which should read “The cart 20, also includes a lid 40.”

4. Fig. 2³ is a partial cross sectional view showing the interior details of the cart **20** of FIG. 1 (Col. 2, ll. 13-14).

5. Fig. 2 shows a false bottom or drying plate **56** having perforations **58** (Col. 2, ll. 47-48). The false bottom **56** includes hinged pins **62** which engage suitable inner receptacles **63** so that the false bottom **56** can rotate upwardly (Col. 2, ll. 52-56). The false bottom **56** is supported from a bottom **59** by a plurality of plastic hollow cylinders **66** (Col. 2, ll. 59-60).

6. Fig. 3⁴ is a side cross sectional view through the cart **20** of Figs. 1 and 2 (Col. 2, ll. 15-16).

7. Fig. 3 shows a hooded lid vent **54** fitting into a vent hole **72** (Col. 3, ll. 7-8). The hooded lid vent **54** has an upper hood portion **76** defining a sideward facing opening **77** [misabeled in Fig. 3 as upper item **72**] and covering a perforated vent plate **78** positioned at about 45 degrees to normal horizontal in the opening **77** so that rain cannot pass through the perforated vent plate **78** (Col. 3, ll. 9-15).

8. Fig. 4⁵ is an exploded perspective view of the major components of the cart **20** of Figs. 1, 2, and 3 (Col. 2, ll. 17-18).

³ The labels for items 62 and 63 appear to be interchanged in Figure 2. Figure 3, Figure 4, and the detailed description each show item 62 as a pin rather than a receptacle.

⁴ Item 72 appears as the label for two distinct features on the lid 40 of Figure 3. The lower label 72 appears to be correct and the upper label 72 should read 77.

⁵ Item 80 appears as the label for two distinct features of Figure 4. The upper label 80 appears to be correct and the lower label 80 should read 50. Also, label 76 in Figure 4 should read 74 as it does in Figure 3.

9. Fig. 4 shows hollow body **22**, lid **40**, vents **50** near the base **24**, vents **52** in the upper end **32** [not labeled in Fig. 4], vent hole **72**, hooded lid vent **54**, perforated vent plate **78**, false bottom or drying plate **56**, a plurality of plastic hollow cylinders **66**, and pins **62**.

10. Fig. 4 also shows a reinforcing groove **85** in hooded lid vent **54** at a right angle to perforated vent plate **78**.

11. Fig. 5 is a front view of the detachable vent **54** of Figs. 1 through 4 (Col. 2, ll. 19-20).

12. Fig. 5 shows the reinforcing groove **85** in hooded lid vent **54** (Col. 3, ll. 29-31).

13. Fig. 6 is a side view of the vent structure of Fig. 5 (Col. 2, ll. 21).

14. Fig. 6 shows the hooded lid vent **54** having a plurality of “L” shaped retainer members **79**, a plurality of arrowhead shaped catch members **80**, all of which face outwardly to engage the lid **40**. The hooded lid vent **54** further includes an abutment surface **75** in contact with the surface while the “L” shaped retainer members **79** retain the vent **54** to the lid **40** and the catch members **80** allow the vent **54** to be snapped into place covering the vent hole **72** (Col. 3, ll. 18-25).

15. U.S. Patent 5,464,733, states three objects of the invention (*emphasis* added):

[It is] therefore [an] object of the invention to provide an improved organic waste cart, which can promote drying of organic

waste therein even in a relatively moist environment. (Col. 1, ll. 61-65)

Another object is to optimize the drying airflow from bottom to top in an organic waste cart. (Col. 1, ll. 66-67)

Another object is to *provide a hooded vent on the lid of a waste cart* amenable to automated pickup, which prevents rain from entering the cart through the lid. (Col. 2, ll. 1-3)

16. The objects of the invention in U.S. Patent 5,464,733, do not include any specific reference to a pivotable, perforated false bottom (such as item **56**) or a support member (such as item **66**) for the false bottom.

PROSECUTION HISTORY OF THE ORIGINAL APPLICATION

17. As noted earlier, the patent sought to be reissued was based on application 08/887,238, filed July 2, 1997 ("original application").

18. As filed, the original application contained claims 1-20. Claims 1, 11, and 17 are independent claims (claims 1 and 11 are reproduced below with reference numbers added). Claims 2-10, 12-16, and 18-20 depend therefrom respectively (claims 2, 3, 4, 6, and 7, are reproduced below with reference numbers added).

19. Claim 1 as originally filed reads as follows:

Claim 1 (as filed). A waste cart [20] that enables the drying of moist waste therein including:

- a hollow body [22] having:
 - a lower portion [which is not labeled];
 - an upper portion [32] defining:
 - an opening for loading and unloading waste from said hollow body [22]; and
 - at least one vent hole [50] in the lower portion; and
- a lid [40] for closing said opening for loading and unloading waste from said hollow body [22], said lid [40] including:
 - at least one lid vent [54 & 72] there through, whereby air can convect through said at least one vent hole [50] in said lower portion [32], through any waste contained in said lower portion [32], and out said lid vent [54 & 72] carrying moisture therewith.

20. Claim 2 as originally filed reads as follows:

Claim 2 (as filed). The waste cart [20] as defined in claim 1 wherein said at least one lid vent [54 & 72] includes:

- a vent hole [72] in said lid [40]; and
- a hood [54] covering said lid vent hole [72].

21. Claim 3 as originally filed reads as follows:

Claim 3 (as filed). The waste cart [20] as defined in claim 2 wherein said hood [54] covering said lid vent hole [72] includes:

- an abutment surface [75] for contacting said lid [40] about said lid vent hole [72];
- at least one L shaped retainer member [79] to hold said hood [54] to said abutment surface [75]; and
- at least [one] catch member [80] opposite said at least one L shaped retainer member [79] to releasably retain said hood [54] to said lid [40].

22. Claim 4 as originally filed reads as follows:

Claim 4 (as filed). The waste cart [20] as defined in claim 2 wherein said hood [54] covering said lid vent hole [72] includes:

- a generally horizontal hood portion [76];
- a sidewardly facing opening [77] in said hood [54] with respect to falling rain by said hood portion; and
- a perforated plate [78] covering said sidewardly facing opening [77].

23. Claim 6 as originally filed reads as follows:

Claim 6 (as filed). The waste cart [20] as defined in claim 4 wherein said hood portion [76] includes:

- a reinforcing groove [85] centrally located in said hood portion [76] at a right angle to said perforated plate [78].

24. Claim 7 as originally filed reads as follows:⁶

Claim 7 (as filed). The waste cart [20] as defined in claim 1 further including:

a perforated false bottom [56] positioned in said hollow body [22] above said at least one vent hole [50] in said lower portion [32] to allow air circulation under waste retained above said false bottom [56], wherein said at least one lid vent [54 & 72] includes:

- a vent hole [72] in said lid [40]; and
- a hood [54] covering said lid vent hole [72],

⁶ Claim 7 recites that various features are part of the lid vent hole [72] whereas claims 3 and 4 properly recite these same features as part of the hood [54] covering the lid vent hole [72]. Applicants have carried forward this problem uncorrected into patent claim 4 and reissue application claim 4.

said vent hole [72] including:

an abutment surface [75] for contacting said lid [40] about said lid vent hole [72];

at least one L shaped retainer member [79] to hold said hood [54] to said abutment surface [75]; and

at least [one] catch member [80] opposite said at least one L shaped retainer member [79] to releasably retain said hood [54] to said lid [40],

said lid vent hole [72] including:

a generally horizontal hood portion [76];

a sidewardly facing opening [77] in said hood [54] with respect to falling rain by said hood portion; and

a perforated plate [78] covering said sidewardly facing opening [77].

25. Claim 11 as originally filed reads as follows:

Claim 11 (as filed). A waste cart [20] that dries moist waste therein including:

a hollow body [22] having;

a lower portion [which is not labeled];

an upper portion [32] defining:

an opening for loading and unloading waste from said hollow body;

at least one vent hole [50] in the lower portion; and

at least one vent hole [52] in the upper portion [32]; and

a lid [40] for closing said opening for loading and unloading waste from said hollow body [22], said lid [40] including:

at least one lid vent [54] there through, whereby air can convect through said at least one vent hole [50] in said lower portion [32], through waste contained in the hollow body [22], and out said lid vent [54 & 72] carrying moisture therewith, whereby moisture does not accumulate under said lid.

26. Claim 12 as originally filed duplicates originally filed claim 2 above except that claim 12 depends from claim 11.

27. Claim 13 as originally filed duplicates originally filed claim 3 above except that claim 13 depends from claim 12.

28. Claim 6 as originally filed has the feature of:
a reinforcing groove [85] centrally located in said hood portion [76] at a right angle to said perforated plate [78].

29. Claims 3, 7, and 13, as originally filed each have the features of:
an abutment surface [75] for contacting said lid [40] about said lid vent hole [72];
at least one L shaped retainer member [79] to hold said hood [54] to said abutment surface [75]; and
at least [one] catch member [80] opposite said at least one L shaped retainer member [79] to releasably retain said hood [54] to said lid [40].

30. On January 26, 1998, the examiner entered a first Office action (the first action).

31. Dependent claim 6 was objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (First action, page 4).

32. Claims 1-5 and 7-20 were rejected under 35 U.S.C. § 103 as being unpatentable over the following prior art (First action, pages 2-4):

(1) Gebr Otto (Gebr), German Patent DE 4002174 C1
in view of
(2) Kuelmichel (Kuel), German Patent DE 3936099
A1.

33. Gebr and Kuel are prior art vis-à-vis applicant under 35 U.S.C. § 102(b).

34. The Examiner found that Gebr describes “in Figure 1 a compost waste trolley with vent hole (23) in its lower portion and lid (4).”

35. However, the Examiner found that Gebr “does not teach a lid vent.”

36. The Examiner further found that Kuel’s Figure 1 describes, in the same field of endeavor, “a collection apparatus with a lid (5) and vent (18).”

37. The Examiner held that:

It would have been obvious to one skilled in the art to have provided the Gehr device with a vent as taught by Kuel in order to provide it with additional air circulation means.”

38. The Examiner further noted:

With respect to Claims 3 and 13, Gebr does not teach [an] L shaped retainer member to hold a hood to an abutment surface for contacting the lid about the vent hole or a catch opposite the retainer. Kuel teaches a hinge or retainer which is L-shaped, as broadly recited and interpreted, which attaches hood (21) and lid (5). Opposite the L-

shaped retainer is a lid lip or catch (10) for releasably retaining the hood to the lid.

39. The Examiner held that:

It would have been obvious to one skilled in the art to have provided the Gehr organic waste container with [an] L-shaped retainer, catch, and hood as taught by Kuel in order to provide it with a means to releasably retain said hood with its lid.

40. On May 1, 1998, applicant filed an amendment responding to the Examiner's first Office action (Res. to first action).

41. As shown below, the amendment amended claims 1 and 7 ({curly brackets} indicate a deletion from the claim by Applicant, underline indicates an insertion into the claim by Applicant).

42. Claim 1 as originally filed was amended to include the limitations of claim 2 originally filed and claim 2 was cancelled. Claim 1 as amended reads as follows:

Claim 1. (Amended) A waste cart [20] that enables the drying of moist waste therein including:

- a hollow body [22] having;
 - a lower portion [not labeled];
 - an upper portion [32] defining:
 - an opening for loading and unloading waste from said hollow body [22]; and
 - at least one vent hole [50] in the lower portion; and
- a lid [40] for closing said opening for loading and unloading waste from said hollow body [22], said lid [40] including:
 - at least one lid vent [54 & 72] there through including:
 - a vent hole [72] in said lid [40]; and

a hood [54] positioned over said lid vent hole [72] to shield said vent hole from down falling moisture, whereby air can convect through said at least one vent hole [50] in said lower portion [32], through any waste contained in said lower portion [32], and out said lid vent [54 & 72] carrying moisture therewith.

43. Claims 3 and 4 as originally filed were amended to now depend from amended claim 1. Minor errors were also corrected.

44. Claim 7 as originally filed was amended to remove several limitations that were redundant to the features added to amended claim 1. Claim 7 as amended reads as follows:

Claim 7. (Amended) The waste cart [20] as defined in claim 1 further including:

a perforated false bottom [56] positioned in said hollow body [22] above said at least one vent hole [50] in said lower portion [32] to allow air circulation under waste retained above said false bottom [56], wherein { said at least one lid vent [54 & 72] includes:

a vent hole [72] in said lid [40]; and
a hood [54] covering said lid vent hole [72], }
said vent hole [72] including:

an abutment surface [75] for contacting said lid [40] about said lid vent hole [72];
at least one L shaped retainer member [79] to hold said hood [54] to said abutment surface [75]; and

at least [one] catch member [80] opposite said at least one L shaped retainer member [79] to releasably retain said hood [54] to said lid [40],
said lid vent hole [72] including:
a generally horizontal hood portion [76];
a sidewardly facing opening [77] in said hood [54] with respect to falling rain by said hood portion; and
a perforated plate [78] covering said sidewardly facing opening [77].

45. Additionally, the amendment cancelled allowable claim 6 and rewrote it as new independent claim 21.

46. With respect to new claim 21, applicant stated as follows:
New claim 21 includes the limitations of claims 1, 2, 4, and 6 as originally submitted. (Res. to first action 4)

47. With respect to amended claim 1 (combining originally filed claims 1 and 2), applicant stated as follows (**emphasis** added):

What the Examiner failed to recognize is that KUELMICHEL is a liquid collection container that is not supposed to vent any fumes ... Applicant's therefore do not understand the Examiner's position that it would be obvious to combine a side vented trash cart like GEHR with ... a container designed to "allow waste to drain under any surface scum and **not release fumes**" [like KUELMICHEL] as stated in the English abstract, to make obvious a trash cart that allows fumes (water [vapor]) to escape out its vented lid. (Res. to first action, page 5)

48. With respect to amended claim 3, applicant stated as follows (**emphasis** added):

The Examiner states that KUELMICHEL teaches a hinge or retainer which is L-shaped, as broadly recited and interpreted,

which attaches hood (21) and lid (5), and that opposite the L-shaped retainer is a lid lip or catch (10) for releasably retaining the hood to the lid. Assuming for the moment that the lid 20 is analogous to the hood of the claims and has an L shaped retainer, **Figure 5 [of Kuelmichel] shows that “hood 20” never touches “lid (5)” and therefor cannot attach thereto.** (Res. to first action 6)

49. On June 24, 1998, the examiner entered a Final Office action (the final action).

50. New independent claim 21 was indicated as allowable (Final action 3).

51. Dependent claims 3, 7-10, and 13 were objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (Final action 3).

52. With respect to dependent claims 3, 7-10, and 13, the Examiner stated:

The L shaped retainer member to hold the hood to its abutment surface could not be found in the available prior art. (Final action 3).

53. Amended claims 1 and 4-5, and originally filed claims 11, 12, and 14-20 were rejected under 35 U.S.C. § 103 as being unpatentable over the following prior art (Final action 2-3):

- (1) Schafer et al. (Schafer), U.S. Patent 5,031,796 in view of
- (2) Martin, Jr., (Martin) U.S. Patent 4,127,216.

54. Schafer and Martin are prior art vis-à-vis applicant under 35 U.S.C. § 102(b).

55. The Examiner found that Schafer describes, “in Figure 1 a waste cart having a hollow body, a lower portion, an upper portion, and at least one vent hole (15) in the lower portion, and a lid.” The Examiner further stated, “The Schafer lid has vent holes (21).”

56. However, the Examiner found that Schafer “does not teach a hood positioned over the lid vent hole(s) to shield the vent hole from rain.”

57. The Examiner further found that Martin ‘216 describes, in the same field of endeavor, “a tank or container having a vent hood (38) over a vent hole.”

58. The Examiner held that:

It would have been obvious to one of ordinary skill in the art to have modified the Schafer waste cart’s lid to have a hood over its vent holes as taught by Martine ‘216 to prevent contaminants from entering the container.”

59. On September 28, 1998, applicant filed an amendment responding to the Examiner's Final Office action (Res. to final action).

60. The amendment cancelled claims 1, 4, 5, 9, 11, 12, and 14-20.

61. Additionally, the amendment cancelled allowable claims 3, 7, and 13, and rewrote them as new independent claims 22, 24, and 25, respectively.

62. New depended claim 23 (from claim 22) as added which incorporated the feature of cancelled claim 4.

63. Dependent claims 8 and 10 as originally filed were also amended to now depend from new claim 25.

64. With respect to new claim 21, applicant stated as follows:
New claim 22 contains all of the limitations of original claims 1 and 3, new claim 23 contains all of the limitations of original claim 4 and depends on allowable claim 22, new claim 24 contains all of the limitations of original claims 1 and 7, and new claim 25 contains all of the limitations of original claims 11, 12, and 13. (Res. to final action, page 7-8)

65. The original application was then allowed.

66. Consistent with Office practice, the claims were re-numbered in the course of preparing the original application for issue, all as follows:

Chronological by original claim

<u>Original claim number</u>	<u>Patent claim as re-numbered</u>
1*	cancelled
2	cancelled
3	cancelled and rewritten as original claim 22
4	cancelled and rewritten as original claim 23
5	cancelled
6	cancelled and rewritten as original claim 21
7	cancelled and rewritten as original claim 24
8	6
9	cancelled
10	7
11*	cancelled
12	cancelled
13	cancelled and rewritten as original claim 25
14	cancelled
15	cancelled
16	cancelled
17*	cancelled
18	cancelled
19	cancelled
20	cancelled
21*	1
22*	2
23	3
24*	4
25*	5

* = independent claim

Chronological by patent claim

<u>Original claim number</u>	<u>Patent claim as re-numbered</u>
21	1
22	2
23	3
24	4
25	5
8	6
10	7

67. U.S. Patent 5,899,468, issued May 4, 1999, based on the original application and contained claims 1-7.

PROSECUTION OF REISSUE APPLICAITON

68. Applicant filed reissue application 09/848,628 on May 3, 2001 seeking to reissue U.S. Patent 5,899,468.

69. Applicant presented original patent claims 1-7 along with a preliminary amendment adding new reissue application claims 8-13 for consideration.

70. New reissue application dependent claims 9 and 10, depend from new reissue application independent claim 8. New reissue application dependent claims 12 and 13, depend from new reissue application independent claim 11.

71. New reissue application claim 8 is reproduced below
(reference numbers added):

Reissue Claim 8. A waste cart [20] that enables the drying of moist waste therein comprising:

a hollow body [22] having a lower portion, an upper portion [32] defining an opening for loading and unloading waste from the hollow body [22], and at least one vent hole [50] in the lower portion;

a pivotable, perforated false bottom [56] positioned in the hollow body [22] above the at least one vent hole [50] to allow air circulation under waste retained by the false bottom [56]; and

a support member [66] extending downwardly from a bottom surface of the false bottom [56], the support [66] having a length sufficient to contact a bottom portion of the waste cart [20] to hold the false bottom [56] generally parallel to the ground when the cart [20] is in a normal waste containing position, and positioned on the bottom surface of the false bottom [56] so that the support member [66] has clearance from an inner surface of the waste cart [20] when the false bottom is pivoted away from the bottom portion of the waste cart [20].

72. New reissue application claim 11 is reproduced below
(reference numbers added):

Reissue Claim 11. A waste cart [20] that enables the drying of moist waste therein comprising:

a hollow body [22] having an opening therein for loading and unloading waste from the hollow body [22];

a perforated false bottom [56] pivotably attached to the hollow body [22] and positioned to hold solid waste away from a bottom surface of the waste cart [20]; and

a support member [66] extending from a bottom surface of the false bottom [56], the support [66] having a length sufficient to contact a bottom surface of the waste cart [20] to hold the false bottom [56] generally parallel to the ground when the cart [20] is in a normal waste containing position, and positioned on the bottom surface of the false bottom [56] so that the

support member [66] has clearance from an inner surface of the waste cart [20] when the false bottom is pivoted away from the bottom surface of the waste cart [20].

73. Reissue application claims 1-7 have been indicated as allowable by the examiner and are not involved in the appeal.

74. New reissue application claims 8-13 are before the Board in the appeal.

75. The Examiner has rejected reissue application claims 8-13 under 35 U.S.C. § 103 as being unpatentable over the following prior art (Reissue application final office action dated April 17, 2002, pages 3-4):

(1) Schafer et al. (Schafer), U.S. Patent 5,031,796 in view of

(2) Matry, U.S. Patent 3,342,368.

76. Additionally, the examiner has rejected reissue application claims 8-13 under 35 U.S.C. § 251 maintaining that the claims seek to "recapture" subject matter surrendered in obtaining allowance of the claims which appear in the patent sought to be reissued.

77. The Examiner based the rejection under 35 U.S.C. § 251 of claims 8-13 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 103 over the Gehr and Kuelmichel prior art German patents applicants made a first significant amendment, and when faced in the original application with a rejection under 35 U.S.C. § 103 over the Schafer and Martin prior art patents, applicants made second and third significant amendments:

(1) First, applicants rewrote original application claim 6 as original application claim 21 to include the limitation of “a reinforcing groove [85] centrally located in said hood portion [76] at a right angle to said perforated plate [78]” (reference numbers added); application claim 21 ultimately became patent claim 1.

(2) Second, applicants rewrote original application claims 3, 7, and 13, as original application claims 22, 24, and 25, respectively, to include the limitation of “at least one L shaped retainer member [79] to hold said hood [54] to said abutment surface [75]” (reference numbers added); application claims 22, 24, and 25, ultimately became patent claims 2, 4, and 5, respectively.

(3) Third, applicants cancelled original application claim 9 which claimed “wherein said perforated false bottom is hingedly connected to said hollow body.”

EXAMINER'S REJECTION BASED ON PRIOR ART

78. The Examiner has rejected reissue application claims 8-13 under 35 U.S.C. § 103 as being unpatentable over the following prior art in Reissue application final office action dated April 17, 2002 (Reissue Final action 3-4):

- (1) Schafer et al. (Schafer), U.S. Patent 5,031,796 in view of
- (2) Matry, U.S. Patent 3,342,368.

79. Schafer and Matry are prior art vis-à-vis applicant under 35 U.S.C. § 102(b).

80. The Examiner found that:

Schafer et al discloses a waste cart that enables the drying of moist waste therein having a hollow body (2) having a lower portion, an upper portion defining an opening (6) for loading and unloading waste from the hollow body, and at least one vent hole (6) in the lower portion; a pivotable, perforated false bottom (18) positioned in the hollow body above the at least one vent hole to allow air circulation under waste retained by the false bottom. (Reissue Final action 3-4)

81. However, the Examiner found that:

Schafer et al. does not specifically disclose a support member extending downwardly from a bottom surface of the false bottom, the support having a length sufficient to contact a bottom portion of the waste cart to hold the false bottom generally parallel to the ground when the cart is in a normal waste containing position, and positioned on the bottom surface of the false bottom so that the support member has clearance from an inner surface of the waste cart when the false bottom is pivoted away from the bottom portion of the waste cart. (Reissue Final action 4)

82. The Examiner further found that in the same field of endeavor:

Matry discloses a plurality of support members (32) made of a molded, hollow cylinder, each extending downwardly from a bottom surface of the false bottom, the support having a length sufficient to contact a bottom portion of the waste cart to hold the false bottom generally parallel to the ground when the cart is in a normal waste containing position (See Fig. 2). (Reissue Final action 4)

83. The Examiner held that:

[I]t would have been obvious to a person of ordinary skill in the art to provide support members under the false bottom disclosed in Schafer et al. in view of the teaching of Matry. The motivation for doing so would have been to provide the false bottom disclosed in Schafer et al. with more support, thus allowing greater waste weight to be placed upon the false bottom. (Reissue Final action 4)

84. The Examiner further held that:

As to the positioning of the support members so that each of the support members has clearance from an inner surface of the waste cart when the false bottom is pivoted away from the bottom portion of the waste cart, a person of ordinary skill in the art would have the requisite skill to position the inserted support members disclosed in Matry onto the pivoting false bottom disclosed in Schafer et al. in a manner that would still allow the false bottom to pivot properly. (Reissue Final action 4)

EXAMINER'S REJECTION BASED ON REISSUE RECAPTURE

85. The Examiner rejected reissue application claims 8-13 as being unpatentable under 35 U.S.C. § 251 for recapturing subject matter surrendered in obtaining allowance of claims during prosecution of the application, which matured into the patent sought to be reissued.

86. The Examiner reasoned as follows (Reissue Final action 3):

Recapture exists because of the following omitted/broadened claim limitations from the previous application: (1) “at least one L shaped retainer member to hold said hood to said abutment surface”, which was the indicated allowable subject matter for independent [patent] Claims 2, 4, and 5 during the previous

prosecution; and (2) “a reinforcing groove centrally located in said hood at right angle to said perforated plate”, which was the indicated allowable subject matter for independent [patent] Claim 1. Both of these limitations were shown to be allowable subject matter in Paper No. 5 from the previous prosecution of Application number 08/887,238.

87. The Examiner further reasoned as follows (see Examiner’s Answer entered November 27, 2002, pages 6-7) (**emphasis added**):

In the original/surrendered application of the present case, Applicant added new claim 21, which included the limitations of [originally filed] Claims 1, 2, 4 and the limitations of [originally filed] Claim 6, which was [previously] indicated as containing allowable subject matter. Specifically, the limitation of Claim 6 that was indicated as allowable was “a reinforcing groove centrally located in said hood at right angle to said perforated plate.” (See Office Action, Paper No. 2 [of original Application number 08/887,238]). Also, Applicant added new Claims 22-[25]. Claim 22 included the limitations of [originally filed] Claim 1 and the limitations of [originally filed] Claim 3, which was [previously] indicated as containing allowable subject matter, and Claim 24 included the limitations of [originally filed] Claim 1 and the limitations of [originally filed] Claim 7, which was [previously] indicated as containing allowable subject matter. Specifically, the limitation of [originally filed] Claims 3 and 7 that was indicated as allowable was “the L shaped retainer member to hold said hood to its abutment surface.” (See Final Office Action, Paper No. 5 [of original Application number 08/887,238]).

* * *

In the present case, reissue claims 8 and 11 are broader in areas relevant to the prior art rejections and narrower in aspects completely unrelated to the prior art rejections. Specifically, reissue claims 8 and

11 have been broadened in an aspect germane to the prior art rejections, because applicant has removed the limitations relating to the “reinforcing groove” and the “L shaped retainer member”. Additionally, Claims 8 and 11 are now narrower, namely, “a pivotable, perforated false bottom . . . a support member extending downwardly from a bottom surface of the false bottom” has been added. However, **this broadening directly relates to the prior art rejections because, in an effort to overcome the prior art rejections, Applicant added the limitations of a “reinforcing groove” and [an] “L shaped retainer member” to define the original claims over the prior art.** Therefore, Examiner believes that the present reissue claims fall into the 3(a) category as set forth above in the principles stated in *Clement*, and that the recapture rule bars reissue Claims 8-13.

88. The record supports the Examiner’s findings with respect to what limitations do not appear in reissue application claims 8-13, which were present in patent claims 1, 2, 4 and 5, of the original application.

C. DECISION ON APPEAL UNDER 35 U.S.C. § 134

The Examiner has rejected claims 8-13 of the reissue application on appeal as being unpatentable under 35 U.S.C. § 103 based on prior art. The entire panel reverses this decision of the Examiner.

The Examiner has rejected claims 8-13 of the reissue application on appeal as being unpatentable under 35 U.S.C. § 251 based on recapture. The entire panel affirms this decision of the Examiner.

A majority opinion authored by Judge Franklin, joined by Judges Garris and McQuade, additional views by Judge McQuade, and a concurring

opinion authored by Judge MacDonald, joined by Judge Smith, having an Appendix, follows.

Judge Franklin, with whom Judges Garris and McQuade join.

We affirm the Examiner's rejection of claims 8-13 under 35 U.S.C. § 251 as improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based.

We reverse the Examiner's rejection of claims 8-13 under 35 U.S.C. § 103 as being obvious over Schafer in view of Matry.

I. The Recapture Rejection

The examiner has rejected claims 8-13 under 35 U.S.C. § 251.

35 U.S.C. § 251, ¶ 1, provides in pertinent part:

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 had a right to claim in the patent, the Director shall . . . 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.

35 U.S.C. § 251, ¶ 4, provides:

No reissued 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.

The reissue statute expressly permits a patentee to obtain reissue claims broader than the originally issued claims at any time within two years from the date the original patent issues. 35 U.S.C. § 251. The scope of permissible broadened reissue claims is limited by a judicial doctrine known as the "recapture rule." The "recapture rule" was developed to prohibit a patentee from obtaining by reissue broadened claims that "recapture" subject matter the patentee "deliberately surrendered" during the course of the original prosecution to obtain the patent. When an Applicant cancels or amends a claim to overcome a prior art rejection, and then relies on the changes made to the claim in arguing patentability of the amended claim, the law infers that the patent applicant admits that the prior art forecloses the scope of the original claim. As a result of this inferred admission, competitors are free to practice the subject matter surrendered by the patentee through the cancellation or amendment. To preserve the public notice function of the file history, the "recapture rule" precludes the patentee from recanting the admission that the prior art precluded a certain breadth of claim scope.

The examiner has the burden of making out a prima facie case of recapture. We believe that the examiner makes out the prima facie case of recapture by establishing: (1) the scope of the surrendered subject matter; and (2) that the surrendered subject matter has crept into a reissue claim. Also, we note that the Court has stated in *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992), that the prima facie case

is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 705, 707 n.3, 15 U.S.P.Q.2d 1655, 1657 n.3 (Fed. Cir. 1990). The term "prima facie case" refers only to the initial examination step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence, with due consideration to persuasiveness of argument. *See In re Spada*, supra; *In re Corkil*, 771 F.2d 1496, 1500, 226 U.S.P.Q. 1005, 1008 (Fed. Cir. 1985); *In re Caveny*, 761 F.2d 671, 674, 226 U.S.P.Q. 1, 3 (Fed. Cir. 1985); *In re Johnson*, 747 F.2d 1456, 1460, 223 U.S.P.Q. 1260, 1263 (Fed. Cir. 1984).

Hence, in the instant case, once a prima facie case of recapture is established by the Examiner, the burden of coming forward with evidence or argument shifts to the applicants. After evidence or argument is submitted by the applicants in response, patentability is determined on the totality of the record, by a preponderance of evidence, with due consideration to persuasiveness of argument. *Id.*

As stated by our concurring colleagues, the Federal Court's opinion in *In re Clement* sets forth a three-step test for analyzing recapture. *In re Clement*, 131 F.3d 1464, 1468, 45 U.S.P.Q.2d 1161, 1164 (Fed. Cir. 1997). However, although we and our concurring colleagues agree with the outcome of the application of this test in the instant case, our analysis in reaching this outcome is significantly different, as discussed below.

Our analysis is not limited to the reasons provided by the Examiner on page 6 of the Supplemental Examiner's Answer, and as discussed by our concurring colleagues (the reasons expressed focus on certain limitations that are absent from the reissue claims). That is, a proper analysis involves a more comprehensive review of the prosecution history of Application No. 08/887,238, and is not limited only to ascertaining which limitations are absent from the reissue claims.⁷ In other words, other evidence in the prosecution history must be considered. *Id.*

Also, binding precedent has defined surrendered subject matter in terms of a claim that had been canceled or amended to avoid a rejection. *See In re Clement*, 131 F.3d 1464, 45 U.S.P.Q.2d 1161 (Fed. Cir. 1997); *Ball Corp. v. U.S.*, 729 F.2d 1429, 221 U.S.P.Q. 289 (Fed. Cir. 1984); *In re Richman*, 409 F.2d 269, 161 U.S.P.Q. 359 (CCPA 1969); *In re Beyers*, 230 F.2d 451, 109 U.S.P.Q. 53 (C.C.P.A. 1956); *In re Wadsworth*, 107 F.2d

⁷ We believe that such a limited review of the prosecution history contradicts the established legal principle that the recapture rule is analogous to prosecution history estoppel. *See Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1481-82, 46 U.S.P.Q.2d 1641, 1649 (Fed. Cir. 1998).

596, 43 U.S.P.Q. 460 (C.C.P.A. 1939). Hence, our concurring colleagues err in taking the position that surrendered subject matter must be defined under all circumstances as including any claim which lacks a limitation added or argued by an applicant in order to avoid a rejection.

The three-step test for analyzing recapture as set forth in *Clement* is as follows.

The first step in applying the recapture rule 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 reissue claims relate to surrendered subject matter. Thus, one looks to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection to determine what surrendered subject matter exists, if any. If no surrendered subject matter exists, then the "recapture rule" does not apply.

If surrendered subject matter exists, it must then be determined whether the surrendered subject matter has crept into the reissue claims (third step). The following categories apply when conducting the third step (when comparing the reissue claim with the surrendered subject matter).

(1) If the scope of the reissue claim is as broad as or broader than the surrendered subject matter in all aspects, then the recapture rule bars the claim.

(2) If the reissue claim is narrower in scope than the surrendered subject matter in all aspects, it escapes the recapture rule entirely.

(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.

APPLICATION OF THE RECAPTURE RULE TO REISSUE CLAIM 8⁸

As noted in *Clement*, the first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claim is broader than the patent claims. This step of the analysis is important to ensure that the applicant has not run afoul of the two-year limitation on broadening, and, if broadening has occurred, to establish exactly in what aspects such broadening has occurred.

Reissue claim 8 is broader than patent claim 1⁹ because reissue claim 8 does not recite a lid and any details of such a lid. Having determined that reissue claim 8 is broader, we now proceed to the second step of the *Clement* test.

⁸ Our determinations made with respect to reissue claim 8 are applicable to reissue claim 11, as each of these claims recites similar subject matter.

⁹ We select patent claim 1 because it is the broadest patent claim.

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Thus, one looks to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection to determine what surrendered subject matter exists, if any. If no surrendered subject matter exists, then the "recapture rule" does not apply. If surrendered subject matter exists, it must then be determined whether the surrendered subject matter has crept into the reissue claims.

As stated, supra, binding precedent has defined surrendered subject matter in terms of a claim that had been canceled or amended to avoid a rejection. In the instant case, we determine that the surrendered subject matter is represented by original patent application claims 1, 2, and 4. We rely upon the following prosecution history of Application No. 08/887,238 in support thereof.

In the First Office Action, dated January 26, 1998, the Examiner rejected originally filed claims 1-5, and 7-20, and indicated that the subject matter of claim 6 was allowable (claim 6 recited the limitation regarding a reinforcing groove in the hood portion). Claim 6 depended upon claim 4, and claim 4 depended upon claim 2, which depended upon claim 1. Appellants' response included cancellation of claims 2 and 6, and addition of new claim 21 containing the subject matter of claims 1, 2, 4, and 6, and claims 1, 3, 4, and 7 were amended.

In a Second Office Action, dated June 24, 1998, the Examiner allowed new claim 21 (having the reinforcing groove element), rejected claims 1, 4, 5, 11, 12, and 14-20, and objected to claims 3, 7-10, and 13 as being dependent upon a rejected base claim. The Examiner indicated that claims 3, 7-10, and 13 were allowable because of the limitation regarding the L shaped retainer member to hold the hood to its abutment surface (Second Office Action 3). This limitation was in original patent application claim 3, in original patent application claim 7 (claims 8-10 depended upon claim 7), and in original patent application claim 13. Claim 3 depended upon claim 2 which depended upon claim 1. In response, Appellants requested cancellation of claims 1, 3-5, 7, 9, and 11-20. Appellants added new claims, including new claim 22 which included the subject matter of claims 1, 2, and 3.

Hence, in view of the aforementioned prosecution history, we select original patent application claims 1, 2, and 4 as representative of surrendered subject matter.¹⁰ A copy of these original patent application claims is set forth below.

1. A waste cart that enables the drying of moist waste therein including:
 - a hollow body having:
 - a lower portion;
 - an upper portion defining:

¹⁰ Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the Appellant admits that the scope of the claim before the cancellation or amendment is unpatentable. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

an opening for loading and unloading waste from said hollow body; and
at least one vent hole in said lower portion; and
a lid for closing said opening for loading and unloading waste from hollow body, said lid including:
at least one lid vent there through, whereby air can convect through said at least one vent hole in said lower portion, through any waste contained in the hollow body and out said lid vent carrying moisture therewith.

2. The waste cart as defined in claim 1 wherein said at least one lid vent includes:
 - a vent hole in said lid; and
 - a hood covering said lid vent hole.

4. The waste cart as defined in claim 2 wherein said hood covering said lid vent hole includes:
 - a generally horizontal hood portion;
 - a sidewardly facing opening in said hood covered with respect to falling rain by said hood portion; and

 - a perforated plate covering said sidewardly facing opening.

Having established the scope of the surrendered subject matter, in compliance with the third step set forth in *Clement*, we now must determine whether the surrendered subject matter has crept into reissue claim 8. We therefore compare reissue claim 8 with the aforementioned surrendered subject matter (original patent application claims 1, 2, and 4), as follows.

Reissue claim 8 is broader than original patent application claims 1, 2, and 4. This is because reissue claim 8 does not recite a lid (in effect, the

claimed waste cart can have any type of lid, or no lid at all). The subject matter of a lid was before Appellants and the Examiner at the time the rejection(s) were made, and therefore is germane to the art rejection(s).

Reissue claim 8 is narrower than original patent application claims 1, 2, and 4 in reciting a perforated false bottom that is pivotable and that has a support member extending downwardly from the perforated false bottom. The issue of whether this claimed aspect is germane to the art rejection can be viewed in one of two ways, as follows.

On the one hand, it can be said that the claimed aspect of a perforated false bottom is germane to the art rejection(s) in view of the prosecution history¹¹. This subject matter was not overlooked¹² by Appellants (it was

¹¹ The subject matter of a perforated false bottom existed in original patent application claims 5, 7, 9, 15, 18, and 19. Claims 9 and 19, for example, each recited that the perforated false bottom is hingedly connected to the hollow body.

¹² As explained in *Hester*, 142 F.3d 1472, 1482-83, 46 U.S.P.Q.2d 1641, 1649-50 (Fed. Cir. 1998), reissue claims which recapture surrendered subject matter nevertheless may avoid the recapture rule “when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.” *North Am. Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 1349, 75 U.S.P.Q.2d 1545, 1556 (Fed. Cir. 2005) (“finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule”); *Pannu v. Storz Instr., Inc.*, 258 F.3d 1366, 1371, 59 U.S.P.Q.2d 1597, 1600 (Fed. Cir. 2001) (“[f]inally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule”).

claimed in varying degrees of specificity), and this subject matter was before the Examiner when making the rejections. Such an approach places the instant case in the very same fact pattern of *Clement*. That is, reissue claim 8 is both broader and narrower in areas relevant to the prior art rejections. *In re Clement*, 131 F.3d 1464, 1470, 45 U.S.P.Q.2d 1161, 1165-66 (Fed. Cir. 1997).

On the other hand, the now claimed aspect of a pivotable perforated false bottom having a support member can be viewed as not being germane to the rejection because the aspect of the perforated false bottom having a support member extending downwardly from a bottom surface of the false bottom was never claimed before. In this scenario, the fact pattern places the instant case in category of 3(a) of *Clement*.

However, no matter which scenario is chosen, each of the above scenarios results in the same outcome because, on balance, reissue claim 8 is broader than it is narrower, relative to the surrendered subject matter. That is, reissue claim 8 is broader than it is narrower because the absence of a lid allows for limitless types of lids or no lid at all (it has been broadened in a limitless manner), while the perforated false bottom has not been narrowed in such a limitless manner (the false bottom is limited to a particular support member).

In view of the above, therefore, the recapture rule bars the claims. *Id.*

We therefore affirm the 35 U.S.C. § 251 rejection of claims 8-13 as being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based.

II. The Prior Art Rejection

The Examiner rejects claims 8-13 under 35 U.S.C. § 103 as being obvious over Schafer in view of Matry for the reasons set forth in the Final Office Action dated April 17, 2002 of Application No. 09/848,628.

Basically, the Examiner's position is that Schafer teaches all aspects of Appellants' claimed invention except for the support member having a specific length sufficient to contact the bottom portion of the waste cart to hold the false bottom generally parallel to the ground when the cart is in a normal waste containing position. The Examiner relies upon Matry for teaching this aspect of the claimed invention (Final Office Action 4). Schafer does teach the concept of a false bottom (grate) 18. Figure 1 of Schafer depicts false bottom (grate) 18. False bottom 18 is held in position when the cart is in a normal waste containing position by ribs 20a, as depicted in Figure 2, and as described in column 5, lines 54-68. False bottom (grate) 18 is pivotable about hinges 19 as shown in Figure 2 and as described in column 5, lines 25-35.

Figure 2 of Matry depicts a basket 28, having feet 32. Basket 28 is carried within casing 12. The Examiner views feet 32 as support members that extend downwardly from the bottom surface of the false bottom, each

having a sufficient length to contact a bottom portion of the waste cart in a normal waste containing position. On page 6 of the Final Office Action, the Examiner states that Schafer's support ribs and Matry's feet 32 are art-recognized equivalents, and therefore substituting one for the other would have been prima facie obvious.

On page 3 of Appellants' Supplemental Reply Brief, Appellants argue that there is no motivation to combine Matry with Schafer because the feet 32 of Matry are attached to the sides of a free-standing basket 28 and not to the bottom, and Schafer only provides ribs 20 on the inside wall of the container to form a support for false bottom (grate) 18. Appellants argue that neither reference provides an objective reason to combine it with the other, nor does the combination suggest legs that extend as bottom supports.

We find that Matry teaches that feet 32 "have an outward extent to assure the positioning of the basket 28 in a generally central location" (Matry, col. 2, ll. 6-9). The Examiner has not proffered a motivation or an explanation as to why or how this feature of feet 32 would have been incorporated into Schafer while meeting Appellants' claim requirement of a support member "positioned on the bottom surface of the false bottom so that the support member has clearance from an inner surface of the waste cart when the false bottom is pivoted away from the bottom portion of the waste cart." At the bottom of page 4 of the Final Office Action, the Examiner states that "a person of ordinary skill in this art would have the requisite skill to position the inserted support members disclosed in Matry

onto the pivoting false bottom disclosed in Schafer et al. in a manner that would still allow the false bottom to pivot properly.” Aside from being unsupported by evidence and thus speculative, this statement also does not provide the aforementioned motivation or explanation. Furthermore, the applied references do not support the Examiner’s position that feet 32 are an art-recognized equivalent to ribs 20 of Schafer. Finally, while the Examiner equates the basket 28 of Matry with the false bottom of Schafer, we question whether such an interpretation of Matry is driven by the evidence or by hindsight reasoning.

In view of the above, we therefore reverse the 35 U.S.C. § 103 rejection of claims 8-13 as being obvious over Schafer in view of Matry.

III. Conclusion

Upon consideration of the record, and for the reasons given, the decision of the Examiner rejecting reissue claims 8 through 13 based on recapture is affirmed, and the decision of the Examiner rejecting reissue claims 8-13 based on obviousness is reversed.

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No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a) (2005).

AFFIRMED

BRADLEY R. GARRIS)
Administrative Patent Judge)
)
)
)
JOHN P. MCQUADE)
Administrative Patent Judge)
)
)
)
BEVERLY A. FRANKLIN)
Administrative Patent Judge)

Judge McQuade, additional views.

The *Clement* step 3(a) analysis set forth in the majority opinion is not the only legitimate approach for evaluating recapture issues.

In general, the reissue recapture rule prevents a patentee from regaining through reissue subject matter that was surrendered in an effort to obtain allowance of the original claims. *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 1349, 75 U.S.P.Q.2d 1545, 1556 (Fed. Cir. 2005); *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1370-71, 59 U.S.P.Q.2d 1597, 1600 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480, 46 U.S.P.Q.2d 1641, 1647 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 1468, 45 U.S.P.Q.2d 1161, 1164 (Fed. Cir. 1997); *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 U.S.P.Q.2d 1521, 1524 (Fed. Cir. 1993). The Court of Appeals for the Federal Circuit recently has employed a three-step process for applying the reissue recapture rule: 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 reissue claims relate to surrendered subject matter; and the third step is to determine whether the reissue claims are materially narrowed in other respects so as to avoid the recapture rule. *North American Container*, 415 F.3d at 1349, 75 U.S.P.Q.2d at 1556; *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600; *Hester*, 142 F.3d at 1480-83, 46 U.S.P.Q.2d at 1648-50. The purpose of the third step is to allow a patentee to obtain

through reissue a scope of protection to which he is rightfully entitled for overlooked aspects. *Hester*, 142 F.3d at 1483, 46 U.S.P.Q.2d at 1650.

In applying these principles to the present case, reissue claim 8 is suitable for discussion given the appellants' statement that "[c]laims 8-13 stand or fall together" (Brief filed November 12, 2002, page 3).

Claim 8 is broader in pertinent part than the claims in the patent sought to be reissued in that does not include the limitations in independent patent claim 1 relating to the "reinforcing groove" or the limitations in independent claims 2, 4 and 5 pertaining to the "at least one L shaped retainer member." The prosecution history of the patent shows that the Appellants relied on these respective limitations to obtain the patent. Thus, the broadened aspects of claim 8 clearly relate to surrendered subject matter.

Claim 8 is narrower than the patent claims in that it recites a pivotable perforated false bottom having a downwardly extending support member. Patent claim 4 is the only patent claim that recites a perforated false bottom, but it does not define this element as being pivotable or as having a support member.

The prosecution history of the patent shows that the original application contained a number of claims that included the perforated false bottom. Original application claims 5, 7, 15 and 18 recited the perforated false bottom in relatively broad terms, and original application claims 9 and 19 further defined the perforated false bottom as being hingedly connected, i.e., pivotable. The record also shows that Appellants ultimately canceled all

of these claims in favor of but a single patent claim (claim 4) reciting the perforated false bottom, with the recitation of this element being relatively broad.

Thus, the prosecution history of the patent establishes that the Appellants originally presented a number of claims reciting the perforated false bottom with varying degrees of specificity and subsequently canceled all of these claims to arrive at patent claims in which the perforated false bottom was either not recited or, in the case of patent claim 4, only broadly recited. These actions by the Appellants do not support, and in fact belie, any contention that the perforated false bottom limitations recited in reissue claim 8 pertain to an overlooked aspect of the invention that materially narrows the claim to the extent necessary to outweigh the broadened, surrender-related aspects of the claim.

Hence, claim 8, and claims 9-13 which stand or fall therewith, run afoul of the recapture rule because they would allow the appellants to regain through reissue subject matter that was surrendered to obtain the patent.

The foregoing illustrates that the law permits some flexibility as to the manner in which recapture issues can be evaluated. There is no basis in law, however, for the procedure advanced in the concurring opinion notwithstanding its understandable aim “to place practical and workable burdens on examiners and Applicants” (page 62) dealing with the admittedly complex and difficult questions posed by reissue claims falling within category 3, and potentially category 3(a), of *Clement*.

As stated in *Clement*, “(3) if the reissue claim is broader [than a canceled or amended claim] 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” (131 F.3d at 1468, 45 U.S.P.Q.2d at 1165). Thus, the observation in the concurring opinion that an examiner “can make out a prima facie case of recapture by establishing that the claims sought to be reissued fall within [Substep] 3(a) of *Clement*” (page 57) goes without saying.

The concurring opinion goes on to propose an allocation of proof that forms the basis for the proposition that

the “surrendered subject matter” that may not be recaptured through reissue should be *presumed* to include subject matter broader than the patent claims in a manner directly related to (1) limitations added to the claims by amendment (either by amending an existing claim or canceling a claim and replacing it with a new claim with that limitation) to overcome a patentability rejection and (2) limitations argued to overcome a patentability rejection without amendment of a claim [page 62].

Applying this novel evidentiary concept to the present case, the concurring opinion concludes that

Because limitations **A** [pertaining to the reinforcing groove] and **B** [pertaining to the at least one L shaped retainer member] are absent from the reissue claims being rejected and since those limitations are germane as to why the prior art did not reach claims containing limitations **A** and **B**, the Examiner has

correctly placed the claims sought to be reissued within Substep (3)(a) of Step (3) of *Clement*.

...

The Examiner's accurate factual analysis demonstrates that the Examiner has made out a *prima facie* case of recapture [page 68].

This analysis is unsound for at least two reasons.

First, category 3(a) of *Clement* involves a comparison between a reissue claim and a canceled or amended claim, not a patent claim.

Second, and more importantly, category 3(a) of *Clement* relates to reissue claims that are (1) as broad or broader in an aspect germane to a prior art rejection *and* (2) narrower in another aspect completely unrelated to the rejection. A finding that a claim is as broad or broader in an aspect germane to a prior art rejection without a corresponding finding that it is narrower in another aspect completely unrelated to the rejection is not sufficient, under the very definition of category 3(a) set forth by *Clement*, to establish a *prima facie* case that the claim falls within this category. The latter finding is a necessary and critical component of any such determination. The case law and reasoning advanced in the concurring opinion fail to provide even a scintilla of reasonable support for the suggestion that an examiner may ignore the express instructions of *Clement* and relevant portions of the

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prosecution history to establish a prima facie case of recapture under category 3(a).

John P. McQuade) BOARD OF PATENT
Administrataive Patent Judge) APPEALS AND
) INTERFERENCES

Judge MacDonald, with whom Judge Jerry Smith joins, concurring.

A. Discussion of Obviousness

We concur with the result and rationale of Judge Franklin with respect to the Examiner's rejection based on 35 U.S.C. § 103.

B. Discussion of Recapture

1. Recapture principles

(1)

The statute

The reissue statute expressly permits a patentee to correct an error thus permitting patentee to obtain reissue claims broader than the originally issued patent claims at any time within two (2) years from the date the original patent issues. More particularly, 35 U.S.C. § 251, ¶¶ 1 and 4, provide in pertinent part:

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 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 reissued 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.

(2)
Recapture is not an error
within the meaning of 35 U.S.C. § 251

What has become known as the “recapture rule,” prevents a patentee from regaining through a reissue patent subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement*, 131 F.3d 1464, 1468, 45 U.S.P.Q.2d 1161, 1164 (Fed. Cir. 1997).

If a patentee attempts to “recapture” what the patentee 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 [subject] matter withdrawn.” *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 U.S.P.Q.2d 1521, 1524 (Fed. Cir. 1993), quoting from *Haliczer v. United States*, 356 F.2d 541, 545, 148 U.S.P.Q. 565, 569 (Ct. Cl. 1966).¹³ See also *Hester Industries Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480, 46 U.S.P.Q.2d 1641, 1647 (Fed. Cir.), *cert. denied*, 525 U.S. 947 (1998). (3)

¹³ *Haliczer* is binding precedent. See *South Corp. v. United States*, 690 F.2d 1368, 215 U.S.P.Q. 657 (Fed. Cir. 1982) (in banc) (decisions of the former U.S. Court of Customs and Patent Appeals and former U.S. Court of Claims decisions are binding precedent).

In re Clement

The Federal Circuit's opinion in *Clement* discusses a three-step test for analyzing recapture.

Step 1 involves a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims. The Federal Circuit reasoned that a reissue application claim deleting a limitation or element from a patent claim is broader as to that limitation's or element's aspect. 131 F.3d at 1468, 45 U.S.P.Q.2d at 1164.

Step 2 involves a determination of whether the broader aspects of the reissue application claims relate to surrendered subject matter. 131 F.3d at 1468-69, 45 U.S.P.Q.2d at 1164. In this respect, review of arguments and/or amendments during the prosecution history of the application, which matured into the patent sought to be reissued, is appropriate. In reviewing the prosecution history, the Federal Circuit observed that “[d]eliberately canceling or amending a claim in an effort to overcome a [prior art] reference strongly suggests that the applicant admits that the scope of the claim before cancellation or amendment is unpatentable. 131 F.3d at 1469, 45 U.S.P.Q.2d at 1164.

Step 3 is applied when the broadening relates to surrendered subject matter and involves a determination whether the surrendered subject matter has crept into the reissue application claim. *Id.* The following principles were articulated by the Federal Circuit, 131 F.3d at 1470, 45 U.S.P.Q.2d at 1165:

Substep (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;

Substep (2): if it is narrower in all aspects, the recapture rules does not apply, but other rejections are possible;

Substep (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 [a] 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.

(4)

North American Container

In *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 U.S.P.Q.2d 1545 (Fed. Cir. 2005), the Federal Circuit had occasion to further address Substep (3)(a) of *Clement*.

North American Container involved a reissue patent, which had been held invalid by the U.S. District Court for the Northern District of Texas. The district court bottomed its invalidity holding based on a violation of the recapture rule. During prosecution of an application for patent, an examiner rejected the claims over a combination of two prior art references: Dechenne and Jakobsen. To overcome the rejection, *North American*

Container limited its application claims by specifying that a shape of “inner walls” of a base of a container was “generally convex.” North American Container convinced the examiner that the shape of the base, as amended, defined over “both the Dechenne patent, wherein the corresponding wall portions 3 are slightly concave ... and the Jakobsen patent, wherein the entire reentrant portion is clearly concave in its entirety.” 415 F.3d at 1340, 75 U.S.P.Q.2d at 1549. After a patent issued containing the amended claims, *North American Container* filed a reissue application seeking reissue claims in which (1) the language “inner wall portions are generally convex” was eliminated, but (2) the language “wherein the diameter of said re-entrant portion is in the range of 5% to 30% of the overall diameter of said side wall” was added. Thus, the claim sought be reissued was broader in some aspects and narrower in other aspects.

The Federal Circuit, applying the *Clement* three-step test, held that the reissue claims were broader in scope than the originally-issued claims in that they no longer require the “inner walls” to be “generally convex.” The Federal Circuit further found that the broadened aspect (i.e., the broadened limitation) “relate[d] to subject matter that was surrendered during prosecution of the original-filed claims.” 415 F.3d at 1350, 75 U.S.P.Q.2d at 1557. The Federal Circuit observed “the reissue claims were not narrowed with respect to the ‘inner wall’ limitation, thus avoiding the recapture rule.” The Federal Circuit stated:

[t]hat the reissue claims, looked at as a whole, may be of “intermediate scope” is irrelevant. . . . [T]he recapture rule is

applied on a limitation-by-limitation basis, and ... [North American Container's] deletion of the "generally convex" limitation clearly broadened the "inner wall" limitation.

Id. Thus, the Federal Circuit in *North American Container* further developed the principles of Substep (3)(a) of *Clement*: "broader in an aspect germane to a prior art rejection" means broader with respect to a specific limitation (1) added to overcome prior art in prosecution of the application which matured into the patent sought to be reissued and (2) eliminated in the reissue application claims.

(5)

Ex parte Eggert

Our opinion in *Ex parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003), issued as a precedential opinion, is also part of the recapture precedent applicable to proceedings before the United States Patent & Trademark Office (USPTO). *Eggert* was entered on May 29, 2003, prior to the Federal Circuit's *North American Container* decision. In *Eggert*, the majority stated that "[i]n our view, the surrendered subject matter is the outer circle of Drawing 1 [the rejected claim prior to the amendment that resulted in the claim being issued] because it is the subject matter appellants conceded was unpatentable." 67 U.S.P.Q.2d at 1717. The majority further held that "in our view" subject matter narrower than the rejected claim but broader than the patented claim is not barred by the recapture rule. *Id.* The majority explained that if the finally rejected claim was ABC and the patent claim was ABCDEF, there would be recapture for ABC or anything broader

than ABC, but not for claims directed to ABCX, ABCD_{Br}, ABCEF, or A_{Br}BCDEF, because those claims would be narrower than the finally rejected claim ABC. 67 U.S.P.Q.2d at 1717. In its opinion, the majority recognized that the Federal Circuit had held that “the mere presence of narrowing limitations in the reissue claim is not necessarily sufficient to save the reissue claim from the recapture rule.” 67 U.S.P.Q. at 1729.

Board of Patent Appeals and Interferences Standard Operating Procedure 2 (Revision 6) (August 10, 2005) mandates that a published precedential opinion of the Board is binding on all judges of the Board *unless* the views expressed in an opinion in support of the decision, among a number of things, are inconsistent with a decision of the Federal Circuit. In our view, the majority view in *Eggert* is believed to be inconsistent with the subsequent Federal Circuit decision in *North American Container* with respect to the principles governing application of Substep (3)(a) of *Clement*.

The *Eggert* majority’s analysis is believed to be consistent with *North American Container* in that the majority applied the three-step framework analysis set forth in applicable Federal Circuit opinions, e.g., (1) *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1370-71, 59 U.S.P.Q.2d 1597, 1600 (Fed. Cir. 2001); (2) *Clement*, 131 F.3d at 1470, 45 U.S.P.Q.2d at 1165 and (3) *Hester*, 142 F.3d at 148, 46 U.S.P.Q.2d at 1648-49. However, the *Eggert* majority also held that the surrendered subject matter was the rejected claim only rather than the amended portion of the issued claim. 67 U.S.P.Q.2d at 1717. At a similar point in the recapture analysis, *North American*

Container has clarified the application of the three-step framework analysis. *North American Container* holds that the “inner walls” limitation (a portion of the issued claim that was added to the rejected claim by amendment) was “subject matter that was surrendered during prosecution of the original-filed claims.” 415 F.3d at 1350, 75 U.S.P.Q.2d at 1557.

It is believed that the Substep (3)(a) rationale of the Eggert majority (1) is not consistent with the rationale of the Federal Circuit in *North American Container* and (2) should no longer be followed or be applicable to proceedings before the USPTO.

(6)

What subject matter is surrendered?

In a case involving Substep (3)(a) of *Clement*, what is the subject matter surrendered?

Is it

- (1) the subject matter of an application claim which was amended or canceled or
- (2) the subject matter of an application claim which was amended or canceled and, on a limitation-by-limitation basis, the territory falling between the scope of
 - (a) the application claim which was canceled or amended and
 - (b) the patent claim which was ultimately issued?

We believe *North American Container* stands for the proposition that it is (2) and not (1). Accordingly, we hold that it is (2).

(7)

Clement principles are not per se rules

Our reading of our appellate reviewing court's recapture opinions, as a whole, suggests that the *Clement* steps should not be viewed as per se rules. For example, we note the following in *Clement*, 131 F.3d at 1469, 45 U.S.P.Q.2d at 1164:

Although the recapture rule does not apply in the absence of evidence that the applicant's amendment was "an admission that the scope of that claim was not in fact patentable," Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984), "the court may draw inferences from changes in claim scope when other reliable evidence of the patentee's intent is not available," Ball [Corp. v. United States], 729 F.2d at 1436, 221 USPQ at 294.

Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary. See Mentor [Corp. v. Coloplast, Inc.], 998 F.2d at 995-96, 27 USPQ2d at 1524-25; Ball, 729 F.2d at 1438, 221 USPQ at 296; Seattle Box Co., 731 F.2d at 826, 221 USPQ at 574 (declining to apply the recapture rule in the absence of evidence that the applicant's "amendment ... was in any sense an admission that the scope of [the] claim was not patentable"); Haliczer [v. United States], 356 F.2d at 545, 148 USPQ at 569 (acquiescence in the rejection and acceptance of a patent whose claims include the limitation added by the applicant to distinguish the claims from the prior art shows intentional

withdrawal of subject matter); In re Willingham, 282 F.2d 353, 354, 357, 127 USPQ 211, 213, 215 (CCPA 1960) (no intent to surrender where the applicant canceled and replaced a claim without an intervening action by the examiner). Amending a claim “by the inclusion of an additional limitation [has] exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation.” In re Byers, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956). [Footnote and citations to the CCPA reports omitted.]

(8)
Allocation of burden of proof

What is the proper allocation of the burden of proof in *ex parte* examination?

For reasons that follow, we hold that an examiner has the burden of making out a prima facie case of recapture. The examiner can make out a prima facie case of recapture by establishing that the claims sought to be reissued fall within Substeps (1) or 3(a) of *Clement*.

For reasons that follow, we also hold that once a prima facie case of recapture is established, the burden of persuasion then shifts to the applicant to establish that the *prosecution history* of the application, which matured into the patent sought to be reissued, establishes that a surrender of subject matter did not occur.

As will become apparent, our rationale parallels practice in determining whether subject matter is surrendered when a doctrine of equivalents analysis occurs in infringement cases.

(9)

Burden of proof analysis

Our analysis begins with an observation made by our appellate reviewing court in *Hester*, 142 F.3d at 1481-82, 46 U.S.P.Q.2d at 1649:

[A]s recognized in *Ball*, the recapture rule is based on principles of equity¹⁴ and therefore embodies the notion of estoppel. 729 F.2d at 1439, 221 USPQ at 296. 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. See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, [520 U.S. 17, 33] 117 S. Ct. 1040, 1051[41 USPQ2d 1865, 1873] (1997). Like the recapture rule, prosecution history estoppel prevents a patentee from regaining subject matter surrendered during prosecution in support of patentability. See *id.*

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 reissue. Rather, the analogy is with the recapture rule, which restricts the permissible range of expansion through

¹⁴ The reissue statute has been characterized as being remedial in nature, based on fundamental principles of equity and fairness and should be construed liberally. *In re Bennett*, 766 F.2d 524, 528, 226 U.S.P.Q. 413, 416 (Fed. Cir. 1985) (in banc); *In re Willingham*, 282 F.2d 353, 354-55, 127 U.S.P.Q. 211, 214 (CCPA 1960). Nevertheless, fairness to the public must also be considered. As stated in *Mentor*, "the reissue statement cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so." 998 F.2d at 996, 27 U.S.P.Q.2d at 1525.

reissue just as prosecution history estoppel restricts the permissible range of equivalents under the doctrine of equivalents.

This court earlier concluded that prosecution history estoppel can arise by way of unmistakable assertions made to the Patent Office in support of patentability, just as it can arise by way of amendments to avoid prior art. See, e.g., Texas Instruments, Inc. v. International Trade Comm'n, 998 F.2d 1165, 1174, 26 USPQ2d 1018, 1025 (Fed. Cir. 1993).

See also Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F.3d 558, 602, 56 U.S.P.Q.2d 1865, 1899 (Fed. Cir. 2000) (*Festo I*), *vacated and remanded*, 535 U.S. 722, 122 S. Ct. 1831, 62 U.S.P.Q.2d 1705 (2002) (*Festo II*)¹⁵ (Michel, J., concurring-in-part and dissenting-in-part):

[T]he law of prosecution history estoppel has developed with equal applicability to reissue patents and original patents whose claims were amended during prosecution. By at least 1879, the Supreme Court recognized that the process of obtaining a reissue patent precluded the patentee from recapturing that which he had disclaimed (i.e., surrendered), through the reissuance process.

¹⁵ The “*Festo*” convention used in this opinion is:

Festo I is the original in banc decision of the Federal Circuit.

Festo II is the decision of the Supreme Court.

Festo III is the decision of the Federal Circuit on remand.

(10)

Relevance of prosecution history

“Surrendered subject matter” is defined in connection with prosecution history estoppel in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733-34, 122 S. Ct. 1831, 1838, 62 U.S.P.Q.2d 1705, 1710-11 (2002) (*Festo II*):

The doctrine of equivalents allows the patentee to claim those insubstantial alterations that were not captured in drafting the original patent claim but which could be created through trivial changes. When, however, the patentee originally claimed the subject matter alleged to infringe but then narrowed the claim in response to a rejection, he may not argue that the surrendered territory comprised unforeseen subject matter that should be deemed equivalent to the literal claims of the issued patent. On the contrary, “[b]y the amendment [the patentee] recognized and emphasized the difference between the two phrases[,] ... and [t]he difference which [the patentee] thus disclaimed must be regarded as material.” Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126, 136-37, 62 S. Ct. 513, 518-19 [52 USPQ 275, 279-80] (1942).

Festo II goes on to comment, 535 U.S. at 737-41, 122 S. Ct. at 1840-42, 62 U.S.P.Q.2d at 1712-14:

[Prosecution history estoppel’s] reach requires an examination of the subject matter surrendered by the narrowing amendment. [A] complete bar [would avoid] this inquiry by establishing a per se rule; but that approach is inconsistent with the purpose of applying the estoppel in the first place to hold the inventor to the representations made during the application process and to the inferences that may reasonably be drawn from the amendment (emphasis added).

*
*
*

A patentee's decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim. Exhibit Supply, 315 U.S., at 136-137, 62 S. Ct. 513 ("By the amendment [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference"). There are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. In those cases the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence (emphasis added).

When the patentee has chosen to narrow a claim, courts may presume the amended text was composed with awareness of this rule and that the territory surrendered is not an equivalent of the territory claimed. In those instances, however, the patentee still might rebut the presumption that estoppel bars a claim of equivalence. The patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent (emphasis added).

The same policy considerations that prevent a patentee from urging equivalents within what the Supreme Court refers to as “surrendered territory” should prima facie prohibit the patentee from being able to claim subject matter within the surrendered territory in reissue. Accordingly, the “surrendered subject matter” that may not be recaptured through reissue should be *presumed* to include subject matter broader than the patent claims in a manner directly related to (1) limitations added to the claims by amendment (either by amending an existing claim or canceling a claim and replacing it with a new claim with that limitation) to overcome a patentability rejection and (2) limitations argued to overcome a patentability rejection without amendment of a claim. These presumptions are believed to place practical and workable burdens on examiners and Applicants.

(11)

Admissible evidence in rebuttal showing

As in the case of surrender when applying the doctrine of equivalents, a reissue Applicant should have an opportunity to rebut any prima facie case made by an Examiner.

What evidence may an Applicant rely on to rebut any prima facie case of recapture?

We hold that the admissible rebuttal evidence generally should be limited to (1) the prosecution history of the application which matured into the patent sought to be reissued and (2) showings related to what was known by a person having ordinary skill in the art at the time an amendment was

made. Nevertheless, we cannot attempt to divine, at this time, all evidence that might be relevant. As with other issues that come before the USPTO, such as obviousness and enablement, the evidence to be presented will vary on a case-by-case basis, as will the analysis of that evidence.

An Applicant must show that at the time the amendment was made, one skilled in the art could not reasonably have viewed the subject matter broader than any narrowing amendment as having been surrendered. The showing required to be made by Applicant is consistent with the public notice function of claims. Nevertheless, some limited extrinsic evidence may be relevant. However, extrinsic evidence unavailable to one of ordinary skill in the art at the time of the amendment is not relevant to showing that one skilled in the art could not reasonably have viewed the subject matter as having been surrendered. Limiting the nature of the admissible evidence is believed to be consistent with the Federal Circuit's decision on remand following *Festo II*. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1367, 68 U.S.P.Q.2d 1321, 1326 (Fed. Cir. 2003), *cert. denied*, 541 U.S. 988 (2004) (*Festo III*).

On remand, the Federal Circuit notes (*Id.* at 1367-70, 68 U.S.P.Q.2d at 1326-29):

[W]e reinstate our earlier holding that a patentee's rebuttal of the Warner-Jenkinson presumption is restricted to the evidence in the prosecution history record. *Festo* [I], 234 F.3d at 586 & n.6; see also Pioneer Magnetics, 330 F.3d at 1356 (stating that only the prosecution history record may be considered in determining whether a patentee has overcome the Warner-

Jenkinson presumption, so as not to undermine the public notice function served by that record). If the patentee successfully establishes that the amendment was not for a reason of patentability, then prosecution history estoppel does not apply.

. . . By its very nature, objective unforeseeability depends on underlying factual issues relating to, for example, the state of the art and the understanding of a hypothetical person of ordinary skill in the art at the time of the amendment. Therefore, in determining whether an alleged equivalent would have been unforeseeable, a district court may hear expert testimony and consider other extrinsic evidence relating to the relevant factual inquiries.

. . . As we have held in the Warner-Jenkinson context, that reason should be discernible from the prosecution history record, if the public notice function of a patent and its prosecution history is to have significance. See id. at 1356 (“Only the public record of the patent prosecution, the prosecution history, can be a basis for [the reason for the amendment to the claim]. Otherwise, the public notice function of the patent record would be undermined.”); Festo [I], 234 F.3d at 586 (“In order to give due deference to public notice considerations under the Warner-Jenkinson framework, a patent holder seeking to establish the reason for an amendment must base his arguments solely upon the public record of the patent’s prosecution, i.e., the patent’s prosecution history. To hold otherwise--that is, to allow a patent holder to rely on evidence not in the public record to establish a reason for an amendment--would undermine the public notice function of the patent record.”). Moreover, whether an amendment was merely tangential to an alleged equivalent necessarily requires focus on the context in which the amendment was made; hence the resort

to the prosecution history. Thus, whether the patentee has established a merely tangential reason for a narrowing amendment is for the court to determine from the prosecution history record without the introduction of additional evidence, except, when necessary, testimony from those skilled in the art as to the interpretation of that record.

. . . When at all possible, determination of the third rebuttal criterion should also be limited to the prosecution history record. . . . We need not decide now what evidence outside the prosecution history record, if any, should be considered in determining if a patentee has met its burden under this third rebuttal criterion.

We interpret *Festo* III to generally, perhaps effectively, limit the admissible rebuttal evidence to the prosecution history record and extrinsic evidence related to the knowledge of the hypothetical person of ordinary skill in the art at the time of the amendment. Admitting evidence not available to the public, such as an affidavit of an attorney giving mental impressions from the attorney who made the amendment, would undermine the public notice function of the patent and its prosecution history.

(12)

Non-relevance of “intervening rights”

We have not overlooked a possibility that an argument might be made that the so-called intervening rights provision relating to reissues makes jurisprudence on the doctrine of equivalents presumption inapplicable to reissue recapture rules. Our answer as to the argument is similar to the answer given by the Federal Circuit in *Hester* with respect to whether the doctrine of equivalents surrender principles have any applicability to reissue

surrender principles. *Hester* squarely held that they do. Moreover, mixing “intervening rights” with “surrender” is like mixing apples with oranges or putting the cart before the horse. A patentee seeking a reissue claim which is barred by recapture is not entitled to a reissue patent under 35 U.S.C. § 251. If there is no reissue patent, there can be no intervening rights.

(13)

The concurrences

Our colleagues seem to be saying that the only subject matter surrendered is that of a canceled claim. This analysis looks a lot like an attempt to create a per se rule.

With all due respect, we believe that any recapture analysis must be bottomed principally on a “public notice” analysis which can occur only after a record becomes “fixed.” In the case of a patent, the “claims” and the “prosecution history” become fixed at the time the patent is issued--not during “fluid” patent prosecution where claims and arguments can change depending on the circumstances, e.g., prior art applied and amendments to claims. It is from a fixed perspective that the public (not the patentee) must make an analysis of what the patentee surrendered during prosecution. Moreover, an Applicant (not the public) controls what amendments are presented during prosecution. When an amendment is presented, it is the applicant that should be in the best position to analyze what subject matter (i.e., territory to use the Supreme Court’s language) is being surrendered.

2. The Examiner's prima facie case

Our findings of fact 84-86 set out the basis upon which the Examiner made a recapture rejection. As noted in Finding 87, the record supports the Examiner's findings.

In the application which matured into the patent now sought to be reissued, the Examiner "rejected" originally filed claims 1-5 and 7-20, as noted in findings of fact 31-38. Applicants proceeded to amend independent application claim 1 and added new independent claim 21 (by combining originally filed claims 1, 2, 4, and 6) while canceling claims 2 and 6.

The Examiner then "rejected" amended claims 1 and 4-5, and originally filed claims 11, 12, and 14-20, as noted in findings of fact 52-57. Applicants proceeded to cancel independent application claims 1 (as amended) and claim 11 (as filed). Applicants cancelled claims 3-5, 7, 9, and 12-20. Applicants also rewrote dependent claim 3 (combining original claims 1 and 3), claim 7 (combining original claims 1 and 7), and claim 13 (combining original claims 11, 12, and 13), in independent form as claims 22, 24, and 25, respectively. Claims 21-25, 8, and 10, issued as renumbered patent claims 1-7 (Finding 65).

The device of the original claims rejected by the Examiner based on prior art did not contain certain limitations:

Limitation A: "a reinforcing groove centrally located in said hood portion at a right angle to said perforated plate" --found in patent claims 1, but not original application claims 1, 11, and 17.

Limitation **B**: “at least one L shaped retainer member to hold said hood to said abutment surface” --found in patent claims 2, 4, and 5, but not original application claims 1, 11, and 17.

Because limitations **A** and **B** are absent from the reissue claims being rejected and since those limitations are germane as to why the prior art did not reach claims containing limitations **A** and **B**, the Examiner has correctly placed the claims sought to be reissued within Substep (3)(a) of Step (3) of Clement.

As the Examiner accurately notes, with respect to reissue application claims 8 through 13 in the Examiner’s Answer entered November 27, 2002, at page 7:

[Independent] reissue claims 8 and 11 have been broadened . . . because applicant has removed the limitations relating to the “reinforcing groove” and the “L shaped retainer member”.

The Examiner’s accurate factual analysis demonstrates that the Examiner has made out a prima facie case of recapture.

3. Applicants' response to the Examiner’s case

(1) Arguments of Appeal Brief filed November 12, 2002

In the Appeal Brief filed March 17, 2003, Appellants cite numerous authorities for the proposition that they are not precluded from broadening a limitation added to a claim in obtaining its allowance. We agree that Appellants are not precluded, so long as Appellants show that at the time the

amendment was made, one skilled in the art could not reasonably have viewed the subject matter broader than any narrowing amendment as having been surrendered. As we have already fully discussed supra, Appellants are free to rebut the presumption of surrender based on evidence generally limited to (1) the prosecution history of the application which matured into the patent sought to be reissued and (2) showings related to what was known by a person having ordinary skill in the art at the time an amendment was made. Appellants have not favored us with such rebuttal argument and evidence in the record before us.

While Appellants' brief does not favor us with such argument and evidence with respect to Limitations **A** and **B** above, we note that Appellants do present such argument and evidence at page 5 of the brief with respect to the cancellation of claim 9. Appellants indicate that the record shows claim 9 was indicated as allowable, and while claim 9 was cancelled, the record shows it was not incorporated into another claim. Appellants argue these facts do not provide any support for a holding of surrender. We agree with Appellants' conclusion with respect to this cancellation.

Appellants only other argument is the decision in *Patecell v. U.S.*, 16 Cl.Ct 644, 12 U.S.P.Q.2d 1440 (US Claims Court 1989), is controlling given the facts before us. *Patecell* held that there is no recapture when "the reissue claim also is narrower than the cancelled claim in a way that is material to the 'error'" (See *Patecell*, 16 Cl.Ct at 652). As we have already

discussed supra, we believe *Clement* and *North American Container* stands for the proposition that the surrendered subject matter includes:

the subject matter of an application claim which was amended or canceled and, on a limitation-by-limitation basis, the territory falling between the scope of

- (a) the application claim which was canceled or amended and
- (b) the patent claim which was ultimately issued.

Accordingly, we disagree with Appellants' *Patecell* argument.

(2) Arguments of Reply Brief filed January 29, 2003

Applicants, at page 2 of the Reply Brief, argues:

The court in *In re Clement* noted that canceling or amending a claim may indicate an admission by applicant that the scope of the claim before cancellation or amendment was not patentable, but also indicated that "it is not dispositive because other evidence in the prosecution history may indicate the contrary." 131 F.3d at 1469 (emphasis added).

We agree. However, Appellants then imply that the burden is on the Examiner to determine what comprises this "other evidence." We disagree. As discuss supra, the burden falls on Appellants to show that at the time the amendment was made, one skilled in the art could not reasonably have viewed the subject matter broader than any narrowing amendment as having been surrendered.

Appellants point to their requested withdrawal of the finality of the rejection and request for a chance to argue the allowability of cancelled claims. Although Appellants admit that the application was in condition for allowance, they contend that despite the above explicit request, the Examiner never gave Appellants a chance to argue the allowability of the cancelled claims. Thus, they contend that no surrender took place. We disagree. As set forth in 35 U.S.C. § 102, “A person shall be entitled to a patent unless [the Examiner can make out a prima facie rejection].” As a register practitioner before the United States Patent and Trademark Office, Appellants’ representative knows once the application was in condition for allowance the Examiner is precluded by law from further prosecution of the cancelled claims. We find Appellants’ request to be totally superfluous having no impact (one way or the other) on any resulting surrender.

Applicants, at page 3 of the Reply Brief, argues:

The *Clement* court noted that “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.” 131 F.3d 1464, 1471.

We agree. However, Appellants then fail to favor us with any explanation of how this is relevant to Limitations **A** and **B**. Again as discussed supra, the burden falls on Appellants to show that at the time the amendment was

made, one skilled in the art could not reasonably have viewed the subject matter broader than any narrowing amendment as having been surrendered.

(3) Arguments of Supplemental Reply Brief filed May 3, 2004

At page 2 of the Supplemental Reply, Applicants argue:

By eliminating recitation of the lid, reissue claims 8-13 . . . do not attempt to recapture coverage of a waste cart having a lid without a groove or retainer. Instead, reissue claims 8-13 do not recite a lid at all.

We disagree. Appellants' logic is flawed. A waste cart having the claimed false bottom and a lid without the groove or retainer would still infringe appellants' reissue claim. The effect of not reciting a lid *at all* is recapture of a waste cart having a lid without the groove or retainer. Our sole concern is whether Appellants can rebut this recapture by showing that at the time the amendment was made, one skilled in the art could not reasonably have viewed the subject matter broader than a lid with a groove or retainer as having been surrendered.

Appellants' Supplemental Reply does not favor us with any argument and evidence with respect to Limitations **A** and **B** above. Thus, we find no basis here for reversing the Examiner's rejection.

(4) Other arguments

We have considered all other arguments made by applicant in the Appeal Brief and subsequent Briefs. None has convinced us that the Examiner erred in rejecting reissue claims 8 through 13 based on recapture.

C. DECISION

Upon consideration of the record, and for the reasons given, the decision of the Examiner rejecting reissue claims 8 through 13 based on obviousness is reversed, and the decision of the Examiner rejecting reissue claims 8 through 13 based on recapture is affirmed.

AFFIRMED

JERRY SMITH)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
ALLEN R. MacDONALD)
Administrative Patent Judge)

APPENDIX 1

Brief description the drawings of Apps et al., U.S. Patent 5,899,468 (drawing sheets 1-5 of Apps et al. are attached as appendix pages 2-6).

Figure 1 on page 2 of this appendix is a perspective view of the exterior of a waste cart constructed according to the present invention.

Figure 2 on page 3 of this appendix is a partial cross sectional view of the organic waste cart of Figure 1 showing the interior details thereof.

Figure 3 on page 4 of this appendix is a side elevational cross sectional view through the waste cart of Figures 1 and 2.

Figure 4 on page 5 of this appendix is an exploded perspective view of the major components of the waste cart of Figures 1, 2, and 3.

Figure 5 on page 6 of this appendix is a front elevational view of the detachable vent structure of Figures 1 through 4.

Figure 6 on page 6 of this appendix is a side view of the vent structure of Figure 5.

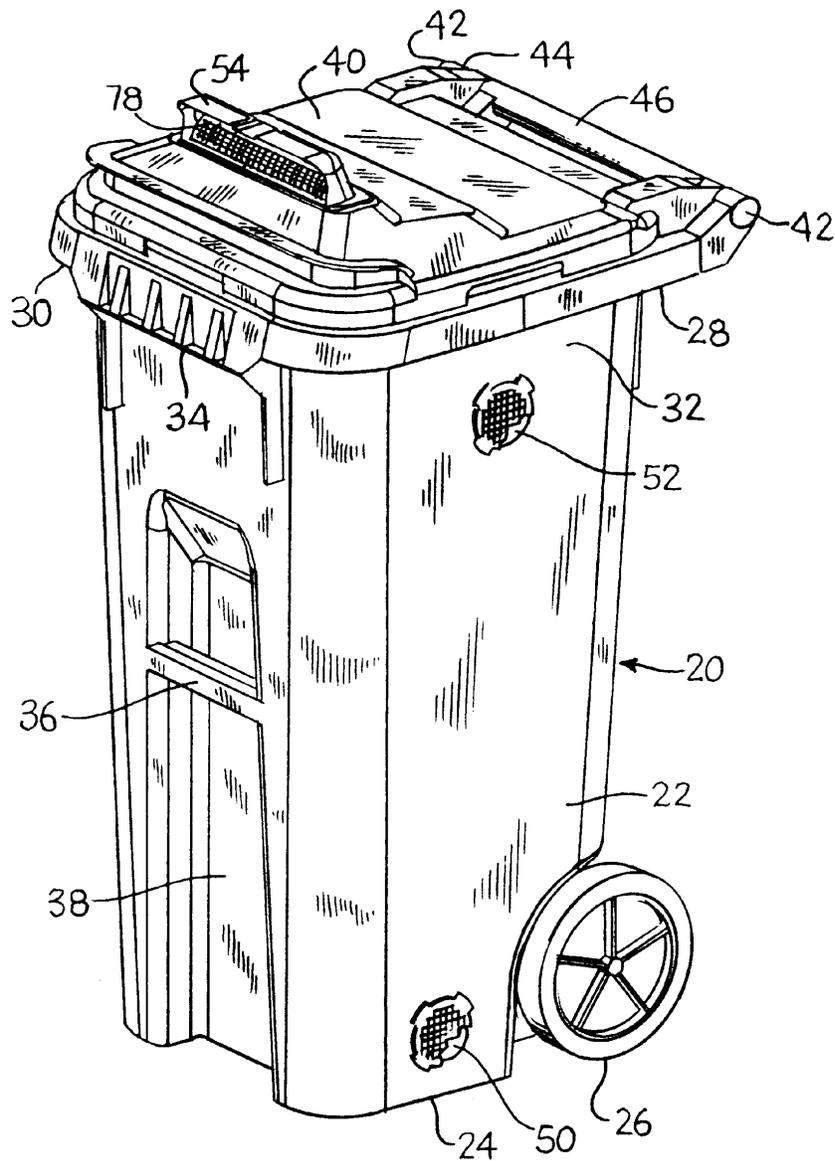


FIG. 1

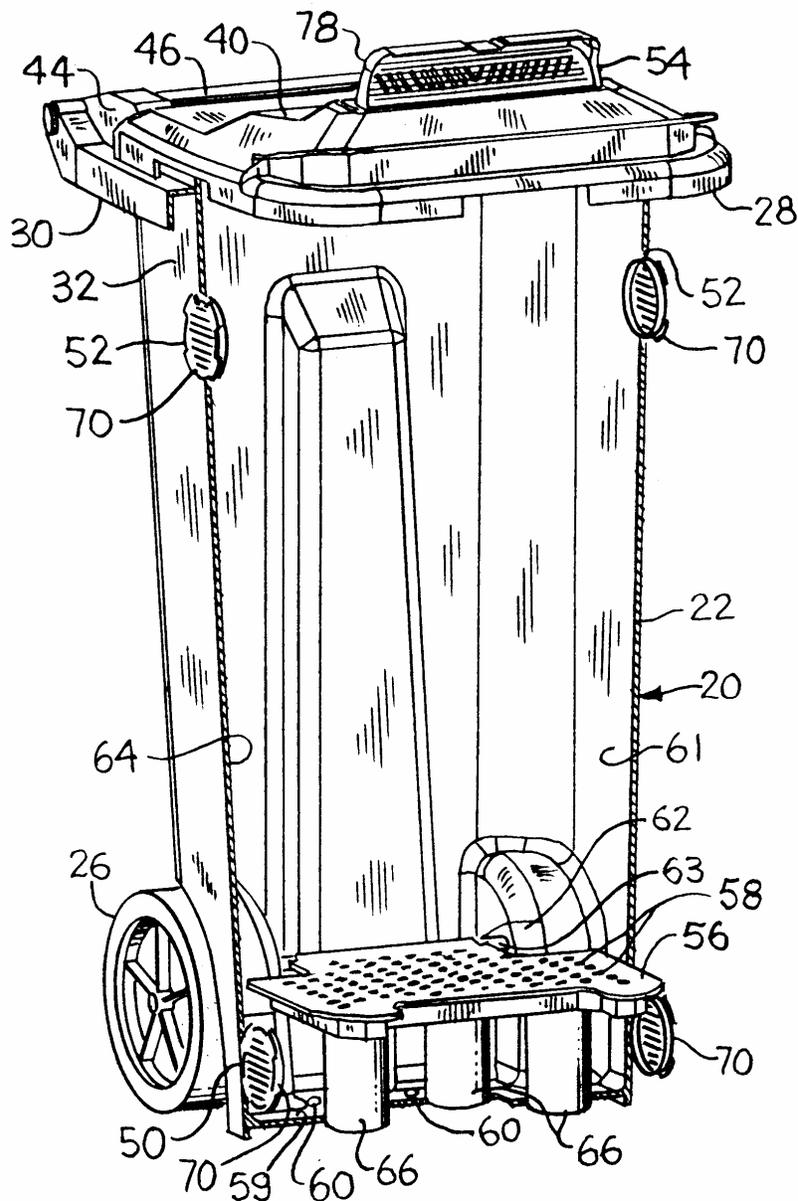


FIG. 2

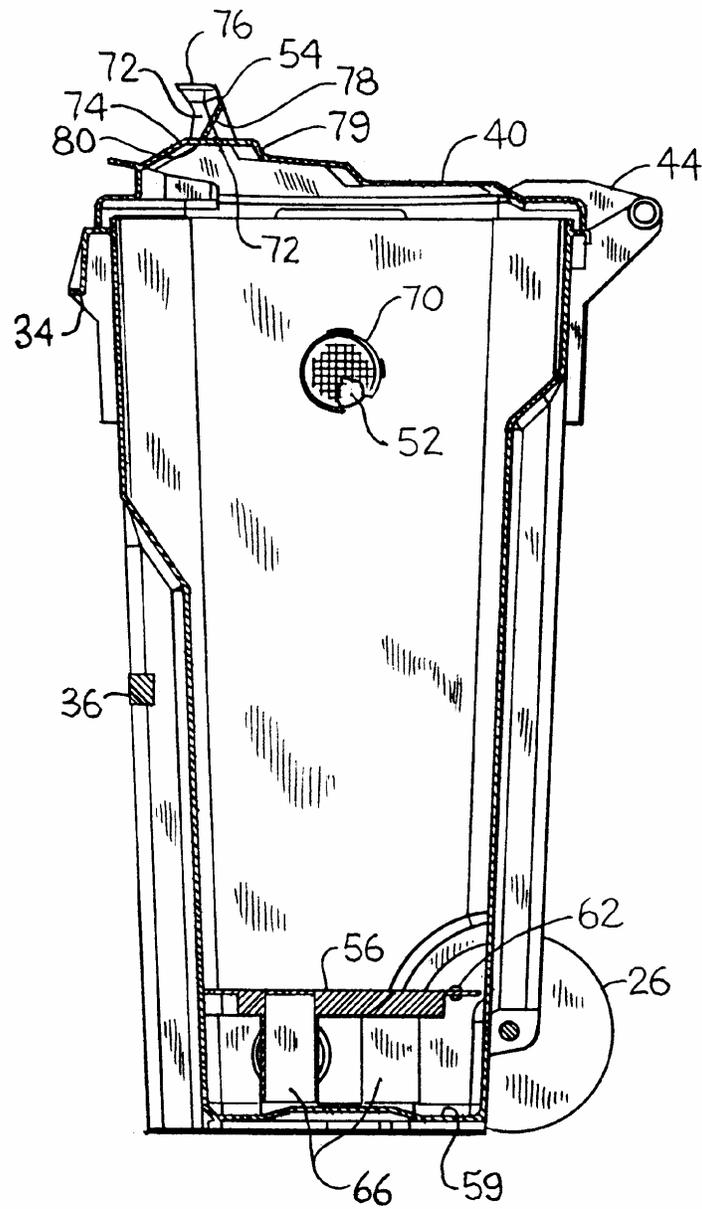


FIG. 3

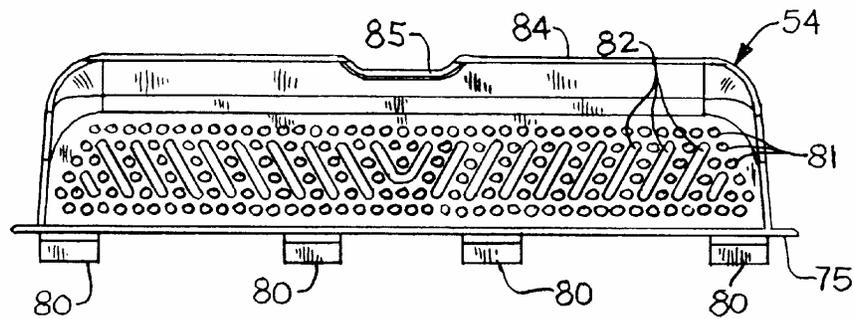


FIG. 5

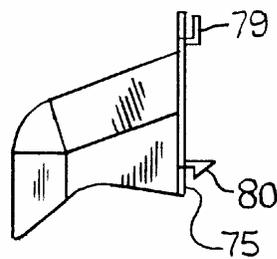


FIG. 6

Appeal 2005-0801
Application 09/848,628

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