

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RALPH F. GREENE and PATRICK C. MALONE

Appeal 2006-1068
Reissue Application 08/425,766¹
Technology Center 3700

Decided: September 13, 2006

Before GARRIS, JERRY SMITH, and MACDONALD, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Examiner's rejection of claims 1-20 in the above identified reissue application as being unpatentable under 35 U.S.C. § 251 based on recapture.

¹This application was filed April 19, 1995 and seeks reissue of U.S. Patent 5,203,267 which issued April 20, 1993.

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We AFFIRM.

The subject matter on appeal relates to a waste disposal apparatus comprising a first combustion chamber for incinerating waste material in an oxygen rich atmosphere to produce ash and exhaust containing gases and particulate matter, and a second combustion chamber for firing the exhaust containing gases and particulate matter in an oxygen starved atmosphere. Further details regarding this subject matter are set forth in representative independent claim 1 of this reissue application which reads as follows:

1. A waste disposal apparatus comprising:
 - a first combustion chamber for incinerating waste material in an oxygen rich atmosphere to produce ash and exhaust containing gasses and particulate matter;
 - an injector for blowing air into said first combustion chamber in excess of the amount required for normal combustion;
 - a second combustion chamber for firing said exhaust containing gasses and particulate matter in an oxygen starved atmosphere; and
 - a damper for restricting air flow into said second combustion chamber to an amount less than that required for normal combustion.

This reissue application claim is an amended form of claim 1 of the '267 patent for which reissue is here sought. This patent claim 1 is reproduced below:

1. A waste disposal apparatus comprising:
 - a first combustion chamber for incinerating waste material in an oxygen rich atmosphere to produce ash and exhaust containing gasses and particulate matter;
 - an injector for blowing air into said first combustion chamber in excess of the amount required for normal combustion;
 - a second combustion chamber for firing said exhaust containing gasses and particulate matter in an oxygen starved atmosphere;
 - a damper for restricting air flow into said second combustion chamber to an amount less than that required for normal combustion; and
 - a liquid filter for capturing said particulate matter contained in said fired exhaust and for chemically treating said fired exhaust gasses to reduce the quantity of CO, NO and SO contained in said fired exhaust.

It is uncontested on this appeal that reissue application claim 1 is an attempt by Appellants to enlarge the scope of patent claim 1 by omitting from the former the following limitation of the latter:²

²Similar scope enlargement is attempted via claim 15 which is the only other independent claim on appeal. Specifically, this appealed claim omits the following limitation from patent claim 15:

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a liquid filter for capturing said particulate matter contained in said fired exhaust and for chemically treating said fired exhaust gasses to reduce the quantity of CO, NO and SO contained in said fired exhaust.

Claims 1-20³ are rejected as being unpatentable under 35 U.S.C.

§ 251 based on the Examiner's determination that the Appellants'

aforenoted attempt to enlarge claim scope constitutes impermissible recapture.

liquid filter means for capturing said particulate matter contained in said fired exhaust and for chemically treating said fired exhaust gasses to reduce CO, NO, HCL and SO₂ contained in said fired exhaust.

The issues raised in this appeal relate equally to both of the Appellants' independent claims. Therefore, our analyses and determinations regarding representative claim 1 are fully applicable to claim 15. We focus on only claim 1 for clarity and ease of exposition.

³On page 3 of the Brief filed September 7, 1999, the Appellants state that "[a]ll [c]laims, 1-20, can be considered as a single group with respect to the applicability of the recapture rule." See then pending regulation 37 CFR § 1.192 (1999). Consistent with this statement, Appellants have not separately argued any of the dependent claims on appeal. We observe, however, that certain of the dependent claims appear to be not subject to the recapture criticism expressed by the Examiner. For example, claim 19, which depends from claim 1, recites the very limitation whose omission from claim 1 engendered the Examiner's recapture determination. Notwithstanding this circumstance, we will restrict our assessment of this appeal by focusing only on representative independent claim 1 in conformance with the Appellants' aforequoted statement.

For a complete exposition of the opposing viewpoints expressed by the Appellants and by the Examiner concerning the above noted rejection, we refer to the several briefs (including reply briefs) and to the several answers (including supplemental answers).

FINDINGS

1. The Appellants' '267 patent matured from application no. 07/804,474, filed December 6, 1991, which was a continuation of application no. 07/643,419, filed January 22, 1991, abandoned.

2. The '419 application was filed with original claims which included independent claim 1 directed to a waste disposal apparatus comprising a first combustion chamber, a second combustion chamber and "a liquid filter for capturing particulate matter contained in said fired exhaust and for chemically treating said exhaust to reduce the quantity of CO, NO, and SO contained in said fired exhaust." This liquid filter limitation corresponds to the limitation omitted from appealed claim 1 which omission is regarded by the Examiner as violating the recapture rule. The '419 application included other original independent claims drawn to a method for disposing of waste material and a waste disposal system, and these other independent claims included similar filter limitations.

3. In response to a restriction requirement, the claims elected for prosecution in the '419 application included independent claim 1, and this claim

was rejected under 35 U.S.C. § 103 as being unpatentable over prior art patents to Hadley and to Kent. Via a paper filed August 19, 1991, the Appellants responded to this rejection with arguments which include the following:

Not only does Hadley '652 fail to teach or suggest either the first and second combustion means of Claims 1 - 14 and 22 - 25, Hadley also fails to teach or mention a liquid filter arrangement as described and claimed by Applicants. Hadley only demonstrates use of a conventional baghouse 20 which performs just a part of the function of Applicants' liquid filter -- apparently some particulate matter is captured in the baghouse -- there is no mention or suggestion of a chemical treatment to reduce the quantity of CO, NO, SO, HCL or SO₂ as is required by the Claims of Applicants' invention. [*Id.*, page 3.]

....

Finally, Kent shows a cooling and neutralizing tower that the Examiner suggests meets the limitation of Applicants' invention for a liquid filter. Applicants respectfully submit that the cooling and neutralizing tower of Kent is entirely different and serves a completely separate purpose from the "liquid filter" of Claims 1 - 14 and the "liquid means" of Claims 22 - 25. In Claims 1 - 14, the liquid filter is for "capturing particulate matter contained in said fire exhaust and for chemically treating said exhaust to reduce the quantity of CO, NO and SO" while in Claims 22 - 25, the liquid means is for "capturing particulate matter . . . and for chemically treating said fired exhaust to reduce CO, NO, HCL and SO₂." Nothing in the cooling and neutralizing tower of Kent meets these two limitations. To the contrary, in his disclosure beginning at Col. 6, line 59, Kent states that the purpose of the cooling tower is simply to cool the fired exhaust to reduce the temperature of the particulate matter. Nothing in Kent suggests that he adds anything other than water or that any other chemical reaction is taking place.

Further, Kent does not teach or suggest that his cooling tower can be used to remove the chemical compounds described in Applicants' claim. Clearly, Kent does not teach or suggest any feature of Applicants' invention as described in Claims 1 - 14 and 22 - 25.

Applicants have shown that each of the references relied on omit critical features of Applicants' invention. Moreover, no reference teaches or suggests the use of first and second combustion chambers where the first combustion chamber incinerates waste material "in an oxygen rich atmosphere" and the second combustion chamber incinerates the fired exhaust in an "oxygen starved atmosphere." In addition, no reference teaches or suggests a liquid filter that both captures particulate matter and treats the exhaust "to reduce the quantity of CO, NO and SO." Applicants therefore respectfully submit that the obviousness rejection has been traversed. [*Id.*, pages 4-5.]

4. The Examiner found these arguments unpersuasive and finally rejected the elected claims including claim 1 of the '419 application. In their November 12, 1991 response to this final rejection, the Appellants made the following arguments:

Applicant[s] further submit[] that the liquid filter of Claim 1 and the liquid filter means of Claim 22 require "recapturing said particulate matter contained in said fired exhaust and for chemically treating said fired exhaust gasses to reduce the quantity of CO, NO, and SO contained in said fired exhaust." This limitation is not taught or suggested in any of the references. While Hadley '652 does show the use of liquid sprays to neutralize the exhaust, his device does not serve the added function of capturing "said particulate matter". The nature of the exhaust in Applicants' invention has been more particularly described by the Amendment requiring that the exhaust contains both "gasses and particulate matter". Nothing in the prior art teaches or suggests Applicants' claimed liquid filter and liquid filter

means. [*Id.*, page 4.]

5. Because the Examiner continued to be unpersuaded by these arguments, the Appellants permitted the '419 application to become abandoned in favor of the '474 application. As in the parent application, the originally filed independent claims including claim 1 of the '474 application contained a liquid filter (or corresponding) limitation. These claims again were rejected by the Examiner under Section 103 as being unpatentable over Hadley and Kent. In their June 17, 1992 response to this rejection, the Appellants presented patentability arguments based on a number of claim features. However, none of these argued claim features included the liquid filter (or corresponding) limitation of the independent claims.

6. On June 30, 1992 in a non-final Office action, the Examiner rejected all claims under Section 103 as being unpatentable over the prior art patents to Houser and Kent and possibly Hadley (i.e., the record is unclear as to whether the non-final rejection included the Hadley reference). In response to this non-final rejection, the Appellants filed an appeal brief on October 29, 1992 wherein the following arguments were presented:

In the June 30, 1992 Office Action, the Examiner indicated that the Applicants' invention was unpatentable over U.S. Patent 4,958,578 to Houser in view of U.S. Patent 4,922,841 to Kent. There are, however, numerous differences between the references and the present application, and these references, alone or together, do not show, teach, or suggest the novel incineration system requiring (1) the oxygen enriched first combustion

chamber, (2) the oxygen starved second combustion chamber, and (3) the liquid filter of Applicants' invention. [*Id.*, page 3.]

....

.... Houser does not profess to reduce the oxides of nitrogen, CO, NO, HCL and SO₂ that may be found in the exhaust gases as do the Applicants. Houser instead requires a smokestack for the remaining gasses to be discharged. *See* Column 5, lines 18-58. The present invention cools and cleans the gasses and particulate after they leave the second chamber by means of a liquid filtering system, Claim 1, lines 13-16, Claim 22, lines 16-23, not shown or suggested in any of the references relied upon by the Examiner. Applicants' claimed invention avoids the need for a smokestack (none is shown or described in Applicants' disclosure) because the liquid filter removes the smoke! [*Id.*, page 5.]

....

.... The percolating, liquid filter module claimed by Applicants is very different from Houser's element 37. The liquid filtering module claimed by Applicants removes soluble compounds from the gasses and particulate by sending the gasses through the liquid so as to form a foam or froth which is circulated while the trapped bubbles rise to the surface and continue on to a neutralizer module 100. The liquid filter system not only operates differently than Houser but functions to remove completely different substances, e.g., CO, NO, SO, and SO₂. Claim 1, lines 13-16; Claim 22, lines 20-23; Claim 25. [*Id.*, page 6.]

....

Hadley discloses a dual combustion chamber arrangement, but like Houser, does not show, teach, or suggest using an oxygen rich atmosphere in

the first chamber, an oxygen starved atmosphere in the second chamber, and a liquid filter. The present invention specifies such atmospheres for the chambers and a liquid filter. Claim 1, lines 2-4, 7-9; Claim 22, lines 4-6; 9-11. [*Id.*, page 7.]

....

.... The Applicants' claimed invention incorporating a liquid filtering module avoids entirely the need for a smokestack. Claim 1, lines 13-16; Claim 22[,] lines 15-23. The filtering components or steps operate to remove or reduce oxides of nitrogen, CO, NO, HCL and SO₂ that the Hadley patent does not even mention, much less teach how to remove or reduce to a level that can be directly vented to the atmosphere. [*Id.*, page 7.]

....

.... Most of the differences between the previous two patents relied upon by the Examiner and the present invention hold true for Kent as well: The Kent system does not use an oxygen rich first chamber and an oxygen starved second chamber; does not use an air injection system that moves the waste material and imparts a specified trajectory; does not use a percolating, liquid filter; does not remove specified chemicals and heat from the gasses and particulate to a degree that the gasses and remaining particulate may be vented without a smokestack. [*Id.*, page 8.]

....

Conclusion

There are distinctive, critical differences between the Applicants' invention and the prior art. The three references cited as prior art do not show, teach, or suggest using air injectors to inject air and waste material into an oxygen rich first combustion chamber, delivering exhaust to an oxygen starved second combustion chamber, or using a liquid filter to remove the specified chemicals so as not to require a smokestack for release of the exhaust as expressly claimed by Applicants. [*Id.*, page 8.]

7. In response to the aforementioned brief, the Examiner issued a Notice of Allowability on December 22, 1992 stating “[u]pon reconsideration of the prior art references and claims rejected, the reasons for allowance of claims 1-14, 22-25 is [sic] the inclusion of ‘the liquid filter of chemically treating the exhaust gases to reduce Co, No and So gases’ [sic] which the prior art references fail to show or suggest” (page 2). Subsequently, the ‘474 application matured into the ‘267 patent for which the Appellants seek reissue on this appeal.

OPINION

We shall sustain this rejection for the reasons expressed in the principal and the supplemental answers and for the reasons expressed below.

It is the Examiner's basic position that appealed claim 1 is an attempt by Appellants to impermissibly recapture subject matter surrendered by them through deliberate arguments repeatedly made during prosecution before the Patent and Trademark Office in their successful endeavor to avoid prior art and obtain the ‘267 patent for which reissue is sought. As support for his position, the Examiner

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relies primarily on *Hester Indus. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998).

The Findings Support a Prima Facie Case of Unpatentability Based on Recapture

As previously indicated, the Examiner primarily relies on *Hester Indus. v. Stein, Inc.*, *id.* in support of his Section 251 rejection based on recapture. In *Hester*, the court expressed the established principles that, under the recapture rule, reissue claims are impermissible if broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution and that a reissue claim which does not include a limitation present in the original patent claims is broader in that respect. *Id.*, 142 F.3d at 1480, 46 USPQ2d at 1648. In assessing whether the broader aspects of reissue claims relate to surrendered subject matter, the *Hester* court explained that, like claim cancellation or claim amendment, arguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender. *Id.*, 142 F.3d at 1480-81, 46 USPQ2d at 1648-49. Because the reissue claims of *Hester* did not include certain limitations which were present in the original patent claims and which had been repeatedly argued as distinguishing the original claims from the prior art, the court determined that there had been a surrender of claim scope which did not include these limitations. *Id.*, 142 F.3d at 1482, 46 USPQ2d at 1649. Finally, the court explained that the surrendered subject matter had crept back into the reissue claims based on the simple analysis that the reissue

claims did not contain the limitations argued during prosecution and therefore were contrary to the arguments on which the surrender was based. *Id.*, 142 F.3d at 1482, 46 USPQ2d at 1649.

In many pivotal respects, the findings in this case parallel the facts of *Hester*. Similar to *Hester*, the Appellants' reissue application claim 1 does not include the liquid filter limitation in claim 1 of their '267 patent and accordingly the former is broader than the latter in that respect. This limitation, as with the *Hester* case, was present in the originally filed independent claims prosecuted by Appellants (i.e., in the '419 and '474 applications). Moreover, during this prosecution (as during the *Hester* prosecution), the Appellants repeatedly argued that the liquid filter limitation distinguished their claims from the prior art.

For example, as correctly observed by the Examiner (e.g., see page 5 of the answer mailed December 21, 1999) and as noted in Finding 3 above, the Appellants' prosecution of the '419 application included repeated arguments in the paper filed August 19, 1991 that neither of the applied prior art patents to Hadley or Kent taught or suggested the liquid filter limitation of claim 1 (see the aforementioned arguments from pages 3, 4, and 5 of this paper). Indeed, on page 5 of this paper (in reference to earlier arguments concerning various claim features including the liquid filter limitation), it was argued "Applicants have shown that each of the references relied on omit *critical* features of Applicants' invention" (emphasis added). We agree with the Examiner that these arguments and use of

the word “critical” concerning the liquid filter limitation evince surrender of claim scope which does not include this limitation.

This surrender is also evinced by arguments subsequently advanced in the paper filed November 12, 1991. As noted at Finding 4, *supra*, the Appellants presented arguments on page 4 of this paper that the liquid filter limitation of claim 1 in the ‘419 application “is not taught or suggested in any of the references” and that “[n]othing in the prior art teaches or suggests Applicants’ claimed liquid filter”

We also agree with the Examiner that evidence of surrender was created by the Appellants’ prosecution of their continuing ‘474 application. Specifically, as explained by the Examiner on page 6 of the Answer mailed December 21, 1999 and as observed at Finding 6 above, the Appeal Brief filed October 29, 1992 repeatedly presented arguments that the liquid filter limitation (i.e., of independent claim 1 in the continuing ‘474 application) distinguished over the prior art. These arguments are quoted at Finding 6 and appear on pages 3, 5, 6, 7, and 8 of the aforementioned Brief. Furthermore, in their concluding argument on page 8 of this Brief (see the corresponding quotation at Finding 6), the Appellants again characterized as “critical” the differences between their invention and the prior art, and these differences included the liquid filter limitation of the claims then on appeal.

To summarize the foregoing circumstances, during prosecution of both the

'419 application and the continuing '474 application, the Appellants repeatedly argued that their liquid filter limitation distinguished over the prior art and repeatedly characterized this claim feature as critical. These factual circumstances, like the corresponding circumstances in *Hester*, establish a prima facie case that the Appellants, by way of repeated arguments, disavowed and thereby surrendered claim scope not restricted to the argued liquid filter limitation.⁴ Likewise as in *Hester*, it is clear that the surrendered subject matter has crept back into appealed reissue application claim 1 by virtue of the fact that the claim does not contain the liquid filter limitation and accordingly is contrary to the arguments on which the surrender is based.

It follows that the above discussed facts of this appeal establish a prima facie case that appealed claim 1 constitutes an attempt by Appellants to recapture subject

⁴As previously noted at Finding 5, this limitation was not argued by Appellants in their June 17, 1992 response to a prior art rejection. This sole instance of nonargument does not neutralize the inference of surrender evinced by the multiple liquid filter arguments presented during prosecution of the '419 and '474 applications.

matter surrendered via arguments made during their successful prosecution efforts to obtain the '267 patent.

The Appellants' Position in Support of Reissue

The Appellants' response to the Examiner's rejection includes only argument, no evidence. Specifically, it is the Appellants' fundamental contention that the facts of their case meaningfully differ from those of *Hester*. In this regard, the Appellants correctly point out that the arguments made during prosecution of their '419 and '474 applications involved claim features other than the liquid filter. According to the Appellants, the liquid filter limitation was only one of several that were argued as distinguishing over the prior art. In contrast, the Appellants state that "the applicants in *Hester Industries* repeatedly emphasized the two claim limitations, it later tried to recapture as the distinguishing factors over the prior art" (Brief, filed September 7, 1999, page 6). The Appellants emphasize this contrast by urging that, during prosecution of their applications, they "did not in any way express the liquid filter element in such a manner that the Applicants made it the primary basis for distinguishing over the prior art[; rather,] [i]t is [sic, was] simply argued as one of several distinctions" (*Id.*, at page 8). In summary, it is the Appellants' position that "*Hester Industries* needs to be limited to those cases where there is an undisputable surrender of subject, such as an

attempt to recapture all the limitations claimed as critical during prosecution” (*Id.*, at page 9).

The Appellants’ position is without persuasive merit for a number of reasons.

First, the position is based on the presumption that, in *Hester*, the two claim limitations discussed with respect to recapture were the *only* two limitations argued during prosecution. However, it is by no means clear from the *Hester* opinion that such a presumption is correct. In any event, we find nothing and the Appellants identify nothing in this opinion which supports their proposition that *Hester* is or should be “limited to those cases where there is an undisputable surrender of subject, such as an attempt to recapture all the limitations claimed as critical during prosecution” (*Id.*).

We perceive little if any convincing merit in the Appellants’ point that the liquid filter limitation was only one of several which were argued during prosecution of their applications. This is because the legal relevancy of the point is questionable and because the point is outweighed by several countervailing facts indicative of surrender. In this latter regard, surrender is evinced by the fact that, during prosecution of their ‘419 and ‘474 applications, Appellants repeatedly characterized the liquid filter limitation (as well as others) as critical. On the other hand, not once during this prosecution was the liquid filter feature ever characterized as, or otherwise indicated to be, a limitation unnecessary for distinguishing over the prior art. For example, this claim feature was never

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characterized as an alternative but unnecessary basis for patentability. Similarly, the Appellants did not once in either of their applications present for prosecution an independent claim which did not contain the liquid filter limitation.

A final point highlights the unacceptability of the Appellants' position that "*Hester Industries* needs to be limited to those cases where there is an undisputable surrender of subject, such as an attempt to recapture all the limitations claimed as critical during prosecution," (Brief, filed September 7, 1999, page 9). It is the point that, during prosecution of their applications, the Appellants argued as critical distinctions over the prior art virtually *all* of the limitations recited in claim 1 of their '267 patent (e.g., see the Brief, filed October 29, 1992 in the '474 application, in its entirety and the conclusion section thereof on pages 8-9 specifically). As a consequence, if surrender were to be restricted in the manner urged by Appellants, there would be no possibility of recapture of any kind under the circumstances of this case. The unacceptability of such an outcome is self evident.

The Appellants' position is unconvincing in yet another respect. In the Examiner's view, recapture is not avoided in this case merely because the liquid filter limitation was only one of several claim features argued during prosecution as distinguishing over the prior art. As support for this view, the Examiner makes the following point on page 4 of his December 21, 1999 Answer:

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The applicability of Hester [i.e., the *Hester* decision] to the present case is further bolstered by decisions in Southwall Technologies Inc. v. Cardinal IG Co., [54 F.3d 1570, 1583,] 34 USPQ2d [1673,] 1682 [(Fed. Cir. 1995)]:

Estoppel extends beyond the basis of patentability, however. Clear assertions made during prosecution in support of patentability, whether or not actually required to secure allowance of the claim, may also create an estoppel.

and in Desper Products Inc. v. Qsound Labs Inc., [157 F.3d 1325, 1340,] 48 USPQ2d 1088[, 1099 (Fed. Cir. 1998)]:

The fact that the . . . reference could have been distinguished, standing alone, on different grounds is immaterial The public has a right to rely on the assertions made by a patent applicant to secure allowance of its claims. Post-hoc, litigation-inspired argument cannot be used to reclaim [abandoned] subject matter.

The Examiner's point is well taken. With respect to the issue of surrender, it is irrelevant that the liquid filter limitation was only one of several claim features argued during prosecution and that the limitation ultimately proved to be unnecessary for distinguishing the claim from the prior art. As explained in *Norian Corp. v. Stryker Corp.*, 432 F.3d 1356, 1361-62, 77 USPQ2d 1242, 1247 (Fed. Cir. 2005), this is because:

[T]here is no principle of patent law that the scope of a surrender of subject matter during prosecution is limited to what is absolutely necessary to avoid a prior art reference that was the basis for an examiner's rejection. To the contrary, it frequently happens that patentees surrender more through

amendment than may have been absolutely necessary to avoid particular prior art. In such cases, we have held the patentees to the scope of what they ultimately claim, and we have not allowed them to assert that claims should be interpreted as if they had surrendered only what they had to.

The Appellants seem to believe that the above discussed point is not applicable to the circumstances of their case. In this regard, the Appellants emphasize that “the present case is not a prosecution history estoppel case” and argue that “the present case needs to be decided under the rules and holdings of *Hester Industries* and its progeny, not prosecution history estoppel cases” (Reply Brief, filed March 22, 2000, page 5).

We do not share the Appellants’ apparent belief that the principles of the above cited decisions are restricted to prosecution history estoppel under the doctrine of equivalents and therefore are not applicable to the reissue case under consideration. As fully explained in *Hester*, 142 F.3d at 1481-82, 46 USPQ2d at 1649, “[t]he analogy [of prosecution history estoppel] is with the recapture rule, which restricts the permissible range of expansion through reissue just as prosecution history estoppel restricts the permissible range of equivalents under the doctrine of equivalents.” Therefore, notwithstanding the Appellants’ contrary view, we consider as well taken the Examiner’s point that the Appellants have surrendered claim scope which does not include the liquid filter limitation even though this limitation was only one of several argued during prosecution and even

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though the limitation ultimately was not necessary for distinguishing claim 1 of the '267 patent from the prior art.

Finally, we have fully considered the remaining arguments advanced by the Appellants but consider them to be unpersuasive of error on the Examiner's part. For example, contrary to the Appellants' argument in the Reply Brief filed March 14, 2005, *Ex parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003) is not relevant to the subject appeal because it is not applicable to the pivotal issue before us, namely, surrender based on prosecution arguments.

Summary

For the reasons set forth above and in the principal and supplemental answers, it is our ultimate determination that the Examiner has established a prima facie case of recapture which the Appellants have failed to successfully rebut with argument or evidence to the contrary. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)(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). Therefore, based on the totality of the record before us, we determine that the

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Appellants, through their admission effected by way of repeated prosecution arguments, have surrendered claim scope not restricted to the liquid filter limitation. Because appealed claim 1 unquestionably encompasses this surrendered claim scope, this claim violates the recapture rule.⁵

We hereby sustain, therefore, the Examiner's rejection of appealed claims 1 through 20 of this reissue application as being unpatentable under 35 U.S.C. § 251 based on recapture.

CONCLUSION

The decision of the Examiner is affirmed.

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

AFFIRMED

BRADLEY R. GARRIS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES

⁵For completeness, we point out that claim 1 has not been materially narrowed in any respect and therefore no possibility exists that the recapture rule might be avoided in the subject appeal by virtue of a material narrowing. *See Hester*, 142 F.3d at 1482-83, 46 USPQ at 1649-50.

Judge MacDonald, *concurring*.

A. Discussion

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 USPQ2d 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 USPQ2d 1521, 1524 (Fed. Cir. 1993), quoting from *Haliczer v. United States*, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966).² *See also Hester Industries Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480, 46 USPQ2d 1641, 1647 (Fed. Cir.), *cert. denied*, 525 U.S. 947 (1998).

² *Haliczer* is binding precedent. *See South Corp. v. United States*, 690 F.2d 1368, 215 USPQ 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).

(3)

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 USPQ2d 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 USPQ2d 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 USPQ2d 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 USPQ2d 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 USPQ2d 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 USPQ2d 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 USPQ2d 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 USPQ2d 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

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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 USPQ2d 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 USPQ 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 USPQ2d 1597, 1600 (Fed. Cir. 2001); (2) *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 and (3) *Hester*, 142 F.3d at 148, 46 USPQ2d at 1648-49. However, the *Eggert* majority also held that the surrendered subject matter was the rejected claim only rather than the amended

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portion of the issued claim. 67 USPQ2d 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 USPQ2d 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 USPQ2d 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 the 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 USPQ2d at 1649:

[A]s recognized in Ball, the recapture rule is based on principles of equity³] 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.

³ 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 USPQ 413, 416 (Fed. Cir. 1985) (in banc); *In re Willingham*, 282 F.2d 353, 354-55, 127 USPQ 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

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 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 USPQ2d 1865, 1899 (Fed. Cir. 2000) (Festo I), *vacated and remanded*, 535 U.S. 722, 122 S. Ct. 1831, 62 USPQ2d 1705 (2002) (Festo II)⁴ (Michel, J.,

relying on prosecution history, become patent infringers when they do so." 998 F.2d at 996, 27 USPQ2d at 1525.

⁴ 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.

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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.

(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 USPQ2d 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 USPQ2d 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

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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 USPQ2d 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 USPQ2d 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)

Public Notice

We believe that any recapture analysis must be bottomed principally on a “public notice” analysis that 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 arguments and amendments are presented during prosecution. When an argument or 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*

As already discussed by Judge Garris, the Examiner’s factual analysis demonstrates that the Examiner has made out a *prima facie* case of recapture. Thus, I find the Examiner’s rejection has created a rebuttable presumption that at the time of the arguments one skilled in the art would reasonably have viewed the subject matter of the argument as having been surrendered.

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3. *Applicant's response to the examiner's case*

For the reasons discussed by Judge Garris with respect to Appellants' failure to rebut the Examiner's *prima facie* case, I similarly find Appellants have not rebutted the presumption, upon which the Examiner's rejection is based, that at the time of the arguments one skilled in the art would reasonably have viewed the subject matter of the argument as having been surrendered.

B. Decision

Upon consideration of the record, and for the reasons given, the decision of the Examiner rejecting reissue claims 1-20 based on recapture is *affirmed*.

AFFIRMED

ALLEN R. MACDONALD
Administrative Patent Judge

) BOARD OF PATENT
)
) APPEALS AND
)
) INTERFERENCES

Judge Jerry Smith, *concurring*.

A. Discussion

1. *The Examiner's prima facie case*

I concur with the opinions of Judge Garris and Judge MacDonald. The Examiner has made out a *prima facie* case of recapture.

2. *Applicant's response to the examiner's case*

I concur with the opinions of Judge Garris and Judge MacDonald. Appellants fail to rebut the Examiner's *prima facie* case.

B. Decision

Upon consideration of the record, and for the reasons given, the decision of the Examiner rejecting reissue claims 1-20 based on recapture is *affirmed*.

AFFIRMED

JERRY SMITH
Administrative Patent Judge

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