

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JIMMY L. HOLLINGSWORTH, JR.

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Appeal 2007-0040  
Application 10/170,069<sup>1</sup>  
Patent 6,073,699  
Technology Center 3600

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Decided: June 25, 2007

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*Before* FRED E. MCKELVEY, HOWARD B. BLANKENSHIP,  
and ALLEN R. MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

AFFIRMED

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<sup>1</sup> Application filed June 12, 2002, seeking to reissue U.S. Patent 6,073,699 issued June 13, 2000, based on Application 09/036,271, filed March 6, 1998. The real party in interest is Weatherford/Lamb, Inc. (Br. 2).

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

## I. STATEMENT OF CASE

1. Appellant appeals under 35 U.S.C. § 134 from a Final Rejection (the “Final”) of reissue claim 4 entered June 12, 2003. We have jurisdiction under 35 U.S.C. § 6(b). A hearing was held on May 22, 2007.

2. Independent reissue claim 4 is the sole claim on appeal.

3. Reissue claim 4 reads as follows:

4. An elevator for use in wellbore operations, the elevator comprising

a first body part,

a second body part,

the body parts together defining an interior opening through the elevator for accommodating a wellbore tubular therein,

first hinge apparatus hingedly connecting the two body parts together and permitting the two body parts to be hingedly openable on a first side of the elevator, and

second hinge apparatus disposed across from the first hinge apparatus, the second hinge apparatus hingedly connecting the two body parts together and permitting the two body parts to be hingedly openable on a second side of the elevator.

4. The Examiner rejected reissue claim 4 under 35 U.S.C. § 251 as being an improper recapture of surrendered subject matter (Final 2-3; Answer 3-4; and Supplemental Answer 4-5).

5. Claims 1-3 are not rejected.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

6. With respect to the rejection of claim 4, the panel affirms the decision of the Examiner.

7. Additionally, the panel enters a new ground of rejection under 35 U.S.C. § 102(b).

## II. ISSUES

The sole issue before the Board is whether Appellant has established that the Examiner erred in rejecting claim 4 under 35 U.S.C. § 251 based on recapture.

## III. FINDINGS OF FACT

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

### *A. The Invention*

1. According to Appellant (U.S. Patent 6,073,699, Abstract):

A new elevator for use in wellbore operations has been invented which, in certain aspects, has a first body part, a second body part, the body parts together defining a interior opening through the elevator for accommodating a wellbore tubular therein, first hinge apparatus hingedly connecting the two body parts together and permitting the two body parts to be hingedly openable on a first side of the elevator, and second hinge apparatus disposed across from the first hinge apparatus, the second hinge apparatus hingedly connecting the two body parts together and permitting the two body parts to

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

be hingedly openable on a second side of the elevator. In certain aspects such an elevator has at least one roller secured to an interior of at least one of the body parts to facilitate movement of a wellbore tubular with respect to the elevator, and in particular aspects has a plurality of spaced apart rollers. In one such elevator the plurality of rollers is one or more rollers on each body part.

B. *Prosecution history of the original application*

2. The patent sought to be reissued is based on Application 09/036,271, filed March 6, 1998 (the “original application”).
3. As filed, the original application contained claims 1-5 including representative independent claim 1 (identical to reissue claim 4 *supra*) which is reproduced below:

1. An elevator for use in wellbore operations, the elevator comprising

- a first body part,

- a second body part,

- the body parts together defining an interior opening through the elevator for accommodating a wellbore tubular therein,

- first hinge apparatus hingedly connecting the two body parts together and permitting the two body parts to be hingedly openable on a first side of the elevator, and

- second hinge apparatus disposed across from the first hinge apparatus, the second hinge apparatus hingedly connecting the two body parts together and permitting the two

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

body parts to be hingedly openable on a second side of the elevator.

4. On May 12, 1998, Appellant filed a Preliminary Amendment adding claims 6-20 and canceling claim 5.

5. After filing of the Preliminary Amendment:

(1) The claims consist of independent claims 1, 10, and 16; and dependent claims 2-4, 7-9, 11-15, and 17-20.

(2) Dependent claims 11-15 do not depend from any independent claim and instead cyclically depend from each other.

6. On July 12, 1999, Appellant filed a Second Preliminary Amendment<sup>2</sup> adding claims 21-27 and canceling claims 1-4, 6, 9, 16-18, and 20.

7. After filing of the Second Preliminary Amendment:

(1) The claims consist of independent claims 10, 21, 23, 25, and 26; and dependent claims 7, 8, 11-15, 19, 22, 24, and 27.

(2) Dependent claims 7 and 8 are amended to depend from newly added claim 21.

(3) Dependent claim 19 is not similarly amended and depends from canceled claim 17.

(4) Dependent claims 11-15 are not amended and still depend from each other.

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<sup>2</sup> At filing the Second Preliminary Amendment was mislabeled as “Third Preliminary Amendment.” The Office relabeled the amendment.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

8. After filing of the Second Preliminary Amendment, the original application contained claims 7-8, 10-15, 19, and 21-27 including representative independent claims 10 and 21, and dependent claim 11, which are reproduced below:

10. A wellbore tubular support system comprising

- an upper elevator for selectively and releasably holding a string of wellbore tubulars,
- upper elastic straps connected to and beneath the upper elevator,
- swivel apparatus below the upper elevator and to which the upper elastic straps are connected,
- lower elastic straps connected to and below the swivel apparatus, and
- a lower elevator below the swivel apparatus and to which the lower elastic straps are connected.

11. The wellbore tubular support system of claim 13, wherein the elevator comprises

- a first body part,
- a second body part,
- the body parts together defining an interior opening through the elevator for accommodating a wellbore tubular therein,
- first hinge apparatus hingedly connecting the two body parts together and permitting the two body parts to be hingedly openable on a first side of the elevator, and

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

second hinge apparatus disposed across from the first hinge apparatus, the second hinge apparatus hingedly connecting the two body parts together and permitting the two body parts to be hingedly openable on a second side of the elevator.

21. An elevator for use in wellbore operations, the elevator comprising

a first body part,

a second body part,

the body parts together defining an interior opening through the elevator for accommodating a wellbore tubular therein,

the body parts connected together and hingedly openable on a side of the elevator,

at least one first roller secured to at least one of the body parts to facilitate movement of a wellbore tubular within and with respect to the elevator,

wherein the least one first roller has a roller portion thereof protruding into the interior opening for contacting an exterior surface of a wellbore tubular within the interior opening.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

9. Simultaneously with the Second Preliminary Amendment, Appellant filed an Information Disclosure Statement (“IDS”) citing six prior art references and an International Search Report (listing the six references) from the International Application PCT/GB99/00664 corresponding to the original application.

10. The prior art submitted with the IDS included:

Holmes	US 1,021,984	Apr. 2, 1912
Schivley	US 4,834,441	May 30, 1989
Stringfellow	EP 0171144	Oct. 18, 1989

11. The International Search Report indicated for claims 1-5 of the PCT application<sup>3</sup>, with respect to Holmes and Schivley each taken separately, that “the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone.”

12. Which respect to the original application, Holmes, Schivley, and Stringfellow are prior art under 35 U.S.C. § 102(b).

13. On September 9, 1999, the Examiner entered a Non-Final Office Action (“Non-Final Action”).

14. Claims 7-8, 10-15, 19, and 21-27 were rejected on various grounds.

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<sup>3</sup> Appellant’s International Publication WO 99/45230 of International Application PCT/GB99/00664 shows that, although they are not duplicates, the contents of PCT claims 1-5 does correspond to originally filed claims 1-5 of Appellant’s original application 09/036,271.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

15. The prior art relied upon by the Examiner in rejecting the claims was:

Taylor	US 3,140,523	Jul. 14, 1964
Stringfellow	EP 0171144	Oct. 18, 1989

16. Which respect to the original application, Taylor and Stringfellow are prior art under 35 U.S.C. § 102(b).

17. Claims 11-15 and 19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because in-part (Non-Final 2):

(1) Dependent claims 11-15 do not depend from any independent claim and instead cyclically depend from each other.

(3) Dependent claim 19 depends from canceled claim 17.

18. Claim 10 was rejected under 35 U.S.C. § 102(b) as being anticipated by Stringfellow.

19. Claims 7 and 21-27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Taylor.

20. Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor.

21. In order to maintain a compact prosecution, the Examiner presumed that claim 11 properly depended from claim 10 and that claim 12 proper depended from either claim 10 or 11. Based on this presumption, claims 11-15 were rejected under 35 U.S.C. § 103 as being unpatentable over Stringfellow and Taylor.

22. On October 18, 1999, Appellant filed a Third Amendment (“the Third Amendment”) responding to the Examiner’s Non-Final Action.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

23. The Third Amendment canceled claims 7-8, 10-15, 19, and 21-27 (all pending claims) and added new claims 28-32. Newly added claim 28 is representative and is reproduced below:

28. An elevator for use in wellbore operations, the elevator comprising

a first body part,

a second body part,

the body parts together defining an interior opening through the elevator for accommodating a wellbore tubular therein,

the body parts hingedly connected together and hingedly openable on a side of the elevator,

at least one first roller secured to at least one of the body parts to facilitate movement of a wellbore tubular within and with respect to the elevator,

wherein the at least one first roller has a roller portion thereof protruding into the interior opening for contacting an exterior surface of a wellbore tubular within the interior opening, and

at least one second roller disposed beneath the first and second body parts and disposed entirely exteriorly of the interior opening to facilitate movement of a wellbore tubular with respect to the elevator.

24. After entry of the Third Amendment, the application claims were 28-32.

25. In the Third Amendment, Appellant argued:

Claims 7, 8, 10-15, 19, and 21-27 have been rejected for various reasons under § § 102, 103, and 112. These claims have been cancelled. No counterpart is presented here to any claim rejected under § 112.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

26. In the Third Amendment, Appellant also argued with respect to the patentability of newly added claims 28-32:

New claims 28-32 all include the limitation of at least one roller disposed beneath body parts and entirely exteriorly of an opening defined by the body parts. EP 171,144 [Stringfellow] has no teaching or suggestion of roller(s). Taylor, Jr. discloses multiple balls 33 or rollers 33; but Taylor, Jr. Has [sic] no teaching or suggestion of a roller beneath its elevators body sections 1 and 2.

27. Appellant's argument (see above) addressed at least the following limitation of Appellant's amended claim 28:

- (1) at least one second roller disposed beneath the first and second body parts and disposed entirely exteriorly of the interior opening.

Limitation (1) is found in some form in all of newly added claims 28-32.

28. On December 9, 1999, the Examiner entered a Final Office Action ("Final Action").

29. Claims 31-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor.

30. Claims 28-30 were indicated as allowable.

31. On December 21, 1999, Appellant filed a Fourth Amendment ("the Fourth Amendment") responding to the Examiner's Final Office Action.

32. The Fourth Amendment canceled claims 31-32.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

33. On January 11, 2000, a Notice of Allowability was mailed which stated that pending claims 28-30 were allowed.

34. Consistent with Office practice, application claims 28-30 were renumbered as patent claims 1-3 in the course of preparing the original application for issue.

35. U.S. Patent 6,073,699 issued June 13, 2000, based on the original application and contained claims 1-3.

*C. Prosecution of reissue application*

36. Appellant filed reissue application 10/170,069 on June 12, 2002, seeking to reissue U.S. Patent 6,073,699.

37. Appellant presented original patent claims 1-3 along with new reissue application claim 4 for consideration.

38. Ultimately, reissue claim 4 was rejected.

39. Reissue application claim 4 is before the Board in the appeal.

40. A copy of the claim 4 under appeal is set forth in the Statement of the Case *supra*.

*D. Examiner's Rejection under 35 U.S.C. § 251*

41. The Examiner has rejected reissue application claim 4 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.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

42. The Examiner based the rejection of claim 4 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 112 and a rejection under 35 U.S.C. § 103(a) over Taylor, Appellant made at least three *significant amendments* on October 18, 1999 (Supplemental Answer 4-5):

(A) Appellant cancelled rejected claim 11 which included all the limitations of reissue claim 4;

(B) Appellant cancelled all the remaining claims in the application; and

(C) Appellant added new claims 28-32 all of which included in some form the limitation of “at least one second roller disposed beneath the first and second body parts and disposed entirely exteriorly of the interior opening.”

Application claims 28-30 ultimately became patent claims 1-3.

43. Additionally, the Examiner based the rejection of claim 4 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 112 and a rejection under 35 U.S.C. § 103(a) over Taylor, Appellant made two *significant arguments* (Supplemental Answer 4):

(A) Appellant argued that no counterpart to claim 11 was being presented (see Finding of Fact 25); and

(B) Appellant argued that the limitation of “at least one roller disposed beneath body parts and entirely exteriorly of an opening defined by the body parts” distinguished over the prior art (see Finding of Fact 26).

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

44. The Examiner reasoned in part as follows (Supplemental Answer 5):

The applicant chose not to prosecute any variation of . . . claim 11 . . . and accepted that all [allowed] claims would include the limitation of at least one second roller disposed beneath the first and second body parts. . .

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[A]pplicant is not permitted to provide a claim omitting the limitation of at least one second roller disposed beneath the first and second body parts and disposed entirely exteriorly of the interior opening to facilitate movement of a wellbore tubular with respect to the elevator and rely instead on a the elevator being openable on both sides; such a claim (i.e., claim 4) is claim subject matter that applicant surrendered by the cancellation of the claim 11.

45. The record supports the Examiner's findings with respect to what limitations do not appear in reissue application claim 4 which were present in claims 1-3 of the original application, as allowed.

46. Additional findings of fact appear in the analysis and rejection sections *infra* as necessary.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

#### IV. DISCUSSION – REJECTION UNDER 35 U.S.C. § 251

##### A. *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

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

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).<sup>4</sup> See also *Hester Industries Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998).

(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

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<sup>4</sup> *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).

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

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 Appellant 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 in *Clement*, 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 rule 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

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

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

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

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 to 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 refined 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.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

(5)  
*Ex parte Eggert*

The 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*, a 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 Appellant 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 patent claim was ABCDEF, there would be recapture for ABC or anything broader than ABC, but not for claims directed to ABCX, ABCD<sub>Br</sub>, ABCEF, or A<sub>Br</sub>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

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

*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 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.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

(6)

*What subject matter is surrendered?*

In a case involving Substep (3)(a) of Step 3 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 Appellant's amendment was "an admission

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

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 Appellant 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 Appellant’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 Appellant 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 Appellant 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.]

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

(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 Step 3 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 Appellant 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 (or that the reissue claims are materially narrowed).

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.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

(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 equity<sup>5</sup> 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

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<sup>5</sup> 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 relying on prosecution history, become patent infringers when they do so." 998 F.2d at 996, 27 USPQ2d at 1525.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

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*, 988 F.2d 1165, 1174, 26 USPQ2d 1018, 1025 (Fed. Cir. 1993).

*See also* Judge Michel's opinion concurring-in-part and dissenting-in-part in *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)<sup>6</sup> (Michel, J.):

[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.

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<sup>6</sup> 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.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

(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).

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

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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).

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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

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

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 Appellant.

(11)

*Admissible evidence in rebuttal showing*

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

What evidence may an Appellant 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 will not attempt to divine, at this time, all evidence that might be relevant. As with other issues that come before the USPTO,

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

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.

“It is clear that in determining whether ‘surrender’ of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent.” *Kim v. Conagra Foods, Inc.*, 465 F.3d 1312, 1323, 80 USPQ2d 1495, 1502 (Fed. Cir. 2006). Thus, we also hold that an Appellant must show that at the time the amendment was made, an “objective observer” could not reasonably have viewed the subject matter broader than any narrowing amendment as having been surrendered (or that an “objective observer” would view the reissue claims as materially narrowed). The showing required to be made by Appellant is consistent with the public notice function of claims. Nevertheless, some limited extrinsic evidence may be relevant. However, extrinsic evidence unavailable to an “objective observer” at the time of the amendment is not relevant to showing that an “objective observer” 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 USPQ2d 1321, 1326 (Fed. Cir. 2003), *cert. denied*, 541 U.S. 988 (2004) (*Festo III*).

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

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.

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. . . 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

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

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.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

(12)

*Materially Narrowed in Overlooked Aspects*

When reissue claims are narrower than the patent claims with respect to features other than the surrender generating feature, then the reissue claims may be materially narrowed relative to the claims prosecuted and issued in the patent, thereby avoiding the recapture rule.

The Federal Circuit in *North American Container* characterized the second and third steps in applying the recapture rule as determining “whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution” and “whether the reissued claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.” 415 F.3d at 1349, 75 USPQ2d at 1556 (emphases added), citing for authority *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600. The language “materially narrowed in other respects” relates for comparison back to the earlier recited “broader aspects of the reissued claims” (i.e., surrendered subject matter). Thus, by using the phrase “in other respects” to modify “materially narrowed,” the court makes clear that reissue claims will avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter. This plain language in *North American Container* indicates that the recapture rule is avoided if the added limitations are a materially narrowing in respects other than the broader aspects relating to surrendered subject matter.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

In *Pannu*, the Federal Circuit described the second step of the recapture rule analysis as determining “whether the broader aspects of the reissued claim related to surrendered subject matter.” 258 F.3d at 1371, 59 USPQ2d at 1600 (quoting *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164). With regard to the third step, the court stated: “Finally, the Court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.” *Id.* (emphases added), citing for authority *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. As in *North American Container*, the language “materially narrowed in other respects” relates for comparison back to the earlier recited “broader aspects of the reissued claim” (i.e., surrendered subject matter). Again, modification of “materially narrowed” with the phrase “in other respects” clarifies that reissue claims will avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter.

Similarly, in *Hester Indus.*, the Federal Circuit determined that “surrendered subject matter - i.e., cooking other than solely with steam and with at least two sources of steam – has crept into the reissue claims [because] [t]he asserted reissue claims are unmistakably broader in these respects.” 142 F.3d at 1482, 46 USPQ2d at 1649. Immediately after making this determination, the court then stated: “Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects.” *Id.* (emphases added). Yet again, the language “materially narrowed in other respects” relates for

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

comparison back to the earlier recited language “[t]he asserted reissue claims are unmistakably broader in these respects.” It follows that *Hester Indus.* also makes clear that a reissue claim will avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter.

There is a reason the Federal Circuit has repeatedly assessed recapture rule avoidance in terms of whether the reissue claims were materially narrowed in respects other than the broader aspects relating to surrendered subject matter. The reason involves the purpose served by permitting the recapture rule to be avoided under certain circumstances. This purpose is described in *Hester Indus.* as follows:

[T]his principle [i.e., avoidance of the recapture rule], in appropriate cases, may operate to overcome 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.

142 F.3d at 1482-83, 46 USPQ2d at 1649-50.

As explained in *Hester Indus.*, the recapture rule is avoided when two conditions are satisfied. First, an aspect of the invention must have been overlooked (e.g., not claimed) during patent prosecution. Second, the reissue claim must have been materially narrowed with respect to this overlooked aspect of the invention. Because recapture rule avoidance requires the reissue claim to be materially narrowed in an overlooked aspect

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

of the invention, this material narrowing must be in respects other than the broader aspects relating to surrendered subject matter. Stated differently, a material narrowing in an overlooked aspect cannot possibly relate to surrendered subject matter since this subject matter, having been claimed and then surrendered during original prosecution, could not have been overlooked.

In *Pannu*, the Federal Circuit stated that “[t]he narrowing aspect of the claim on reissue ... was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means [, and] [t]herefore, the reissued claims were not narrowed in any material respect compared to their broadening.” 258 F.3d at 1372, 59 USPQ2d at 1600-01. If read in a vacuum, this statement might appear to support a contrary result to our analysis. However, the court’s opinion in general and this statement in particular must be read, not in a vacuum but, in light of the facts of the case on appeal.

The reissued claim in *Pannu* was narrowed by requiring the snag resistant means to be “at least three times greater” than the width of the haptics and by requiring the snag resistant means to be “substantially coplanar” with the haptics. 258 F.3d at 1372, 59 USPQ2d at 1600. As revealed in the underlying District Court decision, these same or similar limitations were present in claims throughout prosecution of the original patent application. *Pannu v. Storz Instruments, Inc.*, 106 F. Supp. 2d 1304, 1308 (S.D. Fla. 2000). For this reason, the District Court held that the recapture rule had not been avoided because the narrowing limitations were

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

not overlooked aspects of the invention and did not materially narrow the claim. *Id.*, 106 F. Supp 2d at 1308-09, citing for authority *Hester Indus.*, 142 F.3d at 1483, 45 USPQ2d at 1650 and *Clement*, 131 F.3d at 1469, 45 USPQ2d at 1165.

This factual background more fully illuminates the Federal Circuit's determination in *Pannu* that the reissued claims were not narrowed in any material respect compared with their broadening. This determination is not based on the fact that the narrowing limitations of the reissue claims were unrelated to their broadening. Rather, it is based on the fact that these same or similar limitations had been prosecuted in the original patent application and therefore were not overlooked aspects of the invention and did not materially narrow the reissue claims.

The reissue claims in *Clement* were both broader and narrower in aspects germane to a prior art rejection. 131 F.3d at 1470, 45 USPQ2d at 1165. However, the narrower limitation recited in the *Clement* reissue claims ("at least 59 ISO in the final pulp"; see clause (e) of reissue claim 49) also was recited in the patent claims (see clause (f) of patent claim 1). 131 F.3d at 1470, 1474, 45 USPQ2d at 1165, 1169. Therefore, the narrowing limitation of *Clement*, like *Pannu*, was not overlooked during original prosecution and did not materially narrow the reissue claim.

Additionally, in setting forth the test for recapture *Clement* states in part that "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" and specifically states that "*Ball* is an example

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

of (3)(b).” 131 F.3d at 1470, 45 USPQ2d at 1165. The claims before the court in *Ball* were determined by the trial judge to be materially narrower as to a feature not found in the originally prosecuted claims and were determined by the Examiner to distinguish over the prior art. See *Ball Corporation v. The United States*, 219 USPQ 73 (Cl. Ct. 1982). (“[T]he new reissue claims recite structure never before recited in any claim presented during the prosecution of the original case. These recitations appear, on their face, to be substantial.”)

Finally, in *Mentor*, each of the limitations added to the reissue claims were thoroughly analyzed and determined to not be materially narrowing because the same or similar features were in the patent claims or the prior art. *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525-26. It follows that the reissue claims of *Mentor*, like those of *Pannu* and *Clement*, failed to avoid the recapture rule because they had been broadened to include surrendered subject matter but had not been narrowed in any material respect.

In summary, the recapture rule is avoided if the reissue claim was materially narrowed in other respects compared to its broadening surrendered aspect. A reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention:

- (1) which had not been claimed and thus were overlooked during prosecution of the original patent application;<sup>7</sup> and

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<sup>7</sup> For a patent containing only apparatus claims, it might be argued that reissue method claims cannot involve surrendered subject matter where no method claim was ever presented during prosecution of the patent.

(2) which patentably distinguish over the prior art.

(13)

*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.

(14)

*Public Notice*

We believe that any recapture analysis must be bottomed principally on a “public notice” analysis which can occur only after a record becomes

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However, surrender is not avoided merely by categorizing a claimed invention as a method rather than an apparatus. It is the scope of a claimed invention, not its categorization, which determines whether surrendered subject matter has crept into a reissue claim.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

“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 Appellant (not the public) controls what amendments and arguments are presented during prosecution. When an amendment or argument is presented, it is the Appellant 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 (or explain why the reissue claims are materially narrowed).

Our belief is supported by what appears to be dicta in *MBO Laboratories, Inc. v. Becton, Dickinson & Company*, No. 2006-1062, slip. op. at 12-13 (Fed. Cir. Jan. 24, 2007):

The recapture rule is a limitation on the ability of patentees to broaden their patents after issuance. . . . Section 251 is “remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally.” However, the remedial function of the statute is limited. Material which has been surrendered in order to obtain issuance cannot be reclaimed via Section 251: . . . It is critical to avoid allowing surrendered matter to creep back into the issued patent, since competitors and the public are on notice of the surrender and may have come to rely on the consequent limitations on claim scope. . . . (“[T]he recapture rule ... ensur[es] the ability of the public to rely on a patent’s public record.”). The public’s reliance interest provides a justification for the recapture rule that is independent of the likelihood that the surrendered

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

territory was already covered by prior art or otherwise unpatentable. The recapture rule thus serves the same policy as does the doctrine of prosecution history estoppel: both operate, albeit in different ways, to prevent a patentee from encroaching back into territory that had previously been committed to the public. (citations omitted.)

B. § 251- *The Examiner's Prima Facie Case*

Our Findings of Fact 42-44 set out the basis upon which the Examiner originally made a recapture rejection in the Final Office Action. As noted in Finding of Fact 45, the record supports the Examiner's findings with respect to claim 4.

Basically, in the application which matured into the patent now sought to be reissued, the Examiner rejected dependent claim 11 (among others) under 35 U.S.C. § 112 and over the prior art. Appellant proceeded to cancel claim 11 (and all other pending claims) and added new claims 28-30 which included in limitations new limitations. Amended application claims 28-30 ultimately issued as patent claims 1-3.

The Examiner made three points in Findings of Fact 42-44:

- (1) when faced with a Final rejection in the original application,  
Appellant made a three *significant* amendments (See Findings of Fact 42 (A)-(C));
- (2) when faced with a Final rejection in the original application,  
Appellant made two *significant* arguments (See Finding of Fact 43 and Findings of Fact 25-26);

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

(3) reissue claim 4 is broader than the original patent claims with respect to the limitations added and arguments made to overcome the rejections (See Findings of Fact 42(C), 43(B), 44, and 26).

The Examiner's accurate factual analysis with respect to claim 4 demonstrates that the Examiner has made out a prima facie case of recapture consistent with the test set forth in *Clement* and amplified in *Hester*.

Further, we hold that with respect to the Examiner's rejection of claim 4, the burden of persuasion now shifts to the Appellant 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 or that the reissued claims were materially narrowed.

C. § 251 - Appellant's Response<sup>8</sup>

(1)  
*Originally filed claim 1*

With respect to independent reissue claim 4, Appellant points out that claim 4 is directed to the same feature recited in originally filed claim 1 that was cancelled prior to examination. Appellant then argues that the cancellation of originally filed claim 1 cannot be used as a basis to establish surrendered subject matter. We agree as originally filed claim 1 was never rejected under any statute.

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<sup>8</sup> Appellant's response is contained in the Brief filed March 22, 2004, Reply Brief filed June 18, 2004, and Second Reply Brief filed January 11, 2006.

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

(2)

*Surrendered Subject Matter and Added claim 11*

With respect to independent reissue claim 4, Appellant points out that claim 11 was “cancelled for reasons related to form” and not “to overcome the § 103(a) rejection.” Appellant then argues that the cancellation of claim 11 was due to the rejection under 35 U.S.C. § 112, the cancellation cannot be used as a basis to establish surrendered subject matter. We disagree.

Firstly, an amendment based on a rejection under 35 U.S.C. § 112 may result in the surrender of claimed subject matter. This was specifically addressed by the Court in *Festo II*, 535 U.S. at 736-37, 122 S. Ct. at 1840, 62 USPQ2d at 1712-13:

Estoppel arises when an amendment is made to secure the patent and the amendment narrows the patent's scope. If a § 112 amendment is truly cosmetic, then it would not narrow the patent's scope or raise an estoppel. On the other hand, if a § 112 amendment is necessary and narrows the patent's scope—even if only for the purpose of better description—estoppel may apply. A patentee who narrows a claim as a condition for obtaining a patent disavows his claim to the broader subject matter, whether the amendment was made to avoid the prior art or to comply with § 112. We must regard the patentee as having conceded an inability to claim the broader subject matter or at least as having abandoned his right to appeal a rejection. In either case estoppel may apply.

Secondly, the cancellation of claim 11 does not stand alone. It was preceded by a rejection under § 112; it was accompanied by the addition of new claims containing the limitation argued by Appellant (see Finding of

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

Fact 26); and Appellant explicitly chose not to present a counterpart to claim 11 (see Finding of Fact 25). All of these taken with the cancellation of claim 11 are more than sufficient to support a rebuttable presumption of surrender.

We conclude that an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome the rejections and secure the patent. *Kim v. ConAgra Foods, Inc.*, 465 F.3d at 1323, 80 USPQ2d at 1502. We also conclude that Appellant has not shown that at the time the amendment or argument was made, an "objective observer" could not reasonably have viewed the subject matter broader than the amended and/or argued limitation(s) as having been surrendered.

(4)

*Materially Narrowed*

Appellant argues (Second Reply Br. 5):

The recapture rule may be avoided if the reissue claims were materially narrowed in other respects. See *Hester*, 143 F.3d at 1482 (emphasis added); *Pannu*, 248 F.3d at 1370. 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. *Hester*, 142 F.3d at 1483.

We agree. As discussed at Section IV. A. (12) *supra*, a reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention (1) which had not been claimed and thus were

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

overlooked during prosecution of the original patent application; and (2) which patentably distinguish over the prior art.

However, we conclude that neither of the criteria above is met in the appeal before us. Contrary to Appellant's statement (Second Reply Br. 5:15-17), reissue claim 4 does not distinguish over the prior art.<sup>9</sup> Rather, as discussed in the new ground of rejection *infra*, reissue claim 4 is fully described in the prior art already of record in the patent for which Appellant seeks reissue. Further, no limitation in reissue claim 4 was overlooked during prosecution of the original patent application. Rather, every limitation of reissue claim 4 is found in claim 11 rejected by the Examiner and cancelled by Appellant during the prosecution of the original patent application.

We also conclude that Appellant has not shown that an "objective observer" would reasonably view the reissue claim as materially narrowed thus avoiding the surrendered subject matter, and that with respect to this argument Appellant has not rebutted the Examiner's prima facie showing of recapture.

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<sup>9</sup> The record before this panel does not show that a prior art search was performed by the Examiner. Nor does the Examiner discuss any prior art already of record in the patent for which Appellant is seeking reissue. Facially, one could argue that the Examiner may have conceded that reissue claim 4 is patentable over the prior art. Alternatively, the Examiner may have felt the recapture rejection was sufficient and declined to reach other possible grounds of rejection preferring instead to expedite prosecution. Regardless of the Examiner's reason for not making a prior art rejection, this panel has authority to do so. See 35 U.S.C. § 41.50(b).

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

V. NEW GROUNDS OF REJECTION OF CLAIM 4

Reissue claim 4 is rejected under 35 U.S.C. § 102(b) as being anticipated by both the Holmes and Schivley patents.

As to the Holmes patent, it teaches:

An elevator [title] for use in wellbore operations, the elevator [Figs. 1 and 2] comprising

a first body part [Figs. 1 and 2, member A],

a second body part [Figs. 1 and 2, member A'],

the body parts together defining an interior opening through the elevator for accommodating a wellbore tubular therein [Figs. 1 and 2, the area between A and A'],

first hinge apparatus [Figs. 1 and 2, left side hinge pin C] hingedly connecting the two body parts together and permitting the two body parts to be hingedly openable on a first side of the elevator, and

second hinge apparatus [Figs. 1 and 2, right side hinge pin C] disposed across from the first hinge apparatus, the second hinge apparatus hingedly connecting the two body parts together and permitting the two body parts to be hingedly openable on a second side of the elevator.

As to the Schivley patent, it teaches:

An elevator [Field of Invention] for use in wellbore operations, the elevator [Figs. 3 and 4] comprising

a first body part [Figs. 3 and 4, semiannular segment 28],

a second body part Figs. 3 and 4, semiannular segment 30],

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

the body parts together defining an interior opening through the elevator for accommodating a wellbore tubular therein [Figs. 3 and 4, the center area encircled by semiannular segments 28 and 30],

first hinge apparatus [Figs. 3 and 4, left side hinge pin 34] hingedly connecting the two body parts together and permitting the two body parts to be hingedly openable on a first side of the elevator, and

second hinge apparatus [Figs. 3 and 4, right side hinge pin 34] disposed across from the first hinge apparatus, the second hinge apparatus hingedly connecting the two body parts together and permitting the two body parts to be hingedly openable on a second side of the elevator.

For the reasons *supra*, we reject of claim 4 under 35 U.S.C. § 102(b) using our authority under 37 C.F.R. § 41.50(b).

37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b) as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

(2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

## VI. CONCLUSIONS OF LAW

(1) Appellant has failed to establish that the Examiner erred in rejecting claim 4 under 35 U.S.C. § 251 based on recapture. Specifically:

(a) Appellant's arguments have not rebutted the presumption, upon which the Examiner's rejection is based, i.e., that at the time of the amendment an objective observer would reasonably have viewed the subject matter of the narrowing amendment and limitations argued in the parent as having been surrendered.

(b) Appellant's arguments have not established that the reissue claims are materially narrowed with respect to an overlooked aspect of the invention.

(2) Reissue claim 4 is not patentable.

(3) Since we have entered a new rejection, our decision is not a final agency action.

## VII. DECISION

Upon consideration of the record, and for the reasons given, we affirm the rejection of reissue claim 4 under 35 U.S.C. § 251 based on recapture; and we reject reissue claim 4 under 35 U.S.C. § 102(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

AFFIRMED  
37 C.F.R. § 41.50(b)

BLANKENSHIP, *Administrative Patent Judge*, concurring.

I agree with my colleagues that Appellant has failed to show that reissue claim 4 does not relate to surrendered subject matter as described in the cases of our reviewing court, such as *In re Clement*, 131 F.3d 1464, 1469, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997), and *Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 80 USPQ2d 1495 (Fed. Cir. 2006). Further, I agree that the reissue claim has not been materially narrowed in overlooked aspects of the invention at least for the reason that, as the majority finds, every limitation of reissue claim 4 is found in original application claim 11, which was examined and rejected by the Examiner.

In *Ex parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003) (precedential), an expanded panel of the Board determined that the reissue claims had been narrowed in the same aspect (i.e., the shape of the retaining member) in which they were broadened with regard to a patent claim, thus avoiding recapture. In accordance with the holding of *Eggert*, there is no recapture when the reissue claims retain, in broadened form, the limitation added (or argued) to overcome a prior art rejection in the original prosecution. See *Manual of Patent Examining Procedure* § 1412.02, p. 1400-23, under heading “(d) Reissue Claims Broader in Scope in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; but Reissue Claims Retain, in Broadened Form, the Limitation(s) Argued/Added to Overcome Art Rejection in Original

Appeal 2007-0040  
Application 10/170,069  
Patent 6,073,699

Prosecution:” (8th Ed., Rev. 5, Aug. 2006). Even with a presumption that *Eggert* has *not* been abrogated by *North American Container*,<sup>10</sup> Appellant fails to show (Second Reply Br. 7) that recapture has been avoided by presentation of a broadened form of the limitation “at least one second roller.”

I therefore agree with the conclusion that Appellant has failed to establish that the Examiner erred in rejecting claim 4 under 35 U.S.C. § 251 based on recapture. Further, I agree in full with the majority’s finding that reissue claim 4 is anticipated under 35 U.S.C. § 102(b) by each of the Holmes and Schivley patents.

rwk

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<sup>10</sup> *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005).