

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT L. SWARTZ and DAVID R. DUNHAM

Appeal 2007-0493
Application 10/289,967¹
Patent 6,144,380
Technology Center 2100

Decided: July 24, 2007

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

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

AFFIRMED-IN-PART

¹ Application filed November 7, 2002, seeking to reissue U.S. Patent 6,144,380 issued November 7, 2000, based on Application 08/801,251, filed February 19, 1997, as a continuation of Application 08/454,061, filed May 30, 1995, now abandoned, which is a divisional of 08/147,143, filed November 3, 1993, now U.S. Patent 6,243,071. The real party in interest is Apple Computer, Inc. (Br. 1).

I. STATEMENT OF CASE

1. Appellants appeal under 35 U.S.C. § 134 from a final rejection of reissue claims 1-15, 17-37, 39-59, 61-85, and 87-101 entered November 22, 2004. We have jurisdiction under 35 U.S.C. § 6(b).

2. A copy of Appellants' reissue claim 1-15, 17-37, 39-59, 61-85, and 87-101 is set forth in the Claim Appendix of Appellants' Reply Brief.

3. Independent claims 5 and 49 under appeal reads as follows:

5. A method by which a first computer system searches an electronic book, the electronic book having been created on a second computer system for use and display on the first computer system, the first computer system further having a display screen, a processor communicatively coupled with the display screen, and a memory communicatively coupled to the processor such that at least one portion of the electronic book residing in the memory, the method comprising:

receiving hand-written user input;

recognizing said user input as one or more search strings;
and

displaying, on the display screen, content of the electronic book associated with at least one of the one or more search strings.

49. A method by which a computer system searches an electronic book, the computer system having a display screen, a processor communicatively coupled with the display screen and a memory communicatively coupled to the processor and storing at least one portion of the electronic book, the electronic book comprising at least one block having an associated action, wherein user selection of said block, when displayed on the

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display screen, causes the action to be executed, the method comprising:

receiving hand-written user input;

recognizing said user input as one or more search strings;

searching the electronic book, including said at least one block, for said one or more search strings; and

displaying, on the display screen, a portion of the electronic book associated with at least one of the one or more search strings.

4. The Examiner rejected added reissue claims 5-15, 17-37, 39-59, 61-85, and 87-101 under 35 U.S.C. § 251 as “being an improper recapture of claimed subject matter that was deliberately canceled in the application for the patent upon which the present reissue is based” (Answer 4-6) .

5. The Examiner rejected reissue claims 1-4 (original patent claims 1-4) and added reissue claims 5-15, 17-37, 39-59, 61-85, and 87-101 as being based on a defective reissue oath under 35 U.S.C. § 251 (Answer 6).

6. The prior art relied upon by the Examiner in rejecting the claims on appeal is:

More	US 4,839,634	Jun. 13, 1989
Vertelney	US 5,341,293	Aug. 23, 1994
Ballard	US 5,377,281	Dec. 27, 1994
Dickinson	US 5,500,929	Mar. 19, 1996

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7. The Examiner rejected reissue claims 5-11, 14-15, 17-18, 21-33, 36-37, 39-40, and 43-48 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson and More (Answer 7-9).

8. The Examiner rejected reissue claims 12-13, 19-20, 34-35, and 41-42 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson, More, and Ballard (Answer 9).

9. The Examiner rejected reissue claims 49-55, 58-59, 61-62, 65-82, 85, 87, and 90-101 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson, More, and Vertelney (Answer 9-10).

10. The Examiner rejected reissue claims 56-57, 63-64, 83-84, and 88-89 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson, More, Vertelney, and Ballard (Answer 10-11).

11. With respect to the rejection under 35 U.S.C. § 251 of claims 5-15, 17-37, 39-59, 61-85, and 87-101, the panel affirms the decision of the Examiner.

12. With respect to the rejections under 35 U.S.C. § 103(a) of claims 5-15, 17-37, 39-59, 61-85, and 87-101, the panel affirms the decision of the Examiner.

13. With respect to the rejection of claims 1-4, the panel reverses the decision of the Examiner.

AFFIRMED-IN-PART²

² Also, two new grounds of rejection have been added in Section VI of this decision.

II. ISSUES

1. The first issue before the Board is whether Appellants have established that the Examiner erred in rejecting claims 5-15, 17-37, 39-59, 61-85, and 87-101 under 35 U.S.C. § 251 based on recapture.

2. The second issue before the Board is whether Appellants have established that the Examiner erred in rejecting claims 1-15, 17-37, 39-59, 61-85, and 87-101 under 35 U.S.C. § 251 based on a defective reissue oath.

3. The third issue before the Board is whether Appellants have established that the Examiner erred in rejecting claims 5-11, 14-15, 17-18, 21-33, 36-37, 39-40, and 43-48 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson and More.

4. The fourth issue before the Board is whether Appellants have established that the Examiner erred in rejecting claims 12-13, 19-20, 34-35, and 41-42 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson, More, and Ballard.

5. The fifth issue before the Board is whether Appellants have established that the Examiner erred in rejecting claims 49-55, 58-59, 61-62, 65-82, 85, 87, and 90-101 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson, More, and Vertelney.

6. The sixth issue before the Board is whether Appellants have established that the Examiner erred in rejecting claims 56-57, 63-64, 83-84, and 88-89 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson, More, Vertelney, and Ballard.

III. FINDINGS OF FACT

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

A. *The Invention of U.S. Patent 6,144,380*

1. According to Appellants, they invented (U.S. Patent 6,144,380, Abstract 1-10):

A method for controlling a screen display of an electronic book. The contents of the book are displayed on a screen of the computer system as pages with which the user interacts by a pointer such as a pen or stylus. The content engine performs various functions including one or more of the following: (1) creating page displays for content of the book, (2) providing a navigation interface for identifying material in the book and moving to desired locations, (3) finding character strings located within the book, and (4) accepting handwritten information on pages of the book.

2. The invention claimed in U.S. Patent 6,144,380, is directed to function “(4) accepting handwritten information on pages of the book” as shown in the claim step of “displaying handwriting written on the current page of the book after a mark-up button has been selected” (Patent claim 1).³

³ Claim 19 as originally filed in each of Applications 08/147,142, and 08/454,061 and 08/801,251 which are the grandparent application, parent application, and original application, respectively, of U.S. Patent 6,144,380 for which reissue is sought.

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B. The Inventions of the Reissue Application

3. The inventions claimed in the reissue application on appeal are directed to function “(4) accepting handwritten information on pages of the book” (reissue claims 1-4) and function “(3) finding character strings located within the book” (reissue claims 5-101).

4. Appellants state that “[i]n contrast [to originally filed claim 19], reissue independent claims 5, 27, 49, and 77 are directed to the display of *electronic book contents associated with user input search strings . . .*” (Br. 10:1-2).

C. Prosecution history of the co-pending grandparent and second divisional applications

5. The patent sought to be reissued is based on Application 08/801,251 (which we refer to as the “original application” even though it is the third application in the sequence), filed February 19, 1997, which is a continuation of Application 08/454,061 (which we refer to as the “first divisional”), filed May 30, 1995, now abandoned, which is a first divisional of 08/147,143, (which we refer to as the “grandparent”), filed November 3, 1993, now U.S. Patent 6,243,071.

6. Co-pending Application 08/454,423, (which we refer to as the “second divisional”) was also filed May 30, 1995, now U.S. Patent 5,802,516, as a second divisional of grandparent application 08/147,143.

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7. The related applications consist of:

Grandparent Application 08/147,143 (now U.S. Patent 6,243,071);
First divisional Application 08/454,061 (Abandoned);
Second divisional Application 08/454,423 (U.S. Patent 5,802,516);
Original Application 08/801,251 (U.S. Patent 6,144,380); and
Reissue Application 10/289,967.

8. As filed, grandparent application 08/147,143 contained claims 1-38, including representative independent claims 1, 19, and 24, and dependent claims 20 and 25, which are reproduced below:

1. A method of controlling a display screen of an electronic book having a processor connected to the display screen, a memory connected to the processor, one or more buttons, and a pointer, the method comprising:

opening a book package residing, at least in part, in the memory of the computer;

displaying a view of a current page of the book on the display screen, the view including at least one navigation button;

displaying a navigation dialog box on the display screen when the navigation button is selected, the navigation dialog box having at least a bookmark button and a return to menu button;

placing a bookmark at a preselected page when the bookmark button is selected; and

displaying a menu page in the electronic book when the return to menu button is selected, the menu page listing one or more destinations within the electronic book.

19. A method of processing handwriting written with a pointer on a screen display of a pointer-based computer having a processor connected to the screen display, a memory connected to the processor, a pointer, contents of an electronic book, and one or more buttons, the method comprising:

displaying a view of a current page of the book on the display screen;

recognizing handwriting as character strings when said handwriting is written in handwriting recognition fields displayed on the screen display, the character strings being used to identify at least one location within the book; and

displaying handwriting written on the current page of the book after a mark-up button has been selected.

20. The method of claim 19 wherein the handwriting written on the current page is removed when the mark-up is selected.

24. A method of searching a character string in one or more documents with the aid of a pointer-based computer having a processor, a memory connected to the processor, a display screen connected to the processor, a pointer, and one or more documents residing, at least in part, in the memory, each of the documents having one or more content records, the method comprising the following steps:

selecting a character string by interaction of the pointer with the display screen;

encoding an NGRAM for each n successive characters in the character string, the NGRAM being grouped with other NGRAMs from the character string in an array of NGRAMs;

comparing the character string array of NGRAMs against NGRAMs for the content records of at least one document;

searching the contents of those content records having NGRAMs containing each element of the character string NGRAM;
and

indicating on the display screen the records containing the search string.

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25. A method of claim 24 wherein the step of selecting a character string by interaction of the pointer with the display screen includes the following substeps:

displaying a find dialog box on the display screen, the dialog box having a field for accepting handwriting; and
recognizing handwriting written in the field as the character string.

9. On May 19, 1995, the Examiner entered a Non-Final Office Action which included a “restriction requirement” and documented Appellants’ “provisional election” with traverse made in a telephone conversation with the Examiner on May 1, 1995.

10. The restriction requirement indicated that grandparent application 08/147,143 contained three independent and distinct inventions as follows:

I. Claims 1-18 and 31-38 drawn to a graphical user interface for use with an electronic book;

II. Claims 19-23 drawn to a method of recognizing/digitizing hand writing; and

III. Claims 24-30 drawn to a method of searching through data according to a character string.

11. Appellants’ provisional election with traverse elected to prosecute the invention of group I, claims 1-18 and 31-38.

12. Appellants failed to perfect the traversal.

13. Instead, Appellants filed a second divisional Application 08/454,423 to prosecute the invention of group III, claims 24-30 (identical to

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claims 24-30 of the grandparent), directed to searching through data according to a character string selected by pointer interaction.

14. Grandparent application 08/147,143 ultimately issued as U.S. Patent 6,243,071, on June 5, 2001.

15. The second divisional application ultimately issued as U.S. Patent 5,802,516, on September 1, 1998.

D. Prosecution history of the first divisional and “original” applications

16. Simultaneously with the second divisional, Appellants filed a first divisional Application 08/454,061 to prosecute the invention of group II, claims 19-23 (identical to claims 19-23 of the grandparent), directed to recognizing/digitizing hand writing in an electronic book mark-up operation.

17. On April 1, 1996, the Examiner entered a Non-Final Office Action (“Non-Final Action”).

18. Claims 19-23 were rejected on various grounds.

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

Norwood	US 5,063,600	Nov. 5, 1991
Friend	US 5,455,901	Oct. 3, 1995
Dickinson	US 5,500,929	Mar. 19, 1996

20. Claims 20 and 23 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

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21. Claims 19-23 were rejected under 35 U.S.C. § 103 as being unpatentable over Norwood, Friend, and Dickinson.

22. On August 5, 1996, Appellants filed a first Amendment (“the First Amendment”) responding to the Examiner’s Non-Final Action.

23. The First Amendment amended independent claim 19, and dependent claims 20, 22, and 23.

24. Amended claims 19 and 20 reproduced below (matter underlined added by the First Amendment):

19. A method of processing handwriting written with a pointer on a screen display of a pointer-based computer having a processor connected to the screen display, a memory connected to the processor, a pointer, contents of an electronic book, and one or more buttons, the method comprising:

displaying a view of a current page of the book on the display screen;

recognizing handwriting as one or more character strings when said handwriting is written in handwriting recognition fields displayed on the screen display, the one or more character strings being used to identify at least one location within the book; and

displaying handwriting written on the current page of the book after a mark-up button has been selected.

20. The method of claim 19 wherein the handwriting written on the current page is removed when the mark-up button is selected.

25. After entry of the First Amendment, the application claims were 19-23.

26. In the First Amendment, Appellants presented arguments with respect to the patentability of amended claim 19.

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27. Appellants' arguments (see below) addressed at least the following limitations of Appellants' amended claim 19:

- (1) displaying handwriting written on the current page of the book after a mark-up button has been selected.

Limitation (1) was found in original claim 19.

28. In the First Amendment at page 3, last paragraph, Appellants argued the following:

Applicants have recognized that users often desire to display "clean" page unobscured by handwritten notes. Thus, claim 20 recites a feature whereby the handwritten notes on a given page can be hidden simply by selecting the mark-up button. Further, fresh handwriting will not be displayed unless the mark-up button is first selected as indicated as the third step of claim 19. Nowhere in Norwood is such control described or suggested.

At page 4, second paragraph, Appellants also argued the following:

Further, the patent to Friend et al. fails to show or suggest that display of handwriting is contingent upon selection of a mark-up button. The Friend et al. system continues to display handwriting from the very time it is entered, regardless of any selection of a mark-up button.

The arguments directly above addressed Finding of Fact 27 limitation (1) found in Appellants' amended and original claim 19.

29. On October 24, 1996, the Examiner entered a Final Office Action ("Final Action").

30. Claims 19-23 were again rejected under 35 U.S.C. § 103 as being unpatentable over Norwood, Friend, and Dickinson.

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31. On January 8, 1997, the Examiner conducted an interview with Appellants' representative. On January 8, 1997, the Examiner entered an Interview Summary into the record stating:

Claims discussed: 19, 20

Prior art discussed: Friend et al. ('901) – shows toggling between entered strokes and font-rendered translation.

Description of agreement or other comments: Applicant stressed that the claimed “mark-up button” has the capability of completely removing entered text, in any form,* as in claim 20. The Examiner noted that claims presented so as to have such interpretation would require significant new consideration after final but may overcome the outstanding rejection.

* not positively recited, current claim 20 – text can be alternate form.

32. On January 13, 1997, Appellants filed an After Final Amendment (“the After Final Amendment”) responding to the Examiner's Final Office Action.

33. On January 21, 1997, the Examiner entered an Advisory Action (“Advisory Action”) denying entry of the After Final Amendment as they at least in-part “raise new issues that would require further consideration and/or search.”

34. On February 19, 1997, Appellants filed original Application 08/801,251, as a continuation (File Wrapper Continuing Procedure) of first divisional Application 08/454,061, which was abandoned.

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35. Also, on February 19, 1997, Appellants After Final Amendment was entered as a Preliminary Amendment (“the Preliminary Amendment”) in newly filed original Application 08/801,251.

36. The Preliminary Amendment amended independent claim 19. Dependent claim 20 was canceled. Amended claim 19 is reproduced below (matter underlined added and matter in [brackets] deleted by the After Final Amendment):

19. A method of processing handwriting written with a pointer on a screen display of a pointer-based computer having a processor connected to the screen display, a memory connected to the processor, a pointer, contents of an electronic book, and one or more buttons, the method comprising:

displaying a view of a current page of the book on the display screen;

recognizing handwriting as one or more character strings when said handwriting is written in handwriting recognition fields displayed on the screen display, the one or more character strings being used to identify at least one location within the book; [and]

displaying handwriting written on the current page of the book after a mark-up button has been selected; and

hiding all handwriting and associated text written with said pointer on the current page when the mark-up button is re-selected.

37. After entry of the Preliminary Amendment, the application claims were 19 and 21-23.

38. In the Preliminary Amendment, Appellants presented arguments with respect to the patentability of amended claim 19. (Preliminary Amendment 2-5).

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39. Appellants' amendments and/or arguments (see below) addressed at least the following limitations of Appellants' amended claim 19:

- (A) hiding all handwriting and associated text written with said pointer on the current page when the mark-up button is re-selected.

Limitation (A) was added to claim 19 by the Preliminary Amendment.

40. In the Preliminary Amendment at page 4, Appellants reiterated and added to arguments made in the First Amendment (August 5, 1996). In-part Appellants re-argued and added the following as to the amended claims:

Further, the patent to Friend et al. fails to show or suggest that display of handwriting is contingent upon selection of a mark-up button. The Friend et al. system continues to display handwriting [*whether as user script or font text*] from the very time it is entered, regardless of any selection of a mark-up button.

The argument directly above addressed Finding of Fact 27 limitation (1) found in Appellants' original claim 19, and Finding of Fact 39 limitation (A) found in Appellants' amended claim 19.

41. On June 14, 2000, a Notice of Allowability was mailed which stated that pending claims 19 and 21-23 were allowed.

42. Consistent with Office practice, application claims 19 and 21-23 were renumbered as patent claims 1-4, respectively, in the course of preparing the original application for issue.

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43. U.S. Patent 6,144,380 issued November 7, 2000, based on the original application and contained claims 1-4.

E. Prosecution of reissue application

44. Appellants filed reissue application 10/289,967 on November 7, 2002, seeking to reissue U.S. Patent 6,144,380.

45. Appellants presented original patent claims 1-4 along with new reissue application claims 5-101 for consideration.

46. Ultimately, reissue claims 1-15, 17-37, 39-59, 61-85, and 87-101 were rejected.

47. Reissue application claims 1-15, 17-37, 39-59, 61-85, and 87-101, are before the Board in this appeal.

48. A copy of the claims 1-15, 17-37, 39-59, 61-85, and 87-101 under appeal is set forth in the Claim Appendix of Appellants' Reply Brief.

F. Examiner's Rejections under 35 U.S.C. § 251

49. The Examiner has rejected reissue application claims 5-15, 17-37, 39-59, 61-85, and 87-101 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.

50. The Examiner based the rejection of claims 5-15, 17-37, 39-59, 61-85, and 87-101 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 103 over Norwood, Friend, and

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Dickinson, Appellants made at least one *significant amendment* (on February 19, 1997) to claim 19 (Clause bridging Answer 4-5):

(A) Appellants amended rejected independent claim 1 to add the requirement of “hiding all handwriting and associated text written with said pointer on the current page when the mark-up button is re-selected.”

Amended application claim 19 ultimately became patent claim 1.

51. Additionally, the Examiner based the rejection of claims 5-15, 17-37, 39-59, 61-85, and 87-101 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 103 over Norwood, Friend, and Dickinson, Appellants made *significant arguments* with respect to amended claim 19 (Answer 5:6-13). (See also the Findings of Fact 28 and 40 *supra* with respect to Appellants’ arguments regarding claim limitations (1) and (A) in Findings of Fact 27 and 39 respectively.)

52. The Examiner reasoned in part as follows (Answer 5:6-13):

[S]ignificant limitation (the toggling "mark-up button") is not recited in the newly-presented independent reissue claims 5, 27, 49, 77, but a review of the parent application files shows that such a limitation **was** specifically argued as defining over the prior art of record, at pages 3 - 4 of the amendment filed 5 August 1996 (PTO Mail Room date) in US SN 08/454,061.

In arguing against the applicability of the applied prior art reference Norwood (US #5,063,600), appellant asserted in the paper of 5 August 1996 that "Norwood fails to show a 'mark-up button' which when selected can remove the display of handwriting". In the response, appellant also attempted to distinguish the "mark-up button" claimed over the handwriting input system of Friend et al. (US #5,455,901). The independent

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claim at that time merely recited, regarding the "mark-up button": "displaying handwriting written on the current page of the book after a mark-up button has been selected".

53. The record supports the Examiner's findings with respect to what limitations do not appear in reissue application claims 5-15, 17-37, 39-59, 61-85, and 87-101 which were present in claim 1 of the original application, as allowed.

54. Additionally, the Examiner has rejected reissue application claims 1-15, 17-37, 39-59, 61-85, and 87-101 under 35 U.S.C. § 251 as being based upon a defective reissue declaration since the present application seeks "recapture" of subject matter surrendered in obtaining allowance of the patent claims as noted above.

G. Examiner's Rejections under 35 U.S.C. § 103

55. The Examiner has rejected reissue application claims 5-11, 14-15, 17-18, 21-33, 36-37, 39-40, and 43-48 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson and More.

56. The Examiner has rejected reissue application claims 12-13, 19-20, 34-35, and 41-42 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson, More, and Ballard.

57. The Examiner has rejected reissue application claims 49-55, 58-59, 61-62, 65-82, 85, 87, and 90-101 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson, More, and Vertelney.

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58. The Examiner has rejected reissue application claims 56-57, 63-64, 83-84, and 88-89 under 35 U.S.C. § 103(a) as being unpatentable over Dickinson, More, Vertelney, and Ballard.

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.

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

⁴ *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).

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(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 in *Clement*, 131 F.3d at 1469-70, 45 USPQ2d at 1165:

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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 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

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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

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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.

(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_{Br}, ABCEF, or

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A_BBCDEF, because those claims would be narrower than the finally rejected claim ABC. 67 USPQ2d at 1718. 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 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

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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 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).

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(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 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

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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 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 Appellants 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.

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(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 equity⁵ 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

⁵ 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.

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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., Ltd.*, 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)⁶ (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.

⁶ 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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(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., Ltd.*, 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).

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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).

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

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“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, 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.

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“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 Appellants 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 Appellants are 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., Ltd.*, 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

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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

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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)

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

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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.

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

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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 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

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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 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

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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 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.*,

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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 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

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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, 79 (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;⁷ and

⁷ 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. 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

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(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 “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

invention, not its categorization, which determines whether surrendered subject matter has crept into a reissue claim.

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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, Appellants (not the public) control what amendments and arguments are presented during prosecution. When an amendment or argument is presented, it is the Appellants 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*, 474 F.3d 1323, 1331-32, 81 USPQ2d 1661, 1666-67 (Fed. Cir. 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 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,

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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 50-52 set out the basis upon which the Examiner originally made a recapture rejection in the Final Office Action. As noted in Finding of Fact 53, the record supports the Examiner's findings with respect to claims 5-15, 17-37, 39-59, 61-85, and 87-101.

Basically, in the application which matured into the patent now sought to be reissued, the Examiner rejected originally filed independent claim 19 over the prior art. Appellants proceeded to re-write application claim 19 by adding new limitations. Amended application claim 19 ultimately issued as patent claim 1.

The Examiner made three points in Findings of Fact 50-52:

- (1) when faced with a rejection in the original application, Appellants made a *significant* amendment (See Findings of Fact 50);
- (2) when faced with a rejection in the original application, Appellants made *significant* arguments (See Findings of Fact 51, 27, and 39);
- (3) reissue claims 5-15, 17-37, 39-59, 61-85, and 87-101 are broader than the original patent claims with respect to almost all the limitations added and arguments made to overcome the rejection (See Findings of Fact 50-52).

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The Examiner's accurate factual analysis with respect to claims 5-15, 17-37, 39-59, 61-85, and 87-101 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 claims 5-15, 17-37, 39-59, 61-85, and 87-101, the burden of persuasion now shifts to the Appellants 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 - Appellants' Response⁸

(1)

Clement: Step 1

With respect to independent reissue claims 5, 27, 49, and 77, Appellants "stipulate[] that reissue independent claims 5, 27, 49 and 77 are broader than originally issued independent claim 1 in at least one aspect." (Br. 7). Appellants also admit "the first step towards applying the recapture rule has been satisfied." (Br. 7). See also our discussion of *Clement* at Section IV. A. (3) *supra*.

However, Appellants are silent as to in what respect the reissue claims are broader than patent claim 1. We find that claims 5, 27, 49, and 77 are

⁸ Appellants' response is contained in the Brief filed October 18, 2005, and Reply Brief filed February 27, 2006.

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broader in that they do not contain the “displaying handwriting written on the current page of the book after a mark-up button has been selected” and “hiding all handwriting and associated text written with said pointer on the current page when the mark-up button is re-selected,” steps of issued patent claim 1.

(2)

Clement: Step 2

Appellants argue “reissue independent claims 5, 27, 49, and 77 are broader than originally issued independent claim 1 in a manner *not directly pertinent* to the subject matter surrendered during prosecution (the use of a mark-up button to display or hide handwriting).” (Br. 10) We disagree.

Our finding in section (1) involving Clement: Step 1 shows Appellants’ argument to simply be in error. We find that independent claims 5, 27, 49, and 77 are broader than originally issued independent claim 1 in a manner directly pertinent to the subject matter surrendered during prosecution (the use of a mark-up button to display or hide handwriting).

Therefore, this argument fails to show Examiner erred in rejecting based on recapture.

(3)

Meyers v. United States

Appellants argue that the decision in *B.E. Meyers & Co., Inc. v. The United States*, 47 Fed. Cl. 200, 50 USPQ2d 1110 (Fed. Cl. 2000), is relevant

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to the appeal before us. We disagree. Decisions of the United States Court of Federal Claims are not binding precedent on patentability decisions of the Office. For binding precedents from our reviewing courts, see our discussion at Section IV *supra*.

Therefore, this argument fails to show Examiner erred in rejecting based on recapture.

(4)

Newly claimed subject matter never canceled

The Examiner points to the cancellation of originally filed claims 14 and 31 to bolster the recapture rejection. Appellants argue that the subject matter of originally filed claims 14 and 31 was never canceled during prosecution:

The application from which the '380 patent issued was a divisional application filed under 37 C.F.R. 1.60 ("Rule 60"). As filed, only *claims 19-23 were submitted [in] the file history*, see filing papers for Application serial number 08/454,061 filed 30 May 1995. *Under the mechanics of Rule 60, those claims alleged to have been cancelled by the Examiner were never part of the application.* Because no claims other than 19-23 were submitted, no other claims could have been cancelled. *Ergo*, the Examiner's allegation that "pertinent" subject matter was canceled [i.e., claims 14 and 31,] during this matter's original prosecution is without merit. (footnotes omitted)

(Br. 9). We disagree.

The prosecution history of the 6,144,380 patent is not limited to Applications 08/454,061 and 08/801,251. Rather, the prosecution history

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comprises all the related applications (see FF 7). *See Jonsson v. Stanley Works*, 903 F.2d 812, 818, 14 USPQ2d 1863, 1869 (Fed.Cir.1990) (prosecution history of continuation-in-part application from same parent is relevant). Thus, claims 14 and 31 were cancelled during prosecution.

However, we must agree with Appellants ultimate point, that the cancellation referred to by the Examiner does nothing to bolster the Examiner's recapture rejection. The cancellation of claims 14 and 31 referred to by the Examiner was not in response to any rejection by the Office. Thus, the cancellation of claims 14 and 31 cannot serve as evidence of surrender.

While this argument shows Examiner error, the Examiner presented this point only to bolster a rejection that was already complete. Thus, the error is deemed to be harmless and Appellants' argument fails to show the Examiner's rejection based on recapture is in error.

(5)
Claims 1-4

The Examiner has rejected reissue application claims 1-4 under 35 U.S.C. § 251 as being based upon a defective reissue declaration since the present application seeks "recapture" of subject matter surrendered in obtaining allowance of the patent claims. We reverse this rejection. Because claims 1-4 are not subject to the recapture rule, a defective declaration would not, in and of itself, invalidate them. *See Clement*, 131 F.3d at 1472, 45 USPQ2d at 1167.

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V. DISCUSSION – REJECTION UNDER 35 U.S.C. § 103

A. *Introduction*

In the Brief at page 3, Appellants state:

The invention “provides an efficient method for searching or ‘finding’ character strings within a document [e.g., an electronic book]. Preferably, this is accomplished by first displaying a dialog box having a find field. Handwritten information written within the find field is then recognized as a character string,” See col. 3, lines 24-28; col. 16, lines 55-57, col. 21, line 15 to col. 24, line 21; and FIGS. 10 (elements 218 and 219) and 25-28.

The statement directly above and Appellants’ Specification indicate a two part process where first a find button is selected to open a find dialog box, and after a user writes in a search string, the system recognizes the search string as text. Although the Examiner and Appellants are silent as to their claim interpretations on this point, our review of the Examiner’s rejection and Appellants’ Briefs finds that each is consistent with Appellants’ disclosed two part process.

B. *Claim Interpretation*

In the brief at page 3, Appellants state:

Pending reissue independent claims 5, 27, 49 and 77 are directed generally to receiving handwritten user input, recognizing this input as one or more search strings and displaying electronic book content associated with the search string.

We interpret the language of claims 5, 27, 49, and 77, quite differently than has apparently been done by the Examiner and Appellants. In

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Appellants' Specification the computer is told by user selection of the "Find" button that the next user input will be a search string. In the claims before us, we find the computer "recognizing said user input as one or more search strings." The normal meaning of the word "recognize" and as used by Appellants' Specification is "to identify." Thus, the claims are directed to a computer that identifies input as search strings which means that it is not the user identifying the input as a search string and telling the computer.

Therefore, contrary to the Examiner's and Appellants' claim constructions, the claimed "recognizing" is not directed to the simpler two part process of Appellants' Specification. Rather, we have before us a significantly more powerful process step where the computer recognizes the type of input it is receiving without being told by the user.

B. § 103- The Examiner's Prima Facie Case

The Examiner's prima facie case for every rejection based on prior art relies on a claim construction where a user writes in a search string in a find dialog box and the system recognizes the search string as text. As we have discussed above, such a claim interpretation is not appropriate. Thus, the Examiner fails to present a prima facie case for the rejection of the claims once the claims are properly interpreted.

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VI. NEW GROUNDS OF REJECTION

A. 35 U.S.C. § 251

We reject reissue claims 5-15, 17-37, 39-59, 61-85, and 87-101 under 35 U.S.C. § 251, using our authority under 37 C.F.R. § 41.50(b).

Appellants' reissue oath alleges error as follows:

One error is that patentee claimed less than they had a right to claim as indicated in newly added claims 6 through 101. For example, patentee is entitled but did not originally claim, a method and apparatus by which a first computer system searches an electronic book (created on a second computer system) for user-entered hand-written search strings, wherein a portion of the electronic book is displayed if it is associated with at least one of the user-entered hand-written search strings.

Even if we adopt Appellants' position with respect to recapture, we find no such error. The prosecution of Application 08/801,251, its parent applications, and the patent resulting from Application 08/801,251 are all error free. Patentees claimed exactly what they had a right to claim in the patent, no more, no less.

Appellants prosecution history shows that responsive to a restriction requirement, Appellants elected to prosecute three separate applications directed to three separate inventions. (See FF 10-13 and 16). Reissue claims 5-15, 17-37, 39-59, 61-85, and 87-101 are directed to a different invention than that of patent claims 1-4. (See FF 1-4). Appellants are estopped from obtaining by reissue claims which, because of a requirement for restriction in which they had acquiesced, they could not claim in their patent. *See In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA

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1977). Appellants cannot now rely on the reissue statute, in order to undo the consequences of their attorney's deliberate choice. *In re Serenkin*, 479 F.3d 1359, 1365, 81 USPQ2d 2011, 2014 (Fed. Cir. 2007).

B. 35 U.S.C. § 112, first paragraph

Using our authority under 37 C.F.R. § 41.50(b), we reject reissue claims 5-15, 17-37, 39-59, 61-85, and 87-101 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As discussed above, the claims are directed to a computer that identifies input as search strings which means that it is not the user identifying the input as a search string and telling the computer. Appellants' Specification does not include the now claimed "recognizing said user input as one or more search strings" and analogous claim limitations.

C. 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 Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the

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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 ...

D. Impact of New Rejection on This Decision

In addition to affirming the Examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Bd.R. 41.50(b) provides that a decision including a new ground of rejection shall not be considered final for purposes of judicial review.

With respect to the affirmed rejection, Appellants may file a single request for rehearing within *two months* from the date of this decision under § 41.52(a)(1).

With respect to the new ground of rejections, the Appellants, within *two months* from the date of this decision must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 C.F.R. § § 41.50(b)) as to the rejected claims:

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(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the application will be remanded to the Examiner.

(2) Request rehearing under § 41.50(b)(2) by the Board of Patent Appeals and Interferences upon the same record. A rehearing under this section must also state all other grounds upon which rehearing is sought.

Should the Appellants elect to prosecute further before the Examiner, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellants elects further prosecution before the Examiner and further prosecution does not result in allowance of the application, abandonment or a second appeal, this application should be returned to the Board of Patent Appeals and Interferences for entry of a final decision with respect to the affirmed rejection, including any action on any timely request for reconsideration thereof.

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VII. CONCLUSIONS OF LAW

(1) Appellants have failed to establish that the Examiner erred in rejecting claims 5-15, 17-37, 39-59, 61-85, and 87-101 under 35 U.S.C. § 251 based on recapture. Specifically:

(a) Appellants' 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.

(2) Claims 5-15, 17-37, 39-59, 61-85, and 87-101 are not patentable.

(3) The Examiner erred in rejecting claims 1-4 under 35 U.S.C. § 251 based on a defective reissue oath.

(4) On the record before us, claims 1-4 have not been shown to be unpatentable.

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

VIII. DECISION

Upon consideration of the record, and for the reasons given, we affirm the rejection of claims 5-15, 17-37, 39-59, 61-85, and 87-101 under 35 U.S.C. § 251 based on recapture; we reverse the rejection of claims 1-4 under 35 U.S.C. § 251 based on a defective reissue oath; we reverse the rejection of claims 5-15, 17-37, 39-59, 61-85, and 87-101 under 35 U.S.C. § 103(b); we reject reissue claims 5-15, 17-37, 39-59, 61-85, and

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87-101 under 35 U.S.C. § 251; and we reject reissue claims 5-15, 17-37, 39-59, 61-85, and 87-101 under 35 U.S.C. § 112, first paragraph.

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).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

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BLANKENSHIP, *Administrative Patent Judge*, concurring.

I write separately only to discuss an alternative view of the recapture rule as it applies to this case. I disagree with Appellants' statement, at page 5 of the Reply Brief, that "[w]ith respect to broadening reissues and 'recapture,' there is no ambiguity regarding the law." However, in this case, even with the alternative view of the precedents that set out the law of recapture, the recapture rule bars Appellants' reissue claims.⁹

Application of the recapture rule is a three-step process. The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter. Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 1371, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001) (internal quotations and citations omitted).

"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." *In re Clement*, 131 F.3d 1464, 1469, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997) (citations omitted). Here, Appellants do not point to any evidence in the prosecution history that may indicate the contrary.

⁹ Any differences that I may have with the majority opinion in its interpretation of the recapture rule in no way relates to the new, independent ground of rejection for lack of statutory "error" under § 251.

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“Once we determine that an applicant has surrendered the subject matter of the canceled or amended claim, we then determine whether the surrendered subject matter has crept into the reissue claim.” *In re Clement* at 1469, 45 USPQ2d at 1164.

When a reissue claim is broader than a canceled or amended claim in some aspects, but narrower in others, *Clement* instructs us in a way to determine whether the surrendered subject matter has crept into the reissue claim. The Federal Circuit in *Clement* referred to two earlier cases as examples of how the recapture rule relates to broad and narrow aspects of reissue claims as compared to claims in the original application.

In *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993), the issued claim was directed to a condom catheter, reciting an adhesive means that was transferred from an outer to an inner surface without turning the condom inside-out. In making amendments to the claim, the applicant argued that none of the applied references showed the transfer of adhesive from the outer surface to the inner surface as the sheath is rolled up and then unrolled. The reissue claim eliminated the limitation that adhesive was transferred from the outer to the inner layer, making the reissue claim broader than the canceled claim in this aspect. The reissue claim was also narrower than the canceled claim because it recited that the catheter included a thin, flexible cylindrical material rolled outwardly upon itself to form a single roll. Although the “flexible” and “single roll” limitations made the reissue claim narrower than both the canceled and issued claims, the reissue claim did not escape the recapture rule because the

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limitations did not “materially narrow the claim.” *In re Clement* at 1469-70, 45 USPQ2d at 1165. *See also Mentor Corp.* at 993, 995-97, 27 USPQ2d at 1523-26.

In *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984), the issued claim recited “a plurality of feedlines” and a “substantially cylindrical conductor.” The canceled claim recited “feed means includ[ing] at least one conductive lead” and a “substantially cylindrical conductor.” The prosecution history showed that the patentee added the “plurality of feedlines” limitation in an effort to overcome a prior art rejection, but the cylindrical configuration limitation was not added to overcome a prior art rejection nor argued to distinguish over a reference. The reissue claim included limitations not present in the canceled claims that related to the feed means element, but allowed for multiple feedlines. The reissue claim was narrower than the canceled claim with respect to the feed means aspect. The reissue claim deleted the cylindrical configuration limitation, which made the claim broader with respect to the configuration of the conductor. The reissue claim was allowed because the patentee “was not attempting to recapture surrendered subject matter.” *In re Clement* at 1470, 45 USPQ2d at 1165. *See also Ball Corp.* at 1432-33, 1437, 221 USPQ at 291-92, 295.

In both *Mentor* and *Ball*, the relevance of the prior art rejection to the aspects narrowed in the reissue claim was an important factor in our analysis. From the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended

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claim¹⁰ in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. *Mentor* is an example of (3)(a); *Ball* is an example of (3)(b).

In re Clement at 1470, 45 USPQ2d at 1165 (footnote added).

Appellants' position, as stated at page 10 of the Brief, is that the second step (expressed in *Pannu, supra*) towards applying the recapture rule fails because reissue independent claims 5, 27, 49, and 77 are broader than originally issued independent claim 1 in a manner "not directly pertinent" to the subject matter surrendered during prosecution. The subject matter surrendered during prosecution, according to Appellants, is "the use of a mark-up button to display or hide handwriting." (Br. 10.)

¹⁰ The "canceled or amended claim" is the claim that was canceled or amended. "Once we determine that an applicant has surrendered the subject matter of the canceled or amended claim, we then determine whether the surrendered subject matter has crept into the reissue claim" (emphasis added). *In re Clement* at 1469, 45 USPQ2d at 1164. In *Clement*, the Federal Circuit compared the reissue claim with the corresponding application claim as it stood before the amendments added during prosecution. See *In re Clement* at 1470-71, 45 USPQ2d at 1165-66.

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Appellants' argument that the reissue claims avoid recapture is based on the postulate, "*reissue claims* that are *broader* than the original patent claims *in a manner not directly pertinent* to the subject matter surrendered during prosecution *are permissible*." (Br. 7.) Appellants cite, as the source of the theory, "*Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 998, 27 U.S.P.Q.2d (BNA) 1521, 1524 (Fed. Cir. 1993) (emphasis added)." (*Id.*) *Mentor*, however, does not appear on page 998 of the cited Federal Reporter. Nor does the case contain any statement that supports Appellants' proposition, on page 1524 of volume 27 of USPQ2d, or elsewhere. "If a reissue claim is *broader in a way that does not attempt to reclaim what was surrendered earlier*, the recapture rule may not apply." *Mentor Corp.* at 996, 27 USPQ2d at 1525 (emphasis added).

In any event, Appellants' Brief at pages 8 through 10 demonstrates the subject matter that was surrendered when amending original application claim 19 in response to a prior art rejection. The surrendered subject matter was at least that of claim 19 before entry of the preliminary amendment on February 19, 1997.¹¹ The broader aspects of the reissue claims relate to surrendered subject matter at least for the reason that the reissue claims do not contain all the limitations of original application claim 19 before the amendment of February 19, 1997. That reissue claims may be broader in a manner "not directly pertinent" to the subject matter surrendered during prosecution is a fact addressed in the three-step inquiry identified in

¹¹ Appellants' Brief (at 9) indicates the date of amendment as January 9, 1997.

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Clement, which occurs *after* the determination that subject matter was surrendered. In this case, the reissue claims are broader than application claim 19 before the preliminary amendment in some aspects, but narrower in others. Reissue claim 5 is narrower than application claim 19, for example, in the requirement that user input is recognized as one or more search strings. Reissue claim 5 is broader than application claim 19 in not requiring the display of handwriting written on the current page of the book after a mark-up button has been selected, a limitation that was further refined in response to the prior art rejection.

Appellants' reissue claims fail under *Clement* step 3(a) because the reissue claims are as broad as or broader than original application claim 19, prior to the preliminary amendment, in an aspect germane to a prior art rejection, even though the reissue claims may be narrower in other aspects completely unrelated to the rejection. The recapture rule bars the claims.

Thus, Appellants have not shown that the broader aspects of the reissue claims do not relate to surrendered subject matter. Nor have Appellants shown that the reissue claims have been materially narrowed in other respects to avoid the recapture rule. I agree with the majority's conclusion with respect to recapture, that the Examiner's rejection of claims 5-15, 17-37, 39-59, 61-85, and 87-101 under 35 U.S.C. § 251 should be sustained.

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KIS

WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI, L.L.P.
20333 SH 249
SUITE 600
HOUSTON, TX 77070