

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 BRADFORD W. BEALE

Appeal 2007-1432
Application 09/141,186¹
Patent 5,549,673
Technology Center 3700

Decided: August 29, 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 August 27, 1998, seeking to reissue U.S. Patent 5,549,673 issued August 27, 1996, based on Application 08/118,097, filed September 8, 1993, as a continuation of Application 07/511,454, filed April 20, 1990, now abandoned. The real party in interest is Gyrus Group, plc. (Br. 2).

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I. STATEMENT OF CASE

1. Appellant appeals under 35 U.S.C. § 134 from a Final Rejection of reissue claims 1-3 and 16-26 entered January 4, 2001. We have jurisdiction under 35 U.S.C. § 6(b).

2. A copy of Appellant's reissue claims 1-3 and 16-26 is set forth in the Claim Appendix of Appellant's Brief.

3. Independent claims 1, 16, 17, and 18 under appeal read as follows:

1. (Patent claim) A system of phonosurgery implantation for insertion by a surgeon through an opening formed in a patient's thyroid cartilage to stabilize a vocal cord therein, the system comprising:

(a) a series of implant bodies of different sizes, the implant bodies each having a holding portion and a series of engaging means for holding the implant bodies relative to the vocal cord by engaging the holding portion of the bodies in different positions in the opening formed in the thyroid cartilage;

(b) a series of sizing instruments, each having a sizing portion corresponding respectively in size and shape to one of the implant bodies for enabling a surgeon to determine the implant body to use;

(c) inserter instrument means for engaging the selected implant body so that the surgeon can insert and move the selected implant body in the opening in the thyroid cartilage;

(d) wherein the holding portions on the implant bodies are H-shaped in cross section and substantially the same size and shape.

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16. (Reissue claim) A system of phonosurgery implantation for insertion by a surgeon through an opening formed in a patient's thyroid cartilage to medialize a vocal cord therein, the system comprising:

(a) a series of implant bodies of different sizes, the implant bodies each having a holding portion and a series of engaging means for holding the implant bodies relative to the vocal cord by engaging the holding portion of the bodies in different positions in the opening formed in the thyroid cartilage;

(b) a series of sizing instruments, each having an elongated handle with a handle axis, proximal and distal end portions, the distal end portion having a sizing portion corresponding respectively in size and shape to one of the implant bodies for enabling a surgeon to determine the correct size and shape implant body to use;

(c) each of the sizing portions having a sloped surface that forms an obtuse angle with the handle axis, the sloped surface being positioned to engage the patient's vocal cord to be medialized;

(d) an inserter instrument for engaging the selected implant body so that the surgeon can insert and move the selected implant body in the opening in the thyroid cartilage;

(e) wherein the holding portions on the implant bodies are shaped in cross section to connect with the inserter instrument.

17. (Reissue claim) A system of phonosurgery implantation for insertion by a surgeon through an opening formed in a patient's thyroid cartilage to medialize a vocal cord therein, the system comprising:

(a) a plurality of implant bodies of different sizes;

(b) a plurality of sizing instruments of different sizes for enabling a surgeon to determine the implant body to use, each sizing instrument having an elongated handle with a handle axis, and proximal and distal end portions, and the distal end portion having a

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sizing portion corresponding respectively in size and shape to one of the implant bodies;

(c) each of the sizing portions having a sloped surface that forms an obtuse angle with the handle axis, the sloped surface being positioned to engage the patient's vocal cord to be medalized;

(d) an inserter instrument that enables a surgeon to engage and move the selected implant body in the opening in the thyroid cartilage.

18. (Reissue claim) A system of phonosurgery implantation for enabling a surgeon to insert a prosthesis through an opening formed in a patient's thyroid cartilage to stabilize a vocal cord therein, the system comprising:

(a) a series of implant bodies of different sizes;

(b) a series of sizing instruments for enabling a surgeon to determine the implant body to use, each having proximal and distal end portions, the proximal end portion having a handle, the distal end portion having a sizing portion corresponding respectively in size and shape to one of the implant bodies; and

(c) each of the sizing portions having a sloped surface that forms an obtuse angle with the handle axis, the sloped surface being positioned to engage the patient's vocal cord to be medalized.

4. The Examiner rejected added reissue claims 16-26 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" (Supp. Answer 4-13) .

5. The Examiner rejected reissue claims 1-3 (original patent claims 1-3) and added reissue claims 16-26 as being based on a defective reissue oath under 35 U.S.C. § 251 (Supp. Answer 13).

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6. With respect to the rejection under 35 U.S.C. § 251 of claims 16-26, the panel affirms the decision of the Examiner.

7. With respect to the rejection of claims 1-3, the panel reverses the decision of the Examiner.

Affirmed-In-Part²

II. ISSUES

1. The first issue before the Board is whether Appellant has established that the Examiner erred in rejecting claims 16-26 under 35 U.S.C. § 251 based on recapture.

2. The second issue before the Board is whether Appellant has established that the Examiner erred in rejecting claims 1-3 and 16-26 under 35 U.S.C. § 251 based on a defective reissue oath.

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 5,549,673*

1. According to Appellant (U.S. Patent 5,459,673, col. 1, ll. 10-13):

This invention relates to the field of phonosurgery and, more particularly, to implants, instruments and a method

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

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of implantation for surgically medializing a paralyzed or bowed vocal cord.

2. The invention actually claimed in U.S. Patent 6,144,380, is more specifically directed to “[a] system of phonosurgery implantation for insertion by a surgeon through an opening formed in a patient's thyroid cartilage to stabilize a vocal cord” so “the surgeon can insert and move the selected implant body in the opening in the thyroid cartilage.” (See Patent claims 1-3).

3. The patent sought to be reissued was based on Application 08/118,097 (which we refer to as the “original application” even though it is the second application in the sequence), filed September 8, 1993, which is said to be a continuation of Application 07/511,454 (which we refer to as “the parent”), filed April 20, 1990, now abandoned.

B. Prosecution history of the parent application

4. As filed, parent application 07/511,454 contained claims 1-17, directed to a phonosurgery implant, a system of phonosurgery implantation, and a method of sizing and implanting a phonosurgery prosthesis.

5. Claims 1-11 were directed to the phonosurgery implant. Claim 2 specifically recited that the implant includes “a sloped surface.”

6. Claims 12-16 were directed to the system of phonosurgery implantation. Claim 13 depended from claim 12, claim 14 depended from claim 13, and claims 15 and 16 depended from claim 14.

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7. During prosecution claims 5 and 12 were cancelled and independent claims 18 and 19 were added. Dependent claim 13 was amended to depend from claim 18.

8. Claims 18 and 19 were also directed to the system of phonosurgery implantation. Claim 18 specifically recited “sizing instruments each with sizing portions corresponding in size and shape to one of the implant bodies.”

9. On February 8, 1993, the Examiner finally rejected all pending claims.

C. Prosecution history of the “original” application

10. On September 8, 1993, Appellant filed continuation Application 08/118,097 to prosecute all pending claims. Additionally, claims 20-28 were added by amendment. Also, claim 2 was amended to further define the “sloped surface” portion of the phonosurgery implant body.

11. On February 14, 1994, the Examiner entered a Restriction Requirement.

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12. The restriction requirement indicated that original application 08/118,097 contained four independent and distinct inventions as follows:

- I. Claims 20-28 drawn to a prosthesis;
- II. Claims 1-4 and [6]-11 drawn to a implants;³
- III. Claims 13-16 and 18-19 drawn to a system of implantation;
and
- IV. Claim 17 drawn to a method of sizing and implanting a prosthesis.

13. On April 22, 1994, Appellant elected with traverse to prosecute the invention of Group III, claims 13-16 and 18-19.

14. On August 5, 1994, the Examiner entered a Non-Final Office Action (“Non-Final Action”).

15. The Non-Final Action responded to Appellant’s traversal of the restriction requirement. The restriction was (1) deemed proper, (2) maintained, and (3) made final.

16. Appellant subsequently authorized the cancellation of the claims directed to Groups I, II, and IV. (Notice of Allowability 3).

17. The Non-Final Action rejected claims 13-16 and 18-19 on various grounds.

³ Group II was erroneously listed as claims 1-4 and 7-11 by the Examiner in the Restriction Requirement, but was correctly identified as claims 1-4 and 6-11 by Appellant in the response dated April 22, 1994.

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

Stevens	US 3,547,115	Dec. 15, 1970
Ripple	US 4,566,466	Jan. 28, 1986

Koufman, *Laryngoplastic Phonosurgery*, Laryngeal and Tracheal Reconstruction, 339-350 (1988).

Isshiki, Kojima, Taira, and Shoji, *Recent Modifications in Thyroplasty Type I*, Meeting of the Am. Laryngological Ass'n, 777-779 (1989) (hereinafter "Isshiki").

19. Claims 13-16 and 18-19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

20. Claims 13 and 18-19 were rejected under 35 U.S.C. § 103 as being unpatentable over Koufman, Isshiki, Stevens, and Ripple.

21. In the Non-Final Action at page 5 the Examiner also indicated:

Claims 14-16 are deemed to recite patentably unobvious subject matter because the prior art does not show the claimed features and the instant disclosure appears to recite criticality . . . of the specific holding portion, inserting instrument and engaging means configuration over the prior art, i.e., faster, simpler, efficient locking.

22. On January 9, 1995, and May 18, 1995, Appellant filed a first Amendment ("the First Amendment") and a second Amendment ("the Second Amendment") responding to the Examiner's Non-Final Action.

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23. The First and Second Amendments amended independent claims 18 and 19, and amended dependent claims 14-16 into independent form.

24. Amended claim 18 and claim 13 are reproduced below:

18. A system of phonosurgery implantation for insertion by a surgeon through an opening formed in a patient's thyroid cartilage to stabilize a vocal cord therein, the system comprising:

(a) a series of implant bodies of different sizes, the implant bodies each having a holding portion and a series of engaging means for holding the implant bodies relative to the vocal cord by engaging the holding portion of the bodies in different positions in the opening formed in the thyroid cartilage;

(b) a series of sizing instruments, each having a sizing portion corresponding respectively in size and shape to one of the implant bodies for enabling a surgeon to determine the implant body to use;

(c) inserter instrument means for engaging the selected implant body so that the surgeon can insert and move the selected implant body in the opening in the thyroid cartilage.

13. The system of claim 18, wherein the holding portions on the implant bodies are substantially the same in size and shape.

25. After entry of the First and Second Amendments, the application claims were elected Group III claims 13-16 and 18-19 (and non-elected Groups I, II, and IV claims 1-4, 6-11, 17, and 20-28).

26. In both the First and Second Amendment, Appellant presented an argument with respect to the patentability of amended claims 14-16.

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27. Appellant's argument (see below) addressed at least the following limitations of Appellant's amended claims 14-16:

- (1) wherein the holding portions on the implant bodies are H-shaped in cross section.
- (2) the inserter instrument means includes an elongated portion with a notched-end adapted to engage the H-shaped holding portion in a releasable friction fit, the elongated portion including a telescoping movable rod for disengaging the implant body.
- (3) wherein the series of engaging means includes a series of shims with openings therein for engaging the holding portions of the implant bodies, the shims having openings in different locations for holding the implant bodies in different positions in the thyroid cartilage.

Limitation (1) is the "specific holding portion" referred to by the Examiner and Appellant, and was found in amended claims 14 and 15.

Limitation (2) is the "specific inserting instrument" referred to by the Examiner and Appellant, and was found in amended claim 15.

Limitation (3) is the "specific engaging means" referred to by the Examiner and Appellant, and was found in amended claim 16.

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28. In the First Amendment at page 5, last two full paragraphs, and in the Second Amendment at page 6, last two full paragraphs, Appellant argued the following:

The Examiner felt that Claims 14-16 recited patentably unobvious subject matter because the prior art does not show the claimed features and the instant disclosure appears to recite criticality . . . of the specific holding portion, inserting instrument and engaging means configuration over the prior art, i.e., faster, simpler, efficient locking.

Claims 14-16 have been rewritten in independent form and are believed allowable in view of the Examiner's comments. All of these claims now include a holding portion[,] inserting instrument and engaging means.

The argument addressed limitations (1)-(3) [see Finding of Fact 27] found in Appellant's amended claims 14-16.

29. On August 21, 1995, the Examiner entered a Final Office Action ("Final Action").

30. Claims 14-16 were indicated as allowable. Claims 13 and 18-19 were again rejected under 35 U.S.C. § 103 as being unpatentable over Koufman, Isshiki, Stevens, and Ripple.

31. On January 25, 1996, Appellants filed an After Final Amendment ("the After Final Amendment") responding to the Examiner's Final Office Action.

32. The After Final Amendment cancelled claims 13 and 18-19.

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33. On February 6, 1996, the Examiner conducted an interview with Appellant's representative. The Examiner entered an Interview Summary into the record stating:

Claims discussed: 1-4, 6-11, 17, and 20-28.

Prior art discussed: (None)

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: Authorization was given to cancel the nonelected, with traverse, claims and for the extension of time required to do so.

34. On February 14, 1996, a Notice of Allowability was mailed which stated that pending claims 14-16 were allowed and canceling claims 1-4, 6-11, 17, and 20-28.

35. Consistent with Office practice, application claims 14-16 were renumbered as patent claims 1-3, respectively, in the course of preparing the original application for issue.

36. U.S. Patent 5,549,673 issued August 27, 1996, based on the original application and contained claims 1-3.

D. Prosecution of reissue application

37. Appellant filed reissue application 09/141,186 on August 27, 1998, seeking to reissue U.S. Patent 5,549,673.

38. Appellant presented original patent claims 1-3 along with new reissue application claims 4-15 for consideration.

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39. Ultimately, reissue claims 4-15 were cancelled and reissue claims 16-26 were added by amendment.

40. Reissue claims 1-3 and 16-26 were finally rejected.

41. Reissue application claims 1-3 and 16-26 are before the Board in this appeal.

42. A copy of the claims 1-3 and 16-26 under appeal is set forth in the Claim Appendix of Appellant's Brief.

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

43. The Examiner has rejected reissue application claims 16-26 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.

44. The Examiner based the rejection of claims 16-26 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 103 over Koufman, Isshiki, Stevens, and Ripple, Appellant made *significant amendments* (on January 9, 1995, and May 18, 1995) to claims 14-16 (Supp. Answer 8-9):

(A) Appellant amended dependent claim 14 (depending from dependent claim 13 which depended from independent claim 18) into independent form by adding the claim 14 requirement of "wherein the holding portions on the implant bodies are H-shaped in cross section"

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to the combined subject matter of claims 13 and 18. Amended claim 14 became patent claim 1.

(B) Appellant amended dependent claim 15 (depending from dependent claim 14) into independent form by adding the claim 14 requirement of “wherein the holding portions on the implant bodies are H-shaped in cross section” and the claim 15 requirement of “the inserter instrument means includes an elongated portion with a notched-end adapted to engage the H-shaped holding portion in a releasable friction fit, the elongated portion including a telescopingly movable rod for disengaging the implant body” to the combined subject matter of claims 13 and 18. Amended claim 15 became patent claim 2.

(C) Appellant amended dependent claim 16 into independent form by adding the claim 16 requirement of “wherein the series of engaging means includes a series of shims with openings therein for engaging the holding portions of the implant bodies, the shims having openings in different locations for holding the implant bodies in different positions in the opening in the thyroid cartilage” to the combined subject matter of claims 13 and 18. Amended claim 16 became patent claim 3.

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45. Additionally, the Examiner based the rejection of claims 16-26 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 103 over Koufman, Isshiki, Stevens, and Ripple, Appellant made a *significant argument* with respect to amended claims 14-16. (See Finding of Fact 28 *supra* with respect to Appellant's argument regarding claim limitations (1)-(3) in Finding of Fact 27.)

46. The Examiner reasoned in-part as follows "appellant stated '[a]ll of these claims [14-16] now include a holding portion, inserting instrument and engaging means.'" (Supp. Answer 7, second full paragraph).

47. The Examiner further reasoned that the limitations relied upon by Appellant in securing the grant of the patent "are completely deleted (omitted) from all the disputed claims" (Supp. Answer 10) and "the reissue claims are broader than the original patent claims by not including the surrender-generating limitations" (Supp. Answer 11).

48. The record supports the Examiner's findings with respect to what limitations do not appear in reissue application claims 16-26 which were present in claims 1-3 of the original application, as allowed.

49. Additionally, the Examiner has rejected reissue application claims 1-3 and 16-26 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.

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

A. *Recapture Principles*

(1)

The statute

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

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

(2)

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

What has become known as the “recapture rule,” prevents a patentee from regaining through a reissue patent subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to

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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).

(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

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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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:

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

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in another aspect completely unrelated to the rejection,
the recapture rule bars the claim;

(b) if the reissue claim is narrower in an aspect
germane to [a] prior art rejection, and broader in an
aspect unrelated to the rejection, the recapture rule does
not bar the claim, but other rejections are possible.

(4)

North American Container

In *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005), the Federal Circuit had occasion to further address Substep (3)(a) of *Clement*.

North American Container involved a reissue patent, which had been held invalid by the U.S. District Court for the Northern District of Texas. The district court bottomed its invalidity holding based on a violation of the recapture rule. During prosecution of an application for patent, an examiner rejected the claims over a combination of two prior art references: Dechenne and Jakobsen. To overcome the rejection, *North American Container* limited its application claims by specifying that a shape of “inner walls” of a base of a container was “generally convex.” *North American Container* convinced the examiner that the shape of the base, as amended, defined over “both the Dechenne patent, wherein the corresponding wall portions 3 are *slightly concave* ... and the Jakobsen patent, wherein the entire reentrant portion is clearly *concave in its entirety*.” 415 F.3d at 1340, 75 USPQ2d at 1549. After a patent issued containing the amended claims, *North American Container* filed a reissue application seeking reissue claims

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in which (1) the language “inner wall portions are generally convex” was eliminated, but (2) the language “wherein the diameter of said re-entrant portion is in the range of 5% to 30% of the overall diameter of said side wall” was added. Thus, the claim sought to be reissued was broader in some aspects and narrower in other aspects.

The Federal Circuit, applying the *Clement* three-step test, held that the reissue claims were broader in scope than the originally-issued claims in that they no longer require the “inner walls” to be “generally convex.” The Federal Circuit further found that the broadened aspect (i.e., the broadened limitation) “relate[d] to subject matter that was surrendered during prosecution of the original-filed claims.” 415 F.3d at 1350, 75 USPQ2d at 1557. The Federal Circuit observed “the reissue claims were not narrowed with respect to the ‘inner wall’ limitation, thus avoiding the recapture rule.”

The Federal Circuit stated:

[t]hat the reissue claims, looked at as a whole, may be of “intermediate scope” is irrelevant. . . . [T]he recapture rule is applied on a limitation-by-limitation basis, and ... [North American Container’s] deletion of the “generally convex” limitation clearly broadened the “inner wall” limitation.

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

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(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 A_{Br}BCDEF, 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

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unless the views expressed in an opinion in support of the decision, among a number of things, are inconsistent with a decision of the Federal Circuit. In our view, the majority view in *Eggert* is believed to be inconsistent with the subsequent Federal Circuit decision in *North American Container* with respect to the principles governing application of Substep (3)(a) of *Clement*.

The *Eggert* majority's analysis is believed to be consistent with *North American Container* in that the majority applied the three-step framework analysis set forth in applicable Federal Circuit opinions, *e.g.*, (1) *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1370-71, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001); (2) *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 and (3) *Hester*, 142 F.3d at 148, 46 USPQ2d at 1648-49. However, the *Eggert* majority also held that the surrendered subject matter was the rejected claim only rather than the amended portion of the issued claim. 67 USPQ2d at 1717. At a similar point in the recapture analysis, *North American Container* has clarified the application of the three-step framework analysis. *North American Container* holds that the "inner walls" limitation (a portion of the issued claim that was added to the rejected claim by amendment) was "subject matter that was surrendered during prosecution of the original-filed claims." 415 F.3d at 1350, 75 USPQ2d at 1557.

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

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(6)

What subject matter is surrendered?

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

Is it

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

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

(7)

Clement principles are not per se rules

Our reading of our appellate reviewing court's recapture opinions, as a whole, suggests that the *Clement* steps should not be viewed as per se rules. For example, we note the following in *Clement*, 131 F.3d at 1469, 45 USPQ2d at 1164:

Although the recapture rule does not apply in the absence of evidence that the Appellant's amendment was "an admission

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that the scope of that claim was not in fact patentable,” *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984), “the court may draw inferences from changes in claim scope when other reliable evidence of the patentee’s intent is not available,” *Ball [Corp. v. United States]*, 729 F.2d at 1436, 221 USPQ at 294. Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the Appellant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary. *See Mentor [Corp. v. Coloplast, Inc.]*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball*, 729 F.2d at 1438, 221 USPQ at 296; *Seattle Box Co.*, 731 F.2d at 826, 221 USPQ at 574 (declining to apply the recapture rule in the absence of evidence that the Appellant’s “amendment ... was in any sense an admission that the scope of [the] claim was not patentable”); *Haliczer [v. United States]*, 356 F.2d at 545, 148 USPQ at 569 (acquiescence in the rejection and acceptance of a patent whose claims include the limitation added by the Appellant to distinguish the claims from the prior art shows intentional withdrawal of subject matter); *In re Willingham*, 282 F.2d 353, 354, 357, 127 USPQ 211, 213, 215 (CCPA 1960) (no intent to surrender where the Appellant canceled and replaced a claim without an intervening action by the examiner). Amending a claim “by the inclusion of an additional limitation [has] exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation.” *In re Byers*, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956). [Footnote and citations to the CCPA reports omitted.]

(8)
Allocation of burden of proof

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

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

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

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

(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

⁵ The reissue statute has been characterized as being remedial in nature, based on fundamental principles of equity and fairness and should be

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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 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).

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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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.

(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

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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response to a rejection, he may not argue that the surrendered territory comprised unforeseen subject matter that should be deemed equivalent to the literal claims of the issued patent. On the contrary, “[b]y the amendment [the patentee] recognized and emphasized the difference between the two phrases[,] ... and [t]he difference which [the patentee] thus disclaimed must be regarded as material.” *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136-37, 62 S. Ct. 513, 518-19 [52 USPQ 275, 279-80] (1942).

Festo II goes on to comment, 535 U.S. at 737-41, 122 S. Ct. at 1840-42, 62 USPQ2d at 1712-14:

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

A patentee’s decision to narrow his claims through amendment *may be presumed to be a general disclaimer of the territory between the original claim and the amended claim.* *Exhibit Supply*, 315 U.S., at 136-137, 62 S. Ct. 513 (“By the amendment [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference”). There are some cases, however, where the amendment *cannot reasonably be viewed as surrendering* a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee

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could not reasonably be expected to have described the insubstantial substitute in question. In those cases *the patentee can overcome the presumption* that prosecution history estoppel bars a finding of equivalence (emphasis added).

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

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

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(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.

“It is clear that in determining whether ‘surrender’ of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent.” *Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 1323, 80 USPQ2d 1495, 1502 (Fed. Cir. 2006). Thus, we also hold that an Appellant must show that at the time the amendment was made, an “objective observer” could not reasonably have viewed the subject matter broader than any narrowing amendment as having been surrendered (or that an “objective observer”

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would view the reissue claims as materially narrowed). The showing required to be made by Appellant 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 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

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the art and the understanding of a hypothetical person of ordinary skill in the art at the time of the amendment. Therefore, in determining whether an alleged equivalent would have been unforeseeable, a district court may hear expert testimony and consider other extrinsic evidence relating to the relevant factual inquiries.

. . . As we have held in the *Warner-Jenkinson* context, that reason should be discernible from the prosecution history record, if the public notice function of a patent and its prosecution history is to have significance. *See id.* at 1356 (“Only the public record of the patent prosecution, the prosecution history, can be a basis for [the reason for the amendment to the claim]. Otherwise, the public notice function of the patent record would be undermined.”); *Festo [I]*, 234 F.3d at 586 (“In order to give due deference to public notice considerations under the *Warner-Jenkinson* framework, a patent holder seeking to establish the reason for an amendment must base his arguments solely upon the public record of the patent’s prosecution, i.e., the patent’s prosecution history. To hold otherwise--that is, to allow a patent holder to rely on evidence not in the public record to establish a reason for an amendment--would undermine the public notice function of the patent record.”). Moreover, whether an amendment was merely tangential to an alleged equivalent necessarily requires focus on the context in which the amendment was made; hence the resort to the prosecution history. Thus, whether the patentee has established a merely tangential reason for a narrowing amendment is for the court to determine from the prosecution history record without the introduction of additional evidence, except, when necessary, testimony from those skilled in the art as to the interpretation of that record.

. . . When at all possible, determination of the third rebuttal criterion should also be limited to the prosecution history record. . . . We need not decide now what evidence outside the prosecution history record, if any, should be considered in

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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 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

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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 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.

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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 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

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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 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.

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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.*, 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

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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 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.

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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
- (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

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

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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 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, Appellant (not the public) control what amendments and arguments are presented during prosecution. When an amendment or argument is presented, it is the Appellant that should be in the best position to analyze what subject matter (*i.e.*, territory to use the Supreme Court’s language) is being surrendered (or explain why the reissue claims are materially narrowed).

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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, 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 44-47 set out the basis upon which the Examiner made a recapture rejection. As noted in Finding of Fact 48, the record supports the Examiner’s findings with respect to claims 16-26.

Basically, in the application which matured into the patent now sought to be reissued, the Examiner rejected originally filed independent claim 18 and dependent claim 13 (depending from claim 18) over the prior art.

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Appellant proceeded to re-write original application claims 14-16 (which depended from claim 13) in independent form. Amended application claims 14-16 ultimately issued as patent claims 1-3.

The Examiner made three points all as set out in Findings of Fact 44-46:

- (1) when faced with a rejection in the original application, Appellant made *significant* amendments (See Finding of Fact 44);
- (2) when faced with a rejection in the original application, Appellant made a *significant* argument (See Findings of Fact 45 and 28);
- (3) reissue claims 16-26 are broader than the original patent claims with respect to each of the limitations added and the argument made to overcome the rejection (See Findings of Fact 44-47).

The Examiner's accurate factual analysis with respect to claims 16-26 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 16-26, the burden of persuasion now shifts to the Appellant to establish that the *prosecution history* of the application, which matured into the patent sought to be reissued, establishes that a surrender of subject matter did not occur or that the reissued claims were materially narrowed.

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C. § 251 – Appellant’s Response⁸

(1)

Argument That Surrender Did Not Occur

With respect to reissue claims 16-26, Appellant argues “Applicant did not admit during prosecution of the original patent application that the elements in the independent claims were necessary to make them patentable.” (Br. 3). We disagree.

As discussed in Section IV. B. *supra*, the Examiner has set forth a prima facie case. We particularly note FF 28 and FF 46 which are directed to Appellant’s own statements about the inclusion in the patent claims of specific holding portion (patent claims 1 and 2), inserting instrument (patent claim 2) and engaging means (patent claim 3) configurations to distinguish over the prior art. Contrary to Appellant’s contention, we conclude that Appellant’s amendments (FF 23 and 44) and argument (FF 27, 28, and 46) resulted in a presumption of surrender.

Our conclusion is entirely consistent with the Federal Circuit’s *en banc* decision in *Honeywell Int’l, Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 71 USPQ2d 1065 (Fed. Cir. 2004), *cert. denied*, 125 S. Ct. 2928 (2005) (amending a first independent claim which has been rejected over the prior art by incorporating the limitations of a second dependent claim which had not been rejected, held to be an amendment involving "surrender" in the context of the doctrine of equivalents). *See also, Deering Precision*

⁸ Appellant’s response is contained in the Brief (Br.) filed August 6, 2001, fully replacing the defective Brief filed June 14, 2001.

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Instruments, L.L.C. v. Vector Distribution Systems, Inc., 347 F.3d 1314, 1325, 68 USPQ2d 1716, 1723-24 (Fed. Cir. 2003), *cert. denied*, 540 U.S. 1184 (2004), where the Federal Circuit states:

As an initial note, the only asserted independent claim that is arguably subject to a narrowing amendment during prosecution is issued claim 1. This claim, filed as claim 11, essentially incorporated original claim 1 and original dependent claim 3. Original claim 9 was not amended during prosecution and issued as independent claim 4 in unamended form. In response to the first Office Action rejecting claim 1 under 35 U.S.C. § 103(a) and objecting to claim 3 because it depended from rejected claim 1, the applicants deleted claims 1 and 3 and added new independent claim 11.

Deering's addition of independent claim 11, coupled with the clear surrender of the broader subject matter of the deleted original independent claim presumptively bars Deering from arguing infringement under the doctrine of equivalents. As the Supreme Court noted, the correct focus is on whether the amendment surrendered subject matter that was originally claimed for reasons related to patentability. *Festo II*, 535 U.S. at 736, 122 S.Ct. 1831. Here, the patentees clearly disclaimed the territory between the original claim 1 and new claim 1 as issued. *Id.* at 740, 122 S.Ct. [at] 1831. Original claim 1 claimed “a sliding weight movably carried by said beam for movement along said scale.” In response to the examiner's rejection under 35 U.S.C. § 103(a), the applicants deleted original claims 1 and 3 and settled for claims containing the narrower requirement that a portion of the sliding weight be disposed substantially in a plane defined by the fulcrums originally present in claim 3. The territory between the sliding weight limitation of original claim 1 and the Zero Position Limitation was thus surrendered by the patentees. *See Pioneer Magnetics, Inc. v. Micro Linear Corp.*, 330 F.3d 1352, 1357 [66 USPQ2d 1859, 1862] (Fed. Cir. 2003).

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Appellant further argues “that there were three independent claims with varying scope indicates that there were various patentable aspects of the invention.” (Br. 3). For purposes of resolving the appeal, we will agree.

Appellant’s three patent claims each include at least one of three different specific limitations that distinguish that claim over the prior art. However, Appellant fails to explain why he believes this precludes a recapture rejection when claims are presented which include none of the three surrender generating limitations. Thus, Appellant’s argument does not rebut the presumption of surrender.

(2)
*Argument That Claims 16-26 Are Materially Narrowed
As to An Overlooked Aspect*

Appellant argues “[c]laims 16-18 . . . include a [limitation] that was never a part of the original prosecution and therefore the inclusion of this [limitation] eliminates any ‘recapture’ issue.” (Br. 3). We disagree.

We agree with Appellant that a reissue claim avoids recapture when it is materially narrowed with respect to an overlooked aspect. See Section IV. A. (12) *supra*. However, we do not find that Appellant has demonstrated such in the current reissue application. While we agree that the claims presented during the prosecution of the applications which resulted in the patent do not explicitly recite a sloped surface on the sizing instruments, we are unable to find that this limitation was overlooked.

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The burden is on Appellant to show that failure to claim a sloped surface on the sizing instruments was an oversight. See Section IV. A. (11) *supra*. We particularly note the following facts: (1) application claim 2 recited that the implant included a sloped surface (FF 5 and 10), and (2) application claim 18 recited that the sizing instruments corresponded in size and shape to the implants (FF 8 and 24). Given these facts, Appellant's failure to explicitly import the limitation found in application claim 2 into application claim 18 looks more like a prosecution choice rather than an oversight. In this case, Appellant's failure to explicitly claim the limitation is not sufficient by itself to show that the limitation was overlooked. Thus, contrary to Appellant's contention, we conclude that an "objective observer" would not view the newly claimed limitation as an overlooked aspect.

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

(3)
Claims 1-3

The Examiner has rejected reissue application claims 1-3 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 1-3 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. NEW GROUNDS OF REJECTION

A. 35 U.S.C. § 251

We reject reissue claims 18 and 20-26 under 35 U.S.C. § 251, using our authority under 37 C.F.R. § 41.50(b).

Appellant's reissue oath alleges "I erred by claiming less of my invention than I had a right to claim." Even if we adopt Appellant's position with respect to recapture, we find no such error with respect to claims 18 and 20-26. As to the subject matter of these claims, the prosecution of Application 08/118,097, its parent application, and the patent resulting from Application 08/118,097 are all error free. As to these claims, Patentee claimed exactly what they had a right to claim in the patent, no more, no less.

Appellant's prosecution history shows that responsive to a restriction requirement, Appellant elected to prosecute an application directed to a distinct invention, i.e., a system of implantation. (See FF 11-13 and 16). Reissue claims 18 and 20-26 are directed to a different invention than that of patent claims 1-3. (See FF 1-2). Reissue claims 18 and 20-26 do not result in implantation (i.e., insertion) of anything. Therefore, contrary to the preambles of these claims they are not a system of implantation. Rather, these reissue claims merely recite a series of implants and a series of sizing instruments.

Appellant is estopped from obtaining by reissue claims which, because of a requirement for restriction in which he had acquiesced, he could not claim in his patent. *See In re Orita*, 550 F.2d 1277, 1280,

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193 USPQ 145, 148 (CCPA 1977). Appellant cannot now rely on the reissue statute, in order to undo the consequences of his 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, second paragraph

We reject reissue claims 16-26 under 35 U.S.C. § 112, second paragraph, as being indefinite, using our authority under 37 C.F.R. § 41.50(b),

Part (c) of each of reissue claims 16-18 ends with the term “medalized” which we believe should read –medialized–.

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 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 ...

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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, Appellant 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 Appellant, 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:

(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 Appellant elect to prosecute further before the Examiner, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145

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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 Appellant 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.

VI. CONCLUSIONS OF LAW

(1) Appellant has failed to establish that the Examiner erred in rejecting claims 16-26 under 35 U.S.C. § 251 based on recapture. Specifically, Appellant's arguments have not rebutted the presumption, upon which the Examiner's rejection is based, i.e., that at the time of the amendment an objective observer would reasonably have viewed the subject matter of the narrowing amendment and limitations argued in the parent as having been surrendered.

(2) Claims 16-26 are not patentable.

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

(4) On the record before us, claims 1-3 have not been shown to be unpatentable.

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

VII. DECISION

Upon consideration of the record, and for the reasons given, we affirm the rejection of claims 16-26 under 35 U.S.C. § 251 based on recapture; we reverse the rejection of claims 1-3 under 35 U.S.C. § 251 based on a defective reissue oath; we reject reissue claims 18 and 20-26 under 35 U.S.C. § 251; and we reject reissue claims 16-26 under 35 U.S.C. § 112, second paragraph.

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

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

rwk

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