

## **IP LAW ADVISORY**

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### The Federal Circuit Changes the Reissue Landscape

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Two recent Federal Circuit decisions have highlighted the importance of reissue proceedings, in which a patent owner has the opportunity to correct the claims of an issued patent. *In re Tanaka* and *In re Mostafazadeh* highlight the importance and limitations of reissue proceedings. While *Tanaka* grants patent owners the right to correct issued patents by more precisely claiming certain narrow embodiments of their invention, the reaffirmation of the recapture rule in *Mostafazadeh* limits the ability of patent owners to broaden their claims in a reissue proceeding when this broadening relates substantially to subject matter that was surrendered in order to obtain the underlying patent.

The Federal Circuit's decision in *In re Tanaka*, will be welcomed by patent owners seeking to more completely capture their invention in the claims of their patent. This decision makes it clear that a reissue proceeding is an appropriate procedure for a patent owner who wishes to correct the claims of an issued patent simply by adding new dependent claims.

This type of reissue proceeding is referred to as a narrowing reissue, as the new dependent claims being added are by definition not broader than the independent claims of the issued patent that is the subject of the reissue proceeding.

The U.S. Patent Office argued that the purpose of a reissue proceeding was to correct an error in an issued patent that rendered that patent wholly or partly inoperative or invalid. The Patent Office asserted that simply adding new dependent claims is not correcting any

error, as there is no indication that the patent is in any way invalid.

The Federal Circuit disagreed, holding that omitting a narrower claim from a patent is an error that renders the patent partly inoperative by failing to protect the disclosed invention to the full extent allowed by law. By allowing the patent owner to seek reissue correction for this type of error, the Federal Circuit has broadened the potential use of reissue proceedings.

Adding new dependent claims can more clearly cover your product or your competitor's product, and can be more difficult to invalidate in litigation. These are quite compelling reasons to perfect the claims of a patent as in *Tanaka*.

While *Tanaka* exemplifies the usefulness of reissue proceedings, the second Federal Circuit decision – *In re Mostafazadeh* – limits the manner in which the patent owner can broaden claims in a reissue proceeding.

In addition to the requirement that a broadening reissue proceeding be filed within two years of the issue date of the patent, *Mostafazadeh* affirms the "recapture rule," which bars the patent owner from claiming subject matter in a reissue proceeding that was erroneously surrendered to obtain the patent that is the subject of the reissue proceeding. The subject matter of such amendments is deemed to be surrendered to the public, and the recapture rule can prevent this surrendered subject matter from being recaptured via a reissue proceeding.

The recapture rule applies even when the surrender was made in error and the surrendered subject matter is described in

the patent, novel, and nonobvious over the prior art of record. While the Federal Circuit allows some surrendered subject matter to be recaptured through a modest broadening during a timely filed reissue proceeding, the broadening correction still must materially narrow the claim scope such that the surrendered subject matter is not entirely or substantially recaptured.

The prohibition on substantial recapture and the inherent ambiguity in determining whether a recapture of surrendered subject matter is "substantial" will likely act as a check on broadening reissue proceedings and will complicate a patent owner's attempts to perfect claims to disclosed subject matter in a broadening manner prior to asserting a patent.

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