

Reconsider Recapture In A Patent Reissue

Law360, New York (June 20, 2011) -- An application for a reissue of an issued patent is often the patent owner's only chance to correct an error in the claims of that patent. With recent developments at the Federal Circuit and possible legislative attention to post-grant patent practice, it is increasingly important to convey to business leaders and innovators how effective use of this important post-grant proceeding can strengthen the patent owner's position in essentially any patent-related business transaction.

Understanding when and how to use a reissue proceeding to further a business objective, and a proactive strategy to minimize the pitfalls associated with some reissue proceedings, strengthens patent portfolios and puts patent owners in an advantageous position in their field. As the courts have recently clarified, it is smooth sailing for a patent owner wishing to add narrower claims to an issued patent.

However, the judicially created rule against the recapture of surrendered subject matter acts as a formidable headwind against a patent owner seeking to broaden claims in a reissue proceeding. While reissue proceedings remain valuable, perhaps it is time to reconsider the recapture rule so that reissue proceedings can be used to their full, appropriate extent.

The Recent Developments

The Federal Circuit's recent *In Re Tanaka* decision gave a boost to innovators seeking to more robustly capture their invention in the claims of their patent. This decision makes it clear that the reissue vehicle for correcting errors in an issued patent allows the patent owner to simply add new dependent claims. In doing so, by definition, the claims of the reissued patent are not broader than those of the original patent.

However, the value to the patent owner is profound and clear — new dependent claims may more precisely cover your product, may be more difficult for your competitors to dismiss as likely invalid, and may be more demonstrably infringed by your competitors. When a considered analysis of a patent reveals that your (or your competitors') product is covered more accurately by your patent description than by your patent claims — a reissue proceeding down the path blazed by *Tanaka* should certainly be considered.

Having opened the door to this potent and effective use of the reissue tool with the Tanaka decision, the Federal Circuit almost immediately tempered any enthusiasm with their *In Re Mostafazadeh* decision. This decision limits the manner in which claims in a reissue proceeding can be broadened, holding that claims in a reissue proceeding cannot be broader than the issued claims of the underlying patent in a manner directly pertinent to any subject matter surrendered during prosecution of the underlying patent. This judicial doctrine is called the “recapture rule” and prohibits the inventor from claiming subject matter that was erroneously surrendered to obtain the patent that is the subject of the reissue proceeding.

Put simply, if the inventor amends a claim during prosecution to overcome a prior art rejection, the subject matter given up by that amendment is deemed to be surrendered to the public. Even if this surrender was made in error, the claims in a reissue proceeding cannot be broadened to correct this error, as the Federal Circuit has decided that the surrendered subject matter cannot be “entirely or substantially recaptured.”

While there are nuanced differences between the narrowing reissue proceeding of Tanaka and the broadening reissue proceeding of *Mostafazadeh*, collectively these cases emphasize the importance of reissue proceedings, their potential benefits, and the traps that they present for the unwary. While Tanaka grants innovators the right to correct their issued patents by more explicitly claiming certain embodiments of their invention, the reaffirmation of the recapture rule in *Mostafazadeh* limits the rights of innovators to correct their issued patents to simply claim their own inventions.

Reconsider the Recapture Rule in Reissue Proceedings

One thing that gets lost in the shouting over the recapture rule is the fact that the inventor is simply claiming what he or she invented, fully described and publicly disclosed in the patent. This innovator has a statutory right to broaden issued claims by commencing the reissue proceeding within two years of the issue date of the patent. The very reason for the existence of reissue proceedings is to correct an error that is made without deceptive intent. Why is an erroneous and unnecessary surrender of subject matter made during prosecution beyond reproach? Why are some unnecessary claim amendments correctable errors and others are not?

For example, if it can be demonstrated that a claim amendment during prosecution was added merely for clarity and not to distinguish from the prior art, one could argue that this subject matter has not been surrendered, and therefore could be recaptured in a reissue proceeding. This introduces ambiguity as to which erroneous claim errors are correctable.

Defenders of the recapture rule might point out that this rule lets the public rely on surrendered subject matter as being dedicated to the public. However, this theoretical justification is muddled in practice in two important respects.

First, the exception to the recapture rule is sizable enough to inject uncertainty into the public domain. The Federal Circuit allows some surrendered subject matter to be recaptured. For example, the erroneous claim limitation that surrendered subject matter during prosecution of the underlying patent can be modified in a broadening manner during reissue so long as it materially narrows the claim scope such that the surrendered subject matter is not entirely or substantially recaptured. Determining whether or not the recaptured subject matter is “substantial” entails some risk and ambiguity, especially when applied to the nuanced facts of a claimed invention in, for example, the electrical or pharmaceutical arts.

Second, a reissue proceeding can broaden issued (patented) claims in other respects, unrelated to any subject matter discussed or surrendered during the prosecution of the underlying patent. This potential change in claim scope tempers the public's reliance on the recapture rule as a delineator between the public domain and the exclusive property rights of the issued claim.

Allowing the claims to be broadened in some aspects but not others confuses the issue and does not put the public on proper notice of exactly where the borders of exclusive patent rights and the public domain lie. Silence during prosecution regarding a claim element (and thus no surrendered subject matter) can allow the patent owner to broaden that claim element to the patentable limits of its description in the body of the patent, yet an error by the patent owner where that claim element is unnecessarily amended during prosecution gives rise to a judicial doctrine prohibiting the inventor from fully claiming the invention.

This inconsistency gives the impression that the recapture rule is somewhat arbitrary. Under one fact pattern, the inventor can claim the full patentable scope of the described invention; yet under another fact pattern the same patentable subject matter cannot be claimed.

While the claims define the invention and grant the bundle of rights that accompany an issued patent, the ultimate borders of potentially patentable subject matter in a broadening reissue proceeding are bound by the description of the invention in the body of the patent being reissued. Any statutory subject matter that is appropriately described, novel and non-obvious over the prior art can be claimed in a broadening reissue proceeding. This proceeding is open to the public, and the well-settled rules surrounding written description, novelty and obviousness give both the Patent Office and the public a solid basis for determining what may or may not be claimed during a reissue proceeding.

The recapture rule is unrelated to the novelty and non-obviousness of the claimed subject matter, which, importantly, was invented by an innovator who is simply attempting in good faith to protect his or her invention. A broadening reissue does not allow one to claim the public domain, or to claim anything broader than the inventor is entitled to claim during prosecution of a regular patent application.

Claims in a broadening reissue are limited to embodiments that are adequately described in the underlying patent that is the subject of the reissue proceeding. A broadening reissue simply lets an inventor correct a human error to claim what he or she invented.

Uncertainty on the part of the public as to the maximum potential scope of the invention is eliminated after the two-year window for filing a broadening reissue, and is mitigated during that two-year window by both the prior art and the described subject matter in the patent being reissued. A broadening reissue guided by these straightforward parameters strikes a nice balance between the innovator's contribution to society and the public's need to know where the public and private intellectual property boundaries fall. The recapture rule upsets this balance and unnecessarily excludes some good-faith human errors from correction.

The Value and Pitfalls of Reissue Proceedings

The fundamental value of using a reissue proceeding to perfect the claims of an issued patent remains intact. Whether broadening or narrowing the claims of a patent, a reissue proceeding can more precisely cover your product or an infringing product. This strengthens the patent owner's position when asserting that patent for offensive or defensive reasons in, for example, licensing, litigation, or venture capital fund raising contexts.

The pitfalls of a reissue proceeding require consideration, as there can be unintended consequences. For example, new and problematic prior art may surface; or a third party may file a protest where they assert that your claims are invalid, which can delay the reissue proceeding. In addition to problems with the recapture rule, claim amendments during a reissue proceeding can give rise to intervening rights and can reduce or eliminate past damages. The existence of a continuation or divisional application could moot the need to file a reissue application, as the broader or narrower claims could be incorporated into those currently pending applications.

Conclusion

A reissue proceeding is often the patent owner's last option to correct an issued claim so that it has some value. Unless or until the recapture rule is reconsidered, removed, revoked, rejected or recalled from a reissue proceeding, innovators and patent owners are well served to work with their patent lawyers to ensure that claims are originally filed and prosecuted with considered thought given to precisely what subject matter is being surrendered with any claim amendment.

Is every limitation, element or even word that is added to a claim there for a reason? Is there a better way to phrase the claim limitation or amendment? It is a considered response to these questions that will allow the patent owner to reap the sizeable benefits of a reissue proceeding when necessary, while minimizing the patent owner's exposure to the harmful and limiting consequences of the recapture rule.

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