

# Hot Topics in Patent Reissue Law for 2011



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# Reissue Recapture Doctrine

- *In re Mostafazadeh* (Appeal No. 2010-1260)(Dyk J.)
- Federal Circuit Decision (May 3, 2011)
- Panel: Dyk, Friedman and Prost
- Holding: reissue application (10/016,750) impermissibly recaptured subject matter surrendered during prosecution of the original patent (USPN 6,034,423) directed to lead frame based semiconductor packaging

# Overview from Oblon's [www.patentspostgrant.com](http://www.patentspostgrant.com)

- This case explored the degree to which a claim limitation added to distinguish over the prior art during original prosecution may be broadened during patent reissue
- In patent reissue, *Mostafazadeh* sought an intermediate scope to the “circular attachment pad” limitation added to his claims during original prosecution. In the reissue claims, the terminology “circular” was removed despite the fact that in the original prosecution applicant asserted that a *circular* attachment pad was novel.

# Overview

- To justify this broadening, the Patentee argued that the claim was materially narrowed in “other respects” to make an otherwise invalid claim valid
- On appeal, the CAFC considered whether or not the “materially narrowed in other respects” aspect of the rule established in *In re Clement*, (MPEP 1412.02), must be related to the “critical limitation” (i.e., circular attachment pad) or whether the narrowing must relate to an “overlooked aspect,” such as an unclaimed species or embodiment as advanced by the USPTO

# Overview

- In their affirmance of the USPTO, the CAFC characterized the BPAI analysis as “perplexing” and found their interpretation of “materially narrowing” as “contrary to our precedent”
- The CAFC decision explained that the materially narrowing necessary to avoid recapture must relate to the surrendered subject matter, not an “overlooked aspect” of the invention as required by the USPTO

# Overview

- [A] limitation that is added during prosecution to overcome prior art cannot be entirely eliminated on reissue because doing so would constitute recapture of the surrendered subject matter. The limitation may be modified, however, so long as it continues to materially narrow the claim scope relative to the surrendered subject matter such that the surrendered subject matter is not entirely or substantially recaptured.
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- [T]he recapture rule is violated when a limitation added during prosecution is eliminated entirely, even if other narrowing limitations are added to the claim. If the added limitation is modified but not eliminated, the claims must be materially narrowed relative to the surrendered subject matter such that the surrendered subject matter is not entirely or substantially recaptured. (emphasis added)

# Overview

- *Mostafazadeh* did not eliminate the attachment pad limitation, only modified it by removing “circular”
- Still, the Court found that the narrowing limitations added in the patent reissue did not relate to the attachment pad limitation, thus step (3) of the *Clement* test could not save the Patentee

# Lessons Learned

- Had the Patentee added narrowing language that related to the circular pads, such as requiring that the attachment pads be formed of a specific alloy, or oriented in a certain way, the removal of “circular” may have been acceptable
- This case, much like *In re Tanaka*, will provide Patentees a greater degree of flexibility, and opportunity to pursue patent reissue going forward, if they properly understand the contours of the reissue recapture doctrine when filing broadened reissue applications



# Can there be prosecution laches in patent reissue?

- Federal Circuit appeal of BPAI decision in *Ex parte Staats*, Appeal No. 2009-007162 (April 26, 2010)
- BPAI decision by 5 APJ panel, including former Chief APJ Fleming, Vice Chief APJ Moore and MacDonald, Senior APJ McKelvey and APJ Jeffrey

# Overview from Oblon's [www.patentspostgrant.com](http://www.patentspostgrant.com)

- Although presented in the context of patent reissue, the point of contention in *Staats* is actually one of prosecution laches and the application of equitable principles to statutory interpretation
- In *Staats*, the Board upheld a rejection of a broadening reissue application as defective under 35 U.S.C. 251 for failing to include the appropriate broadening oath within two years of the original patent issuance

# Overview

- The Board reasoned that although a parent reissue had filed an appropriate broadening oath and identified at least one error, the continuation reissue was not entitled to rely on that oath, despite the continuity between these reissue applications

# Overview

- *This is a case of first impression. Resolution of the case hinges on one fundamental question: Can a continuing reissue application broaden patented claims beyond the statutory two-year period in a manner unrelated to the broadening aspect that was identified within the two-year period?*
- *Put another way, is it enough under the law to merely present an intent to broaden that is limited to a particular aspect (e.g., a particular embodiment of the invention) within the two-year period, yet broaden in unforeseeable ways (e.g., pertaining to other embodiments) outside the two-year period?*

# Overview

- While the Board noted that the question of interpreting 35 U.S.C. 251 in this manner was a case of first impression, MPEP 1412.03 (IV) was argued by Applicant as directly on point (i.e., explicitly authorizing the practice)
- Curiously, the Board found this aspect of the MPEP ambiguous, and analyzed the statute based upon their understanding of the equitable principles behind the two-year limitation provided by the statute

# Overview

- In doing so, the BPAI relied heavily on the aspect of *foreseeability* emphasized in case law addressing prosecution laches
- In affirming the rejection, the BPAI surmised:
- *Since this broadening was completely unforeseeable by the public within the two-year statutory period—a circumstance that is undisputed—it runs counter to the public notice function underpinning § 251 and is therefore improper*

# Overview

- In arriving at their conclusion on equitable principles, the BPAI reviewed the seminal cases in this area (*In re Graff*, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997) and (*In re Doll*, 419 F.2d 925, 928, 164 USPQ 218, 220 (CCPA 1970))
- The Board noted that both of these early decisions supported their conclusion that the manner of broadening must be identified within two years

# Overview

- Arguably, neither of these cases needed to consider the *manner* of the broadening
- Thus, the Board noted only that the facts of Doll were consistent with their decision, and *Graff* emphasized the two year requirement. So, to buttress their decision, the Board relied on case law relating to prosecution laches, such as *Symbol Techs., Inc. v. Lemelson Med., Educ. & Res. Found.*, 277 F.3d 1361, 1364 (Fed. Cir. 2002)



# Analysis

- However, the cases dealing with *foreseeability* in the prosecution laches context relate to applications that were prosecuted in secret (i.e., before the days of publication)
- As reissue applications are published in the Official Gazette, foreseeability with respect to specific changes is only a mouse click away via PAIR. Certainly, in the past, there was significant motivation to purposely delay prosecution in the days of “submarine applications.”

# Analysis

- However, by waiting 8 years to file the continuation reissue application in question, Applicant had only the remainder of the patent term to enforce its new claims subject to possible intervening rights
- There is little motivation for anyone to drag their feet in reissue, likewise, the manner of broadening is not the least bit secret
- Interested parties cannot not only track the progress of such broadening publicly, but are provided a mechanism to protest via the submission of prior art under 37 CFR 1.291

# Crystal Ball

- An affirmance by the Federal Circuit would be surprising, either under the reissue statute or the judicially created doctrine of prosecution laches
- Was this unreasonable and unexplained delay in seeking patent protection for the broadened claims?
- Was their repeated refusal to take allowed claims without substantive prosecution?

# Lessons Learned

- Before surprising the public with novel interpretations by the USPTO in BPAI decisions, there should be efforts made by the USPTO to address these legal and policy issues through public notice and comment to obtain a cross-section of views on the wisdom of such action Cf. *Ex parte DeGrado* (BPAI 2011)

# Thank You

- Thank you for your kind attention
- Questions and comments can be sent to me at [skunin@oblon.com](mailto:skunin@oblon.com)