



The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper No. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIBALD KRAUS

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Appeal 2005-0841  
Application 08/230,083<sup>1</sup>  
Technology Center 2600

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ORAL HEARING: April 7, 2005

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Before: FLEMING, Chief Administrative Patent Judge, and GARRIS, McQUADE, JERRY SMITH, NASE, RUGGIERO, GROSS, DELMENDO, FRANKLIN, MacDONALD and NAPPI, Administrative Patent Judges.<sup>2</sup>

PER CURIAM

**DECISION ON APPEAL UNDER 35 U.S.C. § 134**

The examiner has rejected claims 14 and 16 of the reissue application on appeal as being unpatentable under 35 U.S.C. 251 based on recapture. With respect to claim 14, a 6 to 5 majority

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<sup>1</sup> Application filed April 20, 1994, seeking to reissue U.S. Patent 5,105,731, issued April 21, 1992, based on application 07/642,475, filed January 17, 1991. The real party in interest is TRW Automotive Electronics & Components Km/h and Co., KG, previously known as TRW United-Carr GmbH and Co., KG. Appeal Brief (second submission filed October 4, 2000), page 1.

<sup>2</sup> The appeal was originally heard by Administrative Patent Judges McQuade, Nase and Delmendo. Subsequent to oral argument, the panel was expanded to include Chief Administrative Patent Judge Fleming and Administrative Patent Judges Garris, Jerry Smith, Ruggiero, Gross, Franklin, MacDonald and Nappi. Applicant was offered, but declined, an opportunity for additional oral argument.

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of the panel affirms the decision of the examiner. With respect to claim 16, the panel unanimously affirms the decision of the examiner.

A plurality opinion authored by Chief Judge Fleming, joined by Judges Jerry Smith, MacDonald and Nappi, a concurring opinion authored by Judge Gross, joined by Judge Ruggiero, an opinion concurring-in-part and dissenting-in-part authored by Judge Nase, joined by Judges Garris, Delmendo and Franklin, an opinion concurring-in-part and dissenting-in-part authored by Judge McQuade, Appendices 1 through 7 to Chief Judge Fleming's opinion and Appendices 8 through 10 to Judge Nase's opinion, follow.

Chief Judge Fleming, with whom Judges Jerry Smith, MacDonald and Nappi join, concurring.

#### **DECISION ON APPEAL**

##### **A. Introduction**

1. Applicant appeals from a final rejection entered November 9, 1999.

2. The reissue application on appeal seeks to reissue U.S. Patent 5,105,731 (the '731 patent), issued April 21, 1992, based on application 07/642,475, filed January 17, 1991.

3. The reissue application contains claims 1-14 and 16.

4. Claims 14 and 16 have been rejected under 35 U.S.C. § 251 on the grounds that these claims seek to recapture subject matter surrendered when the patent sought to be reissued was granted.

5. Claims 1-13, the remaining claims, have been indicated as being allowable.

6. The principal issue before the Board is whether applicant has established that the examiner erred in rejecting claims 14 and 16 based on recapture.

**B. Findings of fact**

The following findings of fact are believed to be supported by a preponderance of the evidence.

The invention

1. The invention relates to a check valve device for preventing reverse air flow in the ventilation duct leading to the passenger space of a motor vehicle (the '731 patent at col. 1, lines 6-9).

2. The patent also refers to the "device" as an "assembly."

3. The invention can be understood by reference to Figures 1 through 11 of the drawings of the '731 patent, all of which are reproduced in Appendix 1 of this opinion.

4. Fig. 1 is a cross-sectional view of the assembly **1** (col 2, lines 59-61).

5. With reference to Fig. 1, the assembly **1** comprises a stable and relatively rigid outer housing **3** to which is fastened (through at least one clamping device **18, 19**) a thin and somewhat more light-weight inner frame **4** (col. 3, lines 25-28).

6. Between the outer housing **3** and the inner frame **4**, there is check valve element **5** (col. 3, lines 29-31).

7. As shown in Fig. 1, two check valve elements **5** are included in assembly **1**.

8. In Fig. 1, the check valve elements **5** are shown in a "closed" position (col. 3, lines 36-37).

9. When the check valve elements **5** are in a closed position, they rest under their own weight under the force of gravity against an oblique grid **11** formed on the outer housing **3** (col. 3, lines 37-39) and air cannot flow through the assembly **1**.

10. When air enters the assembly, check valve elements **5** are deflected upwardly and lifted away from oblique grid **11** and engage horizontally extending stays **9** of inner frame **4** (col. 3, lines 39-44).

11. The patent indicates that air enters the assembly "from the direction of the arrow" (col. 3, lines 40-41). No arrow is apparent in the drawings, including Fig. 1.

Nevertheless, it is manifest that the "direction of the arrow" is from left to right in Fig. 1.

12. Fig. 2 is a front view of inner frame **4** (col. 2, lines 63-64).

13. With reference to Fig. 2, inner frame **4** has peripheral rim **7** to which are connected transverse rib or web members **8** (col. 3, lines 52-54).

14. With reference to Figs. 3 and 4, extending out from ribs **8** are several stays or support elements **9** (col. 3, lines 56-57).

15. As noted earlier, when check valves **5** are moved into the open position, they are engaged with stays **9**.

16. The stays **9** are adjoined to each other and rigidified by a surrounding, generally continuous frame element **10** (col. 3, lines 58-59).

17. Returning to Fig. 1, the assembly of the inner frame **4**, outer housing **3** and check valve elements **5** is fastened to a support element **2** of a motor vehicle (not shown) by at least one clip connection **6** on outer housing **3** (col. 3, lines 46-51).

18. According to what we will call a "first" embodiment<sup>3</sup> of the invention, the clip connection can include a springy resilient tongue **22'** (col. 5, lines 17-18).

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<sup>3</sup> In the Kraus patent, what we refer to as the "first" embodiment is referred to as a "further embodiment" (col. 5, line 16).

19. With reference to Figs. 9, 10 and 11, there is shown springy tongue **22'** made separately as an independent piece from outer housing **3** (col. 5, lines 16-19).

20. Springy tongue **22'** is supported on locking element **30** (Fig. 9) which can be connected to outer housing **3** (col. 5, lines 19-22).

21. Locking element **30** is guided in its movement through a dove-tail guide **31** (Fig. 11) on the outer surface of outer housing **3** in that part of the outer assembly identified as wall **21** (Fig. 9) (col. 5, lines 21-25).

22. The patent also describes another embodiment, which we will call a "second" embodiment, for a clip **6** without a dove-tail guide having a springy tongue **22**, all as shown in detail in Figs. 6, 7 and 8 (col. 4, line 31 through col. 5, line 15).

Prosecution history of the original application

23. As noted earlier, the patent sought to be reissued was based on application 07/642,475, filed January 17, 1991 ("original application").

24. As filed, the original application contained claims 1-14 (reproduced in Appendix 2 of this opinion).

25. On May 17, 1991, the examiner entered a first Office action.

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26. Claims 1 and 3-11 were rejected on various grounds.

27. Claims 3, 4 and 6-9 were rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite.

28. Claims 2 and 12-14 were "objected to" as being dependent on a rejected claim.

29. Claims 1, 3-5 and 7-11 were rejected under 35 U.S.C. § 103 as being unpatentable over the following prior art:

(1) Feles et al. (Feles), U.S. Patent 3,405,968  
or

(2) Frien, U.S. Patent 4,781,106 in view of

(3) Mizusawa, U.S. Patent 4,691,623.

30. Feles, Frien and Mizusawa are prior art vis-à-vis applicant under 35 U.S.C. § 102(b).

31. The examiner found that Feles and Frien describe the claimed invention "substantially as claimed."

32. However, the examiner found that Feles and Frien do not disclose the resilient clip connection.

33. The examiner further found that Mizusawa shows a ventilator device for a vehicle.

34. With reference to col. 3, lines 39-48, of Mizusawa, the examiner noted:

When the side wall **17** is inserted through the mounting hole **27**, the elastic pawl **23** and lock projection **24** of the side wall **17** engage with the edges of the hole, and the elastic pawl **23** is inwardly flexed as the side wall proceeds through the hole. Eventually, the bent rear end **27a** of the door pillar defining the mounting hole engages with the elastic pawl **23** and lock projection **24**, thus securing the ventilator device **15** in the mounting hole **27** of the door pillar **P** in co-operation with the rear end of the grille **18**.

35. The examiner held that it would have been obvious to provide the flange of Feles or the front part of Frien with the elastic pawl **23** in Mizusawa in order to provide ease of mounting.

36. The examiner advised applicant that claims 2 and 12-14 would be allowable if written in independent form to include all the limitations of the claims from which they depend.

37. In due course, applicant filed an amendment responding to the examiner's first Office action.

38. The amendment:

- (1) canceled claims 2 and 12;
- (2) added new claims 15-16 and
- (3) amended claims 3-11, 13 and 14,

all as shown in Appendix 3 of this opinion.

39. Following entry of the amendment, the application claims were 1, 3-11 and 13-16.

40. In the amendment, applicant stated as follows (emphasis added):

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The Office Action of May 17, 1991 has been given careful consideration. In view thereof, applicant has canceled claims 2 and 12 from further consideration and rewritten them in independent form as new claims 15 and 16. The remaining claims have been made dependent on claims 15 or 16 and various minor corrections made thereto.

The subject amendment was discussed in its current form with . . . Examiner Joyce on September 10, 1991. At that time, it was felt that all formal matters with respect to the above claims had been corrected and that the claims as now presented were patentable over all of the prior art of record.

It is believed that this amendment places the application in condition for allowance and early notice to that effect is respectfully requested.

41. A telephonic interview took place on November 8, 1991.

42. During the interview, applicant agreed to cancel claim 1 and amendments to claims 4 and 15 were agreed to, all as shown in Appendix 4 of this opinion.

43. In dependent claim 4, "(13) of" was deleted.

44. In independent claim 15, "element" was inserted after "valve".

45. The original application was then allowed.

46. Consistent with Office practice, the claims were re-numbered in the course of preparing the original application for issue, all as follows:

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Chronological by original claim

| <u>Original claim number</u> | <u>Claim as re-numbered</u> |
|------------------------------|-----------------------------|
| 1                            | Canceled                    |
| 2                            | Canceled                    |
| 3                            | 2                           |
| 4                            | 3                           |
| 5                            | 4                           |
| 6                            | 5                           |
| 7                            | 6                           |
| 8                            | 7                           |
| 9                            | 8                           |
| 10                           | 9                           |
| 11                           | 10                          |
| 12                           | Canceled                    |
| 13                           | 12                          |
| 14                           | 13                          |
| 15                           | 1                           |
| 16                           | 11                          |

Chronological by patent claim

| <u>Original claim number</u> | <u>Claim as re-numbered</u> |
|------------------------------|-----------------------------|
| 15                           | 1                           |
| 3                            | 2                           |
| 4                            | 3                           |
| 5                            | 4                           |
| 6                            | 5                           |
| 7                            | 6                           |
| 8                            | 7                           |
| 9                            | 8                           |
| 10                           | 9                           |
| 11                           | 10                          |
| 16                           | 11                          |
| 13                           | 12                          |
| 14                           | 13                          |
| 1                            | Canceled                    |
| 2                            | Canceled                    |
| 12                           | Canceled                    |

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47. U.S. Patent 5,105,731 issued April 21, 1992, based on the original application and contained claims 1-13, all as shown in Appendix 5 of this opinion.

Prosecution of reissue application

48. Applicant filed reissue application 08/230,083 on April 20, 1994 seeking to reissue U.S. Patent 5,105,731.

49. Applicant presented original patent claims 1-13 along with new reissue application claims 14-16 for consideration.

50. Reissue application claim 15 has been canceled and is not involved in the appeal.

51. Reissue application claims 14 and 16 are before the Board in the appeal.

52. A copy of reissue application claims 14 and 16 appears in Appendix 6 of this opinion.

53. The examiner has rejected reissue application claims 14 and 16 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.

54. The Examiner based the rejection of claims 14 and 16 on the grounds that when faced in the original application

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with a rejection under 35 U.S.C. § 103 over the Feles, Frien and Mizusawa prior art patents, applicant made two significant amendments:

(1) First, applicant presented new independent application claim 15 which combined the limitations of application dependent claim 2 with application independent claim 1; new independent application claim 15 ultimately became patent claim 1.

(2) Second, applicant presented new independent application claim 16 which combined the limitations of application dependent claims 10, 11 and 12 with application independent claim 1; new original application claim 16 ultimately became patent claim 11.

Examiner's rejection

55. The examiner rejected reissue application claims 14 and 16 as being unpatentable under 35 U.S.C. § 251 for recapturing subject matter surrendered in obtaining allowance of claims during prosecution of the application which matured into the patent sought to be reissued.

56. The examiner reasoned as follows (see Supplemental Examiner's Answer entered July 23, 2004, pages 2-3):

In the application for the patent now sought to be reissued, originally filed dependent claims 2 (dependent on claim 1) and 12 (dependent on claims 1, 10 and 11) were objected to,

and it was indicated in the first Office action that the claims would be allowable if placed in an independent format. The remainder of the claims were rejected over prior art.

\* \* \*

[T]he original independent claims, which were rejected by the examiner based on prior art, did not contain:

Element **E**: a surrounding rim on the inner frame carrying rib members spaced transversely with stays extending therefrom and a surrounding frame joining the stays [From original claim 2 of the original application; claim 2 was objected to and found patentable in the original application]

Element **Z**: wherein the locking element is guided over a **dovetail guide** on the outer surface of the outer housing [From original claim 12 of the original application; claim 12 was objected to and found patentable in the original application]

To overcome the prior art rejection against the claims not having either [Element] E or [Element] Z, the applicants [sic, applicant] rewrote those [rejected] claims to add either [a] limitation [containing Element] E or limitation [containing Element] Z, from the relevant dependent claims.

. . .

. . . [B]ecause the limitations . . . represented as element **E** or **Z** . . . are absent from the reissue claims being rejected . . . the claims impermissibly recapture what was previously surrendered.

57. With respect to reissue application claim 14, the examiner goes on to state (page 4):

Reissue claim 14 completely omits the . . . limitation of originally filed claim 2 (element **E**), and therefore, impermissibly recaptures what was previously surrendered. . . . [E]lement **Z** . . . is also not made a part of reissue claim 14. Thus, claim 14 contains neither element **E** nor element **Z**.

58. With respect to reissue application claim 16, the examiner states (page 4):

Reissue claim 16 omits the ... limitation of originally filed claim 2 (element **E**), and therefore, impermissibly recaptures what was previously surrendered.

\* \* \*

Reissue claim 16 omits the ... limitation of originally filed claim 12 (element **Z**), and therefore, impermissibly recaptures what was previously surrendered.

59. The record supports the examiner's findings with respect to what limitations do not appear in reissue application claims 14 and 16 which were present in claims 2 and 12 of the original application, as filed.

### **C. Discussion**

#### 1. Recapture principles

(1)

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

What has become known as the "recapture rule," prevents a patentee from regaining through a reissue patent subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. In re Clement, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

If a patentee attempts to "recapture" what the patentee previously surrendered in order to obtain allowance of original

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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).<sup>4</sup> See also Hester Industries Inc. v. Stein, Inc., 142 F.3d 1472, 1480, 46 USPQ2d 1641, 1647 (Fed. Cir.), cert. denied, 525 U.S. 947 (1998).

(2)  
In re Clement

The Federal Circuit's opinion in Clement discusses a three-step test for analyzing recapture.

Step 1 involves a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims. The Federal Circuit reasoned that a reissue application claim deleting a limitation or element from a patent claim is broader as to that limitation's or element's aspect. 131 F.3d at 1468, 45 USPQ2d at 1164.

Step 2 involves a determination of whether the broader aspects of the reissue application claims relate to surrendered

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<sup>4</sup> 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).

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 by the Federal Circuit, 131 F.3d at 1470, 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 rules does not apply, but other rejections are possible;

Substep (3): if the reissue claim is broader in some aspects, but narrower in others, then:

(a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;

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(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.

(3)

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

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at 1340, 75 USPQ2d at 1549. After a patent issued containing the amended claims, North American Container filed a reissue application seeking reissue claims in which (1) the language "inner wall portions are generally convex" was eliminated, but (2) the language "wherein the diameter of said re-entrant portion is in the range of 5% to 30% of the overall diameter of said side wall" was added. Thus, the claim sought be reissued was broader in some aspects and narrower in other aspects.

The Federal Circuit, applying the Clement three-step test, held that the reissue claims were broader in scope than the originally-issued claims in that they no longer require the "inner walls" to be "generally convex." The Federal Circuit further found that the broadened aspect (i.e., the broadened limitation) "relate[d] to subject matter that was surrendered during prosecution of the original-filed claims." 415 F.3d at 1350, 75 USPQ2d at 1557. The Federal Circuit observed that "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 developed the principles of 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.

(4)  
Ex parte Eggert

Our 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, the 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 appellants 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

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the patent claim was ABCDEF, there would be recapture for ABC or anything broader than ABC, but not for claims directed to ABCX, ABCD<sub>Br</sub>, ABCEF, or A<sub>Br</sub>BCDEF, because those claims would be narrower than the finally rejected claim ABC. 67 USPQ2d at 1717. In its opinion, the majority recognized that the Federal Circuit had held that "the mere presence of narrowing limitations in the reissue claim is not necessarily sufficient to save the reissue claim from the recapture rule." 67 USPQ at 1729.

Board of Patent Appeals and Interferences Standard Operating Procedure 2 (Revision 6) (August 10, 2005) mandates that a published precedential opinion of the Board is binding on all judges of the Board unless the views expressed in an opinion in support of the decision, among a number of things, are inconsistent with a decision of the Federal Circuit. In our view, the majority view in Eggert is believed to be inconsistent with the subsequent Federal Circuit decision in North American Container with respect to the principles governing application of Substep (3)(a) of Clement.

The Eggert majority's analysis is believed to be consistent with North American Container in that the majority applied the three-step framework analysis set forth in applicable Federal Circuit opinions, e.g., (1) Pannu v. Storz Instruments Inc., 258 F.3d 1366, 1370-71, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001);

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(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.

(5)  
What subject matter is surrendered?

In a case involving Substep (3)(a) 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).

(6)

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 applicant's amendment was "an admission that the scope of that claim was not in fact patentable," Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984), "the court may draw inferences from changes in claim scope when other reliable evidence of the patentee's intent is not available," Ball [Corp. v. United States], 729 F.2d at 1436, 221 USPQ at 294. Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary. 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 applicant'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 applicant 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 applicant 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.]

(7)

Allocation of burden of proof

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

For reasons which 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 Clement.

For reasons which follow, we also hold that once a prima facie case of recapture is established, the burden of persuasion

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then shifts to the applicant 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.

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

(8)  
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 equity<sup>5</sup> and therefore embodies the notion of estoppel. 729 F.2d at 1439, 221 USPQ at 296.

Indeed, the recapture rule is quite similar to prosecution history estoppel, which prevents the application of the doctrine of equivalents in a manner contrary to the patent's prosecution history. See Warner-Jenkinson Co. v. Hilton Davis Chem. Co., [520 U.S. 17, 33] 117 S. Ct. 1040, 1051[41 USPQ2d 1865, 1873] (1997). Like the recapture rule, prosecution history estoppel prevents a patentee from regaining subject matter surrendered during prosecution in support of patentability. See id.

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<sup>5</sup> The reissue statute has been characterized as being remedial in nature, based on fundamental principles of equity and fairness and should be construed liberally. In re Bennett, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985) (in banc); In re Willingham, 282 F.2d 353, 354-55, 127 USPQ 211, 214 (CCPA 1960). Nevertheless, fairness to the public must also be considered. As stated in Mentor, "the reissue statement cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so." 998 F.2d at 996, 27 USPQ2d at 1525.

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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, 998 F.2d 1165, 1174, 26 USPQ2d 1018, 1025 (Fed. Cir. 1993).

See also Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 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)<sup>6</sup> (Michel, J., concurring-in-part and dissenting-in-part):

[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.

(9)

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<sup>6</sup> 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.

Relevance of prosecution history

"Surrendered subject matter" is defined in connection with prosecution history estoppel in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 733-34, 122 S. Ct. 1831, 1838, 62 USPQ2d 1705, 1710-11 (2002) (Festo II):

The doctrine of equivalents allows the patentee to claim those insubstantial alterations that were not captured in drafting the original patent claim but which could be created through trivial changes. When, however, the patentee originally claimed the subject matter alleged to infringe but then narrowed the claim in response to a rejection, he may not argue that the surrendered territory comprised unforeseen subject matter that should be deemed equivalent to the literal claims of the issued patent. On the contrary, "[b]y the amendment [the patentee] recognized and emphasized the difference between the two phrases[,] ... and [t]he difference which [the patentee] thus disclaimed must be regarded as material." Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126, 136-37, 62 S. Ct. 513, 518-19 [52 USPQ 275, 279-80] (1942).

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

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

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A patentee's decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim. Exhibit Supply, 315 U.S., at 136-137,

62 S. Ct. 513 ("By the amendment [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference"). There are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. In those cases the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence (emphasis added).

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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

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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 applicants.

(10)  
Admissible evidence in rebuttal showing

As in the case of surrender when applying the doctrine of equivalents, a reissue applicant should have an opportunity to rebut any prima facie case made by an examiner.

What evidence may an applicant 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 cannot attempt to divine, at this time, all evidence which might be relevant. As with other issues which come before the USPTO, such as obviousness and enablement, the

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evidence to be presented will vary on a case-by-case basis, as will the analysis of that evidence.

An applicant must show that at the time the amendment was made, one skilled in the art could not reasonably have viewed the subject matter broader than any narrowing amendment as having been surrendered. The showing required to be made by applicant is consistent with the public notice function of claims. Nevertheless, some limited extrinsic evidence may be relevant. However, extrinsic evidence unavailable to one of ordinary skill in the art at the time of the amendment is not relevant to showing that one skilled in the art 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.*, 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.

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. . . By its very nature, objective unforeseeability depends on underlying factual issues relating to, for example, the state of the art and the understanding of a hypothetical person of ordinary skill in the art at the time of the amendment. Therefore, in determining whether an alleged equivalent would have been unforeseeable, a district court may hear expert testimony and consider other extrinsic evidence relating to the relevant factual inquiries.

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

necessary, testimony from those skilled in the art as to the interpretation of that record.

. . . When at all possible, determination of the third rebuttal criterion should also be limited to the prosecution history record. . . . We need not decide now what evidence outside the prosecution history record, if any, should be considered in determining if a patentee has met its burden under this third rebuttal criterion.

We interpret Festo III to generally, perhaps effectively, limit the admissible rebuttal evidence to the prosecution history record and extrinsic evidence related to the knowledge of the hypothetical person of ordinary skill in the art at the time of the amendment. Admitting evidence not available to the public, such as an affidavit of an attorney giving mental impressions from the attorney who made the amendment, would undermine the public notice function of the patent and its prosecution history.

(11)

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.

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Moreover, mixing "intervening rights" with "surrender" is like mixing apples with oranges or putting the cart before the horse. A patentee seeking a reissue claim which is barred by recapture is not entitled to a reissue patent under 35 U.S.C. § 251. If there is no reissue patent, there can be no intervening rights.

(12)

The dissent

Our dissenting colleagues seem to be saying that the only subject matter surrendered is that of a canceled claim. The dissent's analysis looks a lot like an attempt to create a per se rule.

With all due respect, 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, an applicant (not the public) controls what amendments are presented during prosecution. When an amendment is presented, it is the applicant 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.

2. The examiner's prima facie case

Our findings of fact 55-58 set out the basis upon which the examiner made a recapture rejection. As noted in Finding 58, the examiner's findings are supported by the record.

Basically, in the application which matured into the patent now sought to be reissued, the examiner "objected to" originally filed dependent claims 2 (dependent on claim 1) and 12 (dependent on claim 1 through dependent claims 10 and 11). Why? Because, they depended from claims which were rejected over the prior art. The examiner indicated in the first Office action, however, that application claims 2 and 12 would be allowable if re-written in independent form.

Applicant proceeded to re-write application claim 2 in independent form by (1) canceling claim 2 and (2) adding application claim 15 which contained all the limitations of original application claims 1 and 2. Claim 15 issued as patent claim 1.

Applicant also proceeded to re-write application claim 12 in independent form by presenting application claim 16 which combined the limitations of original application claims 1, 10, 11 and 12. Claim 16 issued as patent claim 11.

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The apparatus of the original claims rejected by the examiner based on prior art did not contain certain "elements" which the examiner refers to as "Element E" and "Element Z":

Element **E**: a surrounding rim on the inner frame carrying rib members spaced transversely with stays extending therefrom and a surrounding frame joining the stays--found in original application claim 2, but not original application claim 1.

Element **Z**: wherein the locking element is guided over a **dovetail guide** on the outer surface of the outer housing--found in original application claim 12, but not original application claims 1, 10 or 11.

Because the Element **E** or **Z** limitations are absent from the reissue claims being rejected and since those limitations are germane as to why the prior art did not reach claims containing Elements **E** or **Z**, the examiner has correctly placed the claims sought to be reissued within Substep (3)(a) of Step (3) of Clement.

As the examiner accurately notes, with respect to reissue application claim 14:

Reissue claim 14 completely omits the ... limitation of originally filed claim 2 (element **E**), and therefore, impermissibly recaptures what was previously surrendered . . . . [E]lement **Z** ... is also not made a part of reissue claim 14. Thus, claim 14 contains neither element **E** nor element **Z**. [Supplemental Examiner's Answer, page 4]

With respect to reissue application claim 16, the examiner further accurately notes:

Reissue claim 16 omits the ... limitation of originally filed claim 2 (element **E**), and

therefore, impermissibly recaptures what was previously surrendered.

\* \* \*

Reissue claim 16 omits the ... limitation of originally filed claim 12 (element **Z**), and therefore, impermissibly recaptures what was previously surrendered. [Supplemental Examiner's Answer, page 4]

The examiner's accurate factual analysis demonstrates that the examiner has made out a prima facie case of recapture.<sup>7</sup>

3. Applicant's response to the examiner's case

(1) First argument

Applicant argues at pages 7-13 of the Appeal Brief filed October 4, 2000 that (matter in brackets added):

Applicant is not removing limitations that caused claim 1 in the original application to be patented. Rather, as noted above, independent claim 1 of the original

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<sup>7</sup> There is some possibility on this record that applicant might have presented an argument that the examiner's reasoning at pages 2-4 of the first Supplemental Examiner's Answer, mailed July 23, 2004, is in effect a "new ground of rejection." It also might have been argued that such a new ground of rejection was not in compliance with the rules in effect at the time the first Supplemental Examiner's Answer was mailed in July of 2004. Additionally, there is some possibility on this record that applicant might have argued that the second Supplemental Examiner's Answer, mailed November 8, 2004, which incorporated earlier answers (and the statement of the rejection made in those earlier answers) was not in compliance with the rules in effect at the time it was mailed in November of 2004. See 37 CFR § 41.43(a)(2) (2005), which became effective on September 13, 2004. Notice of Final Rule, Practice Before the Board of Patent Appeals and Interferences, 69 Fed. Reg. 49660 (Aug. 12, 2004), reprinted in 1286 Off. Gaz. Pat. & Tm. Office 21 (Sep. 7, 2004). In the Reply Briefs, filed September 28, 2004 and January 10, 2005, applicant did not make any of these arguments or note any procedural objection to the manner in which the examiner procedurally presented the examiner's position on appeal. Accordingly, applicant has waived any procedural error which might have occurred in the manner in which the examiner handled the appeal.

application was never itself patented or amended in any way to become patented. Instead, original claims 2 and 12-14 contain allowable subject matter as filed. The Examiner therefore merely objected to those claims in the Office Action mailed May 17, 1991, and indicated those claims as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. In response to the initial Office Action of May 17, 1991, applicant canceled original allowable claims 2 and 12 and rewrote them into independent form as new claims 15 and 16, respectively.

Essentially, applicant never amended independent claim 1 in the original application in order to secure allowance thereof. Rather, applicant merely canceled the rejected claims [, including rejected claim 1,] and rewrote the allowable claims into independent form to include all of the limitations of the base claim and any intervening claims.

. . . .

[Thus,] applicant respectfully submits that the broader aspects of reissue claim 14, namely the absence of the limitation of "wherein the inner frame 4 has a surrounding rim 7 carrying rib members 8 spaced transversely with stays 9 extending therefrom and a surrounding frame 10 joining the stays 9" does not relate in any way to any subject matter that could fairly be considered to be "surrendered" during prosecution.

. . . .

Further, applicant respectfully submits that reissue claim 14 is broader than the canceled or amended claim only in an aspect unrelated and not germane to the rejection in that the reissue claim 14 does not include the limitation of "the inner frame 4 has a surrounding rim 7 carrying rib members 8 spaced transversely with stays 9 extending

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therefrom and a surrounding frame 10 joining the stays 9." The inner frame, rim and rib member limitations were not germane to the prior art rejection. . . .

Applicant repeats the gist of the argument in subsequent briefs.

The ultimate point which we understand applicant to be trying to make is that at the time of the amendment one skilled in the art could not reasonably have viewed any subject matter as having been surrendered because application claim 1 was never amended. We disagree.

The "amendment" filed September 12, 1991, requesting cancellation of claim 2 and the addition of claim 15 (and the later cancellation of claim 1) is an amendment within the meaning of the application rules. See 37 CFR § 1.119 (1991), which provides that "claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in §1.121." The addition of claim 15 was "presenting new claims." The amendment is an amendment which can result in subsequent application of the recapture rule.

Applicant's argument asks us to distinguish between

- (1) an action incorporating the limitations of a second claim (claim 2 in this case) into a first claim (claim 1 in this case) and

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- (2) canceling first and second claims (claims 1 and 2 in this case) and replacing both with a third claim (claim 15 in this case) combining all limitations of the first and second claims.

Apart from the rules which govern practice in patent cases before the USPTO, applicant's argument would appear to be foreclosed by In re Byers, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956) ("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."). Byers is entirely consistent with the Federal Circuit's in 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 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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With respect to reissue claim 16, applicant presents an analogous argument, at pages 15-20 of the Appeal Brief filed October 4, 2000. The argument related to reissue claim 16, the gist of which is restated in subsequent briefs, is not persuasive for the reasons assigned to reissue claim 14.

There is an additional reason why applicant's argument is not persuasive with respect to reissue claim 14. Applicant's argument addresses only how the amendment added the subject matter of original patent application claim 2 to rejected claim 1 to create new claim 15 (claim 1 of the patent). No argument has been made for patent claims 2-4 and 6-10, all of which were narrowed by the same amendment in response to the examiner's rejection. Patent claims 2-4 and 6-10 correspond to original patent application claims 3-5 and 7-11, none of which included the subject matter of original patent application claim 2. Applicant's amendment filed September 12, 1991, amended each of original patent application claims 3-5 and 7-11 (by their dependency from amended application claim 15) to add the subject matter of original patent application claim 2. Applicant has not satisfactorily explained why at the time of the amendment one skilled in the art would not reasonably have viewed the subject matter broader than the narrowing amendment to original application claims 3-5 and 7-11 as having been surrendered.

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Applicant's first argument has not rebutted the presumption, upon which the examiner's rejection is based, that at the time of the amendment one skilled in the art would reasonably have viewed the subject matter of the narrowing amendment as having been surrendered.

(2) Second argument

Applicant, at pages 7-15 of the Reply Brief filed September 28, 2004, argues:

The analysis in Eggert is consistent with ... [applicant's] set out on page 6 of the Appeal Brief of July 10, 2000 that "the only subject matter that could be considered to have been 'surrendered' by applicant in the original prosecution could only have been the scope of independent claim 1 as originally filed."

In applicant's view, Eggert holds that only the rejected claim (in this case, only a canceled originally filed claim) can be viewed as having been surrendered. Effectively, applicant invites us to establish and apply a per se rule said to be based on Eggert. We decline the invitation. Insofar as Eggert might be read as establishing a per se rule, North American Container has now undermined the three-step framework analysis used in Eggert. Furthermore, we noted, "the USPTO has been admonished for trying to extract per se rules from generalized commentary found in cases. See, e.g., In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995)." 67 USPQ2d at 1727.

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An argument that only the subject matter of a rejected claim can be viewed as surrendered territory appears to be inconsistent with sound public policy made apparent by binding Supreme Court and Federal Circuit precedent. Rather than applying a per se rule, we believe that the proper inquiry requires a factual analysis on a case-by-case basis to determine whether the patentee is attempting to recapture by reissue subject matter surrendered during the prosecution of the patent application. The only fact-specific analysis we find in the briefs before us appears in applicant's first argument--which, as noted above, did not convince us that the examiner had erred.

Based on the premise that the surrendered subject matter can only be the subject matter of a rejected claim, applicant proceeds to apply an erroneous test under Clement to reach an incorrect conclusion that reissue claim 14 does not violate the recapture rule. Applicant's analysis, based on a flawed premise, has not convinced us that at the time of the amendment one skilled in the art would reasonably have viewed the subject matter broader than the narrowing amendment as not having been surrendered.

With respect to reissue claim 16, applicant presents an analogous argument. See pages 15-19 of the Reply Brief filed

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September 28, 2004. The argument directed to reissue claim 16 is no more persuasive than the unpersuasive argument directed to reissue claim 14.

(3) Other arguments

We have considered all other arguments made by applicant in the Appeal Brief and subsequent Briefs. None has convinced us that the examiner erred in rejecting reissue claims 14 and 16 based on recapture.

**D. Decision**

Upon consideration of the record, and for the reasons given, the decision of the examiner rejecting reissue claims 14 and 16 based on recapture is affirmed.

**E. Options for further proceedings**

1. We recognize that our opinion (1) might be viewed as discussing points not previously brought out in the record and (2) citing Federal Circuit opinions based on Federal Circuit decisions entered after applicant filed the appeal.

2. We also recognize that the appeal involves a reissue application which has been pending for some time. Cf. Pritchard v. Loughlin, 361 F.2d 483, 487, 149 USPQ 841, 844 (CCPA

1966) (proceedings involving reissue should be handled expeditiously inasmuch as term of reissue patent is running).

3. Accordingly, in an attempt to minimize any prejudice to applicant, we exercise our discretion by authorizing applicant to proceed under any one of the following options, the choice of the option being up to applicant.

(1) Option 1: Applicant can accept our decision as final, in which case the appeal would be concluded.

(2) Option 2: Within **two (2) months** of the date of this decision, applicant may file a request for rehearing. 37 CFR § 41.52(a)(1) (2005).

(3) Option 3: Applicant may treat this decision as a non-final decision (i.e., an interlocutory order), in which case within **two (2) months** of the date of this decision applicant is invited to file a brief responding to any points discussed in our opinion. 37 CFR § 41.50(d) (2005). The brief may rely (1) on the record, as it exists at this time, and (2) any public document not in the record at the present time, provided the document was available to the public at the time an amendment was made in the application which matured into the patent sought to be reissued. Copies of any document relied upon which is not already of record must be supplied with any brief. If applicant be so advised, the brief may also discuss whether, and how, what

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we have referred to as a "first" and "second" embodiment (Findings 18-22) falls within the scope of (1) reissue application claims 14 and 16 versus (2) the patented claims.

(4) Option 4: Applicant may file a single paper which combines Option 2 and Option 3.

(5) Option 5: Applicant may treat our decision as a final decision and seek judicial review within the time set out in 37 CFR § 1.304(a)(1) (2005).

4. No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (2005).

**AFFIRMED**

|                             |   |                 |
|-----------------------------|---|-----------------|
| MICHAEL R. FLEMING, Chief   | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| JERRY SMITH                 | ) |                 |
| Administrative Patent Judge | ) | BOARD OF PATENT |
|                             | ) |                 |
|                             | ) | APPEALS AND     |
| ALLEN R. MacDONALD          | ) |                 |
| Administrative Patent Judge | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
| ROBERT NAPPI                | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |

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Judge Gross, with whom Judge Ruggiero joins, concurring.

We concur in the result reached by the plurality but we disagree with the plurality's analysis. Specifically, we disagree with the plurality's presumption that subject matter broader than the patented claims has been surrendered and that appellant holds the burden to rebut that presumption.

The plurality states (Opinion, page 27) that "[t]he 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." However, in proceedings in which the doctrine of equivalents is at issue (such as infringement), the public has only the prosecution history upon which to rely and has no reason to believe that such reliance is misplaced. On the other hand, the mere filing of a reissue application puts the public on notice not to rely upon the prosecution history, as the overall prosecution history may change. Further, the purpose of reissue is to allow an applicant to correct errors, which have been defined as including claiming less than they had a right to claim (i.e., allowing applicant to broaden claims). Although

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there are limits on such broadening, such as a two year time period in which to file a broadening reissue and the recapture principle, a presumption of surrender and especially a burden on the applicant to rebut that presumption appears to us to be in conflict with the purpose of reissue. Accordingly, we would affirm the examiner's rejection but for the reasons given infra.

#### **PERTINENT CASE LAW**

In Ball Corp. v. United States, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984), the Federal Circuit stated that "[t]he recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were canceled from the original application." Id. at 1436, 221 USPQ at 295. We note that the language used by the Federal Circuit did not limit the bar to "only" those claims that were canceled from the original application. The Federal Circuit continued that "the patentee is free to acquire, through reissue, claims that are narrower in scope than the canceled claims," but recognized that "[t]he subject matter of the claims is not alone controlling." Id. In other words, merely being narrower in scope than the canceled claims may not be sufficient to overcome the recapture bar. In fact, in analyzing the facts in Ball, the

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Federal Circuit held that the reissue claims were narrower in scope than the canceled claims with respect to the same limitation relied upon to overcome a prior art rejection made in the prosecution of the original application. Thus, although not explicitly stated in Ball, there is a suggestion from the analysis therein that the narrowing to overcome the recapture bar should relate to the same limitation relied upon to overcome the prior art rejection.

Mentor Corp. v. Coloplast Inc., 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993), affirmed the suggestion that surrendered subject matter equates to that which does not include the limitation added to overcome a prior art rejection. Specifically, the Federal Circuit stated, "Coloplast correctly argues that reissue claim 6, which does not include the adhesive transfer limitation [which was added and argued to overcome the prior art rejection], impermissibly recaptures what Mentor deliberately surrendered in the original prosecution." Id. at 996, 27 USPQ2d at 1525. The Federal Circuit then determined whether a narrowing of the claims had occurred that was "material in relation to the impermissible broadening," Id. at 996, 27 USPQ2d at 1526, or, rather, in relation to the omission of the limitation added for patentability.

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In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), relying heavily on the analysis in Ball and Mentor, developed a three step test for determining whether the claims of a reissue application recapture surrendered subject matter. The first step is "to determine whether and in what 'aspect' the reissue claims are broader than the patent claims." Clement at 1468, 45 USPQ2d at 1164. The Federal Circuit looked at the individual limitations that have been broadened, stating that "a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect." Id.

The second step of the test is "to determine whether the broader aspects of the reissue claims relate to surrendered subject matter." Id. at 1468-69, 45 USPQ2d at 1164. The Federal Circuit looked to the prosecution history, focusing on arguments and amendments made to overcome prior art rejections, stating that "[d]eliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before cancellation or amendment is unpatentable." Id. at 1469, 45 USPQ2d at 1164. Thus, the scope of the claim prior to cancellation or amendment is generally considered to be surrendered subject matter. In fact, in setting up the third step, the Federal Circuit refers to the applicant as having "surrendered the subject matter of the

canceled or amended claim,<sup>8</sup> . . . ." Id. However, later in the decision, in analyzing the facts of the case, the Federal Circuit determined that eliminating limitations that had been added to overcome prior art rejections rendered the reissue claims broader "in a manner directly pertinent to the subject matter that Clement surrendered throughout the prosecution." Id. at 1471, 45 USPQ2d at 1166. In other words, the Federal Circuit appears to include as "surrendered subject matter" more than merely the canceled claims; the phrase also encompasses something pertaining to the limitation added in the original prosecution to overcome a prior art rejection.

If the broadening is found to relate to surrendered subject matter, the third and final step of the test is to "determine whether the surrendered subject matter has crept into the reissue claim." Id. at 1469, 45 USPQ2d at 1164. In other words, viewing surrendered subject matter as including more than merely the finally rejected claim, the third step is to determine whether the claims have been narrowed in the same aspects, or with

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<sup>8</sup> We note that the term "amended" generally refers to a claim after an amendment has been entered. Thus, "canceled or amended" could refer to the claim prior to or subsequent to amendment. As the amended claim would equate to the patented claim, thereby rendering the patented claim surrendered, the normal reading of the term "amended" would seem to be inappropriate. Thus, we will focus on the "canceled claim," recognizing that the phrase "canceled or amended" includes something more.

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respect to the same limitations, that prompted a finding of surrendered subject matter.

By analyzing the reasoning in Mentor and Ball, the Federal Circuit arrived at the following principles as an approach to the third step:

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

Clement at 1470, 45 USPQ2d at 1165. The third step of the test in Clement compares the reissue claims to the canceled claims, i.e., the claims of the patented application (upon which the reissue is based) prior to the amendment that resulted in the patent. We note that the test uses the phrase "canceled or amended," which as indicated supra, we assume includes something more than the canceled claim. Again we will focus on the "canceled" claim only, as the alternative language appears to be cumulative in our interpretation of the test.

According to the principles set forth by the Federal Circuit, if the reissue claims are as broad in all aspects as the claims prior to the amendment, then the recapture rule bars the claims. As stated supra, the addition of a limitation to overcome a prior art rejection suggests an admission that the scope of the claim prior to the amendment is unpatentable. Therefore, if all limitations of the reissue claim are at least as broad as the claim prior to the amendment, then the recapture rule bars the claim. Additionally, if the reissue claim is at least as broad in an aspect related to a prior art rejection (i.e., the limitation added to overcome the reference), even if narrower in an aspect unrelated to the prior art rejection, then the recapture rule bars the claims. In other words, completely eliminating a limitation added to overcome a prior art rejection, even if accompanied by a narrowing in another area, is barred by the recapture rule.

However, if the reissue claims are narrower in all aspects (including the limitation added to overcome the reference) or in an aspect related to a prior art rejection (i.e., with regard to the limitation added to overcome the reference), even if broader in other areas, then the recapture rule does not apply. Thus, a narrowing of the claim in the area of the limitation that

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overcame the prior art rejection, regardless of the scope of the remaining limitations, avoids a bar by the recapture rule. To summarize, a limitation added to overcome a prior art rejection cannot be eliminated completely in a reissue claim unless it is offset by a corresponding narrowing in the same area.

In Hester Industries Inc. v. Stein Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir.), cert. denied, 525 U.S. 947 (1998), the patentee eliminated completely, in a reissue application, two limitations of the original claims that were argued as distinguishing the claims over the prior art. The Federal Circuit analyzed the prosecution history of the original patent and determined that Williams, the inventor of Hester's patent, had argued that "each of these limitations was 'critical' with regard to patentability," that those arguments "constitute[d] an admission by Williams that these limitations were necessary to overcome the prior art," and that "Williams, through his admission . . . surrendered claim scope that does not include these limitations." Id. at 1482, 46 USPQ2d at 1649. The Federal Circuit stated, "We share the district court's discomfort with Williams' attempt to remove, through reissue, the 'solely with steam' and 'two sources of steam' limitations after having relied so heavily on those limitations to obtain allowance of the original patent claims over the prior art," referencing the

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recapture rule discussed in Clement at 1468, 45 USPQ2d at 1164.  
Hester at 1480, 46 USPQ2d at 1647.

After determining that the reissue claims in Hester did include surrendered subject matter, the Federal Circuit recognized that "the recapture rule may be avoided in some circumstances." Id. at 1482, 46 USPQ2d at 1649. Therefore, the Federal Circuit continued its analysis by determining "whether the reissue claims were materially narrowed in other respects. See, e.g., Mentor, 998 F.2d at 996, 27 USPQ2d at 1525 ('Reissue claims that are broader in certain respects and narrower in others<sup>9</sup> may avoid the effect of the recapture rule.');

Clement, 131 F.3d at 1470, 45 USPQ2d at 1165." Hester at 1482, 46 USPQ2d at 1649. The Federal Circuit found that the alleged narrowing aspects were not overlooked during the prosecution of the original patent and, therefore, that the case was not one "which involve[d] the addition of material limitations that overcome the recapture rule." Id. at 1483, 46 USPQ2d at 1650.

Pannu v. Storz Instruments Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001) revisited reissue recapture. In an

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<sup>9</sup> Although the Federal Circuit referred to other respects in this quote from Mentor, later in its opinion the Federal Circuit indicated that the other respects must relate to the limitation that was broadened. Mentor at 996, 27 USPQ2d at 1525. Further, the Federal Circuit in Clement indicated in step three of the test that they too interpreted other respects as relating to the limitation that was broadened. See step 3(a) of the Clement test. Clement at 1470, 45 USPQ2d at 1166.

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application for patent, Pannu argued a distinction of "a continuous substantially circular arc having a diameter greater than the diameter of the lens body . . . which significantly enhance the easy insertibility of applicant's lens and significantly reduce any possibility of snagging delicate eye tissue" over the prior art. In the ensuing reissue application, Pannu eliminated that limitation from the claims, but further limited the size and position of the snag resistant means. The Federal Circuit stated:

The addition of the 'continuous, substantially circular arc' limitation . . . and the statements made by Pannu to the examiner during prosecution of the '855 patent limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc. See Southwall Techs., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676 (1995). The shape of the haptics was broadened during reissue and was the same subject matter that was surrendered during prosecution.

Pannu at 1371, 59 USPQ2d at 1600.

As to the narrowing aspects of the reissue claims, the Federal Circuit held that since the narrowing was related to the positioning and dimensions of the snag resistant means rather than to the shape of the haptics, "the reissued claims were not narrowed in any material respect compared with their broadening." Id. at 1372, 59 USPQ2d at 1601. The Federal Circuit concluded that "[i]n prosecuting the '855 patent, Pannu specifically

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limited the shape of the haptics to a 'continuous, substantially circular arc.' On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections." Id.

In Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003), a precedential Board decision entered May 29, 2003, the majority opinion stated, "In 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 appellants conceded was unpatentable." Id. at 1717. The majority further stated 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. However, it acknowledged that the Federal Circuit has 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." Id. at 1729.

In analyzing the facts of the case, the majority in Eggert found that the reissue claims were broader than the patent claims in several respects including that they omitted the limitation "said retaining member being generally bowl-shaped and convex toward said magnet," which defined the shape of the retaining member and which had been added to overcome a prior art

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rejection. Id. at 1731. Accordingly, it further determined that the omission of that limitation in the reissue claims was a broadening in an aspect germane to the prior art rejection. It also found that the finally rejected claim prior to the amendment that resulted in the issuance of the patent was surrendered subject matter. Id.

In applying the third step of the Clement test, determining whether the surrendered subject matter had crept back into the reissue claim, the majority opinion looked at the new limitation of reissue claim 15 that limited the shape of the retaining member to "substantially covering said outer surface of said magnet" and the new limitation of reissue claim 22 that limited the shape of the retaining member to "having a continuous outer periphery such that any two points on the periphery can be joined by a straight line segment which does not extend outside the periphery." The majority ascertained that the reissue claims were "narrower than the surrendered subject matter in an aspect germane to the prior art rejection (i.e., the shape of the retaining member) and broader only in aspects unrelated to the rejection." Eggert at 1731. It held that the facts of the case fell into category 3(b) of the principles set forth in Clement, and, therefore, that the claims were not barred by the recapture

rule. While one can disagree with the Eggert majority as to what is meant by "surrendered subject matter," the result in Eggert is consistent with our reading of the case law prior to Eggert, i.e., Mentor, Clement, Hester, and Pannu, as discussed supra.<sup>10</sup>

The Federal Circuit was faced once again with the issue of reissue recapture in North American Container, Inc. v. Plastipak Packaging, Inc., 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005). During the prosecution of an application for patent, the examiner rejected the claims over a combination of two references, Dechenne and Jakobsen. To overcome the rejection, the applicant limited the claims by specifying that the shape of the inner walls was generally convex. The applicant 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 re-entrant portion is clearly concave in its entirety." Id. at 1340, 75 USPQ2d at 1549. After a patent issued on the amended claims, the applicant filed a reissue application

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<sup>10</sup> We note that although the Eggert majority repeatedly stated that it viewed the finally rejected claim as the surrendered subject matter, the analysis of the facts focused on whether the limitation omitted had been added in the prosecution of the original application to overcome a prior art rejection and whether the narrowing limitations on reissue related to the same subject matter as the limitation omitted. Thus, despite statements in Eggert that could be considered inconsistent with our interpretation of the relevant case law, there is no inconsistency between our interpretation and the holding in Eggert as it applies to the particular facts.

including claims in which the language "inner wall portions are generally convex" was eliminated, but 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 to some of the claims.

The Federal Circuit applied the three step test of Clement. The Federal Circuit found 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.'" Id. at 1350, 75 USPQ2d at 1557. Further, the broadened aspect (i.e., the broadened limitation) "relate[d] to subject matter that was surrendered during prosecution of the original-filed claims." Id. However, the Federal Circuit found that "the reissue claims were not narrowed with respect to the 'inner wall' limitation, thus avoiding the recapture rule." Id. 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 the applicant's deletion of the 'generally convex' limitation clearly broadened the 'inner wall' limitation." Id.

It is important to note that the Federal Circuit determined that the re-entrant portion (the element further narrowed in the

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reissue claims) was part of the inner wall. Thus, the limitation added in the reissue claims (regarding the re-entrant portion) did in fact further limit the inner wall. Accordingly, by "'inner wall' limitation," we believe that the Federal Circuit meant the particular limitation that was broadened (that the inner wall was generally convex) in the reissue claims, not any limitation relating to the inner wall. Thus, the Federal Circuit in North American Container further clarified that "narrower in an aspect germane to a prior art rejection" in the Clement test means narrower with respect to the specific limitation added for patentability in the original prosecution and eliminated in the reissue claims.

In Eggert, the limitation added for patentability was "said retaining member being generally bowl-shaped and convex toward said magnet," whereas the narrowing was "substantially covering said outer surface of said magnet" or "having a continuous outer periphery such that any two points on the periphery can be joined by a straight line segment which does not extend outside the periphery." Id. at 1731. Since North American Container was decided after Eggert, and neither narrowing limitation in Eggert further limited the specific limitation added for patentability, Eggert is no longer consistent with the rationale of the Federal

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Circuit. Thus, we agree with the plurality opinion that Eggert should no longer be followed.

To summarize, to determine if there has been a recapture of surrendered subject matter, we apply the three step analysis set forth in Clement. There is disagreement as to whether or not the phrase "surrendered subject matter" includes more than merely the rejected claim prior to the amendment that overcame the prior art rejection, i.e., something relating to the added limitation. In viewing Clement in a vacuum, even if it could be argued that Clement would support multiple interpretations, as indicated supra, both Mentor and cases decided since Clement suggest that the Federal Circuit did, in fact, mean to include as surrendered subject matter any claim that lacks a limitation directed to the specific subject matter added in the original prosecution to overcome a prior art rejection. Thus, the proper interpretation of the applicable and binding case law is that surrendered subject matter includes any claim that lacks a limitation directed to the specific subject matter that was added to overcome a prior art rejection.

**APPLICATION OF THE RECAPTURE DOCTRINE TO CLAIM 14**

Applying the test set forth in Clement, we first "determine whether and in what 'aspect' the reissue claim[] . . . [is] broader than the patent claims." Id. at 1468, 45 USPQ2d at 1164. We note that independent patent claims 1 and 11 include different limitations that were considered to be allowable over the prior art. Therefore, we must separately compare reissue claim 14 to the closest patent claim that depends from claim 1 and also the closest patent claim that depends from claim 11. Patent claims 9 and 11 have the most limitations in common with reissue claim 14 without including many additional limitations. Claim 14 is broader than patent claim 9 in that the limitation "wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9)," hereafter referred to as the inner frame limitation, has been deleted. Also, the springy tongue is not recited as being "separate from the outer housing (3)." Similarly, claim 14 is broader than patent claim 11 in that the limitation that the springy tongue (22') is "formed separate from the outer housing (3), said springy tongue (22') being arranged on a locking element (30) which can be connected with the outer housing (3), and said locking element

(30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)" has been deleted.<sup>11</sup>

The second step of the Clement test, as discussed supra, is "to determine whether the broader aspects of the reissue claims relate to surrendered subject matter." Id. at 1468-69, 45 USPQ2d at 1164. The prosecution history of Application 07/642,475 set forth above establishes that the examiner indicated that the above-noted inner frame limitation was allowable over the prior art. In response, appellant added the inner frame limitation to rejected claim 1 to overcome the prior art rejection. The examiner also indicated that the limitation "wherein the locking element (30) is guided over a dovetail guide (31) on the outer surface of the outer housing (3)," hereafter referred to as the dovetail guide limitation, was allowable over the prior art. In response, appellant added the dovetail guide limitation to rejected claim 11 to overcome the prior art rejection. Since reissue claim 14 includes neither the inner frame limitation nor the dovetail guide limitation, the limitations that had been added to overcome a prior art rejection, the reissue claim

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<sup>11</sup> Reissue claim 14 also differs from both patent claim 9 and also patent claim 11 in that the limitation "[i]n a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle" has been changed to "[a] check valve assembly adaptable for use with a ventilation system for a passenger space of a motor vehicle," but we consider this alteration neither a broadening nor a material narrowing.

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is broader "in a manner directly pertinent to the subject matter . . . surrendered throughout the prosecution." Id. at 1471, 45 USPQ2d at 1166.

The last step is to determine whether the surrendered subject matter has crept into the rejected reissue claim. In what aspects, if any, is the reissue claim narrower than the canceled, or rejected, claim.

Claim 14 is narrower than original patent application claim 10 (which corresponds to patent claim 9) in that it includes "[a] second clip connection comprising a second springy tongue integral with the surrounding wall" and the first springy tongue is "spaced from the wall." These limitations do not relate to either the inner frame limitation or the dovetail guide limitation. In other words, each narrowing limitation is "an[] aspect completely unrelated to the rejection," Id. at 1470, 45 USPQ2d at 1165, in that it does not narrow the claim regarding the specific subject matter of either the inner frame or the dovetail guide. Thus, since claim 14 is as broad as original patent application claim 10 in an aspect germane to a prior art rejection (i.e., the limitation added to overcome the reference), by including neither the inner frame limitation nor the dovetail guide limitation, and narrower than original patent application

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claim 10 in another aspect, according to principle (3)(a) of Clement, the recapture rule bars the claim.

Comparing claim 14 to original patent application claim 11, we reach the same conclusion. Specifically, claim 14 is broader than original patent application claim 10 at least in an aspect germane to a prior art rejection (i.e., the limitation added to overcome the reference), by failing to include either the inner frame limitation or the dovetail guide limitation, but also narrower than original patent application claim 11 in other aspects, a second springy tongue and the first springy tongue being spaced from the wall. Each narrowing limitation is "an[] aspect completely unrelated to the rejection," Id., in that it does not narrow the claim regarding the specific subject matter of either the inner frame or the dovetail guide. Therefore, comparing reissue claim 14 to original patent application claim 11, according to principle (3)(a) of Clement, the recapture rule bars the claim.

For the reasons set forth above, the decision of the examiner rejecting reissue claim 14 under 35 U.S.C. § 251 should be affirmed.

**APPLICATION OF THE RECAPTURE DOCTRINE TO CLAIM 16**

Applying the test set forth in Clement, we first "determine whether and in what 'aspect' the reissue claim[] . . . [is] broader than the patent claims." Id. at 1468, 45 USPQ2d at 1164. Since claim 16 recites a locking element, patent claims 10 and 11 are the closest to reissue claim 16. Claim 16 is broader than patent claim 10 in that the inner frame limitation, as well as "wherein the clip connection (6) comprises a springy tongue (22')," have been deleted. In addition, claim 16 is broader than patent claim 11 in that the limitation "wherein the clip connection (6) comprises a springy tongue (22') . . . arranged on a locking element (30) . . . said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)" has been deleted.<sup>12</sup>

The second step of the Clement test, as discussed supra, is "to determine whether the broader aspects of the reissue claims relate to surrendered subject matter." Id. at 1468-69, 45 USPQ2d at 1164. As explained supra, the prosecution history of Application 07/642,475 set forth above establishes that the

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<sup>12</sup> Reissue claim 16 also differs from both patent claim 10 and also patent claim 11 in that the limitation "[i]n a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle" has been changed to "[a] check valve assembly adaptable for use with a ventilation system for a passenger space of a motor vehicle." This alteration is neither a broadening nor a material narrowing.

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examiner indicated that the above-noted inner frame and dovetail guide limitations were allowable over the prior art. In response, appellant added the inner frame limitation to rejected claim 1 and the dovetail guide limitation to rejected claim 11 to overcome the prior art rejection. Since reissue claim 16 includes neither the inner frame limitation nor the dovetail guide limitation, the limitations that had been added to overcome a prior art rejection, the reissue claim is broader "in a manner directly pertinent to the subject matter . . . surrendered throughout the prosecution." Id. at 1471, 45 USPQ2d at 1166.

The last step is to determine whether the surrendered subject matter has crept into the rejected reissue claim. In what aspects, if any, is the reissue claim narrower than the canceled, or rejected, claim?

As discussed supra, claim 16 is as broad as original patent application claim 11 in an aspect germane to a prior art rejection (i.e., the limitation added to overcome the reference), by not including either the inner frame limitation or the dovetail guide limitation. Claim 16 is not narrower than original patent application claim 11 in any respects. Thus, comparing reissue claim 16 to original patent application claim 11, claim 16 is "as broad as or broader than the canceled or amended claim in all aspects." Therefore, according to

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principle (1) of Clement, 131 F.3d at 1470, 45 USPQ2d at 1165, the recapture rule bars the claim.

Appellant incorrectly argues that claim 16 has been narrowed relative to the surrendered subject of original patent application claim 11 in that it includes the limitation of "the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle." Original patent application claim 1 included the limitation that "the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve element (3) [sic, (5)] is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3)." Original patent application claim 10, which depended from claim 1, included the limitation "wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3)" and original patent application claim 11, dependent from claim 10, included the limitation "wherein the springy tongue (22') is arranged on a locking element (30) which can be connected with the outer housing (3)." These limitations of original patent application claims 1, 10 and 11 fully correspond to the above-quoted argued limitation of claim 16.

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For the reasons set forth above, the decision of the examiner rejecting claim 16 under 35 U.S.C. § 251 should be affirmed.

**AFFIRMED**

|                             |   |                 |
|-----------------------------|---|-----------------|
| JOSEPH F. RUGGIERO          | ) |                 |
| Administrative Patent Judge | ) | BOARD OF PATENT |
|                             | ) |                 |
|                             | ) | APPEALS         |
|                             | ) |                 |
| ANITA PELLMAN GROSS         | ) | AND             |
| Administrative Patent Judge | ) |                 |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |

Judge Nase, with whom Judges Garris, Delmendo and Franklin join, concurring-in-part and dissenting-in-part.

We concur with the decision of the majority (set forth in the plurality and concurring opinions) to affirm the rejection of claim 16 under 35 U.S.C. § 251 albeit based on a different analysis. We dissent from the decision of the majority to affirm the rejection of claim 14 under 35 U.S.C. § 251. In our view, the decision of the examiner to reject claim 14 under 35 U.S.C. § 251 should be reversed.

#### **OVERVIEW OF OUR POSITION REGARDING CLAIM 14**

The majority's affirmance of the claim 14 rejection is in conflict with the provisions of 35 U.S.C. § 251<sup>13</sup> which grant a

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<sup>13</sup> 35 U.S.C. § 251, ¶ 1, provides 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 . . . 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.

35 U.S.C. § 251, ¶ 4, provides:

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.

reissue applicant the right to enlarged claim scope while providing intervening rights to the public under 35 U.S.C. § 252.<sup>14</sup>

The majority's affirmance of the claim 14 rejection is based on the belief that claim 14 recaptures surrendered subject matter by omitting the original dependent claim 2 limitation which had been added to original parent independent claim 1 in order to avoid prior art and thereby obtain patent claim 1. This original claim 2 limitation relates to a surrounding rim with stays which is disclosed as a "further embodiment" of patentee's invention, (e.g., see lines 3-10 in column 2 of the patent).

Significantly, the patent also discloses other embodiments of the invention which involve various clip connection arrangements (e.g., see the paragraph bridging columns 1 and 2 as well as lines 37-52 in column 2) including the first and second resilient clip connections defined by claim 14 (as well as the alternative clip connection embodiment of patent claim 11). It appears to be the

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<sup>14</sup> 35 U.S.C. § 252, ¶ 2, provides:

A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, used, or imported as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or for the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

plurality's and concurrence's position that the embodiment of first and second resilient clip connections defined by claim 14 has been surrendered and therefore cannot now be claimed by reissue except in combination with the surrounding rim embodiment defined by original dependent claim 2 and by patent claim 1. The merit of this position is questionable for a number of reasons.

First, the now claimed embodiment of first and second resilient clip connections cannot have been surrendered by patentee because this embodiment had never before been claimed by patentee. Not one of the original or amended claims presented by patentee in his original patent application was ever directed to the particular embodiment now defined by appealed claim 14. We perceive no convincing rationale in support of the plurality's and concurrence's view that patentee has surrendered an embodiment which had never been claimed (and therefore never argued). To the contrary, this failure to claim an embodiment, which has been expressly disclosed as part of the invention and which patentably distinguishes over the prior art, is the very type of error 35 U.S.C. § 251 is meant to allow or permit to be corrected.

Second, as previously indicated, the majority apparently believes that the claim 14 embodiment of first and second resilient clip connections would avoid recapture and thus be allowable only if combined with the surrounding rim embodiment of original claim 2 and patent claim 1. This belief presupposes that the two embodiments are compatible. In this case, such a presupposition is

correct in our view. Nevertheless, we see nothing in the plurality's or concurrence's opinions which suggests that their decision to affirm the claim 14 rejection would be any different even if the aforementioned embodiments were incompatible. Under this circumstance, it would be impossible for a patentee to ever obtain reissue patent protection for an invention embodiment which had been erroneously never claimed during prosecution of the original application. Such an outcome would violate a reissue applicant's statutory rights including the right to enlarged claim scope.

Third, the majority's determination, that patentee has surrendered subject matter which does not include the surrounding rim embodiment of original claim 2 and patent claim 1, is directly contrary to intrinsic record evidence in the form of patent claim 11. This is because patent claim 11, which is directed to an alternative clip connection embodiment, unquestionably does not contain any limitations specific to the surrounding rim embodiment. From our perspective, this undisputed fact by itself clearly invalidates any merit the majority's determination might otherwise seem to possess.

In summary, we believe that any one of the above discussed reasons taken alone is adequate to reveal that the majority has impermissibly denied the appellant his right under 35 U.S.C. § 251 to enlarged claim scope as defined by claim 14. These reasons

taken together emphasize the error of the majority's decision to affirm the claim 14 rejection.

In our view, the basic error in the majority's affirmance stems from the failure to appreciate that a determination of surrendered subject matter is a fact dependent analysis based on evidence. As reflected by the decisional authority cited below, surrendered subject matter may be evinced by a variety of factual circumstances. For example, evidence of surrendered subject matter may be in the form of a claim alone as it existed prior to cancellation and/or amendment. In re Byers, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956). Additionally, surrender may be evinced by such a claim in combination with argument. In re Clement, 131 F.3d 1464, 1470, 45 USPQ2d 1161, 1165-66 (Fed. Cir. 1997). Surrender also may be evinced by argument alone. Hester Industries, Inc. v. Stein Inc., 142 F.3d 1472, 1480, 46 USPQ2d 1641, 1648 (Fed. Cir. 1998). Other types of surrendered subject matter evidence are conceivable.<sup>15</sup>

In the case before us, it is undisputed that, during prosecution of the original application, the examiner's prior art rejections were avoided, sans argument, by cancelling the sole independent original claim 1 and rewriting the examiner-denominated allowable subject matter of dependent claim 2 (as well as dependent

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<sup>15</sup> For example, surrender may also occur via an admission made in the body of the specification or via an asserted claim distinction with respect to nonapplied prior art cited in an Information Disclosure Statement.

claim 12) into independent claim form. The majority has cited no authority which directly supports the proposition that, under such a factual circumstance, it is appropriate to define subject matter which has been surrendered by referring to subject matter which has been patented. The only authority, which supports referring to patented subject matter as defining surrender, is limited to the factual circumstance wherein surrender is evinced by argument concerning a limitation of the patent claim. Hester, id. However, even under that scenario, the surrendered subject matter is the patent claim sans the argued limitation.

No argument is present in this case. Thus, the record of this appeal contains no evidence specifically sanctioned by decisional authority which supports the majority's determination that claim 14 recaptures surrendered subject matter because it is not limited to the surrounding rim embodiment of original dependent claim 2 and independent patent claim 1. On the other hand, the majority's determination is contradictory to the intrinsic record evidence of patent claim 11 which indisputably is not limited to this surrounding rim embodiment.

In light of the foregoing, we consider the majority decision as to claim 14 as conflicting with binding precedent which we are obliged to follow and as conflicting with a reissue applicant's 35 U.S.C. § 251 right to enlarged claim scope which we are obliged to implement.

**RECAPTURE UNDER 35 U.S.C. § 251**

The reissue statute expressly permits a patentee to obtain reissue claims broader than the originally issued claims at any time within two years from the date the original patent issues. 35 U.S.C. § 251. The scope of permissible broadened reissue claims is limited by a judicial doctrine known as the "recapture rule." The "recapture rule" was developed to prohibit a patentee from obtaining by reissue broadened claims that "recapture" subject matter the patentee "deliberately surrendered" during the course of the original prosecution to obtain the patent. When an applicant cancels or amends a claim to overcome a prior art rejection, and then relies on the changes made to the claim in arguing patentability of the amended claim, the law infers that the patent applicant admits that the prior art forecloses the scope of the original claim. As a result of this inferred admission, competitors are free to practice the subject matter surrendered by the patentee through the cancellation or amendment. To preserve the public notice function of the file history, the "recapture rule" precludes the patentee from recanting the admission that the prior art precluded a certain breadth of claim scope.

**BURDEN OF PROOF**

We agree with the plurality that an examiner has the burden of making out a prima facie case of recapture. However, we believe that the examiner makes out the prima facie case of recapture by

establishing: (1) the scope of the surrendered subject matter; and (2) that the surrendered subject matter has crept into a reissue claim.

Once a prima facie case of recapture is established, the burden of persuasion then shifts to the applicant to establish that the rejected claim sought to be reissued does not recapture surrendered subject matter.

#### **THE PRECEDENT**

The seminal Federal Circuit case regarding the "recapture rule" is Clement which is set forth in pertinent part at Appendix 7.

The Federal Circuit in Clement set forth an analytical process for determining if the recapture rule should be applied against claims in a reissue application. However, to properly understand that analytical process one must first understand the cases that proceeded Clement which are analyzed in Appendix 8.

How the analytical process set forth in Clement was applied in the Clement case itself and in subsequent cases is set forth in Appendix 9.

#### **WHAT SUBJECT MATTER WAS SURRENDERED?**

The question in this appeal is what subject matter was surrendered?

Is it

(1) the subject matter of original patent application claims 1, 3-5 and 7-11 or

(2) the subject matter of original patent application claims 1, 3-5 and 7-11 and, on a limitation-by-limitation basis, the territory falling between the scope of

(a) original patent application claims 1, 3-5 and 7-11 and

(b) original patent application claims 2 and 12.

For the reasons which follow, we believe that it is (1) while the majority believes it is (2).

In the context of recapture under 35 U.S.C. § 251, surrendered subject matter has been determined by the Supreme Court, the Federal Circuit, or the Court of Customs and Patent Appeals (CCPA) to be either (1) the rejected claim deliberately canceled or amended in an effort to overcome a prior art rejection (which strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable);<sup>16</sup> or (2) the argued claim minus the argued limitations when surrender

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<sup>16</sup> See Leggett v. Avery, 101 U.S. 256, 259-60 (1879); Dobson v. Lees, 137 U.S. 258, 265-66 (1890); Byers, 230 F.2d at 455-56, 109 USPQ at 55-56; In re Willingham, 282 F.2d 353, 356-57, 127 USPQ 211, 215-16 (CCPA 1960); In re Wesseler, 367 F.2d 838, 151 USPQ 339 (CCPA 1966); In re Richman, 409 F.2d 269, 161 USPQ 359 (CCPA 1969); In re Wadlinger, 496 F.2d 1200, 1207-08, 181 USPQ 826, 832 (CCPA 1974); Ball Corporation v. United States, 729 F.2d 1429, 1435-36, 221 USPQ 289, 293-95 (Fed. Cir. 1984); Whittaker Corp. v. UNR Industries Inc., 911 F.2d 709, 713, 15 USPQ2d 1742, 1745 (Fed. Cir. 1990); Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993); and Clement, 131 F.3d at 1468-70, 45 USPQ2d at 1163-65.

occurs through arguments alone.<sup>17</sup> This may not be an exhaustive list since other types of surrendered subject matter evidence are conceivable.<sup>18</sup> However, we are aware of no 35 U.S.C. § 251 recapture case in which the Supreme Court, the Federal Circuit, the CCPA or the Court of Claims determined that surrendered subject matter includes both the subject matter of a rejected claim that is subsequently amended into allowable form and, on a limitation-by-limitation basis, the territory falling between the scope of the rejected claim and the amended allowable claim.

It is our view that, in this appeal, the prosecution history of Application No. 07/642,475 set forth in the plurality opinion establishes only each of original patent application claims 1, 3-5 and 7-11 as surrendered subject matter since the appellant either canceled or amended each of those claims in order to overcome a prior art rejection.

Our view is consistent with recent Federal Circuit decisions

Our view is clearly consistent with Clement which compared reissue claim 49 with claim 42 before the amendments thereto which made claim 42 allowable. The court found that claim 49 was narrower in one area, namely, the brightness being "at least 59 ISO in the final pulp."<sup>19</sup> The court found that this narrowing related

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<sup>17</sup> See Hester.

<sup>18</sup> See footnote 15.

<sup>19</sup> The brightness being "at least 59 ISO in the final pulp" is one of the limitations added to claim 42 that led to the allowance of that claim.

to a prior art rejection because, during the prosecution of the '179 patent, Clement added this brightness limitation in an effort to overcome a prior art rejection. The court's comparison also revealed that reissue claim 49 was broader than claim 42 before the amendments thereto which made claim 42 allowable in that it eliminates the room temperature and specific energy limitations of step (a), and the temperature, specific energy, and pH values of steps (c) and (d). The court found that this broadening directly related to several prior art rejections because, in an effort to overcome the applied prior art Clement added to step (a) the limitation that it is carried out "at room temperature," and applies "specific mechanical energy lower than 50 KW.H/Ton to form a pumpable slurry." On balance, the court held that reissue claim 49 was broader than it was narrower in a manner directly pertinent to the subject matter that Clement surrendered throughout the prosecution and accordingly the court affirmed the board's decision to sustain the examiner's rejection of claim 49 under 35 U.S.C. § 251 based on the recapture rule.

Our view is consistent with Pannu v. Storz Instruments Inc., 258 F.3d 1366, 1370-71, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001). In Pannu the court stated that "[o]n reissue, [Pannu] is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections." 258 F.3d at 1372, 59 USPQ2d at 1601. This statement may, when viewed in complete isolation, appear to provide

limited support for the majority's rationale in this appeal. In our view, this statement means only what it says, that is, Pannu is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections. We decline to extract from the above-quoted language in Pannu a generalized rule that a reissue claim which omits a limitation relied upon during prosecution of the patent application is per se impermissible under the recapture rule, regardless of whether the claim has been materially narrowed in other respects compared to the surrendered subject matter. Rather, the proper inquiry requires a fact-specific analysis in each case to determine whether the patentee is attempting to recapture by reissue subject matter that was surrendered during the prosecution of the patent application. In Pannu, reissue claim 1 was broader than the surrendered subject matter in an aspect germane to the prior art rejection. Specifically, the addition of limitations to later added claim 16 and statements made by Pannu limited claim 16 to exclude an interpretation that did not include a continuous, substantially circular arc. However, claim 16 with the limitation "a continuous, substantially circular arc" constitutes surrendered subject matter in Pannu due to the later examiner's amendments to claim 16 setting forth structural details of the haptics. The Federal Circuit determined that the deletion of the "continuous, substantially circular arc" limitation resulted in the shape of the haptics being

broadened during reissue and that this was the same subject matter that was surrendered during prosecution. The reissue claims were also narrower than both claim 16 in the patent application prior to the examiner's amendments and patent claim 1, in that the reissue claims changed the recitation that the length of the haptics was "substantially greater" than the width of the haptics to "at least three times greater" than the width of the haptics and added the limitation that the snag resistant means must be "substantially coplanar" with the haptics. The Federal Circuit then balanced the broadening of the surrendered subject matter against the narrowing of the surrendered subject matter and concluded that "the reissued claims were not narrowed in any material aspect compared with their broadening." Pannu, 258 F.3d at 1372, 59 USPQ2d at 1601. As such, Pannu was estopped from attempting to recapture the precise limitation he added (i.e., the "continuous, substantially circular arc" limitation) to overcome prior art rejections. The Federal Circuit added that "[f]urthermore, 'if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture.'" Anderson v. Int'l Eng'g & Mfg., Inc., 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998)."  
Pannu, 258 F.3d at 1372, 59 USPQ2d at 1601. We understand this language, consistent with the prior precedent of the Federal

Circuit, to mean that, where a patentee is seeking to recover in a reissue claim subject matter broader than that surrendered during prosecution, the mere presence of narrowing limitations in the reissue claim is not necessarily sufficient to save the reissue claim from the recapture rule.

Our view is consistent with North American Container, Inc. v. Plastipak Packaging, Inc., et al., 415 F.3d 1335, 1349-50, 75 USPQ2d 1545, 1556-57 (Fed. Cir. 2005). The prosecution history of U.S. Patent 5,072,841 ("the '841 patent"), which issued from Application 07/577,799, a file-wrapper-continuation of Application 07/112,607 ("the '607 application") was as follows. The '607 application was filed with claims 1-14. The first office action (mailed 5/25/1989) in the '607 application rejected claims 1-3 and 8-12 as obvious over U.S. Patent 4,231,483 to Dechenne in view of U.S. Patent 4,467,929 to Jakobsen. Claims 4-7, 13 and 14 were objected to as improper dependent claims. An amendment was filed August 28, 1989 in the '607 application canceling claims 1-14 and adding claims 15-41. This amendment included the limitation that the shape of the inner walls was "generally convex" in each independent claim. A final rejection was mailed December 7, 1989 in the '607 application rejecting claims 15, 17-19, 24, 26-28, 33, 35, 37 and 39 under 35 U.S.C. § 103. The '799 application was then filed with a pre-amendment canceling claims 15-41 and adding claims 42-68. This amendment maintained the limitation that the shape of

the inner walls was "generally convex" in each independent claim while adding new limitations to each independent claim in an attempt to overcome the 35 U.S.C. § 103 rejection made in the final rejection in the '607 application. Claims 42-68 in the '799 application were allowed in a Quayle action mailed on February 16, 1991. Claims 42, 43, 45, 48, 51, 52, 54-57, 59 and 60 in the '799 application were further amended on April 16, 1991 and new dependent claim 69 was added. Claims 42-69 in the '799 application were allowed on June 27, 1991 and issued in the '841 patent as claims 1-28.

In our view, the above prosecution history of the '841 patent establishes finally rejected claims 15, 17-19, 24, 26-28, 33, 35, 37 and 39 in the '607 application containing the limitation that the shape of the inner walls was "generally convex" to be surrendered subject matter. Thus, the removal of the limitation that the shape of the inner walls was "generally convex" results in a claim that is broader than the surrendered subject matter in an aspect germane to a prior art rejection. As such, the reissue claims in North American Container were subject to a recapture rejection, having fallen into principle 3 of Clement<sup>20</sup> wherein the reissue claims are broader than the surrendered subject matter in some aspects, but narrower than the surrendered subject matter in others, thus requiring the broadening aspects of the reissue claims

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<sup>20</sup> 131 F.3d at 1470, 45 USPQ2d at 1165.

to be balanced against the narrowing aspects of the reissue claims to determine if the recapture rule bars the claims. Since the Federal Circuit has never set forth any fact pattern where a reissue claim falling into principle 3 of Clement which is broader than the surrendered subject matter in an aspect germane to a prior art rejection avoids the recapture rule, North American Container is, in our view, an example of how the Federal Circuit balances the broadening aspects of a reissue claim against the narrowing aspects of the reissue claim to determine if the recapture rule bars the claim. The Federal Circuit found in North American Container that (1) the reissue claims are broader in scope than the originally-issued claims in that they no longer require the "inner walls" to be "generally convex"; (2) the broader aspect of the reissue claims relates to subject matter that was surrendered during prosecution of the originally-filed claims; (3) the reissue claims were not narrowed sufficiently to avoid the recapture rule; and (4) the reissue claims were invalid for violating the rule against recapture.

Fatal flaw in majority decision

The fatal flaw in the majority decision is that they adopt an interpretation of the phrase "surrendered subject matter" as used in the context of recapture under 35 U.S.C. § 251 unsupported by the case law. The plurality and concurring opinions view the phrase "surrendered subject matter" as applied to the facts of this

case as including both (1) the rejected claim prior to the amendment attempting to overcome a prior art rejection (i.e., the limitations of original claims 1, 3-5 and 7-11), and (2) any claim that lacks a limitation directed to subject matter added to overcome a prior art rejection (i.e., the limitations of original claims 2 and 12). In our view, the "surrendered subject matter" in this case is only original patent application claims 1, 3-5 and 7-11 since the appellant either canceled or amended each of those claims in order to overcome a prior art rejection. Thus, each of original patent application claims 1, 3-5 and 7-11 correspond to distinct and separate "surrendered subject matter."<sup>21</sup>

The following simplified example highlights the difference between the majority's interpretation of the phrase "surrendered subject matter" and our interpretation of the phrase "surrendered subject matter." The original application is filed with claim 1 to ABC (like original claim 1 from Application No. 07/642,475) and dependent claim 2 adding limitation D to claim 1 (like original claim 2 from Application No. 07/642,475). Claim 1 is rejected as being unpatentable over reference X while claim 2 is objected to as depending from a non-allowed claim. In response to that rejection, the applicant cancels claims 1 and 2 and presents new claim 3 to

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<sup>21</sup> See Byers, 230 F.2d at 456-57, 109 USPQ at 56-57 and Clement, 131 F.3d at 1471-72, 45 USPQ2d at 1166. These cases support the proposition that in applying the "recapture rule" the focus is on the narrowest of the cancelled claims not the broadest cancelled claim. In Ball, 729 F.2d at 1432, 221 USPQ at 291, the court stated that "[d]ependent claims 8 and 9 are the only claims of the original application critical to this appeal."

ABCD (like added claim 15 from Application No. 07/642,475). The examiner allows claim 3 and a patent issues with one claim to ABCD. Within two years of the issuance of that patent, the applicant files a reissue application adding a claim to ABCE. In the prosecution of the reissue claim to ABCE, no prior art rejection is made and it is clear that limitation E<sup>22</sup> is not taught or suggested by reference X. The majority would consider the claim to ABCE to be barred by the "recapture rule" since that claim lacks the limitation directed to the subject matter added to overcome a prior art rejection (i.e., limitation D). We consider the claim to ABCE to avoid the "recapture rule" since that claim is narrower in scope than the surrendered subject matter (i.e., the claim to ABC) in all aspects (i.e., that claim has not been broadened in any aspect relative to the surrendered subject matter of ABC and has been amended to be narrower than the surrendered subject matter of ABC in at least one aspect by the addition of limitation E). The majority's interpretation, we believe, is contrary to precedent

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<sup>22</sup> Limitation E is a totally distinct and separate limitation from limitation D.

binding on this Board.<sup>23</sup> See, for example, Willingham, Wesseler, Richman, Wadlinger, Ball, Whittaker and Clement discussed in Appendixes 7 and 8.

In its first decision, South Corp. v. United States, 690 F.2d 1368, 1370 & n.2, 215 USPQ 657, 657-58 & n.2 (Fed. Cir. 1982), the Federal Circuit dealt unequivocally with the matter of binding precedent. Sitting, en banc, the court held that it would adhere to the body of law that existed in its predecessor courts, the United States Court of Claims and the United States Court of Customs and Patent Appeals (CCPA), as of September 30, 1982. Overruling such precedent, or resolving a conflict between the two predecessors, would require en banc consideration.<sup>24</sup> The Federal Circuit has faithfully observed the rule of South. Even where it is possible that a prior decision of the CCPA would be decided

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<sup>23</sup> Under Standard Operating Procedure 2 (Revision 6) (August 10, 2005), the following are considered precedent binding upon the Board:

1. An opinion of the Supreme Court.
2. An en banc decision of the Court of Appeals for the Federal Circuit.
3. A decision of the Court of Appeals for the Federal Circuit, or its predecessors, the Court of Customs and Patent Appeals (CCPA) and the Court of Claims, which the Court of Appeals for the Federal Circuit considers binding precedent.
4. An opinion of the Board made precedential by the procedures contained in this or earlier versions of Standard Operating Procedure 2.

Standard Operating Procedure 2 can be found at <http://www.uspto.gov/web/offices/dcom/bpai/sop2.pdf>.

<sup>24</sup> See also UMC Elec. Co. v. United States, 816 F.2d 647, 652 n. 6, 2 USPQ2d 1465, 1468 n. 6 (Fed. Cir. 1987); United States v. Rush, 804 F.2d 645, 647 (Fed. Cir. 1986); Gindes v. United States, 740 F.2d 947, 949-50 (Fed. Cir. 1984); Mother's Restaurant, Inc. v. Mama's Pizza, Inc., 723 F.2d 1566, 1569, 221 USPQ 394, 397 (Fed. Cir. 1983).

differently today, it still stands as binding precedent until overruled.<sup>25</sup> On the other hand, what may have been traditional practice is not, without a clear holding of one of the Federal Circuit's predecessors, binding upon it.<sup>26</sup> The Federal Circuit has adopted the rule that prior decisions of a panel of the court are binding precedent on subsequent panels unless and until overturned en banc. Where there is direct conflict, the earliest decision controls.<sup>27</sup> We believe it is the burden of the majority to establish that their new interpretation of "surrendered subject matter" is consistent with the decisions in Willingham, Wesseler, Richman, Wadlinger and Whittaker. This, they have not done.

#### **SUMMARY OF THE RECAPTURE RULE**

In our opinion, the Federal Circuit has set forth the following analytical process for determining if the recapture rule should be applied against claims in a reissue application.

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<sup>25</sup> In re Durden, 763 F.2d 1406, 1410, 226 USPQ 359, 361 (Fed. Cir. 1985). See also Larry Harmon Pictures Corp. v. Williams Rest. Corp., 929 F.2d 662, 666, 18 USPQ2d 1292, 1295 (Fed. Cir. 1991). The Federal Circuit has recognized that later CCPA decisions could resolve precedential inconsistencies sub silentio; later CCPA decisions would control because that court always sat en banc. In re Gosteli, 872 F.2d 1008, 1011, 10 USPQ2d 1614, 1616 (Fed. Cir. 1989).

<sup>26</sup> Dynamics Corp. v. United States, 766 F.2d 518, 520, 226 USPQ 622, 623 (Fed. Cir. 1985).

<sup>27</sup> Newell Cos. v. Kenney Mfg. Co., 864 F.2d 757, 765, 9 USPQ2d 1417, 1423 (Fed. Cir. 1988). Decisions of a three-judge panel cannot overturn prior precedential decisions of the court. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). A reversal of such a holding would have to be through an en banc proceeding in the Federal Circuit, Supreme Court review, or a change in the patent statute by Congress. Jacobs Wind Elec. Co. v. Florida Dep't of Transp., 919 F.2d 726, 728, 16 USPQ2d 1972, 1973-74 (Fed. Cir. 1990).

The first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims.

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Thus, one looks to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection to determine what surrendered subject matter exists, if any. If no surrendered subject matter exists, then the "recapture rule" does not apply. If surrendered subject matter exists, it must then be determined whether the surrendered subject matter has crept into the reissue claims. Accordingly, the reissue claim must be compared with the surrendered subject matter. If the scope of the reissue claim is as broad as or broader than the surrendered subject matter in all aspects (i.e., a claim that has not been narrowed in any aspect relative to the surrendered subject matter), then the recapture rule bars the claim. In contrast, a reissue claim narrower in scope than the surrendered subject matter in all aspects (i.e., a claim that has not been broadened in any aspect relative to the surrendered subject matter and has been amended to be narrower than the surrendered subject matter in at least one aspect) escapes the recapture rule entirely. However, if the reissue claim is broader than the surrendered subject matter in some aspects, but narrower than the surrendered subject matter in

others, then the broadening aspects of the reissue claim must be balanced against the narrowing aspects of the reissue claim to determine if the recapture rule bars the claim.<sup>28</sup>

APPLICATION OF THE RECAPTURE RULE TO CLAIM 14

As noted in Clement, the first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claim is broader than the patent claims. This step of the analysis is important to ensure that the appellant has not run afoul of the two-year limitation on broadening, and, if broadening has occurred, to establish exactly in what aspects such broadening has occurred.

Claim 14 is broader than patent claim 1 in that the limitation "wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9)" has been deleted.<sup>29</sup>

Claim 14 is broader than patent claim 11 in that the limitation "wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3), said

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<sup>28</sup> See Clement; Mentor; Ball; Pannu., 258 F.3d at 1370-71, 59 USPQ2d at 1600; North American Container, 415 F.3d at 1349-50, 75 USPQ2d at 1556-57; and Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003).

<sup>29</sup> In addition, the limitation "[i]n a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle" has been changed to "[a] check valve assembly adaptable for use with a ventilation system for a passenger space of a motor vehicle." The concurring opinion (see footnote 11) views this change as neither a broadening nor a material narrowing. We view this change as being a slight broadening in an aspect that is clearly not germane to the prior art rejection.

springy tongue (22') being arranged on a locking element (30) which can be connected with the outer housing (3), and said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)" has been deleted.<sup>30</sup>

The prosecution history of Application No. 07/642,475 set forth in the plurality opinion establishes each of original patent application claims 1, 3-5 and 7-11 as surrendered subject matter since the appellant either canceled or amended each of those claims in order to overcome a prior art rejection. In compliance with the second step set forth in Clement, we now must determine whether the surrendered subject matter has crept into the rejected reissue claim. We therefore compare rejected reissue claim 14 with the surrendered subject matter (i.e., original patent application claims 1, 3-5 and 7-11).

Claim 14 is not broader than original patent application claim 8<sup>31</sup> in any relevant aspect.<sup>32</sup> Claim 14 is narrower than

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<sup>30</sup> See footnote 29.

<sup>31</sup> We have selected original patent application claim 8 as representative of the "surrendered subject matter" since this claim is, in our view, the closest in scope to rejected claim 14. In the rejection under appeal (see final rejection mailed November 9, 1999), the examiner relied upon original patent application claim 1 as the basis for the rejection. In the response to argument section of the Supplemental Examiner's Answer (mailed July 23, 2004), the examiner relied upon original patent application claim 10 as the basis for the rejection. The concurrence relies upon original patent application claims 9 and 11 (which they believe have the most limitations in common with rejected claim 14) as the basis for affirming the rejection. Viewing either claim 9 or claim 11 as the "surrendered subject matter" does not change the outcome, in our view, concerning claim 14 on appeal since the limitations of claim 9 and claim 11 are completely unrelated to the prior art rejection since those limitations are met by the prior art applied in the prior art rejection. The selection of a representative claim is a matter of exposition convenience. A proper Clement analysis of any surrendered claim would result in the same outcome.

<sup>32</sup> See footnote 29.

original patent application claim 8 in the following aspect: "[a] second clip connection comprising a second springy tongue integral with the surrounding wall."

Since claim 14 is broader than original patent application claim 8<sup>33</sup> in one non-germane aspect, and also narrower than original patent application claim 8 in one aspect, the broadening, non-germane aspect of claim 14 must be balanced against the narrowing aspect of claim 14. The narrowing aspect is germane to the prior art rejection in the sense that it overcomes the prior art applied in the prior art rejection.<sup>34, 35</sup> Viewed from this perspective, claim 14 is at least narrower in all aspects germane to the prior art rejection (see footnotes 29 and 35), thus falling into Clement principle (3)(b) and avoiding the recapture rule.

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<sup>33</sup> Original patent application claim 8 depended from original patent application claim 7 which depended from original patent application claim 1.

<sup>34</sup> In the prior art rejection of original patent application claims 1, 3-5 and 7-11, the examiner combined either U.S. Patent No. 3,405,968 to Feles et al. (Feles) or U.S. Patent No. 4,781,106 to Frien with U.S. Patent No. 4,691,623 to Mizusawa. The examiner ascertained that Feles and Frien do not disclose the resilient clip connection. Mizusawa shows a ventilator device having a single elastic pawl. The examiner then concluded that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide either Feles and Frien with an elastic pawl as suggested and taught by Mizusawa. Thus, the applied prior art does not teach or suggest both a first clip connection comprising a first springy tongue spaced from the wall and a second clip connection comprising a second springy tongue integral with the surrounding wall.

<sup>35</sup> There is very little specific authority or guidance given by the Federal Circuit as to how one ascertains whether or not an aspect is or is not germane to the prior art rejection. Since there is no prior art rejection of claim 14 and the applied prior art does not teach or suggest both a first clip connection comprising a first springy tongue spaced from the wall and a second clip connection comprising a second springy tongue integral with the surrounding wall (see footnote 34), it is appropriate, in our view, to conclude that the narrowing aspect overcomes the prior art applied and is therefore germane to the prior art rejection.

When viewed from the perspective of the concurring opinion (see footnote 29) that the change of the limitation "[i]n a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle" to "[a] check valve assembly adaptable for use with a ventilation system for a passenger space of a motor vehicle" is neither a broadening nor a material narrowing, claim 14 would only be narrower than the surrendered subject matter, thus falling into Clement principle (2) and avoiding the recapture rule.

Viewed from an alternative perspective, claim 14 avoids the recapture rule (1) regardless of whether the narrowing aspect of this claim is considered germane to the prior art rejection and perhaps more importantly, (2) regardless of how surrendered subject matter is defined. That is, the recapture rule is avoided even if surrendered subject matter is as defined in the plurality and concurring opinions and even if the narrowing aspect of claim 14 is completely unrelated to the rejection as determined expressly in the concurring opinion and implicitly in the plurality opinion.

As explained in Hester, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50, reissue claims which recapture surrendered subject matter nevertheless may avoid the recapture rule

when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

Accord North American Container, 415 F.3d at 1349, 75 USPQ2d at 1556 ("finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule"); Pannu, 258 F.3d at 1371, 59 USPQ2d at 1600 ("[f]inally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule").

We have previously determined that the narrowing aspect of claim 14 (i.e., "[a] second clip connection comprising a second springy tongue integral with the surrounding wall") concerns an expressly disclosed embodiment of the invention which had never before been claimed. Significantly, neither the plurality nor the concurring opinions disagree with our determination. It is undisputed, therefore, that the claim 14 narrowing is an overlooked aspect of the invention since it had never been claimed in the original patent application. Further, this claim narrowing is a material narrowing because it renders claim 14 novel and unobvious over the prior art of record. To elaborate, claim 14 without its narrowing aspect would essentially correspond to rejected original claims 1, 7 or 8 and thus would presumably be unpatentable over the prior art applied in the rejection of original claims 1, 7 and 8. Because it is the narrowing aspect only which renders claim 14 patentable over the prior art, it is appropriate to consider this narrowing to be material.

In summary, claim 14 avoids the recapture rule because it is "materially narrower in other overlooked aspects of the invention" and thereby provides the appellant with "a scope of protection to which he is rightfully entitled for such overlooked aspects." Hester, 142 F.3d at 1482-83, 46 USPQ2d at 1650.

Claim 14 is broader than original patent application claim 10<sup>36</sup> in the following additional aspect: the limitation "wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3)" has been deleted.<sup>37</sup> Claim 14 is narrower than original patent application claim 10 in the following aspects: (1) the outer housing having "a surrounding wall"; and (2) "[a] second clip connection comprising a second springy tongue integral with the surrounding wall."

Since claim 14 is broader than original patent application claim 10 in two aspects, and also narrower than original patent application claim 10 in two aspects, the broadening aspects of claim 14 must be balanced against the narrowing aspects of claim 14. The broadening aspects are completely unrelated to the prior art rejection since both limitations were set forth in original patent application claim 10<sup>38</sup> and were met by the prior art applied

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<sup>36</sup> This is the claim the examiner relied on in the response to argument section of the Supplemental Examiner's Answer (mailed July 23, 2004). See footnote 31.

<sup>37</sup> See footnote 29.

<sup>38</sup> Original patent application claim 10 depended from original patent application claim 1.

in the prior art rejection. The first narrowing aspect is not germane to the prior art rejection in the sense that it does not overcome the prior art applied in the prior art rejection. The second narrowing aspect is germane to the prior art rejection in the sense that it overcomes the prior art applied in the prior art rejection.<sup>39</sup> Moreover, this second narrowing aspect is an overlooked aspect of the invention since it had never been claimed in the original patent application and is a material narrowing since it is novel and unobvious over the prior art of record. See Hester, id. Even assuming the "surrendered subject matter" to be that set forth in the plurality and concurring opinions, claim 14 still would avoid the "recapture rule" because this second narrowing aspect was a material and overlooked aspect of the invention as more fully explained above.

In accordance with Clement, if a reissue claim is narrower in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim. Since claim 14 is narrower than original patent application claim 10 in an aspect germane to the prior art rejection, and broader than original patent application claim 10 in aspects unrelated to the rejection, the recapture rule does not bar the claim.

For the reasons set forth above, we would reverse the decision of the examiner to reject claim 14 under 35 U.S.C. § 251.

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<sup>39</sup> See footnote 35.

**APPLICATION OF THE RECAPTURE RULE TO CLAIM 16**

In applying the first step of Clement, we find that claim 16 is broader than patent claim 1 in that the limitation "wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9)" has been deleted.<sup>40</sup>

Claim 16 is broader than patent claim 11 in that the limitation "wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3), said springy tongue (22') being arranged on a locking element (30) which can be connected with the outer housing (3), and said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)" has been deleted.

The prosecution history of Application No. 07/642,475 set forth in the plurality opinion establishes each of original patent application claims 1, 3-5 and 7-11 as surrendered subject matter since the appellant either canceled or amended each of those claims in order to overcome a prior art rejection. In compliance with the second step set forth in Clement, we now must determine whether the surrendered subject matter has crept into the rejected reissue claim. We therefore compare rejected reissue claim 16 with the surrendered subject matter (i.e., original patent application claims 1, 3-5 and 7-11).

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<sup>40</sup> See footnote 29.

Claim 16 is broader than original patent application claim 11<sup>41</sup> in the following aspect: the limitation that "wherein the clip connection (6) comprises a springy tongue" has been deleted. Claim 16 is not narrower than original patent application claim 11 in any aspect.

Since claim 16 is as broad as or broader than original patent application claim 11 in all aspects (i.e., claim 16 contains no limitation narrowing the scope of original patent application claim 11), the recapture rule bars the claim. Clement, 131 F.3d at 1470, 45 USPQ2d at 1165.

The appellant argues that claim 16 has been narrowed relative to the surrendered subject of original patent application claim 11 in that it includes the limitation of "the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle." We do not agree. Original patent application claim 1 included the limitation that "the assembled unit comprising the

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<sup>41</sup> We have selected original patent application claim 11 as representative of the "surrendered subject matter" since this claim is, in our view, the closest in scope to rejected claim 16. In the rejection under appeal (see final rejection mailed November 9, 1999), the examiner relied upon original patent application claim 1 as the basis for the rejection. In the response to argument section of the Supplemental Examiner's Answer (mailed July 23, 2004), the examiner relied upon original patent application claim 11 as the basis for the rejection. The concurrence relies upon original patent application claim 11 (which they believe have the most limitations in common with rejected claim 16) as the basis for affirming the rejection. See footnote 30.

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inner frame (4), the outer housing (3), and the check valve element (3) [sic, (5)] is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3)." Original patent application claim 10 included the limitation that "wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3)" and original patent application claim 11 included the limitation that "wherein the springy tongue (22') is arranged on a locking element (30) which can be connected with the outer housing (3)." In our view, these limitations of original patent application claims 1, 10 and 11 fully correspond to the above-quoted argued limitation of claim 16.

For the reasons set forth above, we would affirm the decision of the examiner to reject claim 16 under 35 U.S.C. § 251.

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SUMMARY

To summarize, we would reverse the decision of the examiner to reject claim 14 under 35 U.S.C. § 251 and would affirm the decision of the examiner to reject claim 16 under 35 U.S.C. § 251.

**AFFIRMED-IN-PART and REVERSED-IN-PART**

|                             |   |                 |
|-----------------------------|---|-----------------|
| BRADLEY R. GARRIS           | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| JEFFREY V. NASE             | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) | BOARD OF PATENT |
|                             | ) | APPEALS         |
|                             | ) | AND             |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
| ROMULO H. DELMENDO          | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| BEVERLY A. FRANKLIN         | ) |                 |
| Administrative Patent Judge | ) |                 |

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Judge McQuade, concurring-in-part; dissenting-in-part.

The reissue recapture rule prevents a patentee from regaining through reissue the subject matter that was surrendered in an effort to obtain allowance of the original claims. North American Container, Inc. v. Plastipak Packaging, Inc., 415 F.3d 1335, 1349, 75 USPQ2d 1545, 1556 (Fed. Cir. 2005); Pannu v. Storz Instruments Inc., 258 F.3d 1366, 1370-71, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001); Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997); Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). In recent cases, the Court of Appeals for the Federal Circuit has employed a three-step process to apply the reissue recapture rule: the first step is to determine whether and in what aspect the reissue claims are broader than the patent claims; the second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter; and the third step is to determine whether the reissue claims are materially narrowed in other respects so as to avoid the recapture rule. North American Container, 415 F.3d at 1349, 75 USPQ2d at 1556; Pannu, 258 F.3d at 1371, 59 USPQ2d at 1600; Hester, 142 F.3d at 1480-83, 46 USPQ2d at 1648-50. The purpose of the third step is

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to allow a patentee to obtain through reissue a scope of protection to which he is rightfully entitled for overlooked aspects. Hester, 142 F.3d at 1483, 46 USPQ2d at 1650.

In essence, reissue claims 14 and 16 are broader than the claims in U.S. Patent No. 5,105,731 in that neither includes the limitation in independent patent claim 1 which reads "wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9)," or the limitation in independent patent claim 11 which reads "wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3), said springy tongue (22') being arranged on a locking element (30) which can be connected with the outer housing (3), and said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)."

These two limitations appeared in substance in original application claim 2 (which depended from claim 1) and claim 12 (which depended from claim 1 through claims 10 and 11), respectively. The examiner never rejected claims 2 and 12 on prior art grounds and the appellant simply canceled these claims and rewrote them in independent form as claims 15 and 16 (subsequently renumbered as patent claims 1 and 11, respectively), canceled

claim 1, and made minor amendments to the remaining claims to obtain the allowance of the original application. Since reissue claims 14 and 16 do not include the limitations from original application claims 2 and 12 which were relied on by the appellant to obtain the patent, the broadened aspects of claims 14 and 16 arguably relate to surrendered subject matter. The prosecution history of the patent, however, contains no evidence that the appellant ever considered the limitations in original application claims 2 and 12 to embody critical or exclusively defining elements of the invention. Hence, on the record before us, the broadened aspects of reissue claims 14 and 16 relate to surrendered subject matter only in a limited sense. Conceivably, these broadened aspects merely set the limits of the surrendered subject matter at the scope of the original application claims which were canceled or amended.

Reissue claim 14 includes the limitation which reads "the second clip connection comprising a second springy tongue integral with the surrounding wall." The underlying specification indicates that this limitation, which was not recited in any of the original application claims, relates to a significant aspect of the appellant's invention. Moreover, the prior art of record does not anticipate, and would not have suggested, the subject matter recited in claim 14 due to the presence of such limitation.

Reasonably viewed in light of the record as a whole, this limitation materially narrows claim 14 to the extent necessary to avoid the recapture rule and allows the appellant to obtain through reissue a scope of protection to which he is rightfully entitled for an overlooked aspect of his invention. The majority's conclusion to the contrary stems from analyses which, among other faults, attach too much weight to the broadened aspects of claim 14 and too little, if any, weight to the materially narrowed aspect of the claim.

Claim 16, on the other hand, includes no materially narrowing limitation and has a scope essentially similar to that of original application claim 11 which was amended in light of a prior art rejection. Thus, claim 16 would allow the appellant to regain through reissue subject matter that was surrendered to obtain the patent.

Accordingly, the decision of the examiner to reject claims 14 and 16 under 35 U.S.C. § 251 should be reversed with respect to claim 14 and affirmed with respect to claim 16.

|                             |                   |
|-----------------------------|-------------------|
|                             | ) BOARD OF PATENT |
| JOHN P. MCQUADE             | ) APPEALS         |
| Administrative Patent Judge | ) AND             |
|                             | ) INTERFERENCES   |

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Application No. 08/230,083

Fay, Sharpe, Beall,  
Fagan, Minnich & McKee  
1100 Superior Avenue, Suite 700  
Cleveland, OH 44114-2518

### Appendix 1

Brief description the drawings of Krause, U.S. Patent 5,105,731 (drawing sheets 1-3 of Krause are attached as appendix pages 2-4)

Figure 1 on page 2 of this appendix is a cross-sectional view through the check valve structure formed in accordance with the preferred embodiment of the invention. Figure 1 shows the structure in an installed condition in the vehicle.

Figure 2 on page 3 of this appendix is a front view of the inner frame structure used in the figure 1 embodiment.

Figure 3 on page 3 of this appendix is a bottom view of the inner frame structure shown in figure 2.

Figure 4 on page 2 of this appendix is a cross-sectional view taken on line IV-IV of figure 2.

Figure 5 on page 2 of this appendix is an enlarged view of the fastening zone for the flexible elastic closing valve elements.

Figure 6 on page 3 of this appendix is a cross-sectional view of a part of the outer housing and the inner frame (the components are partially broken away to more clearly illustrate certain features of the construction).

Figure 7 on page 3 of this appendix is a top view of the embodiment of figure 6.

Figure 8 on page 3 of this appendix is a cross-sectional view taken along the line VIII-VIII in figure 7.

Figure 9 on page 4 of this appendix shows another form of the invention where the view is taken along line IX-IX of figure 10.

Figure 10 on page 4 of this appendix is a top plan view of the embodiment according to figure 9.

Figure 11 on page 4 of this appendix is a cross-sectional view taken along the line XI-XI in figure 10.



FIG. 2

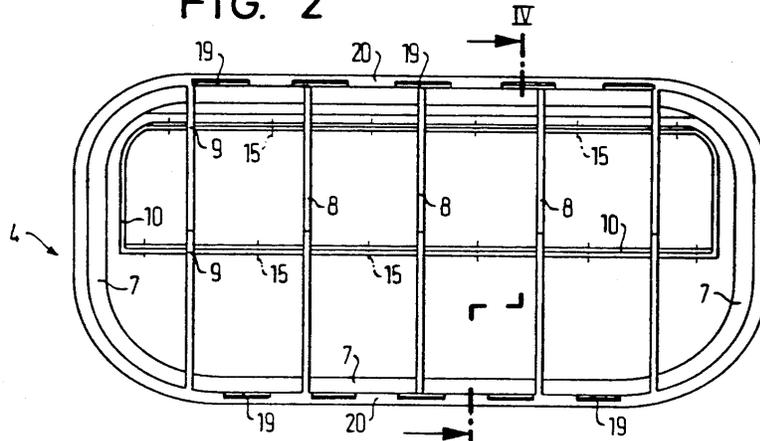


FIG. 3

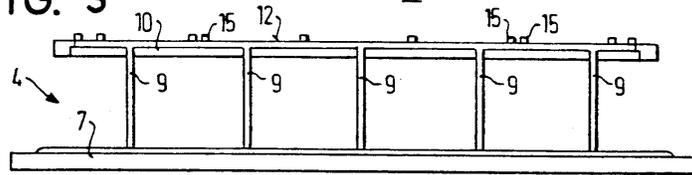


FIG. 6

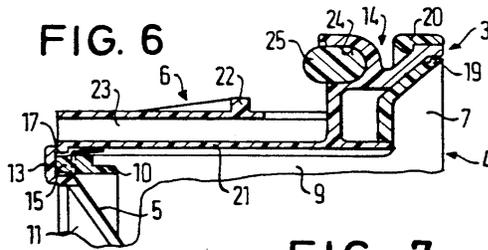


FIG. 7

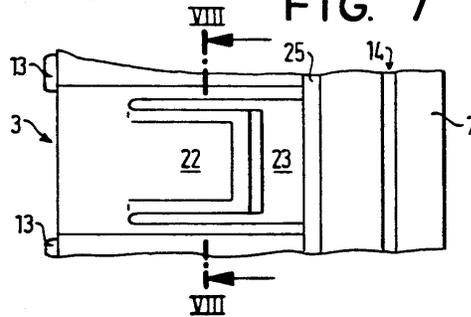
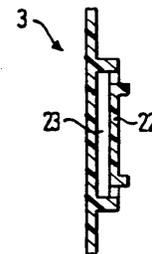
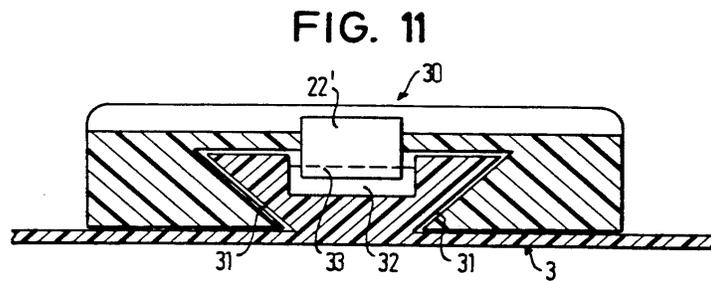
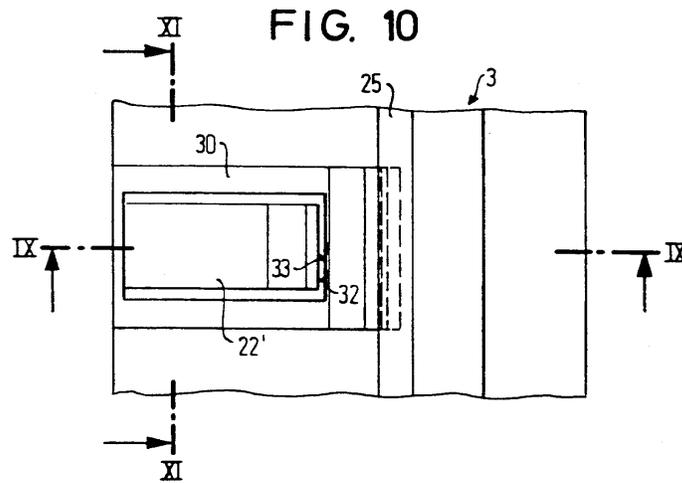
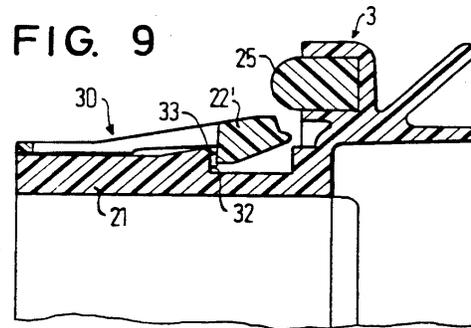


FIG. 8





## Appendix 2

Claims of original application, as filed  
(matter in **bold** and [brackets] added)

1. In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising an outer housing to which an inner frame is connected with a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve [(5)] is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3).
2. The assembly as defined in **claim 1** wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9).
3. The assembly as defined in **claim 1** wherein an oblique grid (11) is arranged on the outer housing (3) and end surfaces (12) of the surrounding frame (10) of the inner frame (4) and a closing zone (13) of the oblique grid (11) form the clamp for the check valve element.
4. The assembly as defined in **claim 3** wherein the surrounding frame (10) of the inner frame (4) has an end surface (12) carrying pins (16) spaced from one another and penetrating through the rim zone (16) of the check valve (5) into lodged position in openings (17) formed in the closing zone (13) of the oblique grid (11) of the outer housing (3).
5. The assembly as defined in **claim 1** wherein the outer housing (3) has a surrounding rim (14) with a clamping connection means (18) for fastening to opposite elements (19) of a surrounding rim (20) of the inner frame (4).
6. The assembly as defined in **claim 2** wherein the outer housing (3) has a surrounding rim (14) and a surrounding wall (21) on the end of which is formed this oblique grid (11).

7. The assembly as defined in **claim 1** wherein the surrounding wall (21) has an upper side provided with at least one springy tongue (22, 22') directed toward the support (2) and functioning as the clip connection (6).

8. The assembly as defined in **claim 7** wherein the at least one springy tongue (22) is arranged in a pocket-like open zone (23) of the surrounding wall (21).

9. The assembly as defined in **claim 8** wherein the surrounding rim (14) of the outer housing (3) has a surrounding groove (24) directed toward the at least one springy tongue (22), said groove (24) carrying a sealing ring (25).

10. The assembly as defined in **claim 1** wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3).

11. The assembly as defined in **claim 10** wherein the springy tongue (22') is arranged on a locking element (30) which can be connected with the outer housing (3).

12. The assembly as defined in **claim 11** wherein the locking element (30) is guided over a dovetail guide (31) on the outer surface of the outer housing (3).

13. The assembly as defined in **claim 12** wherein the locking element (30) has a gripping edge (33) which is arranged on the springy tongue (22') and engages a stop surface (32) on the outer housing (3).

14. The assembly as defined in **claim 13** wherein the springy tongue (22') lies in the middle zone of the locking element (30) between the surfaces of the dovetail guide (31).

### Appendix 3

Claims after presentation of amendment  
in original application (matter in **bold** and {braces} added)  
(matter in [brackets and strikeout] deleted by the amendment  
matter underlined added by the amendment)

1. In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising an outer housing to which an inner frame is connected with a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve element {(5)} is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3).

2. Canceled.

3. (Amended) The assembly as defined in **claim [1] 15** wherein an oblique grid (11) is arranged on the outer housing (3) and end surfaces (12) of the surrounding frame (10) of the inner frame (4) and a closing zone (13) of the oblique grid (11) form the clamp for the check valve element.

4. (Amended) The assembly as defined in **claim 3** wherein the [~~surrounding frame (10) of the inner frame (4) has an~~] end [~~surface~~] surfaces (12) [~~carrying~~] carry pins (16) spaced from one another and penetrating through a [~~the~~] rim zone (16) of the check valve element [~~(5)~~] into lodged position in openings (17) formed in [~~the closing zone~~] (13) of the oblique grid (11) [~~of the outer housing (3)~~].

5. (Amended) The assembly as defined in **claim [1] 15** wherein the outer housing (3) has a surrounding rim (14) with a clamping connection means (18) for fastening to [~~opposite elements (19) of a~~] the surrounding rim [~~(20)~~] (7) of the inner frame (4).

6. (Amended) The assembly as defined in **claim [2] 3** wherein the outer housing (3) has a surrounding rim (14) and a surrounding wall (21) on the end of which is formed [~~this~~] the oblique grid (11).

7. (Amended) The assembly as defined in **claim [1] 6** wherein the surrounding wall (21) has an upper side provided with at least one springy tongue (22, 22') directed toward the support (2) and functioning as the clip connection (6).

8. (Amended) The assembly as defined in **claim 7** wherein the at least one springy tongue (22) is carried by [~~arranged in a pocket-like open zone (23) of~~] the surrounding wall (21).

9. (Amended) The assembly as defined in **claim 8** wherein the surrounding rim (14) of [~~tie~~] the outer housing (3) has a surrounding groove (24) directed toward the at least one springy tongue (22), said groove (24) carrying a sealing ring (25).

10. (Amended) The assembly as defined in **claim [1] 15** wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3).

11. (Amended) The assembly as defined in **claim 10** wherein the springy tongue (22') is [~~arranged~~] carried on a locking element (30) which [~~can be~~] is connected with the outer housing (3).

12. Canceled.

13. (Amended) The assembly as defined in **claim [12] 16** wherein the [~~locking element (30) has a gripping edge (33) which is arranged on the~~] springy tongue (22') has a gripping edge (33) which [~~and~~] engages a stop surface (32) on the outer housing (3).

14. (Amended) The assembly as defined in **claim 13** wherein the springy tongue (22') [~~lies in the middle zone of~~] is centrally located on the locking element (30) [~~between the surfaces of the dovetail guide (31)~~].

15. In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising an outer housing to which an inner frame is connected with a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer

housing (3), and the check valve {5} is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3); and,

wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9).

16. In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising an outer housing to which an inner frame is connected with a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve {(5)} is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3); and,

wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3), said springy tongue (22') being arranged on a locking element (30) which can be connected with the outer housing (3), and said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3).

**Appendix 4**

Claims 4 and 15 after examiner's amendment  
in original application (matter in **bold** and {braces} added)  
(matter underlined added by examiner  
matter in strikeout deleted by examiner)

4. (Amended) The assembly as defined in **claim 3** wherein the end surfaces (**12**) carry pins (**16**) spaced from one another and penetrating through a rim zone (**16**) of the check valve element into lodged position in openings (**17**) formed in ~~(13)~~ of the oblique grid (**11**).

15. In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising an outer housing to which an inner frame is connected with a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (**4**) is received into an open end of the outer housing (**3**) and the assembled unit comprising the inner frame (**4**), the outer housing (**3**), and the check valve element {**5**} is joined to a support (**2**) of the motor vehicle through a resilient clip connection (**6**) carried on the outer housing (**3**); and,  
wherein the inner frame (**4**) has a surrounding rim (**7**) carrying rib members (**8**) spaced transversely with stays (**9**) extending therefrom and a surrounding frame (**10**) joining the stays (**9**).

### Appendix 5

Claims as they appear in U.S. Patent 5,105,731

1. (application claim 15 prior to re-numbering) In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising an outer housing to which an inner frame is connected with a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve element {5} is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3); and,

wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9).

2. (application claim 3 prior to re-numbering) The assembly as defined in **claim 15** wherein an oblique grid (11) is arranged on the outer housing (3) and end surfaces (12) of the surrounding frame (10) of the inner frame (4) and a closing zone (13) of the oblique grid (11) form the clamp for the check valve element.

3. (application claim 4 prior to re-numbering) The assembly as defined in **claim 2** wherein the end surfaces (12) carry pins (16) spaced from one another and penetrating through a rim zone (16) of the check valve element into lodged position in openings (17) formed in the oblique grid (11).

4. (application claim 5 prior to re-numbering) The assembly as defined in **claim 15** wherein the outer housing (3) has a surrounding rim (14) with a clamping connection means (18) for fastening to the surrounding rim (7) of the inner frame (4).

5. (application claim 6 prior to re-numbering) The assembly as defined in **claim 2** wherein the outer housing (3) has a surrounding rim (14) and a surrounding wall (21) on the end of which is formed the oblique grid (11).

6. (application claim 7 prior to re-numbering) The assembly as defined in **claim 5** wherein the surrounding wall (21) has an upper side provided with at least one springy tongue (22, 22') directed toward the support (2) and functioning as the clip connection (6).

7. (application claim 8 prior to re-numbering) The assembly as defined in **claim 6** wherein the at least one springy tongue (22) is carried by the surrounding wall (21).

8. (application claim 9 prior to re-numbering) The assembly as defined in **claim 8** wherein the surrounding rim (14) of the outer housing (3) has a surrounding groove (24) directed toward the at least one springy tongue (22), said groove (24) carrying a sealing ring (25).

9. (application claim 10 prior to re-numbering) The assembly as defined in **claim 15** wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3).

10. (application claim 11 prior to re-numbering) The assembly as defined in **claim 9** wherein the springy tongue (22') is carried on a locking element (30) which is connected with the outer housing (3).

11. (application claim 16 prior to re-numbering) In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising an outer housing to which an inner frame is connected with a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve {(5)} is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3); and,

wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3), said springy tongue (22') being arranged on a locking element (30) which can be connected with the outer housing (3), and said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3).

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12. (application claim 13 prior to re-numbering) The assembly as defined in **claim 11** wherein the springy tongue (**22'**) has a gripping edge (**33**) which engages a stop surface (**32**) on the outer housing (**3**).

13. (application claim 14 prior to re-numbering) The assembly as defined in **claim 12** wherein the springy tongue (**22'**) is centrally located on the locking element (**30**).

**Appendix 6**  
Claims 14 and 16 on appeal

14. A check valve assembly adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising:  
    an outer housing having an open end and a surrounding wall;  
    an inner frame received in the open end;  
    a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and,  
    first and second resilient clip connections joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle,  
    the first clip connection comprising a first springy tongue spaced from the wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall.

16. A check valve assembly adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising:  
    an outer housing having an open end;  
    an inner frame received in the open end;  
    a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and,  
    a resilient clip connection formed separate from the outer housing and carried on a locking element which is connected with the outer housing the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle.

### Appendix 7

The court in Clement, 131 F.3d at 1468-70, 45 USPQ2d at 1163-65 stated that

[a]n attorney's failure to appreciate the full scope of the invention qualifies as an error under section 251 and is correctable by reissue. In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 370-71 (Fed. Cir. 1984). Nevertheless, "deliberate withdrawal or amendment . . . cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251." Haliczer v. United States, . . . 356 F.2d 541, 545, 148 USPQ 565, 569 ([Ct. Cl.] 1966). The recapture rule, therefore, prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims. See Mentor, 998 F.2d at 995, 27 USPQ2d at 1524. Under this rule, claims that are "broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution" are impermissible. Id. at 996, 27 USPQ2d at 1525.

The first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect. Clement argues that the board focused too much on the specific limitations that were omitted from the reissue claims. Although the scope of the claims is the proper inquiry, In re Richman, . . . 409 F.2d 269, 274, 161 USPQ 359, 362 (CCPA 1969), claim language, including limitations, defines claim scope. Abtox, Inc. v. Exitron Corp., 122 F.3d 1019, 1023, 43 USPQ2d 1545, 1548 (Fed. Cir. 1997); Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 619, 34 USPQ2d 1816, 1819 (Fed. Cir. 1995) ("[T]he language of the claim defines the scope of the protected invention."). Under Mentor, courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation. The board did not err by determining which limitations Clement deleted from the patent claims.

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

Although the recapture rule does not apply in the absence of evidence that the applicant's amendment was "an admission that the scope of that claim was not in fact patentable," Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984), "the court may draw inferences from changes in claim scope when other reliable evidence of the patentee's intent is not available," Ball, 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 applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary. . . . 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).

Once we determine that an applicant has surrendered the subject matter of the canceled or amended claim, we then determine whether the surrendered subject matter has crept into the reissue claim. Comparing the reissue claim with the canceled claim is one way to do this. In re Wadlinger, 496 F.2d 1200, 1204, 181 USPQ 826, 830 (CCPA 1974); Richman, 409 F.2d at 274, 161 USPQ at 362. If the scope of the reissue claim is the same as or broader than that of the canceled claim, then the patentee is clearly attempting to recapture surrendered subject matter and the reissue claim is, therefore, unallowable. Ball, 729 F.2d at 1436, 221 USPQ at 295 ("The recapture rule bars the patentee from acquiring, through reissue, claims that are the same or of broader scope than those claims that were canceled from the

original application.") (emphasis omitted); Byers, 230 F.2d at 456, 109 USPQ at 56. In contrast, a reissue claim narrower in scope escapes the recapture rule entirely. Ball, 729 F.2d at 1436, 221 USPQ at 295.

Some reissue claims, however, are broader than the canceled claim in some aspects, but narrower in others. In Mentor, for example, the issued claim, which was directed to a condom catheter, recited an adhesive means that was transferred from an outer to an inner surface without turning the condom inside-out. 998 F.2d at 993, 27 USPQ2d at 1523. The issued claim also recited, inter alia, that the condom catheter included a "thin cylindrical sheath member of resilient material rolled outwardly upon itself to form consecutively larger rolls . . . ." One canceled claim recited an adhesive means between the rolls, but did not specify that the adhesive was transferred from the outer to the inner surface without turning the condom inside-out. Another canceled claim recited that adhesive was transferred from the outer to the inner surface, but did not specify that this operation was done without turning the condom inside-out. The prior art rejections focused on the obviousness of the adhesive means positioned between the rolls and the process of transferring adhesive to the inner surface of the condom.

In making amendments to the claim, the applicant argued that "none of the references relied upon actually showed the transfer of adhesive from the outer surface to the inner surface as the sheath is rolled up and then unrolled." Id. at 995-96, 998 F.2d 992, 27 USPQ2d at 1524-25 (emphasis in original). The reissue claim eliminated the limitation that adhesive was transferred from the outer to the inner layer, and was, therefore, broader in this aspect. The reissue claim was also narrower than the canceled claim because it recited that the catheter included "a thin, flexible cylindrical member of resilient material rolled outwardly upon itself to form a single roll. . . ." (Emphasis added). We held that, although the "flexible" and "single roll" limitations made the reissue claim narrower than both the canceled and issued claims, it did not escape the recapture rule because these limitations did not "materially narrow the claim[]." Id. at 996-97, 27 USPQ2d at 1525-26.

Similarly, in Ball, the issued claim recited "a plurality of feedlines" and a "substantially cylindrical conductor." 729 F.2d at 1432-33, 221 USPQ at 291-92. The canceled claim recited "feed means includ[ing] at least one conductive lead," and a "substantially cylindrical conductor." The prosecution history showed that the patentee added the "plurality of feedlines" limitation in an effort to overcome prior art, but the cylindrical configuration limitation was neither added in an effort to overcome a prior art rejection, nor argued to distinguish the claims from a reference. Id. The reissue claim included limitations not present in the canceled claims that related to the feed means element, but allowed for multiple feedlines. On balance, the claim was narrower than the canceled claim with respect to the feed means aspect. The reissue claim also deleted the cylindrical configuration limitation, which made the claim broader with respect to the configuration of the conductor. Id. at 1437, 729 F.2d 1429, 221 USPQ at 295. We allowed the reissue claim because the patentee was not attempting to recapture surrendered subject matter. Id. at 1438, 729 F.2d 1429, 221 USPQ at 296.

In both Mentor and Ball, the relevance of the prior art rejection to the aspects narrowed in the reissue claim was an important factor in our analysis. From the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. Mentor is an example of (3)(a); Ball is an example of (3)(b).

### Appendix 8

The purpose of the reissue recapture rule was expressed by Justice Bradley for the court, in Leggett, 101 U.S. at 259-60 as follows:

It is obvious, on inspection, that the first and second of these claims are for substantially the same inventions which were disclaimed before the extension, and are for different inventions from that which was included in and secured by the letters-patent as extended. The court below deemed this, amongst other things, a fatal objection to the validity of the reissued letters-patent. We agree with the Circuit Court. We think it was a manifest error of the commissioner, in the reissue, to allow to the patentee a claim for an invention different from that which was described in the surrendered letters, and which he had thus expressly disclaimed. The pretence that an 'error had arisen by inadvertence, accident, or mistake,' within the meaning of the patent law, was too bald for consideration. The very question of the validity of these claims had just been considered and decided with the acquiescence and the express disclaimer of the patentee. If, in any case, where an applicant for letters-patent, in order to obtain the issue thereof, disclaims a particular invention, or acquiesces in the rejection of a claim thereto, a reissue containing such claim is valid (which we greatly doubt), it certainly cannot be sustained in this case. The allowance of claims once formally abandoned by the applicant, in order to get his letters-patent through, is the occasion of immense frauds against the public. It not unfrequently happens that, after an application has been carefully examined and compared with previous inventions, and after the claims which such an examination renders admissible have been settled with the acquiescence of the applicant, he, or his assignee, when the investigation is forgotten and perhaps new officers have been appointed, comes back to the Patent Office, and, under the pretence of inadvertence and mistake in the first specification, gets inserted into reissued letters all that had been previously rejected. In this manner, without an appeal, he gets the first decision of the office reversed, steals a march on the public, and on

those who before opposed his pretensions (if, indeed, the latter have not been silenced by purchase), and procures a valuable monopoly to which he has not the slightest title. We have more than once expressed our disapprobation of this practice. As before remarked, we consider it extremely doubtful whether reissued letters can be sustained in any case where they contain claims that have once been formally disclaimed by the patentee, or rejected with his acquiescence, and he has consented to such rejection in order to obtain his letters-patent. Under such circumstances, the rejection of the claim can in no just sense be regarded as a matter of inadvertence or mistake. Even though it was such, the applicant should seem to be estopped from setting it up on an application for a reissue.

In Dobson, 137 U.S. at 265-66, the Supreme Court stated:

A reissue is an amendment, and cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident, or mistake, (Rev. St. § 4916;) hence the reissue cannot be permitted to enlarge the claims of the original patent by including matter once intentionally omitted. Acquiescence in the rejection of a claim, its withdrawal by amendment, either to save the application or to escape an interference, the acceptance of a patent containing limitations imposed by the patent-office, which narrow the scope of the invention as at first described and claimed, are instances of such omission. [Citations omitted]. It is clear that the claim of this reissue is not covered by the original patent, and it appears that, before the issue of the latter, it was passed upon and rejected, was withdrawn and erased, an interference was dissolved upon condition of the amendment, and the issue of the original letters was predicated upon its abandonment. There is no room for the contention that there was any inadvertence, accident, or mistake in the premises. Nor, in the light of these protracted proceedings in the patent-office, can the applicant be permitted to treat the deliberate acts of his attorney as the result of inadvertence, accident, or mistake. The repeated official decisions and orders, and the repeated efforts to maintain this claim without success, during this long struggle, indicate anything but negligence or inadvertence on the part of the solicitors employed.

Byers, 230 F.2d at 454-56, 109 USPQ at 55-56, stated that

[t]he issue to be determined in here is whether the failure to obtain, in the patent sought to be reissued, claims corresponding to those involved in the present appeal was due to "error" within the meaning of the sentence just quoted [35 U.S.C. § 251, first paragraph]. The use of the word "error" in that sentence instead of the words "inadvertence, accident or mistake," which appeared in the corresponding section, 35 U.S.C. § 64, Section 4916 R.S., of the patent statutes prior to the recodification of 1952, does not involve a substantive change, and the same type of error is necessary to justify a reissue after the enactment of the Patent Act of 1952 as before. [Citations omitted]. Accordingly, decisions as to what constituted inadvertence, accident or mistake under the prior law are pertinent here.

. . . .

Original claim 20 was amended by substituting "coplanar" for flat and by including a further limitation that the cavity was approximately one-third of the diameter of the base and, as so amended, it was allowed. While claim 20 was not technically canceled, the amendment of that claim by the inclusion of an additional limitation had exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation. So far as the right to reissue the patent is concerned, therefore, the case is to be treated as if original claim 20 had been canceled and replaced by the claim on which the patent was granted.

While the record does not show the specific circumstances under which claim 20 was amended, it was stated by the Board of Appeals that such action was a "deliberate amending of claim 20 to secure the patent" and, in the absence of any showing to the contrary, that statement will be accepted as accurate. [Citations omitted]. Moreover, the board's statement is in accord with that in the appellant's brief that the examiner agreed to allow the claim of appellant's patent "only on condition that this claim be amended to recite not only

the three-to-one relationship between the cavity and the base, but also the specific definition of the cone angles." It is clear, therefore, that the appellant deliberately relinquished claim 20 as it originally stood, in order to obtain the patent.

It is well settled that the deliberate withdrawal or amendment of a claim in order to obtain a patent does not involve inadvertence, accident or mistake and is not an error of the kind which will justify a reissue of the patent including the matter withdrawn. . . .

. . . .

It is evident that since the deliberate cancellation of a claim in order to obtain a patent constitutes a bar to the obtaining of the same claim by reissue, it necessarily also constitutes a bar to the obtaining of a claim which differs from that canceled only in being broader.

Ex parte Feissel, 131 USPQ 252, 254 (Bd. App. 1960)

provided that

[u]pon careful consideration of the issues involved, we do not agree with the examiner as to the instant rejection. We do not have here before us a situation falling strictly within the general rule that where a claim in a first application is deliberately cancelled or restricted in response to a rejection thereof on prior art, the cancelled claim or a claim merely without the restrictive amendment that was added cannot be obtained in a reissue. Nor does the instant situation involve a claim in a reissue application which differs from that cancelled in the first application only in being broader, which would be barred as denoted in *In re Byers*, 43 CCPA 803, 109 USPQ 53, 230 F.2d 451, 1956 C.D. 183, 705 O.G. 444. Here, in the original application, the claim which was in effect first cancelled contained neither the amplifier limitation nor the further limitation referred to by the examiner, while the claim that was later cancelled contained only the amplifier limitation. There was no cancellation in that application of any claim of the scope of that here before us on appeal, namely, containing only said further limitation but not the

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amplifier limitation. Viewing the claims here involved in their entirety, as we must, rather than in their disjointed parts, it is apparent that claims of the particular scope of those at bar were never presented and asked for in the original application, and there abandoned by appellant upon a refusal thereof.

In In re Willingham, 282 F.2d at 356-57, 127 USPQ at 215-16, the court found that the reissue claims, while broader in scope than allowed claim 15, were somewhat narrower in scope than deleted claim 12. The court then stated that

[t]he deliberate cancellation of a claim of an original application in order to secure a patent cannot ordinarily be said to be an "error" and will in most cases prevent the applicant from obtaining the cancelled claim by reissue. The extent to which it may also prevent him from obtaining other claims differing in form or substance from that cancelled necessarily depends upon the facts in each case and particularly on the reasons for the cancellation.

In the instant case, the reasons for the deletion of claim 12 of the original application do not appear of record, and we may not properly speculate as to what they may have been and base our decision on the results of such speculation. The appealed claims differ materially from cancelled claim 12 and there is nothing of record on which to base a holding that the cancellation of claim 12 was in any sense an admission that the reissue claims on appeal were not in fact patentable to appellant at the time claim 12 was deleted.

Id. at 357, 127 USPQ at 215-16.

The court in Wessler reversed a rejection under 35 U.S.C. § 251 wherein the claims presented on appeal defined patentable subject matter and were narrower in scope than the cancelled claims in the application which resulted in the appellant's patent but

were broader than the patent claims. The court noted (id. at 849, 151 USPQ at 348) that since there is no objection to the appealed claims based on the prior art, they did not think the statement in Shepard,<sup>42</sup> arising from the facts therein stated, is applicable here. The court then stated that Shepard may be support for the rule that "one who deliberately adds a limitation to avoid the prior art cannot omit that limitation in reissue claims so as to encroach upon the prior art, but that is not the situation here as the board's opinions clearly point out." Lastly, the court found (id. at 850, 151 USPQ at 349) as a factual matter that a mistake occurred in the prosecution of the patent application. That mistake was in not then presenting the appealed claims with the result that the appellant's patent claimed less than he had the right to claim. The court also found that the record establishes that the appellant erroneously considered he was securing protection commensurate with the invention disclosed in the original application. There was no evidence that the appellant

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<sup>42</sup> Shepard v. Carrigan, 116 U.S. 593, 597 (1886) states that  
[w]here an applicant for a patent to cover  
a new combination is compelled by the  
rejection of his application by the patent-  
office to narrow his claim by the  
introduction of a new element, he cannot  
after the issue of the patent broaden his  
claim by dropping the element which he was  
compelled to include in order to secure his  
patent.

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intentionally omitted or abandoned the claimed subject matter. Thus, the court found that while appellant acted "deliberately" he did so in error. This error, in view of the facts of record, was held to be an "error without any deceptive intention" which entitled the appellant to secure a reissue of his patent under the provisions of 35 U.S.C. § 251.

The court in In re Richman, 409 F.2d 269, 161 USPQ 359, (CCPA 1969) reversed a rejection under 35 U.S.C. § 251 wherein the claims rejected were narrower in scope than the cancelled claims in the application which resulted in the appellant's patent but were broader than the patent claims. The court set forth (id. at 274, 161 USPQ at 362) that the recapture question raised in the appeal was whether the appealed claims are of the same scope as the cancelled claims, not whether they lack some specific recitation absent from the cancelled claims but included in the patent claims. The court stated (id. at 274-75, 161 USPQ at 363) that

[w]e therefore find neither decision [Wesseler and Shepard] to be authority for the proposition that a limitation added to a claim in obtaining its allowance cannot be broadened, under present statutory law, by reissue if the limitation turns out to be more restrictive than the prior art required. Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.

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The court in Wadlinger, 496 F.2d at 1207-08, 181 USPQ at 832 stated that

in its decisions both before and after Wesseler, has made it clear that a reissue applicant is, at most, prevented by interpretations of the language of § 251, and its predecessor statute R.S. 4916, from obtaining claims which are of the same scope as the claims previously cancelled in the original application. As for obtaining claims on reissue which are different, no prohibition arises merely because of the language of the reissue statute. Still apropos and basic is our statement in Wesseler [151 USPQ at 348]:

We think the term "error," arising as it does in a remedial provision designed to advance both the rights of the public and the inventor, is to be interpreted as Congress has stated it, "error without any deceptive intention," and in light of Supreme Court decisions favoring the liberal construction of reissue statutes in order to secure to inventors protection for what they have actually invented.

See In re Richman, 409 F.2d 269, 56 CCPA 1083 [161 USPQ 359] (1969), holding there was "error without any deceptive intention" under § 251 where the reissue claims differed in scope from cancelled claims and also found, as in Wesseler, that "while appellant acted 'deliberately', he did so in error."

The court in Wadlinger reversed the rejection under 35 U.S.C. § 251 of claims which were narrower in scope than the cancelled claims in the application but were broader in scope than the patent claims.

The Federal Circuit first discussed the recapture rule in Ball, 729 F.2d at 1435-37, 221 USPQ at 293-95. The Court provided that

[r]eissue is not a substitute for Patent Office appeal procedures. Reissue is an extraordinary procedure and

must be adequately supported by the circumstances detailed in 35 U.S.C. § 251 (1976) and in the implementing regulations, 37 C.F.R. § 1.175 (1982). The Government asserts that the nature of error that will justify reissue is narrowly circumscribed to ensure that reissue remains the exception and not the rule. Relying on Edward Miller & Co. v. Bridgeport Brass Co., the Government contends that "a mere error of judgment" is not adequate to support reissue; rather the error must be "a real bona fide mistake, inadvertently committed."

The 1952 revision of the patent laws made no substantive change in the definition of error under section 251. While deliberate cancellation of a claim cannot ordinarily be considered error, the CCPA has repeatedly held that the deliberate cancellation of claims may constitute error, if it occurs without deceptive intent. In In re Petrow, the CCPA went so far as to state that error is sufficient where the deliberate cancellation of claims does not amount to an admission that the reissue claims were not patentable at the time the original claims were canceled. Similarly, in In re Wesseler, the CCPA stated that error is established where there is no evidence that the appellant intentionally omitted or abandoned the claimed subject matter. Thus, the CCPA has construed the term error under section 251 broadly.

The Ninth Circuit employed a more rigid standard in Riley v. Broadway-Hale Stores, Inc. stating: "when the chief element added by reissue has been abandoned while seeking the original patent, the reissue is void." The trial judge sought to determine whether Ball had made a deliberate judgment that claims of substantially the same scope as the new reissue claims would have been unpatentable. The Government, arguing from Riley, submits that the trial judge's approach loses sight of the feature given up by a patentee in order to secure the original patent. We decline to adopt the rigid standard applied in Riley, in favor of the more liberal approach taken by the CCPA. Petrow clearly establishes the vitality of the standard employed by the trial judge under this court's precedent.

Further, the Government argues that we need not reach the issue of claim scope because the sufficiency of error is a threshold issue. While claim scope is no oracle on intent, the Government fails to apprehend its role.

Rarely is evidence of the patentee's intent in canceling a claim presented. Thus, the court may draw inferences from changes in claim scope when other reliable evidence of the patentee's intent is not available. Claim scope is not the lodestar of reissue. Rather, the court's reliance on that indicator in the case law appears to be born of practical necessity as the only available reliable evidence.

The Government relies heavily on Haliczer v. United States, which also involved a suit under 28 U.S.C. § 1498. The Court of Claims in that case held the reissue claims invalid because the patentee sought to acquire through reissue the same claims that had earlier been canceled from the original application. The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were canceled from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are narrower in scope than the canceled claims. If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after grant of the original patent.

Thus, the applicability of the recapture rule and the sufficiency of error under section 251 turn in this case, in the absence of other evidence of the patentee's intent, on the similarity between the reissue and the canceled claims. Narrower reissue claims are allowable; broader reissue claims or reissue claims of the same scope as the canceled claims are not. The subject matter of the claims is not alone controlling. Similarly, the focus is not, as the Government contends, on the specific limitations or on the elements of the claims but, rather, on the scope of the claims.

#### Ball's Reissue Claims

The trial judge required the Government to establish that the applicant has made a deliberate decision that the canceled claims are unpatentable. The Government argues that that standard is not correct because it loses sight of the feature that the patentee gave up during prosecution of the original application. We find the Government's argument entirely unpersuasive. The proper focus is on the scope of the claims, not on the

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individual feature or element purportedly given up during prosecution of the original application. The trial judge quite properly focused on the scope of the claims and we find no error in this respect. He determined that the reissue claims were intermediate in scope -- broader than the claims of the original patent yet narrower than the canceled claims. [Footnotes omitted]

The Court in Ball found (729 F.2d at 1438, 221 USPQ at 296) that the reissue claims (which were broader than the canceled claims in one respect and narrower than the canceled claims in some respects) were valid. Specifically, the Court found that the non-material, broader aspects of Ball's reissue claims do not deprive them of their fundamental narrowness of scope relative to the canceled claims. Thus, the reissue claims were sufficiently narrower than the canceled claims to avoid the effect of the recapture rule.

The court in Whittaker, 911 F.2d at 713, 15 USPQ2d at 1745 stated:

Since we hold that the claims of the reissue patent are narrower in scope than the cancelled original claims of the application that resulted in the '882 patent, the '453 patent cannot be held invalid under the recapture rule as described in Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984) ("the patentee is free to acquire, through reissue, claims that are narrower in scope than the canceled claims." (emphasis in original))

The court in Mentor, 998 F.2d at 995, 27 USPQ2d at 1524 stated that

[r]eissue "error" is generally liberally construed, and we have recognized that "[a]n attorney's failure to appreciate the full scope of the invention" is not an

uncommon defect in claiming an invention. In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 . . . (1985). However, the reissue procedure does not give the patentee "a second opportunity to prosecute de novo his original application," In re Weiler, 790 F.2d 1576, 1582, 229 USPQ 673, 677 (Fed. Cir. 1986).

The deliberate cancellation of a claim of an original application in order to secure a patent cannot ordinarily be said to be an "error" and will in most cases prevent the applicant from obtaining the cancelled claim by reissue. The extent to which it may also prevent him from obtaining other claims differing in form or substance from that cancelled necessarily depends upon the facts in each case and particularly on the reasons for the cancellation.

In re Willingham, 282 F.2d 353, 357, 127 USPQ 211, 215 (CCPA 1960).

If a patentee tries to recapture what he or she 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 matter withdrawn." Haliczer v. United States, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966). "The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were cancelled from the original application." Ball Corp., 729 F.2d at 1436, 221 USPQ at 295 (citations omitted).

The reissue claims before the court in Mentor were narrower in some respects than the canceled claims and broader in others respects than the canceled claims. The court in Mentor asserted (998 F.2d at 996, 27 USPQ2d at 1525) that reissue claims that are broader in certain respects and narrower in others than the surrendered

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subject matter may avoid the effect of the recapture rule; thus, if a reissue claim is broader in a way that does not attempt to reclaim what was surrendered earlier, the recapture rule may not apply. The court in Mentor held that the reissue claims did not avoid the recapture rule since

the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up. Moreover, the added limitations do not narrow the claims in any material respect compared with their broadening.

Id.

### Appendix 9

The court in Clement, 131 F.3d at 1470-71, 45 USPQ2d at 1165-66, held that reissue claim 49 was both broader and narrower in areas relevant to the prior art rejections.<sup>43</sup> Comparing reissue claim 49 with claim 42 before the May 1988 and June 1987 amendments, the court found that claim 49 was narrower in one area, namely, the brightness is "at least 59 ISO in the final pulp." This narrowing related to a prior art rejection because, during the prosecution of the '179 patent, Clement added this brightness limitation in an effort to overcome Burns. The court's comparison also revealed that reissue claim 49 was broader in that it eliminates the room temperature and specific energy limitations of step (a), and the temperature, specific energy, and pH values of steps (c) and (d). This broadening directly related to several prior art rejections because, in an effort to overcome Ortnier, Clement added to step (a) the limitation that it is carried out "at room temperature," and applies "specific mechanical energy lower than 50 KW.H/Ton to form a pumpable slurry." On balance, the court

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<sup>43</sup> As such, claim 49 does not fall into either Clement's principle (3)(a) or principle (3)(b). Claim 49 does fall into principle (3) of Clement wherein the reissue claims are broader than the surrendered subject matter in some aspects, but narrower than the surrendered subject matter in others, thus requiring the broadening aspects of the reissue claims to be balanced against the narrowing aspects of the reissue claims to determine if the recapture rule bars the claims.

held that reissue claim 49 was broader than it was narrower in a manner directly pertinent to the subject matter that Clement surrendered throughout the prosecution and accordingly the court affirmed the board's decision to sustain the examiner's rejection of claim 49 under 35 U.S.C. § 251 based on the recapture rule.

The court in Hester, 142 F.3d at 1479-84, 46 USPQ2d at 1647-51 provided:

In considering the "error" requirement, we keep in mind that the reissue statute is "based on fundamental principles of equity and fairness, and should be construed liberally." In re Weiler, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986). We also keep in mind that "not every event or circumstance that might be labeled 'error' is correctable by reissue." Id. Indeed, the reissue procedure does not give the patentee the right "to prosecute de novo his original application." Id. at 1582, 790 F.2d 1576, 229 USPQ at 677; see also Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993).

One of the most commonly asserted "errors" in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original patent application. See Amos, 953 F.2d at 616, 21 USPQ2d at 1273; In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the "error" requirement of § 251. See Clement, 131 F.3d at 1468, 45 USPQ2d at 1163; Wilder, 736 F.2d at 1519, 222 USPQ at 371. Williams asserted this form of error as the basis for his reissue applications, and the Patent Office accepted his assertion as adequate.

However, the district court concluded that there was no such error by Williams' attorney. Hester, 963 F. Supp. at 1411. In reaching this conclusion, the court was particularly persuaded by the prosecution history of the original patent. The court concluded that the attorney's repeated attempts to distinguish Williams'

invention on the basis of the "solely with steam" and "two sources of steam" limitations belied Williams' assertion that his attorney failed to appreciate the full scope of his invention. Id. at 1409-11. The court also determined that there was no other form of § 251 "error" and thus held the asserted reissue claims invalid. Id. at 1411-12.

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We share the district court's discomfort with Williams' attempt to remove, through reissue, the "solely with steam" and "two sources of steam" limitations after having relied so heavily on those limitations to obtain allowance of the original patent claims over the prior art. This concern is addressed most squarely by the "recapture rule," recently discussed at length in Clement, 131 F.3d 1464, 45 USPQ2d 1161. The recapture rule "prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims." Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The rule is rooted in the "error" requirement in that such a surrender is not the type of correctable "error" contemplated by the reissue statute. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1525.

In its motion for summary judgment, Stein presented the recapture rule as one basis for finding the asserted reissue claims invalid, and Stein repeats this argument on appeal as one basis for affirming the summary judgment of invalidity. While the district court did not explicitly rule on this ground, its opinion indicates the view that Hester, through the reissue patents, recaptured surrendered subject matter. Hester, 963 F. Supp. at 1412 (stating that through the reissues, Hester obtained claims covering "ovens with characteristics repeatedly distinguished and disclaimed in the PTO" and that was contrary to the "error" requirement of § 251). As will be next explained, we conclude that the asserted reissue claims violate the recapture rule and that the summary judgment ruling is appropriately affirmed on this ground.

"Under [the recapture] rule, claims that are 'broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution' are impermissible." Clement, 131 F.3d at 1468, 45 USPQ2d at 1164 (quoting Mentor, 998 F.2d at 996,

27 USPQ2d at 1525). Application of the recapture rule begins with a determination of whether and in what respect the reissue claims are broader than the original patent claims. See id. A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. See id. Here, it is undisputed that the asserted reissue claims are broader than the original patent claims in that the reissue claims do not include the "solely with steam" and "two sources of steam" limitations found in each of the original patent claims.

Having determined that the reissue claims are broader in these respects, under the recapture rule we next examine whether these broader aspects relate to surrendered subject matter. See id. at 1468-69, 131 F.3d 1464, 45 USPQ2d at 1164. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection." Id. at 1469, 131 F.3d 1464, 45 USPQ2d at 1164 (emphasis added). This statement in Clement indicates that a surrender can occur by way of arguments or claim changes made during the prosecution of the original patent application. To date, the cases in which this court has found an impermissible recapture have involved claim amendments or cancellations. See, e.g., id. at 1469-70, 131 F.3d 1464, 45 USPQ2d at 1164-65; Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25. However, in addition to the suggestion in Clement that argument alone can effect a surrender, this court expressly left open that possibility in Ball Corp. v. United States: "If reissue is sought where claims have not been previously canceled, analysis becomes more difficult. In that case relative claim scope is not available to illuminate the alleged error. We are not faced with that situation in this proceeding." 729 F.2d 1429, 1436 n.19, 221 USPQ 289, 295 n.19 (Fed. Cir. 1984). Prior to this case, this court has not squarely addressed the question.

. . . .

Thus we conclude that, in a proper case, a surrender can occur through arguments alone. We next evaluate whether such a surrender occurred here with respect to the "solely with steam" and "two sources of steam"

limitations, the pertinent aspects in which the asserted reissue claims are broader than the original patent claims. The obvious conclusion is that there has been a surrender.

. . . .

Having concluded that there has been a surrender, we must next determine whether the surrendered subject matter has crept back into the asserted reissue claims. See Clement, 131 F.3d at 1469, 45 USPQ2d at 1164. When the surrender occurs by way of claim amendment or cancellation, "[c]omparing the reissue claim with the canceled claim is one way to do this." See id. This analysis is not available when the surrender is made by way of argument alone. Instead, in this case, we simply analyze the asserted reissue claims to determine if they were obtained in a manner contrary to the arguments on which the surrender is based.

Clearly they were. None of the asserted reissue claims include either the "solely with steam" limitation or the "two sources of steam" limitation. Thus, this 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. The asserted reissue claims are unmistakably broader in these respects.

Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. See, e.g., Mentor, 998 F.2d at 996, 27 USPQ2d at 1525 ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule."); Clement, 131 F.3d at 1470, 45 USPQ2d at 1165. For example, in Ball the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 USPQ at 296. In the context of a surrender by way of argument, this principle, in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

However, this is not such a case. The asserted reissue claims are not materially narrower, despite Hester's arguments to the contrary. Hester argues that the claims are materially narrower by the addition of the "spiral conveyance path" and "high humidity steam" limitations. The term "high humidity steam" is included in each of the asserted reissue claims except reissue claim 30 of the '259 reissue patent. However, the term "high humidity steam" is actually the same as or broader than the limitation in original claim 1 that this term replaced. Original claim 1 specifies a steam atmosphere "at near 100% humidity 100° C and a pressure above atmospheric." '047 patent, col. 6, ll. 3-4. Hester concedes that the term "high humidity steam" is not narrower than this limitation in original claim 1. In fact, with respect to the claim construction issue, Hester argues that the limitation in original claim 1 is but one example of "high humidity steam." Accordingly, the use of the term "high humidity steam" does not save the reissue claims from the recapture rule.

The term "spiral conveyance path" is also not materially limiting. This term appears explicitly in asserted reissue claims 28, 32, 75, and 76 of the '259 reissue patent; it does not appear explicitly in the other reissue claims asserted. Original claim 1 includes a corresponding limitation, namely, "means passing said conveyor belt through said housing. . . ." This is a so-called means-plus-function clause drafted pursuant to 35 U.S.C. § 112 ¶ 6 (1994). [Footnote omitted]. According to § 112 ¶ 6, the clause is to be construed to "cover the corresponding structure . . . described in the specification and equivalents thereof." The only corresponding structure described in the specification (more properly, the written description of the patent) passes the conveyor belt through a spiral path. See '047 patent, col. 4, l. 64 to col. 5, l. 8. Thus, the explicit recitation of a "spiral conveyance path" in some of the asserted reissue claims does not materially narrow those claims. Indeed, Hester does not explain how the explicit recitation of a spiral conveyance path--which is present in prior art cookers cited by the examiner during the prosecution of the original patent--materially narrows these claims. In sum, neither alone nor together do the terms "high humidity steam" and "spiral conveyance path" materially narrow the claims.

Furthermore, the "spiral conveyance path" and "high humidity steam" limitations are not aspects of the invention that were overlooked during prosecution of the original patent. To the contrary, as just explained, these aspects were included in original claim 1. Additionally, with regard to the "spiral conveyance path" limitation, original dependent claim 12 explicitly recites "a spiral path." '047 patent, col. 6, l. 60. In prosecuting the original patent, Williams pointed out these features in an attempt to overcome the Examiner's obviousness rejection. Hester cannot now argue that Williams overlooked these aspects during the prosecution of the original patent application. In conclusion, this is not a case which involves the addition of material limitations that overcome the recapture rule.

In effect, Hester, through eight years of reissue proceedings, prosecuted Williams' original patent application anew, this time placing greater emphasis on aspects previously included in the original patent claims and removing limitations repeatedly relied upon to distinguish the prior art and described as "critical" and "very material" to the patentability of the invention. The reissue statute is to be construed liberally, but not that liberally. The realm of corrections contemplated within § 251 does not include recapturing surrendered subject matter, without the addition of materially-narrowing limitations, in an attempt to 'custom-fit' the reissue claims to a competitor's product.

No doubt if two patent attorneys are given the task of drafting patent claims for the same invention, the two attorneys will in all likelihood arrive at somewhat different claims of somewhat different scope. And such differences are even more likely when, as here, the second attorney drafts the new claims nearly a decade later and with the distinct advantage of having before him the exact product offered by the now accused infringer. This reality does not justify recapturing surrendered subject matter under the mantra of "failure to appreciate the scope of the invention." The circumstances of the case before us simply do not fit within the concept of "error" as contemplated by the reissue statute. See Mentor, 998 F.2d at 996, 27 USPQ2d at 1525 ("Error under the reissue statute does not include a deliberate decision to surrender specific

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subject matter in order to overcome prior art, a decision which in light of subsequent developments in the marketplace might be regretted.").

With respect to the recapture issue, there are no underlying material facts as to which there is a genuine issue in dispute. The original patent's prosecution history, on which we rely, is before us and undisputed. All that remains is the ultimate legal conclusion as to whether the asserted reissue claims fail to meet the "error" requirement because the claims impermissibly recapture surrendered subject matter. See id. at 994, 998 F.2d 992, 27 USPQ2d at 1524 (stating that whether the "error" requirement has been met is a legal conclusion). For the reasons explained above, we conclude as a matter of law that the asserted reissue claims fail in this regard. Summary judgment of invalidity of the asserted reissue claims under § 251 is called for. Accordingly, we affirm the district court's entry of summary judgment.

The court in Pannu, 258 F.3d at 1370-71, 59 USPQ2d at 1600, expressly endorses the process for applying the recapture rule set forth in Clement and Hester. Specifically, according to Pannu:

[t]he first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." Id. [citing to Clement, 131 F.3d at 1468, 45 USPQ2d at 1164]. "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." Id. [citing to Clement, 131 F.3d at 1468, 45 USPQ2d at 1164]. Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

Id. at 1371, 59 USPQ2d at 1600 (citations omitted). The Federal Circuit applied the test set forth in Clement in analyzing the facts in Pannu as follows.

Pannu's application was directed to an artificial intraocular lens comprising a round lens called an "optic" that focuses light on the retina, two or more elements called "haptics" that are attached to the optic, and "snag resistant" discs attached at the end of the haptics. In applying the first step of the test set forth in Clement to the facts therein, the Pannu court determined that reissue claim 1 was broader than patent claim 1 with respect to the shape of the haptics, in that the reissue claim eliminated the limitation that the haptics ("elements") define "a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference."

In order to determine whether the broader aspect of the reissue claim related to surrendered subject matter, the Federal Circuit in Pannu looked to the prosecution history of the original patent application. A review of the prosecution history revealed that original claims 1-14 presented in the patent application were rejected by the examiner as obvious under 35 U.S.C. § 103 in light of four prior art references. None of the original claims limited the shape of the haptics. In response to that rejection, Pannu filed an amendment canceling claims 1-7 and 10-14, adding new claims 16-22 and amending claims 8 and 9 to depend from claim 16.

Independent claim 16 recited the haptics (elements) as "defining a continuous substantially circular arc having a diameter greater than the diameter of the lens body, said arc curved toward said lens circumference." The examiner made amendments to claim 16 setting forth structural details of the haptics and the amended claim 16 issued as patent claim 1.<sup>44</sup> The Federal Circuit determined that

[t]he addition of the "continuous, substantially circular arc" limitation to claim 16 and the statements made by Pannu to the examiner during prosecution of the '855 patent limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc. The shape of the haptics was broadened during reissue and was the same subject matter that was surrendered during prosecution. [Pannu, 258 F.3d at 1371, 59 USPQ2d at 1600 (citations omitted)].

Accordingly, the Federal Circuit concluded that this broadened aspect of the reissue claim related to surrendered subject matter.

The reissue claims in Pannu were also narrower than both claim 16 in the patent application prior to the examiner's amendments and patent claim 1, in that the reissue claims changed the recitation that the length of the haptics was "substantially greater" than the width of the haptics to "at least three times greater" than the

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<sup>44</sup> This amendment results in originally presented claim 16 also being surrendered subject matter. See Clement, 131 F.3d at 1471, 45 USPQ2d at 1166 (applicant abandoned the subject matter of claim 42, as it existed before the examiner's amendment, because he allowed the examiner to amend it to obtain allowance and no other evidence suggested that there was no intent to abandon it).

width of the haptics and added the limitation that the snag resistant means must be "substantially coplanar" with the haptics. The Federal Circuit reasoned that, since the narrowing aspect of the claim was directed to the positioning and dimensions of the snag resistant means and not to the shape of the haptics (the broadened aspect), "the reissued claims were not narrowed in any material aspect compared with their broadening."<sup>45</sup> Pannu, 258 F.3d at 1372, 59 USPQ2d at 1600-01. The Federal Circuit added that "[f]urthermore, 'if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture.' Anderson v. Int'l Eng'g & Mfg., Inc., 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998)." Pannu, 258 F.3d at 1372, 59 USPQ2d at 1601. The court ended the decision by stating that "[o]n reissue, he [Pannu] is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections" (id.).

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<sup>45</sup> The district court in the Pannu case determined that the three times greater width limitation and coplanar limitation were contained in or similar to parallel terminology in originally filed claim 1 and remained in a dependent claim throughout prosecution of the patent and thus were not overlooked aspects of the original patent. Moreover, the change from substantially greater to three times greater was not a material alteration, according to the district court. Thus, the district court concluded that neither limitation materially narrowed the claim. Pannu v. Storz Instruments, Inc., 106 F. Supp. 2d 1304, 1308 (S.D. Fla. 2000).

A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was entered by the Board of Patent Appeals and Interferences on May 29, 2003 in Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003). In Eggert, the majority opinion applied the fact-specific analysis set forth in Clement and determined that under the facts and circumstances before it, the "surrendered subject matter" was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of Eggert were not precluded (i.e., barred) by the "recapture rule." 67 USPQ2d at 1730-33.

In North American Container, 415 F.3d at 1349-50, 75 USPQ2d at 1556-57, the court again followed the analytical process of Clement and found that the "recapture rule" applied. Specifically, the court stated:

Under the recapture rule, a patentee is precluded "from regaining the subject matter that he surrendered in an effort to obtain allowance of the original claims." *Id.* at 1370-71 [citing to Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001)] (citing In re Clement, 131 F.3d 1464, 1468 [45 USPQ2d 1161, 1164] (Fed. Cir. 1997)). When that has occurred, the patent is invalid. *Id.* at 1368. We apply the recapture rule as a three-step process: (1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims; (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and (3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the

claims may not have been enlarged, and hence avoid the recapture rule. Id. at 1371 (citations omitted).

NAC appeals from the district court's summary judgment holding reissue claims 29-42 invalid for violation of the recapture rule. According to NAC, the court improperly grounded its invalidity decision on the applicant's arguments and amendments in view of the prior art Dechenne patent and rendered an unduly narrow interpretation of the "generally convex" claim limitation. In doing so, NAC argues mainly that the court failed to give the patent examiner "the deference that is due to a qualified government agency presumed to have properly done its job." Appellant's Opening Br., at 50 (citing McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1353 [60 USPQ2d 1001] (Fed. Cir. 2001)). According to NAC, during the reissue proceedings, Plastipak submitted, and the patent examiner rejected, protests making the same recapture arguments that Plastipak made to the court.

Plastipak argues that the applicant violated the recapture rule by removing in the reissue proceedings the "generally convex" restriction from the "inner wall" limitation. According to Plastipak, the applicant amended his claims to add the "generally convex" limitation to the inner walls in order to overcome the Dechenne patent, which was "slightly concave." With respect to NAC's argument that the district court did not give the patent examiner due deference, Plastipak reasserts the court's position that the patent examiner misapplied the recapture rule, and thus any presumption that the examiner properly did his job was rebutted.

We agree that NAC violated the recapture rule, and thus the reissue claims are invalid. Applying our three-part test, we find that the reissue claims are broader in scope than the originally-issued claims in that they no longer require the "inner walls" to be "generally convex." Moreover, the broader aspect of the reissue claims relates to subject matter that was surrendered during prosecution of the original-filed claims. Indeed, during prosecution, the applicant conceded that the pending independent claims "have been amended to refer to the convex nature of the inner wall portions of the central re-entrant portion." '607 Application, Paper No. 6, at 10. The applicant even argued that the "shape of the base as now defined in the

claims differs from those of . . . the Dechenne patent, wherein the corresponding wall portions are slightly concave." Id. (emphasis added). Finally, the reissue claims were not narrowed with respect to the "inner wall" limitation, thus avoiding the recapture rule.

We reject NAC's argument that the district court did not give the patent examiner due deference in finding the reissue claims invalid. The examiner's basis for denying the protests filed against the reissue claims, i.e., that the claims "are considered to be of intermediate scope and the deleted language . . . directed to the convexity of the inner wall . . . are not considered to be critical limitations," demonstrates the examiner's inattention to the rule against recapture. '918 Application, Paper No. 29, at 4. For the reasons set forth above, the deleted language was critical in that it allowed the applicant to overcome the Dechenne reference. Moreover, that the reissue claims, looked at as a whole, may be of "intermediate scope" is irrelevant. As the district court recognized, the recapture rule is applied on a limitation-by-limitation basis, and the applicant's deletion of the "generally convex" limitation clearly broadened the "inner wall" limitation. Thus, reissue claims 29-42 are invalid for violating the rule against recapture.