

May 18, 2012

Practice Group:
**IP Procurement and
Portfolio
Management**

Federal Circuit Addresses Recapture Rule in Patent Reissue Proceedings

By Mark R. Leslie and Christopher G. Wolfe

In its May 8 opinion *In re Youman*¹, the U.S. Court of Appeals for the Federal Circuit bolstered the utility of reissue proceedings as a means to broaden the scope of claims of issued U.S. patents. The Federal Circuit adopted a restricted interpretation of the recapture rule as applied in reissue proceedings before the U.S. Patent and Trademark Office, thereby expanding the claim scope that potentially is available to a patent owner in a broadening reissue. On the heels of its March 5 decision *In re Staats*², *In re Youman* marks the second time this year that the Federal Circuit has ruled for a patent owner in the context of a broadening reissue.

The broadening of a claim in a reissue proceeding is limited by the recapture rule. The recapture rule prohibits a patentee from using a broadening reissue to regain claim scope that was relinquished during the original prosecution of the patent to obtain allowance. *In re Youman* helps to clarify those situations in which the broadening of a claim during reissue is permissible under the rule.

In re Youman involved an appeal from a decision of the Board of Patent Appeals and Interferences (Board) upholding a patent examiner's rejection of broadening reissue claims as violating the recapture rule. The patent at issue relates to an electronic program scheduling system allowing users to navigate and access television programs using a remote control. Original claim 1 of the patent application recited an electronic television programming guide (EPG) comprising:

... user control means ...; data processing means ...; a video display generator; and *selection means for allowing said user to select a title for display on said television receiver by selecting the first n characters of said title, where n is greater than or equal to one*; said data processing means being responsive to said selection means and adapted to select said plurality of television program titles for display on said television receiver in response to said n characters.

Original claim 1 was rejected over prior art during the original prosecution. Applicants then amended claim 1 claim to add the following limitation describing more narrowly the way that the selection means is used to select title characters:

... said selection means comprising means for causing each of said n characters to cycle forward and backward through a plurality of alphanumeric characters.

¹ *In re Roger Youman and Marney Morris*, No. 2011-1136 (Fed. Cir., May 8, 2012).

² *In re Erik P. Staats and Robin D. Lash*, No. 2010-1443 (Fed. Cir., March 5, 2012). See March 23, 2012 Alert titled "[The Federal Circuit Affirms the Use of Continuing Patent Applications to Extend the Statutory Broadening Reissue Period beyond Two Years.](#)"

Federal Circuit Addresses Recapture Rule in Patent Reissue Proceedings

The attorney representing the applicants included the following argument in the office action response distinguishing the amended form of claim 1 from a cited prior art reference disclosing a computer keyboard as the input device:

[T]he system disclosed in [the prior art reference] operates using a full keyboard. As such, it is a simple matter to type in the first few letters of an article title. In contrast, in an EPG [Electronic Program Guide] environment, the user control device is typically a handheld remote control transmitter with only a very limited number of keys. Therefore, in terms of performing searching based on alphanumeric characters, an EPG presents a problem not present in nor solved by systems such as that described in [the prior art reference]. Applicants solve this problem by using the existing keys on the remote control device to input characters of a program title. ... For example, as disclosed in applicants' specification, the up/down arrow keys used for changing channels in normal television mode may be used to cycle through the letters A-Z and the numbers 0-9 in order to choose the individual letters in a program title.

In response to the claim amendments and arguments, the Patent Office issued a Notice of Allowability, and the patent issued with the "cycle forward and backward" limitation quoted above recited in claim 1.

A reissue application was filed within two years of the patent issue date, adding new claims 24-55. In the declaration accompanying the reissue application, the applicant stated that the patent was "partly inoperative by reason of said patent claiming less than we had a right to claim in said patent." In response to a non-final rejection, the applicants amended claim 24 to read in pertinent part as follows:

An electronic television programming guide ... comprising:

a wireless remote control ...;

a data processor ...; and

a video display generator ...,

wherein a user may search for a title to be displayed by selecting n characters with the wireless remote control, where n is greater than one, wherein each of the n characters may be selected with the wireless remote control from a plurality of displayed alphanumeric characters *by changing from a first character to a second character using the nonalphanumeric keys.*

This amended form of claim 24 does not recite "cycle forward and backward" and, instead, recites the broader phrase "changing from a first character to a second character." The reissue examiner rejected the amended form of claim 24 as improperly recapturing subject matter surrendered during the original prosecution to obtain allowance. The Board subsequently affirmed the examiner's rejection of claim 24 as violating the recapture rule.

Federal Circuit Addresses Recapture Rule in Patent Reissue Proceedings

The Federal Circuit reversed the rejection and remanded the reissue application to the examiner for further consideration. In assessing whether the attempt to broaden claim scope in a reissue is “permissible” or “impermissible” under the recapture rule, the Court applied the following established three-step recapture rule analysis³:

- First, determine whether, and in what respect, the reissue claims are broader than the original patent claims.
- Second, determine whether the broader aspects of the reissue claims relate to subject matter that was surrendered during the patent’s original prosecution.
- Third, if the reissue claims are broader relative to the patented claims in a manner related to surrendered subject matter, determine whether the reissue claims are materially narrowed in a way that avoids substantial or whole recapture of the surrendered subject matter.

The appellant conceded that the first and second steps of the analysis were satisfied with regard to the “changing” limitation, and the Federal Circuit focused its analysis on step 3, *i.e.*, whether “surrendered subject matter has crept into the reissue claim” and is barred by the recapture rule.⁴ The Court explained that during reissue it is never permissible under the recapture rule to entirely eliminate a limitation added to secure the patent grant. The Federal Circuit, however, concluded that the “cycling” limitation was broadened, but not entirely eliminated, during reissue, and that this was not necessarily impermissible under the recapture rule:

In the case at bar ... the Board has already determined that the added limitation - cycling - has not been eliminated; rather, it has been broadened to changing. [] Such modification does not instantly implicate the recapture rule bar, as the Board held; rather, such a broadening modification must be evaluated to determine if it materially narrows relative to the original claim such that surrendered subject matter is not entirely or substantially recaptured.

The [Patent Office] argues that material narrowing should be determined relative to the patented claim, rather than the original claim. We disagree. Using the original claim as a frame of reference for determining whether the reissue claim materially narrows is consistent both with case law and the purposes underlying the reissue statute. By measuring material narrowing relative to the original claim, which was deliberately surrendered during the original prosecution, we are ensuring that the patentee is unable to recapture what it surrendered deliberately, but allowing room for error, as required by the reissue statute. ...⁵

³ See *In re Mostafazadeh*, 643 F.3d 1353, 1358 (Fed. Cir. 2011).

⁴ *In re Youman*, slip op. at 14 (quoting *Mostafazadeh*, 643 F.3d at 1358).

⁵ *Id.* at 16-17.

Federal Circuit Addresses Recapture Rule in Patent Reissue Proceedings

Thus, the Federal Circuit recognized that *surrendered subject matter can be partially recaptured during reissue*, and it held that one must focus on the original application’s claims as a frame of reference for determining whether a broadened claim presented in reissue is permissible: “[I]f the patentee modifies the added limitation such that it is broader than the patented claim yet still materially narrows relative to the original claim, the recapture rule does not bar reissue.”⁶ The Court explained that focusing the frame of reference on the original application claims, and not the patented claims, ensures that the patentee has room to recapture what it surrendered through error. These “errors” include mistakes made during original prosecution when an attorney inadvertently overly narrowed claims in response to prior art rejections. Preventing a broadening reissue applicant from remedially correcting situations in which a claim was inadvertently overly narrowed as a result of attorney error would “frustrate the remedial nature of the reissue statute.”⁷ The Court concluded that “[t]he Board’s failure to distinguish this case from instances where the added limitation is deleted in its entirety and to conduct the proper analysis for a modified limitation is reason enough to vacate and remand.”⁸ The Federal Circuit remanded to the Board with instructions to consider how the reissue claim was materially narrowed relative to the original claim, and whether and how the material narrowing relates to the surrendered subject matter, to determine whether the recapture rule bars the claim.

In re Youman confirms that there may be significant leeway, even in light of the recapture rule, for broadening claim limitations introduced during original prosecution to distinguish over prior art. As such, reissue can be a very powerful tool to expand the scope of claims of an issued patent, even in cases where the broadening involves limitations added to secure the patent in the first place. On the flip side, *In re Youman* complicates assessing whether claim limitations resulting in allowance may be broadened post-grant. As such, one should exercise care when evaluating infringement risks posed by patents that may be subject to broadening reissue proceedings.

Authors:

Mark R. Leslie

mark.leslie@klgates.com

+1.412.355.6271

Christopher G. Wolfe

christopher.wolfe@klgates.com

+1.412. 355.6798

⁶ *Id.* at 19.

⁷ *Id.* at 18.

⁸ *Id.* at 19.

Federal Circuit Addresses Recapture Rule in Patent Reissue Proceedings

K&L GATES

Anchorage Austin Beijing Berlin Boston Brussels Charleston Charlotte Chicago Dallas Doha Dubai Fort Worth Frankfurt Harrisburg
Hong Kong London Los Angeles Miami Milan Moscow Newark New York Orange County Palo Alto Paris Pittsburgh Portland Raleigh
Research Triangle Park San Diego San Francisco São Paulo Seattle Shanghai Singapore Spokane Taipei Tokyo Warsaw Washington, D.C.

K&L Gates includes lawyers practicing out of more than 40 fully integrated offices located in North America, Europe, Asia, South America, and the Middle East, and represents numerous GLOBAL 500, FORTUNE 100, and FTSE 100 corporations, in addition to growth and middle market companies, entrepreneurs, capital market participants and public sector entities. For more information about K&L Gates or its locations and registrations, visit www.klgates.com.

This publication is for informational purposes and does not contain or convey legal advice. The information herein should not be used or relied upon in regard to any particular facts or circumstances without first consulting a lawyer.

©2012 K&L Gates LLP. All Rights Reserved.