

# Broadening Reissue: The Recapture Rule and Material Narrowing

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The test for whether a reissue application or patent impermissibly recaptures surrendered subject matter, known as the rule against recapture or the recapture rule, involves three steps. Once it has been determined (1) what aspects of a reissue claim are broader than a patent claim and (2) whether the broader aspects relate to surrendered subject matter, the third step can be applied. We addressed the first two steps in an earlier article.<sup>1</sup> This article analyzes the third step.

## STEP 3: WERE THE REISSUE CLAIMS MATERIALLY NARROWED?

An illustrative scenario in which the third step of the recapture rule would be evaluated may be instructive. Where a claim in an application originally recites elements AB, is amended to recite ABC in light of a prior art rejection, and then ultimately issues, the addition of element C to the claim would generally surrender subject matter with respect to this limitation. Although the claim may be acceptably broadened in a reissue application by altering or omitting elements A or B, altering element C is only permissible if the third step is satisfied.

The Federal Circuit has described the third step of the recapture rule in various ways. In *In re Clement*,<sup>2</sup> the court indicated that a determination is made as to "whether the surrendered subject matter has crept into the reissue claim"<sup>3</sup> The court further indicated in *North American Container, Inc. v. Plastipak Packaging, Inc.*<sup>4</sup> that the third step assesses "whether the reissue claims were materially narrowed in [respects other than those in which they were broadened], so that the claims may not have been enlarged, and hence avoid the recapture rule."<sup>5</sup>

The Federal Circuit most recently addressed the third step of the recapture rule in *In re Mostafazadeh*.<sup>6</sup> In clarifying its precedent, the court noted that:

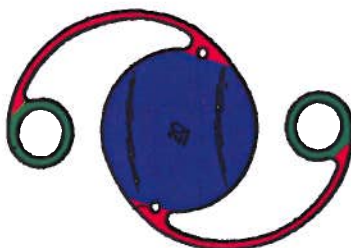
Violation of the rule against recapture may be avoided under this final step of the analysis if the reissue claims "materially narrow" the claims relative to the original claims such that full or substantial recapture of the subject matter surrendered during prosecution is avoided. . . . [T]he narrowing must relate to the subject matter surrendered during the original prosecution (i.e., the applicant cannot recapture the full scope of what was surrendered).<sup>7</sup>

The court did not indicate exactly how to determine whether such "material narrowing" is present, as this analysis tends to be quite fact-specific. Rather, the court discussed precedential cases in which no material narrowing was found. A brief overview of both the analyzed cases and *Mostafazadeh* follows.

## EXAMPLES OF NO "MATERIAL NARROWING"

### *Pannu*

In *Pannu v. Storz Instruments, Inc.*,<sup>8</sup> the original claim recited an ocular implant that included a lens (shown below in blue), flexible strands known as "haptics" (shown in red) extending from the lens, and snag-resistant discs (shown in green) connected to the flexible strands.



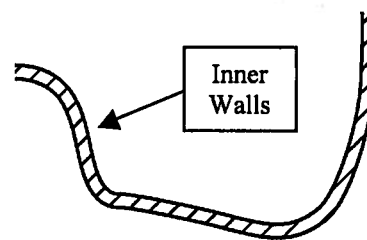
During prosecution, the applicant amended the claims to require the haptics to define a "continuous, substantially circular arc," which resulted in issuance of the claims. This limitation was omitted

from the reissue claims, but new limitations were added that required the snag-resistant discs to be "substantially coplanar" with the haptics and have a width "at least three times greater" than the haptics. The court determined that no material narrowing had occurred in that case.

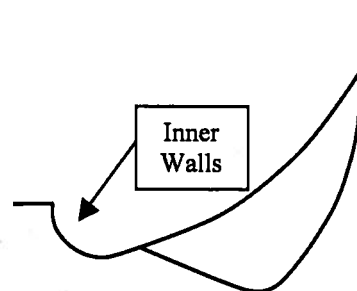
The "continuous, substantially circular arc" limitation related to the shape of the haptics. The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening.<sup>9</sup>

### *North American Container*

In *North American Container*, the claims were rejected during prosecution of the original application based on a prior art container for carbonated drinks. The container had a base portion with inner walls that are slightly concave, as illustrated below.



The applicant amended the claims to recite that the inner walls of its container were "generally convex," as shown below. The applicant argued that this new limitation distinguished the claims over the prior art, and the patent was granted. The patentee then removed the "generally convex" limitation in the reissue claims. A different limitation was added that required a specific relationship between the diameter of the inner walls and the overall diameter of the bottle.

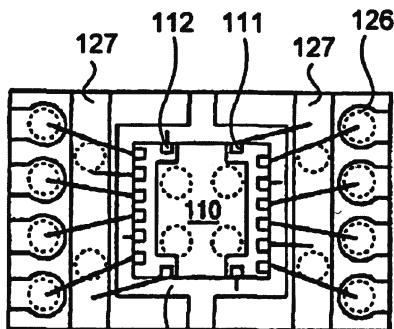


According to the Federal Circuit, "the applicant's deletion of the 'generally con-

vex' limitation clearly broadened the 'inner wall' limitation."<sup>10</sup> Since the reissue claims were not materially narrowed with respect to the generally convex inner wall limitation, the reissue claims were considered invalid for violating the recapture rule.

### Mostafazadeh

The original claim in *Mostafazadeh* recited an integrated circuit package with a plurality of elongated leads. To overcome a rejection, the applicants added a limitation that required each of the leads to include a circular attachment pad (shown below at 126). The circular shape of the attachment pads was emphasized when the applicants argued for patentability.



In the reissue application, the patentee recited the attachment pads, but not their circular shape. Additionally, the patentee narrowed the claims by reciting a bus bar (shown above at 127) and its related features, among other elements. The patentee argued that by maintaining the attachment pads in the reissue claim, even though the shape of the attachment pads was no longer recited, the reissue claims were narrowed in a manner germane to the prior art rejections made in the original prosecution. The patentee further argued that it had avoided the recapture rule because the claims had not been broadened to encompass everything that was surrendered.

The Federal Circuit rejected this position. Although retention of the attachment pad limitation was related to the surrendered subject matter, it was "not materially narrowing because the use of an attachment pad was well known in the prior art."<sup>11</sup> Moreover, "the mere argument that the reissue claims constitute only a partial recapture is insufficient without a corresponding demonstration of material narrowing."<sup>12</sup>

But what is meant by "material narrowing?" The applicants argued that narrowing is material where additional claim limitations render the claim patentable over the prior art, regardless of whether the narrowing is related to the surrendered subject

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matter. The Federal Circuit rejected that argument as well. The court stated:

the recapture rule is violated when a limitation added during prosecution is eliminated entirely, even if other narrowing limitations are added to the claim. If the added limitation is modified but not eliminated, the claims must be materially narrowed relative to the surrendered subject matter such that the surrendered subject matter is not entirely or substantially recaptured.<sup>13</sup>

Accordingly, it did not matter that the bus bar limitations might have made the reissue claims patentable over the prior art, since these limitations were unrelated to the attachment pads. However, it appears that material narrowing might have been present if the mere recitation of attachment pads had rendered the claims patentable over the prior art, or possibly, if the patentee had recited features of the attachment pads that were unrelated to shape yet were sufficient to make the claims patentable. Such a result seems likely in view of the following statement by the court:

a limitation that is added during prosecution to overcome prior art . . . may be modified, however, so long as it continues to materially narrow the claim scope relative to the surrendered subject matter such that the surrendered subject matter is not entirely or substantially recaptured.<sup>14</sup>

### EXAMPLE OF "MATERIAL NARROWING"

*Mostafazadeh* and the cases analyzed therein only provide examples of situations in which no material narrowing was found. *Ball Corp. v. United States*<sup>15</sup> is an older case that provides an example of material narrowing. In this case, the original claims were directed to a missile antenna assembly that included "electrical signal feed means connected with [a] conductor." Two dependent claims provided separate details regarding the "electrical signal feed means": one indicated that the feed means included "at least one conductive lead," whereas the other indicated that it included a "plurality of leads." Only the claim that included the "plurality of leads" limitation was allowed in view of the prior art, which taught a single electrical lead. The applicant incorporated the "plurality of leads"

limitation into the independent claim that eventually issued in a patent.

The reissue claims omitted the “plurality of leads” limitation but included entirely new limitations, such as an “electrical signal feed assembly” and a dielectric material positioned in a cavity of the antenna assembly. The court reasoned that the “electrical signal feed assembly” limitation was in fact narrower than the original “electrical signal feed means” limitation, and thus the reissue claims were “sufficiently narrower than the canceled claims to avoid the effect of the recapture rule.”<sup>16</sup>

The court also noted that the reissue claims were broader than the canceled claims in their omission of a requirement that the antenna be “cylindrical.” The applicant had not relied on this limitation to overcome the prior art. The court reasoned that this broadening did not deprive the reissue claims of “their fundamental narrowness of scope relative to the canceled claims.”<sup>17</sup>

## THE BOARD AND THE MPEP

In *Mostafazadeh*, the Federal Circuit disparaged the Board’s approach to the third step of the recapture rule. Although the court affirmed the Board’s rejection of the claims, it characterized the framework the Board used to make this rejection as “perplexing”<sup>18</sup> and contrary to Federal Circuit precedent. In essence, the Board had reasoned that material narrowing is present only when the reissue claims are directed to “overlooked aspects” of the

invention. The Board had defined such overlooked aspects as patentably distinct inventions, embodiments, or species that were not originally claimed, and had relied on the section of the MPEP that is directed to the third step of the recapture rule to arrive at this definition.<sup>19</sup>

The Federal Circuit concluded that when a claim is directed to such inventions, embodiments, or species, the recapture rule is not even applicable, since the subject matter of the claims is “wholly unrelated to the subject matter that was surrendered during prosecution.”<sup>20</sup> Clearly, then, recitation of features of an unclaimed invention, embodiment, or species is not a requirement for material narrowing of a claim.

The MPEP’s treatment of the third step of the recapture rule is generally consistent with the Board’s. In particular, the MPEP appears to suggest that the only way material narrowing may be found is if subject matter directed to overlooked aspects of the disclosed invention is added to the claims.<sup>21</sup> Practitioners thus should be wary of the MPEP’s treatment of the third step of the recapture rule until it has been revised in view of *Mostafazadeh*.

## CONCLUSION

*Mostafazadeh* provides insights for analyzing the third step of the recapture rule. However, due to the fact-specific nature in determining whether “material narrowing” has occurred with respect to surrendered subject matter, lower tribunals will con-

tinue to struggle with this portion of the recapture rule. *Mostafazadeh* also marks an end to the Board’s conflation of the third step of the recapture rule with “overlooked aspects” of an invention, which also appears to be the approach set forth in the present version of the MPEP. IPT

## ENDNOTES

1. See Daniel C. Higgs, Kevin B. Laurence, & Matthew C. Phillips, *Broadening Reissue: The Recapture Rule and Surrendered Subject Matter*, *Intell. Prop. Today*, Apr. 2011, at 30-32.
2. 131 F.3d 1464, 1468-70 (Fed. Cir. 1997).
3. *Id.* at 1469.
4. 415 F.3d 1335 (Fed. Cir. 2005).
5. *Id.* at 1349.
6. No. 2010-1260, 2011 U.S. App. LEXIS 9042 (no pinpoint citation) (Fed. Cir. May 3, 2011).
7. *Id.* at \*9.
8. 258 F.3d 1366 (Fed. Cir. 2001).
9. *Id.* at 1372.
10. 415 F.3d at 1350.
11. *Id.* at \*17.
12. *Mostafazadeh*, 2011 U.S. App. LEXIS 9042, at \*16-17.
13. *Id.* at \*15-16.
14. *Id.* at \*12.
15. 729 F.2d 1429 (Fed. Cir. 1984).
16. *Id.* at 1438.
17. *Id.*
18. *Mostafazadeh*, 2011 U.S. App. LEXIS 9042, at \*12.
19. *Id.* (citing MPEP § 1412.02(I)(C) (8th ed., rev. 7, July 2008)).
20. *Id.* at \*15.
21. See MPEP § 1412.02(I)(C), (V) (8th ed., rev. 7, July 2008).

## Nixon Peabody Partner Named President of Chicago Intellectual Property Association

*Janet Garetto to Lead 2011-2012 New Officers and Board Members*

International law firm Nixon Peabody LLP is pleased to announce that Chicago partner Janet M. Garetto has been named President of the Intellectual Property Law Association of Chicago (IPLAC). Ms. Garetto assumed this leadership role for the 2011-2012 year at the recently held IPLAC Annual Meeting. Ms. Garetto succeeds Edward D. Manzo in this leadership role.

“This is an exciting time in this industry as more companies are recognizing the importance of protecting and maximizing the value of their intellectual property assets,” said Ms. Garetto. “I am truly privileged and humbled to serve as President of this important organization for the coming year, and I thank Edward for his service to this organization as its president over the past year.”

Ms. Garetto’s practice is devoted to intellectual property counseling and litigation. Her transactional experience in the patent area encompasses drafting and prosecuting patent applications in various chemical and mechanical areas and preparing infringement, invalidity, and due diligence opinions. She has prosecuted patents and provided counseling to clients in a variety of technical areas. Ms. Garetto’s transactional experience in the trademark area encompasses general counseling regarding trademark matters, trademark prosecution, and handling proceedings before the Trademark Trial and Appeal Board. She is also an experienced patent and trademark litigator.

IPLAC is the oldest intellectual property law association in the nation and is dedicated to maintaining a high standard of professional ethics in the practice of patent, trademark, copyright, trade secret, and associated fields of law. With more than 1,200 members, the association represents a full spectrum of the profession ranging from law firm attorneys to sole practitioners, corporate attorneys, law school professors, paralegals, and law students. Each year, IPLAC’s members prosecute thousands of patent applications and litigate many patent lawsuits.