

Claim Changes in Reexamination and Reissue

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Reexamination and reissue can affect patents in a variety of ways. Most notably, a reexamined or reissued patent that has different claims, either by amendment to claims originally present or by addition of new claims, may or may not have retroactive effect back to the original issue date of the patent. Such claim changes may or may not also give rise to intervening rights, thereby limiting the patent owner’s ability to prevent certain future acts that would otherwise be infringement but for the reexamination or reissue proceeding. This article discusses the circumstances under which past liability may be extinguished and intervening patent rights are typically created in the reexamination or reissue process.

ARE THE CLAIMS SUBSTANTIALLY IDENTICAL?

The threshold issue in determining pre-certificate or pre-reissuance liability arises under 35 U.S.C. § 252. The statutory test is whether the claims, as amended in reexamination or reissue, are “substantially

identical” to the claims in effect prior to the issuance of a reexamination certificate or reissuance of a patent.¹ If so, then it is as if the reexamination or reissue proceeding never occurred, and upon a finding of infringement of a valid claim and in the absence of another defense, the infringer will be fully liable for all its actionable infringement before and after the reexamination certificate or reissued patent. By contrast, if the amended and original claims are not “substantially identical,” then there can be no liability for accused activities occurring before the reexamination certificate or reissue patent issues, and accused activities after that date are usually subject to the intervening rights defenses, even if the patent owner can prove infringement of a valid claim.²

Whether claims are “substantially identical” before and after an amendment depends on the claim scope, a question of law.

Consider All Claims Together

In deciding whether a reexamined or reissued claim is “substantially identical” in scope to the original claims, courts do not look only at the individual claim before and after the amendment, in isolation from the rest of the claims. Instead, courts consider the set of claims in the patent as a whole before and after the amendment. If there was any claim in the original claim set that had the same scope as the amended claim, then the patent owner can reach back – for that claim – to the original issue date.

That principle was best illustrated in *Bloom Engineering v. North American Manufacturing*.³ During reexamination, Bloom replaced the word “furnace” in an original independent claim with “radiant tube” while canceling a dependent claim that essentially recited that the furnace was of the “radiant tube” type. The Federal Circuit held that the change was not substantive within the meaning of § 252 because the amended independent claim had the same scope as the dependent claim in the original patent.

That holding from *Bloom Engineering* provides a clear strategy for patent owners in reexamination or reissue: When a narrowing claim amendment is necessary, typically to distinguish prior art, patent owners

should look first to the dependent claims for limitations to incorporate into the base claim. The dependent claim limitations are safe harbors under § 252. A dependent claim limitation that avoids the prior art yet still preserves the infringement case is an ideal retreat position in reexamination or reissue. This principle also highlights the importance of presenting a rich set of dependent claims during original prosecution. Failure to have that ideal retreat position recited as a dependent claim limitation may be costly to the patent owner in reexamination or reissue.

This holding from *Bloom Engineering* also reinforces the desirability of having one limitation per dependent claim. Consider what would have happened to Bloom if the “radiant tube” dependent claim further recited another limitation that turned out to be absent from the accused device. Then, the incorporation of the “radiant tube” limitation alone into the independent claim would not have resulted in an amended claim “substantially identical” to the original dependent claim. In fact, that is exactly what happened in *Fortel v. Phone-Mate*.⁴ Fortel, the patent owner, amended its independent claim during reexamination by incorporating into it some, but not all, of the subject matter of a dependent claim, which was canceled. The Federal Circuit affirmed the district court’s determination “that, because no asserted claim in the reexamined patent was without substantive change from any claim in the original patent, Fortel had no right to enforce those reexamined claims before the date of the reexamination certificate.”⁵

No Per Se Rule

Whether claims have different scope after a reexamination or reissue proceeding requires “an overall examination of the written description, the prosecution history and the language of the respective claims.”⁶ There is no *per se* rule that every amendment made to overcome a prior-art rejection relinquishes claim scope for purposes of § 252.

However, the *per se* rule is almost always right, as *Laitram v. NEC* demonstrates.⁷ In that case, the patented invention was a printing apparatus and method. To overcome a rejection during reexamination, the patent owner, Laitram, added the modifier “type quality” before the phrase “alpha-numeric characters” in the claim. When Laitram asserted the amended claim against NEC, the district court granted summary judgment to NEC under § 252

without engaging in any substantive analysis of the scope of the claims before and after the amendment.

In an interlocutory appeal, the Federal Circuit reversed and remanded, explaining that there is no *per se* rule and instructing the district court to consider the full context of the amendment, including the prior art, the prosecution history, and other claims.

In a subsequent appeal, after the district court undertook the analysis prescribed above, the Federal Circuit affirmed the district court's determination that the amendment was indeed substantive. While not repudiating the *no-per-se* rule, the Federal Circuit remarked that the *per se* rule is almost always right, conceding that "it is difficult to conceive of many situations in which the scope of a rejected claim that became allowable when amended is not substantively changed by the amendment."⁸

Patent owners who have made a claim change in reexamination or reissue can latch onto the requirement that the entire intrinsic record must be examined before concluding that the change was scope-affecting. Such patent owners should search the intrinsic record for arguments that the new claim language was inherent in how the original claims should have been construed. This may put patent owners in the unusual posture of arguing that a limitation from the specification should be read into the original claims or that a particular remark in the original prosecution history forms the basis for a narrow construction of the original claims.

EXAMPLES OF SCOPE-CHANGING AMENDMENTS

A common example of a narrowing amendment occurs when the patentee adds a limitation to a claim in order to make the claim patentable over prior art that forms the basis for the PTO's rejection of the original claim during reexamination or reissue. Typically, the patentee will add a recitation in the claim of a feature or element not found in the prior art in order to make the claim patentably different from the prior art.

An instructive example is found in *Bloom Engineering*. Bloom's furnace patent was reexamined based on a British patent describing a furnace using an injected gas stream that included combustion air. Bloom amended its claims in reexamination to require that the gas stream used in the patented invention be "separate" from

the combustion air stream. In finding that the amendment changed the scope of the claims, the Federal Circuit reasoned:

The amendment narrowed the claims to exclude an injected gas stream that includes combustion air, and to require a separate combustion air stream. This change was necessary in order to distinguish Bloom's injected stream from that shown in the British patent. The British patent was newly cited prior art, and the claims were narrowed and limited in view of that patent.⁹

Another instructive example is *Laitram*. As noted above, the patent owner added the modifier "type quality" before the phrase "alpha-numeric characters" during reexamination, in order to overcome a prior-art rejection, and the PTO allowed the amended claims. The Federal Circuit held that the amendment changed the scope of the claims, explaining:

[A] plain reading of the claims would indicate that the original and reexamined claims are of different scope: the original claims appear to cover a printer or method of printing which generates any quality of alphanumeric characters, while the amended claims seem to cover only a printing apparatus or method of printing which generates "type quality" alphanumeric characters. Most significantly, however, the addition of the "type quality" limitation, along with the other amendments, resulted in the allowance of claims that had been rejected in the reexamination proceeding over prior art; this is a highly influential piece of prosecution history.¹⁰

EXAMPLES OF NON-SCOPE-CHANGING AMENDMENTS

The statutory phrase "substantially identical" does not mean "verbatim" and permits rewording so long as the scope of the claim is not changed.¹¹ Examples of amendments that did not change the scope of the claims include the following.

Replacing a Word with an Equivalent Word

Replacing a word in a claim with an equivalent word does not change the scope of the claim. An example of this occurred in *Minco v. Combustion Engineering*.¹² Like *Bloom Engineering*, *Minco* is another case in which the invention was a furnace.

During reexamination, the patent owner amended certain claims to change the word "furnace" to "housing." As the court read the specification, the patent often used those two terms to mean the same thing, and the court held that one of ordinary skill in the pertinent furnace art would understand the claims not to have changed in scope.

Making Explicit What Was Implicit

An amendment leaving the claims "substantially identical" must be "a mere clarification of language to make specific what was always implicit or inherent."¹³ For example, addition of a modifying adjective before a noun to make more clear which object already recited in the claim is being referenced is not a scope-changing amendment. In *Tennant v. Hako Minuteman*, the patentee added the word "bottom" to the claim during reexamination, as illustrated below with underlining:

1. A sweeping machine having a sweeping brush and a storage hopper for receiving swept material from the brush, said hopper having a movable first bottom wall section, a main part that includes a second bottom wall section¹⁴

The Federal Circuit held that the addition of the word "bottom" did not change the claim scope because the recited "first wall" was always a bottom wall. The key to the court's analysis was that the claim originally referred to "a second bottom wall section." Because a second cannot exist without a first, the claimed "first wall section" must necessarily have also been a "bottom" wall section.

Moreover, adding explicit antecedent basis for an element already expressed in the claim does not change the scope of the claim. An example of this occurred in *Slimfold v. Kinkead*.¹⁵ The claim at issue was directed at a metal door assembly. The original claim referred to "said collar" and recited the relationship of other elements of the door assembly to "said collar." However, the phrase "said collar" had no antecedent basis in the original claim, as the original claim did not refer to a "collar" earlier in the claim. During reissue, the patent owner added the language "a collar on said sleeve" as one of the elements of the claimed door assembly, thereby adding the missing antecedent. The Federal Circuit affirmed the district court's determination that that was not a scope-changing amendment under § 252.

Incorporating Dependent Claim in Base Claim

Finally and most importantly, incorporation of the limitations of a dependent claim into its base claim is not a scope-changing amendment for purposes of § 252, as discussed above. This is consistent with the principle that all of the claims of the patent are considered together in applying § 252.

This type of amendment is often the most useful to the patent owner because, unlike the other types of amendments that are retroactive under § 252, incorporating a dependent claim into its base claim is more likely to be effective in overcoming a prior art rejection because it actually narrows the base claim. In fact, incorporation of an entire dependent claim into its base claim may be the only way of surrendering claim scope to avoid prior art while preserving the retroactive effect of the claims.

CONCLUSION

Reexamination or reissue counsel should carefully assess whether claim

amendments will change the scope of the claims, particularly when litigation is occurring or contemplated. Similarly, patent challengers considering reexamination would be wise to consider the likely outcomes of the reexamination and assess whether those outcomes would change the scope of the claims. Entitlement to past damages and typically intervening rights turns on whether the scope of the claims changes. **IP**

ENDNOTES

1. 35 U.S.C. § 252, ¶ 1 (retroactive effect for reissue claims); *see also* 35 U.S.C. § 252, ¶ 2 (intervening rights for reissue claims); 35 U.S.C. § 307 (applying § 252 to reexamination). Older cases refer to an earlier version of § 252, which used the term “identical,” rather than the current phrase “substantially identical.” However, those older cases interpreting and applying the earlier statute are still applicable today, as the change in the statutory text was meant to codify judicial interpretation of the term “identical” in the earlier statute. H. R. Rep. No. 105-97, at 62 (1997). Thus, adding the word “substantially” to the statute is an example of an amendment that left the statute “substantially identical.”

2. *Bloom Eng'g Co. v. N. Am. Mfg. Co.*, 129 F.3d 1247, 1249 (Fed. Cir. 1997); *see also Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 27 U.S.P.Q.2d 1959 (Fed. Cir. 1993) (nonprecedential) (describing original claims as “void *ab initio*”).
3. *Bloom Eng'g*, 129 F.3d at 1249.
4. *Fortel Corp. v. Phone-Mate, Inc.*, 825 F.2d 1577 (Fed. Cir. 1987).
5. *Id.* at 1579 (emphasis added).
6. *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1348 (Fed. Cir. 1998).
7. *Id.*
8. *Id.*
9. *Bloom Eng'g*, 129 F.3d at 1251.
10. *Laitram*, 163 F.3d at 1348.
11. *Laitram Corp. v. NEC Corp.*, 952 F.2d 1357, 1361 (Fed. Cir. 1991).
12. *Minco, Inc. v. Combustion Eng'g, Inc.*, 95 F.3d 1109, 1115 (Fed. Cir. 1996).
13. *Seattle Box Co. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 828 (Fed. Cir. 1984).
14. *Tennant Co. v. Hako Minuteman, Inc.*, 878 F.2d 1413, 1417 (Fed. Cir. 1989).
15. *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1114 (Fed. Cir. 1987).

Commerce Secretary Locke Names New Members to Patent and Trademark Public Advisory Committees

U.S. Commerce Secretary **Gary Locke** recently named three new members to the **Patent Public Advisory Committee** (PPAC) and two to the **Trademark Public Advisory Committee** (TPAC). The committees were created by the 1999 American Inventors Protection Act to advise the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (USPTO) on the management of patent and trademark operations including goals, performance, budget, and user fees. The committees have nine voting members who are appointed by and serve at the pleasure of the Secretary of Commerce. Each member serves a three-year term.

“I look forward to working with each of the new committee members,” said Under Secretary of Commerce for Intellectual Property and Director of the USPTO David Kappos. “Their advice will be invaluable as we work to address the significant challenges facing the agency.”

The new PPAC members are:

- **Dr. Benjamin Borson** is the founder of Borson Law Group, PC where he advises small, mid-sized and large clients in developing business-based IP strategies in the life sciences and high technology industries. He has been an IP professional for 15 years and is a frequent author and speaker on IP law.
- **Steven W. Miller** is Vice President and General Counsel-Intellectual Property for Procter & Gamble in Cincinnati, Ohio. He has held various positions in the IP law department of Procter & Gamble since 1984. Miller holds a B.S. and J.D. degree from The Ohio State University.
- **Esther Kepplinger** is the director of patent operations for Wilson Sonsini Goodrich & Rosati, PC and serves as the firm’s liaison to the USPTO. Additionally, she provides strategic patent counseling and serves as an expert witness for U.S. patent examination practice.
- **Damon Matteo** was appointed by Secretary Locke for a three-year term as chairman of PPAC. Matteo is vice president and chief intellectual property officer of the Palo Alto Research Center (PARC).

The new TPAC members are:

- **James Conley** serves on the faculty of both the Kellogg School of Management and the McCormick School of Engineering at Northwestern University. He is a member of the Kellogg Center for Research in Technology & Innovation and serves as a Faculty Fellow at the Segal Design Institute.
- **Kathryn Barrett Park** is a past president of the International Trademark Association and currently serves as Senior Counsel for Advertising and Brand Management for the General Electric Company, headquartered in Fairfield, CT.