



## Federal Circuit clarifies three-step recapture rule for analysis of reissued claims

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Author(s): Charles R. Macedo, Michael J. Kasdan and Addie A. Bendory

*In re Youman*, No. 2011-1136, US Court of Appeals for the Federal Circuit, 2012 US App LEXIS 9346, 8 May 2012 (*'Youman II'*)

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*The US Court of Appeals for the Federal Circuit provided an important clarification regarding the application of the so-called 'recapture rule' during a broadening reissue proceeding before the US Patent and Trademark Office (USPTO). Under the recapture rule, a patentee may not recapture in a reissue proceeding that which was given up during original prosecution. Significantly, Youman II confirms that some broadening of even previously narrowed claim elements is permitted.*

### Legal context

Under US patent law, a patentee may use a reissue proceeding to fix errors made in the original grant of a US Patent. Under this procedure, when a reissue proceeding is commenced within two years after issuance of the original US patent, the patentee may obtain claims that are potentially broader in scope and/or narrower in scope than the issued claims. However, a significant limit placed on a patentee is that it may not recapture subject matter in a reissue proceeding that was given up in the original proceeding in order to obtain the original patent. In *Youman II*, the Federal Circuit addressed how the recapture rule should apply when a reissue claim sought is broader than the issued claim but narrower than the originally filed claim that was narrowed during original prosecution.

### Facts

The *Youman* patent covers an electronic programme schedule system for a television that allows users to search for a list of programme titles. As originally filed, the claim provided for users to 'select' a title from the list. During the original prosecution, the claim was modified to require a user to 'cycle' through the list, rather than 'select' a title from the list, in order to obtain allowance of the claim. It was undisputed that the requirement in the issued claim to 'cycle' through the list is narrower than the original claim merely requiring a user to 'select' a title. Nor was it disputed that this narrowing amendment was at least arguably used to traverse potential prior art rejections.



Within the two-year window after issuance of the original patent, the patentee submitted a reissue application which sought to broaden the issued claims from having the user ‘cycle’ through the list to having the user ‘change’ characters on the menu using remote control keys. It was undisputed that while the proposed reissue claims requiring the user to ‘change’ characters were narrower than the original claims requirement of the user to ‘select’ from a list, they were broader than the issued claims requiring the user to ‘cycle’ through it.

In the reissue proceeding, the examiner rejected the claims under 35 USC §251 because the reissue claims improperly recaptured subject matter that was surrendered in the application for the original patent. The patentee appealed the rejection to the US Board of Patent Appeals and Interferences, which subsequently affirmed the examiner's rejections of the reissue claims (*Ex parte Youman*, No 2010-007029, 2010 Pat App LEXIS 13302 (BPAI 8 September 2010), ‘*Youman I*’). According to the Board, because the reissue claim broadened the claim to an intermediate scope, it constituted an impermissible recapture of surrendered subject matter.

The patentee appealed to the Federal Circuit.

## **Analysis**

On appeal, in a split decision, the Federal Circuit vacated and remanded the Board's rejections of multiple claims in the reissue patent application. *Youman II* held that the Board improperly applied the recapture rule. According to the majority, the recapture rule permits reissue claims of intermediate scope, namely those between the scope of the original claim in the application and the issued claim.

The reissue statute allows a patentee to broaden claims in its original patent if the patentee can show ‘error without any deceptive intention’ (35 USC §251). However, the recapture rule bars reissue applications that broaden claims in order to recapture subject matter surrendered during the original prosecution.

In *Youman II*, the Federal Circuit applied a three-step recapture rule analysis in determining whether an applicant's reissue claims violate the recapture rule:

The reissue claims are compared to the patented claims to determine whether and in what aspect the reissue claims are broader than the patented claims.

It is then determined whether the broader aspects of the reissue claims relate to surrendered subject matter.

If the reissue claims are broader relative to the patented claims in a manner related to the surrendered subject matter, it must be determined whether the surrendered subject matter has crept into the reissue claim.



The Federal Circuit then held that the Board improperly applied the recapture rule by comparing the reissue claims to the patented claims, rather than to the original claims. In particular, the court held that ‘[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’ (*Youman II*, 2012 US App LEXIS 9346, para 26). However, as *Youman II* further explained, ‘[u]nless the claims are materially narrowed in a way that avoids substantial or whole recapture of the surrendered subject matter, the surrendered subject matter has crept into the reissue claims and they are barred under the recapture rule’ (ibid, para 19).

*Youman II* explained its rationale for comparing the reissue claims to the original claims, and not merely the patented claims, as follows: ‘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’ (ibid, para 22, emphasis in original).

The Federal Circuit remanded the case to the USPTO with instructions to properly apply the recapture rule analysis to the claims at issue and make necessary findings of fact.

### **Practical significance**

In *Youman II*, the Federal Circuit clarified that the recapture rule does not per se bar claims in a reissue patent which are broader than the patented claims but narrower than the original claims, even when narrowed in an original prosecution to obtain allowance. Rather, *Youman II* looks to the practical significance of the amendment in the original application and determines if that significance is undermined by the broadening claim in reissuance. In other words, some broadening of previously narrowed claim elements will be acceptable in reissuance proceedings, as long as the surrendered subject matter has not crept into the reissue claim. This may present patentees with more opportunities to use reissue practice to their strategic advantage. No doubt, the Federal Circuit will have further opportunities in the future to address how this rule should be applied.

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\*[Charles Macedo](#) is a partner, Michael J. Kasdan is a former partner, and Addie A. Bendory is a former associate at Amster, Rothstein & Ebenstein LLP. Their practice specializes in intellectual property issues. Charles may be reached at [cmacedo@arelaw.com](mailto:cmacedo@arelaw.com).

Mr. Macedo is also the author of *The Corporate Insider’s Guide to U.S. Patent Practice*, published by Oxford University Press in 2009.