

**“TO ERR IS HUMAN, TO CORRECT BY REISSUE DIVINE”: CORRECTING BY
REISSUE WHAT COULD NOT BE BROADENED BY THE DOCTRINE OF
EQUIVALENTS**

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I. Introduction

This article explores the interplay, or lack thereof, between “file history estoppel” with respect to the doctrine of equivalents, as set forth in the Supreme Court’s 2002 decision in Festo,¹ and the “recapture rule” for reissue patent applications. Of particular interest is a 2003 precedential (per curiam) decision from the Patent Office’s Board of Appeals, Eggert². In Eggert, the majority of the Board held that Festo is not applicable to the recapture rule in reissue applications. The practical implications of Eggert are described below. Finally, this article suggests some strategies for practitioners pursuing reissue patent applications.

II. The Recapture Rule

The reissue statute (35 U.S.C. § 251) permits inventors to correct errors in their patents. The claims of a patent can be broadened if the reissue application is filed within two (2) years of the issue date of the patent. A significant limitation on the latter right, however, is the “recapture rule.” This rule, which was judicially created and is based on principles of equity, holds that a reissue patent will not be granted to “recapture” claimed subject matter that was surrendered in an effort to obtain the original patent. “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

¹ Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 535 U.S. 722, 152 L. Ed. 2d 944, 122 S. Ct. 1831 (2002). See also Court of Appeals for the Federal Circuit *en banc* decision Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 344 F.3d 1359, 68 USPQ2d 1321 (Fed. Cir. 2003).

² Ex Parte Eggert, 2003 Pat. App. LEXIS 27, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003).

canceled from the original application.”³ The theory behind the rule is that a surrender of subject matter intentionally in order to secure the patent could not constitute an “error” that is correctible by reissue.

III. File History Estoppel

The doctrine of equivalents, also judicially created, generally holds that a claim of a patent not literally infringed may nonetheless be deemed infringed if the differences between the claimed invention and the accused product are “insubstantial.”⁴ In the case of mechanical inventions, for example, a common way to determine whether the differences are insubstantial is to check whether or not the accused product performs substantially the same function, in substantially the same way, and with substantially the same result as the claimed invention.⁵

However, application of the doctrine of equivalents is limited by “prosecution history estoppel.”⁶ The Supreme Court explained the doctrine of prosecution history estoppel and its effect on the doctrine of equivalents in Festo⁷:

Prosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process. Estoppel is a "rule of patent construction" that ensures that claims are interpreted by reference to those "that have been cancelled or rejected." Schriber-Schroth Co. v. Cleveland

³ Ball v. U.S., 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001).

⁴ See, e.g., Dawn Equip. Co. v. Kentucky Farms, Inc., 140 F.3d 1009, 1015, 46 USPQ2d 1109 (Fed. Cir. 1998).

⁵ Warner-Jenkinson Co. Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 137 L.Ed. 2d, 146, 117 S.Ct. 1040 (1997).

⁶ Festo, 535 U.S. at 727.

⁷ Id. at 733-734.

Trust Co., 311 U.S. 211, 220-221, 61 S. Ct. 235, 85 L. Ed. 132, 1941 Dec. Comm'r Pat. 802 (1940). 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, "by the amendment [the patentee] recognized and emphasized the difference between the two phrases[,] . . . and the difference which [the patentee] thus disclaimed must be regarded as material." Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126, 136-137, 62 S. Ct. 513, 86 L. Ed. 736, 1942 Dec. Comm'r Pat. 738 (1942).

The Festo court established a presumption that a narrowing amendment made for reasons of patentability surrenders the entire territory between the original claim limitation and the amended claim limitation.⁸ This presumption can only be rebutted in one of three ways—by demonstrating that "the equivalent [would] have been unforeseeable at the time of the [amendment]"; by demonstrating that "the rationale underlying the amendment [bore] no more than a tangential relation to the equivalent in question"; or by demonstrating that "there [was] some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question."²

⁸ Id. at 740-41.

² Id.

It remains to be seen just how difficult it is in practice to rebut the presumption of a complete surrender of equivalents. Since Festo, there have been only a few decisions that address the three ways to rebut the presumptive surrender of equivalents.¹⁰

IV. Eggert, and the Interplay Between the Recapture Rule and File History

Estoppel

At issue in Eggert was a recapture rejection of newly added claims in a reissue application, where the newly added claims did not include all of the limitations added to the claims of the original application. During prosecution of the original patent, the patentee twice amended the claims to overcome a prior art rejection. As a result of the second amendment to the claims, the scope of the patent claims was limited to only one of the two embodiments disclosed by Eggert.¹¹ Seeking to correct this error, the patentee filed a reissue application within the prescribed time limit. The reissue application added new claims, which were sufficient in scope to cover both of the disclosed embodiments, as well as to distinguish over the prior art of record.¹²

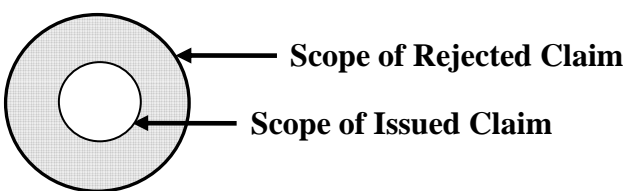
Although the new reissue claims did not include the limitations that were added by the second amendment during prosecution of the original patent, the new reissue claims were

¹⁰ See, e.g., Ranbaxy Pharmaceuticals, Inc. v. Apotex, Inc., 350 F.3d 1235, 69 U.S.P.Q.2D (BNA) 1086 (Fed. Cir. 2003); SmithKline Beecham Corp. v. Excel Pharmaceuticals, Inc., 356 F.3d 1357, 69 U.S.P.Q.2D (BNA) 1712 (Fed. Cir. 2004); Glaxo Wellcome, Inc., v. Impax Laboratories, 356 F.3d 1348, 69 U.S.P.Q.2D (BNA) 1705 (Fed. Cir. 2004); and Insituform Technologies, Inc., v. CAT Contracting, Inc., 385 F.3d 1360, 72 U.S.P.Q.2D (BNA) (Fed. Cir. 2004).

¹¹ Eggert, 67 USPQ2d at 1730.

¹² Id.

narrower in scope than the claims prior to the second amendment.¹³ As shown in the following drawing appended to the Board’s Decision (Drawing 1), the scope of the reissue claims fell within the shaded area between the scope of the issued claim (twice amended) and the scope of the rejected claim (once amended). In other words, “[t]he shaded area between circles represents subject matter which is only narrower than the scope of the rejected claim but only broader than the scope of the patent claim.”¹⁴



Drawing 1

In the reissue application, the Examiner twice rejected the new claims under 35 U.S.C. § 251 as being an improper recapture of broadened subject matter surrendered in the application for the original patent. In particular, the Examiner argued that by amending the rejected claim to correspond to the inner circle, the patentee necessarily relinquished all subject matter outside the inner circle. Because the new reissue claims did not recite all of the specific limitations added during prosecution of the original patent, the Examiner contended that the new reissue claims violated the recapture rule per se.

On appeal, the Examiner’s rejection was initially reversed by a three-member panel of the Board. In response to the Examiner’s request for rehearing, the appeal was reheard by an

¹³ Id. at 1731 and 1732.

¹⁴ Id. at 1717.

expanded eleven-member (per curiam) panel of the Board, which upheld the decision of the original three-member panel of the Board.

The dissenters argued, citing Festo, that “the principles of prosecution history estoppel apply to reissue applications.”¹⁵ The majority rejected the dissenters’ contention.¹⁶ The majority concluded:

While, as pointed out by the dissent, “[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” (Festo, 122 S. Ct. at 1842, 62 USPQ2d at 1713) in the context of prosecution history estoppel when applying the doctrine of equivalents in an infringement action, we are aware of no case, and the dissent has not pointed to any case, which so defined “surrendered subject matter” in the context of the reissue recapture rule. Indeed, as discussed above, the precedent in the area of the reissue recapture rule repeatedly establishes that the narrowing of a claim by amendment constitutes surrender of the amended claim, that is, the claim prior to the amendment. Moreover, in light of the fact that the fourth paragraph of 35 U.S.C. § 251 permits enlargement of the scope of patent claims in reissue within two years of the issue date of the patent, it is quite apparent that the theory of disclaimer through narrowing amendments expressed in Festo cannot be applied to correction of patents through reissue consistent with 35 U.S.C. § 251.

Thus, the majority considered the surrendered subject matter to be anything equal in scope or broader than the claim as it stood prior to the second (final) amendment.

¹⁵ Chief Judge Stoner dissented. The other dissenters were Judges Barrett, Pawlikowski and Nagumo. See Eggert at 1738.

¹⁶ Consisting of Judges Harkcom, Smith, Abrams, Frankfort, Fleming, Nase and Bahr. See Eggert at 1732.

V. Practical Considerations

What practical implications does Eggert have for patent practitioners (both patent prosecutors and litigators) and their clients? The following example, borrowed from Section 1412.02 of the Manual for Patent Examining Procedure (“MPEP”), helps answer this question.¹⁷

1. During prosecution of the original application, a key limitation added to the claims to overcome a prior art rejection is “an orange peel”.
2. In a reissue application filed within two years of the issue date of the patent, the claims are broadened by substituting “a citrus fruit peel” for the limitation “an orange peel”.

Under Eggert and the MPEP, this broadening reissue application does not violate the recapture rule, since the amended claim presented by reissue is merely a broader form of the key limitation added/argued during original prosecution to overcome a prior art rejection (and therefore does not entirely remove that key limitation). Prior to Eggert and the corresponding revisions to the MPEP, the Patent Office would almost certainly have made a recapture rejection in this situation. This outcome seems much less likely now.

Expounding on this hypothetical, let us assume that the reissue application has not been filed yet, and therefore the patent claims still recite “an orange peel”. Let us further assume that there is a potential infringer who has the identical device, except that it uses “a grapefruit peel” rather than “an orange peel.” In this scenario, there is clearly no literal infringement. But has there been an infringement under the doctrine of equivalents? Most likely, the answer to that question is no, since the claims were amended (i.e., narrowed) to recite “an orange peel.” Under Festo, due to prosecution history estoppel, there would be a presumption that there is no scope of

¹⁷ MPEP Section 1412.02.I.C was revised in May of 2004 to specifically reference Eggert.

equivalents for the orange peel, provided none of the exceptions to Festo apply. So, in this scenario, the patentee could be out of luck.

In contrast, if the patentee filed the above described reissue application to correct the error in claiming less than they were entitled to, then the recapture rule would be inapplicable, and the patentee could proceed on a theory of literal infringement (assuming the reissue claims were still patentable/valid).

Thus, a decision must be made whether to proceed on a suspect theory of equivalents infringement or to file a broadening reissue application to correct the error in claim scope and, in the process, subject all of the claims to another substantive examination.¹⁸ Ultimately, the decision should be based on a consideration of the multitude of factors unique to the particular circumstances. Of course, if the patent is more than two years old, then the decision is simple, since by statute no broadening reissue application can be filed in that event.

It is unknown whether the district courts and the Federal Circuit will adopt the Board's decision in Eggert. To date, the authors have identified only one case that cites Eggert. In that case, Dethmers,¹⁹ the Northern District of Iowa adopted Eggert, holding:

If anything, then, Eggert stands for the proposition that the Supreme Court's decision in Festo is not applicable to the scope of the "recapture rule" for reissue patents. Thus, Automatic has failed to demonstrate that any court, let alone any court stating controlling precedent, has applied the "Festo rule" regarding the scope of prosecution history estoppel, for purposes of a claim of infringement under the doctrine of equivalents, to the scope of the

¹⁸ See 37 C.F.R. § 1.176 ("Examination of Reissue") and MPEP Section 1440. The claims of a reissue application will be fully examined in the same manner, and subject to the same rules, as if being presented for the first time in an original non-reissue, non-provisional application.

¹⁹ Dethmers Manufacturing Co., Inc. v. Automatic Equipment Mfg., Co., 299 F. Supp. 2d 903, 920, 2004 U.S. Dist. LEXIS 471 (N.D. Iowa, 2004).

"recapture rule," for purposes of determining the validity of a reissue patent.

VI. Conclusion

Ultimately, as a result of the Board's decision in Eggert, practitioners should be less wary about pursuing reissue applications, particularly where it is fairly certain that there is no literal infringement and infringement under the doctrine of equivalents is questionable. Until recently, it has been this practitioner's experience that all reissue applications are met with a recapture rejection, as standard practice. The Eggert decision begins to clarify what for many years has been muddied waters for the Patent Office and patent practitioners.