RECAPTURE APPLIES UNDER 35 U.S.C. 101

| October 17, 2022

In re: John Bradley McDonald

Decided: August 10, 2022

NEWMAN, STOLL, and CUNNINGHAM[1]. Opinion by CUNNINGHAM

Summary

This precedential opinion serves as a warning for applicants seeking a broadening reissue application, namely, that amendments made in a ***parent*** application can trigger recapture in a child ***continuation*** application, even if the amendment in the ***parent*** application was made in response to a rejection under 35 U.S.C. 101. As a further warning, the recapture issue did not arise until a decision by the Patent Trial and Appeal Board (the Board) when two new grounds of rejection were made (with respect to recapture and based on a defective reissue declaration as lacking an error correctable by reissue).

Background

A parent application was filed in 2008 naming John Bradley McDonald as the inventor. In response to a rejection under 35 U.S.C. 101, the claims were amended to add a "processor" to certain claim limitations. The application was eventually allowed and issued as U.S. Patent No. 8,280,901 (the '901 patent). Prior to issuing, a continuation application was filed. The claims of the continuation application, while different from the claims in the parent application, also contained "processor" limitations. The claims in the continuation application were rejected based on nonstatutory double patenting over the parent application claims, and an obviousness rejection over prior art. A terminal disclaimer was filed to obviate the double patenting rejection, and the obviousness rejection was traversed without amendments. The continuation application was allowed and issued as U.S. Patent No. 8,572,111 (the '111 patent).

In 2015, McDonald filed a reissue application seeking to broaden the claims of the '111 patent. Claim 1 of the reissue application was amended as follows:

1. (Amended) A computer-implemented method of displaying search results in a search and display window, the method comprising:

a) receiving a primary search query from a user;

b) determining a primary search result comprising a first plurality of search results [using a processor executing] by executing the primary search query;

c) displaying a plurality of primary electronic representations representing at least a subset of [data] search results in the primary search result, the plurality of primary electronic representations being displayed in a primary search results portion of the search and display window, wherein each primary electronic representation represents a single respective corresponding [data item] search result in the primary search result;

d) receiving a secondary search query, wherein the secondary search query comprises a user selection of one of the primary electronic representations;

e) determining a secondary search result [using the processor executing] comprising a second plurality of search results by executing the secondary search query, wherein at least a portion of the [data] search results in the primary search result is different from the [data] search results in the secondary search result, wherein the secondary search result is determined by at least one of: (i) a

visual similarity search on the [data item] search result represented by the selected primary electronic representation, and (ii) a metadata similarity search based on metadata associated with the [data item] search result represented by the selected primary electronic representation; and
f) displaying a plurality of secondary electronic representations representing at least a subset of [data] the search results in the secondary search result, the plurality of secondary electronic representations being displayed in a secondary search results portion of the search and display window, wherein each secondary electronic representation represents a single respective corresponding [data item] search result in the secondary search result;
wherein when the plurality of secondary electronic representations are displayed, at least a portion of the plurality of primary electronic representations [and the plurality of secondary electronic representations] are visible at the same time; and wherein [the data in] the primary search result is unchanged by display of the plurality of secondary electronic representations [secondary search result].

The Examiner rejected claims 1-7, 10, 12-16, and 18-38 as obvious. On appeal, the Board affirmed the obviousness rejection of claims 35-38 and entered two new grounds of rejection: (1) rejecting the reissue claims as based on a defective reissue application lacking an error correctable by reissue, and (2) rejecting claims 1-7, 10, 12-14 and 29-38 as impermissibly attempting to recapture subject matter that the patentee intentionally surrendered during prosecution to overcome a §101 rejection. A request for rehearing was filed and denied. McDonald then appealed to the CAFC arguing that the Board erred in making the rejection under 35 U.S.C. 251 as being an improper recapture of surrendered subject matter, and being based on a defective reissue declaration.

Discussion

The CAFC began its opinion with a discussion of the reissue statute and the recapture rule, noting that the Supreme Court had recognized over a century ago that a patentee could seek reissue if erroneously claiming less than the right to claim in the original patent (*Leggett v. Avery*, 101 U.S. 256 (1879)). Stemming from the reissue statute, the recapture rule provides that a reissue will not be granted to "recapture" claimed subject matter that was surrendered during prosecution to obtain the original claims. The reissue statute is "based on fundamental principles of equity and fairness." *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986).

The opinion then applied the three-step recapture analysis by considering (1) whether and in what aspect the reissue claims are broader than the patent claims; (2) if broader, whether those broader aspects of the reissue claim relate to the surrendered subject matter; and (3) if so, whether the surrendered subject matter has crept into the reissue claim.

Against this backdrop, the opinion summarizes the facts of the appeal as "simple":

"By first adding the "processor" limitations during prosecution of the original claims, then removing the exact terms "using a processor executing" and "using the processor executing," Mr. McDonald seeks to reclaim a broader claim scope related to the surrendered subject matter that has now crept back into the reissue claim."

The opinion notes the reissue statute requirement of "inadvertence or mistake", concluding that McDonald made no mistake but deliberately "amended the claim scope during prosecution of the parent application, explaining that the "processor" limitation overcame the §101 rejection by tying the

methods to a particular machine. "He cannot now use the reissue application as a Trojan horse to recapture that which he deliberately gave up."

The opinion states:

We have previously explained that "this court reviews a patent family's entire prosecution history when applying both the rule against recapture and prosecution history estoppel." *MBO Lab'ys*, 602 F.3d at 1318. "Because the rule against recapture and prosecution history estoppel both protect the public's interest in relying on a patent's prosecution history, we think equity requires a review of a patent family's prosecution history to protect against recapture in a reissue patent." *Id*. We have also rejected the erroneous theory that the recapture rule "does not contemplate surrenders made while prosecuting the original application or any precedent divisional, continuation, or continuation-in-part applications. . . . We have never limited our review of recapture only to the prosecution history for the patent corrected by reissue." *Id*. at 1316.

McDonald had pointed out that prior decisions of the CAFC had been limited to amendments "to overcome a prior art rejection". In response, the opinion stated "Although we previously addressed cases centered on prior art rejections, this does not mean that the recapture rule is limited to that context."

McDonald also argued that a prior CAFC opinion held that § 112 amendments did not involve recapture because the rule "applies only if the patentee surrendered subject matter in the original prosecution in order to overcome a prior art rejection". The opinion distinguished this stating "the outcome hinged on our determination that canceling the claim in response to the indefiniteness rejection did not constitute intentional surrender of claim scope."

McDonald also pointed out that there was no surrender as the MPEP notes that surrender occurs when an amendment is made to overcome a prior art rejection. This argument was dismissed as the MPEP is merely informative and does not carry the weight of law.

With respect to the reissue declaration, the Board had held that "the statement of error in the Reissue Declaration relates to an error that is uncorrectable by reissue." The error noted in the declaration was the existence of the "processor" limitations. This was not considered a correctable error because doing so would violate the recapture rule. McDonald had conceded that the defectiveness of the declaration rises or falls with the determination on recapture.

Comments and Observations

In the author's opinion, the facts may not be as simple as stated. The claims of the continuation application, while appearing similar in some respects to the parent application, should have been considered directed to a different invention such that the "processor" limitation could have ***possibly*** been deemed unnecessary to those particular claims. For reference, the ***parent*** claim 1 is reproduced below highlighting some differences from the child continuation claims:

1. A computer-implemented method of displaying search results in a search and display window, the method comprising:

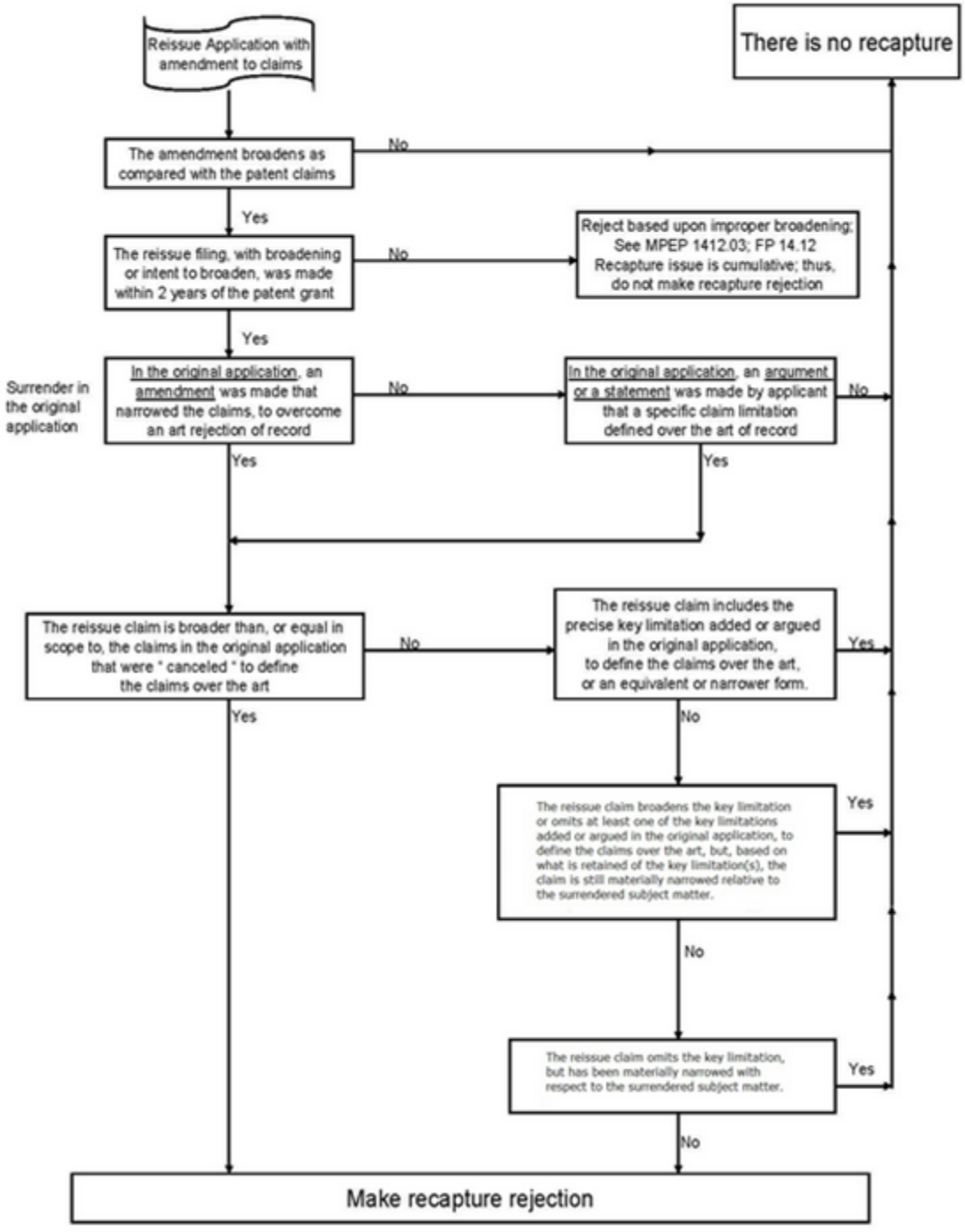
a) receiving a primary search ***term***from a user;

b) determining a primary search result using a processor executing ***a primary search query, the primary search query comprising the primary search term***;

c) displaying a plurality of primary electronic representations representing at least a subset of data in the primary search result, the plurality of primary electronic representations being displayed in a

primary search results portion of the search and display window, wherein each primary electronic representation represents a corresponding ***datum*** in the primary search result;
d) receiving a secondary search query, wherein the secondary search query comprises a user selection of one of the primary electronic representations;
e) determining a secondary search result using the processor executing the secondary search query, wherein at least a portion of the data in the primary search result is different from the data in the secondary search result, wherein the secondary search result is determined by ***a visual similarity search on the secondary search query***; and
f) displaying a plurality of secondary electronic representations representing at least a subset of data in the secondary search result, the plurality of secondary electronic representations being displayed in a secondary search results portion of the search and display window, wherein each secondary electronic representation represents a corresponding datum in the secondary search result;
wherein the plurality of primary electronic representations and the plurality of secondary electronic representations are visible at the same time; and
wherein the data in the primary search result is unchanged by display of the secondary search result; and
(g) receiving a subsequent secondary search term, and determining a subsequent secondary search result.
It is hard to fault the patentee or the Examiner for not raising the issues of recapture or a defective declaration as seen by the flow chart below from the MPEP which clearly sets forth amendments in response to ***prior art*** rejections.

Reissue Recapture - Determining its presence or absence



Take Aways

1. 35 U.S.C. §101 can trigger recapture.
2. Look out at as this case could serve as opening the door to recapture based on 35 U.S.C. §112!
3. When filing a continuation or divisional application, be aware that amendments made in the parent application could be used to invoke the recapture rule.
4. When appealing a decision, be aware of the potential for the Board to raise new rejections. When new rejections are raised on appeal, addressing such rejections adequately can be difficult.
5. Consider adding other possible errors in the reissue declaration.
6. Could traversing the obviousness-type patenting rejection in the child application have avoided the recapture by making a stronger case of separately patentable claims or overlooked aspects? Or stating that the error was an overlooked aspect? MPEP 1412.01 states that overlooked aspects of the invention are not subject to recapture "because the claims are, by definition, unrelated to subject matter that was surrendered during the prosecution of the original application. In the decision of *In re Youman*, 679 F.3d 1335, 102 USPQ2d 1862 (Fed. Cir. 2012), the Federal Circuit explained:

Whereas the recapture rule applies when surrendered subject matter is being reclaimed, overlooked aspects by definition were never claimed and thus never surrendered. See *Mostafazadeh*, 643 F.3d at 1360 [98 USPQ2d at 1644]. Rather, as we explained in *Mostafazadeh*, "overlooked aspects" is a separate inquiry under reissue that is independent of whether or not the recapture rule applies. 679 F.3d at 1347, 102 USPQ2d at 1870.

- The patentee was asserted to have intentionally amended the parent claims to overcome the §101 rejection. Couldn't be said that the claims of the child application were also intentionally "amended" in other respects to avoid §101?
- Unfortunately for the patentee, these issues would be difficult to foresee based on the guidance provided by the MPEP, and the fact that the Examiner never raised recapture during prosecution. It was only when the Board issued its decision with the new rejections based on recapture and a defective reissue declaration.

Full OpinionDownload