Nixon Peabody LLP

Federal Circuit Patent Watch

OCTOBER 12, 2006

Medtronic, Inc. v. Guidant Corp.

No. 05-1515, Federal Circuit (Michel, *Schall*, Dyk)

[W]hether recapture applies "'necessarily depends upon the facts in each case and particularly on the reasons for the cancellation.'" When we consider whether subject matter was "surrendered," we look at whether there was a deliberate withdrawal or amendment in order to secure the patent, as this kind of deliberate action is not the inadvertence or mistake that reissue is meant to remedy.

On October 12, 2006, the Federal Circuit affirmed the district court's judgment that claims 15-26 of U.S. Patent No. RE 38,119 (a re-issue of U.S. Patent No. 4,928,688), which related to a pacemaker for treating ventricular asynchrony, are not invalid for violating the rule against recapturing surrendered subject matter. The Federal Circuit stated:

> Pursuant to 35 U.S.C. § 251, a patentee may obtain reissue of a patent if the patent is, through error "without any deceptive intention, deemed wholly or partly inoperative or invalid … by reason of the patentee claiming more or less than he had a right to claim in the patent …." "In considering the 'error' requirement, we keep in mind that the reissue statute is 'based on fundamental principles of equity and fairness, and should be construed liberally.'" "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents," and is generally sufficient to justify reissuing a patent. It is not necessary that the error be unavoidable or that the error could not have been discovered by the patentee through proper communication with the prosecuting attorney.
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> Reissue proceedings, however, cannot be used to obtain subject matter that could not have been included in the original patent. Under the "recapture" rule, the deliberate surrender of a claim to certain subject matter during the original prosecution of the application for a patent "made in an effort to overcome a prior

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art rejection" is not such "error" as will allow the patentee to recapture that subject matter in a reissue. Thus, the recapture rule prevents a patentee from regaining, through reissue, subject matter that was surrendered during prosecution of the original patent in an effort to obtain allowance of the original claims.

A surrender can occur by argument as well as by amendment. [L]ike prosecution history estoppel, "unmistakable assertions made to the Patent Office in support of patentability" "can give rise to a surrender for purposes of the recapture rule." "We apply the recapture rule as a three-step process: (1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims; (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and (3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule."…

"Whether amendments made during reexamination enlarge the scope of a claim is a matter of claim construction." "'A claim of a reissue application is broader in scope than the original claims if it contains within its scope any conceivable apparatus or process which would not have infringed the original patent. A reissue claim that is broader in any respect is considered to be broader than the original claims even though it may be narrower in other respects.'"

[W]hether recapture applies "'necessarily depends upon the facts in each case and particularly on the reasons for the cancellation.'" When we consider whether subject matter was "surrendered," we look at whether there was a deliberate withdrawal or amendment in order to secure the patent, as this kind of deliberate action is not the inadvertence or mistake that reissue is meant to remedy.

In this case, there was no deliberate surrender of subject matter to obtain allowance of the claims. As discussed above, an attorney's failure to appreciate the full scope of the invention is a common source of defects in patents and has been found to be sufficient to justify reissuing a patent. It is clear from the prosecution history that neither the examiner nor the prosecuting attorney, Mr. Nikolai, considered the unconditional embodiment a part of the invention … The fact that the examiner thought that the claim was to the conditional embodiment alone is demonstrated by the examiner's amendment he made to add "minor wording changes." This is the kind of inadvertence or mistake that the reissue doctrine was meant to remedy.

For more information on these issues or other intellectual property law matters, please contact **Lawrence M. Sung, Ph.D.** at lsung@nixonpeabody.com or 202-585-8221.

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