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BLG Files Appeal to Federal Circuit on Patent Reissue Rights

Beyer Law Group (BLG) announced today that it completed its briefings in an appeal filed with the Court of Appeals for the Federal Circuit on behalf of National Semiconductor, Inc. based on the recent USPTO Board of Appeals Mostafazadeh decision (*Ex parte Mostafazadeh*, Appeal No. 2009-004238, BPAI 12/14/2009). The outcome of the appeal could impact the right of a patentee to broaden claims in a reissue patent application and affect the validity of patents previously reissued.

Under the judicially-created reissue recapture rule, a patentee is permitted to broaden claims in reissue proceedings to remove claim elements that were added during the original prosecution so long as the reissue claims are “materially narrowed in other respects” relative to claims that were disavowed during prosecution of the original patent application.

Mostafazadeh’s reissue application was rejected by the Patent Office because some of the reissue claims sought to remove selected claim elements that were added during prosecution of the original patent. However, the reissue claims were narrowed by including limitations for other features of the same embodiment as the original patent. The USPTO Board of Patent Appeals and Interferences issued a decision affirming the Patent Office’s rejection under the recapture rule on the basis that the reissue claims were directed to the same embodiment as the original claims.

Mostafazadeh’s appeal seeks to clarify the scope of the reissue recapture doctrine and asserts that properly interpreted, the reissue recapture rule only requires that the reissue claims be patentably distinct from any claims that were affirmatively disavowed during the original prosecution.

Ed Van Gieson, a member of BLG’s patent reexamination and reissue group stated: “For decades the Federal Circuit has stated that the reissue statute is to be interpreted liberally to permit the claims of an issued patent to be broadened. In contrast, the USPTO’s recent policy changes makes obtaining broadened reissue claims difficult and even impossible in many situations, such as a patent having only one embodiment. This case is important because the validity of many reissue patents in the electronics, software, and pharmaceutical fields will be affected by the rulings in this case. Additionally, this case is

important for patentees in the common situation that they simply failed to appreciate the full scope of their invention when they obtained a patent and need to use reissue proceedings to obtain the full scope of protection they deserve under the law.”

BLG is a Silicon Valley based intellectual property law firm specializing in patent related matters. For more information, see the firm's website at www.beyerlaw.com

For more information contact:
Cara Romero (408) 255-8001 x320
cromero@beyerlaw.com