



May 6, 2011

BLG COMMENTS ON DECISION IN APPEAL TO FEDERAL CIRCUIT ON PATENT REISSUE RIGHTS

Beyer Law Group (BLG) commented today on the May 3, 2011 decision of the United States Court of Appeals for the Federal Circuit in the case of *In Re Mostafazadeh*, Appeal No. 2010-1260, which was filed by Beyer Law Group on behalf of National Semiconductor, Inc. The outcome of the appeal impacts the right of a patentee to broaden claims in a reissue patent application and affects the validity of patents previously reissued.

The patent reissue statute permits a broadened reissue application to be filed within two years of the issuance of a patent. 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 filed in 2001 and languished in the patent office for almost ten years because the patent office’s procedural rules on permissible broadening were unclear and kept changing. When the reissue application was filed the patent office permitted broadened reissue claims that had a partially broadened form of a limitation added by amendment under the holding of *Clement*. Midway through the prosecution of the reissue application, the patent office changed its rules to impose a per-se bar to the use of a less restrictive form of a limitation added by amendment to satisfy the recapture rule. The patent office also effectively interpreted the recapture rule as imposing a per se bar against broadened reissue claims directed to the same embodiment as in the original prosecution.

Mostafazadeh’s appeal sought to clarify the scope of the reissue recapture doctrine. Mostafazadeh appealed on the two main grounds that: 1) material narrowing under the recapture rule should be satisfied by retaining a less restrictive form of a limitation added by amendment under *Clement*; and 2) material narrowing under the recapture rule could alternately be satisfied by including features directed to “overlooked aspects” under *Hester* that are not directly related to the limitations removed during reissue. The Federal Circuit has affirmed the first point of law raised in the appeal.

Ed Van Gieson, a member of BLG’s patent reexamination and reissue group stated:

We appealed this case on a *pro bono* basis to clarify that the patent office’s rules did not comport with Federal Circuit case law. The Federal Circuit in *In Re Mostafazadeh* agreed that the patent office misapplied the law and that under certain circumstances in a broadened reissue a “limitation may be modified so long as it continues to materially narrow the claim scope relative to the

surrendered subject matter such that the surrendered subject matter is not entirely or substantially recaptured.” This case is thus a victory in terms of providing greater flexibility for patent owners to broaden claims during reissue. However, of potential concern to other patent owners is that the Federal Circuit unfortunately has not found in our favor on the second point of law we raised, which may bar other patent owners from satisfying the “material narrowing” requirement of the recapture rule by adding limitations unrelated to the specific language added in the original prosecution, regardless of the extent of the material narrowing. We are considering whether this second issue is important enough to the patent community to pursue our remaining options to appeal this additional important issue.

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

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