



ARE Patent Law Alert: Federal Circuit Clarifies Recapture Rule For Analysis Of Reissue Claims

May 11, 2012

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(May 11, 2012). Earlier this week, the Federal Circuit in *In re Youman*, No. 2011-1136, 2012 U.S. App. LEXIS 9346 (Fed. Cir. May 8, 2012) clarified the meets and bounds of the recapture rule for broadening reissue patents.

Generally, the reissue statute allows a patentee to broaden claims in its original patent if the patentee can show “error without any deceptive intention.” 35 U.S.C. § 251. However, the recapture rule bars reissue applications that broaden claims in order to recapture subject matter surrendered during the original prosecution.

In *Youman*, the Federal Circuit applied a three-step recapture rule analysis in determining whether an applicant’s reissue claims violate the recapture rule. *Id.* at *15.

First, the reissue claims are compared to the issued patent claims to determine which, if any, aspects of the reissue claims are broader than the issued patent claims.

Next, the broader aspects of the issued patent claims are compared to surrendered subject matter during the original prosecution.

Finally, if the reissue claims are broader relative to the patented claims in a manner related to the surrendered subject matter, the broader aspects are analyzed to determine whether the surrendered subject matter has crept into the reissue claim.

Significantly, in *Youman*, the Federal Circuit held that the Board improperly applied the recapture rule by comparing the reissue claims to the patented claims, rather than to the original claims stating that “[i]f the patentee modifies the added limitation such that it is broader than the patented claim yet still materially narrows relative to the original claim, the recapture rule does not bar reissue.” *In re Youman*, 2012 U.S. App. LEXIS 9346, at *26. Thus, *Youman* holds that the recapture rule permits reissue claims of intermediate scope, namely, those between the scope of the original claim in the application and the issued claim.

We will continue to monitor and report on post-issuance patent proceedings cases, and encourage you to review the publications and events page of our firm website (www.arelaw.com) for more information. Please feel free to contact one of our firm’s attorneys to learn more.



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