

## Case Study: In Re Youman

*Law360, New York (May 11, 2012, 1:37 PM ET)* -- On May 8, 2012, the Federal Circuit provided some important clarification as to what can, and cannot, be permissibly recaptured through a broadened reissue application.

The technology at issue relates to an electronic program schedule system that allows a user to access and navigate television efficiently using a remote controller. Original claim 1 in the patent application was directed to:

An electronic television programming guide ... comprising: user control means ...; data processing means ...; a video display generator; and selection means for allowing said user to select a title for display on said television receiver by selecting the first n characters of said title, where n is greater than or equal to one; said data processing means being responsive.

During prosecution the claims were rejected over the prior art. In a response to the rejection, the claim was amended to include the phrase:

said selection means comprising means for causing each of said n characters to cycle forward and backward through a plurality of alphanumeric characters.

In responding to the rejection, the attorney prosecuting the application argued:

The system disclosed in Reed operates using a full keyboard. ... In contrast, in an EPG [Electronic Program Guide] environment, the user control device is typically a hand-held remote control transmitter with only a very limited number of keys. ... Applicants solve this problem by using the existing keys on the remote control device to input characters of a program title.

The amendments and arguments resulted in a notice of allowability. The patent issued with the limitations in claim 1.

Within two years, a reissue application was filed where new claims 24-55 were added. By the time the application reached the appeal stage, broadened claim 24 read in relevant part:

An electronic television programming guide ... comprising:

a wireless remote control, comprising nonalphanumeric keys, that generates control commands;

...wherein a user may search for a title ... by changing from a first character to a second character using the nonalphanumeric keys.

In the above claim, the word “cycle” no longer was present and the term “changing” was used instead. The Board of Appeals affirmed a rejection of the claims based upon impermissible recapture because the narrowing limitation was not directed to one or more of the overlooked aspects of the invention.

In reversing and remanding the rejection, the Federal Circuit provided the following helpful suggestions in determining whether recaptured subject matter is “permissible” or “impermissible.” After reaffirming the well-established “three-step recapture rule analysis,” the court provides some useful guidance regarding step 3, i.e., “whether the surrendered subject matter has crept into the reissue claim.”

Initially, the Federal Circuit distinguished the situations “where an added limitation has been modified versus instances where an added limitation is eliminated in its entirety”; the former sometimes being acceptable and the latter never being acceptable. In this case, the Federal Circuit held that the added limitation of “cycling” was broadened, but not eliminated altogether.

Next, the court stated: “[A] broadening modification must be evaluated to determine if it materially narrows relative to the original claim such that surrendered subject matter is not entirely or substantially recaptured.” This statement reaffirms that surrendered subject matter can be partially recaptured. The court held that it is proper to “[u]se the original [application] claim [not the patented claim] as a frame of reference for determining whether the reissue claim materially narrows.” In this regard, the court noted:

By measuring material narrowing relative to the original [application] claim, which was deliberately surrendered during the original prosecution, we are ensuring that the patentee is unable to recapture what it surrendered deliberately, but allowing room for error.”

The Federal Circuit noted that if the U.S. Patent and Trademark office were to use the patented claims as a frame of reference, this would prevent any broadening relative to the patented claims, for example in a situation where the claims were overly narrowed as a result of attorney error and would “frustrate the remedial nature of the reissue statute.” In balancing the equities between the remedial nature of the statute (which benefits the patentee) and the interest of the public (which needs to be able to rely on the scope of an issued patent in making business decisions), the Federal Circuit noted that “the public interest is protected through intervening rights.”

On remand, the court stated that “such a broadening modification must be evaluated to determine if it materially narrows relative to the original claim such that surrendered subject matter is not entirely or substantially recaptured”; directing the board’s attention to *In re Mostafazadeh* (Fed. Cir. 2011) for guidance on whether a modified limitation is a “material narrowing.”

In re Youman provides some comfort to patentees seeking to file a broadened reissue where only some of the surrendered subject matter is “recaptured” and also provides useful rules for determining how much subject matter can be permissibly recaptured.

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