

## The Federal Circuit Clarifies Law on Broadening Reissue Claims

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Legal Update

The Federal Circuit recently issued a decision in *In re Staats* confirming that patentees can seek broadened reissue claims more than two years after a patent issues as long as they first sought a broader claim within the two year period. While filing a continuing application during the pendency of an original application is usually the preferred approach, the *Staats* panel confirmed that seeking a broadening reissue is another available option, even after the two year mark.

The law governing reissue applications requires that any broadening reissue be filed within two years of the grant of the original patent. See 35 U.S.C. § 251. Courts have interpreted this to mean that only the initial application to broaden must be filed within two years, and that subsequently, other broadened claims can be submitted during the prosecution of a reissue application. See, e.g., M.P.E.P. 1412.03, Part IV. Despite this accepted practice, in *In re Staats*, the Board of Patent Appeals and Interferences (the Board) rejected broadened claims in a continuation of a reissue application because they were filed well after the two year mark, even though the original broadening reissue was filed within the two year period.

*Staats'* patent disclosed two embodiments and the first broadening reissue sought broader claims covering the first embodiment. After the two year mark, *Staats* sought additional broadened claims covering the first embodiment in a continuation of the reissue, and then sought broadened claims covering the second embodiment in a second continuation. In rejecting the broadened claims to the second embodiment, the Board held that broadened claims filed after the two year mark must be "related" to the earlier-filed broadened claims in order to comport with the public notice function of Section 251. The Federal Circuit disagreed, holding that there is no "relatedness" test, and that the outcome in this case was clearly dictated by the court's precedent, *In re Doll*, 419 F.2d 925 (CCPA 1970). Judge O'Malley wrote a separate concurring opinion in which she criticized the narrow basis that the majority provided for the ruling, and provided further support for the holding.

*In re Staats* serves as a useful reminder to consider filing a broadening reissue application when there is a possibility of seeking broader claims in the future based on the disclosure in a patent nearing the two year mark. Of course, filing a continuing application during the pendency of the original application is usually preferable to avoid the challenges associated with a broadening reissue application, including showing error without deceptive intent and dealing with recapture and intervening rights issues.

**This advisory was prepared by Nutter's Intellectual Property practice. For more information, please contact your Nutter attorney at 617-439-2000.**

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