

# The Fed. Circ. In July: Reissue Claims And The Original Patent

By **Paul Stewart and Brandon Smith** (July 24, 2023)

In a recent decision, the U.S. Court of Appeals for the Federal Circuit explained and clarified the statutory requirement that reissue claims cover "the invention disclosed in the original patent" under Title 35 of the U.S. Code, Section 251.

The court held that where a structure is not described in the specification as optional and only a single embodiment is disclosed, then a reissue claim may not be broadened to cover an entire class of structures.

In the July 12 decision in *In re: Float'N'Grill LLC*, the Federal Circuit assessed whether the Patent Trial and Appeal Board properly upheld the rejection of a proposed reissue claim based on the original patent requirement of Section 251. The court affirmed the rejection.

As practitioners are likely aware, and as the Federal Circuit decision reiterated:

[Patent applicants are] free to seek an expanded scope of coverage beyond that originally sought by filing a continuation or divisional application ... [that] may therein include claims extending to the full scope of the subject matter described in the specification under 35 U.S.C. § 112(a).

However, if a patentee seeks to change the scope of a patent through the reissue process, additional statutory requirements apply. One such requirement is found in Section 251: Reissue claims must be directed to "the invention disclosed in the original patent." This is known as the original patent requirement.

In 1942, the U.S. Supreme Court explained the standard for satisfying the original patent requirement in *U.S. Industrial Chemicals Inc. v. Carbide & Carbon Chemicals Corp.*

Reissue claims under Section 251 are valid under this requirement if "the reissue fully describes and claims the very invention intended to be secured by the original patent." This must be apparent from the face of the patent.

It is not sufficient that the reissue claims could have been claimed in the original patent "because it was suggested or indicated in the specification." In other words, the original patent requirement is different from the requirements of Section 112.

The Federal Circuit has applied the *Industrial Chemicals* standard in several prior cases. For example, in the 2019 *Forum US Inc. v. Flow Valve LLC* decision, the Federal Circuit analyzed the validity of a reissue patent.

In *Forum*, the claims originally recited a "plurality of arbors supported by the body member." The specification of the original patent included multiple embodiments, each including multiple arbors, which the patent taught allowed rapid and accurate machining by changing from one arbor to another.



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In the reissued claims, the patentee removed the "plurality of arbors" limitation and replaced it with "support that is selectively positionable."

The Federal Circuit held that this change violated the original patent requirement because the specification did not "disclose that arbors are an optional feature of the invention." Thus, the reissue patent was invalid.

In contrast, In re: Peters reversed a rejection under the original patent requirement. The original patent claimed support elements having a tapered metal tip. The reissue claims omitted the requirement that the metal tips be tapered.

The Federal Circuit in 1983 held that nothing in the specification suggested the shape of the tips was "essential or critical to either operation or patentability of the invention."

The court pointed out that the tapering limitation was not used to overcome prior art and "[m]ost importantly, one skilled in the art would readily understand that in practicing the invention it is unimportant whether the tips are tapered."

In *Float'N'Grill*, after summarizing the precedent regarding the original patent requirement in some detail, the Federal Circuit turned to *Float'N'Grill*'s claims. U.S. Patent No. 9771,132 was issued on Sept. 26, 2017.

The '132 patent "is directed to a float designed to support a grill to facilitate a user grilling food while remaining in a body of water."

The specification described a single embodiment wherein grill supports "include[] a plurality of magnets 60 disposed within the middle segment 58 of the upper support 52 of each" grill support. The court found that "[n]o other structure besides the plurality of magnets is disclosed, suggested, or implied for removably securing the grill to the supports."

The issued claims of the '132 patent recited in relevant part "a plurality of magnets disposed within the middle segment of the upper support... wherein a flattened bottom side of a portable outdoor grill is removably secured to the plurality of magnets."

Later, *Float'N'Grill* filed a reissue application with new claims that omitted the "plurality of magnets" limitation, replacing it with a more generic recitation that "a bottom side of the grill is removably securable ... atop the upper support portion of the grill support member."

The examiner rejected the proposed reissue claims based on the original patent requirement and the board affirmed.

The Federal Circuit agreed with the examiner and the board, finding that "the original description describes a single embodiment of the invention" that included "a plurality of magnets for safely and removably securing the grill to the float."

It further determined that the specification did not describe the magnets as optional, representative of removable fasteners generally, or exemplary of a broader invention. Rather, the magnets were essential as the only disclosed structure for removably and safely securing the grill to the float.

Thus, the Federal Circuit held that *Float'N'Grill*'s proposed reissue claims were similar to *Forum* where the patent did "not disclose an arbor-less embodiment of the invention." They

were different from Peters because the specification did not describe the plurality of magnets as superficial, but rather as the only disclosed embodiment that fulfills the removably securing function.

The Federal Circuit therefore held that because the reissue claims were not limited to the plurality of magnets that were essential to the invention of the original patent, the reissue claims failed the original patent requirement of Section 251, even if they might satisfy the requirements of Section 112.

While the Federal Circuit's conclusion that the claims in Float'N'Grill were closer to the claims in Forum than the claims in Peters seems correct, the Float'N'Grill decision provides little additional guidance in determining whether future claims meet the original patent requirement of Section 251.

Unlike the well-developed principles under Section 112, there are few cases elaborating upon the original patent requirement. Float'N'Grill purports to apply an essential-to-the-invention requirement based on Industrial Chemicals, but provides little guidance on how to do so.

Nevertheless, the Float'N'Grill, decision highlights, again, the additional statutory requirements that apply to reissue claims. There was no dispute in Float'N'Grill that other types of fasteners were known, and the Federal Circuit even noted that some alternatives were described in the prior art. Though this doubtlessly would have impacted a Section 112 analysis, it was essentially irrelevant to the Section 251 analysis.

The reissue claims were unpatentable because they went beyond the single structure that the specification disclosed for performing the removably securing function, despite the existence of other known structures for performing that same function.

Float'N'Grill, also illustrates the importance of keeping patent families open with pending continuation or divisional applications. This approach likely would have avoided many of the issues presented by the reissue claims.

Finally, Float'N'Grill, again demonstrates the importance of specification drafting and disclosing alternative embodiments. The Federal Circuit focused on the single disclosed embodiment of the '132 patent and several statements where the magnets were not listed as exemplary or optional embodiments.

In contrast to the oft-repeated refrain that patents are not limited to their preferred embodiments, Section 251 did not permit Float'N'Grill to expand its claims in reissue beyond the "plurality of magnets" that it disclosed.

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