

## Recent Decisions Regarding Reissue

*Antares Pharma v. Medac Pharma*

*Fleming v Escort*



© 2009 Birch, Stewart, Kolasch & Birch, LLP

## *Antares Pharma v. Medac Pharma* (Fed. Cir. 2014)

- ▶ *Antares appeals decision denying Motion for Preliminary Injunction.*
- ▶ *Denied for lack of showing of likelihood of success because claims added during reissue are likely invalid for violating the recapture rule*



© 2009 Birch, Stewart, Kolasch & Birch, LLP

## Original and Reissue Patent

- Original Patent 7,776,015 issued on August 17, 2010
- All claims recite a “jet injector” limitation to distinguish claims over prior art.
- Within two years, filed reissue application retaining original claims 1-22 and adding new claims 23-37



© 2009 Birch, Stewart, Kolasch & Birch, LLP

## Original and Reissue Patent, cont.

- Reissue claims do not recite “jet injector,” but recite “injection devices” having safety features, such as a latch, pushbutton and needle guard.
- Antares admits that reissue claims are directed to different invention



© 2009 Birch, Stewart, Kolasch & Birch, LLP

## 35 U.S.C. 251

- ▶ Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, **reissue the patent for the invention disclosed in the original patent**, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.
- ▶ No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.



© 2009 Birch, Stewart, Kolasch & Birch, LLP

## Compared to Continuation and Divisional Applications

- Court states that claims can be pursued in a continuation and divisional application restricted by only the requirement of the written description requirement
- Seeking to add claims in a reissue application requires that the claims not violate the recapture rule and the statutory original patent requirement



© 2009 Birch, Stewart, Kolasch & Birch, LLP

## Recapture Rule

- ▶ Three part test:
  - 1) whether, and in what respect, the reissue claims are broader
  - 2) Whether broader aspects relate to surrendered subject matter
  - 3) Whether the claims were materially narrowed in other respects to avoid recapture rule



© 2009 Birch, Stewart, Kolach & Birch, LLP

## Recapture Rule

Materially narrowed in overlooked aspects (ie. not previously claimed)

-Hester Industries, Inc. v. Stein, Inc. 142 F.3d 1772, 46 USPQ2d 1641

Recapture rule avoided when

- 1) Aspects of the invention were overlooked and not claimed; and
- 2) Patentably distinguish over the prior art



© 2009 Birch, Stewart, Kolach & Birch, LLP

## Original Patent Requirement

- ▶ This “original patent” requirement is roughly equivalent to both the *written description requirement* and the *prohibition on new matter* — all three basically require that the original patent specification disclose the particular invention now being claimed.



© 2009 Birch, Stewart, Kolach & Birch, LLP

## Precedent applied

- ▶ The leading Supreme Court case on the topic is *US Industrial Chem v. Carbide & Carbon Chem*, 315 U.S. 668 (1942). In that case, the Supreme Court held the asserted reissue invalid because claimed solution no longer required water even though the original specification had at least hinted that water was optional. There, the court held that reissued claims must be “the same invention described and claimed and intended to be secured by the original patent.”



© 2009 Birch, Stewart, Kolach & Birch, LLP

## Precedent applied

- It is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification but must be explicitly disclosed and taught in the specification- *McCullough Tool Co. v. Well Surveys, Inc.* 343 F.2d 381 (10<sup>th</sup> Cir 1965)
- Court has rejected an “intent to claim” test  
In re Mead, 581 F.2d 251 (C.C.P.A. 1978)



© 2009 Birch, Stewart, Kolach & Birch, LLP

## Original Patent Requirement

- The specification discussed only one invention: a particular class of jet injectors. . . . Although safety features were mentioned in the specification, they were never described separately from the jet injector, nor were the particular combinations of safety features claimed on reissue ever disclosed in the specification. Rather, the safety features were serially mentioned as part of the broader conversation: how to build the patented jet injection device



© 2009 Birch, Stewart, Kolach & Birch, LLP

## Original Patent Requirement

- Nowhere does the specification disclose, in an explicit and unequivocal manner, the particular combinations of safety features claimed on reissue, separate from the jet injection invention. This does not meet the original patent requirement under Section 251
- Looked to Title (Needle Assisted Jet Injector), Abstract (A jet injection device ...), Summary of Invention (The present injection related to a needle assisted jet injector), the repetitive descriptions of the "present invention" as being for a jet injector and use of the word "jet" 48 times in 7 page specification.



© 2009 Birch, Stewart, Kolach & Birch, LLP

## In re Amos, 953 F.2d 613 (Fed Cir 1991)

- The specification expressly disclosed that rollers, as they approached the end of the table, could be raised either mechanically by the roller cams or electronically by the computer controlling the router
- Original claims covered only covered mechanical embodiment



© 2009 Birch, Stewart, Kolach & Birch, LLP

## Conclusion

- The specification must clearly and unequivocally disclose the newly claimed invention as a separate invention to satisfy the original patent requirement



© 2009 Birch, Stewart, Kolach & Birch, LLP

## Fleming v. Escort

- Claims directed to radar detector having GPS system to reduce false alarms
- A method, executed by a device having a position, of generating an alert to an incoming radar signal having a frequency and a signal strength, the method comprising the acts of:
  - (a) detecting the incoming radar signal;
  - (b) determining the position of the device that detected the incoming radar signal; and
  - (c) generating an alert if the position of the device is not within a predetermined distance of a predetermined position.



© 2009 Birch, Stewart, Kolach & Birch, LLP

## Reissue Application

- Amends independent claim 11, rewrites claim 18 into independent form, add many dependent claims
- Claims error is not having claimed certain features, now recited in new claims
- Escort states that there is no error being corrected



© 2009 Birch, Stewart, Kolach & Birch, LLP

## Recapture not an error

- ▶ Deliberate withdrawal or amendment cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the withdrawn subject matter



© 2009 Birch, Stewart, Kolach & Birch, LLP

## Explanation by Fleming

---

- Wrote the application from the perspective of a programmer
- Inventor prosecuted application himself
- Has registration number
- Accepted by Court – even if marketplace developments prompted inventor to reassess issued claims and notice their deficiencies



© 2009 Birch, Stewart, Kolasch & Birch, LLP

## Conclusion

---

- Any questions



© 2009 Birch, Stewart, Kolasch & Birch, LLP