Checking the Staats: How Long is Too Long to Give Adequate Public Notice in Broadening Reissue Patent Applications?

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CHECKING THE STAATS: HOW LONG IS TOO LONG TO GIVE ADEQUATE PUBLIC NOTICE IN BROADENING REISSUE PATENT APPLICATIONS?

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INTRODUCTION

From its grounding in the U.S. Constitution² to its staggeringly complex application in modern society and business, intellectual property—and in particular, patent law—has always required a palatable balance between adequate public notice and providing enforceable rights. One question looms large in the field of patent law: where do the rights of inventors end and the rights of the public begin? Analyzing this question poses significant difficulties even after grant of a patent, as demonstrated by the explosive growth in post-grant adjudication both at the U.S. Patent & Trademark Office (“USPTO”) and in the courts.³ Portions of the recent Leahy-Smith America Invents Act appear to reinforce that the scope of property rights accorded by the “limited monopoly” of a patent may shift during the lifetime of the patent.⁴

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² See U.S. CONST., art. I, § 8, cl. 8 (“The Congress shall have Power … To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”)


⁴ See, e.g., Leahy-Smith America Invents Act, H.R. 1249, 112th Cong. § 6, chs. 31–32 (signed into law by President Obama on Sept. 16, 2011) (sections of patent reform bill addressing post-grant review procedures).
One of the most straightforward ways patent owners can expand the limited monopoly of one of their patents is by seeking increased claim scope via one or more broadening reissue patent applications. While patent owners may narrow the scope of the patent claims at any time during the lifetime of the patent, they may only broaden claim scope for a limited period of time after issuance of the patent. Despite the relatively straightforward statutory provision of 35 U.S.C. § 251, however, a remarkable body of case law has addressed the provision, dating back well over a century. In particular, notice must be given of the intent to broaden, and current jurisprudence specifies that manifestation of such intent should have been “foreseeable,” within two years from the issue date of the patent. Under what circumstances, however, should a patent owner be allowed to broaden claim scope beyond the statutory window of two years after issuance of the patent?

As any registered patent practitioner knows, patent applications are notoriously complicated legal documents, difficult to draft in a manner that accurately and broadly captures the full scope of the invention, and all too often placed in the hands of those inexperienced in drafting their disclosure. The current patent system provides little incentive for patentees or the

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5 See MPEP § 1412.03 (8th ed. Rev. 8, Jul. 2010), discussing implementation of 35 U.S.C. § 251 (2006) (“No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.”).


Simply put, the broadening in the present reissue application is in a manner that was completely unforeseeable by the public within the two-year period following the original patent's issuance—a fact likewise admitted at the oral hearing. Despite Appellants' arguments to the contrary, permitting such an unforeseeable broadening nearly eight years after Appellants' original patent issued simply runs counter to the underlying public notice function of § 251—notice that must be timely to ensure meaningful reliance on the finality and certainty of patent rights.
U.S. Patent and Trademark Office to spend sufficient time and money to prosecute a high-quality patent;\(^8\) the result is a kudzu-like thicket of low-quality, under-descriptive patents.\(^9\) Moreover, as discussed almost 120 years ago in Topliff v. Topliff, the Supreme Court noted, with remarkable foresight about today’s reissue dilemma:

To hold that a patent can never be reissued for an enlarged claim would be not only to override the obvious intent of the statute, but would operate in many cases with great hardship upon the patentee. The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention, provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it….\(^{10}\)

As will be evident to the reader from a study of Topliff, it appears that some things never change.\(^{11}\)

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\(^8\) See generally Mark A. Lemley, Rational Ignorance at the Patent Office, 95 NW. U. L. REV. 1495 (2001) (weighing incentives of patentees and the U.S. Patent and Trademark Office and finding that it generally favors both to file a higher volume of patent applications that are of lower quality: “In short, the PTO doesn’t do a very detailed job of examining patents, but we probably don’t want it to. It is ‘rationally ignorant’ of the objective validity of patents, in economics lingo, because it is too costly for the PTO to discover those facts.” Id. at 1497 (internal footnote omitted)).

\(^9\) See Robert P. Merges, As Many as Six Impossible Patents before Breakfast: Property Rights for Business Concepts and Patent System Reform, 14 BERRKELEY TECH. L. J. 577, 577, 579, 588–91 (1999) (arguing that the increased volume of patent applications, particularly as patentable subject matter has expanded in the courts, has “pushed the patent system into crisis.”).


\(^11\) See, e.g., 59 Off. Gaz. Pat. Office 1257–62 (1892) (summarizing Topliff and noting that claims could be broadened “provided it is evident that there has been a mistake and that the applicant has been guilty of no want of reasonable diligence in discovering it,” that there was a presumption that after two years from issuance anything not claimed had been “abandoned,” and further discussing the idea of undue delay and laches, all of which are at issue in Staats; see Part II, infra.).
Under such circumstances, where reissue applications may serve a valuable function in the patent system, how can we separate the wheat from the chaff, so to speak, such that patent owners may broaden claim scope beyond the statutory window of two years after issuance, while still protecting the public’s right to rely on the scope of the patent as originally issued?

Recently, this question has again come under scrutiny in the courts. In 2010, the Board of Patent Appeals and Interferences (“the Board”) denied Apple Computer, Inc. the right to broaden the claims of five of its patents on grounds that it had failed to provide proper notice within the two year statutory window. Apple appealed one of the cases, In re Staats, to the Court of Appeals for the Federal Circuit (“the CAFC”), and oral arguments were heard on September 8, 2011. The decision of the CAFC panel, expected in early 2012, has the potential to become the most definitive statement in broadening reissue practice in almost twenty years, and will likely coincide with sweeping changes recently signed into law in the Leahy-Smith America Invents Act.

Part I of this article will review the pertinent case law in the realm of reissue patent practice, particularly in the context of the statutory window for broadening reissues. Part II will analyze the facts of the Staats case currently before the CAFC. Part III will critically review the arguments presented by the parties in Staats to the CAFC as well as larger public-policy themes relevant to resolution of the arguments. Finally, Part IV will offer concluding remarks.


14 Leahy-Smith America Invents Act, H.R. 1249, 112th Cong. § 6, chs. 31–32 (signed into law by President Obama on Sept. 16, 2011) (sections of patent reform bill addressing post-grant review procedures).
I. REISSUE JURISPRUDENCE

"These provisions [concerning patent reissue practice] have often been before the courts and there are sharply differing views concerning them."15

The concept of patent reissue in the U.S. dates back nearly as far as the concept of patents themselves. A reissue provision first appeared in the Patent Act of 1832,16 which was passed on July 3, 1832, largely in response to the Supreme Court case Grant v. Raymond,17 decided in January of the same year. The relevant provision of the Patent Act of 1832 thus read:

That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of [the Patent Act of 1793], or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of the said act.18

The general stipulations of this provision survive today,19 with minor changes in language and the formal codified addition of the two-year statutory period upon the passage of the Patent Act of 1952.20

16 An Act Concerning Patents for Useful Inventions, ch. 162, 4 Stat. 559 (1832).
17 31 U.S. 218 (1832).
18 An Act Concerning Patents for Useful Inventions, ch. 162, 4 Stat. 559 (1832).
20 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,
By the midnineteenth-century, patentees were using—and abusing—the reissue statutes in the rapidly industrializing United States. Abuse of reissue statutes led to the landmark decision in *Miller v. Brass Co.*,21 where the Supreme Court stated the problem as follows:

But by a curious misapplication of the law [the reissue provision] has come to be principally resorted to for the purpose of enlarging and expanding patent claims. And the evils which have grown from the practice have assumed large proportions. Patents have been so expanded and idealized, years after their first issue, that hundreds and thousands of mechanics and manufactures, who had just reason to suppose that the field of action was open, have been obliged to discontinue their employments, or to pay an enormous tax for continuing them.22

The Supreme Court reiterated that reissue was only available in the case of a mistake, and for the first time set the period in which reissue must be applied for at two years.23 This two-year window was consistently applied by courts from that point forward, to an extent that it was formally written into the Patent Act upon its midtwentieth-century retooling in 1952.24 *Miller v. Brass Co.* (also known as “*Bridgeport Brass*”) has been cited thirty-seven times by the Supreme Court since 1882 and remains good law today. An example of the consistent application of the two-year window can be seen in *In re Otto*, a 1919 case from the Court of Appeals of the District of Columbia.25 The court noted: “We must now regard the law as well settled by the Supreme Court for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

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20 Patent Act of July 19, 1952, Pub. L. No. 82-593, 66 Stat. 792 (1952) (codified as amended at 35 U.S.C. §§ 1–318 (2006) (“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.”). As discussed *infra*, this was merely the codification of a common law rule that had been in use for decades.
21 104 U.S. 350 (1881).
22 Id. at 355.
23 Id. at 352 (“If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public.”).
24 See LADAS & PERRY, LLP, A BRIEF HISTORY OF THE PATENT LAW OF THE UNITED STATES n.37, http://www.ladas.com/Patents/USPatentHistory_fn.html#fn37 (last updated Jul. 17, 2009) (“When the code was established prior laws had been compiled into it but nor re-enacted. Subsequently it was felt desirable to clean up and re-enact each title of the code as positive law. In 1952 it was patents[*] turn.”).
25 259 F. 985 (D.C. Cir. 1919).
Court of the United States that, after the lapse of two years after the issue of a patent, a reissue which seeks to enlarge the claims of the original patent will not be granted.”\textsuperscript{26} The court went on to state that exceptions were possible, but that diligence would certainly be required.\textsuperscript{27}

Other alterations and expansions of the reissue privilege have been comparatively recent.\textsuperscript{28} An important decision came from the Court of Customs and Patent Appeals, the predecessor to the CAFC, in the 1970 case \textit{In re Doll}.\textsuperscript{29} In that case, the USPTO issued the patent in question with nineteen claims on December 20, 1955. A reissue application containing twelve additional, broadened claims for the purpose of provoking an interference was properly filed on October 31, 1957—one year and ten months after the initial issue.\textsuperscript{30} But during further \textit{ex parte} proceedings and a second interference, the patentees added and amended additional claims as late as October 16, 1962, nearly seven years after issue.\textsuperscript{31} The USPTO rejected the claims that were added outside the two-year period, stating that they were time-barred by 35 U.S.C. § 251.\textsuperscript{32} The patentee appealed, arguing that the plain language of the statute “unless \textit{applied for} within two years from the grant of the original patent”\textsuperscript{33} meant exactly that: the application for reissue patent merely needed to be \textit{applied for} within the two years, with the right to thereafter tinker with its scope preserved.\textsuperscript{34} The court looked to the legislative history of the 1952 Patent Act, and was “unable to ascertain . . . any intent similar to the interpretation placed on section 251 by the board. To the contrary, it appears clear that the language ‘applied for’ refers to filing of an application.”\textsuperscript{35} The government argued that the “rights of the public” demanded the rejection of the expanded claims, but the court disagreed, stating that it was unnecessary to even reach the issue due to the plain-meaning interpretation of section 251.\textsuperscript{36} The

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\textsuperscript{26} \textit{Id.} at 986 (quoting \textit{In re Starkey}, 21 App. D.C. 519, 525 (D.C. Cir. 1903)).
\textsuperscript{27} \textit{Id.}
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court did note, however, that “35 USC 252 provides safeguards for the public by virtue of its intervening rights provisions.”

Later decisions have further defined the softer contours of the blunt two-year restriction. In In re Fotland, the CAFC affirmed the rejection of broadened claims introduced outside the two-year window when an application had been filed within two years. The reissue application in question, however, was a so-called “no defect” reissue application filed under 37 C.F.R. § 1.175(a)(4). During prosecution of the reissue application, the examiner deemed that there was no impact on the patent by the new references and rejected the application for reissue. The reissue applicants responded, then two years and three months after issue, by amending the claims and attempting to convert the reissue application to one under a different regulation that

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28 This article chiefly focuses on the major cases of the last forty years. For a detailed summary of the evolution of reissue jurisprudence prior to the 1970s, see Federico, supra note 10, at 605–24.
29 419 F.2d 925 (C.C.P.A. 1970).
30 Id. at 926.
31 Id.
32 Id.
34 Doll, 419 F.2d at 926–27.
35 Id. at 928 (emphasis in original).
36 Id.
37 Id. (emphasis in original.)
38 779 F.2d 31 (Fed. Cir. 1985).
39 Id. at 32.
40 Id. 37 C.F.R. § 1.175(a)(4) was repealed in 1982 as it was deemed to be redundant to the then newly instituted ex parte reexamination process. See id. at 32 n.1 (citing 47 Fed. Reg. 21746, 21748–49, 21752 (May 19, 1982)). The provision in effect at the time of the events of Fotland read as follows:

(4) When the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid, particularly specifying such prior art or other information and requesting that if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent.

37 C.F.R. § 1.175(a)(4) (1980). The provision essentially allowed a patent holder who found new prior art relevant to the invention post-issue to bring it to the USPTO and obtain re-review of their claims without amending the claims or the specification. See Robert W. Fieseler, Note, Staying Litigation Pending Reexamination of Patents, 14 Loy. U. Chi. L. J. 279, 285 (1983).
41 Fotland, 779 F.2d at 32–33.
would have allowed broadening.\textsuperscript{42} The USPTO and the Board rejected the reissue claim amendments as being made outside the permissible two-year window. The applicants appealed to the CAFC, urging that a reissue application had been filed within two years of patent grant.\textsuperscript{43} The CAFC affirmed, however, stating that \textit{Doll} authorized later broadening only when a \textit{broadening} reissue was filed within two years; a “no defect” reissue was not within the purview of the plain language of the statute.\textsuperscript{44}

Two cases in the next decade affirmed both \textit{Fotland} and \textit{Doll}, and provided more detail in the context of when broadening reissue applications were permissible. First, a Board decision in \textit{Buell v. Beckestrom} held that \textit{divisional} reissue applications that broadened claims outside the two-year window were permissible under 35 U.S.C. § 251, so long as an intervening reissue that demonstrated intent to broaden was filed \textit{within} the two-year period.\textsuperscript{45} Second, the CAFC later affirmed in \textit{In re Graff} that both \textit{divisional} and \textit{continuation} reissues could include broadened claims more than two years after issuance, if, as in \textit{Buell}, patentees filed a proper parent-broadening reissue application within two years of patent grant.\textsuperscript{46} The particular reissue application in \textit{Graff}, however, was held insufficient because the parent reissue application only sought to correct an error in a figure, not to broaden the claims.\textsuperscript{47} The \textit{Graff} court particularly focused on public notice, stating:

\begin{quote}
The reissue statute balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope, with the public interest in finality and certainty of patent rights . . . . The interested public is entitled to rely on the absence of a broadening reissue application within two years of grant of the original patent.\textsuperscript{48}
\end{quote}

\textsuperscript{42} Id. at 33.  
\textsuperscript{43} Id.  
\textsuperscript{44} Id. at 34.  
\textsuperscript{46} 111 F.3d 874, 876–77 (Fed. Cir. 1997).  
\textsuperscript{47} Id. at 877 (citing \textit{Fotland}).  
\textsuperscript{48} Id.
In summary, if and only if a patentee properly files a broadening reissue application based on an “error” within two years of patent issuance, would further broadening be possible for later-filed reissue applications claiming priority from an original (“parent”) reissue application. It is critical to note that an “error” under § 251 has also developed a standard definition in the case law—to state this in the negative, surrendering claims during prosecution of the application which led to an issued patent in order to gain allowance of other claims is not an “error” that justifies a reissue.\(^4\) This is known as “recapture,” which is generally not permitted to any real extent and is described in the MPEP and most recently discussed by the CAFC in *In re Mostafazadeh* in 2011.\(^5\) So, essentially the reissue jurisprudence stood—until the landmark year of 2010.

### II. Multiple Bites from “The Apple”—*Kelly, Riddle, and Staats*

A new dimension has evolved in the doctrine of broadening reissue over the last two years: what if a patentee properly files a broadening reissue application within the two-year window, but then attempts to broaden again, in a different manner from the original reissue application, via one or more continuation reissue applications filed outside the two-year window? This question forms the basis of five rejected reissue applications directed towards computer-system architecture from Apple Computer, Inc. in 2010-2011. *Ex parte Kelly*,\(^5\) *Ex parte Staats*,\(^5\) and three different rejected reissue applications in *Ex parte Riddle*,\(^5\) were all...

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\(^5\) See MPEP § 1412.02; see also *In re Mostafazadeh*, 643 F.3d 1353, 1358 (Fed. Cir. 2011). The *Mostafazadeh* court held that a claim could be broadened in a reissue to incorporate surrendered subject matter if the claim is also materially narrowed with respect to the surrendered subject matter.


broadening reissue applications filed by Apple and rejected by various USPTO examiners under 35 U.S.C. § 251 for improper broadening outside the two-year window.

The facts of each case were essentially identical and were treated as such by the Board. In each case, the Board did not dispute that Apple properly filed a broadening reissue application within the two-year statutory period, or that proper continuation reissue applications were later filed outside of the initial two-year window. In all cases, Apple acknowledged filing all of the relevant rejected reissue applications (in some cases, as in Staats, the second or third continuation reissue claiming priority to the original, “qualifying” reissue application) “to broaden the claims in different ways.” The examiners in each case rejected the claims as impermissible attempts to broaden, since the entirely different manner of broadening proposed in the latest reissue applications would deny the public the benefit of sufficient notice. Apple appealed each case and argued that while “an intent to broaden” must certainly be shown within the two-year period—and in each case, was shown—the “eventual scope” of the initial broadening need not be fully laid out in that first reissue application filing inside the two-year period. Since the public was duly notified of any intent to broaden within two years of patent issuance, earlier case law such as Doll should permit any broadening in a later—and properly filed—continuation or divisional reissue application.

54 See, e.g., Kelly, No. 2009-006496, 2010 WL 3454272 at *1 (“Since the present application pertains to substantially the same issue of law as in Staats, the reasoning in Staats applies largely to the issue before us in this appeal.”).
55 See, e.g., Staats, No. 2009-007162, 2010 WL 1725728 at *2 (“The Examiner found that the present reissue application impermissibly broadens the patented claims beyond two years from the original patent's issuance. The Examiner assumed that the present application is a proper continuation application . . . [and] that Appellants indicated an intent to broaden the patented claims within two years.”)(citations omitted).
56 See id.
57 Id.
58 Id.
59 Id.
60 See id. (“According to Appellants, so long as the public is notified of any intent to broaden within two years, it is unnecessary to notify the public of the specific scope of broadening within that time period.”) (emphasis in original).
Thus, Apple appealed a fairly concrete issue to the Board—“whether a continuing reissue application can broaden patented claims beyond the two-year statutory period in a manner unrelated to the broadening aspect that was identified within the two-year period.” As the Board admitted, “[t]his is a case of first impression.” The Board first looked to the statute and the case law, and noted that the holding of Graff in particular neatly presented the issue of adequate public notice by stating that the “public is entitled to rely on the absence of a broadening reissue application within two years of grant of the original patent.” Here, though, there was a relevant broadening reissue within two years—it was just intended to broaden a different aspect of the patent claims than that of the rejected second reissue application. Apple’s patent at issue in Staats contained claims directed to two embodiments. The original reissue application, properly filed on the two-year anniversary of issue, sought to broaden claims directed to one embodiment. On the other hand, the claims in the rejected continuation reissue application, filed some six years later, sought to broaden claims directed to another embodiment. Apple was forthright about this fact, conceding it “absolutely” during oral argument before the Board.

In the end, the Board affirmed the USPTO and rejected all of the broadened claims in the continuation reissue applications. Stating that such unforeseeable broadening would “run[] counter to the public notice function underpinning § 251,” the Board refused to allow the

61 Id. at *3.
62 Id. at *7.
63 Id. (quoting In re Graff, 111 F.3d 874, 877 (Fed. Cir. 1997)).
64 U.S. Pat. No. 5,940,600 (issued Aug. 17, 1999).
66 Id. at *8.
67 See id. at *8 nn. 10–11 (when asked by Administrative Patent Judge Jeffery whether the original broadening declaration was to a different embodiment than the present application and whether “no one could have foreseen” the second broadening based on the original declaration, Apple’s counsel responded “Absolutely” to both questions).
68 See, e.g., id. at *15 (“For the foregoing reasons, Appellants have not persuaded us of error in the Examiner’s rejection of claims 12-32 under 35 U.S.C. § 251. Therefore, we will sustain the Examiner’s rejection of those claims.”)
continuing reissue application because “[t]o hold otherwise would effectively give Appellants a license to unforeseeably shift from one invention to another via reissue well beyond the two-year statutory period.”69 Apple’s arguments that Doll, Graff, and even the MPEP permitted their actions were soundly rejected by the Board.70 The Board distinguished Doll and Graff because the broadening in those cases was directed toward the same embodiment, whereas in the present case multiple embodiments were at issue.71

Interestingly, Apple’s MPEP-based arguments are worth noting. Apple cited MPEP § 1412.03(IV) in its brief, which reads in pertinent part “[w]here any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period.”72 On appeal, the Board conceded that this passage of the MPEP seemed to indicate via “ambiguous expansive” language that the second broadening might be allowable.73 But the Board noted that the July 2008 revision to the MPEP made an important change to this provision: it inserted the word “unequivocally” between “is” and “indicated.”74 The provision thus now reads “[w]here any intent to broaden is unequivocally indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period.”75 One is left to wonder, however, whether Apple could have reasonably anticipated this new qualifying provision in the language of the MPEP. Curiously, Apple did not challenge this discrepancy either in its briefs or at oral argument at any level of the appeals.

69 Id. at *9.
70 See id. at *9–13.
71 Id. at *10.
72 Id. at *11, *11 n.20.
73 Id. at *11.
74 Id. (citing MPEP § 1412.03 8th ed. Rev. 7, Jul. 2008).
75 Id.
The Board finally rejected Apple’s claims in *Staats* in November 2007—almost eight months before this revision to the MPEP came into effect. Moreover, the claim rejections in *Kelly* also occurred before the July 2008 MPEP revision; and the rejections in *Riddle* would have taken place after the revision. Nevertheless, the Board believed that the public-notice function of 35 U.S.C. § 251 trumped the MPEP taken alone.

The Board decided the *Kelly* and *Riddle* cases after *Staats* using virtually identical reasoning, given the virtually identical facts of the interrelated appeals. Apple appealed the *Staats* decision to the Federal Circuit on June 24, 2010, soon after release of the Board opinion on April 26, 2010. The parties completed briefing in April 2011, and the CAFC heard oral arguments on September 8, 2011.

### III. *Staats* – “OVERLY BROAD”? 

The *Staats* case presents a collision of two robust statutory interpretations and two equally weighty sets of policy considerations. On the one hand, the public-notice function cited by both the USPTO and the Board, and regarded as a hallmark of the protections in 35 U.S.C. § 251, is crucial. The public has the right to know what is claimed and disclaimed in a patent,

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76 *Id. at *6.
and patentees should not be able to reshape their inventions throughout the life of the patent simply by lodging a “placeholder” broadening reissue application within two years of patent issuance, from which any number of potentially disparate continuing reissue applications could be filed. Allowing such activity without adequate safeguards would result in a nightmare scenario where millions, perhaps billions, of dollars could be spent by a competitor based on knowledge of the bounds of the limited monopoly granted by a particular patent, only to stare down an infringement action years later after the boundaries of the limited monopoly have shifted.

Abuse of reissue practice, particularly in the context of continuation reissue applications, is nothing new. Testimony before Congress in 1878 during consideration of Patent Act amendments reflected the serious concern of members of Congress and members of the patent bar regarding the potential for misconduct: “Scratch a reissue and you will find a fraud. In nine cases out of ten you will find a fraud upon the law, and in every instance a fraud in fact.”

These doomsday visions are akin to the parade of horribles frequently presented by arguments against “submarine”-type patents, so called because they surface after years submerged in prosecution pendency to essentially “torpedo” mature industries and collect rents. The chilling effect that such a similar system of ever-shifting reissue application scope would have on innovation is indisputable. When faced with the choice of ramping up R&D only to shut it down

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85 See, generally, Timothy R. DeWitt, Does Supreme Court Precedent Sink Submarine Patents?, 38 IDEA 601 (1998) (citing Miller v. Brass Co., 104 U.S. 350 (1881)) (outlining the dangers presented by patents that enlarge their scope “many years” after issuance). See also Federico, supra note 10, at 636-637 (discussing in passing the concept of presenting “dominating” claims “sometime after the application has been filed” in the context of intervening rights, and calling for further study in the context of reissue patents).
at or before production when a broadening reissue application changes the landscape, one can imagine the stifling effect unbridled broadening reissue applications could have on the market at large.

On the other hand, as argued by Apple in the *Staats* appeal to the Board, the CAFC in *Doll* held that the intervening rights provided by 35 U.S.C. § 252 are potentially sufficient to counterbalance the damage to public notice done by broadening reissues.\(^{86}\) That is, there is a clear *quid pro quo*—in exchange for a reissued patent, the patentee must “surrender” the original patent.\(^{87}\) Furthermore, given the recent transparency in publication and prosecution practice for pending applications and reissue applications at the USPTO, applicants already surrender a great deal of secrecy before issuance of a patent or reissue patent. Any broadening reissue patent would of course still have to be supported by its specification or other claims, which could have effectively been part of the public knowledge for years before the broadening. Therefore, one can argue that nothing would serve to hamper a competitor from developing a competing and noninfringing product with improvements in the years it would undoubtedly take for the USPTO to wade through applications, reissues, and continuations of those reissues.\(^{88}\)

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> A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent.


\(^{88}\) *But see* Ganzi, *supra* note 83, at 594–95 (arguing that new publication regimes actually serve to undermine public notice by complicating intervening rights remedies).
In considering broadening reissue applications, their publication, and their effect on competition, what is a “reasonable” delay for the purposes of bringing broadened reissue claims to the table? What is “foreseeable?” Should the public be left to divine the scope of potential reissue patent claims from each application disclosure? And where should we draw the line? These are questions that the CAFC will need to tackle in considering the Staats appeal.

The parties’ briefs provide a fascinating preview of the arguments they brought before the CAFC panel on September 8, 2011. For example, in their opening brief, Apple states that forty years ago Doll established that as long as a broadening reissue is on file within the statutory two-year period, claims can be further broadened after that two-year period. As reinforced over the years by Fotland, Graff, and the MPEP, this initial public notice within two years of patent issuance should adequately balance the needs of patentees and the public.

As reinforced over the years by Fotland, Graff, and the MPEP, this initial public notice within two years of patent issuance should adequately balance the needs of patentees and the public. The public-notice policy rationale was the chief force behind the Board’s decision—but that rationale has been rejected many times before by the CAFC and its predecessor. Apple argued that Doll and its progeny are still good law, and thus are binding on the CAFC and the PTO. Furthermore, the MPEP has maintained the “any intent to broaden” language as being sufficient for decades, so a decision against Apple on appeal would overturn that precedent.

Another compelling argument in Apple’s opening brief was that the “embodiment” restriction imposed by the Board constituted an “extra-statutory limitation,” which the CAFC has

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90 Id. at *11 (quoting In re Graff, 111 F.3d 874, 877 (Fed. Cir. 1997)) (35 U.S.C. § 251 “balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope, with the public interest in finality and certainty.”).
91 Id. at *26–27.
92 Id. at *32–34.
93 But, practitioners have recently been receiving USPTO rejections on continuation reissue applications implicitly based on the reasoning in Staats. Consequently, the “any intent” language appears to be marginalized at the USPTO at present, pending the decision at the Federal Circuit.
94 Id. at *34–37.
consistently ruled impermissible. After documenting a number of cases where extra requirements on reissue applicants were rejected, Apple declares that this is anything but “a case of first impression.” According to Apple, the Board’s allusion to prosecution laches is also misplaced and irrelevant, as six years should not be deemed an “unreasonable” delay assuming the applicant demonstrated unequivocal intent to broaden in a broadening reissue application filing within two years of patent issuance, and prosecution of reissue application(s) was diligent during that time. It would thus appear that in order to rule against Apple, the CAFC would have to expressly overrule Doll and Graff, or abrogate them substantially. Apple concluded its opening brief by addressing the public-notice policy concerns: to the extent that such a policy would be relevant, any panic is overblown. The public has plenty of notice via other existing mechanisms, such as publication and transparency of reissue prosecution, and potentially intervening rights would be available. Inventors’ rights must also be taken into account, and they should not be required up front to show their cards all at once when so much is at stake.

From the perspective of owners of intellectual property and many patent practitioners that represent large corporate clients, Apple’s argument appears on its face to be quite compelling. As the USPTO prosecution process has become ever more transparent (and unfortunately, ever more backlogged), the public has plenty of time to gain notice of what pending applications

95 Id. at *40–41.  
96 Id. at *41–45 (citing Graff, 111 F.3d at 876–77 (preclusion of multiple reissue patents was “beyond the strictures” of § 251 because the plain language of the statute contained no such limit); In re Amos, 953 F.2d 613 (Fed. Cir. 1991) (rejecting an “intent to claim” requirement); In re Doyle, 293 F.3d 1355, 1363 (Fed. Cir. 2002) (preclusion of linking claims in a broadening reissue rejected); In re Bauman, 683 F.2d 405, 407 (C.C.P.A. 1982) (a rule prohibiting regular utility applications from claiming the benefit of reissue applications for filing date purposes was rejected as being extra-statutory to 35 U.S.C. § 120); In re Doll, 419 F.2d 925, 928 (C.C.P.A. 1970) (requirement that each broadening claim be asserted within the two-year window rather than a broadening application was extra-statutory)).  
97 Id. at *43.  
98 Id. at *49.  
99 Id. at *66–74.
intend to claim. Companies can still pay a fee to hide pending applications from public view by requesting nonpublication, but doing so raises transaction costs and also sacrifices some rights to the nonpublished invention in overseas markets. The public can now readily view the USPTO’s Public PAIR database to find detailed and updated information on any pending, published application. Other user-friendly services such as Google Patents and IP.com also make searching patents and even creating active alert functions accessible at little or no cost. Thus, for the Board to so strongly hang its hat on a policy rationale, that rationale seems fairly weak in view of this publicly available information.

In contrast, the government’s opening brief is heavy with historical and policy appeals, and understandably reinforces much of the language of the Board decision. The brief observed, as did the Board, that the statutory two-year limit is merely the codification of the equitable doctrine of laches applied to broadening reissues. This tradition dates back to Bridgeport Brass and beyond, and clearly reflects the undisturbed intent of the Supreme Court. The government then pointed to counsel’s admissions at oral argument that Apple’s broadening was directed to a different embodiment and that the broadening was thus unforeseen as evidence that Apple’s reliance on Doll, Graff, and the MPEP were misplaced. Allowing the Staats claims would not break from precedent as Apple asserts but instead would blaze significant new ground,
since in Doll and Graff all relevant broadening reissues were directed at all times to the same embodiment, and thus the public at all times had notice of the nature of the broadening.108

Looking back to the legislative history of the 1952 Patent Act, where §§ 251–252 were added largely in their present form, the government maintained that the two-year notice window and the intervening-rights provisions were added for different reasons.109 Consequently, intervening rights cannot be a compelling enough safeguard to override the superior interests of the public.110 In closing, the government stated that when read as a whole, the Patent Act would not permit Apple’s actions—do so would open the door for the worst-case scenario of placeholder, submarine-type reissue patents for which claim scope could be altered throughout the entire patent term.111

Finally, in their reply brief, Apple essentially reiterated the points in its opening brief but noted again that historical allusions to cases such as Bridgeport Brass were inapposite since that era preceded a time when there were clear statutory bounds for broadening reissues.112 The policy arguments of the government simply did not justify an extra-statutory limitation.113 Apple also appealed to judicial efficiency, stating that the new USPTO rule according to the Board’s decision in Staats would create a “new, confusing, and endlessly litigable ground for challenging reissue patents in district court,”114 as courts would be forced to navigate what even the USPTO

108 See id. at *17–18.
109 Id. at *50 (citing Seattle Box Co., Inc. v. Indus. Crating & Packing Inc., 756 F.d 1574, 1579 (Fed. Cir. 1985) (Federico’s Commentary on the New Patent Act set aside the intervening rights of § 252 as a personal defense to patent infringement for particular users who began use before the reissue was granted; § 251 rights are for the public at large)).
110 Id. at *50–51.
111 Id. at *61–63.
113 Id. at *35–40.
114 Id. at *39–40.
admitted was a “fact-intensive inquiry” into relatedness between a patent and subsequent reissue patent applications.115

The compelling arguments and skilled briefing by both parties set the stage for a very interesting oral argument on September 8, 2011. The panel, comprised of Judges Dyk, O’Malley, and Reyna,116 quickly focused the argument on interpretation of USPTO rules and prior court precedent. After Apple’s counsel John M. Whealan opened by stating that the proposed USPTO rule would go against the court’s prior holdings in Doll, Fotland, and Graff, Judge Dyk immediately asked “Were those cases correctly decided?”117 Whealan responded in the affirmative.118 Judge Dyk later asked USPTO Associate Solicitor William Lamarca a similar question: “Doesn’t your argument lead you to say that Doll was wrongly decided?”119 When Lamarca demurred, stating “Doll is precedent…we understand that,”120 Judge Dyk asked again, “Do you believe Doll was correctly decided?”121 Lamarca responded “I personally think Doll could have been decided more strictly . . . . the PTO understands that it’s precedent . . . . if it was 1971 right now and we were arguing about the Doll situation I, as a PTO representative, would have argued against it being decided that way. But the PTO lost that argument. We lost. And we accept that.”122 Judge Dyk’s persistent interest in whether the C.C.P.A. wrongly decided Doll seems to suggest that Doll is critically on point in this case and that resolution of this case might include some reevaluation of Doll’s precedential value.

115 Id. at *38.
116 Senior Judge Clevenger was on the panel for all other cases heard on September 8, 2011, but apparently recused himself for the Staats hearing.
118 Id. at 1:48.
119 Id. at 20:26.
120 Id. at 20:32.
121 Id. at 20:39.
122 Id. at 20:42.
Another key topic of discussion was the early Supreme Court decisions relating to broadening reissue applications, including *Miller v. Brass Co.*, 123 *Sontag Chain Stores Co., Ltd.* v. *Nat’l Nut Co. of Calif.*, 124 and *Webster Elec. Co. v. Splitdorf Elec. Co.* 125 One of the most heated exchanges of the argument came in response to a question posed by Judge Dyk to Apple counsel John M. Whealan. In reference to the older precedent, Judge Dyk asked whether Apple’s proposed rule would hypothetically be permissible under those cases, and if it would have constituted laches. 126 For the next several minutes, Judge Dyk and Mr. Whealan sparred over the answer, with Whealan refusing to concede that the hypothetical was even valid, and Judge Dyk becoming increasingly frustrated. Judge Dyk finally concluded “You can’t answer my question,”127 and “So you’re agreeing that under the Miller Brass regime this would not have been permissible.”128 Judge Dyk also sparred with Lamarca on the old cases, stating: “I find it very difficult to find in those earlier Supreme Court cases any support whatsoever for the distinction the Board made here.”129 Lamarca responded that the early cases supported the simple proposition that reissue was available only when a true “error” was found and that the cases would support the premise that Apple’s rule would “operate most unjustly against the public.”130 Judge Dyk’s statements that the Supreme Court cases would seem to support a

123 104 U.S. 350 (1881).
124 310 U.S. 281 (1940).
125 264 U.S. 463 (1924). *Webster Elec. Co.* was the chief foundation of the “laches” reasoning in the Board decision. See *Ex parte Staats*, No. 2009-007162, 2010 WL 1725728 at *13–14. In *Webster*, the United States Supreme Court held that a patentee applying for a broadening reissue eight years after the initial patent had issued had resulted in “a case of unreasonable delay and neglect on the part of the applicant and his assignee in bringing forward claims broader than those originally sought.” *Webster*, 264 U.S. at 465–66.
126 Oral Argument, *supra* note 118, at 12:03.
127 Id. at 13:47.
128 Id. at 14:08. This exchange would not be the last time that Judge Dyk and Mr. Whealan would be at loggerheads in the course of the oral argument: during rebuttal, when Whealan was discussing how the advent of intervening rights has made more liberal broadening reissue practice possible, Judge Dyk countered “But those intervening rights are pretty limited.” *Id.* at 32:07. Whealan immediately interrupted “That’s not true, Your Honor!” and Judge Dyk responded “Don’t interrupt me.” 129 Id. at 32:13.
129 Id. at 32:13.
130 Id. at 22:28.
position that *Doll* was wrongly decided, but not support the Board’s decision, are intriguing.\(^{131}\)

Could the panel rule in favor of Apple on this set of facts and still overturn *Doll*? While such an outcome appears unlikely based on the prior opinions and the briefs, oral argument appears to at least crack the door open to such a possibility.

The CAFC also appeared to struggle to define a rule to apply to broadening reissues that should be used going forward. Apple’s counsel noted during his argument that the USPTO’s legal argument had shifted throughout the course of the appeal process:\(^{132}\) the examiner was concerned with the reissue declaration, the Board was concerned with embodiments, and now in the briefs the test was “unforeseeable.” Thus, the test was totally “unworkable” and could never be pinned down. The judges, particularly Judge O’Malley, seemed to seize on this point. Judge O’Malley criticized the USPTO’s argument at several instances, stating “Your test is a bit of a moving target,”\(^{133}\) “I still can’t understand what your test is, other than ‘I know it when I see it.’ What is your test?”\(^{134}\) and “You’ve sort of avoided using words like ‘unforeseeable’ here … and yet you used them in your brief . . . are you moving away from that test?”\(^{135}\) Lamarca responded that the examiner was consistent because the embodiments at issue were “totally unrelated” to the subject matter in the original declaration and reissue application.\(^{136}\) But Judge O’Malley, sounding somewhat exasperated, asked “How is something totally unrelated to a subject matter if it comes out of the same specification?”\(^{137}\) Lamarca merely responded that he did not feel that the statute could be read in this manner, suggesting that he understood the importance (and

\(^{131}\) *Id.* at 21:30.
\(^{132}\) *Id.* at 9:07.
\(^{133}\) *Id.* at 16:57.
\(^{134}\) *Id.* at 18:38.
\(^{135}\) *Id.* at 24:13.
\(^{136}\) *Id.* at 24:34.
\(^{137}\) *Id.* at 24:42.
potential weakness) of the definition of terms like “unforeseeable” and “unrelated” just as much as Judge O’Malley.

Two other anecdotes from the USPTO’s argument are worthy of special mention. First was a question about the effects of broadening reissue applications on innovation. At the end of the respondent’s argument, Judge Reyna asked Lamarca: “It seems to me though that [broadening reissue practice] advances innovation, and that encourages … creativity by the inventors. If we were to adopt the PTO’s determination, what would that do to innovation within the American patent system?” Mr. Lamarca responded that the “opposite” would be true: adopting Apple’s determination would take away public notice, and “blurring” the lines of the patent would discourage innovation. Given Apple’s history of innovation in the consumer-electronics field, it would have been interesting to hear Apple’s answer had it been presented with a similar question. Second, in response to a question by Judge O’Malley, Mr. Lamarca stated “you can’t take back what you’ve already given to the public…” in reference to clearly demarcating the lines of the patent property right. Although in a different intellectual-property context, this position is an intriguing one for the government to take given the upcoming Supreme Court case Golan v. Holder.

Although the points raised at oral argument generally followed those presented in the briefs, some interesting insights emerged as the argument proceeded. Apple maintained that stare decisis principles dictated that the forty years of practice since Doll should support their

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138 Id. at 28:09. (in response to Mr. Lamarca’s contention that if Apple’s determination were upheld, “tomorrow” a deluge of inventors would go to the PTO and file broadening reissue applications).
139 Id. at 28:25.
140 Id. at 23:25.
141 609 F.3d 1076 (10th Cir. 2010), cert. granted, 131 S. Ct. 1600 (U.S. Mar. 7, 2011) (No. 10-545). In Golan, various interested parties are challenging the constitutionality of section 104A of the Copyright Act, which was added by way of the Uruguay Round Agreements Act. The provision restores copyright to a subset of foreign works that had previously been in the public domain; thus, it is interesting to hear a government attorney argue here that the public can never lose what intellectual property rights holders had given them.
arguments, while the USPTO claimed again that Apple’s proposed practice was unsupportable under the statutes and rules, and denied proper notice to the public. While the overall tenor of the oral argument was cordial, there were certainly tense, heated moments, mostly between Judge Dyk and Apple’s counsel Whealan. Interestingly, Judge O’Malley seemed to be the more aggressive interrogator of the USPTO’s Lamarca, perhaps suggesting that Judge Reyna may be the critical vote on this panel. In addition, Judge Dyk’s question “How often does this problem come up?”\textsuperscript{142} suggests that the panel may wrestle with the question of just how broad or narrow real-world application of any prospective holding might be. The court may choose to rule narrowly simply on this set of facts, or it may take the opportunity to make a more sweeping pronouncement on the boundaries of broadening reissue practice.

IV. CONCLUSION

“In ... reissues more deviltry, if I may be permitted to use the phrase, creeps into the practice of patent law than everything else put together. Reissues ought to be guarded carefully....”\textsuperscript{143}

In many ways, broadening reissue practice is a headache for patent attorneys today just as it was in the 1870s. Considering the remarkable body of case law and commentary addressing the concept of broadening reissues and attempts to alter its implementation and practice, we have come full circle since the earliest attempts to rein in the potential for—and actual abuse of—reissue patent practice. The issue now at a head before the CAFC distills down to how long is too long to give adequate public notice in broadening reissue applications. And what must that “notice” entail? How much notice must be given when reissue applicants seek to pursue broader reissue patent claims directed to embodiments that may differ from those sought initially? In addition to the two-year statutory window for broadening reissues, and the “foreseeability”

\textsuperscript{142} Oral Argument, supra note 118, at 26:20.
\textsuperscript{143} ARGUMENTS BEFORE THE COMM. ON PATENTS OF THE SENATE AND HOUSE OF REPRESENTATIVES, S. MISC. DOC. NO. 45-50, at 104–05 (2d Sess. 1878) (statement of M.D. Leggett, ex-Commissioner of Patents); see also Federico, supra note 10, at 610.
aspect applied in *Staats* and earlier cases, the authors believe that a palatable balance must be achieved between providing adequate public notice in broadening reissue patent applications, while still providing enforceable rights for patent owners.

Clearly there is a need to rein in any unbounded\(^{144}\) “shifting” of subject matter claimed in chains of continuation broadening reissue applications filed years after the initial two-year statutory window for filing a broadening reissue application. The CAFC should take this opportunity to institute a mechanism to limit excessive alteration of patent claim scope by reissue for use solely as a means to capture previously unforeseen competitors and their equally unforeseen products.

The CAFC should also be willing to permit alteration of claim scope in reissue applications, and even in continuing broadening reissue applications, which can be beneficial to inventors and provide a valuable mechanism to correct later-discovered mistakes in a patent.\(^{145}\) In such legitimate circumstances, continuing broadening reissue applications should be permitted outside the two-year statutory window if unequivocal intent to broaden is demonstrated in an initial broadening reissue application. The devil is in the details, however, because it will be difficult to define reasonable bounds of permissibility (in time and in scope) for continuing broadening reissue applications. For example, what is an “unequivocal” intent to broaden, and how long is too long to permit broadening of any kind, especially in the context of continuations of broadening reissue applications?

One possible solution, although perhaps difficult to implement in practice, would be to require inventors to scour their patent and provide multiple examples of errors (assuming there

\(^{144}\) Unbounded in terms of scope, while still clearly bounded by the term of the parent patent.

\(^{145}\) See *Topliff v. Topliff*, 145 U.S. 156, 171 (1892)(“Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention, provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it….”).
are multiple errors) in the declaration accompanying an initial broadening reissue application. That is, inventors would explain in their declaration any number of possible “errors” and specify possible avenues for claiming subject matter not earlier claimed due to mistake, as well as a detailed explanation of why such errors do not constitute impermissible recapture of surrendered subject matter. Then, the inventors would be limited to pursuing families of broadening reissue applications (including continuations thereof) with claims limited to only those errors initially identified. This could serve a public-notice function, by apprising the public of the possible scope of reissue applications stemming from a given patent vis-à-vis the declaration accompanying an initial broadening reissue application. The counterpoint to this, of course, is that it may be difficult or impossible to recognize all possible errors at the time of filing an initial broadening reissue application, and that sometimes additional errors may not come to light until inventors are well ensconced in prosecution of the initial broadening reissue application.

Moreover, how should one define “unrelated” or “unforeseeable” embodiments? And how would this affect patent owners’ rights? For example, in today’s white-hot “smart phone” market, product development is so rapid and product lifecycle is so short (a fraction of the length of patent term) that it may be impossible to predict all possible future variations that competitors might attempt to exploit in designing around a patent.

To take just one simple example, assume an inventor discloses a novel portable electronic device and has patent claims directed to its screen and user interface. The inventor has a robust disclosure of the device, its screen, its functionality, user interface, display, battery, software, etc. Along comes a competitor (within two years of patent grant) who wishes to market a similar yet noninfringing device. Assume the competitor attempts a design-around to change the user interface and provide a remarkably long-lasting battery to power a similar device. Should the
inventor be permitted to file a broadening reissue application within two years to pursue claims directed to the competitor’s user interface (assuming support from the patent disclosure and no attempt at recapture)? Probably yes. Now, assume the original inventor’s disclosure broadly describes the battery used in the claimed device, but the inventor never included any claims directed to the battery in either the patent or an initial broadening reissue application. Should the inventor be permitted to file a continuation of that broadening reissue application after two years to add claims to a battery for a portable electronic device? This is a more complicated question. Would claims to a battery have been “foreseeable” to a competitor having knowledge of the original patent and its disclosure? Perhaps. Would claims to a battery be considered “unrelated” to the original device and user interface claims for the portable electronic device? Possibly. One can readily see that this is a gray area defying simple categorization.

There must be a balancing to promote competition while still protecting patent owners’ rights, in order to allow patent owners to maintain the value of their patent by later claiming more broadly that which they were originally entitled to claim. Otherwise, overall patent value may decrease if the potential scope of broadening reissues is curtailed. For example, in the “smart phone” market, patent value could diminish significantly after a short time, especially if a patent owner is not permitted to mine (within reason) a robust patent disclosure for unclaimed subject matter.

So where should we place the fulcrum in this balance? One possibility is for the CAFC to judicially implement a hard time limit on filing continuations of broadening reissue applications. For example, there could be a time limit requiring the filing of any continuing broadening reissue applications within three years after the initial two-year window for the first broadening reissue application. Thus, all broadening reissue patent applications (including any
continuations) would have to be filed within five years of initial patent grant, with expiration of any reissue patents still being tied to original patent’s term. Five years is a long time, for example, in the “smart phone” market. For example, we are on the cusp of a possible iPhone® 5 release in Fall 2011, and one will notice that there are not many people carrying around the original iPhone® from 2007. That being said, however, there are many patented features in the original iPhone® that are still being aggressively defended today, almost five years later.

The problem for the CAFC if it attempts to establish a bright-line rule for capping continuing broadening reissue applications, say, at five years, is that it is difficult to objectively and even-handedly apply such a rule to patents overall and across so many industries and technologies. Sometimes, however, courts seem to favor bright-line rules. Other times, they prefer overly complicated or case-specific approaches with many corollaries that soon muddy even their seemingly most straightforward application.

And so broadening reissue practice may remain a headache for patent attorneys regardless of the outcome in Staats. We must hope that the CAFC uses the occasion of the Staats case to impart a reasonable and fair balance between adequate public notice and enforceable rights for patent owners in broadening reissue patent applications.

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146 For example, patents in the biopharmaceutical industry are particularly valuable towards the end of their term as they recoup time lost due to FDA approval and fend off generic competitors, whereas in industries such as semiconductors, patents may more quickly become obsolete before the end of their term. See Mark A. Lemley, Empirical Study of the Twenty Year Patent Term, 22 AIPLA Q. J. 369, 377 n.32 (1994) (“There is some evidence, however, that the value of patents over time may differ by industry. For example, because of regulatory delays, patents in the biotechnology and pharmaceutical industries may be more valuable at the end of their term than at the beginning.”); see also Robert L. Risberg, Jr., Comment, Five Years Without Infringement Litigation Under the Semiconductor Chip Protection Act; Unmasking the Spectre of Chip Piracy in an Era of Diverse and Incompatible Process Technologies, 1990 Wis. L. Rev. 241, 252 (1990) (“In addition, some companies neglect to patent facets of a chip that are eligible because the chip may be obsolete by the time the Patent and Trademark Office issues a patent.”).