

Fed. Circ. Grill Ruling Clears Up Original Patent Requirement

By **Alexis Cohen** (August 8, 2023)

The U.S. Court of Appeals for the Federal Circuit's recent precedential opinion in *In re: Float'N'Grill LLC* clarifies the original patent requirement based on Title 35 of the U.S. Code, Section 251, that applies to reissue applications.

Float'N'Grill differentiates the original patent requirement from the written description requirement and describes what is necessary to meet the original patent requirement.



Alexis Cohen

What is Section 251?

Patentees have been able to correct the scope of their granted claims since 1836.[1] Currently, Section 251 provides that ability and dictates its limits.[2]

Section 251 allows patent holders to correct the scope of their patents' claims where they are unintentionally too narrow or too broad.

Patentees have only two years from a patent's issuance to pursue a reissue claiming more than what was originally claimed.[3] This is called a broadening reissue. A patentee can pursue narrower claims in a reissue any time after a patent grants.

If a patentee pursues claims in a reissue that are broader in at least one respect than the originally granted claims, it will be treated as a broadening reissue even if the claims are narrower in other respects.[4]

On average, 633 reissue patents have been granted per year from 2007 to 2020.[5] A broadening reissue can be a useful tool for inventors to seek claim coverage for aspects of their invention that became apparent after the patent grants.[6]

A narrowing reissue can be used to avoid prior art discovered after the patent has been granted. Either way, a patentee can obtain clearer claim coverage that is more likely to withstand a validity attack through reissue.

However, the scope of claim coverage that can be obtained through reissue has limitations.

The Original Patent Requirement — Is It Written Description?

Section 251 provides that a reissue patent can only be granted for "the invention disclosed in the original patent" under Title 35 of the U.S. Code, Section 251(a). This is called the original patent requirement.[7]

Historically, the original patent requirement has frequently been described in a manner that suggests it is the same as the written description requirement of Title 35 of the U.S. Code, Section 112(a).

The Federal Circuit in the 2009 *Revolution Eyewear v. Aspex Eyewear* decision described the original patent requirement as being analogous to the written description requirement under

Section 112.[8] Other iterations of the original patent requirement sound very similar to the written description requirement:

- Original patent: In the 1983 In re: Peters decision, the court wrote that "the overall disclosure reasonably conveys to one skilled in the art that the inventor had possession of the broad invention at the time the original application was filed." [9]
- Original patent: In the 1991 In re: Amos decision, the court wrote that "whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees." [10]
- Written description: In the 2010 Ariad Pharmaceuticals Inc. v. Eli Lilly & Co. decision, the court wrote that "whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." [11]

Float'N'Grill makes clear that the original patent requirement is different, and likely supports narrower claims, than the written description requirement.

Original Patent Is More Than Written Description

Float'N'Grill involved an appeal from a Patent Trial and Appeal Board decision affirming the rejection of a reissue application's claims. [12] The examiner had rejected the claims for being indefinite under Section 112(b) and for failing to satisfy the original patent requirement under Section 251. [13]

The patent-at-issue, U.S. Patent No. 9,771,132, disclosed a float apparatus having a grill support that included a number of magnets for removably securing a grill to the float. [14] The float was intended to keep the grill afloat in water so a user could grill food while remaining in the water. [15]

During reissue, Float'N'Grill tried to pursue claims that removed any requirement for magnets on the float. [16] The Federal Circuit affirmed the board's decision. [17]

In its decision, the Federal Circuit clarified the "original patent" requirement, stating:

[W]e hold that reissue claims broadening a limitation to cover undisclosed alternatives to a particular feature appearing from the face of the original specification to be a necessary, critical, or essential part of the invention, do not meet the original patent requirement of § 251. [18]

The Federal Circuit explained that it is not enough to show that the reissue claims have support in the original specification. [19] Instead, the original patent requirement focuses on assessing the heart of the invention in the original patent and what is necessary to achieve that invention.

The patentee in Float'N'Grill was limited on reissue to claims requiring a plurality of magnets because:

- The grill support's ability to removably attach to the grill was the crucial function of the invention;
- The specification only disclosed one embodiment, a plurality of magnets, that performed the function of removable attachment; and
- Nothing in the patent described the magnets as optional or described any other component that could perform the crucial function of removable attachment.[20]

Going Forward

Practitioners should take a number of lessons from the Float'N'Grill decision.

The first, as should be practiced whenever drafting a patent application, is to think critically and creatively about the disclosure.

Care should be put into thinking about the key function of the invention and what embodiments are disclosed to accomplish that function.

Second, Float'N'Grill makes it apparent that a patentee may be entitled to broader claims under the written description requirement as compared to the original patent requirement.

Therefore, to the extent feasible, it is better to keep prosecution open by filing continuation or, where applicable, divisional applications.[21]

Third, broadening reissues remain a powerful tool when prosecution is closed and the patent was granted less than two years ago.

This is especially true given that continuation reissue applications can be filed outside of the two-year time frame that allow patentees to pursue broader claims.[22]

The key question will be whether those broader claims reflect the essential, critical or necessary parts of the invention in the original patent.

Alexis Cohen is a partner at WilmerHale.

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[1] Patent Act of 1836, ch. 357, § 13, 5 Stat. 117, 122 (1836) ("[W]henver any patent which has heretofore been granted, shall be inoperative, or invalid, ... by reason of the patentee claiming in his specification as his own invention, more than he had or shall have a right to claim as new; if the error has, or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent...to cause a new patent to be

issued to the said inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification ...").

[2] 35 U.S.C. § 251 (2012).

[3] *Id.* at §251(d) ("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.").

[4] MPEP 1412.03 (citing 37 C.F.R 1.175(b)).

[5] https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm.

[6] Tun-Jen Chiang, *Fixing Patent Boundaries*, 108 MILR 523, 529 (Feb. 2010) ("Thus, if it emerges a year after the patent issues that it is unclear whether the claim covers chairs with four legs, the patentee can seek to reissue his patent to make clear that, yes, he does claim chairs as part of his patent on tables, since chairs stand up in the same way as a table.").

[7] *In re: Float'N'Grill LLC*, 2022-1438, slip op. at 5 (Fed. Cir. July 12, 2023).

[8] *Revolution Eyewear Inc. v. Aspex Eyewear Inc.*, 563 F.3d 1358, 1367 (Fed. Cir. 2009).

[9] *In re Peters*, 723 F.2d 891, 894 (Fed. Cir. 1983).

[10] *In re Amos*, 953 F.2d 613, 618 (Fed. Cir. 1991).

[11] *Ariad Pharmaceuticals Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351-52 (Fed. Cir. 2010) (en banc).

[12] *In re Float'N'Grill*, slip op. at 1.

[13] *Id.* at 1.

[14] *Id.* at 2-3.

[15] *Id.*

[16] *Id.* at 3-4.

[17] *Id.* at 14.

[18] *Id.* at 9.

[19] *Id.* at 13 ("FNG argues...that if the original specification would have supported the reissue claim omitting the limitation, then the original patent requirement is satisfied. FNG is incorrect.").

[20] *Id.* at 2 ("No other structure besides the plurality of magnets is disclosed, suggested, or implied for removably securing the grill to the supports.").

[21] The Federal Circuit notes this advantage in *Float'N'Grill*, stating "An applicant is free to

seek an expanded scope of coverage beyond that originally sought by filing a continuation or divisional application during the pendency of a parent application and may therein include claims extending to the full scope of the subject matter described in the original specification under 35 U.S.C. § 112(a)...Once a patent is granted, however, a patentee seeking to change the scope of the claims through reissue is subject to the additional statutory limitations in 35 U.S.C. § 251, including, as particularly relevant here, that the reissue claims must be directed to "the invention disclosed in the original patent." *Id.* at 5-6.

[22] *In re Staats*, 671 F.3d 1350 (Fed. Cir. 2012).