

The opinion in support of the decision being entered today  
is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte DANIEL M. EGGERT and FRANK MIKIC (deceased)

---

Appeal No. 2001-0790  
Application No. 09/110,145

---

HEARD: JUNE 12, 2001

---

Before ABRAMS, FRANKFORT and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of reissue claims 15-22.<sup>1</sup> Claims 1-14, which are the original patent claims, stand allowed. No other claim is pending in this reissue application.

---

<sup>1</sup> This application, filed July 2, 1998, is a reissue application of U.S. Pat. No. 5,577,426, issued November 26, 1996 ("the original patent"), on Application No. 08/335,992 ("the patent application"), filed November 8, 1994.

Appeal No. 2001-0790  
Application No. 09/110,145

BACKGROUND

The sole rejection before us on appeal is as follows.<sup>2</sup>

Claims 15-22 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened subject matter surrendered in the application for the original patent upon which the present reissue is based. The basis for this rejection is that the claims have been broadened and, according to the examiner, the record of the application for the original patent shows that the broadening aspect of the reissue claims relates to subject matter that appellants previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the original patent claims was not an error within the meaning of 35 U.S.C. § 251, and the broader scope surrendered in the application cannot be recaptured by the filing of the present reissue application (final rejection, pages 2 and 3).

Reference is made to the brief and reply brief (Paper Nos. 10 and 12) and the final rejection and answer (Paper Nos.

---

<sup>2</sup> There is no prior art rejection under 35 U.S.C. § 102 or 103 before us.

Appeal No. 2001-0790  
Application No. 09/110,145

4 and 11) for the respective positions of the appellants and the examiner with regard to the merits of this rejection.

The prosecution history of the original patent

Claim 1, as originally presented in the patent application which matured into appellants' original patent, reads as follows:

1. A bit holder comprising:
  - a cylindrical body having a distal end surface and an axis, said body having formed in said end surface an axial bore terminating at an inner end surface,
  - a permanent magnet received in said bore and having an outer surface, and
  - retaining structure in contact with the outer surface of said magnet and interference fitted in said bore to retain said magnet in said bore, said bore having a portion of non-circular transverse cross section outboard of said retaining structure defining a bit-receiving socket.

Original claim 4, which depended indirectly from claim 1, further recited "wherein said retaining structure includes a retaining member mounted in said bore outboard of said magnet for cooperation with said inner end surface to retain said magnet therebetween."

In a first Office action (Paper No. 2), the examiner, inter alia, rejected claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite, because "it is not clear as to

Appeal No. 2001-0790  
Application No. 09/110,145

the meaning of 'retaining member ... for cooperation with said inner end surface' since the retaining member is mounted in the bore outboard of the magnet" (page 2). Additionally, the examiner rejected claims 1 and 4, inter alia, under 35 U.S.C. § 103 as being unpatentable over Parsons (U.S. Pat. No. 4,663,998) in view of Clark (U.S. Pat. No. 3,007,504) and Miller (U.S. Pat. No. 2,806,396).

In an amendment filed August 31, 1995 (Paper No. 3), appellants added the following language to the end of the last paragraph of claim 1:

said retaining structure including a discrete retaining member friction fitted in said bore outboard of said magnet, said retaining member and said inner end surface cooperating to retain said magnet therebetween.

According to appellants' remarks on page 4 of that amendment (Paper No. 3), appellants indicated that this amendatory language is clear and definite in reciting cooperation between the retaining member and the inner end surface of the bore to retain the magnet in place, thereby presumably responding to the indefiniteness rejection of claim 4, the subject matter

Appeal No. 2001-0790  
Application No. 09/110,145

thereof being substantially incorporated into independent claim 1. Additionally, appellants pointed out that

[a] significant aspect of the invention is the provision of a discrete retaining member which is press-fitted in the bore outboard of the permanent magnet. This permits the use of various sized magnets which do not have to be precisely sized for press-fitting in the bore, thereby avoiding the stress occasioned by the press-fitting operation. It also permits the use of a straight bore which does not have to have special grooves or the like formed therein to accommodate a retaining member [Paper No. 3, page 5].

According to appellants, the above-cited language added to claim 1 more clearly brings out this distinguishing aspect of the invention, which is not disclosed or suggested by the cited references (Paper No. 3, page 5).

In a final rejection (Paper No. 4), the examiner repeated the rejection of claim 1 et al. under 35 U.S.C. § 103. The examiner also repeated the rejection of claim 4 under 35 U.S.C. § 112, second paragraph, but did not apply the rejection under 35 U.S.C. § 112, second paragraph, to claim 1.

In response to the final rejection, appellants filed a second amendment on January 22, 1996 (Paper No. 5) in which the language "said retaining member being generally bowl-

Appeal No. 2001-0790  
Application No. 09/110,145

shaped and convex toward said magnet,"<sup>3</sup> was added to the last paragraph of claim 1. The claims were thus directed specifically to the embodiment of Figures 4 and 5. Appellants stated on page 3 of that amendment (Paper No. 5) that "[a]s thus amended, claim 1 is effectively an independent form of claim 6, which was indicated to be allowable." On January 29, 1996, appellants filed a division (Application No. 08/593,396) of the patent application containing claims directed to a bit holder or hand tool including a discrete, flat, imperforate retaining member (the embodiment of Figure 2).

The examiner allowed the patent application without further comment (see Paper No. 7) and the original patent thereon issued on November 26, 1996.

*The prosecution history of this reissue application*

On July 2, 1998, appellants filed this application for reissue of the original patent. The reissue application included original patent claims 1-14 without amendment and

---

<sup>3</sup> This limitation was incorporated into claim 1 from claim 6, which had not been subject to a prior art rejection. The amendment also canceled claim 6.

Appeal No. 2001-0790  
Application No. 09/110,145

added reissue claims 15-22 thereto. Reissue claims 15 and 22,  
the only independent reissue claims, read as follows:

15. A bit holder comprising:  
a body having a distal end surface,  
said body having a bore formed in said end  
surface,  
a magnet received in said bore and having an  
outer surface,  
and a discrete retaining member friction fitted  
in said bore outboard of said magnet and  
substantially covering said outer surface of said  
magnet to retain said magnet in said bore,  
said bore having a portion outboard of said  
retaining member defining a bit-receiving socket.

22. A bit holder comprising:  
a body having a distal end surface,  
said body having a bore formed in said end  
surface,  
a magnet received in said bore and having an  
outer surface,  
and a discrete retaining member friction fitted  
in said bore outboard of said magnet and having a  
continuous, closed, non-reentrant outer periphery to  
retain said magnet in said bore,  
said bore having a portion outboard of said  
retaining member defining a bit-receiving socket.

In a first Office action (Paper No. 2, page 3), the  
examiner rejected claims 15-22 under 35 U.S.C. § 251 as being  
an improper recapture of broadened subject matter in the  
application for the original patent upon which the present  
reissue is based (the rejection now before us). Additionally,  
the examiner rejected claim 22 under 35 U.S.C. § 251 as

Appeal No. 2001-0790  
Application No. 09/110,145

containing new matter not supported by appellants' original patent and under the first paragraph of 35 U.S.C. § 112 as containing subject matter which was not described in the specification of appellants' original patent application in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the patent application was filed, had possession of the claimed invention. According to the examiner, the subject matter not supported by the original patent is the limitation "continuous, closed, non-reentrant outer periphery."

In response to the examiner's new matter rejections of claim 22, appellants filed an amendment (Paper No. 3) to claim 22 deleting the language "and having a continuous, closed, non-reentrant outer periphery" and adding the following limitation:

said retaining member having a continuous outer periphery such that any two points on the periphery can be joined by a straight line segment which does not extend outside the periphery.

In the final rejection (Paper No. 4) in this reissue application, the examiner repeated the recapture rejection but did not repeat the new matter rejections.

Appeal No. 2001-0790  
Application No. 09/110,145

OPINION

Section 251, ¶1, provides in pertinent part:

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 . . . 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.

Section 251, ¶4, provides:

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.

A comparison of the reissue claims on appeal and the original patent claims reveals that independent reissue claims 15 and 22 on appeal are broader in some respects and narrower in other respects relative to the original patent claims. As the instant reissue application was filed within two years from the grant of appellants' original patent, appellants are not barred by the fourth paragraph of 35 U.S.C. § 251 from enlarging the scope of the claims of the original patent.

With regard to the first paragraph of 35 U.S.C. § 251, the Federal Circuit, and its predecessor, has held that

Appeal No. 2001-0790  
Application No. 09/110,145

the deliberate cancellation of claims *may* constitute error, if it occurs without deceptive intent . . . . the CCPA went so far as to state that error is sufficient where the deliberate cancellation of claims does not amount to an admission that the reissue claims were not patentable at the time the original claims were canceled.

. . . .  
. . . The recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those claims that were canceled from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are *narrower* in scope than the canceled claims. If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after the grant of the original patent.

Ball Corp. v. United States, 729 F.2d 1429, 1435-36, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

The court in Ball emphasized that the focus is not on the specific limitations or on the elements of the claims but, rather, on the *scope* of the claims. The principle that a claim is broadened if it is broader in any respect than the original claim serves to effect the bar of § 251 against reissue filed later than 2 years after issuance of the original patent but will not bar appellants from securing the

Appeal No. 2001-0790  
Application No. 09/110,145

reissue claims here on appeal. See Id., 729 F.2d at 1437-38, 221 USPQ at 295-96.

As the court stated in Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993),

the reissue procedure does not give the patentee a second opportunity to prosecute de novo his original application. The deliberate cancellation of a claim of an original application in order to secure a patent cannot ordinarily be said to be an "error" and will in most cases prevent the applicant from obtaining the canceled claim by reissue. The extent to which it may also prevent him from obtaining other claims differing in form or substance from that canceled necessarily depends upon the facts in each case and particularly on the reasons for the cancellation.

The reissue claims in Mentor were broader in some respects and narrower in other respects relative to the canceled claim. In Mentor, the court determined that Mentor narrowed the claims for the purpose of obtaining allowance in the original prosecution and is thus precluded from recapturing what it earlier conceded. The court explained the policy behind the recapture rule as follows:

It is precisely because the patentee amended his claims to overcome prior art that a member of the public is entitled to occupy the space abandoned by the patent applicant. Thus, the reissue statute cannot be construed in such a way that competitors,

Appeal No. 2001-0790  
Application No. 09/110,145

properly relying on prosecution history, become patent infringers when they do so.

Id., 998 F.2d at 996, 27 USPQ2d at 1525.

The court in Mentor also stated that

[r]eissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule. If a reissue claim is broader in a way that does not attempt to reclaim what was surrendered earlier, the recapture rule may not apply. However, in this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up. Moreover, the added limitations do not narrow the claims in any material respect with their broadening.

Id.

In In re Clement, 131 F.3d 1464, 1469, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997), the court explained that "[d]eliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the

contrary." Thus, the surrendered subject matter may be either a canceled or amended<sup>4</sup> claim.

Once it is determined that an applicant has surrendered the subject matter of the canceled or amended claim, we must then determine whether the surrendered subject matter has crept into the reissue claim. Comparing the reissue claim with the canceled or amended claim is one way to do this. If the scope of the reissue claim is the same as or broader than that of the canceled or amended claim, then the patentee is clearly attempting to recapture surrendered subject matter and the reissue claim is, therefore, unallowable. In contrast, a reissue claim narrower in scope than the canceled or amended claim escapes the recapture rule. See Id., 131 F.3d at 1469, 45 USPQ2d at 1164-65.

Where the reissue claim is broader than the canceled or amended claim in some respects but narrower in others, further inquiry is needed. This was the situation in Ball, Mentor and Clement, for example. The Clement court observed that, in

---

<sup>4</sup> The phrase "amended claim" in this context refers to a claim in its form prior to being amended, just as a "canceled claim" refers to a claim in its form prior to being canceled.

Appeal No. 2001-0790  
Application No. 09/110,145

Mentor, the reissue claim was broadened in relation to the canceled claim by eliminating a limitation argued by the applicant to define over the applied prior art and narrowed in another aspect. As noted in Clement, the reissue claim in Mentor did not escape the recapture rule because the narrowing limitations did not "materially narrow the claim." Id., 131 F.3d at 1470, 45 USPQ2d at 1165. In Ball, on the other hand, the reissue claim did escape the recapture rule. The Clement court characterized the facts in Ball as follows:

Similarly, in *Ball*, the issued claim recited "a plurality of feedlines" and a "substantially cylindrical conductor." The canceled claim recited "feed means includ[ing] at least one conductive lead," and a "sustantially cylindrical conductor." The prosecucion history showed that the patentee added the "plurality of feedlines" limitation in an effort to overcome prior art, but the cylindrical configuration limitation was neither added in an effort to overcome a prior art rejection, nor argued to distinguish the claims from a reference. The reissue claim included limitations not present in the canceled claims that related to the feed means element, but allowed for multiple feedlines. On balance, the claim was narrower than the canceled claim with respect to the feed means aspect. The reissue claim also deleted the cylindrical configuration limitation, which made the claim broader with respect to the configuration of the conductor. We allowed the reissue claim because the patentee was not attempting to recapture surrendered subject matter [citations omitted].

Appeal No. 2001-0790  
Application No. 09/110,145

Id.

According to the Clement court,

[f]rom the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower [than the canceled or amended claim] in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader [than the canceled or amended claim] in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader [than the canceled or amended claim] in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower [than the canceled or amended claim] in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

Id.

In Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1480, 46 USPQ2d 1641, 1648 (Fed. Cir. 1998), the court pointed out that a reissue claim that does not include a limitation present in the original patent claims is broader in that respect. Hester also established that an applicant can surrender subject matter through argument alone,

Appeal No. 2001-0790  
Application No. 09/110,145

notwithstanding that the claims were not amended during prosecution. Id., 142 F.3d at 1482, 46 USPQ2d at 1649.

In Hester, the reissue claims were broadened relative to the original patent claims by removing limitations repeatedly relied upon by the applicant to distinguish the prior art and described as "critical" and "very material" to the patentability of the invention and were not materially narrowed. Thus, in essence, notwithstanding that no claims were canceled or amended in the prosecution of the original patent, these repeated arguments constituted a surrender of a claim scope that does not include these limitations. See Id., 142 F.3d at 1482, 46 USPQ2d at 1649.

Appeal No. 2001-0790  
Application No. 09/110,145

The court in Hester stated that

[t]he reissue statute is to be construed liberally, but not that liberally. The realm of corrections contemplated within § 251 does not include recapturing surrendered subject matter, without the addition of materially-narrowing limitations, in an attempt to 'custom fit' the reissue claims to a competitor's product.

Id., 142 F.3d at 1483-84, 46 USPQ2d at 1650.

In addition to the elimination of limitations that had been relied upon to distinguish the prior art during prosecution of the original patent, the language of the reissue claims differed in other respects from the original patent claims. The Hester court examined each of these other differences and concluded that these recitations did not materially narrow those claims. Factors cited by the court in reaching this determination were that the recitations at issue were the same as or broader than limitations present in the original patent claims or were present in the prior art of record in the patent application. See Id., 142 F.3d at 1483, 46 USPQ2d at 1650.

In our view, the cases cited above establish the following principles or categories to determine whether a reissue claim is precluded by the recapture rule.

(1) if the reissue claim is as broad as or broader than the surrendered subject matter (i.e., a claim canceled or amended<sup>5</sup> in an effort to overcome a prior art rejection) in all aspects, the recapture rule bars the claim;

(2) if it is only narrower than the surrendered subject matter, the recapture rule does not apply, but other rejections are possible;

(3) if the reissue claim is broader than the surrendered subject matter in some aspects and also narrower than the surrendered subject matter in others, then the recapture rule may bar the claim. See, e.g., Ball, Mentor, Clement and Hester. Specifically,

(a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;

---

<sup>5</sup> By "amended" claim it is meant the claim in its form prior to it being amended, not the claim as amended. Thus, for example, when original claim 1 is rejected over prior art under 35 U.S.C. § 102 or 35 U.S.C. § 103 and then is replaced by amended claim 1, which amended claim 1 is allowed by the examiner, the surrendered subject matter is original claim 1, not amended and now allowed claim 1.

- (b) if the reissue claim is narrower in an aspect germane to the prior art rejection and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

In this case, it is apparent to us that appellants did, in fact, surrender subject matter in prosecuting the original patent. In particular, appellants surrendered original claim 1 in the patent application in an attempt to overcome the prior art rejection applied thereagainst (see Paper No. 3 in the patent application). Further, appellants later surrendered claim 1 as presented prior to the amendment of January 22, 1996 by amending it to add the limitation "said retaining member being generally bowl-shaped and convex toward said magnet" in order to overcome the prior art rejection applied thereagainst.<sup>6</sup> Accordingly, in addition to the subject matter of original claim 1, the following subject

---

<sup>6</sup> While appellants did file a division shortly after amending the claims to overcome the prior art rejection, the claims presented in that division were narrower than claim 1 prior to the amendment. Thus, the filing of a division in this instance does not, in our opinion, evidence an intent not to surrender the subject matter of claim 1 prior to the amendment.

Appeal No. 2001-0790  
Application No. 09/110,145

matter (hereinafter "the surrendered subject matter") was surrendered by appellants.

1. A bit holder comprising:
  - a cylindrical body having a distal end surface and an axis, said body having formed in said end surface an axial bore terminating at an inner end surface,
  - a permanent magnet received in said bore and having an outer surface, and
  - retaining structure in contact with the outer surface of said magnet and interference fitted in said bore to retain said magnet in said bore, said bore having a portion of non-circular transverse cross section outboard of said retaining structure defining a bit-receiving socket, said retaining structure including a discrete retaining member friction fitted in said bore outboard of said magnet, said retaining member and said inner end surface cooperating to retain said magnet therebetween.

Having determined, supra, in accordance with the first step set out in Clement, that the reissue claims before us are broader than the patent claims and properly applied for within two years from the grant of the original patent, we must next determine whether the broader aspects relate to surrendered subject matter (i.e., the second step set out in Clement)<sup>7</sup>. As pointed out supra, one way to do this is to compare the reissue claim with "the surrendered subject matter." See

---

<sup>7</sup> Clement, 131 F.3d at 1468-69, 45 USPQ2d at 1164.

Appeal No. 2001-0790  
Application No. 09/110,145

Hester, 142 F.3d at 1482, 46 USPQ2d at 1649; Clement, 131 F.3d at 1469, 45 USPQ2d at 1164.

The reissue claims are broader in some respects and narrower in other respects as compared with "the surrendered subject matter." In particular, the limitations in "the surrendered subject matter" that the retaining member is "generally bowl-shaped and convex toward said magnet," that the body is "cylindrical," that the magnet is a "permanent" magnet and that the bore has a "non-circular" portion and terminates at an inner end surface are not present in independent reissue claims 15 and 22. Additionally, the recitations that the body has an "axis," the retaining structure is "in contact with the outer surface of said magnet and interference fitted in said bore" and "said retaining member and said inner end surface cooperating to retain said magnet therebetween" present in "the surrendered subject matter" are not present in reissue claims 15 and 22. On the other hand, reissue claim 15 has been narrowed with respect to "the surrendered subject matter" with the addition of the limitation that the retaining member is "substantially

Appeal No. 2001-0790  
Application No. 09/110,145

covering said outer surface of said magnet." Claim 22 has been narrowed relative to "the surrendered subject matter" by the addition of the limitation that the retaining member "[has] a continuous outer periphery such that any two points on the periphery can be joined by a straight line segment which does not extend outside the periphery."

In that reissue claims 15 and 22 are broader than "the surrendered subject matter" in some respects and narrower in other respects, as noted above, we have determined that reissue claims 15 and 22 in this case fall into category (3), discussed supra. Accordingly, consistent with the principles set forth by our reviewing court, we must review all of the differences between "the surrendered subject matter" and the reissue claims. If the reissue claims are as broad as or broader than "the surrendered subject matter" in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the reissue claims. If, on the other hand, the reissue claims are narrower than "the surrendered subject matter" in an aspect germane to the prior art rejection, and

broader in an aspect unrelated to the rejection, the recapture rule does not bar the reissue claims.<sup>8</sup> The examiner's rationale in determining that the reissue claims are precluded by the recapture rule simply because a limitation ("said retaining member being generally bowl-shaped and convex toward said magnet") of the original patent claims relied upon to overcome a prior art rejection in prosecuting the original patent is not present in the reissue claims is, in our opinion, flawed, in that it does not take into account the other differences, listed supra, between "the surrendered subject matter" and the reissue claims.<sup>9</sup>

Reissue claims 15 and 22 differ from "the surrendered subject matter" with regard to the shape of the retaining member. Specifically, "the surrendered subject matter" is silent with regard to the shape of the retaining member.

---

<sup>8</sup> While other sub-categories of category (3) are possible (e.g., the reissue claim being broader in an aspect germane to the prior art rejection and also narrower in an aspect germane to the rejection), we are not aware of any precedent involving such facts.

<sup>9</sup> Moreover, the examiner's application of this rejection with regard to reissue claim 18 seems illogical, in that reissue claim 18 includes the limitation that the retaining member is "generally bowl-shaped and convex toward said magnet."

Appeal No. 2001-0790  
Application No. 09/110,145

While reissue claims 15 and 22 do not contain the particular limitation "said retaining member being generally bowl-shaped and convex toward said magnet" relied upon to overcome the prior art rejection to obtain the original patent, reissue claim 15 contains a limitation "substantially covering said outer surface of said magnet" with regard to the shape of the retaining member which is not present in "the surrendered subject matter." Similarly, reissue claim 22 contains a limitation "having a continuous periphery such that any two points on the periphery can be joined by a straight line segment which does not extend outside the periphery" with regard to the shape of the retaining member which is not present in "the surrendered subject matter." Thus, we conclude that reissue claims 15 and 22 are narrower than "the surrendered subject matter" with respect to the shape of the retaining member. In that the shape of the retaining member was relied upon to overcome the prior art rejection and the above-cited features of the retaining member shape included in reissue claims 15 and 22 do not appear to be taught or suggested by the prior art of record, as evidenced by the

Appeal No. 2001-0790  
Application No. 09/110,145

absence of a prior art rejection in this reissue, this narrowing with respect to the shape of the retaining member is germane to the prior art rejection<sup>10</sup>.

Reissue claims 15 and 22 have also been broadened relative to "the surrendered subject matter" by the elimination of the limitation that the magnet is a "permanent" magnet. However, we note that this limitation was not argued by appellants as defining the claims over the prior art in prosecuting the original patent. Additionally, we observe that the magnet 34 of Parsons, the primary reference relied upon in the prior art rejection applied in the original patent application, appears to be a permanent magnet, thereby indicating that the "permanent" limitation is not material to the patentability of the claims. Accordingly, we conclude that the elimination of the "permanent" limitation in reissue claims 15 and 22 is a broadening unrelated to the prior art rejection.

---

<sup>10</sup> In this regard, we view the facts of this case as distinct from the facts of Pannu v. Storz Instruments, Inc., No. 00-1482 (Fed. Cir. July 25, 2001).

Reissue claims 15 and 22 are broader than "the surrendered subject matter," in that the limitation that the body is "cylindrical" in "the surrendered subject matter" is not present in reissue claims 15 and 22. This "cylindrical" limitation was not argued by appellants as a distinction over the prior art in prosecuting the original patent. Moreover, the body (shell 20) of Parsons is cylindrical, thereby indicating that the limitation that the body is "cylindrical" is not material to the patentability of the claims. Thus, we conclude that the elimination of the "cylindrical" limitation in reissue claims 15 and 22 is a broadening unrelated to the prior art rejection.

Reissue claims 15 and 22 are also broader relative to "the surrendered subject matter," in that the limitations that the bore has a "non-circular" portion and terminates at an inner end surface are not present in reissue claims 15 and 22. However, these limitations were not argued by appellants as distinguishing over the prior art and, further, appear to be met by Parsons (column 1, lines 50-54, and Figure 4). Thus,

Appeal No. 2001-0790  
Application No. 09/110,145

from our perspective, the elimination of these limitations constitutes a broadening unrelated to the prior art rejection.

As for the elimination of the limitation that the retaining member is "interference fitted in said bore" in reissue claims 15 and 22, in our view, this limitation is of the same scope as the limitation in "the surrendered subject matter" that the retaining member is "friction fitted in said bore" as these phrases would ordinarily be understood by one skilled in the art. As the "friction fitted" limitation is retained in all of the reissue claims, the elimination of the "interference fitted" limitation does not constitute a material broadening of the claims.

We also do not view the elimination of the limitation that the body has an "axis" to be a material broadening of the claims. In our view, any three-dimensional object or body would meet this limitation, as an axis can be drawn through any body. Accordingly, it follows that this language cannot be considered material to the patentability of the claims over the prior art.

Appeal No. 2001-0790  
Application No. 09/110,145

Similarly, the limitations that the retaining structure is in contact with the outer surface of the magnet and that the retaining member and the inner end surface cooperate to retain the magnet therebetween present in "the surrendered subject matter" and eliminated in reissue claims 15 and 22 are inherent from the limitations in reissue claim 15 that the retaining member is friction fitted in the bore outboard of the magnet and substantially covers the outer surface of the magnet to retain the magnet in the bore. Thus, we conclude that the elimination of these limitations from reissue claim 15 does not constitute a material broadening of the claim. Moreover, a review of the prosecution history indicates that these limitations in "the surrendered subject matter" were not relied upon to distinguish over the prior art in prosecuting the original patent.<sup>11</sup> In any event, these limitations in "the surrendered subject matter" appear to be met by Parsons. In summary, we conclude that the elimination of these limitations

---

<sup>11</sup> While the language "said retaining member and said inner end surface cooperating to retain said magnet therebetween" was added to original claim 1 in the first amendment (Paper No. 3) in prosecuting the original patent, it is apparent from appellants' comments in that amendment that the "friction fitted" language of that amendment was the critical feature being relied upon by appellants in an attempt to define over the prior art.

Appeal No. 2001-0790  
Application No. 09/110,145

from reissue claims 15 and 22 does not constitute a broadening in an aspect germane to the prior art rejection.

In light of the above, on balance, it is our opinion that reissue claims 15 and 22, and hence reissue claims 16-21 which depend from reissue claim 15, are narrower than "the surrendered subject matter" in an aspect germane to the prior art rejection and broader only in aspects unrelated to the rejection. Accordingly, we conclude that reissue claims 15-22 are not precluded by the recapture rule. It follows that we cannot sustain the examiner's rejection.

Appeal No. 2001-0790  
Application No. 09/110,145

CONCLUSION

To summarize, the decision of the examiner to reject claims 15-22 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

jdb/vsh

Appeal No. 2001-0790  
Application No. 09/110,145

HAROLD V. STOTLAND  
SEYFARTH, SHAW, FAIRWEATHER & GERALDSON  
42ND FLOOR  
55 EAST MONROE STREET  
CHICAGO, IL 60603-5803