

Federal Circuit Holds that Reissue Application of Hemodialysis Shunt Patent Impermissibly Recaptured Surrendered Subject Matter

Article By:

Aaron J. Morrow

The Federal Circuit, in a nonprecedential decision, held that claims of a reissue application were properly rejected because they recaptured subject matter surrendered during the original prosecution of U.S. Patent No. 8,282,591 (“**the ’591 patent**”).^[1]

The ’591 patent is directed to an arteriovenous shunt that connects a graft to an artery and passes returned blood through a “single lumen venous outflow catheter” into the right atrium of a patient’s heart. This system reduces the risk of infection, clotting, and hyperplasia compared to systems that remove and return blood through a graft connected to a vein.^[2]

During prosecution of the ’591 patent, Drs. Iftikhar and Nazir Khan (**the Khans**) amended the claims to require a “cylindrical cuff” to direct passage of blood from the arterial graft to the venous outflow catheter and argued that the cited art did not disclose a cylindrical cuff.^[3] The Khans then sought reissue of the ’591 patent, filing new claims that omitted the cylindrical cuff limitation. After the examiner rejected these claims for recapturing subject matter surrendered during the original prosecution, the Khans appealed to the Patent Trial and Appeal Board (**the Board**).^[4] The Board affirmed the examiner’s rejection and the Khans appealed to the Federal Circuit.^[5]

35 U.S.C. § 251 permits a patentee to seek a broadening reissue of a patent within two years from the grant of the original patent where, through error, the patentee claimed less than he had a right to claim. The patentee, however, may not recapture subject matter through reissue that was intentionally surrendered during the original prosecution to overcome the prior art.

The Federal Circuit applied a three-step analysis to determine whether recapture occurred. First, the court considered whether and in what aspect the reissue claims were broader than the original patent claims. The court found that the reissue claims were broader because none required the cylindrical cuff recited in the patented claims.^[6] In step two, the court determined whether the broader aspects of the reissue claims related to surrendered subject matter. The court held that the cylindrical cuff related to surrendered subject matter because the Khans amended the claims in response to prior art rejections to require the cylindrical cuff and relied on this aspect to distinguish the claims over the prior art.^[7] The court stated that it not need address the third step ? whether the reissue claims were

materially narrowed in other respects such that they may not have been enlarged ? because the Khans did not argue that the independent reissue claims were materially narrowed in other respects.^[8] The court found that because the Khans did not separately argue the patentability of dependent claims before the Board, these arguments were waived, and therefore affirmed the Board's rejections of the reissue claims for impermissibly recapturing surrendered subject matter.^[9]

While this decision did not address whether claims were materially narrowed in other aspects such that they may not have been enlarged, applicants seeking a broadening reissue of their patent claims will want to carefully consider both broadening and narrowing aspects of the claims to be pursued in their reissue application.

[1] In re: *Iftikhar Khan, Nazir Khan*, No. 2017-2207 (Fed. Cir. Feb. 15, 2018)

[2] *Id.* at 2.

[3] *Id.*

[4] *Id.* at 3.

[5] *Id.*

[6] *Id.* at 4.

[7] *Id.*

[8] *Id.* at 5.

[9] *Id.* at 5-6.