

In re Float'N'Grill LLC, 2022-1438 (Fed. Cir. 7/12/2023)

This is an appeal from the PTAB case 16/110,448. The Float'N'Grill (herein after “FNG”) appealed from a PTAB decision affirming the examiner’s rejections of claims in the application to reissue the ‘132 reissue patent under 35 USC 112(b) and 251. The Federal Circuit affirmed.

Legal issue: 35 USC 251, original patent requirement.

The Federal Circuit held that the rejected claims did not cover the invention disclosed in the original patent because they “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.”

In each of these cases, the focus of the § 251 analysis was on the invention disclosed in the original patent and whether that disclosure, on its face, explicitly and unequivocally described the invention as recited in the reissue claims. As relevant to this appeal, we hold that reissue claims broadening a limitation to cover undisclosed alter natives 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 pa tent requirement of § 251. [In re Float'N'Grill LLC, 2022-1438 (Fed. Cir. 7/12/2023).]

The Federal Circuit rejected FNG’s arguments, reasoning as follows.

FNG argues that the plurality of magnets is simply a non-essential embodiment of the original patent, like the tapering of the metal tips in *Peters*. *** We disagree. First, an express statement of criticality of an element in the original specification is not a prerequisite for a determination that that element is essential to the invention claimed in the original patent. There was no such statement of criticality of the arbors in *Forum* or the added water in *U.S. Industrial Chemicals*. Our court and the Supreme Court in those cases held that the limitations were critical because the inventions were described exclusively with the limitations later omitted, and an analysis of the relationship of those limitations to the functionality and disclosure of the original invention revealed their essential and critical nature. The same analysis reveals the essential and critical nature of the plurality of magnets here. [In re Float'N'Grill LLC, 2022-1438 (Fed. Cir. 7/12/2023).]

FNG repeatedly argues that because the reissue claims are broad enough to generically cover a float apparatus having a plurality of magnets, the original patent requirement of § 251 is met. What FNG fails to appreciate is that it is precisely because the reissue claims go beyond and are not limited to the plurality of magnets essential to the invention disclosed in the original patent that they fail to meet the requirement of § 251. [In re Float'N'Grill LLC, 2022-1438 (Fed. Cir. 7/12/2023).]

Finally, FNG argues that *Revolution Eyewear v. Aspex Eyewear, Inc.*, 563 F.3d 1358, 1366 (Fed. Cir. 2009) and *In re Rasmussen*, 650 F.2d 1212, 1215–16

(CCPA 1981) hold that if the original specification would have supported the reissue claim omitting the limitation, then the original patent requirement is satisfied. FNG is incorrect. In *Revolution Eyewear*, the court found that the original patent was satisfied “[b]ecause [it had just] held that the written description requirement [was] satisfied.” *Id.* at 1367. In *Antares*, 771 F.3d at 1362 & n. 8, we explained that this analysis in *Revolution Eyewear* was a product of the parties’ arguments and not a holding that satisfaction of written description therefore satisfies the original patent requirement. FNG’s reliance on *In re Rasmussen* fares no better; that case too was analyzed in the context of written description and new matter, not the original patent requirement of § 251 as an independent basis for unpatentability of the reissue claims. *In re Rasmussen*, 650 F.3d at 1215–16. [In re Float'N'Grill LLC, 2022-1438 (Fed. Cir. 7/12/2023).]