

IN RE FLOAT'N'GRILL LLC, Appeal No. 2022-1438 (Fed. Cir. July 12, 2023). Before Prost, Linn, and Cunningham. Appealed from the PTAB.

Background:

The patentee Float'N'Grill ("FNG") obtained a patent for a float configured to support a grill over a body of water, so that a user can grill food while remaining in the water. The specification described a single embodiment in which the float portion was secured to the portable grill via magnets. No alternative mechanisms for securing the float to the portable grill were described. The allowed claim recited "a plurality of magnets disposed within...each of the right grill support and the left grill support."

After the patent issued, FNG filed a broadening reissue application, in which the magnets were no longer explicitly recited in the claims. The broadened claim in the reissue application simply recited "wherein a bottom side of the grill is removably securable and removably disposed immediately atop the upper support portion of the grill support member." This recitation is silent as to the particular structure for securing the grill to the float.

The Examiner reviewing the reissue application rejected the claims for failure to satisfy the "original patent" requirement of 35 U.S.C. § 251. The Examiner alleged that the magnets were not disclosed as being optional, and that the magnets were a "critical" part of the invention that could not be removed. The PTAB affirmed the Examiner's rejection. FNG appealed to the Federal Circuit.

Issue/Holding:

Did the patentee's reissue claims comply with the "original patent" requirement of 35 U.S.C. § 251(a)? No, affirmed.

Discussion:

Reissue patents must comply with 35 U.S.C. § 251(a), which states that "the Director shall, on the surrender of such patent and the payment... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application... No new matter shall be introduced into the application for reissue."

The Supreme Court has held that the "original patent" requirement is only satisfied if the disclosure explicitly and unequivocally describes the invention as recited in the reissue claims. *U.S. Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668 (1942). In that case, the patentee claimed a process for producing ethylene oxide that included adding water to the reaction chamber. Water was described as essential in the specification, and the addition of water was claimed in the original patent. The Court held that a reissued patent that removed the requirement for water in the reaction was invalid because the "original patent" required the use of water.

In view of this case law, the Federal Circuit held that FNG's reissue claims were properly rejected because FNG's original disclosure simply did not contemplate securing the portable grill to the float with mechanisms other than magnets. That is, the magnets were not disclosed as being optional, and were instead basically essential to FNG's disclosure: "the specification contains nothing to suggest to one of ordinary skill in the art that alternative mechanisms may be used in place of the plurality of magnets..."

Since the "original patent" requirement of §251(a) is more stringent than the written description standard of §112(a), continuation applications are a better vehicle for broadening than reissue applications.