IN RE KOSTIC ET AL., Appeal No. 2023-1437 (Fed. Cir. May 6, 2025). Before Cunningham, Stoll, and Clevenger. Appealed from the PTAB.

Background:

The patent in suit included independent claim 1 which recited, among other things, "conducting *a pre-bidding trial* of click-through traffic from the first exchange partner's website." Claim 3 depended from claim 1 and recited "wherein the intermediary web site enables interested exchange partners to conduct a direct exchange of click-through traffic *without a trial process*." That is, claim 1 was directed to a method with steps A, B, and C, and claim 3 recited a method performed *without* C.

Well after the two-year reissue broadening window, the patentee filed a reissue application and alleged that claim 3 was in error because it "expressly excludes the trial bidding process referred to in the method of claim 1," which raises issues under 35 U.S.C. §112(b) and §112(d). The patentee attempted to rewrite claim 3 into independent form, and reissue claim 3 referred to conducting an exchange with *or* without a trial process.

The Examiner rejected claim 3 twice under 35 U.S.C. §251(d), asserting that it improperly broadened the scope of original claim 3. The patentee appealed to the PTAB, and the PTAB affirmed the rejection of claim 3 under §251(d).

The patentee then appealed to the Federal Circuit, asserting that "the proper inquiry is not whether the scope of reissue claim 3 is broader than the scope of original claim 3, but whether the scope of reissue claim 3 is broader than the 'intended scope' of original claim 3."

Issue/Holding:

Was the USPTO correct to consider only whether reissue claim 3 was literally broader than original claim 3, regardless of the patentee's intended scope of original claim 3? Yes, affirmed.

Discussion:

The Federal Circuit clearly rejected the patentee's argument that the subjective intent behind claim 3 was relevant at all. More specifically, in the court's view, the "suggestion that we compare claim scope by considering what was intended by the parties, rather than by construing the claims for what they actually recite, is completely without merit." *Superior Fireplace Co. v. Majestic Prods. Co*., 270 F.3d 1358, 1375 (Fed. Cir. 2001). Furthermore, the plain text of 35 U.S.C. §251(d) provides no indication that intent is a relevant factor.

As for the claim language at issue, the court found that original claim 3 recited a method performed without a trial process, and that reissue claim 3, rewritten into independent form, broadened this in a meaningful way by reciting a method performed with "an exchange of click-through traffic *with a trial process or* a direct exchange of click-through traffic *without a trial process*."

Thus, the Federal Circuit held that reissue claim 3 was clearly broader than original claim 3, and since the reissue application was filed more than two years after the grant of the patent, claim 3 in the reissue application was statutorily barred under 35 U.S.C. §251(d).