



# US reissue procedure can fix failure to include dependent claims

– *Journal of Intellectual Property Law & Practice*, 2011

Author(s): Charles R. Macedo

*In re Tanaka*, No. 2010-1262, US Court of Appeals for the Federal Circuit, 2011 US App. LEXIS 7739, 15 April 2011

## Abstract

US reissue proceedings may be used to add additional dependent claims even if none of the issued claims are changed.

## Legal Context

Once a US patent issues, a patentee may seek to correct certain errors made without deceptive intent that are deemed to render the issued patent either wholly or partly inoperative or invalid. In *In re Tanaka*, a divided panel of the US Court of Appeals for the Federal Circuit confirmed that a reissue proceeding may be used to add dependent claims as a hedge against possible invalidity of the original claims. *Tanaka* is likely to reinforce the use of reissue proceedings by patentees who would like to strengthen their patent protection without sacrificing claim scope and damages for previously issued claims.

## Facts

In July 2000, US Patent No. 6,093,991 (the '991 patent) issued with one independent claim (claim 1) and six dependent claims (claims 2–7).

Exactly two years later, Tanaka filed reissue application Serial No. 10/201,948 (the '948 application) with respect to the '991 patent at the US Patent and Trademark Office (PTO), seeking to broaden the scope of independent claim 1 of the '991 patent. In support of the application, Tanaka filed a declaration stating that 'the originally-presented claims did not adequately define the invention because they were more specific than necessary' and thus 'the claims of the original patent cover less subject matter than we were entitled to claim'.



During the prosecution of the ?948 application, Tanaka gave up his efforts to seek to broaden claim 1 and eventually presented for reexamination un-amended original claims 1–7, and a new dependent claim (claim 16), which depended from claim 1. In September 2007, Tanaka submitted a substitute declaration stating: ‘because I did not fully appreciate the process of claiming according to U.S. practice, I did not realize that I had claimed more or less than I was entitled to claim’ and ‘the originally presented claims did not adequately define the invention because they were more specific than necessary’.

Ultimately, the Examiner rejected claims 1–7 and 16 with the following explanation:

The nature of the defect is that the error specified in the oath filed 9/24/2007 is not an error correctible by a reissue. The Applicant has not specified an error that broadens or narrows the scope of the claims of issued patent 6093991. The original claim 1 remains in the current reissue application, therefore the broadest scope of the patent remains the same.

This rejection was made final, and Tanaka appealed to the US Board of Patent Appeals and Interferences.

On appeal to the Board, a seven-judge panel issued a precedential opinion affirming the Examiner's rejection. *Ex parte Tanaka*, No. 2009-000234, 2009 Pat. App. LEXIS 24 (BPAI 9 December 2009) (*Tanaka I*). *Tanaka I* phrased the issue to be decided as follows:

Has the Appellant shown that the Examiner erred in determining that the presentation of a narrower claim in a reissue application that still contains all of the original patent claims does not present the type of error correctible by reissue under 35 U.S.C. §251?

The Board found the examiner did not err, and that under its analysis of the statute, ‘the presentation of a narrower claim in a reissue application that still contains all of the original patent claims is not an error correctible by reissue under 35 U.S.C. §251’.

In addressing this issue, the Board discussed *In re Handel*, 312 F.2d 943 (CCPA 1963), a decision by the US Court of Customs and Patent Appeals (a predecessor court of the Federal Circuit, whose precedent is binding on the Federal Circuit). The Board acknowledged that in footnote 2 of *Handel*, the *Handel* court commented on the examiner's rejection in that case, which addressed the same issue raised by the ?948 application, but came to a different conclusion: ‘[t]he narrower appealed claims are simply a hedge against possible invalidity of the original claims should the prior use be proved, which is a proper reason for asking that a reissue be granted’. Despite these express statements, *Tanaka I* rejected as ‘dictum’, *Handel*'s guidance on this very issue:

As such, the CCPA's tacit approval in a footnote that it is proper to seek narrower claims in a reissue as a hedge against the possible invalidity of the original claims is a voluntary opinion made by the court which falls outside the holding of the court in *Handel*



and which was made without argument or full consideration of the point after briefing by the parties. In other words, this statement in footnote 2 of *Handel* is dictum.

*Tanaka I* also discussed *Hewlett-Packard Co. v Bausch & Lomb, Inc.*, 882 F.2d 1556 (Fed. Cir. 1989), which *Tanaka I* recognized ‘noted’ that ‘[a]lthough neither “more” nor “less” in the sense of scope of the claims, the practice of allowing reissue for the purpose of including narrower claims as a hedge against the possible invalidation of a broad claim has been tacitly approved, at least in dicta, in our precedent’. Nonetheless, *Tanaka I* concluded that ‘the court in *Hewlett-Packard* did not squarely address the issue before us in the present appeal’.

*Tanaka I* also discussed *In re Muller*, 417 F.2d 1387 (CCPA 1969), which the Board rejected as not fully addressing the present issue:

The court in *Muller* did not address, even in dicta, the issue of whether the failure to present narrower claims is an error correctible under §251 “by reason of the patentee claiming more or less than he had a right to claim in the patent.” Rather, the court's holding in *Muller* was limited to a holding that the Board erred in determining that the patentee made a deliberate renunciation of subject matter during prosecution of the original patent. *Id.* (declining to reach the question of whether a deliberate non-election of species can be remedied by reissue).

Finally, *Tanaka I* turned to the Manual of Patent Examining Procedure (MPEP) §1402, which the Board concluded interprets section 251 as not allowing ‘for a reissue application in which the only error specified to support reissue is the failure to include one or more claims that is/are narrower than at least one of the existing patent claims(s) without an allegation that one or more of the broader patent claims(s) is/are too broad together with an amendment to such claim(s)’. The Board noted that ‘[s]ince July 2008, the 5,000+ USPTO examiners have applied the above stated MPEP reissue policy to determine proper and improper grounds for filing reissue applications’. Thus the Board on its own interpreted section 251 to ‘disallow[s] reissue applications that simply add narrow claims to the reissue patent when no assertion of inoperativeness or invalidity for the reasons set forth in §251 can be made by the patentee.’

Tanaka appealed the Board's decision to the Federal Circuit.

## Analysis

Section 251 of the US Patent Act (35 USC), which governs reissue proceedings, states:

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, on the surrender of such patent and the payment of the fee required by law, 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. No new matter shall be introduced into the application for reissue.

35 USC §251, quoted in *In re Tanaka*, No. 2010-1262, 2011 US App. LEXIS 7739, at \*6–7 (Fed. Cir. 15 Apr 2011) (emphases supplied by the court) (*Tanaka II*).

On appeal, Judge Linn, writing for the majority in *Tanaka II*, found against the PTO, concluding ‘that the Board’s determination is contrary to longstanding precedent of this court and flies counter to principles of *stare decisis*’. *Tanaka II* recognized that section 251 ‘imposes two requirements for properly invoking the reissue process’:

1. The original patent must be ‘wholly or partly inoperative or invalid’.
2. The ‘defective, inoperative, or invalid patent’ must have arisen ‘through error without deceptive intent’.

*Tanaka II* found ‘[t]here is no dispute in this case that any defect arose without deceptive intent’.

*Tanaka II* recognized that, in *Handel*, the CCPA ‘clearly stated’ that ‘adding dependent claims as a hedge against possible invalidity of original claims “is a proper reason for asking that a reissue be granted”’. After discussing *Muller* and *Hewlett-Packard* in addition to *Handel*, *Tanaka II* concluded that the statements in *Handel*, *Muller*, and *Hewlett-Packard* are more than ‘a passing observation’: ‘it was a considered explanation of the scope of the reissue authority of the PTO in the context of a detailed explanation of the reissue statute. Based on this court’s adoption of that rule and its adherence to the rule in both *Muller* and *Hewlett-Packard*, this court rejects the Board’s contrary ruling’.

*Tanaka II* also rejected the assertion that the omission of a narrower claim from an original patent does not constitute an error under §251 because the omission of a dependent claim does not render the patent inoperative. In particular, *Tanaka II* found that the omission of a narrower claim from a patent can render a patent partly inoperative by failing to protect the disclosed invention to the full extent allowed by law.

*Tanaka II* further rejected the premise that adding a single dependent claim to the originally issued claims is equivalent to the disallowed practice of filing a ‘no defect’ reissue. In particular, *Tanaka II* held that ‘[a]pplying for a reissue that adds only narrower claims without amending any of the original claims is not the same as a “no defect” reissue’.

Finally, *Tanaka II* rejected arguments by Teva, an amicus, contending that permitting the addition of narrower dependent claims by reissue would be against the public policy



of allowing the public to rely upon what was actually claimed. In particular, *Tanaka II* recognized that under the equitable intervening rights statute, 35 USC §252, a court could fashion remedies to protect public investments made before the reissue. Thus the majority in *Tanaka II* followed the prior statements of its predecessor court and the Federal Circuit in *Handel*, *Muller*, and *Hewlett-Packard* regarding the addition of dependent claims being within the scope of section 252, and reversed the Board.

In his dissenting opinion, Judge Dyk confirmed he ‘would affirm the Board’s holding that the addition of a narrower claim in a reissue application is not a proper basis for reissue under 35 U.S.C. §251 if the application still contains all of the original patent claims’. Judge Dyk, unlike the majority, did not feel bound by the statements in *Handel*, *Muller*, and *Hewlett-Packard*, which, in his view, ‘never squarely addressed the issue, and have at most assumed the applicability of [a particular] standard’.

### **Practical significance**

In *Tanaka II*, the majority rejected an interpretation of the reissue statute, which has been incorporated into the MPEP since at least 2008, as contrary to the statement of law found in the precedent of the Federal Circuit and its predecessor court for over fifty years. Considering the divergent views expressed by the majority, *Handel*, *Muller*, and *Hewlett-Packard*, on the one hand, and the PTO, the Board, and the dissent, on the other hand, it is likely that this issue may be revisited either en banc by the Federal Circuit and/or by the Supreme Court in the not too distant future.

For more information on these developments, please contact one of our attorneys.

---

\*Charles R. Macedo is a partner at Amster, Rothstein & Ebenstein LLP. His practice specializes in intellectual property issues including litigating patent, trademark and other intellectual property disputes. The author may be reached at [cmacedo@arelaw.com](mailto:cmacedo@arelaw.com).

Mr. Macedo is also the author of *The Corporate Insider's Guide to U.S. Patent Practice*, published by Oxford University Press in 2009.