

In re Yasuhito Tanaka - An Improper Expansion of Reissue Law and Practice

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I. Introduction

On April 15, 2011, a divided three judge panel of the Court of Appeals for the Federal Circuit issued a decision in an appeal styled as *In re Yasuhito Tanaka*.¹ *Tanaka* reversed *Ex parte Yasuhito Tanaka*,² a precedential decision by an expanded seven-member panel of the Board of Patent Appeals and Interferences (“Board”)³ in the United States Patent and Trademark Office (“USPTO”). In that decision, the Board had held that:

The specific wording used in § 251 limits the scope of the Director’s power to grant reissue patents only in situations in which the original patent is 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 Office’s interpretation of § 251 to disallow reissue applications that simply add narrower 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, is in keeping with the plain wording and scope of § 251.⁴

On April 15, 2011, Judges Linn and Bryson, writing for the panel majority in *Tanaka*, held that:

Because the Board’s determination is contrary to long-standing precedent of this

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¹640 F.3d 1246, (Fed. Cir. 2011). This decision is hereinafter referred to as “*Tanaka*,” except where attached to a citation of the reported decision.

²BPAI Appeal No. 2009-000234 (BPAI 2009), 2009 WL 5819322 (2009). This decision is hereinafter referred to as “*Ex parte Tanaka*”

³Pursuant to the 35 U.S.C. § 6 of the Leahy-Smith America Invents Act (the “AIA”), as of September 16, 2012, the Board of Patent Appeals and Interferences (the “BPAI”) has been renamed the Patent Trial and Appeal Board (the “PTAB”). This paper uses “Board” to mean the BPAI.

⁴*Ex Parte Tanaka*, 2009 WL 5819322 (2009), at *12

court, this court reverses and remands.⁵

The USPTO did not file a request for rehearing, petition for an en banc panel, or petition for certiorari with respect to the *Tanaka* decision. Therefore, reissue patent RE42,990 E issued on December 6, 2011, adding new dependent claim 8 that depends from patent claim 1.⁶ Claims 1-7 of this reissue patent remained identical to claims 1-7 of the original *Tanaka* patent.⁷

It is the opinion of the author that *Tanaka* was wrongly decided by the Federal Circuit panel majority ("majority") for three reasons:

1) The majority appears to have either improperly interpreted, and/or simply ignored, the plain language of 35 U.S.C. § 251, first paragraph.

2) The majority relied on prior decisions of the Federal Circuit and its predecessor court⁸ as being precedential with respect to the issue that was decided in *Tanaka*, when those decisions are, in fact, *not* precedential to the issue decided in *Tanaka*.

3) The majority failed to properly analyze the language of the reissue declaration of record in the *Tanaka* reissue application in light of previous decisions by the Federal Circuit and the CCPA.

As a result of the Federal Circuit's decision, a policy memorandum that had

been issued on November 15, 2007 by then Deputy Commissioner for Patent Examination Policy John J. Love entitled "Clarification of Treatment of Reissue Applications That Only Add One or More Narrower Claims"⁹ was withdrawn in favor of a new policy memorandum by Director David J. Kappos issued on August 1, 2011.¹⁰

The new policy memorandum is entitled "Clarification of Criteria for Reissue Error in View of *In re Tanaka*." The Love memorandum had included the following summary:

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 claim(s) without an allegation that one or more of the broader patent claim(s) is/are too broad together with an amendment to such claim(s), does not meet the requirements of 35 USC § 251. Such reissue application should not be allowed.

The new Kappos policy memorandum abrogated the Love memorandum, and stated that:

The United States Patent and Trademark Office (the "Office") is providing notification of change in policy based on the recent decision of the U.S. Court of Appeals for the Federal Circuit of *In re Tanaka*.

⁵640 F.3d, at 1247.

⁶Reissue claim 8 provides: "8. The alternator pulley of claim 1, wherein an outer side of a respective pressing member contacts a middle portion of a corresponding roller such that the pressing members bear against axial centers of the rollers."

⁷U.S. Patent No. 6,093,991 ("the '991 patent.")

⁸The Court of Customs and Patent Appeals (hereinafter "CCPA").

⁹http://www.uspto.gov/web/offices/pac/dapp/opla/documents/reissue_narrower_claims_11152007.pdf

¹⁰1369 OG 230; <http://www.uspto.gov/web/offices/com/sol/og/2011/week34/TOC.htm#ref14>

In a reissue application, the addition of claims that are narrower in scope than the existing claims, without any narrowing of the existing patent claims, may be the basis for correcting an error under 35 U.S.C. § 251 to support a proper reissue application. A rejection under 35 U.S.C. § 251 will no longer be made in this scenario, provided that the claims are otherwise compliant with 35 U.S.C. § 251. This change revises the policy in the current Manual of Patent Examining Procedure (“MPEP”) that is provided in MPEP § 1402.

A citation to the *Tanaka* decision, and language that approves the filing of a reissue application such as was the subject of the *Tanaka* decision, have been added to MPEP § 1402, 8th Edition, Revision 9 (August 2012).¹¹

¹¹The MPEP provides that: “An error under 35 U.S.C. 251 may be based upon the addition of a claim or claims that is/are narrower in scope than the existing patent claims, without any narrowing of the existing patent claims. See *In re Tanaka*, 640 F.3d 1246, 1251, 98 USPQ2d 1331, 1334 (Fed. Cir. 2011).”

¹²At the time that the *Tanaka* reissue application was pending in the USPTO and in the Federal Circuit, the first paragraph of 35 U.S.C. § 251 provided, in pertinent part:

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. (Emphasis, in bold, added).

¹³The AIA amendments that are relevant to the above reproduced first paragraph of 35 U.S.C. § 251 are to strike “Whenever” and insert “(a) IN GENERAL.— Whenever”; and to strike the words “without any deceptive intention.” Presumably, the authors of the amendment to Section 251 were of the view that “error” is by definition an innocent mistake that was made unintentionally.

¹⁴Original claim 1 of the *Tanaka* patent defined the claimed alternator pulley as comprising a number of elements. The example of a claimed apparatus comprising elements A, B and C for which reissue is requested to add a dependent claim adding limitation D to one of the elements A, B and C is a simplified, but entirely accurate, analogy. However, note footnote 15, *infra*.

II. The Statutory Requirements for Reissue Involved in *Tanaka*

The first paragraph of 35 U.S.C. § 251, as it read throughout the *Tanaka* reissue application prosecution and at the time of the Federal Circuit’s *Tanaka*¹² decision, is reproduced in footnote 12, *supra*. The language of § 251 that was critical in the *Tanaka* matter is emphasized in bold. The first paragraph of Section 251 has been amended by subsections (d)(1)(A) and (d)(1)(B) of Sec. 20, TECHNICAL AMENDMENTS, of the Leahy-Smith America Invents Act that was enacted September 16, 2011 (“the AIA”).¹³ Those amendments became effective on September 16, 2012, but do not have any impact on the statutory language that controls the result reached in *Tanaka*, which became final in 2011.

The original *Tanaka* patent included seven claims to an alternator pulley, with independent claim 1 being the only independent claim. Broadly stated, the issue in the *Tanaka* reissue application prosecution was whether an original utility patent having an open-ended comprising type claim to an apparatus comprising, for example, elements A, B, and C is wholly or partly inoperative to afford patent protection for

an apparatus that as disclosed in the original utility patent comprises elements A, B, C and an additional limitation, D, on that combination.¹⁴ If so, then 35 U.S.C. § 251 would apply to permit the reissue applicant to protect claimed combination A, B, C and limitation D, and the original utility patent could be reissued to include a claim that depends from the existing patent claim for apparatus A, B and C, or a new independent claim for an apparatus that recites elements A, B, C and limitation D.

However, it is the opinion of the author that the original Tanaka patent was *not* inoperative to protect invention A, B, C and limitation D, as required by 35 U.S.C. § 251. Independent claim 1 in the original Tanaka patent was an open-ended comprising claim that necessarily covered any apparatus that included all elements specified in independent claim 1 of the Tanaka patent and any unclaimed limitation on the structure, arrangement or functioning of those elements, whether or not an apparatus accused of infringing independent claim 1 that includes elements A, B and C also imposed limitation D the combination of elements A, B and C.¹⁵ Therefore, the original Tanaka patent was *not* “inoperative” to protect the invention now specified in Tanaka reissue patent claim 8, which merely adds an additional limitation to the combination of elements that is more broadly recited in original patent claim 1, which “comprises” an alternator pulley having a plurality of elements that have certain structures and are arranged to cooperate in a certain way. Further, the record of the prosecution of the Tanaka reissue application and the resulting appeals based on that record fail to cite any

precedent that holds that the absence of a dependent claim that ultimately refers back to an patent open-ended comprising type claim in the original patent renders the original patent inoperative within the meaning of the 35 U.S.C. § 251 and can therefore be reissued to cure the error of “the patentee claiming more or less than he had a right to claim.”

III. The Original Tanaka Patent

The original '991 patent to Tanaka was issued on July 25, 2000. As issued, the '991 patent included independent claim 1 and dependent claims 2-7. The '991 patent is directed to an alternator pulley comprising a number of components arranged in a certain way. Included in those components was a one-way clutch. The one-way clutch can be broadly described as including an inner race, a retainer, plural rollers (i.e., roller bearings), plural coil springs and plural receiving members. The springs bias the receiving members against the axial centers of the rollers. Depending on the rotational speed of a driving belt, the rollers will be biased to either lock the inner race to a belt-driven driving member or unlock the inner race from the belt-driven member. Independent claim 1 of the '991 patent comprises over fifty lines of text, and in the opinion of the author is that claim 1 was, (and remains), a relatively narrow claim. The original application for patent was filed on January 21, 1998 and was indicated as being allowable on June 8, 1999, after applicant filed a response March 16, 1999 to a non-final office action

¹⁵See: MPEP § 2111.03, Eighth Ed., Rev. 6, Sept. 2010, pp. 2100-43 - 2100-44: “The transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) (“like the term ‘comprising,’ the terms ‘containing’ and ‘mixture’ are open-ended.”). Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) (“The transition ‘comprising’ in a method claim indicates that the claim is open-ended and allows for additional steps.”); Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997).” (Additional citations omitted.)

mailed on November 16, 1998.¹⁶

IV. The Tanaka Reissue Application Prosecution

A. Prosecution Before the USPTO Examiner

Reissue application serial number 10/201,948,¹⁷ was filed on July 25, 2002, within two years of the issue date of the '991 patent, as is required for a broadening reissue application.¹⁸ As filed, the '948 reissue application included a preliminary amendment to patent claim 1 that canceled two limitations of that claim, thereby broadening claim 1 and all claims depending directly or indirectly on claim 1. The application papers did *not* include a reissue declaration, but was nevertheless accorded a filing date of July 25, 2002 as permitted by 37 C.F.R. § 1.53(b).¹⁹

On January 8, 2003, a reissue declaration was filed in the '948 reissue application. That declaration was executed by the inventor of the '991 patent, and included an error statement having this language:

“...That I believe that the original patent is at least partially inoperative by reason of claiming more or less than I had a right to claim in the original

patent. ...

The amended claim 1 removes the limitations of "a belt disposed on said outer side of said driving member;" and "each pocket including a first wedge-shaped side and a second wedge-shaped side, each first wedge-shaped side being substantially wider than each second wedge-shaped side, each wedge-shaped side defining a wedge element, each wedge element having a first surface disposed within a respective pocket and a second annular surface adjacent to said inner side of said driving member," thereby reciting an invention less restrictive than that embodied in the originally granted claims.

That 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.

That in accordance with the foregoing, the claims in the original patent fail to claim the subject matter recited in new claims 1-7, and thus, in error, the claims of the original patent

¹⁶The file history of the '991 patent is not available on line, but the transaction history is available. All application papers in Tanaka reissue application no. 10/201,948, including the decision by the Board on appeal, are available to the public on the USPTO website at <http://portal.uspto.gov/external/portal/pair> *Ex parte Tanaka* is available in the file history, and at <http://www.uspto.gov/ip/boards/bpai/index.jsp> by using the Precedential Opinions Link under "Appeals."

¹⁷Hereinafter "the '948 reissue application."

¹⁸See: 35 U.S.C. § 251, fourth paragraph, in the pre-AIA text and 35 U.S.C. § 251(d) in the post-AIA text.

¹⁹37 C.F.R. § 1.53(b), then in effect, provided that an application filed in the Patent and Trademark Office that includes a specification containing a description pursuant to 37 C.F.R. § 1.71, at least one claim pursuant to 37 C.F.R. § 1.75, and any drawing required by § 1.81(a) is entitled to a filing date. To date, the author is unaware of any proposed amendment to § 1.53(b).

²⁰The language of 35 U.S.C. § 251: "Whenever any patent is, ..., deemed wholly or partly inoperative or invalid, ... by reason of the patentee claiming more or less than he had a right to claim in the patent ..." has a clear and settled meaning. See: *In re Wesseler*, 367 F.2d 838, 847-8 (CCPA, 1966) ("Yet the whole purpose of the [reissue] statute, so far as claims are concerned, is to permit limitations to be added to claims that are too broad or to be taken from claims that are too narrow. That is what the statute means in referring to 'claiming more or less than he had a right to claim.'" Accordingly it now stated in MPEP § 1402 that an error statement that recites the error of claiming "more or less" than there was a right to claim is not an unequivocal statement of broadening, the January 8, 2003 reissue declaration was accompanied by a statement that explained which

cover less subject matter than we were entitled to claim.”²⁰

Notwithstanding the “more or less” language, it is clear from the language of above-quoted declaration that the ‘948 reissue application, which was filed less than two years after the issue date of the original Tanaka ‘991 patent, was intended to create a broadening reissue application for the purpose of correcting the error of claiming “less than the patentee had a right to claim,” i.e., claiming the disclosed invention too narrowly.

Prosecution of the ‘948 reissue application resulted in prior art rejections of the broadened claims. During the course of the prosecution of the ‘948 reissue application in the USPTO, originally patented claims 1-7 were restored to their original form as issued in the ‘991 patent, and new, broader independent claims were asserted together with claims dependent on the broadened claims. However, the Examiner did not find any of the newly presented broadened claims presented during prosecution of the ‘948 reissue application to be patentable. A final rejection was issued on June 28, 2005, and applicant thereafter filed a Request for Continued Examination (“RCE”).²¹ On September 5, 2006, a non-final Office action was issued in the ‘948 reissue application. In that Office action, originally patented claims 1-7 were determined to be patentable without amendment, but all of the broadened claims, except for claims 16 and 17 that depended, respectively, from new broadening independent claims 8 and 15, were rejected. The reissue applicant then filed an amendment in which claims 8-15 and 17 were canceled, leaving only original patent claims 1-7 and dependent claim 16 remained pending. Claim 16 was

amended to depend from original patent claim 1.

Although dependent claim 16 appeared to be patentable over the prior art of record because parent claim 1 was found to be patentable, a final rejection was nevertheless issued on March 23, 2007. In that final rejection, the examiner found that originally patented claims 1-7 of the original ‘991 patent remained patentable over the prior art of record in the ‘948 reissue application, but new dependent claim 16 was objected to by the examiner. The final rejection required applicant to file a reissue oath or declaration stating an error that was now being corrected by the reissue application, and also stating that all errors being corrected by the reissue application had arose without any deceptive intention on the part of applicant. This requirement was specifically aimed at dependent claim 16, the sole claim now being added to the claims the claims of the original ‘991 patent.

Applicant responded to the March 23, 2007 rejection by filing a substitute reissue declaration on September 24, 2007.²² That declaration, which ultimately became the declaration of record in both of the Tanaka reissue application appeals, contained the following statements by the inventor that are pertinent to describing the error to support reissue of the original patent:

...

Claims 1-7 correspond to the original claims in the U.S. Patent No. 6,093,991, and new dependent claim 16 has been added to set forth the invention in a varying scope. ...

That I believe that the original patent is at least partially in-

limitations were being removed from claim 1.

²¹35 U.S.C. § 132(b) (Nov. 29, 1999); AIA 35 U.S.C. § 132(b), (Sept. 16, 2012), 37 C.F.R § 1.114 (effective May 29, 2000 and MPEP § 706.07(h) (8th Ed. Aug., 2001 and subsequent MPEP Revisions).

²²March 24, 2007 was a Monday, so that with extensions of time, the September 24, 2007 filing was timely.

operative by reason of claiming more or less than I had a right to claim in the original patent.

That while I recognize the importance of the aspects of the invention disclosed in the original patent, I did not fully understand the scope of the claims under U.S. law, and thus, when the original application was prepared, I failed to recognize that the disclosed invention was not fully covered by the original claims.

For example, at least one error on which reissue is based is described below.

Newly added dependent claim 16 recites that an outer side of a respective pressing member contacts a middle portion of a corresponding roller such that the pressing members bear against axial centers of the rollers. As noted in the response filed October 13, 2005, the features recited in claim 16 are supported at least by Figure 2.

The features recited in dependent claim 16 were not included in the original patent.

That 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.

That when I executed the Declaration of the original application, I reviewed the application carefully for accuracy, but did not recognize the various degrees of specificity with which aspects of an invention can be claimed or that such as-

pects could be claimed alone.

That is was not until after the original patent issued that I discovered that the originally presented claims did not adequately define the invention because they were more specific than necessary.

That for this reason, there was an error in the original patent claims that rendered the original patent partially inoperative by failure to adequately claim the invention to the fullest extent possible.

That in accordance with the foregoing, the claims in the original patent fail to claim the subject matter recited in new claims 1-7, and thus, in error, the claims of the original patent cover less subject matter than we were entitled to claim.

That the foregoing is not an exhaustive detailing of all errors present in the original patent, but does reflect some of the errors.

That all errors being corrected in this application for reissue, up to the time of filing this declaration, arose without any deceptive intention on my part.

The Examiner responded on October 10, 2007 by issuing a final rejection. The basis for the rejection was that the reissue application no longer specified any error that could be corrected by reissue of the original Tanaka patent, and that there had been neither broadening or narrowing of the scope of the originally patented claims. Applicant responded by arguing that the declaration properly stated that applicant had claimed "more or less" than the applicant had a right to claim. Applicant thereafter

perfected an appeal to the Board.

B. *Ex parte Tanaka*²³

In *Ex parte Tanaka*, an expanded Board panel framed the issue as being:

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 correctable by reissue under 35 U.S.C. § 251?²⁴

In arriving at its decision, the Board considered the reissue declarations that were filed during the prosecution of the reissue application, analyzed the language of 35 U.S.C. § 251 and proceeded on the basis that the Federal Circuit has acknowledged that although § 251 should be construed liberally, it does not enable correction of every error in a patent via reissue of that patent.²⁵ The Board then proceeded to analyze a number of prior decisions that included *In re Handel*,²⁶ *Hewlett-Packard Company, v. Bausch & Lomb Incorporated*,²⁷ *In re Muller*,²⁸ *In re Altenpohl*²⁹ and *In re Dien*.³⁰

The Board found that in *Handel*, Judge Rich, writing for a five-judge panel that included Chief Judge Worley, stated that:

The sole issue in the case is whether the appealed claims are ‘for the invention disclosed in the original patent,’ as required by 35 U.S.C. § 251, the statute governing the granting of reissues.³¹

The Board explained that Judge Rich’s above-quoted statement was for the purpose of focusing the *Handel* opinion on the issue before the Court.³² Apparently, it was necessary that Judge Rich do so because during the prosecution of Handel’s reissue application, the Board had reversed a claim rejection as being improperly based on claiming less than the patentee had a right to claim. Judge Rich took the time to comment on the confused language of the reissue oath of record in the Handel reissue application.³³ As part of his commentary, Judge Rich quoted the first paragraph of 35 U.S.C. § 251, and also added the following guidance:

The [Examiner’s] reference here is obviously to the opening clauses of 35 U.S.C. § 251, the first paragraph of which reads as follows:...³⁴

Quoting from McCrady, Patent Office Practice, 4th Ed., 1959, p. 309, ‘The term ‘inoperative’ has been construed to mean inoperative adequately

²³2009 WL 5819322, Appeal 2009-000234, (BPAI 2009), Reissue Application No. 10/201,948, decided December 9, 2009 (Precedential). The Board decision is also available as stated in footnote 7, *supra*.

²⁴*Ex parte Tanaka*, at *3.

²⁵*Id.*, at *4, citing *In re Serenkin*, 479 F.3d 1359, 1362 (Fed. Cir. 2007) (quoting portions of *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986) and *MBO Labs., Inc. v. Becton, Dickinson & Co.*, 474 F.3d 1323 (Fed. Cir. 2007)

²⁶312 F.2d 943, (CCPA 1963)

²⁷882 F.2d 1556 (Fed. Cir. 1989)

²⁸417 F.2d 1387 (CCPA 1969)

²⁹500 F.2d 1151 (CCPA 1974)(rehearing denied)

³⁰680 F.2d 151 (CCPA 1982)

³¹*Ex parte Tanaka* at *5, citing 312 F.2d, at 945 and 948. (N.B.: The *Handel* opinion actually first states the issue at 312 F.2d 944, prior to the footnote at 945, which actually appears on page 949.)

³²*Id.*, at *5-6.

³³*Id.*, at *6, citing 312 F.2d, at 945, note 2.

³⁴The language of 35 U.S.C. § 251, first paragraph appears in footnote 12, *supra*.

to protect the invention, which may be due to failure of the solicitor to understand the invention * * *.' There is no issue of new matter in this case. At oral argument the solicitor admitted that the reissue claims on appeal are narrower than the claims of the original patent. Hence, the defect of the original claims would seem to be that they claimed more, not less, as the examiner said, than the applicant had a right to claim.

The examiner's error seems to be traceable to the reissue oath. While in its entirety the oath makes it perfectly clear that appellant's purpose was to narrow his claims (at least claims 4, 5, and 6) to avoid the possibility of their being invalid in view of an alleged prior public use, he too asserted that his patent was partly inoperative 'by reason of his claiming less than he had a right to claim in his patent.' The term 'less' appears to have been used in the sense of fewer claims than he could properly have made, rather than in the statutory sense of subject matter included within the claims. *Since the patent claims have been retained, neither more nor less is being claimed. The 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. [Emphasis added.]³⁵

The Board then discussed the portion of the *Handel* decision that appears in *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556 (Fed. Cir. 1989), a decision involving the validity of reissue patent RE31,684, which had added dependent claims 10-12 to original patent 3,761,950. The Board found that in *Hewlett-Packard*, the Federal Circuit declined to address the question of whether merely adding one or more dependent claims to a patent by reissue to cure the "error" of omitting narrow claims that more specifically cover a broadly claimed invention qualified as a reissuable error under 35 U.S.C. § 251. Instead, the *Hewlett-Packard* panel chose to decide the appeal in *Hewlett-Packard* based only on the requirement in 35 U.S.C. § 251 that reissue of a patent be based on "error without deceptive intent" because the *Hewlett-Packard* panel had determined that there had been intentional misconduct in the prosecution of the reissue application and that the reissue patent was *not* based on "error without deceptive intent."³⁶ The Board further found that in *Hewlett-Packard*, the Federal Circuit expressly stated that footnote 2 of the *Handel* decision was *dicta*.

The Board also pointed out that even after the *Hewlett-Packard* panel had declined to decide whether the addition of narrow claims via reissue as a so-called hedge

³⁵*Handel*, at 945, footnote 2.

³⁶*Ex parte Tanaka*, at *6-7, citing 882 F.2d at 1565. "Although 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. (Citing *In re Handel*, 312- F.2d at 945-46 n.2). See also 4 E. Lipscomb, Walker on Patents § 14:33 at 479 (3d ed. 1986). For purposes of this case, we will assume that that practice is in accordance with the remedial purpose of the statute, **although B & L clearly did not allege an "error" in the patent which meets the literal language of the statute.** We need not decide here whether omission of narrow claims which more specifically cover a broadly claimed invention meets the first prong of the requirement for error, that is, error in the patent, because B & L clearly did not establish the second prong, namely, inadvertent error in conduct. Contrary to B & L's position, a reissue applicant does not make a prima facie case of error in conduct merely by submitting a sworn statement which parrots the statutory language." [Emphasis added.]

against possible claim invalidity of original patent claims constitutes correction of an error that would support reissue of an original patent, the *Hewlett-Packard* panel noted that if a patent could be issued merely to add narrow claims as a hedge against possible claim invalidity, then virtually every patent could be reissued.³⁷

Next, the Board discussed *In re Muller*.³⁸ The Board observed that the facts in *Muller* were similar to those in *Handel* and in *Hewlett-Packard*, in that the reissue applicant in *Muller* merely added four additional claims without asserting an error in the existing patent claims. The

Board found that:

In *Muller*, the examiner's rejection under § 251 was based on the premise that the oath was defective because the appellant was attempting to recapture by reissue claims to a non-elected species.³⁹ As in *Handel*, the issue presented to us by the present appeal was not before the court in *Muller*, and the holding in *Muller* did not address the question now before us. Rather, the CCPA in *Muller* held that the newly-added reissue claims did not impermissibly recapture a non-elected species because 'the provisional election disappeared with the allowance of claims 1-3 of the patent, each of

which is generic as regards filter material' and because '[b]y including an additional limitation in each of four new claims here, appellant is not shifting to different species; he is simply defining his invention more narrowly, which he could have done but failed to do in the prosecution of the patent.'⁴⁰ 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.⁴¹

The Board then discussed *In re Altenpohl*.⁴² *Altenpohl* had been cited in at least one earlier Board decision as approving reissue of an original patent based solely on adding narrow patent claims as a hedge against claim invalidity.⁴³ However, in *Altenpohl*, dependent claim 11 of the *Altenpohl* patent lacked an antecedent basis for a particular limitation, and thus the original patent was partly invalid. This error was addressed through the filing a reissue appli-

³⁷*Id.*, at *7, citing 882 F.2d at 1565 in which it was stated that "B & L asserts the theory that, whenever it is apparent that narrower claims could have been obtained, error warranting reissue exists. Under B & L's theory, the dual error inquiry collapses into one because the omission of additional narrow claims not only makes the patent 'defective,' but also gives rise to an inference of 'oversight'. Were that theory correct, it is difficult to conceive of any extant patent for which a right of reissue would not exist, a view which this court has unequivocally and repeatedly rejected." (Citing *In re Weiler*, 790 F.2d 1576, 1582 (Fed. Cir. 1986 ("The reissue statute was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute *de novo* his original application."))

³⁸Cited at footnote 28, *supra*.

³⁹*Ex parte Tanaka*, at *7, citing *Muller* at 1388.

⁴⁰*Id.*, citing *Muller* at 1391.

⁴¹*Id.*

⁴²*Ex parte Tanaka* at *8, citing 500 F.2d 1151 (CCPA 1974)

⁴³*See: Ex parte Parks et al.*, 30 U.S.P.Q.2d 1234 (BPAL, 1994), at *1237

cation that included (1) an error statement in a supplemental reissue declaration that pointed out the technical defect in claim 11 that rendered it invalid, and (2) also included an amendment in which claim 11 was amended to correct the lack of antecedent basis that had resulted in claim 11 being invalid due to indefiniteness.⁴⁴

The Board concluded its review of the case law by discussing *In re Dien*.⁴⁵ In *Dien*, a patentee had filed a reissue application based on a so-called “no defect” provision that had been added in new subsection (a)(4) of 37 C.F.R § 1.175. The rule created the practice of permitting an applicant to file a reissue application without amending the claims or otherwise asserting an error. The purpose of such a reissue application was to obtain an Examiner’s opinion on patentability of the patent claims in light of new prior art cited by the reissue applicant.⁴⁶ In *Dien*, the Examiner applied the prior art to reject claims in the reissue application, the applicant appealed the rejections, and the Board affirmed the rejections. An appeal was then taken from that rejection. In that appeal, the CCPA granted a motion by the USPTO to dismiss the appeal on the grounds of lack of subject matter jurisdiction, since the applicant had filed a reissue application without asserting any existing error or defect in the patent that rendered the patent wholly or partly inoperative or invalid. The Board found that as in *Dien*, the record in *Ex parte Tanaka* did not provide an error asserted by the reissue applicant that would have rendered

the patent wholly or partly inoperative or invalid, and to accept the error in *Tanaka* would provide a work around against the proscription against no defect reissue applications mandated by the *Dien* court.⁴⁷

Ultimately, the Board held that the language of 35 U.S.C. § 251 could not be reconciled with the dicta in *Handel* stating that a proper use of the reissue process is to present narrower claims “as a hedge against possible invalidity of the original claims.”⁴⁸ The Board held that the Examiner had not erred in determining that 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. § 251.⁴⁹

C. *Tanaka*⁵⁰ at the Federal Circuit

1. The Majority Opinion

In the Federal Circuit appeal from the Board decision in *Ex parte Tanaka*, Judge Linn wrote the main opinion for a two-judge majority, and Judge Dyk wrote a dissenting opinion. The majority began by stating that

Because the Board’s decision is contrary to longstanding precedent of this court, this court reverses and remands.⁵¹

The majority then discussed *Handel*, and opined that

The basis for the reissue application in *Handel* was nearly identical to that in this case.⁵²

⁴⁴500 F.2d at 1156-57.

⁴⁵680 F.2d 151 (CCPA 1982)(So-called “no defect” reissue application filed under a then existing USPTO regulation that permitted a reissue applicant to obtain a review of new additional prior art without stating that the patent was wholly or partly inoperative or invalid did not present any reissuable error and was technically not a reissue application.)

⁴⁶See: 42 FR 5588 (January 28, 1977)

⁴⁷*Ex parte Tanaka*, at *11.

⁴⁸*Id.*, at *11-12.

⁴⁹The Board’s decision is available at <http://www.uspto.gov/ip/boards/bpai/index.jsp> under the link for Precedential Opinions.

⁵⁰Hereinafter “*Tanaka*”

⁵¹*In re Tanaka*, 640 F.3d 1246, 1247 (Fed. Cir. 2011). See also: 640 F.3d, at 1251.

⁵²*Id.*, at 1249, citing 312 F.2d 943, 946, n .2.

However, the majority opinion conceded that Judge Rich's statement in *Handel* that⁵³ has been characterized "as dictum," but pointed out that the Federal Circuit "has not departed from it."⁵⁴

The majority then discussed *Muller*. The majority stated that

The issue presented to the [Muller] court was whether the new claims were improper for reissue as defining a species different from that of the original claims.⁵⁵

In the *Muller* decision, it was held that the reissue application was proper because the reissue applicant was not shifting to a different species, but was simply defining the invention more narrowly, which was something that the reissue applicant could have done but failed to do during the prosecution of the original patent application. The majority noted that

Although the court did not expressly address the *Handel* case or restate the principle set forth there, the plain implication of the court's statement is that the court regarded the inclusion of dependent claims (i.e. "species") to be proper in a reissue proceeding, assuming that it was accompanied by an oath asserting that the "failure to present the narrower claims was through error without any deceptive intent. *Id.*"⁵⁶

The majority also discussed *Hewlett-Packard*, and noted that the panel in *Hewlett-Packard* observed that

Although 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." [Citations omitted.] For purposes of this case, we will assume that that practice is in accordance with the remedial purpose of the statute, although B & L clearly did not allege an "error" in the patent which meets the literal language of the statute. *We need not decide here whether omission of narrow claims which more specifically cover a broadly claimed invention meets the first prong of the requirement for error, that is, error in the patent, because B & L clearly did not establish the second prong, namely, inadvertent error in conduct. Contrary to B & L's position, a reissue applicant does not make a prima facie case of error in conduct merely by submitting a sworn statement which parrots the statutory language.*⁵⁷ [Emphasis added.]

However, in the very next paragraph of its decision in *Tanaka*, the majority appears to have conceded that

Even though the rule that adding a dependent claim as a hedge against possible invalidity is a proper reason to seek reissue has seemingly never been formally embodied in a holding of this court

⁵³"The 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."

⁵⁴*Id.*, at 1249.

⁵⁵*Id.*, at 1249, 1250, citing 417 F.2d 1387 (CCPA 1949)

⁵⁶*Muller*, 417 F.2d at 1391.

⁵⁷*Hewlett-Packard*, 882 F.2d at 1565.

or its predecessor, articulation of the rule in *Handel* was not simply 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.⁵⁸ [Emphasis added.]

The majority also cited *Pall Corp. v. Micron Separations, Inc.*⁵⁹ for the proposition that “each claim is a separate patent,” and *Phillips v. AWH Corp.*⁶⁰ for the proposition that narrow claims can be useful to clarify the meaning of broader, independent claims under the doctrine of claim differentiation.

Lastly, the majority considered *In re Dien*, and distinguished *Dien* by pointing out that in *Dien*, the reissue applicant was seeking an advisory opinion from USPTO regarding the patentability of the original patent claims, and did not allege any defect in the original patent. The majority opinion contrasted those circumstances with the facts in *Tanaka*, in which the reissue applicant was alleging error in failing to obtain a narrower claim.

2. The Dissenting Opinion

Judge Dyk began his dissent by stating:

Respectfully, I dissent. I 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.

The majority here bases its decision on the assertion that ‘the Board's determination is contrary to longstanding precedent of this court and flies counter to principles of stare decisis.’ Maj. op. at 1249. To support this assertion the majority relies on *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556 (Fed.Cir.1989), *In re Muller*, 57 CCPA 748, 417 F.2d 1387 (1969), and *In re Handel*, 50 CCPA 918, 312 F.2d 943 (1963). In my view, in those cases do not resolve the issue before us. Where, as here, the prior cases have “never squarely addressed the issue, and have at most assumed the applicability of [a particular] standard,” we are not bound by those decisions and remain “free to address the issue on the merits” in subsequent cases. *Brecht v. Abrahamson*, 507 U.S. 619, 631, 113 S.Ct. 1710, 123 L.Ed.2d 353 (1993); see also *Jan's Helicopter Serv., Inc. v. F.A.A.*, 525 F.3d 1299, 1308 n. 9 (Fed.Cir.2008); *Co-Steel Raritan, Inc. v. Int'l Trade Comm'n*, 357 F.3d 1294, 1307 (Fed.Cir.2004); *United States v. County of Cook, Ill.*, 170 F.3d 1084, 1088 (Fed.Cir.1999).⁶¹

Judge Dyk's dissent usefully points out that there are simply no reported court decisions that squarely address the issue

⁵⁸*In re Tanaka*, 640 F.3d 1246, 1250

⁵⁹66 F.3d 1211, 1220 (Fed. Cir. 1995)

⁶⁰415 F.3d 1303, 1314 (Fed. Cir. 2005)

⁶¹*Tanaka*, at 1252.

decided in *Tanaka*. The dissent then discussed the *Handel*, *Muller* and *Hewlett-Packard* cases. With respect to *Handel*, the dissent succinctly explained that:

In *Handel*, the examiner rejected the reissue claims in part because the addition of narrower claims without modification of the original claims was not a proper ground for reissue. 312 F.2d at 945. The Board reversed that ground for rejection, holding instead that the reissue claims were improper because they were not ‘directed to the same invention recited in the claims of the patent.’ *Id.*, at 947. On appeal, our predecessor court made clear that its “function [was] to pass only on such grounds of rejection as [had] not been reversed by the [Board].” *Id.* At 948. Thus, whether the addition of narrower claims was a proper ground for reissue was ‘clearly out of the case.’ *Id.* at 946. The court stated explicitly that the sole issue in the case [was] whether the [reissue] claims [were] for the invention disclosed in the original patent, as required by 35 U.S.C. § 251.’ *Id.* at 944. Though the court stated in a footnote that reissue is proper when the only change to the original patent is the addition of narrower claims as ‘a hedge against possible invalidity,’ it did not squarely address the issue. *See id.* at 945 n. 2.⁶²

Judge Dyk also pointed out that in *Muller*, the reissue claims were rejected in part because:

...‘they [were] drawn to species which were not elected under a restriction requirement in the original application.’ 417 F.2d at 1388. The court reversed because it concluded that the applicant was not shifting to [a] different species. Far from resolving the issue before us today, the court said nothing about whether the addition of a narrower claim in a reissue application that still contains all of the original patent claims is proper.⁶³

Judge Dyk’s dissent also addressed the *Hewlett-Packard* decision, and relied upon portions of the same language that the majority had relied on.⁶⁴ However, Judge Dyk emphasized that the *Hewlett-Packard* court was *not* deciding whether to allow reissue for the purpose of including narrower claims as a hedge against invalidity. Accordingly, Judge Dyk’s dissent indicates that *Hewlett-Packard* provided no precedent on the issue in the *Tanaka* proceedings.⁶⁵

The dissent concluded with a discussion of *Gage v. Herring*.⁶⁶ In that case, a broadening reissue application was filed in which a broadened claim was added, but did not modify any of the original patent claims. The Supreme Court concluded that there was no mistake or error in the original patent because the original patent claim was maintained without modification.⁶⁷ The dissent drew an analogy between the facts in the *Gage* and *Tanaka* de-

⁶²*Tanaka* at 1252. The citations within the quotation are to the various pages in the *Handel* decision.

⁶³*Id.* at 1252-53, citing to *Muller* at 1388 and 1391.

⁶⁴See the discussion of the *Tanaka* majority’s discussion of *Hewlett-Packard*, *infra*,

⁶⁵*Tanaka*, at 1253.

⁶⁶107 U.S. 640, 2 S.Ct. 819, 27 L.Ed. 601 (1883).

⁶⁷*Tanaka* at 1253-54, citing *Gage* at 645.

decisions, noting that the Tanaka reissue application did the same thing that had been done in *Gage*, i.e.; in both cases, the reissue applicant sought to add a claim and still retain the originally patented claims.

However, although the dissent correctly states that in *Gage*, as in *Tanaka*, the original claims were retained while a new claim was added, *Gage* involved the addition of a *broadening* claim, not a narrowing claim.⁶⁸ The facts in *Gage* therefore differ from the facts in *Tanaka*, in which the originally patented claims were retained and a single, *narrowing* dependent claim was added via reissue. It has long been a conventional reissue practice to file and obtain a reissue patent in which the originally patented claims have been retained, while one or more *broadened* claims are added to obtain a reissue patent that broadens the coverage that was accorded by the original patent.⁶⁹

V. Discussion of the Case Law Considered in *Tanaka*

With due respect to the Federal Circuit majority's analysis in *Tanaka*, the majority's opinion is flawed, and inarguably reached the wrong result.

The language of 35 U.S.C. § 251, (both pre-AIA and post-AIA), does not support the majority's holding that the "error" relied on by reissue applicant Tanaka to obtain a reissue patent is an error that falls within the plain language of 35 U.S.C. § 251. The *Tanaka* majority did not cite *any* decision that is precedential on the issue

that was decided in *Tanaka*, and admitted that the addition of a dependent claim "as a hedge against possible invalidity" has seemingly never been formally asserted in a holding of either the Federal Circuit or the Court of Customs and Patent Appeals as being a proper reason to seek reissue. The *Hewlett-Packard* decision is the only authority relied on by the *Tanaka* majority in which the facts at bar presented the issue of whether a patentee could reissue a patent under 35 U.S.C. §251 solely to add a dependent claim to a patent, without specifying any other error. As noted above, the *Hewlett-Packard* panel expressly elected not to decide the appeal on that issue, and instead decided to basis its opinion on a different issue that dictated the outcome reached by the *Hewlett-Packard* panel.

A. *In re Handel* is Not Precedential on the Issue Decided in *Tanaka*

"Stare decisis" is generally defined as "a policy of courts to stand by precedent and not to disturb a settled point."⁷⁰ While it is true that all decisions of the Court of Customs and Patent Appeals have been adopted by the Federal Circuit as precedential,⁷¹ a legal precedent is generally considered to be:

A principle of law actually presented to a court of authority for consideration and determination [that] has, after due consideration, been declared to serve as a rule for future guidance in the same or analogous cases, but matters which merely

⁶⁸ *Gage* cites *Miller v. Brass Company*, 104 U.S. 350 (1881), a case in which the Court held that as a matter of equity, a broadened reissue claim could properly be issued in a reissue patent if it had been omitted by mistake and was applied for within two years of the issue of the patent. Otherwise laches would bar the broadened claim.

⁶⁹ See: MPEP § 1401.09 in Rev. 1, November 1950, which quotes then existing Rule 176 and provides that "An original claim, if re-presented in the reissue application, is subject to re-examination, and the entire application will be examined in the same manner as original applications, subject to the rules relating thereto, excepting that division will not be required." Subsequently this practice has been retained and is discussed in MPEP § 1440.

⁷⁰ *Black's Law Dictionary*, Fourth Ed. 1951, at p. 1577.

⁷¹ *South Corp. v. United States*, 690 F.2d 1368 (Fed. Cir. 1982).

lurk in the record and are not directly advanced or expressly decided are not precedents.⁷²

In the *Handel* case, Judge Rich clearly and succinctly stated the sole issue before the *Handel* court.⁷³ However, the true basis for the majority opinion in *Tanaka* appears to have ignored Judge Rich's statement, because the majority opinion in *Tanaka* stated:

This court concludes that the Board's determination is contrary to longstanding precedent of this court and flies counter to principles of stare decisis. ... Nearly a half century ago, our predecessor court, the Court of Customs and Patent Appeals, 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." *In re Handel*, 50 CCPA 918, 312 F.2d 943, 946 n. 2 (1963). The basis for the reissue application in *Handel* was nearly identical to that in this case. The patentee had mistakenly failed to include narrow claims that he had a right to claim and later sought reissue to obtain those narrower claims without proposing to cancel any broader claims encompassing the claims sought to be added. The proposed reissue claims differed from the existing claims simply by the inclusion of additional limitations.⁷⁴

With all due respect to the *Tanaka* majority, the opinion in *Handel* cites *no* authority to

support the Judge Rich's pronouncement that reissue based only on the addition of a dependent claim that is being added "as a hedge against possible claim invalidity" is proper. Further, the above-quoted material ignores the fact that Judge Rich's opinion in *Handel* clearly stated the issue before the *Handel* court, and that issue was *not* stated to be the propriety of reissuing a patent based solely on adding a dependent claim to the original patent. Accordingly, *Handel* is *not* precedential on that issue.

B. *Hewlett-Packard v. Bausch & Lomb* is *not* Precedential on the Issue Decided in *Tanaka*

The decision in *Hewlett-Packard*, involved an issued reissue patent that was asserted to have been infringed by defendant Bausch & Lomb. The court's decision in each of the *Hewlett-Packard* involved a reissue statement that was inaccurate with respect to the conduct of the reissue applicant in obtaining the reissue patent

The *Hewlett-Packard* court cited *Handel* for the proposition that reissue of a patent based on the adding claims that were narrower in scope than the originally patented claims, without acknowledging the existence of any other error in the original patent, was procedurally proper "as a hedge against possible claim invalidity." However, the *Hewlett-Packard* court clearly stated that

We need not decide here whether omission of narrow claims which more specifically cover a broadly claimed invention meets the first prong of the requirement for error, that is, error in the patent, because B &

⁷²Black's Law Dictionary, Fourth Ed. 1951, at p. 1340.

⁷³See: notes 34 and 35, *supra*. See also: *Handel*, at 948 ("We stated at the beginning of this opinion that the issue before us is whether the claims are for the invention disclosed in the patent.")

⁷⁴640 F.3d 1246, 1249, language of 35 U.S.C. § 251, first paragraph omitted.

L clearly did not establish the second prong, namely, inadvertent error in conduct.⁷⁵

Thus, the *Hewlett-Packard* court in no way approved of the practice of permitting reissue of an original patent based on adding one or more narrow claims “as a hedge against possible claim invalidity.” Instead, the *Hewlett-Packard* court decided the appeal before it on the basis of the failure of the reissue patentee to rely on an “error without deceptive intention” in its reissue application. It should, however, also be recognized that the *Hewlett-Packard* court noted that the reissue declaration involved did *not* state an error that met the literal language of the reissue statute.⁷⁶ *Hewlett-Packard* is not precedential on the issue de-

cided in *Tanaka*.

C. *In re Muller* is Neither Informative nor Precedential on the Issue Decided in *Tanaka*

The *Muller* panel said nothing about the propriety of adding a narrower claim to a reissue application that included all of the originally patented claims. A comparison of Muller’s originally patented claim 1 and newly added independent reissue claim 11 illustrates that the four new independent reissue claims in the Muller reissue patent do not cure any error in the original Muller patent. For example, compare original Muller claim 1 and New Muller Reissue Claim 11:

A comparison of Muller’s originally patented independent claims 2, 3 and 9 with corresponding new reissue claims 12, 13 and 14 will also show that any device that would infringe original Muller reissue claim 12 would also infringe original Muller reissue claim 2, any device that would infringe Muller claim 13 would also infringe original Muller claim 3, and any device that would infringe original Muller reissue claim 14 would also infringe original Muller claim 9. All that remains in support of the Muller reissue application as being a “proper” reissue of the original Muller patent was the conclusion of the *Muller* panel, unsupported by citation to any authority, that:

By including an additional limitation in each of four new claims here, appellant is not shifting to different species; he is simply defining his invention more narrowly, which he could have done but failed to do in the

prosecution of the patent. We conclude that the reissue oath here shows that the failure to present the narrower claims was through error without any deceptive intention. The oath was therefore sufficient under 35 U.S.C. 251. [Emphasis added.]

The emphasized language above is not supported by any authority cited by the *Muller* panel.

D. *In re Dien*, 680 F.2d 151 (CCPA, 1982)

Dien was an *ex parte* appeal from a decision by the BPAI in which the BPAI had affirmed the rejection of all appealed claims. *Dien* is a precedential decision of the Court of Customs and Patent Appeals, and is a decision that most clearly indicates that the two judge majority got the *Tanaka* decision wrong.

⁷⁵882 F.2d 1565

⁷⁶*Id.*

Original Muller Claim 1	Reissue Claim 11
<p>1. Filtering means for tobacco smoke and like gaseous medium; comprising at least two adjacent layers of fibrous material having surfaces provided with a plurality of spaced openings defined by open bases and projections extending from said open bases and beyond said surfaces of the respective layers, said projections of said layers being directed toward each other and spacing the surfaces one from the other, said projections being made of said fibrous material and terminating in irregularly shaped frayed ends, whereby the projections of one layer may interlace with the projections of the other layer, to thereby provide a tortuous path for said medium between said layers and to thereby enhance the filtering action when said medium streams between said layers and along said surfaces of the latter.</p>	<p>11. Filtering means for tobacco smoke and like gaseous medium comprising: a plurality of adjacent layers of fibrous material constituted by adjacent folds of paper-like material folded and shaped to form an essentially round, cylindrical filter body, said layers having surfaces provided with a plurality of spaced openings defined by open bases and projections extending from said open bases and beyond said surfaces of the respective layers, said projections of said layers being directed toward each other and spacing the surfaces one from the other said projections being made of said fibrous material and terminating in irregularly shaped frayed ends, whereby the projections of an adjacent layer may interlace with the projections of an adjacent layer, to thereby provide a tortuous path for said medium between said layers and to thereby enhance the filtering action when said medium streams between said layers and along said surfaces of the latter.</p>

The reissue application in *Dien* had been filed under a provision of the rules that permitted a patentee to seek an “advisory opinion” from the Office by filing a reissue application in which it was alleged, pursuant to 37 C.F.R. § 1.175(a)(4), that the claims of the patent for which the reissue application was filed “might be” be wholly or partly inoperative or invalid.⁷⁷

Judge Rich wrote the decision in *Dien*, and held that the reissue application was *not* for the purpose of truly seeking a reissue application, but was instead simply filed in order to obtain an advisory opinion for the claims in the original patent. Given that the CCPA was an Article III court, it lacked jurisdiction to entertain an appeal from the BPAI on the matter, which Judge Rich deemed not involve a true reissue application.

The basis of the Court’s refusal to grant a reissue patent was that the rule did not require a reissue applicant to state a specific existing error that would qualify for relief under the provisions of 35 U.S.C. § 251 until the reissue applicant received a rejection based on the prior art or other information submitted with the reissue application. In the *Tanaka* prosecution, although required by the statute to do so, the reissue applicant also did not state a specific error that satisfies the provisions of 35 U.S.C. § 251

⁷⁷37 C.F.R. § 1.175(a)(4) provided: “(a) Applicants for reissue, in addition to complying with the requirements of the first sentence of § 1.65, must also file with their applications a statement under oath or declaration as follows: (4) When the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid, particularly specifying such prior art or other information and requesting that if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent.” The rule became effective on March 1, 1977 and was removed on July 1, 1982. The *Dien* reissue declaration included, for example, the reissue applicant’s statement that “THAT I have become aware of prior art relevant to patentability not previously considered by the U. S. Patent and Trademark Office which might cause the U. S. Patent and Trademark Office to deem the original Letters Patent No. 3, 342,823 wholly or partly inoperative or invalid, and which was not disclosed to the U. S. Patent and Trademark Office, and there was no deceptive intent in failing to make such a disclosure;

THAT said prior art was not known to me prior to the issue date of U. S. patent 3,342,823, and was brought to my attention recently as support for a contention by a licensee under Letter Patent No. 3,342,823 that the patent is invalid.”

E. *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211 (Fed. Cir. 1995)

Pall Corporation does not decide an issue that directly relates to reissue practice. It is a decision that was rendered in an infringement/invalidity litigation. The opinion includes the statement that “[A] patent is infringed if any claim is infringed, (citations omitted), for each claim is a separate statement of the patented invention.”

Although that concept may be important in the context of infringement/validity litigation, it does not relate to reissue practice in any significant way, and has no real applicability to the question of whether the language of 35 U.S.C. § 251 permits reissue based on merely adding a narrow dependent claim to a patent via reissue without conceding that the patented claims are otherwise too broad is proper “as a hedge against possible claim invalidity.”

F. *Phillips v AWH Corp et al.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc)

The *Phillips* decision is also not a reissue decision. Instead, it is a claim construction decision within an infringement/validity litigation. The *Tanaka* majority cited *Phillips* for the propositions that:

[...] each claim of a patent has a purpose that is separate and distinct from the remaining claims. Claims of narrower scope can be useful to clarify

the meaning of broader, independent claims under the doctrine of claim differentiation.

The *Tanaka* majority then opined, without citation to authority, that:

[...] dependent claims are also less vulnerable to validity attacks given their more narrow subject matter. Thus, 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.

Whatever the accuracy of the above-quoted language may be, it has no bearing on reissue practice. The sentiments expressed in *Phillips* do *not* address the language of 35 U.S.C. § 251, which requires an error that renders a patent wholly or partly inoperative or wholly or partly invalid.

G. *Schering Corp., et al. v. Glenmark Pharmaceuticals, Inc., USA, et al.* (CIVIL ACTION NO. 07-1334(JLL) (NOT FOR PUBLICATION))

Schering Corp is an interesting and highly relevant decision on the issue of reissue based only on adding one or more claims “as a hedge against possible claim invalidity.” In that infringement/validity litigation, the above styled decision was issued on defendant’s motion for partial summary judgment in the District Court for the District of New Jersey on April 19, 2010, after the Board issued its decision in *Ex parte Tanaka* affirming the Examiner’s rejection of newly added claim 16.

Schering Corp. (“Schering”) sued Glenmark Pharmaceuticals, Inc., USA (“Glenmark”) for infringement of reissue patent RE37,721 (“the ‘721 reissue patent”). Glenmark moved for partial summary judgment claims 10-13 of the ‘721 reissue patent were invalid. Glenmark alleged that the reissue was improper. Specifically, it was alleged that in order to correct the oversight of failing to include so-called “bullet claims” directed to ezetimibe in the original patent⁷⁸, a reissue application⁷⁹ had been filed by patent owner Schering in order to add new claims 10-13, each of which was narrower than the claims of the original patent. The reissue declaration filed in the ‘996 reissue application and executed by the assignee of the original patent stated that the original patent was wholly or partly inoperative or invalid by claiming more or less than the inventors had a right to claim, and that the specific error relied on was the failure to include claims of narrower scope in the original patent.⁸⁰ Glenmark moved for summary judgment under Rule 59(c) of the Federal Rules of Civil Procedure, alleging that claims 10-13 were invalid and that no genuine issue of material fact on that issue existed.

Judge Jose L. Linares cited 35 U.S.C. § 251 and *In re Serenkin*, 479 F.3d 1359, 1362 (Fed. Cir. 2007) (quoting *In re Weiler*, 790 F.2d at 1579) for the proposition that 35 U.S.C. § 251

“...’was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute de novo his original application.’ Thus, ‘not every event or circumstance that might be labeled “error” is

⁷⁸U.S. Patent No. 5,767,115 (“the ‘115 patent”). The file histories of both the original patent and the reissue patent are available at the USPTO website on both Private PAIR and Public PAIR. Go to <http://www.uspto.gov/> and then select the appropriate PAIR link at the middle of the page and search for Patent No.5,767,115 or Patent No. RE37,721.

⁷⁹Serial No. 09/594,996, filed on June 15, 2000, (hereinafter “the ‘996 reissue application”).

⁸⁰*Id.*, Declaration filed on June 15, 2000.

correctable by reissue.”

Judge Linares further found that although there was no error in conduct that led to the failure to add so-called “bullet claims” to the original patent, there was no basis for accepting Schering’s argument that the omitted bullet claims could properly be added to an original patent by reissuing that patent in order to act as “a hedge against the possibility of invalidation of a broad claim.” Judge Linares held that even without the addition of bullet claims pertaining to ezetimibe, the original patent claims would have covered the drug ezetimibe, as admitted by Glenmark.

Judge Linares then concluded that the “hedging” argument has only been referenced in *dicta*. Judge Linares reached that conclusion by considering *In re Handel, Hewlett-Packard Co. v. Bausch & Lomb Inc.*, and *Alcon Labs, Inc. v. Allergan, Inc.*⁸¹ Judge Linares also noted that hedging had been used only where a patentee was concerned about a prior public use (*Handel*) or specific prior art that raised a question of validity (*Nat’l Rolled Thread Die Co. v. E.W. Ferry Screw Prods., Inc.*).⁸² Accordingly, Judge Linares granted summary judgment on the Glenmark’s motion as to claims 10-13 of the ’721 reissue patent in which he held claims 10-13 to be invalid because plaintiff’s reissue patent was based on hedging against an unknown and unspecified potential future challenge which did not fall within the concept of hedging as defined by *dicta* in the Federal Circuit.

However, on May 10, 2010, Judge Linares issued an Order vacating his grant of summary judgment based on improper reissue of the ’721 reissue patent because the Board’s decision in *Ex Parte Tanaka* was being appealed to the Federal Circuit.

VI. Discussion of *Tanaka’s* Practical Effect

The language of 35 U.S.C § 251 requires the *present* existence of an error that would render an originally issued patent, (or a previously issued reissue patent), to be wholly or partly inoperative or invalid. Nothing in the legislative history suggests otherwise. In *Tanaka*, any device that would infringe Tanaka’s newly presented dependent claim 16, (which issued as reissue patent claim 8), would also *necessarily* infringe broader parent independent claim 1 of the original Tanaka patent.⁸³ Therefore, assuming that claims 1-7 were patentable, as found by the Examiner in the Tanaka reissue application, claim claims 1-7 were certainly not wholly or partly invalid. As claim 1 was a patentable comprising-type claim, claim 1 was *not* “inoperative” to protect the patentee from infringement of the device that is now expressly claimed in new reissue dependent claim 8, which includes all of claim 1 plus the additional limitation in claim 8. Further, merely reciting that the reissue applicant had claimed in the original Tanaka patent “more or less than [he] had a right to claim,” did not specify any

⁸¹1990 WL 27418 (N.D. Tex. Aug. 28, 1990). *Alcon Labs* is similar to *Hewlett-Packard* because as in *Hewlett-Packard*, the *Alcon Labs* decision is based on conduct errors. It should be noted that in citing *Alcon Labs*, Judge Linares did not note that the *Alcon Labs* decision failed to recognize that the *Hewlett-Packard* Federal Circuit decision only acknowledged the inclusion of narrow claims as a hedge against possible claim invalidity as having been “tacitly approved, at least in *dicta*, in our precedent,” and the precedent that is referred to as containing the *dicta* is the decision in *In re Handel*.

⁸²541 F.2d 593 (6th Cir. 1976) In this case, the patent owner National Rolled Thread had reissued the original patent to specifically distinguish over certain prior art, thereby using the reissue statute exactly as it was intended to be used.

⁸³MPEP § 2111.03, 8th Edition, Rev. 3 August 2005 provides: “The transitional term ‘comprising’, which is synonymous with ‘including,’ ‘containing,’ or ‘characterized by,’ is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.” The cited MPEP section supports this guidance with case law citations, the earliest of which being *In re Gray*, 53 F.2d 520 (CCPA 1931). The latest edition of the MPEP (8th Edition, Rev. 9, August 2012) maintains this guidance and includes additional case law citations.

existing error in the original Tanaka patent that rendered that patent either wholly or partly inoperative to protect the disclosed invention that is now the subject of claim 8 of the U.S. Patent No. RE42,990 E.⁸⁴

Even a statement of error specific to adding claim 8 “as a hedge against possible claim invalidity” would not have provided an error statement in compliance with the requirements of 35 U.S.C. § 251.

Although narrower claims can be, (and sometimes are), added to a patent without otherwise amending or canceling patent claims, it is required that at least one error that supports reissue of a patent is being corrected in a reissue application. However, it does not appear that the Tanaka reissue application, as ultimately “allowed” by the Federal Circuit, was such a reissue application.⁸⁵ None of the case law considered by the Federal Circuit majority in *Tanaka* provided a precedent for the proposition that the addition of a narrow claim to a patent by way of reissue, without either cancellation of or an amendment to an overly broad (and therefore invalid) claim in the original patent, satisfies the statutory requirement for reissue.⁸⁶ Even though each of the *Handel, Muller* and

Hewlett-Packard decisions discuss the propriety of supporting a reissue application by stating that the failure to include one or more dependent claims (or, for that matter, independent claims) that are narrower than the original claims of the patent as the sole basis for reissuing the original patent, none of those decisions actually held that the language of 35 U.S.C. § 251 permits reissue on that basis. In short, any discussion in those decisions regarding the addition of one or more narrower claims as a hedge against invalidity of the existing patent claims is dicta in those decisions.⁸⁷

In P.J. Federico’s Commentary on 1952 Patent Act, Mr. Federico pointed out that 35 U.S.C. § 251 in the 1952 patent statute had added the words “or less” to the language of the prior law, “by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new.”⁸⁸ The added language made express what had otherwise been the interpretation of the prior Patent Act of 1870, which did not facially provided for broadening reissue applications. However, no language in the 1952 Act was provided that would permit reissue of a patent to add claims in order to provide a hedge against

⁸⁴See *In re Wesseler*, cited and quoted in footnote 20, *supra*. It should be noted that *Wesseler* is a decision of the Court of Customs and Patent appeals, and therefore a precedential decision in the Federal Circuit.

⁸⁵For example, if a given claim lacked a proper antecedent basis for a claim limitation mentioned in the claim, that claim would technically be invalid and would render the patent at least “partly invalid.” See: *In re Altenpohl*, 500 F.2d 1151 (CCPA 1974) (correction of an indefinite dependent claim supports reissue). In a reissue application filed to correct such an error, it would be perfectly permissible to add additional dependent claims to the patent via reissue because the reissue statute, (both pre-AIA and post-AIA), requires the existence and correction of only one error that renders a patent wholly or partly inoperative or invalid. Adding additional claims would subject such claims to examination, but would not require a separate error statement that additional errors that were correctable by asserting additional claims in the reissue application. See also: 37 C.F.R. § 1.175(a)(1), which requires a statement of “at least one error being relied upon as the basis for reissue ...” and MPEP § 1414(II)(B), (8th Ed., rev. 8, July 2010 and 8th Ed., rev. 9, August 2012), which both provide that “Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied. 37 C.F.R. §1.175 was amended effective September 16, 2012, but new section (a) does not change the substance of former section (a)(1).”

⁸⁶In fact, there is in reality no error of “claiming more than or less than the original patentee had a right to claim.” The statutory language is directed to the error of claiming more than the original patentee had a right to claim i.e., claiming too broadly, and also to the error of claiming less than the original patentee had a right to claim, i.e., claiming too narrowly. See: *In re Handel*, note 2, cited in footnote 2, *supra*.

See also: *In re Wesseler*, cited in footnote 20, *supra* and *In re Weiler*

⁸⁷*King v. Erickson*, 89 F.3d 1575, 1581 (Fed. Cir. 1996)

⁸⁸The 1952 statute was the first completely rewritten patent statute since July 8, 1870, and expressly provided that both overly broad and overly narrow claiming could be corrected by reissue.

“possible claim invalidity.” In other words, existing errors in claiming too broadly or to narrowly qualify as errors that can be corrected by reissue, but hypothetical or potential errors in claiming, such as the addition of additional narrow claims as “a hedge against possible claim invalidity” were not provided for by the prior patent statute, the 1952 Act, the 1999 amendments thereto, or by the recent AIA amendments thereto.⁸⁹

VII. Conclusion

Where original comprising-type claims of a patent remain unchanged, existing errors in those claims are not asserted as rendering the patent wholly or partly inoperative (too narrow to protect the disclosed invention) or invalid (for any reason), the failure to include one or more claims depending from the original comprising-type patent claims is asserted, but no other error that would support reissue under the language of 35 U.S.C. § 251 is alleged, there is simply no statutory basis for reissue of the original patent.⁹⁰ 35 U.S.C. § 251 is directed to reissue of an issued U.S. Patent based on *existing* errors that render the patent wholly or partly inoperative or invalid. There is no language in 35 U.S.C. § 251, (either pre-AIA or post-AIA) that can be interpreted as permitting reissue of a patent by adding one or more dependent claims (or inde-

pendent claims for the invention claimed in the patent) to cure the “potential” or “inchoate” error that one or more original comprising-type patent claims might later adjudicated to be invalid. Therefore, the decision by the Federal Circuit majority in *Tanaka* was incorrect as a matter of law. This view is reinforced by the complete absence of the citation of any precedential decision on the issue decided in *Tanaka*, which also is not precedential on the issue decided therein.

The USPTO should seek to correct the law on this issue by bringing the issue before the Federal Circuit in a reissue application in which a reissue applicant alleges an error that is similar or identical to the error alleged in the *Tanaka* appeal.⁹¹ The failure to do so could well inundate the USPTO with a large number of reissue applications that seek merely to add dependent claims as “a hedge against possible claim invalidity” in disregard of the clear language of 35 U.S.C. § 251 and the lack of any precedent supporting reissue based on adding claims as a hedge against possible claim invalidity. Aside from the Federal Circuit’s decision in *Tanaka* being incorrect as a matter of law, it is entirely possible that the USPTO will see a large increase in the number of reissue applications that are filed based on a *Tanaka*-type error statement, thereby creating an additional and unnecessary burden on the examining resources of the USPTO.

⁸⁹It should again be remembered there was no decision cited by Judge Rich in *In re Handel*, or cited by the majority in *Tanaka*, or discovered by the author, which provides for reissuing a patent based on correcting a potential or inchoate error in claim scope.

⁹⁰See: Footnote 83. See also: MPEP § 1402 (8th Edition, Revision 9), which provides examples of errors not directly involving the claims that are curable by reissue are the failure to claim failure foreign priority, failure to or improperly claiming benefit of a prior copending U.S. patent application and misjoinder of an inventor (although the latter is curable via certificate of correction). This section was revised to add correction of “error” per *In re Tanaka*.

⁹¹See: *Ex parte McGrew*, 1995 WL 914279 (BPAI) and *In re McGrew*, 120 F.3d 1236 (Fed. Cir. 1997). In *Ex part McGrew*, the Board declined to follow law as announced in *In re Sasse*, 629 F.2d 675 (CCPA 1980) on an issue of the meaning of 35 U.S.C. § 135(b). On appeal, it was held in *In re McGrew*, 120 F.3d 1236 (Fed. Cir. 1997), that the Board had decided the issue correctly.