

Keywords: 35 U.S.C. § 251; reissue patents; correctible errors; hedge against invalidity

General: The B.P.A.I. finds that the presentation of narrower dependent claims in a reissue application that contains the original claims as a hedge against possible invalidity is not an error correctible by 35 U.S.C. § 251.

Ex parte Tanaka

93 U.S.P.Q.2d 1291 (B.P.A.I. 2009) (precedential)

Decided December 9, 2009

I. Facts

The Appellant's claimed invention is directed to an alternator pulley for which a letters patent was granted (6,093,991) containing claims 1-7 directed to the pulley. The Appellant then filed a reissue application, which surrendered his rights to the granted patent in order to obtain a new set of broader claims (8-17). During the course of prosecution and after a final rejection of the broadened independent claim 8, the Appellant cancelled new claims 8-15 and 17 and retained claims 1-7 (original) and 16 (new). Accordingly, the Examiner issued a final rejection of claims 1-7 and 16, asserting that the error specified in the reissue oath was not an error correctible by a reissue according to 35 U.S.C. § 251. The Appellant appealed the Examiner's rejections to the Board of Patent Appeals and Interferences and contended that 35 U.S.C. § 251 allows the addition of narrower claims simply as a hedge against possible invalidity.

II. Issue

Did the Appellant show 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?

III. Discussion

No. 35 U.S.C. § 251 states, in pertinent part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly invalid, by reason of a defective specification 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.

Therefore, the reissue statute requires that for a patent to be eligible for reissue, a patent must (1) be wholly or partly inoperative or invalid, (2) by reason of an existing error, (3) without any deceptive intention. 37 C.F.R. § 1.175(a)(1) requires that an applicant for reissue must state:

- (1) that the applicant believes the original patent to be wholly or partly inoperative or invalid, and
- (2) at least one such error that is being corrected at the time of filing the reissue oath or declaration.

In filing a Supplemental Reissue Declaration (after a number of rejected oaths), the Appellant specifically stated that the invention was not fully covered by the original claims, as the features recited in claim 16 were not claimed in the original patent. The Appellant also stated that the claims of the original patent were “more specific than necessary” and that “in error, the claims of the original patent cover less subject matter than we were entitled to claim.” Substitute Reissue Declaration 3-4. Of course, the Board found such statements to be contradictory to the nature of the appealed reissue claims, which do not attempt in any way to broaden the claims of the original patent.

The Board considered the Appellant’s citation of *In re Handel*, 312 F.2d 943, 136 U.S.P.Q. 460 (C.C.P.A. 1963), in which the patentee’s oath was clear that the appellant’s purpose in filing the reissue application was to narrow the claims to avoid the possibility of the patent being held invalid in view of an alleged prior public use. However, the sole issue before the court in *Handel* was not whether it was admissible to add claims as a hedge against possible invalidity, but whether the appealed claims were for the invention disclosed in the original patent as set forth by 35 U.S.C. § 251. The court did, however, comment on the examiner’s initial rationale, which seemed to reject the reissue oath because the appellant asserted that his patent was partially inoperative by reason of his claiming less than he had a right to claim and “[s]ince the patent claims have been retained, neither more nor less is being claimed.” *Id.* at 945, n.2. Specifically, the court added in a footnote “[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.” *Id.*

However, the Board noted that the C.C.P.A.’s tacit approval in a footnote of using a new dependent claim in reissue as a hedge against possible invalidity of the original claims was a voluntary opinion that falls outside of the holding in *Handel*. The Board continued that the footnote was made without argument or full consideration of the point after briefing by the parties, and was thus dictum. In sum, the Board asserted that *Handel* did not provide a clear answer regarding the issue at hand.

The Board also noted the Federal Circuit’s comments in *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556, 1565, 11 U.S.P.Q.2d 1750 (Fed. Cir. 1989), in which the patentee (B & L) filed a reissue containing original patent claims and three new, narrower claims as a hedge against patent claims being held as overly broad. The court suggested that the patentee, rather than asserting that the claims in the original patent were inoperative by claiming too much or too little in terms of scope, was essentially indicating that he included too few claims. The court 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.” *Id.* at 1565 (citing *Handel*). However, the court did not reach this issue in *Hewlett-Packard* and explicitly stated it would not because the court held that the patentee did not establish the second prong of the statute, namely, inadvertent error in conduct.

Curiously, while the court in *Hewlett-Packard* stated it would not reach this issue, it simultaneously noted that the patentee’s statement regarding the need for additional claims as a hedge was not within the literal language of the statute. Specifically, the court noted that if the type of error alleged by B& L were in fact an error correctible by reissue, that virtually every patent could be reissued out of hand. The court stated “B & L asserts the theory that, whenever it is apparent that narrower claims could have been obtained, error warranting reissue exists.” The court further stated “[w]ere 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.” *Id.*

The Board also cited the Patent Office’s policy regarding reissue applications, which is described in § 1402 of the M.P.E.P. Section 1402 generally states that according to 35 U.S.C. § 251, a reissue application cannot be allowed in which the only error specified is the failure to include one or more

claims that are narrower in scope than at least one of the existing claims without (1) an allegation that one or more of the broader patent claims are too broad together with (2) an amendment to such claims. The Board then asserts that this has been the practice for the 5,000+ U.S.P.T.O. examiners since July 2008.

The Board concluded that the defect in the current case is not the result of the patentee claiming more or less than he had a right to claim in a patent, citing both *Handel* and *Hewlett-Packard*. The Board asserted that it could not reconcile the contradiction between the literal language of 35 U.S.C. § 251 and the dicta in *Handel*, and states that a reissue consistent with the dicta in *Handel* would cover neither more nor less than the original claims. The Board then concluded that the facts presented did not meet the requirement for a reissue under the plain wording of § 251. The Board therefore affirmed the Examiner's rejection, and stated that the Appellant did not show that the Examiner erred in determining that the error alleged by the Appellant was an error correctible by reissue under 35 U.S.C. § 251.