

## REPORT

**FEDERAL CIRCUIT APPROVES REISSUE APPLICATIONS THAT ONLY ADD DEPENDENT CLAIMS TO AN ISSUED PATENT**

April 29, 2011

**I. Introduction**

The U.S. Court of Appeals for the Federal Circuit has now confirmed that 35 U.S.C. §251 permits reissue of an issued patent for the sole purpose of adding one or more new dependent claims.

In *In re Tanaka*, the Federal Circuit reversed a U.S. PTO Board of Patent Appeals and Interferences ("Board") decision holding that a reissue application that only adds dependent claims failed to meet the reissue requirements of 35 U.S.C. §251.<sup>1</sup> The court confirmed that "longstanding precedent" permits adding dependent claims in a reissue application as a hedge against the possible invalidity of original claims.

**II. 35 U.S.C. §251**

Under 35 U.S.C. §251, a patentee is only permitted to file a reissue application for the purpose of correcting the claims when the patent:

...is, through error without any deceptive intention, 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.

35 U.S.C. §251 (emphasis added).<sup>2</sup>

<sup>1</sup> *In re Tanaka*, 98 USPQ2d 1331 (Fed Cir. 2011).

<sup>2</sup> There are separate provisions in 35 U.S.C. §251 for correcting defective specifications or drawings.

**III. The Prior Board Decision**

In its December 9, 2009 precedential decision, the Board held that a reissue application that retains all of the original patent claims and only adds dependent claims does not present the type of error correctable by reissue under 35 U.S.C. §251. The Board disregarded prior decisions by both the Court of Customs and Patent Appeals ("CCPA") and the Federal Circuit as either addressing the issue in non-binding dicta or as having been decided on other grounds. Thus, the Board determined that there was no controlling authority to guide its decision.

Interpreting the language of 35 U.S.C. §251 itself, the Board reasoned that a patentee who merely seeks to add dependent claims cannot meet the requirement of the original patent being "wholly or partly inoperative or invalid...by reason of the patentee claiming more or less than he had a right to claim" because a dependent claim neither adds to nor detracts from the overall scope of the original patent when the broadest original claim remains in the reissue application. Thus, the Board held that a reissue application that retains all of the original patent claims and only adds dependent claims is not permitted under 35 U.S.C. §251.

**IV. The Federal Circuit Decision**

The Federal Circuit reversed the Board's decision. A majority of the panel disagreed with (1) the Board's conclusion that there was no controlling authority on the issue of whether a reissue application can maintain the original patent claims and only add one or more new dependent claims, and (2) the Board's narrow interpretation of 35 U.S.C. §251.

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Regarding the existence of controlling authority, the majority relied on dicta in a 1963 CCPA decision in *In re Handel*.<sup>3</sup> The dicta in *Handel* described adding narrower dependent claims as "simply a hedge against the possible invalidity of the original claims...which is a proper reason for asking that a reissue be granted."<sup>4</sup> The majority characterized the dicta in *Handel* as "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" that was followed in two subsequent decisions.<sup>5</sup> Thus, the majority concluded that the language in *Handel* was a rule that should be followed.

Regarding the Board's interpretation of 35 U.S.C. §251, the majority disagreed with the Board's narrow view of what constitutes "wholly or partly inoperative or invalid." The majority reasoned that "the omission of a narrow claim from a patent can render the patent partially inoperative by failing to protect the disclosed invention to the full extent allowed by the law."

## V. Judge Dyk's Dissent

In a strong dissenting opinion, Judge Dyk agreed with the ruling of the Board. Judge Dyk disagreed with the majority's determination that the dicta in *Handel* and its subsequent treatment in *Muller* and *Hewlett-Packard* are binding. Judge Dyk instead analogized to a 19<sup>th</sup> century U.S. Supreme Court case he believed held to the contrary.<sup>6</sup> Judge Dyk also disagreed with the majority's interpretation that the mere addition of a dependent claim corrects an error. According to Judge Dyk, by maintaining the original claims without alteration or amendment, the patentee "has admitted that there was no error in the original patent."

## VI. Recommendations

Following the *In re Tanaka* decision, reissue applications can now be filed or amended so as to maintain the original patent claims and only add new dependent claims. However, there are a few things that should be kept in mind:

<sup>3</sup> *In re Handel*, 312 F.2d 943, 946 n.2 (CCPA 1963).

<sup>4</sup> *Citing In re Handel*, 312 F.2d at 946 n.2.

<sup>5</sup> *In re Muller*, 417 F.2d 1387 (CCPA 1969), and *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556 (Fed. Cir. 1989).

<sup>6</sup> *Gage v. Herring*, 107 U.S. 640 (1883).

(1) *In re Tanaka* makes it easier to have the U.S. PTO consider prior art that was either (1) discovered after the grant of the original patent, or (2) known before the grant of the original patent but unintentionally not submitted to the U.S. PTO before grant of the original patent. This is because the patentee can file a reissue application that only adds one or more dependent claims (assuming they were erroneously omitted from the patent) along with an Information Disclosure Statement including the prior art. In situations in which the claims cannot be broadened, such a reissue application will allow the patentee to attempt to maintain the scope of the patent's claims (1) without having to narrow the original claims or admit that there was an error in the original claims, and (2) without the disadvantages associated with other post-grant proceedings, such as reexamination.

(2) Because of the split panel decision, there remains a possibility that *In re Tanaka* will be reconsidered by the Federal Circuit *en banc*. Thus, unless a pending reissue application is about to issue, you may wish to wait to see whether there will be an *en banc* hearing before filing or amending a reissue application so as to only add one or more dependent claims. We should know by the end of May 2011 if the U.S. PTO has requested that *In re Tanaka* be reconsidered *en banc*.

(3) A reissue application that only adds one or more dependent claims should not be considered to be a broadening reissue application that must be filed within two years after the grant of the original patent under the provisions of the last paragraph of 35 U.S.C. §251. Under the judicial doctrine of claim differentiation, however, a dependent claim can affect construction of the scope of a claim from which it depends. Therefore, a patentee or an accused party might argue that the scope of an unchanged claim in a reissued patent was broadened by the addition of a dependent claim in the reissue application. However, the Federal Circuit has commented that dependent claims added to a patent in a post-grant proceeding in which claims cannot be broadened (e.g., a reexamination) are not a reliable guide to the meaning of original claims.<sup>7</sup>

Thus, if the goal of filing a reissue application that merely adds dependent claim(s) is not to broaden any of the original claims, it should be permissible to file the reissue

<sup>7</sup> See *Total Containment, Inc. v. Environ Products, Inc.*, Appeal Nos. 96-1138, 96-1151, slip op. (Fed. Cir. Jan 17, 1997) (non-precedential).

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application before or after two years after the grant of the original patent. Of course, out of an abundance of caution, and especially when it is unclear whether the added claims might nonetheless be argued to have a broadening effect on an original claim, the safest course of action would be to file the reissue application within two years of the original patent grant. Moreover, if the goal of filing a reissue application is to broaden one or more of the original claims, we recommend directly amending the original claims in a broadening manner (within two years of the original patent grant) rather than merely adding dependent claims and attempting to rely on the doctrine of claim differentiation.

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