

CAN NARROWING REISSUE APPLICATIONS STILL BE USED TO PROVOKE INTERFERENCES?¹

By

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Introduction

On November 15, 2007, John J. Love, Deputy Commissioner for Patent Examination Policy, issued a directive to the Directors of the Technology Centers entitled “Clarification of Treatment of Reissue Applications That Only Add One or More Narrower Claims.” In it he decreed that:

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[s] should not be allowed. [Emphasis in the original.]

However, 37 CFR 41.202(a) states that:

An applicant, including a reissue applicant [emphasis supplied], may suggest an interference with another application or a patent. The suggestion must:

* * *

(2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,

* * *

(5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant’s specification....

Frequently, a patentee desirous of provoking a 35 USC 135(a) interference with another patent (and what patentee in its right mind would want to provoke a 35 USC 291 interference with another patent?) files an application to reissue its patent, thereby restoring jurisdiction to the PTO to declare the interference. Moreover, the patentee desirous of provoking the 35 USC 135(a) interference often wants to file a narrowing reissue, either in order to comply with the “two-way” test of 37 CFR 41.203(a) or because of 35 USC 252’s ban on broadening reissues filed more than two years after issuance of the patent sought to be reissued. That is, it wants to add “one or more claims that is/are narrower than at least one of the existing patent claim(s),” but it does not want to (and, apart from Mr. Love’s directive, would not have to) give up any of its “existing patent claim(s).” In the past, that has not presented a problem. However, if Mr. Love’s ukase withstands judicial scrutiny, it’s going to present a problem in the future.

Mr. Love’s Analysis

Mr. Love starts off by writing that:

It has come to...[his] attention that certain reissue applications are being examined in the Corps in an inconsistent manner. The inconsistent examination occurs in those reissue applications in which the only “error” set forth in the reissue oath/declaration is that one or more additional claims that is/are narrower than at least one of the patent claims is/are being added for some reason other than that one or more patent claims is too broad. [For instance, a harmless/worthless narrower claim is being added to restore jurisdiction to the PTO so that an interference can be suggested.]

He then asserts that:

Absent a statement that the patent for which reissue is sought is wholly or partly inoperative or invalid in that one or more patent claims is/are too broad, or a statement specifying and correcting some other (proper) error that renders the patent wholly or partly inoperative or invalid, such reissue applications do not recite an error within the meaning of 35 U.S.C. §251. Retaining the original broader patent claim(s) in the reissue application[,] without amendment or cancellation of such claim(s), is an indication that the broader claim(s) is/are not in any way inoperative to cover the disclosed invention, or invalid as being too broad. [The emphasis of “not” is in the original; the other emphasis is supplied.]

* * *

The authority for reissue of defective patents is 35 U.S.C. §251. The statute provides that the patent is defective for “claiming less than patentee had a right to claim” does not mean that there are too few claims, but rather that the patent claims are not broad enough to protect the invention (and the patent is thereby inoperative to protect the disclosed invention). Therefore, where no broadening claims are presented, such an allegation does not correctly set forth a reissuable error under 35 U.S.C. §251. [Emphasis in the original.]

Comments on Mr. Love’s Analysis

The problem with Mr. Love’s analysis is that, ever since Hector was a pup, the term “inoperative” in 35 USC 251 has been construed to mean “inoperative adequately to protect the invention,” **not** to mean “invalid.” See McCrady, Patent Office Practice (4th ed. 1959) at page 309, quoted approvingly in In re Handel. 312 F.2d 943, 945-46 n. 2, 136 USPQ 460, 462 n. 2 (CCPA 1963)(Rich, J.). In Handel, the court cited McCrady for the proposition that:

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.

Moreover, the BPAI has long thought itself bound by Handel.

For instance, in In re Larkin, 9 USPQ2d 1078, 1079-80 (PTOBPAI 1988), it reversed a rejection of the appealed reissue claims under 35 USC 251 “as lacking statutory basis for reissue” on the ground that:

The filing of the reissue application before us would appear to be a legitimate attempt by appellant to limit the claims simply as a hedge against possible invalidity of the original claims. *In re Handel*, 312 F.2d 943, 136 USPQ 460 (CCPA 1963).

Similarly, in Ex parte Parks, 30 USPQ2d 1234, 1237 (PTOBPAI 1993), it said of a rejection of narrowed claims “for Lack of the Requisite Error”:

This rejection is *reversed* essentially for the reasons advocated by appellants on appeal. We emphasize that the practice of submitting claims as a hedge against the possible invalidity of original claims has been judicially sanctioned. See, for example, *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556, 11 USPQ2d 1750 (Fed. Cir. 1989); *In re Altenpohl*, 500 F.2d 1151, 183 USPQ 38 (CCPA 1974); *In re Handel*, 312 F.2d 943, 136 USPQ 460 (CCPA 1963).

How Mr. Love’s Directive Would Affect Interference Practice

Of course, when a member of the interference bar presents narrowed claims via reissue for the purpose of provoking a patent-reissue applicant interference, he or she is not (at least primarily) presenting those claims “as a hedge against the possible invalidity of [the] original claims.”³ Instead, the primary reason for filing such a reissue is normally the desire of the assignee of the reissue application (1) to “take down” one or more of the target patent’s claims in an interference rather than waiting to defend against a claim of patent infringement while (2) attempting to keep its own, pre-existing claims out of harm’s way.⁴ However, it seems to me that the basic points here are (1) that there

is nothing inherently wrong with presenting narrower claims in a reissue without canceling broader claims and (2) that a desire to present narrower claims (for any legitimate reason) “is a proper reason for asking that a reissue be granted.”⁵

The reason for my use of the word “legitimate” in the last sentence of the previous paragraph is that Hewlett-Packard Co. v. Baush & Lomb Inc., cited in Ex Parte Parks, says 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 [error in the patent and error in conduct] collapses into one because the omission of additional narrower 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 [sic; unequivocally] and repeatedly rejected.” [882 F.2d at 1165, 11 USPQ2d at 1758.]

However, Hewlett-Packard dealt with the second prong of “the dual error inquiry” (namely, error in conduct), not the first prong (namely, error in the patent). The second prong of the “dual error inquiry” is normally not at issue when narrowing reissue applications are used in attempt to provoke interferences.

If a desire to present narrower claims in a reissue application in order to provoke an interference is not “a proper reason for asking that a reissue be granted,” the interference bar will be reduced to looking for errors in the specification or drawings sufficient to support a reissue application.⁶ As to that use of reissue applications, see Kayton et al., Patent Practice (6th ed. 1998) Chapter 22 “Correction of Patent” § IV.C.I., “Defects Correctable by Reissue,” which states that:

mistakes and errors [in a specification] of the type that can be corrected through the process of reissue are at best only

those that are of substantially the same type and magnitude that an applicant may correct during the course of normal prosecution. Thus, a reissue application may accomplish a wide variety of corrective modifications ranging from correction of extremely minor typographical or grammatical errors to the making of major substantive changes in the scope of protection afforded by the claims.

However, the next section, “Defects Correctable Without Reissue,” goes on to warn that:

While an application for reissue may incidentally serve the function of a certificate of correction by correcting minor errors in the patent..., a reissue application is not properly filed *solely* for the purpose of curing defects that might otherwise be disposed of without complete reexamination by the PTO.

* * *

The examiner may reject a reissue application that was filed for the sole purpose of correcting a minor error that did not materially affect the patent’s validity and that could be adequately corrected by other means. However, the inconvenience and expense of reissue practice is generally sufficient to dissuade patentees from pursuing this mode of correction where other remedies exist. Accordingly, the PTO does not normally challenge the applicant’s statement in the reissue oath that *the applicant* believes that the original patent is wholly or partly inoperative or invalid. Moreover, while it was formerly believe that the PTO might challenge the applicant’s statement in the reissue oath that the *applicant* believes that the original patent is wholly or partly inoperative or invalid in a situation where the examiner believes that the applicant has seized upon a minor error as a pretext for obtaining reexamination of unchanged claims or in order to “circumvent” 35 USC §291 by obtaining an interference in the PTO between a reissue application and an interfering patent, *In re Altenpohl*, 500 F.2d 1151, 183 USPW 38 (CCPA 1974) and *In re Bose*, 687 F.2d 432, 435 n. 12, 215 USPQ 1, 3-4 n. 12 (CCPA 1982), suggest that such a challenge would likely not be sustained.

In any event, while this technique is used from time to time, it is a transparent legal fiction of the kind which elicits cynical laughter from knowledgeable observers.

Finally, note that care must be exercised in describing the “error” justifying reissue of the patent. Specifically, one must assert that the error was the applicant’s error (in, e.g., failing to note the target patent or published application during the pendency of the application that matured into the patent sought to be reissued), not the PTO’s error. The PTO does not like to be told that it erred by failing to notice the existence of two interfering cases.⁷

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³ Parks, 30 USPQ2d at 1237.

⁴ The latter desire often leads to the filing of two reissue applications under 37 CFR 1.177, one containing at least primarily the pre-existing claims and one containing the targeting “sacrificial” claims. That places the burden on the target patentee to attempt to drag the pre-existing claims onto the killing filed (that is, to have the reissue application containing the pre-existing claims added to the interference under SO 203.2).

⁵ Handel, 312 F.2d at 946 n. 2, 136 USPQ at 462 n. 2.

⁶ See 4 A Chisum §15.03[1][b].

⁷ Gregory v. Ledoux, 1915 C.D. 11, 12 (Comm’r 1915) (“[The petitioner] further alleges that there claims were not suggested to him from the interfering application by the Patent Office; but this was not an inadvertence, accident, or mistake on his part [as required by

the then statute.”); In re Guastavino, 83 F.2d 913, 916, 29 USPQ 532, 535 (CCPA 1936) (“It is accordingly held that no right to a reissue of appellant’s patent may be predicated upon the [Patent Office’s] failure to declare an interference.”); and Slip Track Systems, Inc. v. Metal Lite, Inc., 159 F.3d 1337, 1341, 48 USPQ2d 1055, 1058 (Fed. Cir. 1995) (“a reissue application may not be filed solely on the ground that the PTO erred in issuing two patents for the same invention.”).