

# Narrowing Reissue Applications Can Again Be Used To Provoke Interferences!<sup>1</sup>

By

Charles L. Gholz<sup>2</sup>

## **Introduction**

In 2008, I wrote Can Narrowing Reissue Applications Still Be Used to Provoke Interferences?, 15 Intellectual Property Today No. 4 at page 28 (2008), in response to a directive from John J. Love, the then Deputy Commissioner for Patent Examination Policy, decreeing 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 claims 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.]

In that article, I pointed out that that directive was not only contrary to Judge Rich's opinion in In re Handel, 312 F.2d 943, 945-46 n. 2, 136 USPQ 460, 462 n.2 (CCPA 1963), but contrary to at least two published board precedents—namely, In re Larkin, 9 USPQ2d 1078, 1079-80 (PTOBPAI 1988), and Ex parte Parks, 30 USPQ2d 1234, 1237 (PTOBPAI 1993).

Late in 2009, an expanded panel of the board followed Mr. Love's directive in a precedential opinion. Ex parte Tanaka, 93 USPQ2d 1291 (PTOBPAI 2009)(precedential)(per curiam)(expanded panel consisting of CAPJ Fleming, VCAPJs Moore and MacDonald, and APJs Hairston, Pate, Lane, and Horner<sup>3</sup>).

I am now happy to write that the Federal Circuit has reversed the board's decision--albeit by a 2 to 1 vote and not in an interference context.

## **What the Majority Said in In re Tanaka**

In In re Tanaka, \_\_\_ F.3d \_\_\_, 98 USPQ2d 1331 (Fed. Cir. 2011)(opinion by Circuit

Judge Linn, joined by Circuit Judge Bryson, over a dissent by Circuit Judge Dyk), the majority said that:

the Board's determination is contrary to longstanding precedent of this court and flies counter to principles of stare decisis.<sup>4</sup>

\* \* \*

This court also rejects the PTO's assertion that the omission of a narrower claim from an original patent does not constitute an error under § 251 because the omission of a dependent claim does not render the patent inoperative. \*\*\* [T]he 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.<sup>5</sup>

\* \* \*

Finally, this court rejects the Board's conclusion that adding a single dependent claim to the originally issued claims is equivalent to the disallowed practice of filing a "no defect" reissue. \* \* \* This court in *In re Dien* addressed the PTO's former practice of allowing patentees to file a reissue application for the purpose of having the claims reexamined in light of newly discovered prior art without alleging a defect nor seeking any change in the patent. 680 F.2d at 151, 152 (CCPA 1982). The court criticized this practice as permitting a patentee to obtain an advisory opinion from the PTO. *Id.* at 154. Here, however, there is no dispute that Tanaka has admitted error in the original prosecution, pointing out that he neglected to seek a narrower dependent claim to which he was entitled. In addition, unlike the practice of "no defect" reissue, Tanaka's reissue application requested changes to his patent in the form of a new dependent claim. Applying for a reissue that adds only narrower claims without amending any of the original claims is not the same as a "no defect" reissue.<sup>6</sup>

\* \* \*

This court recognizes that 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." *Serenkin*, 479 F.3d at 1362 (quoting *In re Weiler*, 790 F.2d 1576, 1582 (Fed. Cir. 1986)). However, the narrow rule relating to the addition of dependent claims as a hedge against possible invalidity has been embraced as a reasonable interpretation of the reissue statute by this court and its predecessor

for nearly fifty years without any obvious adverse consequences. To deviate from that long-standing interpretation would be contrary to the doctrine of stare decisis and is unwarranted.<sup>7</sup>

### **What the Dissent Said in In re Tanaka**

In dissent, Circuit Judge Dyk first pointed out that what Judge Rich had written for the unanimous CCPA in In re Handel was dictum and therefore not binding on the Federal Circuit.<sup>8</sup> However, he then went on to assert that “Both the language and the purpose of the statute clearly support the PTO’s position.”<sup>9</sup>

On the former point, Judge Dyk asserted that, because “The reissue statute explicitly restricts reissues to circumstances in which the ‘patent is, through error..., deemed wholly or partly inoperative or invalid’,”<sup>10</sup> it followed that “the statute is intended [only] to ‘provid[e] the patentee with an opportunity to correct errors’ within the patent.”<sup>11</sup> Judge Dyk apparently thought that the error that the patentee was seeking to correct was somehow external to the patent.

While I don’t think that Judge Dyk clearly returned to the latter point, he did say that “There is no assertion that correction of anything in the original patent was required”<sup>12</sup> and that, “By retaining the original claims without alteration or amendment, the applicants have admitted that there was no error in the original patent.”<sup>13</sup> Of course, his apparent position that reissues are only available to correct errors in the original patent clearly flies in the face of the opinions holding that reissues are available to correct errors in failing to perfect claims to domestic or foreign priority.<sup>14</sup> However, he dealt with that inconvenience as follows:

While our decisions, and those of our predecessor court<sup>[15]</sup>, have held that a reissue may sometimes be proper where the original claims have not been revised, those decisions make clear that some correction of an error affecting the original claims is required. In other words, the correction of that error must have a direct and identifiable effect on the applicant’s right under the

original patent.. \* \* \*

Here, the addition of the dependent claims has no impact on the applicants' rights under the original patent. The original claims were not changed, and the addition of new claims has no effect on the applicants' rights under the original claims. The applicants effectively attempt to retain their rights under [the] original patent while securing a second patent which covers the subject matter of the dependent claims [sic; additional dependent claim].<sup>16</sup>

### Comments

(1) Of course, when a patentee presents one or more narrowed claims via reissue for the purpose of provoking a 35 USC 135(a) interference in the PTO rather than a 35 USC 291 interference in a district court, it is not (at least primarily) presenting that claim or those claims “as a hedge against possible invalidity.” Instead, the primary reason for filing such a reissue is normally the desire to restore jurisdiction over the interference to the PTO (and, specifically, to the tech-savvy and interference-law-experienced APJs, whose expertise in such matters makes the BPAI the preferred venue for settling such disputes). However, I think that the dispositive point is the same: The term “inoperable” in 35 USC 2451 is not synonymous with or limited to “invalid.” Hence, if In re Tanaka is not an express holding that a narrowing reissue application can be used to provoke an interference, I think that its logic dictates that result.

(2) It seems to me that failing to provoke a 35 USC 135(a) interference has “a direct and identifiable effect on the applicant’s right under the original patent” to every bit as much of an extent as failing to perfect a claim to foreign or domestic priority.

(3) There is, however, one important caveat. The majority in Tanaka distinguished In re Dien on the ground that “Here, however, there is no dispute that Tanaka has admitted error in the original prosecution, pointing out that he neglected to seek a narrower dependent claim to which he was entitled.”<sup>17</sup> As I wrote in my 2008 article cited at the outset:

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.<sup>8</sup>

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<sup>8</sup> Gregory v. Ledoux, 1915 C.D. 11, 13 (Comm’r 1915)(“[The petitioner] further alleges that these 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.”).<sup>18</sup>

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<sup>2</sup> Partner in Oblon, Spivak, McClelland, Maier & Neustadt, LLP. My direct dial telephone number is 703/412-6485, and my email address is cgholz@oblon.com.

<sup>3</sup> I think it worth noting that, although it was an ex parte appeal, the expanded panel included VCAPJ Moore and APJs Pate and Lane, all of whom specialize or specialized in handling interferences. It is also worth noting that the opinion was per curiam—meaning that none of the APJs wanted to have his or her name individually associated with it!

<sup>4</sup> \_\_\_ F.3d at \_\_\_, 98 USPQ2d at 1332.

<sup>5</sup> \_\_\_ F.3d at \_\_\_, 98 USPQ2d at 1334.

<sup>6</sup> \_\_\_ F.3d at \_\_\_, 98 USPQ2d at 1334; footnote omitted.

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<sup>7</sup> \_\_\_ F.3d at \_\_\_, 98 USPQ2d at 1335; emphasis added.

<sup>8</sup> That, of course, was perfectly true—but it didn't deal either with the fact that what Judge Rich had written made sense or with the fact that what Judge Rich had written had been followed by the board before Mr. Love sought to change the PTO's policy in that regard.

<sup>9</sup> \_\_\_ F.3d at \_\_\_, 98 USPQ2d at 1336.

<sup>10</sup> \_\_\_ F.3d at \_\_\_, 98 USPQ2d at 1336.

<sup>11</sup> \_\_\_ F.3d at \_\_\_, 98 USPQ2d at 1336; emphasis supplied.

<sup>12</sup> \_\_\_ F.3d at \_\_\_, 98 USPQ2d at 1336.

<sup>13</sup> \_\_\_ F.3d at \_\_\_, 98 USPQ2d at 1337; emphasis supplied.

<sup>14</sup> Brenner v. Israel, 400 F.2d 789, 790-91, 158 USPQ 584, 585 (D.C.Cir. 1968)(per curiam)(re foreign priority) and Fontijn v. Okamoto, 518 F.2d 610, 621-23, 186 USPQ 97, 106-08 (CCPA 1975)( re domestic priority).

<sup>15</sup> This peculiar statement suggests that Judge Dyk believes that the United States Circuit Court of Appeals for the District of Columbia Circuit is a predecessor of the United States Circuit Court of Appeals for the Federal Circuit!

<sup>16</sup> \_\_\_ F.3d at \_\_\_, 98 USPQ2d at 1337.

<sup>17</sup> \_\_\_ F.3d at \_\_\_, 98 USPQ2d at 1334.

<sup>18</sup> 15 Intellectual Property Today No. 4 at page 29.