

Reissue Denied For Adding Single Dependent Claim

By Wei Wei Jeang ¹

Reissue is a post-issuance procedure to correct certain limited types of errors in a patent. The Board of Patent Appeals and Interferences (BPAI) decided in a precedential opinion that a reissue cannot be used to add a dependent claim “simply as a hedge against possible invalidity of the original claims.” *Ex parte Yasuhiro Tanaka*, Appeal No. 2009-000234 (BPAI, Dec. 9, 2009) (*per curiam*).

Under 35 U.S.C. § 251, reissue is proper when a patent is “deemed wholly or partly inoperative or invalid” for two reasons: 1) “defective specification or drawing,” or 2) “the patentee claiming more or less than he had a right to claim in the patent.” A further requirement is that the inoperative or invalid patent arose through “error without any deceptive intent.”

The patentee in this case, Tanaka, filed a reissue application that included a new dependent claim as the only amendment to the original patent. The subject matter in the new claim was not included in any of the original issued claims. None of the original issued claims were amended. In the Substitute Reissue Declaration, the inventor stated that “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.” The inventor also asserted that it 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.” The Examiner rejected the claims because the error was not one that is correctible by reissue under 35 U.S.C. § 251. Tanaka appealed.

The BPAI affirmed the Examiner. The BPAI pointed to the policy statement issued by the USPTO concerning its interpretation of 35 U.S.C. § 251 in *Manual of Patent Examining Procedure* (MPEP) § 1402 (8th ed., rev. 7, July 2008). The MPEP stated that “§ 251 does not allow for 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 claims without either narrowing the broader patent claim by amendment or canceling the broader patent claim.” The BPAI further quoted the MPEP: “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 BPAI determined that where a single narrower dependent claim has been added in a reissue application that still contains all of the original claims, “the defect in this situation is not the result of the patentee claiming more or less than he had a right to claim in the patent.” Tanaka had failed to “indicate whether the patent is partly inoperative because the original claims are too broad in scope, or whether the patent is partly inoperative because the original claims are too narrow in scope.” The BPAI decided that “the only conclusion we can reach . . . is that the patentee is seeking an additional claim . . . in order to hedge against the possible invalidity of one or more of the original claims.” This the BPAI deemed to be contrary to 35 U.S.C. § 251 and is akin to a “now-disallowed ‘no defect reissue.’”

Practice Tip: The requirements of 35 U.S.C. § 251 must be satisfied when seeking reissue. The errors that rendered the patent wholly or partly inoperative or invalid should be stated with some specificity. Merely adding dependent claims without changing the scope of the original claims does not satisfy 35 U.S.C. § 251.

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