

April 21, 2011

New Dependent Claims in Reissue Are Permissible Under *In re Yasuhito Tanaka*

The ruling of the U.S. Court of Appeals for the Federal Circuit in *In re Yasuhito Tanaka* has left no doubt that the patent reissue procedure can be used to add new dependent claims, and is not limited to only correction of claiming errors. At the time of original patenting, the preferred commercial embodiments are often not yet known or specifically claimed. U.S. patent owners now have the opportunity to modify previously issued claim sets, avoiding a loss of all rights from an invalidity challenge against potentially vulnerable broad claims, by adding more defensible narrow claims directed to the most commercially relevant embodiments.

Background

In 2000, U.S. Patent No. 6,093,991 was issued to Yasuhito Tanaka with independent claim 1 and dependent claims 2-7 directed to an alternator pulley that uses a one-way clutch to improve power generation efficiency of an automobile's clutch. Exactly two years later, Tanaka filed a reissue patent application seeking to broaden the scope of independent claim 1. Tanaka subsequently abandoned his reissue attempt to broaden claim 1, and instead presented the originally issued claims 1-7 and a new claim 16 dependent on claim 1.

The examiner rejected those claims as presented on the basis that Tanaka had failed to specify an error that broadened or narrowed the scope of the claims in the originally issued patent. After the rejection was made final, Tanaka appealed to the Board of Patent Appeals and Interferences. The Board interpreted the language of 35 U.S.C. § 251, and affirmed the examiner's decision, holding that the statute "disallow[s] reissue applications that simply add narrow claims to the reissue patent when no assertion of inoperativeness or invalidity for the reasons set forth in § 251 can be made by the patentee."¹ The Board noted that reissue can not be used simply to hedge against the possible invalidity of one or more of the original claims.

Narrower Claims May Be Added During Reissue

Tanaka appealed to the Federal Circuit and obtained a reversal. Judges Linn and Bryson disagreed with the Board's determination, finding it contrary to long-standing Federal Circuit precedent and counter to the principles of *stare decisis*. The majority held that dependent claims can be added during reissue because "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."² The majority relied on *In re Handel*, 312 F.2d 943, 946 n.2 (CCPA 1963), *In re Muller*, 417 F.2d 1387 (CCPA 1969), and *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 822 F.2d 1556 (Fed. Cir. 1989) in rendering its decision:

¹ *In re Yasuhito Tanaka*, 2010-1262 (Fed. Cir. Apr. 15, 2011), Slip Op. at 4 (quoting *Ex parte Yasuhito Tanaka*, No. 2009-000234 (B.P.A.I. Dec. 9, 2009) at 24).

² Slip Op. at 11.

Even though the rule that adding a dependent claim as a hedge against possible invalidity is a proper reason to seek reissue has seemingly never been formally embodied in a holding of this court or its predecessor, articulation of the rule in *Handel* was 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. Based on this court’s adoption of that rule and its adherence to the rule in both *Muller* and *Hewlett-Packard*, this court rejects the Board’s contrary ruling.

Specifically, the majority found that Judge Rich’s opinion in *Handel*, while admittedly dictum, “clearly stated that adding dependent claims as a hedge against possible invalidity of original claims ‘is a proper reason for asking that a reissue be granted’” and had not been departed from.³ In furtherance of the adherence to this rule, *Muller* plainly implied “that the court regarded the inclusion of dependent claims (i.e., ‘species’) to be proper in a reissue proceeding” assuming no deceptive intent.⁴

Dissent

Judge Dyk dissented, acknowledging that Federal Circuit and predecessor courts have held that reissues *may sometimes* be proper where the original claims have not been revised, but finding that “some correction of an error affecting the original claims is required,” and it “must have a direct and identifiable effect on the applicant’s rights under the original patent.”⁵ Judge Dyk’s dissent relied on a 19th century Supreme Court decision to demonstrate that reissue is unavailable when nothing in the original patent was being corrected. Judge Dyk summarized the majority’s ruling as permitting a patent holder to retain rights under an original patent, while securing a second patent covering the subject matter of new dependent claims.

The effect of this case is to more clearly provide patent holders across all technical fields the opportunity to later specifically claim commercially relevant embodiments or species, which otherwise might not be protected by the broader, potentially invalid claims in the original patent.



If you have questions about this Legal Alert, please feel free to contact either of the attorneys listed below or the Sutherland attorney with whom you regularly work.

William L. Warren
Louise T. Rains

404.853.8081
404.853.8133

bill.warren@sutherland.com
louise.rains@sutherland.com

³ Slip Op. at 6-7.

⁴ Slip Op. at 8.

⁵ *Dissent*, Slip Op. at 6.