

## PRECEDENTIAL OPINION

Pursuant to Board of Patent Appeals and Interferences Standard Operating Procedure 2, the opinion below has been designated a precedential opinion.

UNITED STATES PATENT AND TRADEMARK OFFICE

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### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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*Ex parte* YASUHITO TANAKA

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Appeal 2009-000234  
Application 10/201,948  
Patent 6,093,991  
Technology Center 2800

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Decided: December 9, 2009

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Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*, JAMES T. MOORE and ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judges*, and KENNETH W. HAIRSTON, WILLIAM F. PATE, III, SALLY G. LANE, and LINDA E. HORNER, *Administrative Patent Judges*.<sup>1</sup>

PER CURIAM

### DECISION ON APPEAL

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<sup>1</sup> The Appellant presented arguments at an oral hearing on June 25, 2009 before Judges Hairston, Pate, and Horner. The panel was expanded after the oral hearing.

## SUMMARY OF DECISION

For this reissue appeal, the issue before us is whether the reissue declaration can satisfy the error required under 35 U.S.C. § 251 when the Appellant is only adding a narrower dependent claim by reissue to the existing patented claims simply as a hedge against possible invalidity of the original claims.

The Examiner determined that the Appellant's Substitute Reissue Declaration<sup>2</sup> is defective because the error identified is not an error correctible by reissue. Ans. 4. In particular, the Examiner found that because the reissue application contains all of the original patent claims and adds by reissue application only a single dependent claim 16, the reissue declaration cannot satisfy the error required under 35 U.S.C. § 251 because it cannot properly allege that the patent is 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. Ans. 4-5.

The Appellant contends that § 251 is not as limiting as the Examiner proposes and that it allows for a patentee to add narrower claims by reissue to existing patented claims simply as a hedge against possible invalidity of the original claims. App. Br. 10-12.

We AFFIRM.

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<sup>2</sup> The Appellant filed a Substitute Reissue Declaration on September 24, 2007, because the original reissue oath stated an error that was no longer being corrected. *See* 37 C.F.R. § 1.175(c).

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## STATEMENT OF THE CASE

Yasuhito Tanaka (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision finally rejecting claims 1-7 and 16 in reissue application 10/201,948. The reissue application seeks to reissue U.S. Patent 6,093,991, issued July 25, 2000. The reissue application contains original claims 1-7 and newly-added claim 16. Claims 8-15 and 17 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## THE INVENTION

The Appellant's claimed invention is directed to an alternator pulley. Claims 1 and 16, reproduced below, are representative of the subject matter on appeal.

1. An alternator pulley comprising:

an annular driving member having an inner side and an outer side, said annular driving member having a first center of rotation, said driving member having a first rotation speed and a second rotation speed, said first rotation speed being substantially greater than said second rotation speed;

a belt disposed on said outer side of said driving member;

a driven member disposed on said inner side of said driving member, said driven member having an inner surface and an outer surface, said driven member having a second center of rotation, said first center of rotation being substantially coincident with said second center of rotation; and

a one-way clutch being disposed between said inner side of said driving member and said outer surface of said driven member, said one-way clutch including:

an inner race being disposed on an outer surface of said driven member, said inner race having an inner side and an outer side, said inner side of said inner race contacting said outer surface of said driven member, said outer side of said inner race including a plurality of cam surfaces;

a retainer disposed between said outer surface of said inner race and said inner side of said driving member, said retainer including a plurality of pockets, each pocket including a first wedge-shaped side and a second wedge-shaped side, each first wedge-shaped side being substantially wider than each second wedge-shaped side, each wedge-shaped side defining a wedge element, each wedge element having a first surface disposed within a respective pocket and a second annular surface adjacent to said inner side of said driving member;

a plurality of pressing members, each pocket including a pressing member, each pressing member disposed adjacent to a respective first wedge-shaped side of a pocket; and

a plurality of rollers, each pocket including a roller biased by a respective pressing member, said rollers being in one of a locked state and a free flowing state, said locked state occurring when a respective pressing member biases a respective roller against a respective second wedge-shaped side of a pocket, said free flowing state occurring when a respective pressing member biases a respective roller against a respective first wedge-shaped side of a pocket,

whereby during said first rotation speed, each roller is in said locked state, and during said second rotation speed, each roller is in said free flowing state and said driven member continues rotation due to inertia and said rollers which in turn substantially increases power generation efficiency during said second rotation speed.

16. The alternator pulley of claim 1, wherein an outer side of a respective pressing member contacts a middle portion of a

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corresponding roller such that the pressing members bear against axial centers of the rollers.

### THE REJECTION

The Appellant seeks review of the Examiner's rejection of claims 1-7 and 16 as being based upon a defective reissue declaration because the error identified in the reissue declaration is not an error correctible by reissue under 35 U.S.C. § 251.

### ISSUE

The issue presented by this appeal is:

Has the Appellant shown that the Examiner erred in determining that the presentation of a narrower claim in a reissue application that still contains all of the original patent claims does not present the type of error correctible by reissue under 35 U.S.C. § 251?

### FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Substitute Reissue Declaration, dated September 24, 2007, was signed by the inventor, Yasuhito Tanaka.

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2. The inventor asserted that he believed that “the original patent is at least partially inoperative by reason of claiming more or less than [he] had a right to claim in the original patent.” Substitute Reissue Declaration 3.
3. The inventor further asserted:

That while I recognize the importance of the aspects of the invention disclosed in the original patent, 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.

Substitute Reissue Declaration 3.

4. The inventor further asserted:

The features recited in dependent claim 16 were not included in the original patent.

That because I did not fully appreciate the process of claiming according to U.S. practice, I did not realize that I had claimed more or less than I was entitled to claim.

Substitute Reissue Declaration 3.

5. The inventor further asserted:

That when I executed the declaration of the original application, I reviewed the application carefully for accuracy, but did not recognize the various degrees of specificity with which aspects of an invention can be claimed or that such aspects could be claimed alone.

That is [sic, 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.

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That for this reason, there was an error in the original patent claims that rendered the original patent partially inoperative by failure to adequately claim the invention to the fullest extent possible.

That in accordance wit [sic] the foregoing, the claims in the original patent fail to claim the subject matter recited in new claims 1-7, and thus, in error, the claims of the original patent cover less subject matter than we were entitled to claim.

Substitute Reissue Declaration 3-4.

#### PRINCIPLES OF LAW

Section 251 of the Patent Act states, in pertinent part:

Whenever any patent is, through error without any deceptive intention, *deemed wholly or partly inoperative or invalid*, by reason of a defective specification or drawing, or by *reason of the patentee claiming more or less than he had a right to claim in the patent*, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

35 U.S.C. § 251 (emphasis added). The reissue statute requires that for a patent to be eligible for reissue, a patent must (1) be wholly or partly inoperative or invalid, (2) by reason of an existing error, (3) without any deceptive intention.

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The Federal Circuit has acknowledged that although § 251 should be construed liberally, it does not enable correction of every error:

While we have acknowledged that § 251 is “based on fundamental principles of equity and fairness, and should be construed liberally,” *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986), we have also stated that the remedial function of the statute is not without limits. *MBO Labs., Inc. v. Becton, Dickinson & Co.*, 474 F.3d 1323 (Fed. Cir. 2007). Indeed, “[t]he 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.” *Weiler*, 790 F.2d at 1582. Thus, “not every event or circumstance that might be labeled ‘error’ is correctable by reissue.” *Id.* at 1579.

*In re Serenkin*, 479 F.3d 1359, 1362 (Fed. Cir. 2007).

37 C.F.R. § 1.175(a)(1) implements the above enumerated requirement of 35 U.S.C. § 251, and requires that an applicant for a reissue patent must state:

1. That the applicant believes the original patent to be wholly or partly inoperative or invalid, and
2. At least one such error that is being corrected at the time of filing the reissue oath or declaration.

## ANALYSIS

The plain language of the statute allows for reissues of patents only in situations in which, as it pertains to errors in claims, the patent is 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.” However, the CCPA

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has tacitly approved, at least in dicta, a more liberal construction of the statute which would allow for reissue applications in cases where the patentee is not asserting that the claims in the patent are inoperative (i.e., ineffective to protect the invention) by reason of the patentee claiming either too much or too little in scope.

In *In re Handel*, 312 F.2d 943 (CCPA 1963), the original patent claims 1, 2, and 3 were retained in a reissue application, narrower claims 4, 5, and 6 were added<sup>3</sup>, and the patentee's oath made clear that the appellant's purpose in filing the reissue was to narrow the claims to avoid the possibility of the patent being held invalid in view of an alleged prior public use. *Id.* at 945; *see also id.* at 945 n.2.

The examiner rejected the reissue claims, in part, because the original patent was not partially inoperative and defective by reason of applicant's claiming less than he had a right to claim in his patent. *Id.* at 945. In particular, the examiner had, during prosecution of the original patent, required restriction between claims to a combination of applicator and feed and claims to a sub-combination of applicator, and the applicant had elected the claims to the sub-combination. *Id.* at 946. The examiner based his rejection of the reissue claims on the ground that the reissue claims were drawn to the same combination as the non-elected claims of the original application. *Id.*

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<sup>3</sup>Appealed claims 4, 5, and 6 incorporated entirely the language of original patent claims 1, 2, and 3, and differed therefrom in subject matter only in that each of the appealed claims added one or two elements to the patent claim on which it was based. *Id.* at 945.

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On appeal to the Board, the Board did not accept the examiner’s rationale for rejection of the reissue claims, but nevertheless, sustained the examiner’s rejection on a new basis. *Id.* at 947. The Board sustained the rejection of the reissue claims on the ground that “it is fundamental that a reissue must pertain to the same invention as that recited in the claims of the patent.” *Id.* at 947 (citation omitted). The Board held that “by the introduction of an additional element [i.e., a mechanism for feeding connectors to the applicator mechanism] the appealed claims are not directed to the same invention recited in the claims of the patent” and the Board found “no clear evidence of an intention to claim the particular subject matter of the appealed claims.” *Id.*

Thus, the sole issue before the court in *Handel* was “whether the appealed claims are ‘for the invention disclosed in the original patent,’ as required by 35 U.S.C. § 251, the statute governing the granting of reissues.” *Id.* at 945; *see also id.* at 948. The court in *Handel* held that “the board erred in applying the wrong test to determine whether appellant’s claims are for ‘the invention disclosed in the original patent,’ which is the only provision of section 251 relied on by the Patent Office.” *Id.* at 948 (stating that by looking only to the claims of the patent, the board incorrectly disregarded the express command of the statute to look at the disclosure to determine the invention disclosed in the original patent).

In a footnote, the court commented on the examiner’s original rationale, which was not before the court for review on appeal. *Id.* at 945 n.2. Specifically, the court noted that the examiner’s original rationale

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seemed to reject the reissue oath because the appellant asserted that his patent was partly inoperative by reason of his claiming less than he had a right to claim and “[s]ince the patent claims have been retained, *neither more nor less is being claimed.*” *Id.* at 945 n.2 (emphasis added). The court then added “[t]he 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.” *Id.*

The board’s rationale for sustaining the examiner’s original rejection was not based on any theory that the oath was defective because the appellant could not state that the patent was partially inoperative for claiming more or less than the appellant had a right to claim. The CCPA’s reversal of the board’s decision in *Handel* was based solely on the CCPA’s review of the *board’s* rationale that the narrower reissue claims were not directed to “the invention disclosed in the original patent” as required under § 251. As such, the CCPA’s tacit approval in a footnote that it is proper to seek narrower claims in a reissue as a hedge against the possible invalidity of the original claims is a voluntary opinion made by the court which falls outside the holding of the court in *Handel* and which was made without argument or full consideration of the point after briefing by the parties. In other words, this statement in footnote 2 of *Handel* is dictum.

The Federal Circuit acknowledged as much in *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556, 1565 (Fed. Cir. 1989). In *Hewlett-Packard*, the patentee filed a reissue application containing the original patent claims and three new, narrower claims as a hedge against the original

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patent claims being held overly broad. The court noted that the patentee “is not asserting that the claims in the [original] patent are inoperative (i.e., ineffective to protect the invention) by reason of the patentee claiming either too much or too little in scope, but because he included, in a sense, *too few* claims.” *Id.* at 1565 (citing *In re Handel*, 312 F.2d at 945-46 n.2). The Court in *Hewlett-Packard* noted that “[a]lthough neither ‘more’ nor ‘less’ in the sense of scope of the claims, the practice of allowing reissue for the purpose of including narrower claims as a hedge against the possible invalidation of a broad claim has been tacitly approved, at least in dicta, in our precedent.” *Id.* at 1565 (citing *In re Handel*, 312 F.2d at 945-46 n.2 and 4 E. Lipscomb, *Walker on Patents* § 14:33 at 479 (3d ed. 1986)).

Importantly, however, the court in *Hewlett-Packard* did not need to reach the issue of “whether omission of narrow claims which more specifically cover a broadly claimed invention meets the first prong [of section 251] of the requirement for error” in the patent, because the court held that the patentee clearly did not establish the second prong of the statute, namely, inadvertent error in conduct. *Id.* at 1565. The Court explicitly stated that it would not reach this issue, albeit simultaneously noting that the patentee’s statement regarding the need for additional claims as a hedge against possible claim invalidity was not within the literal language of the reissue statute:

For purposes of this case, we will assume that that practice is in accordance with the remedial purpose of the statute, although B & L clearly did not allege an ‘error’ in the patent which meets the literal language of the statute. We need not decide here

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whether omission of narrow claims which more specifically cover a broadly claimed invention meets the first prong of the requirement for error, that is, error in the patent, because B & L clearly did not establish the second prong, namely, inadvertent error in conduct

*Id.* Thus, the court in *Hewlett-Packard* did not squarely address the issue before us in the present appeal.

However, even after stating that the court declined to decide that issue, the court pointed out that if the type of error alleged by B & L were in fact a reissuable error, then virtually every patent could be reissued out of hand:

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 collapses into one because the omission of additional narrow 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 unequivocably and repeatedly rejected.*

*Id.* (emphasis added).

Finally, the Federal Circuit added:

B & L does not suggest circumstances which would constitute abandonment of the subject matter of the dependent claims while not, at the same time, abandoning the subject matter of the independent claim. Thus, B & L's proposed restriction on reissue where narrower claims are sought is, in truth, no restriction at all.

*Id.* at 1566.

Similar facts were also presented in *In re Muller*, 417 F.2d 1387 (CCPA 1969), in which all of the original patent claims were presented in the reissue application and four additional narrower claims were sought by reissue. In *Muller*, the examiner’s rejection under § 251 was based on the premise that the oath was defective because the appellant was attempting to recapture by reissue claims to a non-elected species. *Id.* at 1388. As in *Handel*, the issue presented to us by the present appeal was not before the court in *Muller*, and the holding in *Muller* did not address the question now before us. Rather, the CCPA in *Muller* held that the newly-added reissue claims did not impermissibly recapture a non-elected species because “the provisional election disappeared with the allowance of claims 1-3 of the patent, each of which is generic as regards filter material” and because “[b]y including an additional limitation in each of four new claims here, appellant is not shifting to different species; he is simply defining his invention more narrowly, which he could have done but failed to do in the prosecution of the patent.” *Id.* at 1391. The court in *Muller* did not address, even in dicta, the issue of whether the failure to present narrower claims is an error correctible under § 251 “by reason of the patentee claiming more or less than he had a right to claim in the patent.” Rather, the court’s holding in *Muller* was limited to a holding that the Board erred in determining that the patentee made a deliberate renunciation of subject matter during prosecution of the original patent. *Id.* (declining to reach the question of whether a deliberate non-election of species can be remedied by reissue).

In other cases, the court has found it proper to correct indefinite claims by reissue, even if the indefiniteness is based on lack of antecedent basis such that the reissue claims are not of different scope than the original patent claims. *See e.g., In re Altenpohl*, 500 F.2d 1151 (CCPA 1974). In *Altenpohl*, the CCPA remarked that “35 U.S.C. § 251 is a remedial provision, which should be liberally construed.” *Id.* at 1156 (holding that correction of an antecedent basis defect in a claim is proper under 35 U.S.C. § 251 and that “correction of such a defect should not have to depend on difference in scope of the claim.”). The important difference between the situation presented by the facts of *Altenpohl* and the facts of the present appeal, is that the court in *Altenpohl* noted that “[l]ack of an antecedent basis in a claim could render it invalid under 35 U.S.C. § 112.” *Id.* at 1156. Thus, the court in *Altenpohl* had claims before it that contained a defect that could render them invalid and the patentee was attempting to correct this defect or error by reissue. By contrast, in the present case, the original patent claims are not being amended to correct a defect that could render the claims invalid. Rather, the original patent claims are not being corrected at all. The Appellant is simply seeking, by reissue, to add narrower claims, where no valid assertion has been made by the patentee that any error exists as to the scope of the original patent claims.

The Patent Office has issued a policy statement concerning its interpretation of 35 U.S.C. § 251 as it pertains to the issue now before us. *See Manual of Patent Examining Procedure (MPEP) § 1402 (8<sup>th</sup> ed., rev. 7, July 2008).* Section 1402 of the MPEP states that the Patent Office’s

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interpretation of § 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(s) without an allegation that one or more of the broader patent claims(s) is/are too broad together with an amendment to such claim(s). *Id.* This section of the MPEP states, in pertinent part:

An error under 35 U.S.C. 251 *has not been presented* where a reissue application only adds one or more claims that is/are narrower than one or more broader existing patent claims without either narrowing the broader patent claim by amendment or canceling the broader patent claim. 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 U.S.C. 251. Such a reissue application should not be allowed. 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) 35 U.S.C. 251 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.

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*Id.* Since July 2008, the 5,000+ USPTO examiners have applied the above-stated MPEP reissue policy to determine proper and improper grounds for filing reissue applications.

There are two distinct statutory requirements that a reissue oath or declaration must satisfy. First, it must state that the patent is wholly or partly inoperative or invalid because of defects in the specification or drawing, or because the patentee has claimed more or less than he is entitled to. Second, it must allege that the inoperative or invalid patent arose through error without deceptive intent.<sup>4</sup>

The only issue before us is whether the presentation of a narrower claim in a reissue application that still contains all of the original patent claims is an error correctible by reissue under 35 U.S.C. § 251 and 37 C.F.R. § 1.175(a)(1). As noted by the CCPA in *Handel*, 312 F.2d at 945 n.2, and later by the Federal Circuit in *Hewlett-Packard*, 882 F.2d at 1565, 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.<sup>5</sup>

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<sup>4</sup> The Examiner's rejection is not based on the second requirement of § 251. As such, we do not address the sufficiency of the description in the Substitute Reissue Declaration of how the error occurred.

<sup>5</sup> The Appellant argues that claim 16 should be viewed, in theory, as a separate patent, and that the limitation added by claim 16 is of different scope from the remaining claims 1-7. App. Br. 10. While we agree that claim 16 is narrower than the scope of claim 1, and that claims 2-7 are of different scope than claim 16, this fact does not address the Examiner's point that, because the scope of claim 16 is subsumed by claim 1, from which it depends, the claims, collectively, are not broader or narrower in scope than

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Precisely for this reason, the Appellant<sup>6</sup> had difficulty in stating an error in the Substitute Reissue Declaration that would comply with 35 U.S.C. § 251 and 37 C.F.R. § 1.175(a)(1). In particular, the Appellant asserted generally that the original patent is partly inoperative by reason of claiming “more or less” than he had a right to claim in the patent (Facts 1, 2, 4). The Appellant’s mere reiteration of the statutory language “more or less” does not clearly identify the error to be corrected by reissue, because it does not 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. *See e.g., Ex parte Oetiker*, 1997 WL 1883795, Appeal No. 96-4146 (BPAI 1997) (holding that a reissue declaration which merely repeats the disjunctive statutory language that the error was one of claiming “more or less” than the patentee had a right to claim is an insufficient statement of error to satisfy 35 U.S.C. § 251).

The Appellant then asserted that the error is that “the originally presented claims did not adequately define the invention because they were more specific than necessary” and thus the original patent was in error by covering “less subject matter” than he was entitled to claim (Fact 5). This

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the claims of the original patent. As such, the patent is not “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.”

<sup>6</sup> In this case, the Appellant (inventor) is also the declarant who signed the Substitute Reissue Declaration (Fact 1).

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assertion does not comport with the scope of the reissue claims, which do not attempt in any way to broaden the claims of the original patent.

Rather, as in *Hewlett-Packard*, 882 F.2d at 1565, the error presented by the present appeal appears to be based on the fact that the patentee included too few claims. The closest that the Appellant comes to asserting this error as the error upon which the reissue is based is in paragraph 3 of the Substitute Reissue Declaration, in which the Appellant asserts that he failed to recognize that the disclosed invention was not “fully covered by the original claims” (Fact 3).

This statement, however, is inaccurate, because the original claims, which are drafted using the open-ended “comprising” language, would cover the invention as now presented in claim 16. It is only if the Appellant were to assert that claim 1 is overly broad or otherwise inoperative or invalid that the original claims may not fully cover the invention now presented in reissue claim 16. The Appellant, however, nowhere asserts in the Substitute Reissue Declaration that the patent is partly inoperative by reason of the patentee claiming more (i.e., by broadly reciting the invention in claim 1) than he had a right to claim in the patent. The Appellant also does not attempt in this reissue application to add narrowing language to claim 1 or to cancel claim 1 as being overly broad.

Considering the vague language used in the Substitute Reissue Declaration to describe the error being corrected by reissue, the only conclusion we can reach from a review of the reissue claims on appeal is that the patentee is seeking an additional claim (i.e., claim 16) in order to

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hedge against the possible invalidity of one or more of the original claims. The Appellant attempts to have it both ways, by seeking to add narrower claims to the original patent without complying with the requirements of 35 U.S.C. § 251 and 37 C.F.R. § 1.175(a)(1) that the patent be deemed, presumably by the Appellant in a reissue oath or declaration, to be 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. Section 251, however, requires that for the Director to reissue a patent, the patent must be deemed to be wholly or partly inoperative or invalid. The reissue statute may be remedial in nature, *Altenpohl*, 500 F.2d at 1156, but it is not as broad in its plain wording as to allow a patentee to simply re-prosecute an otherwise operative and valid patent.<sup>7</sup>

Further, we see little difference between the practice of simply adding a single dependent claim to the originally-issued claims as the basis for a reissue and the now-disallowed practice of filing a “no defect reissue.” The

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<sup>7</sup> The Appellant requests us to also consider two prior, published Board decisions in which the Board reversed examiners’ rejections of reissue claims under 35 U.S.C. § 251 and stated that the filing of a reissue application with the original claims and newly-added narrower claims is a permissible hedge against the possible invalidity of the original claims. Appeal Br. 10-12 (citing *Ex parte Larkin*, 9 USPQ2d 1078 (BPAI 1988) and *Ex parte Parks*, 30 USPQ2d 1234 (BPAI 1993)). To the extent that the holdings in these cases conflict with the holding in the present case, the present decision overrules those aspects of *Parks* and *Larkin*. See *Ex parte Holt*, 19 USPQ2d 1211 (BPAI 1991) (“A published Board opinion may be overruled only by the Board sitting en banc, or by an expanded panel of the Board (i.e., one with more than three members)” (citations omitted)).

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PTO rules<sup>8</sup> previously permitted patentees to file a “no defect” reissue application for the purpose of submitting to the PTO the claims of its issued patent together with several items of “prior art” for the purpose of having the claims reexamined in light of this art. *See In re Dien*, 680 F.2d 151, 152 (CCPA 1982) (discussing “no defect” reissue applications).

In *Dien*, the PTO initially accepted a “no defect” reissue application, the Examiner made art rejections of the claims, the Board affirmed the Examiner’s rejections, and appeal was taken to the CCPA. *Id.* at 153. Before the case was heard by the CCPA, the PTO filed a motion to dismiss the appeal on the grounds that the reviewing court did not have jurisdiction to hear the appeal because the reissue application did not satisfy the provisions of § 251. *Id.* The CCPA granted the PTO’s motion and dismissed the appeal for lack of jurisdiction. *Id.* at 155. The CCPA found that because the reissue application specification and claims were identical

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<sup>8</sup> Old rule 37 C.F.R. § 1.175(a)(4) stated, in pertinent part:

(a) Applicants for reissue, in addition to complying with the requirements of the first sentence of § 1.65, must also file with their applications a statement under oath or declaration as follows:

(4) When the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid, particularly specifying such prior art or other information and requesting that if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent.

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with the patent specification and claims, and because the applicant had pointed to no error or defect in the patent and had not alleged that it is inoperative or invalid in part or in whole, the patentee failed to comply with the provisions of 35 U.S.C. § 251. *Id.* at 154.<sup>9</sup> In commenting on § 1.175(a)(4) practice, the court criticized the practice as permitting a patentee to obtain an advisory opinion without seeking a true reissue of its patent because the patentee did not have to identify a true error in the original patent. *Id.* In removing § 1.175(a)(4) practice, the Office stated that removing the regulation would eliminate consideration of reissue applications not initially presented to correct defects pursuant to 35 U.S.C. § 251. 47 Fed. Reg. 21746-21749 (discussion beginning at the bottom of page 21748).<sup>10</sup>

Likewise, in this case, for the reasons discussed *supra*, the Appellant failed to properly allege in the Supplemental Reissue Declaration that the patent is wholly or partially inoperative or invalid by reason of the patentee

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<sup>9</sup> The PTO rules have been amended since the decision in *In re Dien* to delete the provision for “no defect” reissue applications.

<sup>10</sup> See also *In re Bose*, 687 F.2d 432 (Fed. Cir. 1982) (dismissing an appeal from a decision in a “no defect” reissue for lack of jurisdiction and stating that “merely removing claims from an (a)(4) application is not enough to turn such application into an application seeking reissue or avoid the holding that all that has been given by the board is an advisory opinion.”) Thus, *Bose* confirms the position taken by the court in *Dien* that a proper reissue application must be supported by the allegation of an *existing* 35 U.S.C. § 251 error (i.e., that the patent to be reissued is wholly or partly inoperative or invalid).

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claiming more or less than he had a right to claim (Facts 1-5). Further, the practice at issue in this case, if allowed, would be a work around to the proscription against “no defect” reissues. If such a practice were allowed, a patentee would simply file a reissue application with the same specification and claims as in the patent, add a single inconsequential dependent claim, submit new prior art in an Information Disclosure Statement, and obtain a reexamination of the original patent in view of the new prior art.

We cannot reconcile the contradiction between the plain wording of § 251, which authorizes the Director to reissue patents 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,” and the dicta in *Handel* stating that a proper use of the reissue process is to present narrower claims as a hedge against possible invalidity of the original claims, even though such a reissue covers neither more nor less than the original claims. 312 F.2d at 945 n.2. The facts presented in the present appeal cannot meet the requirement for a reissue under the plain wording of § 251.

The Appellant asks us to re-write § 251 to simply read the operative words “by reason of a patentee claiming more or less than he had a right to claim in the patent” out of the statute. We decline to do so. If those who wrote the statute intended a situation such as the one before us on appeal to be covered by the reissue process, then the solution is to amend the language of the statute to provide for reissue under such circumstances.

The specific wording used in § 251 limits the scope of the Director’s power to grant reissue patents only in situations in which the original patent

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is deemed wholly or partly inoperative or invalid by reason of a defective specification or drawing, or *by reason of the patentee claiming more or less than he had a right to claim in the patent*. The Office's interpretation of § 251 to disallow reissue applications that simply add narrower 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, is in keeping with the plain wording and scope of § 251.

Since we find no controlling precedent requiring us to allow the Appellant to correct the error as presented in this reissue application, and since we find that the Examiner's interpretation of § 251 is in keeping with the plain wording of the statute, we sustain the Examiner's rejection of claims 1-7 and 16 as being based on a defective reissue declaration by attempting to correct an error not correctible under 35 U.S.C. § 251.

## CONCLUSION

The Appellant has failed to show that the Examiner erred in determining that the presentation of a narrower claim in a reissue application that still contains all of the original patent claims is not an error correctible by reissue under 35 U.S.C. § 251.

## DECISION

The decision of the Examiner to reject claims 1-7 and 16 is  
**AFFIRMED.**

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH VA 22040-0747