Clarification of Criteria for Reissue Error in View of In re Tanaka

A. Summary

The United States Patent and Trademark Office (the "Office") is providing notification of change in policy based on the recent decision of the U.S. Court of Appeals for the Federal Circuit of In re Tanaka. In a reissue application, the addition of claims that are narrower in scope than the existing claims, without any narrowing of the existing patent claims, may be the basis for correcting an error under 35 U.S.C. § 251 to support a proper reissue application. A rejection under 35 U.S.C. § 251 will no longer be made in this scenario, provided that the claims are otherwise compliant with 35 U.S.C. § 251. This change revises the policy in the current Manual of Patent Examining Procedure (MPEP) that is provided in MPEP § 1402.

B. Discussion

The Manual of Patent Examining Procedure (MPEP) § 1402 was revised in July of 2008 to state:

> 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. [Emphasis in original.]

MPEP § 1402, July 2008, page 1400-2.

Tanaka sought reissue to add one dependent claim to his original patent. Because the only error alleged was the failure to present the narrower dependent claim during the original patent examination, the examiner rejected the reissue application under 35 U.S.C. § 251, relying on MPEP § 1402. The Board of Patent Appeals and Interferences (the "Board") affirmed the examiner on appeal (see Ex parte Tanaka, 93 USPQ2d 1291, 92 (Bd. Pat. App. & Int. 2009), and the matter was appealed to the U.S. Court of Appeals for the Federal Circuit.

On appeal, the Federal Circuit held, in its decision of In re Tanaka, 640 F. 3d 1246, 1251, 98 USPQ2d 1331, 1334 (Fed. Cir. 2011), that "the 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." Tanaka, 640 F. 3d at 1251, 98 USPQ2d at 1334. The court went on to state that:

> "[t]his 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. While the Board correctly recognized that a patent is inoperative under § 251 if it is ineffective to protect the disclosed invention, the Board improperly assumed that Tanaka's original patent cannot be deemed partly inoperative in the absence of claim 16, whose scope is subsumed by claim 1, from which it depends.... 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." Tanaka, 640 F. 3d at 1250-51, 98 USPQ2d at 1334 [emphasis added].

Even further, the court stated that "...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...." Tanaka, 640 F. 3d at 1251-52, 98 USPQ2d at 1335.

The current version of MPEP § 1402 is not consistent with the Tanaka decision.

C. Implementation of New Policy

Effective immediately, the following policy is implemented. Where the only change to a patent made in an application for its reissue is the addition of a claim or claims that is/are narrower in scope than the existing patent claims, without any narrowing of the existing patent claims, the application claims are not to be rejected as failing to state an error under 35 U.S.C. § 251. In addition, any rejection of record in a pending application on this basis will be withdrawn, and any new Office action issued will inform applicant of the withdrawal, and the resulting status of the application in view of the withdrawal.

MPEP § 1402 will be revised in due course to reflect the holding in Tanaka.

D. Inquiries: Questions regarding this notice may be directed by phone to Kenneth M. Schor at (571) 272-7710, Senior Legal Advisor, Office of Patent Legal Administration.

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