

The Proscription Against Broadening Claims in Reissue and Reexamination:

Conflict Between the Federal Circuit and the Board of Patent Appeals and Interferences*

Scott E. Kamholz[†]

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[†] Copyright © 2005 by Scott E. Kamholz. Dr. Kamholz is a patent attorney in the Boston office of Foley Hoag LLP. He received a J.D. from Boston College Law School and an M.D., a Ph.D. in physiology and biophysics, and a B.S. in biomedical engineering *magna cum laude* from the University of Miami. He may be reached at skamholz@foleyhoag.com. The author gratefully acknowledges Dana M. Gordon, Ph.D., Esq. of Foley Hoag LLP for suggesting the topic, and Joseph H Born, Esq., Denise W. DeFranco, Esq. and Claire Laporte, Esq., all of Foley Hoag LLP, for valuable comments on portions of the manuscript.

I. Introduction

Reissue applications and reexamination proceedings provide two mechanisms for the U.S. Patent and Trademark office to alter substantively the content of a U.S. patent following its issuance.¹ Both mechanisms were designed to impose strict limits on the patentee's ability to broaden the scope of the claims. These limits were intended to preserve the notice function of patents and to protect the public from additional "discovered" rights.²

The U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") has observed the strict statutory limits on the broadening of claims in reissue applications and reexamination proceedings. It has repeatedly stated a simple test to detect a broadened claim: a reissue or reexamination claim is "broadening" if it could be infringed by something that would not have infringed any claim of the original patent, and that a claim is broadening if broader in any aspect, even if narrower in other aspects.³ This infringement-based test is motivated by a long-standing policy, discussed below, of protecting innocent members of the public who might have

reasonably concluded, in relying on the smaller scope of the original claims, that they were not infringing.

However, the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences ("Board") has taken a more expansive view of the proscription against broadening than is required by Federal Circuit precedent in at least one respect. Specifically, the Board has held in two opinions that reissue/reexamination claims are broadening if they recite a statutory class (i.e., "process, machine, manufacture, or composition of matter"⁴) that was not recited in the original patent, even if the new claims include all the limitations of the original claims.⁵ The Federal Circuit has not had the occasion to review the issue, because neither case was appealed.

The Board's test for broadening is inappropriately stricter than the Federal Circuit's "infringement" test, because it would label claims as "broadening" even where those claims could not possibly proscribe any activity not already proscribed by the patent and thereby trap the innocent public in infringement. The Board has thus departed from the policy underlying the Federal Circuit's test, a policy that has been carefully shaped over more than a century of case law and several statutory revisions. This paper traces the origins and development of the reissue and reexamination procedures, identifies the policy reasons underlying the proscription against broadening claims, and concludes by applying these principles to the "claim category" issue.

¹ The third mechanism, disclaimer, is governed by 35 U.S.C. § 253. Another mechanism, the Certificate of Correction, is reserved for rectifying mistakes made by the Patent Office, 35 U.S.C. § 254 (2000), or for a patentee's clerical or typographical mistake, 35 U.S.C. § 255 (2000).

² A term coined by the author and made with reference to the chess tactic "discovered check," a startling feat in which the movement of one piece (read: "removal of a claim limitation") reveals a check (read: "infringement") administered by another piece.

³ *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037, 4 U.S.P.Q.2d 1450, 1453 n.2 (Fed. Cir. 1987).

⁴ 35 U.S.C. § 101 (2000).

⁵ *Ex parte Logan*, 38 U.S.P.Q.2d 1852 (Bd. Pat. App. & Inter. 1994); *Ex parte Wikdahl*, 10 U.S.P.Q.2d 1546 (Bd. Pat. App. & Inter. 1989).

II. Reissue Applications - Origins and Development

A. The First Reissue Rule

The U.S. patent system has long embraced the propriety of correcting errors in issued patents. Indeed, the Secretary of State (administrator of the patent system under the 1790 and 1793 Patent Acts) routinely reissued patents shown to be defective, even though the Patent Acts of 1790⁶ and 1793⁷ provided no statutory authority for post-issuance correction of patents. The Supreme Court acquiesced in this practice in *Grant v. Raymond*,⁸ and the Patent Act of 1832⁹ codified the reissue procedure to settle the doubt. The reissue provision of the 1832 Act (and as retained

similarly in the 1836 Act¹⁰) made reissue available when a granted patent:

shall be inoperative, or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention, more than he had or shall have a right to claim as new; if the error has, or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention...¹¹

The focus, then, of the original reissue rule was to provide a mechanism for a patentee to *reduce* the scope of a defectively broad specification. This focus was preserved in the

⁶ Patent Act of 1790, ch. 7, 1 Stat. 109-112 (1790).

⁷ Patent Act of 1793, ch. 11, 1 Stat. 318-323 (1793).

⁸ *Grant v. Raymond*, 31 U.S. 218, 8 L.Ed. 376 (U.S. 1832). In *Grant*, a patent infringement case, the plaintiff had surrendered his original patent to the Secretary of State and obtained a second patent, with an amended specification, for the remainder of the original patent's term. The defendant argued that the Patent Act granted the Secretary of State no such power to accept surrender and to regrant patents. *Id.* at 225. Chief Justice Marshall, conceding as much, nevertheless held that the practice was consistent with the purpose and spirit of the act ("If the mistake should be committed in the department of state, no one would say that it ought not to be corrected... The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals... That which gives complete effect to this object and intention, by employing the same means for the correction of inadvertent error which are directed in the first instance, cannot, we think, be a departure from the spirit and character of the act."). *Id.* at 242-43.

⁹ Patent Act of 1832, ch. 162, 4 Stat. 559 (1832).

¹⁰ Patent Act of 1836, ch. 357, 5 Stat. 117 (1836).

¹¹ *Id.*, § 13, which reads in pertinent part: "*And be it further enacted*, That whenever any patent which has heretofore been granted, shall be inoperative, or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention, more than he had or shall have a right to claim as new; if the error has, or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification... And the patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent.

next major revision of the Patent Act in 1870,¹² although the reissue provision was slightly reworded to reflect the new requirement that the invention be set forth in one or more claims.¹³

B. “Broadening” of the Reissue Rule

Over time, however, lower courts interpreted the reissue provision to allow for broadening of patent scope.¹⁴ The Supreme Court sharply limited this practice in 1881 with its landmark case *Miller v. Bridgeport Brass Co.*, principally citing the injury suffered by the public in suddenly finding itself infringing a reissued patent.¹⁵ The Supreme Court noted the clear language of the 1870 Act that permitted reissue where a patentee had claimed “more than he had a right to claim”¹⁶ but not where the patentee had claimed “less.” The Court also decried the “curious misapplication of the law” that resulted in the routine issuance of enlarging reissue patents “years after their first issue, [so] that hundreds and thousands of mechanics and manufactures, who had just reason to suppose that the field of action was open, have been obliged to discontinue their employments, or to pay an enormous tax for continuing

them.”¹⁷ The Court announced that broadening reissue applications must be brought speedily and on a clear mistake or inadvertence.¹⁸ Delay, such as the fifteen year delay in *Miller*,¹⁹ amounted to laches, because it was inconceivable that an error of such importance (i.e., claiming too little) could reasonably go unnoticed by the patentee for such a long time.²⁰

The Court then held that when a patentee discloses more than is claimed, the unclaimed subject matter is deemed dedicated to the public unless the failure to claim was accidental and the patentee acts quickly to correct the error.²¹ The Court analogized the notice function of the original patent to the two-year public use bar then applicable for patentability determinations,²² observing, “If

¹² Patent Act of 1870, ch. 230, 16 Stat. 198 (1870).

¹³ *Id.*, § 53. The claim requirement was included in section 26 of the 1870 Act: “...and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery...”). *Id.*, § 26. The reissue provision was amended by deleting the words “in his specification” after “claiming.”

¹⁴ *Miller v. Bridgeport Brass Co.*, 104 U.S. 350 (U.S. 1881).

¹⁵ *Id.*

¹⁶ *Id.* at 353.

¹⁷ *Id.* at 354-55.

¹⁸ *Id.* at 352.

¹⁹ *Id.* The patent had been initially granted for a 14 year term and then extended 7 years.

²⁰ *Id.*

²¹ *Id.* (“[T]he claim of a specific device or combination... is a declaration that that which is not claimed is either not the patentee’s invention, or, if his, he dedicates it to the public. This legal effect of the patent cannot be revoked unless the patentee surrenders it and proves that the specification was framed by real inadvertence, accident, or mistake, without any fraudulent or deceptive intention on his part; and this should be done with all due diligence and speed.”)

²² The grace period for public use was then two years. Patent Act of 1870, ch. 230 § 24, 16 Stat. 198 (1870) (“*And be it further enacted*, That any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented, or described in any printed publication in this or

two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public."²³ Subsequent courts interpreted this analogy to require that a broadening reissue patent must be sought no more than two years after the original patent issued – just as a patent must be sought no more than two years after a public disclosure – except on a showing of the reasonableness of the further delay.²⁴

After the public use grace period was reduced to one year,²⁵ subsequent cases noted that, as a result, the period for filing a broadening reissue application was similarly shortened from two years to one.²⁶ Despite

any foreign country, before his invention or discovery thereof, *and not in public use or on sale for more than two years prior to his application*, unless the same is proved to have been abandoned, may, upon payment of the duty required by law, and other due proceedings had, obtain a patent therefor.”) (second emphasis added).

²³ *Miller v. Bridgeport Brass Co.*, 104 U.S. at 352.

²⁴ *E.g., Wollensak v. Reihe*, 115 U.S. 96, 101, 5 S.Ct. 1137, 1140, 29 L.Ed. 350, 352 (U.S. 1885) (“in cases where the claim is merely expanded, that the delay has been for two years or more, it is adjudged to invalidate the reissue, unless the delay is accounted for and excused by special circumstances, which show it to have been not unreasonable.”).

²⁵ Effected by an Act of Congress approved August 5, 1939, 53 Stat. 1212.

²⁶ *E.g., Application of Croskey*, 165 F.2d 797, 799, 76 U.S.P.Q. 389, 391 (C.C.P.A. 1948) (“Of course, in view of the amendments referred to herein [reducing the public use bar grace period to one year] and following the rule of law set forth in [*Miller v. Bridgeport Brass Co.* and other cases], it

these fluctuations, the courts steadfastly maintained their commitment to protect the public from patents broadened outside a reasonable time period.²⁷ “Otherwise,” noted the Supreme Court, “the door is open for gross injustice to alert inventors and baffling uncertainty will hinder orderly development of useful arts.”²⁸

C. The Path to Codification in the Patent Act of 1952

The broadening reissue rule was judicially-created doctrine, as were many other aspects of the patent law, most notably obviousness. The effort to codify the amassed judicial doctrine, which culminated in the 1952 Patent Act, accordingly addressed the question of broadening reissue patents. While the reissue provision evolved gradually during the codification process, the policy of protecting the innocent public from “discovered” rights underlay each revision.

An early proposed patent act provision included a reissue section little changed from its predecessors and did not expressly authorize broadening reissues.²⁹ A subsequent

would seem with respect to such applications and to patents granted thereon that an application for reissue, unless made manifest by the special circumstances of the case, would have to be made within one year after the date of the patent.”); *Application of Hayes*, 178 F.2d 940, 943, 84 U.S.P.Q. 245, 247 (C.C.P.A. 1950).

²⁷ A separate doctrine of “intervening rights” (later codified at 35 U.S.C. § 252) protected those whose infringement of broadened reissue claims commenced prior to those claims’ issuance.

²⁸ *Sontag Chain Stores Co. Ltd. v. National Nut Co. of California*, 310 U.S. 281, 294, 60 S. Ct. 961, 967, 84 L.Ed. 1204, 1212; 45 U.S.P.Q. 448, 453 (U.S. 1940).

²⁹ STAFF OF HOUSE COMM. ON THE JUDICIARY, 81ST CONG., Proposed Revision and Amendment of the Patent Laws, Preliminary Draft with Notes (Comm. Print 1950). Section 58 provided the

draft in July 1950, presented as H.R. 9133 in the 81st Congress, however, added authorization for broadening reissues.³⁰ This draft also provided an express time limit of one year for filing a broadening reissue application.³¹ This time limit would have codified the change recognized in then-recent cases such as *Croskey* and *Hayes*;³² the similarity between the draft provision and the prevailing case law suggests that the proposed legislation was intended to reflect the public-protective policy expressed by the courts.

H.R. 9133 was not enacted, and a new patent bill, H.R. 3760, was introduced in the following session. Without explanation, however, the reissue provision was modified to increase the one-year broadening reissue period back to its former two years: “No reissued patent shall be granted enlarging the scope of the claims of the original patent

reissue provision and began: “Whenever any patent is deemed wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming more than he had a right to claim in the patent, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention...”

³⁰ H.R. 9133, 81st Cong. § 201 (1950). Section 201 began: “Whenever any patent is deemed wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming more *or less* than he had a right to claim in the patent, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention...” (emphasis added).

³¹ *Id.* The final paragraph of § 201 read: “No reissued patent shall be granted enlarging the scope of the original patent unless applied for within *one year* from the grant of the original patent” (emphasis added).

³² See *supra* note 26 and accompanying text.

unless applied for within *two years* from the grant of the original patent” (emphasis added).³³ This change, though unexplained in the testimony of principal author Giles Rich and others, nevertheless did not go unnoticed by members of the public who submitted comments to the House Judiciary Committee. One C. A. Soans noted that the statutory two-year provision disturbed the traditional parallelism with the public use bar and cautioned that the bright-line time period might discourage diligence in detecting errors and filing reissue applications.³⁴ Louis Robertson of New York, on the other hand, felt that limiting the period for broadening reissues to merely 2 years was unjust on the ground that inventors of pioneering patents were unlikely to realize the full scope of their inventions within that time.³⁵ The “two years” language was ultimately adopted with the Patent Act of 1952³⁶ and codified at 35 U.S.C. § 251.³⁷

In his Commentary shortly following the adoption of the Patent Act of 1952, Examiner-in-Chief P.J. Federico pointed out that the long-lived concern for public protection still underlay the limitation on broadening reissues:

The statute does not define a broadened reissue... but the cases indicate that the general rule is that if a claim of a reissue can hold something

³³ H.R. 3760, 82d Cong. § 201 (1951).

³⁴ Testimony Appendix to June 1951 Subcommittee hearings on H.R. 3760, 82d Cong., 214.

³⁵ *Id.* at 219.

³⁶ Patent Act of 1952, ch. 950, 66 Stat. 792 (1952).

³⁷ 35 U.S.C. § 251 (2000).

as an infringement which would not be an infringement of any of the claims of the original patent... then the particular claim of the reissue enlarges the scope of the claims of the original patent, and that a claim is broadened if it is broadened in any respect.³⁸

This, of course, remains the present-day test for a broadening claim. When set in its historical context, one can appreciate its origins in *Miller v. Bridgeport Brass Co.* and the desire to protect the public from reasonably unexpected infringement.

III. Reexamination Proceedings

While the reissue avenue has been available to patentees for over a century to correct errors in their patents, only one mechanism existed for an accused infringer to “modify” a patent: the successful assertion in court of patent invalidity.³⁹ This typically involved years of expensive litigation and was at the mercy of a nontechnical judge who might not appreciate the subtleties of the asserted prior art. These mammoth patent litigations consumed vast judicial resources and seemed unnecessarily burdensome to many. Moreover, as many as sixty percent of all litigated patents were being found invalid,⁴⁰ often after extensive (and expensive) periods of fact discovery largely concerning infringement and damages, not validity. The Patent Office, these critics argued, was a more

appropriate venue for assessing patentability over prior art.⁴¹

The solution offered to this problem was reexamination, a proceeding in the Patent Office whereby any person could obtain an evaluation of a patent’s claims upon a substantial new question of patentability. Enacted alongside the Bayh-Dole Act of 1980,⁴² the *ex parte* reexamination scheme was codified at 35 U.S.C. §§ 301-307. Many versions of reexamination schemes were proposed in a series of bills during the 1970’s,⁴³ but all of them shared at least one feature: an absolute proscription against the broadening of the patent’s claims beyond the broadest claim that issued, now codified at 35 U.S.C. § 305.⁴⁴ The propriety of this requirement seems to have spoken for itself,

⁴¹ *Id.*

⁴² Act of December 12, 1980, Pub. L. No. 96-517, 94 Stat. 3015 (1980). The name “Bayh-Dole” traditionally refers to the part of that law dealing with patent rights in inventions made with federal assistance and codified at 35 U.S.C. §§ 200-11.

⁴³ Some bills, such as S. 4259, which was introduced in December 1974 by Senator Hiram Fong, prohibited a party from asserting invalidity in court based on a prior art reference that had not been considered by the Patent Office. Thus, if an infringement defendant wished to offer an invalidity defense based on art not cited during prosecution, the litigant would have been required first to obtain a reexamination of the patent on that art before being allowed to make the defense.

⁴⁴ 35 U.S.C. § 305 (2000) (“No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter.”). The optional inter partes reexamination law also forbids broadening claim amendments. 35 U.S.C. § 314 (2000).

³⁸ P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. § 1 (West 1954), reprinted in 75 J. PAT. & TRADEMARK OFF. SOC’Y 161, 204-5 (1993).

³⁹ 35 U.S.C. § 282 (2000).

⁴⁰ William G. Conger, *Patent Reexamination Re-examined*, 1986 Det. C.L. Rev. 523, 532.

for there appears to be no commentary on the reasons for its inclusion. The rationale, then, would appear to be thus: the mechanism for correcting an underbroad patent is already available to the patentee in the form of a broadening reissue application. The reexamination procedure therefore need not provide a redundant feature. Indeed, the purpose of reexamination is not to correct errors in patents, but rather to provide a reassessment of existing claims in light of newly discovered prior art or new interpretations of “old” prior art.⁴⁵ The patentee in reexamination, unlike in litigation, is afforded the privilege of narrowing the patented claims to overcome new prior art rejections,⁴⁶ and claim broadening is inconsistent with this purpose, because overcoming a prior art rejection can never require claim broadening.⁴⁷

Regardless of the reason, reexamination thus shares a statutory proscription against broadening with reissue applications filed outside the two-year limit. Recognizing this

⁴⁵ *In re Freeman*, 30 F.3d 1459, 1468, 31 U.S.P.Q.2d 1444, 1451 (Fed. Cir. 1994) (“However, the ability of a patentee to amend claims during reexamination must be seen in light of the fundamental purpose of reexamination--the determination of validity in light of a substantial new question of patentability. Thus, amendment of claims during reexamination is limited to amendment in light of prior art raising a substantial new question of patentability.”) (citing *In re Yamamoto*, 740 F.2d 1569, 1572, 222 U.S.P.Q. 934, 937 (Fed. Cir. 1984)).

⁴⁶ *In re Etter*, 756 F.2d 852, 857, 225 U.S.P.Q. 1, 4 (Fed. Cir. 1985) (“That a patentee may... amend his claims under reexamination, 35 U.S.C. § 305, further distinguish[es] reexamination from litigation.”).

⁴⁷ *In re Freeman*, 30 F.3d at 1468, 31 U.S.P.Q.2d at 1451.

similarity, the Federal Circuit applies the same standards of broadening in both contexts.⁴⁸

IV. The “Per se” Proscription Against New Claim Categories - Conflict Between the Board of Patent Appeals and Interferences and the Federal Circuit

Within the rigid confines of the statutory bright lines, however, the policy of public protection must be remembered. The *reason* that broadened claims are not permitted is that the public may be harmed by making use of disclosed but unclaimed subject matter in a patent that, years later, is suddenly broadened to cover the unclaimed material.⁴⁹ Courts should keep this policy in mind when defining the contours of broadening.

The Board has failed to do just that. As will be shown, it has developed a rule that restricts broadening more than is necessary for the public interest championed in *Miller*, its progeny, and in the legislative history of the 1952 Patent Act. Specifically, the Board has twice held that new claim categories

⁴⁸ *Anderson v. International Eng'g & Mfg.*, 160 F.3d 1345, 1349, 48 U.S.P.Q.2d 1631, 1634 (Fed. Cir. 1998) (“In determining whether the scope of a claim has been enlarged, the reexamination practice has shared the body of precedent developed for reissue determinations.”)

⁴⁹ Continuation and division applications may issue years after an initial patent and may contain claims drawn to previously unclaimed subject matter. However, the public has notice of the existence of continuation applications (37 C.F.R. § 1.14(a)(2)(iv) (“The information that may be communicated to the public... includes:...[w]hether another application claims the benefit of the application... under 35 U.S.C....120 [or] 121”)) and so is not taken by surprise when broadened claims subsequently issue.

(specifically, method claims) added during reexamination are impermissibly broadening *per se* when the patent originally issued with only product claims. The Board's position, however, is contrary to Federal Circuit precedent, and may therefore be vulnerable to reversal.

A. The Federal Circuit Standard for "Broadening"

The Federal Circuit's oft-stated standard for broadening is as follows: "A claim of a reissue application is broader in scope than the original claims if it contains within its scope any conceivable apparatus or process which would not have infringed the original patent... A reissue claim that is broader in any respect is considered to be broader than the original claims even though it may be narrower in other respects."⁵⁰ The same broadening test is applied to claims in reexamination.⁵¹

B. The Board's Position on New Claim Categories in Reexamination

The Board has held that a new category of claim constitutes a broadening of the invention when it is presented during reexamination of a patent that issued without claims of that category.⁵² In *Ex parte Wikdahl*, the owner of U.S. Patent No. 3,613,887 presented a method claim during reexamination of a patent. The issued patent had claims directed to a cyclone separator apparatus, including claim 6,⁵³ but

no method claims. The new method claim (claim 7)⁵⁴ included the step "using the cyclone separator according to claim 6" where claim 6 was an independent apparatus claim. The Examiner rejected all of the claims in reexamination over prior art. On appeal, the Board affirmed some of the prior art rejections, reversed others, and imposed a new ground of rejection for the new method claim under 35 U.S.C. § 305 as impermissibly broadening the scope of the patent's claims. The Board held that the method claim added during reexamination impermissibly broadened the claimed invention because "[n]o claims drawn to a method were ever presented during prosecution of, nor issued in, [the patent in reexamination]."⁵⁵ The Board reasoned that the new method claim was "thus *not* directed to 'the invention as claimed' in the 887 patent as required by §305" because there was no record in the patent file history that "appellant ever objectively intended or considered his invention to include method."⁵⁶ (Emphasis in original).

The Board reiterated this view in *Ex parte Logan*.⁵⁷ The patent in *Logan*, number

⁵⁰ *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d at 1037, 4 U.S.P.Q.2d at 1453 n.2.

⁵¹ *Anderson v. International Eng'g & Mfg.*, 160 F.3d at 1349, 48 U.S.P.Q.2d at 1634.

⁵² *Ex parte Wikdahl*, 10 U.S.P.Q.2d at 1549.

⁵³ *Id.* at 1549-60 ("6. A cyclone separator...comprising: a generally conical separation chamber... a vortex finder... and a casing...").

⁵⁴ *Id.* at 1550 ("7. A method for separating material including fibers suspended in a liquid suspension into a light fraction containing the fibers and a heavy fraction containing rejects using the cyclone separator according to claim 6 to prevent the twisting together of fibers in the light fraction and to recover pressure energy.").

⁵⁵ *Id.* at 1549.

⁵⁶ *Id.*

⁵⁷ *Ex parte Logan*, 38 U.S.P.Q.2d at 1854-55. This case was not selected for publication by the Board of Patent Appeals and Interferences but was nevertheless published in *U.S. Patents Quarterly*. The case is treated here due to its relevance and the dearth of case law on the topic.

5,030,472, concerned arrangement of sliced meat in a single spiral. The issued claims, 1-4, were all directed to boneless sliced meats.⁵⁸ The patentee sought to add claims directed to methods of slicing a boneless meat during the reexamination.⁵⁹ Claims directed to such methods had been presented in an abandoned parent application of the '472 patent.⁶⁰ The examiner rejected the method claims under 35 U.S.C. § 305, citing *Ex parte Wikdahl*. The patentee tried to distinguish *Wikdahl* on the ground that the presentation of method claims during prosecution showed that he had "objectively intended or considered his invention to include a method of the type defined by [the] appealed claims."⁶¹ The Board affirmed the Examiner and clarified that the "new category" test is simply whether claims of the new category were issued in the patent undergoing reexamination; the question

⁵⁸ *Id.* at 1853. Claim 1 is representative: "1. A boneless sliced meat having its meat arranged in the form of a continuous spiral cut about an axis of the meat, the axis being created by the temporary insertion of a support member in the meat." *Id.*

⁵⁹ *Id.* Claim 11 is representative: "11. A method of slicing a boneless meat product comprising: inserting a temporary support member through the meat product, rotating the meat product around the axis of the support member, moving a blade into the meat product adjacent one end of the support member, with the blade lying in a plane substantially perpendicular to the longitudinal axis of the support member, moving the blade along an axis parallel to the axis of rotation of the support member to produce a spiral cut in the meat, limiting the depth of the cut to leave a central annular core of uncut meat around the support member, and, after slicing, removing the temporary support member." *Id.*

⁶⁰ *Id.* at 1854.

⁶¹ *Id.*

of whether claims of the new category were ever prosecuted is irrelevant, and reference to the patent file history is unnecessary: "From our perspective, the § 305 rejection in *Wikdahl* was considered to be proper based upon the earlier finding that no claims drawn to a method were issued in the patent there being reexamined. In this context, the subsequent reference to the *Wikdahl* patent file record was dicta."⁶² Thus, under *Wikdahl* and *Logan*, it would seem that a new class of claims cannot be presented in reexamination if it was not among the issued claims.

V. Proposal for Resolution of Conflict

The *Wikdahl/Logan* test should be discarded as overly restrictive because it excludes claims that would otherwise pass the Federal Circuit's test for broadened claims (henceforth referred to as the "infringement" test).

For example, a new method claim depending from, or otherwise including all the limitations of, an issued apparatus claim would pass the Federal Circuit's "infringement" test (i.e., claim is not broadening) but would fail the *Wikdahl* test (i.e., claim is broadening). The Federal Circuit would find this claim acceptable because it does not expose anyone to infringement who would not have already been on notice from the original claims. The Board, in contrast, would interpret the new method claim to cover something that an issued apparatus claim does not. This view is mistaken.

The true effect of a claim is in what it proscribes. An issued and enforceable apparatus claim confers on the patent owner the right to proscribe others from *inter alia*

⁶² *Id.* at 1854-55.

making, *using*, or selling the apparatus.⁶³ The new method claim, in proscribing a use of the claimed apparatus, would therefore not cover anything that the issued apparatus claim does not already. Indeed, a new dependent method claim would be a narrowing claim, not a broadening claim, because the apparatus claim already proscribes *any* use, whereas the new method claim would proscribe only a *particular* use. In extreme situations, in fact, a reexamination participant or reissue applicant might be unable to overcome rejections of the apparatus claims and would find it necessary to pursue “method of use” or “method of manufacture” claims to retain any patent protection at all. Even this strategy, by all measures a surrender of claim scope, would be barred by the Board’s policy.⁶⁴

Moreover, the Board’s position also runs counter to the nature of a “useful”⁶⁵ invention. For an invention to meet the usefulness requirement, it must have some use. That is, the invention must provide some identifiable

benefit.⁶⁶ When applied to an apparatus, the term “useful” means that the apparatus “will accomplish the purpose practically when applied in industry. It is to be given a practical and not a speculative meaning. It means that the machine will work and accomplish the purposes set forth in the specification.”⁶⁷ Thus, a useful apparatus invention necessarily includes a method of using the apparatus. The method of use is part-and-parcel of the invention, not separate and distinct.

A product invention casts light in several directions: it is *multifaceted*. One facet is the product itself. Another is the act accomplished by using the product. Another is the process by which the product is made. These facets correspond to statutory classes set forth in 35 U.S.C. 101.⁶⁸ Each facet, considered alone, is an incomplete characterization of a useful invention, just as a single photograph provides an incomplete visualization of a three-dimensional object. Accordingly, U.S. patent law offers no barrier to a patent applicant who wishes to obtain claims drafted in each statutory class relevant to the invention.⁶⁹

⁶³ 35 U.S.C. § 154(a)(1) (2000); 35 U.S.C. § 271(a) (2000).

⁶⁴ The Board’s policy also runs counter to the Federal Circuit’s desire to avoid *per se* rules. The Federal Circuit has sharply criticized the Board for its tendency to craft *per se* rules where a more fact-specific analysis is appropriate. *In re Ochiai*, 71 F.3d 1565, 1572, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995) (criticizing Board’s having generalized into a *per se* rule a particular obviousness determination in an earlier Federal Circuit opinion). The Board itself has noted this tendency as well. *Ex parte Eggert*, 67 U.S.P.Q.2d 1716, 1727 (B.P.A.I. 2003) (“We are also reminded, however, that the USPTO has been admonished for trying to extract *per se* rules from generalized commentary found in cases.” (citing *In re Ochiai*)).

⁶⁵ 35 U.S.C. § 101 (2000).

⁶⁶ *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1366, 51 U.S.P.Q.2d 1700, 1702 (Fed. Cir. 1999) (“The threshold of utility is not high: An invention is “useful” under section 101 if it is capable of providing some identifiable benefit.”) (citations omitted).

⁶⁷ *Lorenz v. Berklinc Corp.*, 215 F.Supp. 869, 880, 137 U.S.P.Q. 29, 37 (D.Ill. 1963).

⁶⁸ 35 U.S.C. § 101 (2000) (“process, machine, manufacture, or composition of matter”).

⁶⁹ However, the Patent Office may restrict a patent application to apparatus or method of use claims if it can be shown that those claims are drawn to independent and distinct inventions. The Office may require the applicant to elect one invention for examination. Claims drawn to the unelected invention(s) may be pursued in one or more

Indeed, an applicant must include “one or more claims particularly pointing out and distinctly claiming the subject matter *which the applicant regards as his invention*” (emphasis added).⁷⁰ This language has been interpreted to grant the applicant broad latitude in crafting the legal description of his or her invention.⁷¹

Courts recognize that inventions are multifaceted, so they focus their inquiries on the substance of the claims at issue, rather than the particular form they take. The U.S. Court of Customs and Patent Appeals (“C.C.P.A.”) in 1973 declared a broad policy of granting method claims alongside corresponding non-method claims,⁷² a policy that the Federal Circuit has preserved.⁷³ Writing for the C.C.P.A., Judge Giles S. Rich held that the

divisional applications. 35 U.S.C. § 121. Claims relating to a method and to an apparatus for its practice are distinct if the method as claimed can be practiced by another materially different apparatus or by hand, and/or the apparatus as claimed can be used to practice another and materially different method. MANUAL OF PATENT EXAMINING PROCEDURE § 806.05(e) (8th ed., rev. 1. 2003).

⁷⁰ 35 U.S.C. § 112, ¶ 2 (2000).

⁷¹ *In re Duva*, 387 F.2d 402, 406, 156 U.S.P.Q. 90, 93 (C.C.P.A. 1967) (“The breadth of the language employed in section 112 suggests that Congress intended that applicants be given a considerable range of choice in claim form and claim language so long as the form chosen and the language employed meet the requirement expressly stated therein that the claims particularly point out and distinctly claim the subject matter which the applicant regards as his invention.”).

⁷² *In re Kuehl*, 475 F.2d 658, 666-67, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

⁷³ *In re Ochiai*, 71 F.3d at 1571, 37 U.S.P.Q.2d at 1132-33; *In re Pleuddemann*, 910 F.2d 823, 827-28, 15 U.S.P.Q.2d 1738, 1741 (Fed. Cir. 1990).

inventor of a chemical composition was entitled to composition claims as well as process-of-use claims, because this would encourage the fullest disclosure possible.⁷⁴ He recognized that the composition and method claims were merely different ways of claiming the invention:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112, all aspects of what they regard as their inventions, regardless of the number of statutory classes involved. The dependent claims on appeal to the use of the new [composition] in the same application with the composition claims *do not materially increase the scope of protection* of his inchoate patent property under 35 U.S.C. § 154, which already includes the right to exclude others from making, *using*, or selling the composition by allowance of claims thereon, but they do tend to increase the wealth of technical knowledge disclosed in the patent by encouraging description of the use aspects of his invention in the manner required by 35 U.S.C. § 112, paragraph 1.⁷⁵

“The result,” Judge Rich wrote, “is to encourage a more detailed disclosure of the specific methods of using the novel

⁷⁴ *In re Kuehl*, 475 F.2d at 666, 177 U.S.P.Q. at 256.

⁷⁵ *Id.* at 666-67, 177 U.S.P.Q. at 256 (first emphasis added).

composition he has invented in order to have support for the process claims.”⁷⁶

In the infringement context as well, claims reach across the statutory classes to proscribe behavior. As noted above, product claims exclude not just articles of manufacture, but also methods of making them and methods of using them.⁷⁷ Analogously, the creation or possession of an apparatus may indirectly infringe a method-of-use claim under theories of inducement to infringe⁷⁸ and contributory infringement.⁷⁹

The Board’s restrictive, needlessly technical view imperils patents by denying certain narrowing amendments and flatly runs counter to the long tradition of protecting the public from “discovered” rights.

Moreover, The U.S. Patent and Trademark Office’s Office of Patent Legal Administration recently recognized that the addition of method claims in a reissue application that issued with only product claims is generally

not broadening.⁸⁰ Until 2004, the Office’s Manual of Patent Examining Procedure advised examiners: “The addition of process claims as a new category of invention to be claimed in the patent (i.e., where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex parte Wikdahl...*”⁸¹ Broadening reissue applicants and reexamination participants were thus routinely denied claim scope to which they should be entitled under Federal Circuit precedent.⁸² In the May 2004 revision of the Manual, however, the Office made an about-face change in policy, noting (emphasis in original):

A situation may arise, however, where the reissue application adds a limitation (or limitations) to process A of making the product A claimed in the original patent claims. For example:

(1) a process of using the product A (made by the process of the original patent) to make a product B, disclosed but not claimed in the original patent; or

⁷⁶ *Id.* at 666, 177 U.S.P.Q. at 256.

⁷⁷ See *supra* note 57 and accompanying text.

⁷⁸ 35 U.S.C. § 271(b) (2000) (“Whoever actively induces infringement of a patent shall be liable as an infringer.”).

⁷⁹ 35 U.S.C. § 271(c) (2000) (“Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.”).

⁸⁰ United States Patent and Trademark Office, MANUAL OF PATENT EXAMINING PROCEDURE § 1412.03 (8th ed., rev. 2. 2004).

⁸¹ United States Patent and Trademark Office, MANUAL OF PATENT EXAMINING PROCEDURE § 1412.03 (8th ed., rev. 1. 2003).

⁸² Arguably, though, it may be said that the Board’s policy promotes efficiency by encouraging applicants to seek the broadest and most multifaceted coverage possible during the initial examination.

(2) a process of using the product A to carry out a process B disclosed but not claimed in the original patent.

Although this amendment of the claims adds a method of making product B or adds a method of using product A, this is not broadening (i.e., this is not an enlargement of the scope of the original patent) because the "newly claimed invention" contains all the limitations of the original patent claim(s).⁸³

The Office's change in policy leaves examining procedure in a precarious situation, because Office policy, while consistent with Federal Circuit precedent, nevertheless conflicts with Board precedent. The Manual of Patent Examining Procedure does not have the force of law or rule,⁸⁴ so patent examiners remain bound to follow the Board's holding in *Ex parte Wikdahl*.

This is not to say that a new claim category must always be tolerated. For example, a situation reverse of above, in which apparatus claims are added to a method patent, would probably not pass the Federal Circuit's test, because the new apparatus claims would proscribe any use, not just the uses claimed in the original patent. The apparatus claim would thereby be considered broadening and properly rejected. The present proposal is limited to situations in which claims of the

new category would not proscribe anything not already proscribed by the issued claims.

VI. Conclusion

Post-issuance mechanisms for patent modification allow for claim broadening in specific, statutorily-defined circumstances. Broadening is circumscribed for the purpose of protecting the public from inadvertent infringement where an original patent discloses but does not claim some subject matter. In recognition of this policy, the Federal Circuit's test for broadening focuses on infringement: a claim is broader than the original claim if it would be infringed by something that would not infringe the original, or if it is broadened in any dimension, even if narrowed in others. The Board of Patent Appeals and Interferences has grafted its own, more restrictive test on broadening claims by proscribing *per se* categories of claims not included in the original patent. This test breaks from the policy of public protection and strips patentees (perhaps unwittingly) of an important technique for narrowing the scope of an unpatentable apparatus claim. The Board's test should therefore be discarded in favor of the public policy emphatically expressed in the Federal Circuit's decades-old precedent.

⁸³ United States Patent and Trademark Office, MANUAL OF PATENT EXAMINING PROCEDURE § 1412.03 (8th ed., rev. 2 2004). The Office has retained this policy in the August 2005 revision of the Manual. United States Patent and Trademark Office, MANUAL OF PATENT EXAMINING PROCEDURE § 1412.03 (8th ed., rev. 3 2005).

⁸⁴ *Id.*, Foreword.