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BSKB Files Appeal to Federal Circuit on USPTO Decision Limiting Patent Reissue Rights

Falls Church, VA & San Diego, CA -- February 23, 2010 – Birch, Stewart, Kolasch & Birch, LLP (BSKB) announced today that it has filed an appeal to the Federal Circuit on behalf of Koyo Seiko Co. Ltd, based on the recent Tanaka decision (*Ex Parte Tanaka*; Appeal No. 2009 – 000234, BPAI 12/11/09). The outcome of this ruling could impact the right of any patentee to seek reissue of a patent and reflect on the validity of many patents already reissued. Additionally, the decision may impact upon the ability of patentees to add claims by reissue for the purpose of invoking an interference with another patent.

On December 11, 2009 the USPTO Board of Patent Appeals and Interferences issued a decision in the matter of *Ex Parte Tanaka*, who sought reissue of his patent under 35 U.S.C. §251 on the basis that the patent was inoperative because he had claimed more or less than he had a right to claim in the original patent. Tanaka sought to add a dependent claim to the patent but did not cancel or modify the original independent claim. The reissue application was rejected on the basis that the matter was not one that could be addressed under Section 251.

In this precedential decision the USPTO Board overruled its own prior decisions and held that, “The presentation of a narrower claim in a reissue application that still contains all of the original claims does not present the type of error correctible by reissue under 35 U.S.C. §251.”

Charles Gorenstein, partner at BSKB stated, “The decision improperly limits the rights of patentees to seek reissue.” He added, “Beyond that, it calls into question any number of patents already reissued under long-standing law and practice of the Court of Appeals for the Federal Circuit and of the Board itself.”

The decision in *Ex Parte Tanaka* raises issues that are highly technical and complex. BSKB is one of a handful of firms in the U.S. with a practice group dedicated to patent reexaminations and reissues.

About BSKB

Founded in 1976, BSKB is an internationally recognized intellectual property law firm with offices in Falls Church, VA and San Diego, CA. The firm has a full service intellectual property practice including litigation, patent interference, patent re-examination, patent prosecution and copyright and trademark services. For more information, see the firm’s website at www.bskb.com

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