



STAKE YOUR (LINKING) CLAIM: ASSESSING THE IMPACT OF *IN RE DOYLE*
ON PATENT REISSUE

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ABSTRACT

A common problem encountered during patent prosecution is a restriction requirement. According to *In re Doyle*, the failure to assert linking claims that read on non-elected claims is an error correctable by reissue. This paper argues that the Doyle court was correct in holding that Doyle was distinguishable from *In re Orita*. Allowance of genus claims that link previously non-elected claims comports with the patent statute. As the public is on notice that patent claims may be broadened within two years, the Doyle holding ensures that the patentee is given the full breadth of protection necessary to “promote the Progress of Science and the useful Arts.” Patentees are advised to review patents issued in the last two years where the patent application was subject to a restriction requirement and a divisional application was not filed. A reissue may be granted for genus claims that would cover some of the originally non-elected claims.

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STAKE YOUR (LINKING) CLAIM: ASSESSING THE IMPACT OF *IN RE DOYLE* ON PATENT REISSUE

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[T]he public knows, or should know, that an issued patent can be broadened by reissue during a two-year period following issuance. The public is therefore on notice that at least some matter can be ‘dedicated to the public’ in error, and that the error, if caught in time, can be corrected by reissue.¹

INTRODUCTION

In a top-secret, private laboratory operating under a clever guise of a law school journal office, a scientist discovers some compounds.² In filling out her application for a patent, she writes out a specification and broad claims for the compounds covering four species:³ c1, c2, c3, and c4. The examiner for the United States Patent and Trademark Office (“PTO”) subjects the claims to a restriction requirement: Group I of “protein compounds” must include c1 and c2 and Group II of “organic compounds” must include c3 and c4. The inventor amends her claim to elect only Group I and cancels c3 and c4. The patent for Group I issues but the inventor declines to file a divisional application. Later, without doing anything else, will she be able to get a broadening reissue for claims that link the subject matter from the issued patent and the non-elected claims?

The short answer, according to *In re Doyle*⁴, is yes because a failure to assert linking claims that read on non-elected claims is an error correctable by reissue.⁵ The complexity of the patent laws dealing with making corrections to a patent after it has been properly granted is four-fold: the patentee must consider prior art, the scope of the claims in the original patent granted, the error itself and whether it is a

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¹ *In re Doyle*, 293 F.3d 1355, 1364 (Fed. Cir. 2002)

² The idea for this hypothetical was derived from an article written by Linda E. Alcorn and Teresa U. Medler, *The Johnson & Johnson Case, Part II: Arguing Against ‘Dedicated to the Public,’* 8 No. 9 INTELL. PROP. STRATEGIST 6 (June 2002).

³ See DONALD S. CHISUM, CHISUM ON PATENTS, § 12.03[3] (2002) (describing the genus-species relationship as it applies to restriction requirements). In patent law, “genus” claims are broad claims encompassing a multiple embodiments of the invention. *Id.* In contrast, “species” claims are narrower claims, generally a singular embodiment of a variable. *Id.*

⁴ 293 F.3d 1355 (Fed. Cir. 2002).

⁵ See 35 U.S.C. § 251 (2000). Reissues are granted where the issued patent is “wholly or partially inoperative or invalid . . .” *Id.* Furthermore, note that if the rejection of the claims in the original patent had been due to prior art rather than a restriction requirement, the “recapture rule” would apply, and the patentee would be barred from reissuing the non-elected claims after deliberately surrendering them during prosecution in order to obtain her patent. See U.S. Patent and Trademark Office, *Manual of Patent Examining Procedure* § 1412.02 (8th ed., 2001) (hereinafter “MPEP”).

“fixable” error, and the post-issue method of correction that is best suited to correct the error.

In *Doyle*, the Federal Circuit allowed a reissue with broadening genus claims that linked prior non-elected species claims.⁶ This article analyzes the Federal Circuit’s decision in *Doyle* and offers suggestions on how to ameliorate the reissue process. Part I traces the history of reissue in the Patent Act and the case law leading up to *Doyle*. Part II analyzes *Doyle* and considers the impact of the *Doyle* decision on the future of patent law. Part III proposes several statutory changes in light of issues raised by *Doyle* and in conjunction with policy arguments that have been made by the legal community in the past few decades.

I. BACKGROUND

A. Issue as a Post-Grant Revision of a Patent

The Constitution gives Congress the power to enact laws related to patents.⁷ Patent applications are reviewed and examined by the PTO to ensure the requirements of Title 35 of the United States Code are met, and patents are granted to those inventions that, among other requirements, are “useful,”⁸ novel,⁹ and non-obvious¹⁰ with respect to prior art.¹¹ For each patent application, the patentee provides a written description¹² of the invention in what is known as the “specification,” concluding with “one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.”¹³

Despite numerous checks and balances, errors in the application may still find their way into issued patents. Four types of post-grant revisions of patents are

⁶ See *Doyle*, 293 F.3d at 1358-59.

⁷ See U.S. CONST. art. I, § 8, cl. 8 (“The Congress shall have the Power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”).

⁸ 35 U.S.C. § 101 (2000). As part of the limitation on the congressional purpose of enacting patent laws, the Patent Act thus echos the phrase “useful Arts” in the Constitution. U.S. CONST. art. I, § 8, cl. 8.

⁹ 35 U.S.C. § 102 (2000).

¹⁰ 35 U.S.C. § 103 (2000).

¹¹ 35 U.S.C. § 131 (2000) (“The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor”).

¹² 35 U.S.C. § 112 (2000).

The specification shall contain a written description of the invention, and of the manner and process for making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Id.

¹³ *Id.*

available to patent holders: disclaimer,¹⁴ certificate of correction,¹⁵ reexamination,¹⁶ and reissue.¹⁷ This comment focuses on the last method, reissue.

Patent reissues are largely controlled by Sections 251¹⁸ and 252¹⁹ of the Patent Act. For a fee, and on the surrender of the original patent, the Director of the PTO may reissue a patent for the unexpired time from the original patent if the original patent is “wholly or partly inoperative or invalid, due to 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....”²⁰ However, the application for reissue must not be based on an error “made with deceptive intention,” as a reissued patent will not be granted even if the patent is deemed inoperative or invalid where fraud is involved.²¹ Upon a reissue grant, the patent holder will again have the right to exclude all others from practicing the same invention for the rest of the valid term.²²

B. The Development of Reissue in The Patent Act

i. History of Reissue

While no statutory provisions existed in the eighteenth century to permit corrections to issued patents,²³ in 1825, the Secretary of State issued a new patent to Joseph Grant for the rest of the original patent’s term when he surrendered his original patent due to its “defective specification.”²⁴ The Supreme Court would uphold the patent reissue in *Grant v. Raymond*.²⁵ Later, the Patent Acts of 1832,²⁶

¹⁴ 35 U.S.C. § 253 (2000) (explaining that a substantive disclaimer cancels invalid claims of the original patent while a terminal disclaimer allows the remaining term of a patent to be disclaimed or dedicated to the public so that public is no longer excluded from the manufacture, use or sale of the invention).

¹⁵ Patentees may use certificates of correction to make changes under 35 U.S.C. § 254 (2000), for PTO errors, 35 U.S.C. § 255 (2000), for clerical or typographical errors, and 35 U.S.C. § 256 (2000), for errors in who is named an inventor.

¹⁶ See 35 U.S.C. §§ 301-07 (2000). For a critical look at the reexamination system, see Mark D. Janis, *Rethinking Reexamination: Toward a Viable Administrative Revocation System for U.S. Patent Law*, 11 HARV. J.L. & TECH. 1 (1997).

¹⁷ In addition to correcting claims or disclosures, reissues may also be used to claim an earlier priority date based on a co-pending United States application or a foreign application. See *MPEP*, *supra* note 5, § 1402.

¹⁸ 35 U.S.C. § 251 (2000).

¹⁹ 35 U.S.C. § 252 (2000).

²⁰ 35 U.S.C. § 251 ¶ 1.

²¹ *Id.*

²² 35 U.S.C. § 251.

²³ See CHISUM, *supra* note 3, § 15.02.

²⁴ *Grant v. Raymond*, 31 U.S. (6 Pet.) 218, 222 (1832). The patent was for a “winding machine for setting up hat bodies.” *Id.*

²⁵ *Id.* The court in *Grant* reasoned that “[i]f the mistake should be committed in the department of state, no one would say that it ought not to be corrected Why should not the same step be taken for the same purpose, if the mistake has been innocently committed by the inventor himself?” *Id.* at 242.

²⁶ Act of July 3, 1832, ch. 162, § 3, 4 Stat. 559.

1836,²⁷ and 1870²⁸ codified the authority of patent officials to reissue patents for the same invention when mistakes or inadvertent errors made without fraud were found in issued patents.²⁹ The reissued patent was valid for the rest of the original term.³⁰ It was not until the Act of 1870³¹ that “new matter”³² was expressly barred from reissue applications.

Until *Topliff v. Topliff*³³ was handed down by the Supreme Court in 1892, reissue applications to better clarify or correct the written description were common, but applications to broaden the scope of the original description were rarely successful.³⁴ The main problem associated with broadening issued patents through reissue was the effect of the new patent on the public. The world outside the PTO would have known only of the original patent and, consequently, may have made investments and used resources that did not infringe under the original patent but nonetheless violated the claims of the reissued patent.

ii. Intervening Rights

The courts struggled to reconcile the rights of the patentee and the rights of the public.³⁵ In the 1915 decision *Autopiano Co. v. American Player Action Co.*,³⁶ the Second Circuit broke new ground as the first court³⁷ to protect an accused infringer from the effects of a reissued patent.³⁸ Ultimately, in *Sontag Chain Stores v. National Nut Co. of Cal.*,³⁹ the Supreme Court held that an alleged infringer who is

²⁷ Act of July 4, 1836, ch. 162.

²⁸ Act of July 8, 1870, ch. 230, § 53, 16 Stat. 198.

²⁹ See CHISUM, *supra* note 3, § 15.02.

³⁰ *Id.*

³¹ See Act of July 8, 1870, *supra* note 28, at 198.

³² CHISUM, *supra* note 3, § 15.02. “New matter” is a term of art and a historical limitation in patent reissue applications that is still present in statutory law today. *Id.* New substantive matter that would belong in a separate patent application should not be included in a reissue application. *Id.*

³³ 145 U.S. 156 (1892).

³⁴ *Id.* at 171 (discussing the right of the patentee to get a reissue); see also CHISUM, *supra* note 3, § 15.02[5].

³⁵ For a discussion of “fairness” in the way Congress wrote the Patent Act and how the Courts construe patent law, see Georgia E. Kralovic, *The Principle of Fair Notice: Is It Prudent Guidance For the Future of Patent Law?*, 26 PEPP. L. REV. 89 (1999).

³⁶ 222 F. 276 (2d Cir. 1915).

³⁷ See Paul M. Janicke, *When Patents Are Broadened Midstream: A Compromise Solution to Protect Competitors and Existing Users*, 66 U. CIN. L. REV. 7, 30 (1997).

³⁸ 222 F. 276 (1915). In *Autopiano*, the plaintiff surrendered his original patent for player pianos for a first reissue with narrower claims. *Id.* at 280. After the reissue was granted, he then applied for a second reissue that broadened the claims and effectively returned the patent to its original wording. *Id.* The court held that the defendant, who had manufactured pianos in the interim between the two reissues, was not liable for infringement on estoppel grounds. *Id.* at 282; see also CHISUM, *supra* note 3, § 15.02[6] (discussing intervening rights in the context of the development of reissue patents).

³⁹ 310 U.S. 281 (1940). The decision in *Sontag* settled 25 years of inconsistent holdings that followed *Autopiano*, but left unresolved was the reasoning for the award of intervening rights. See Janicke, *supra* note 37, at 33. At the present time, the rights under reissue as found under 35 U.S.C. § 252 (2001) also apply to reexamination situations. See *MPEP*, *supra* note 5, § 2293 (2001).

unaware of the original patent and uses a machine after the original patent has issued, but before the reissue application for a broader claim is filed, has intervening rights⁴⁰ that would bar injunctive relief against a continued use of the invention.

iii. Complicating the Criteria

While the *Sontag Chain Stores* decision provided some guidance, case law still showed a lack of consistency on what type of broadening reissues could be granted. The sole requirement was that applications for broadening reissues must be made within two years of the original patent issue.⁴¹ Two years later, in *U.S. Industrial Chemicals, Inc. v. Carbide Carbon Chemicals Corp.*,⁴² the Supreme Court set forth a more definite test for determining if the broadening reissue was properly granted. The court explained that “[i]t must appear from the face of the instrument that what is covered by the reissue was *intended to have been covered and secured by the original.*”⁴³

An early interpretation of error for the purposes of patent reissue was any “inadvertence, accident, or mistake.”⁴⁴ Although this interpretational standard still

⁴⁰ 35 U.S.C. § 251 (2000). *See generally*, P. J. Federico, *Intervening Rights in Patent Reissues*, 30 GEO. WASH. L. REV. 603-637 (1962). For a more recent perspective on how reissue procedure might be changed so that the doctrine of equivalents would be abolished, and equitable intervening rights would be strongly promoted, see Jonathan A. Platt, *Protecting Reliance on the Patent System: The Economics and Equities of Intervening Rights*, 47 CASE W. RES. L. REV. 1031 (1997). Platt offers three possible remedies to the competitor of a reissued patent holder: (1) allowance of limited post-issue infringement after reissue; (2) a right to royalty-free future infringement; and (3) forced licensing of the patent. *Id.* at 1069-73.

⁴¹ *See* Janicke, *supra* note 37, at 33 (citing *Sontag*, 310 U.S. at 283-84 and cases therein). The two-year statute of limitation was later codified in 35 U.S.C. § 251 ¶ 4(2000).

⁴² 315 U.S. 668 (1942).

⁴³ *Id.* at 676 (emphasis added) (elaborating on the “same invention” requirements from *Parker & Whipple Co. v. Yale Clock Co.*, 123 U.S. 87, 99 (1887)); *see also* *Flower v. Detroit*, 127 U.S. 563, 571 (1888). *See generally* CHISUM, *supra* note 3, § 15.02[8][d] (discussing the history of the “same invention” requirement). It may appear that “face value” is a valued aspect of claim drafting; a contradictory point of note lies in the doctrine of equivalents where one can show infringement if the accused infringing device is substantially similar to the claim. Although the Supreme Court held in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 25 (1997), that the doctrine of equivalents was valid and rejected the argument that it contravenes the reissue process, the Supreme Court greatly limited the effects of the doctrine of equivalents in *Festo Corp v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002). Thus, Federal Circuit Judge Helen Nies’ dissent in *Warner-Jenkinson*, where she remarked that “[t]he patentee is much better off evading the reissue procedure which Congress has provided, and resorting to its counterpart, the doctrine of equivalents, created out of the judiciary’s sense of ‘fairness’[]”, *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1560 (1995), no longer is as persuasive as it was at the time.

⁴⁴ The exception of “deceptive” intention was also paired with “fraudulent” intention in section 64 of former Title 35 and is well established by case law. *See* R.S. § 4916; Act of May 24, 1928, ch. 730, 45 Stat. 732; *see also In re Orita*, 550 F.2d 1277, 1280 n. 6 (C.C.P.A. 1977) (demonstrating that cases continue to follow the historical equitable estoppel principles, citing *In re Cornell*, 150 F.2d 702 (Ct. Cust. App. 1945), and *In re Smyser*, 135 F.2d 747 (Ct. Cust. App. 1943)); *In re Wesseler*, 367 F.2d 838, 834, (C.C.P.A. 1966) (explaining that “Congress did not intend to alter the test of ‘inadvertence, accident, or mistake’ established in relation to the pre-1952 [Patent Act] rules”).

remains in court decisions, the wording is not found in the current statutes, and only “deceptive intentions” remain.⁴⁵

C. The Supreme Court and Federal Circuit Decisions Before *In re Doyle*

In the early decades of patent drafting, the courts used claims solely for determining novelty.⁴⁶ During the nineteenth century, however, claims evolved into the basis of determining infringement.⁴⁷ Two years before the 1952 Patent Act, the Supreme Court in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*⁴⁸ quite succinctly stated that “[i]f accused matter falls clearly within the claim, infringement is made out and that is the end of it.”⁴⁹

While the claims determine the scope of the invention, this does not resolve the matter. Both the courts and Congress recognized that the careful drafting of claims might nonetheless result in errors in the final issued patent;⁵⁰ thus, certain errors made in the claims could be corrected through reissue.⁵¹ However, the United States Court of Customs and Patent Appeals (“CCPA”) denied the patent reissue applicants this option in *In re Orita*.⁵²

⁴⁵ See 35 U.S.C. § 251 (2000). For an inoperative or invalid patent to qualify for reissue, the error at issue must not have been made with “deceptive intention.” *Id.* The *MPEP*, *supra* note 5, § 1448 (emphasis added), explains that while there is an “[e]xamining” of whether there is a lack of deceptive intent for reexamination purposes for reissue applications at the PTO, there is no actual “investigation of fraud, inequitable conduct, or duty of disclosure issues.” Rather, the applicant’s statement of lack of deceptive intent in the reissue oath as required by 37 C.F.R. § 1.175 (1997) is taken as dispositive. *Id.* The exceptions that may lead to an investigation include “an admission or judicial determination of fraud, inequitable conduct, or violation of the duty of disclosure.” *Id.*

⁴⁶ Janicke, *supra* note 37, at 39 n.126, (citing Karl B. Lutz, *Evolution of the Claims of U.S. Patents*, 20 J. PAT. & TRADEMARK OFF. SOC’Y 134, 147, 488 (1938)).

⁴⁷ *Id.*

⁴⁸ 339 U.S. 605, 607 (1950).

⁴⁹ *Id.* at 607.

⁵⁰ See Arnold B. Silverman, *To Err is Human: Patent Reissues and the Doctrine of Intervening Rights*, 48 J. PAT. & TRADEMARK OFF. SOC’Y 696 (1966). Correction of errors is “allowed in the interest of protecting the patentee from inequitable forfeiting rights.” See Platt, *supra* note 40, at 1031 n.4.

⁵¹ See *supra* text accompanying note 16. The PTO made a substantial overhaul of the patent reissue procedure and guidelines in the late 1970s: specifically the PTO sought to “improve the quality and reliability of issued patents.” Janis, *supra* note 16, at 16 (quoting 42 Fed. Reg. 5588 (1977)). The new regulation, known as the Dann Amendments, paved the way for a more user-friendly system. *Id.* at 17-19. For example, reissue application files became open to the public, no-defect re-issues were permissible, and a public protest procedure came into place. *Id.* at 18. Some of the decisions were perhaps too liberal and uncontrolled, however, by 1982 the PTO had eliminated the no-defect reissue procedure and had scaled back on its former open-arm policy for public protesting. *Id.* at 19.

⁵² 550 F.2d 1277 (C.C.P.A. 1977).

In *Orita*, the patent application⁵³ was subjected to a restriction requirement.⁵⁴ Due to their failure to file a divisional application, the applicants tried to apply for a reissue of their patent that would have, in effect, added four claims substantially identical to their non-elected claims.⁵⁵ The applicants explained their error was made without deceptive intent,⁵⁶ but the court found the alleged error was not the type of error reissue was meant to address.⁵⁷ Further, the court found that the copendency requirement of Section 120⁵⁸ was incorporated in Section 121⁵⁹.⁶⁰ The statutes required an applicant who wished to have the benefit of an earlier filing date, despite canceling claims to meet an examiner's restriction requirement, to file a divisional application.⁶¹ To allow a reissue in this particular case would circumvent this copendency requirement.⁶²

The Court of Appeals for the Federal Circuit ("Federal Circuit") echoed the holding in *Orita*⁶³ in their review of *In re Weiler*,⁶⁴ where the applicants failed to timely file a divisional application for the non-elected claims.⁶⁵ There, the Federal

⁵³ The patent included claims 1-4 to compounds and a method for their preparation. *Id.* at 1277. Dependant claims 5-8 included a color-developable coating composition, an emulsion, and a coated sheet, such that these latter claims shared a compound of generic claim 1. *Id.* at 1278. The examiner required that the applicants limit their claims to one invention per application as codified in Section 251 of the Patent Act. *Id.* The applicant's counsel elected claims 1-4 and preserved the right to traverse the examiner's restriction but it was never perfected, thus, the applicants filed an application for reissue. *Id.* at 1278-79.

⁵⁴ See 35 U.S.C. § 251 (2000).

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application.

Id.

⁵⁵ *Id.*

⁵⁶ Pursuant to 37 CFR 1.175(a), the applicants for reissue must file a statement under oath or declaration which includes: "(3) When it is claimed that such patent is inoperative or invalid 'by reason of the patentee claiming more or less than he had a right to claim in the patent,' distinctly specifying the excess or insufficiency in the claims."

⁵⁷ *Orita*, 550 F.2d at 1280.

⁵⁸ See 35 U.S.C. § 120 (2000).

⁵⁹ See 35 U.S.C. § 121 (2000).

⁶⁰ *Orita*, 550 F.2d at 1280-81.

⁶¹ 35 U.S.C. § 121.

⁶² *Orita*, 550 F.2d at 1281. The court was quite unsympathetic to the applicant's arguments, explaining that "[s]ection 251 is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney, and the case at bar exemplifies a mistake which this section cannot cure." *Id.*

⁶³ *Id.* at 1280 (holding acquiescence to an examiner's requirement for restriction is not an error correctable by reissue).

⁶⁴ 790 F.2d 1576 (Fed. Cir. 1986). The original patent application filed contained eleven claims, and the examiner held that there were actually "three independent and distinct inventions." *Id.* at 1578. A section 121 restriction requirement was effected between Claims 1-7 (assay method), Claims 8 and 11 (an "organic compound," and Claims 9 and 10 ("a protein compound")). *Id.*

⁶⁵ *Id.* at 1578-79. Claim 1 was the independent claim and dependant claims 2-7 followed. These claims compromised the original patent, "Method for Quantitative Analysis for Limonin." Claim 1 read:

A method of quantitative analysis of limonin which comprises reacting a known amount of limonin-specific antibodies, with a mixture of a known volume of

Circuit provided a clearer analysis for determining whether a correctable error was present, and required that in the original patent, there must be an “intent to claim”⁶⁶ the matter that the applicant now asserts is the error at the heart of the reissue.⁶⁷ This was the requirement the Board found lacking in the Weiler’s original patent.⁶⁸ Consequently, although “error” is interpreted liberally, no error correctable by reissue was present.⁶⁹ The applicant was wrong to apply for reissue.⁷⁰

Another reissue applicant challenged the Board’s denial of an application in *In re Watkinson*.⁷¹ Watkinson argued that the error in the original patent was her

sample containing an unknown amount of limonin and a known amount of a limonin-derivative labeled with an enzyme or with a radioactive isotope, determining the amount of labeled limonin-derivative which has reacted with said antibodies and calculating therefrom the unknown amount of limonin in said sample.

Id. at 1578.

The two rejected claims in the reissue patent application were claims 13 and 19. *Id.* at 1579. Claim 13 read: “A method for developing citrus fruit strains low in limonin content, which method comprises identifying by the use of limonin-specific antibodies as an analytical reagent the limonin-low mutants in a breeding or cell culture program, and propagating said mutants.” *Id.* at 1578. Claim 19 reads: “A gamma globulin fraction comprising antibodies reactive with limonin, said antibodies being formed consequent to injecting into an animal a limonin-protein conjugate.” *Id.* at 1578-79.

⁶⁶ *See id.* at 1581 (noting that although ‘intent to claim’ does not appear in the statute[,] . . . [i]t is but judicial shorthand, signifying a means of measuring whether the statutorily required *error* is present”); *see also In re Rowand*, 526 F.2d 558, 560 (C.C.P.A.) (explaining that where there is no disclosure of a method for making the tubing in the original patent, there is no intent to claim a method; thus, it is proper to reject a reissue application for a lack of evidence in the original patent showing an intent to claim the subject matter that the applicants now assert to be their invention).

⁶⁷ *Weiler*, 790 F.2d at 1582 (“If it were not error to forego divisional applications on subject matter to which claims had been made in the original application, it cannot on the present record have been error to forego divisional applications on subject matter to which claims had never been made”).

⁶⁸ The Board had found that the subject matter of the claims at issue “was not claimed at all in the original application . . . nothing in the patent evidenced an ‘intent to claim’ that subject matter.” *Id.* at 1580.

⁶⁹ *Id.* at 1582. The court notes in its analysis that the “error” to be corrected by reissue is not a subjective error like “deceptive intention.” *Id.* at 1583 n.4. Weiler argued that he was ignorant of the drafting and claiming requirements while his counsel was ignorant of the invention, which resulted in his failure to claim the subject matter of the claims at issue; however, the court rejected the argument. *Id.* The Federal Circuit held that such allegations may be “frequently made, and if accepted as establishing error, would require the grant of reissues on anything and everything mentioned in a disclosure.” *Id.*

⁷⁰ Moreover, although the Patent Act provides a variety of methods to correct issued patents, the court had to discourage applicants from scrambling for any seemingly “wrongful” action during their reissue application process. The court in *Weiler* suggested that “[i]nsight resulting from hindsight on the part of new counsel does not, in every case, establish error.” *Id.*

⁷¹ 900 F.2d 230 (Fed. Cir. 1990). The Board found that the case was in line with *Orita* in that there was a deliberate choice to file a divisional application and a subsequent failure to file such a divisional. *Id.* at 231. The original application by Watkinson was “directed to compositions for and methods of inhibiting the growth of timber fungus.” *Id.* During prosecution, the examiner subjected the application to a restriction requirement, and Watkinson elected the claims within Group I and cancelled the remaining non-elect claim 38. *Id.* at 230-31. Upon filing an application for reissue of the Group I patent to include claims 36-38 corresponding to the cancelled claim 38, the examiner rejected all the claims for reissue under 35 U.S.C. § 251 (2000) because there was no finding of error. *Id.* at 231 (observing a similar argument in *Orita* for the principle that reissue applicants are

acquiescence to a restriction requirement in the original application.⁷² The court held that there was no error because Watkinson should have “challenged the merits of the restriction requirement in the original application during the prosecution of the original application.”⁷³

Although the CCPA defined the analysis in *Orita*, it was not until *Doyle* that the Federal Circuit actually had a chance to review a lower court’s interpretation of the *Orita* doctrine and thus determine its proper applicability.

II. ANALYSIS

A. *The Original Patent and Procedural History of In re Doyle*

In *Doyle*, the inventor, Dr. Michael Doyle, discovered a genus of chiral transition metal catalysts⁷⁴ and a method involving the use of this genus of catalysts to perform enantioselective reactions.⁷⁵ On September 24, 1992, Dr. Doyle filed a patent application claiming his invention.⁷⁶ The examiner imposed a nine-way restriction requirement on the grounds that the application was attempting to claim nine different inventions,⁷⁷ and consequently, Dr. Doyle elected group VI only.⁷⁸ Group VI consisted of method claims directed towards using the chiral transition metal

estopped from obtaining claims that they could not claim in their original patent because they acquiesced to a requirement for restriction); see *Orita*, 550 F.2d at 1280.

⁷² *Id.*; see also *Weiler*, 790 F.2d at 1576, 1582 (holding that cancelled claims could not be reissued upon no finding of error); *Ball Corp. v. United States*, 729 F.2d 1429, 1435 (Fed. Cir. 1984) (“The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were canceled from the original application”).

⁷³ *Watkinson*, 900 F.2d at 233. The court could not have undergone the review of the examiner’s restriction requirement that Watkinson demanded because “neither this court nor the board has jurisdiction in this proceeding to review the merits of a requirement for restriction under Section 121, as a restriction requirement is a matter within the discretion of the examiner and not tantamount to a rejection of claims.” *Id.* The court in *Watkinson* admonished the applicant’s attempt to file an application for a patent reissue when the proper procedure would have been to challenge the restriction immediately. *Id.*

⁷⁴ Chiral molecules have one or more chiral centers, which are centers to which different chemical groups may attach to form different compounds. *Id.* The relative arrangements of the molecular structure are known as stereoisomers. *Id.* at 1356 n.1. A chiral molecule has a mirror image structure, its enantiomer, such that the two structures cannot be superimposed and have different properties. *Id.* at 1356. Scientists requiring only one structure would have to find some way to manufacture the sole variation of the molecule desired, or alternatively, attain a mixture of the enantiomers with the preferential result that the desired structure makes up a significantly large percentage of the mix with only a few isolated molecules of other disfavored structures. *Id.* In pharmaceutical chemistry, enantioselective reactions have this precise function of producing a heightened quantity of only one structure of a target compound selected for its specific pharmacological properties. *Id.*

⁷⁵ *Id.*

⁷⁶ U.S. Patent No. 5,296,595 (issued March 22, 1994).

⁷⁷ *Doyle*, 293 F.3d at 1356.

⁷⁸ *Id.*

catalysts to insert carbenes⁷⁹ into carbon-hydrogen, oxygen-hydrogen, nitrogen-hydrogen, and silicon-hydrogen bonds.⁸⁰ The other claims in the initial patent applications were cancelled.⁸¹ No divisional applications were filed and the patent, U.S. Patent No. 5,296,595, issued on March 22, 1994.⁸²

Nearly two years later, on February 14, 1996, Dr. Doyle sought to broaden his patent and filed a request for reissue.⁸³ The proposed reissue genus claims covered the reaction of his catalysts with a genus of prochiral molecules.⁸⁴ This change would effectively include the already claimed reactions of the catalysts with the insertion of carbenes and “read on”⁸⁵ the claims of the non-elected Groups VII-IX.⁸⁶ The

⁷⁹ See *id.* at 1356 n.3 (“A carbene is a CR₂ fragment, where R represents a group bonded to the carbon atom.”).

⁸⁰ *Id.* at 1356.

⁸¹ *Id.* At this stage of the prosecution history, a patentee has the option to file divisional applications for the remaining non-elected claims, but here, Dr. Doyle did not attempt to do so. *Id.*

⁸² U.S. Patent No. 5,296,595 (issued March 22, 1994).

⁸³ Dr. Doyle explained his reasoning for reissue:

the 595 patent is partially defective because the claims are narrower than they should be in view of the 595 patent’s disclosure and the prior art. In particular, all 53 claims of the 595 patent are drawn to a method of enantioselectively inserting a carbene with a chiral catalyst. I now believe that the claims should have been broader in order to cover the use of the defined catalyst to enantioselectively catalyze reactions with a prochiral compound.

Doyle, 293 F.3d at 1357.

⁸⁴ See *id.* at 1356 n.2, (“A prochiral compound is one that, while not yet chiral, can become so when it undergoes a chemical transformation”).

⁸⁵ *Id.*; see also CHISUM, *supra* note 3, at Glossary (defining a claim that “reads on” as one that “covers products or processes that contain all of the elements and limitations of the claim. In determining the coverage of a claim, it is not construed or applied by literal language alone; consideration is given to the prior art and the description of the invention in the specification”); Landis on the Mechanics of Claim Drafting, Practising Law Institute, § 18, n.5 (2000) (“each technical phrase in the claim must literally describe a corresponding element or connection, etc., found in the description”).

⁸⁶ Proposed claim 54 is illustrative of the other reissue claims:

A method of enantioselectively catalyzing a reaction comprising the steps of: providing a prochiral compound, providing a chiral catalyst comprising a nucleus with a first and second atom of the same metal aligned on an axis, said metal selected from the group consisting of rhodium, ruthenium, chromium, molybdenum, tungsten, rhenium and osmium; and first, second, third and fourth bridging ligands oriented radially to the axis, each ligand having a first and second complexing atom, the first complexing atom of each of said bridging ligands being complexed with said first metal atom, and the second complexing atom of each of said bridging ligands being complexed to said second metal atom, said first bridging ligand further comprising a ring including said first complexing atom and attached to said second complexing atom, said ring also including a chiral center attached through a first bonding site to said first complexing atom, attached through a second bonding site to said ring, having a third bonding site occupied by a first substituent, and having a fourth bonding site occupied by a second substituent, and said second bridging ligand further comprising a ring including said second complexing atom and attached to said first complexing atom, said ring also including a chiral center attached through a first bonding site to said second complexing atom, attached through a second bonding site to said ring, having a third bonding site occupied by a first substituent, and having a fourth bonding site occupied by a second substituent, and wherein the R/S configuration of the chiral center on the second bridging ligand is the same as the R/S

examiner approved claims 1-53 for the reissue but refused to allow claims 54 through 71.⁸⁷ The rejection was based on two main grounds: failure to specify an error correctable by reissue and the doctrine of recapture.⁸⁸ Dr. Doyle appealed the lack of error finding and the applicability of the doctrine of recapture.⁸⁹ The Board agreed with the examiner that there was a lack of error,⁹⁰ but did not sustain the rejection under the doctrine of recapture.⁹¹ The Board ruled that the recapture doctrine, which prevents an applicant from claiming through reissue any matter that had been surrendered to overcome a rejection based on prior art, was inapplicable because Doyle's new claims were not canceled to overcome prior art, rather, the claims were canceled to overcome a restriction requirement.⁹²

Both the examiner and the Board based their decisions about the missing correctable error on the *Orita* doctrine;⁹³ the proposed claims 54-71 of the patent reissue request could not be granted because the *Orita* doctrine precludes a reissue applicant from obtaining claims that read on to the non-elected groups when these proposed claims could have been prosecuted in a divisional application.⁹⁴

B. Affirming the Doyle Court's Analysis of Other Reissue Cases

In *Doyle*, the issue was whether a failure to present a linking claim,⁹⁵ that is, a claim broad enough to "read on" or link two or more groups of claims subject to a restriction requirement, is an error correctable by reissue according to the Patent Act.⁹⁶ This was an issue of first impression for the Federal Circuit.⁹⁷ Although the Board had affirmed the examiner's rejection of claims 54-71 based on the *Orita* doctrine,⁹⁸ the Federal Circuit in *Doyle* found the Board's interpretation of *Orita* too

configuration of the chiral center on the first bridging ligand, and reacting said prochiral compound and said chiral catalyst under conditions sufficient [sic, to] cause the reaction.

Doyle, 293 F.3d at 1357.

⁸⁷ *Id.*; see also *Ex parte Doyle*, No.2000-0601, 2000 WL 33118610, at *2 (Bd. Pat. App & Interf. Dec. 29, 2000), request for reh'g denied (Mar. 22, 2001).

⁸⁸ *Ex parte Doyle*, 2000 WL 33118610, at *2-3.

⁸⁹ *Id.* at *2.

⁹⁰ *Id.* at *3-5. The Board conceded with Doyle that the appealed reissue claims are not identical to the non-elected claims of the original application; however, the Board was persuaded that the proposed claims "nevertheless encompass the subject matter of each of the canceled, non-elected claims," and that was sufficient to bar the reissue. *Id.* at *3-4. Furthermore, the Board believed that granting a reissue for this type of linking claim would "circumvent the copendency requirement of Section 120 incorporated by reference in Section 251." *Id.* at *5.

⁹¹ *Id.* at *5-6.

⁹² *Id.*

⁹³ See generally *Orita*, 550 F.2d 1277.

⁹⁴ See *Ex parte Doyle*, 2000 WL 33118610, at *2-5.

⁹⁵ See *MPEP*, supra note 5, § 809.03 (2001) ("Linking claims"); see also *MPEP*, supra note 5, § 809.04 ("Retention of Claims to Non-elected Invention").

⁹⁶ *Doyle*, 293 F.3d at 1359.

⁹⁷ *Id.*

⁹⁸ See generally *Orita*, 550 F.2d 1277.

expansive.⁹⁹ The court distinguished *Orita*¹⁰⁰ and its progeny, including *Watkinson*¹⁰¹ and *Weiler*,¹⁰² and reversed the Board.¹⁰³

1. The Theory of Estoppel

The Court held that the theory of estoppel, at the heart of the *Orita* doctrine¹⁰⁴ asserted by the Board, was not successful in arguing against the reissue.¹⁰⁵ The rationale for estoppel is to prevent the holder of a patent from trying to claim aspects of an invention that were purposely excluded from a patent application so that a patent could be approved and issued by the PTO.

As the rationale for estoppel did not apply, Doyle's reissue application was distinguishable from earlier cases that precluded from reissue claims under the *Orita* doctrine.¹⁰⁶ The court also looked at *Watkinson*, where *Watkinson* expressly acquiesced to the restriction and cancelled the non-elected claims.¹⁰⁷ *Watkinson* was estopped in her reissue application because she was bound to her original decision to cancel the claims.¹⁰⁸ However, Doyle "did not assert the reissue claims" exactly or in a similar form in his original application and "also never agreed to prosecute the reissue claims in a divisional application."¹⁰⁹

A further contention by the Court was that not only could Doyle assert these claims in his reissue, but pursuant to *MPEP* § 809.04,¹¹⁰ "these linking claims . . . should have been prosecuted with the elected group."¹¹¹

⁹⁹ See *Doyle*, 293 F.3d at 1361. "[T]he rationale underlying *In re Orita* and the holding of that case extend *only* to claims that are identical to or of substantially similar scope to those of the non-elected group" and does not preclude broadening claims which read on non-elected subject matter. *Id.* (emphasis added).

¹⁰⁰ See *Orita*, 550 F.2d 1277.

¹⁰¹ 900 F.2d 230.

¹⁰² 790 F.2d 1576.

¹⁰³ *Doyle*, 293 F.3d at 1364.

¹⁰⁴ See also *Watkinson*, 900 F.2d 230. *Watkinson* was the only Federal Circuit case to apply the *Orita* doctrine prior to *Doyle*.

¹⁰⁵ See generally T. Whitley Chandler, *Prosecution History Estoppel, the Doctrine of Equivalents, and the Scope of Patents*, 13 HARV. J. LAW & TECH. 465, 514-19 (2000) (comparing the historical basis of doctrine of recapture and estoppel in the context of reissues and discussing the present day effects of these doctrines).

¹⁰⁶ See *Orita*, 550 F.2d 1277.

¹⁰⁷ See *Watkinson*, 900 F.2d at 232.

¹⁰⁸ *Id.*

¹⁰⁹ *Doyle*, 293 F.2d at 1360.

¹¹⁰ See *MPEP*, *supra* note 5, § 809.4. For the retention of claims to non-elected inventions, the *MPEP* provides that "[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim." *Id.*

¹¹¹ *Doyle*, 293 F.2d at 1360-62 (recognizing that if Doyle had declared the linking claim during the initial prosecution of his patent, "the examiner would have been required to lift the restriction requirement as to the other groups linked by the new claims and allow prosecution of those other groups").

2. The Scope of the Reissue Claims

Another aspect that distinguished *Watkinson* from *Doyle* was that while Doyle could have prosecuted his broader reissue claims in his original patent,¹¹² *Watkinson's* patent reissue attempt failed because she had already tried to make the exact claims in her original patent application.¹¹³ In Doyle's first attempt to claim his discoveries, the claims covered too many aspects of the inventions.¹¹⁴ After the restriction, the claims did not cover enough of the invention.¹¹⁵ Thus, Doyle could have successfully claimed the middle ground in the original patent, and the board should have allowed the modified claims in the reissue declaration.¹¹⁶

Doyle was entitled¹¹⁷ to a reissue "by reason of [Dr. Doyle] claiming . . . less than he had a right to claim in the patent" pursuant to Section 251 of the Patent Act.¹¹⁸ The court also found that the correctable error in *Doyle* was distinguishable from *Orita*, because the patent issued in *Orita* contained no errors at all,¹¹⁹ rather, the applicant had claimed exactly what he intended to claim.¹²⁰

The court also found that *Doyle* was distinguishable from *Weiler* because the *Weiler* concerned a bar against reissue claims that did not have a showing of "intent to claim" in the original application.¹²¹ Thus, *Weiler's* new claims were a separate invention,¹²² while Doyle's new claims read on the elected group.¹²³

Consequently, the *Orita* doctrine is applicable only to claims "identical to or of substantially similar scope to those of the non-elected group."¹²⁴ Comparatively, Doyle's linking claims were "significantly broader" than the species claims of the non-elected groups, and are "obviously not of substantially similar scope as the non-elected species claimed"¹²⁵ although the subject matter is the same as the issued patent.¹²⁶

¹¹² *Id.*

¹¹³ *See Watkinson*, 900 F.2d at 231.

¹¹⁴ *Doyle*, 293 F.3d at 1358.

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ The granting of a reissue pursuant to Section 251 depends on how the courts construe the statute. It is a long held understanding that the reissue statute is "remedial in nature, based on the fundamental principles of equity and fairness, and should be construed liberally." *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986).

¹¹⁸ *See* 35 U.S.C. § 251 (2000); *Doyle*, 293 F.3d at 1360 ("*In re Orita* does not – and cannot – limit his statutory right to seek reissue under the circumstances").

¹¹⁹ *Orita*, 550 F.2d at 1280.

¹²⁰ *Id.* ("Patentee claimed exactly what they had a right to claim in the patent, no more nor less, and the appellant's failure to timely re-file does not change this fact").

¹²¹ *See Doyle*, 293 F.3d at 1362; *see also Weiler*, 790 F.2d at 1580.

¹²² *Weiler*, 790 F.2d at 1581.

¹²³ *Doyle*, 293 F.3d at 1363.

¹²⁴ *Id.* at 1361.

¹²⁵ *Id.*

¹²⁶ The claims in the reissue declaration are broader, however, the claims may not be so broad as to introduce new matter since no new matter can be introduced in the reissue declaration. *See* 35 U.S.C. § 251 (2000).

3. Coadependency Argument

The Federal Circuit had two reasons for rejecting the Board's argument that permitting linking claims by reissues will offset the statutory provisions of the coadependency requirements in sections 120¹²⁷ and 121¹²⁸ of the Patent Act and thus adversely affect "the public interest in the certainty and finality of patent rights."¹²⁹ First, the court held that *Doyle* does not concern the two statutes because the matter sought on reissue was not subject to a restriction requirement and could have been presented with the original application.¹³⁰ Second, the court found Doyle's situation "no more an affront to the public interest than any other broadening reissue."¹³¹

4. Divisional Applications versus Broadening Reissues

The other public interest argument made by the PTO Solicitor, that Doyle had dedicated the subject matter of his linking claims to the public by failing to file a divisional application¹³² on the non-elected groups, also failed.¹³³ The Federal Circuit justified the reissue as part of Doyle's "right to exclude."¹³⁴ Moreover, the reissue statutes put the public on notice¹³⁵ for any infringement from the time between the issue of the original patent and the granting of the reissue by way of statutory intervening rights.¹³⁶

¹²⁷ 35 U.S.C. § 120 (2000) (requiring that an earlier filing date is granted when a continuation or divisional application is filed "before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the [first] filing date . . .").

¹²⁸ 35 U.S.C. § 121 (2000) (providing for divisional applications).

¹²⁹ *Doyle*, 293 F.3d at 1363.

¹³⁰ *Id.*

¹³¹ *Id.* ("Congress has weighed the benefits and burdens of allowing corrections of this sort of error by reissue, and has decided to allow broadening reissues, subject, of course, to certain safeguards: the two year time limitation and intervening rights."); see also J. Christopher Carraway, *The Uncertain Future of Enforcing Patents That Have Been Broadened Through Reissue*, 8 FED. CIR. B.J. 63, 70-75 (1998) (discussing the conflict of broadening reissues with the public notice and encouraging design around claims).

¹³² While Doyle did not file a divisional application prior to his reissue application, he must file a terminal disclaimer to get the reissued patent. *Doyle*, 293 F.3d at 1358, n.4. Otherwise, a conflict of obviousness-type double patenting would be created in reissue claims that are not distinct from the original patent. *In re Londaro*, 119 F.3d 960, 965 (Fed. Cir. 1997).

¹³³ See *Doyle*, 293 F.3d at 1364.

¹³⁴ *Id.*

The public is therefore on notice that at least some [subject] matter can be "dedicated to the public" in error and that the error, if caught in time, can be corrected by reissue. . . . [I]f the patentee succeeds in obtaining a reissue that alters the scope of her right to exclude, then the public interest is protected through intervening rights.

Id. The right to exclude is a right recognized by the Constitution. U.S. CONST. art. I, § 8, cl. 8.

¹³⁵ *Doyle*, 293 F.3d at 1363.

¹³⁶ See *id.* Reissues have the benefit of the same filing date as the original patent. See 35 U.S.C. § 251, ¶ 2 (2000). Thus, members of the public who were not infringers at the time of the patent issue may suddenly find themselves to be infringers once the reissue is granted. See *id.* n.5 (quoting *Seattle Box Co. v. Indus. Crating & Packing Inc.*, 756 F.2d 1574, 1579 (Fed. Cir. 1985), for the proposition that "when certain conditions are present a reissue shall not abridge or affect certain

Ultimately, the Federal Circuit reversed the ruling of the Board to reject the pending claims and remanded for further proceedings.¹³⁷

C. *The Effect of the Allowing Linking Claims by Reissue*

Rulings in *Orita*, *Weiler*, *Watkinson*, and most recently, *Doyle*, have clarified and perhaps even expanded the former regime of patent reissues. In *Doyle*, the Federal Circuit distinguished a number of prior cases, and in doing so, appears to have expanded the application of broadening reissue. However, some questions yet remain unanswered: for example, if an omission of a linking claim during a patent's prosecution history is an error correctable by reissue, does policy suggest that the two year limitation on broadening reissues should also apply to attempts to link claims?¹³⁸ Also, the *Orita* doctrine was understood by both the reissue application examiner and the Board to mean that any failure to file a divisional claim was not an error correctable by reissue, are there any other situations that could potentially draw more reissue applications to the PTO now that failure to assert a linking claim has been distinguished from a simple failure to file a divisional application?

Patent drafters learned the important skill of wording claims.¹³⁹ But ultimately, the patentee must retain a sizable stake in the claims for the purpose of retaining an exclusive right against the world.¹⁴⁰ The question that the larger picture poses is whether the grant of reissue claims to the genus of non-elected claims is consistent with the procedures and goals of the patent system.

rights of those who acted before the reissue was granted.”). Intervening rights play an important function because broadening reissues are liberally granted pursuant to the longstanding practice of “constru[ing] [reissue] liberally.” See *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986). Increasing ways to apply for broadening reissues presumably increases the likelihood of infringement by the members of the public.

¹³⁷ *Doyle*, 293 F.3d at 1364.

¹³⁸ See 35 U.S.C. §§ 251-52 (2000) (providing for a two-year statute of limitation on filing reissue applications and on recovery under the doctrine of intervening rights).

¹³⁹ See 1 PATENT APPLICATIONS HANDBOOK § 2:2 (2002). Claim structure consists of a preamble, transition statement and a body, and form a single sentence with a single period. *Id.* The ideal claim is neither too broad, nor too narrow, and the invention is clearly and adequately described so that novelty and nonobviousness with respect to all prior art are present.

¹⁴⁰ See Kralovic, *supra* note 35, at 89-90 (suggesting that a tension is created between the patentee and the public in achieving the “economically advantageous” balance of the patent system’s objectives, namely to reward and encourage inventors, and to disclose new technologies in the useful arts to the public domain). Ironically, while the economic consequences of a granted patent is ultimately based on the ability to create a unique and distinguished market share for the invention, the build-up to that position in the form of a patent or reissue application is a much more dependent evaluation of prior art.

III. PROPOSAL

A. The Statutory Treatment of Linking Claims

The current U.S. Patent Act does not delineate the types or forms of error that are correctable by reissue, however, *Doyle* has clearly shown that a failure to assert a linking claim may be considered a section § 251 “error.”¹⁴¹ Authorities such as the Patent Office, which publishes the Manual of Patent Examination and Procedures, and even Congress,¹⁴² might consider revising the Patent Act to reflect the ongoing development of law surrounding the granting of reissues.

For example, while the court did not have to decide in *Doyle* whether linking claims correctable by reissue are likely subject to the two-year limitation on broadening reissues,¹⁴³ the lack of any language to the contrary suggests that the same cut-off would apply.¹⁴⁴ Since the court has interpreted the Patent Act to allow Doyle’s particular omission as “error” when the reissue claims read on to the non-elected claims, thus broadening the original claim, Congress should clarify if it is indeed their intent to place a time limit on the inclusion of the subject matter of non-elected claims.¹⁴⁵

As *Doyle* inferred, the policy of broadening reissue supports such a limitation in the interest of the patent’s holder’s right to claim no more and no less, than what was discovered.¹⁴⁶ But the court made no finding that the interest of the patent holder is

¹⁴¹ While both the Patent Act under Title 35 of the United States Code and authoritative patent law guides such as the *MPEP* describe linking claims and its applications in claim drafting to some extent, not all countries with patent systems permit the use of linking claims. For example, in the Canadian patent system, linking claims are specifically discouraged and not authorized. *See, e.g., The Canadian Patent Office Manual of Patent Office Practice*, § 14.04.01, (1998), available at http://strategis.ic.gc.ca/sc_mrksv/cipo/patents/mopop/ch14-e.pdf (last visited February 3, 2003) (showing that linking claims are categorized under “Unacceptable Claim Groupings”). For example, where “Claim 1 to the combination of A, B and C; Claim 2 to the combination of E, F and G; Claim 3 to the combination of C, D and E; claim 3 . . . does not justify the inclusion of unrelated subcombinations in one application.” *Id.* Section 36(1) of the Canadian Patent Act (R.S., c. P-4) and Section 36 of the Canadian Patent Rules (P.C. 1996-1350 28 August, 1996) requires a restriction. *Id.*

¹⁴² The Federal Circuit mentions Congress twice in the *Doyle* opinion. The first reference is in an argument discussing the “benefits and burdens” on broadening reissues. *Doyle*, 293 F.2d at 1363. In the second reference, which was in response to the PTO Solicitor’s concern about the inadequacy of public notice if new linking claims were allowed by reissue, the court directs that if the statutory rights are “insufficient[,]” then “the remedy lies with Congress.” *Id.* at 1364.

¹⁴³ *See* 35 U.S.C. §§ 251-52 (2000).

¹⁴⁴ Judge Learned Hand long ago expressed his opinion of the relation between reissue and public notice when he expressed that public notice is an important aspect of granting reissue. *Otis Elevator Co. v. Atl. Elevator Co.*, 47 F.2d 545, 549-50 (2d Cir. 1931); *see also* Janicke, *supra* note 37, at 33.

¹⁴⁵ A close reading of the court’s opinion in *Doyle* shows that while the court disagreed with the solicitor’s argument that there is a lack of public notice for allowing linking claims that read on to non-elected claims, the court itself took no firm position on whether policy gives the court discretion to allow for greater consideration of public notice over that of the patent holder. 293 F.2d at 1364. Rather, the court silently points to the current statutory controls such as the statute of limitation. *Id.*

¹⁴⁶ *See* 35 U.S.C. § 251 (2000) (allowing a reissue to be granted if the reason underlying the reissue is that the patentee claimed “more or less than he had a right to claim in the patent”). *Cf.*

greater than the interest of public notice.¹⁴⁷ Statistically, reissue patent grants are increasing as the total number of patent grants increases, but there is no indication that there is a flux of reissue applicants flooding the system.¹⁴⁸ There is ample room to expand reissue procedures. Consequently, it is likely that Congress will agree that a reissue should be granted to correct the error of failing to make a linking claim. If Congress' position is that public notice is not adequately protected by allowing this type of error to be corrected, a clarification now would ensure that little or no litigation would reach finality based on the court's current presumption of congressional intentions.

Furthermore, the PTO and Congress may look to the current reissue applications in the system and determine if there any other situations similar to a failure to assert a linking claim that may be categorically distinguished from the non-correctable failure to file a divisional application. However, a list delineating specific correctable errors by reissue is highly unlikely since error is liberally construed.¹⁴⁹

B. Policy Arguments for the Promotion of Strategic Safeguards for the Patent Holder: Divisional Applications and Reissues

In the early years of the patent system, there were severe consequences when a patentee surrendered a patent for a reissue.¹⁵⁰ A patent holder today, however, has a large supporting framework to relinquish a patent.¹⁵¹ A goal of the patent system is

Doyle, 293 F.3d at 1361 (holding that Doyle correctly identified an error in his existing patent as the "failure to claim as broadly as possible matter that could have been sought in the original application"). Thus, in the original patent, Doyle satisfies Section 251 by claiming less than he had a right to claim.

¹⁴⁷ *Doyle*, 293 F.3d at 1363 (the court clarified its position and effectively refused to act as a superlegislature by emphasizing that "[the court] may not rewrite the statute based on our own view of the proper outcome of that public policy debate"). Judge Clevenger's opinion of *Doyle* is a detailed and careful analysis to distinguish earlier cases. There is no doubt that the Federal Circuit desired greater definiteness in the application of the *Orita* doctrine, where in severe cases, the cost of a denial of a reissue could mean losing parts of an invention to the public domain.

¹⁴⁸ "Reissue Patents: January 1977 to December 2001." U.S. Patent and Trademark Office, April 2002, available at <http://www.uspto.gov/web/offices/ac/ido/oeip/taf/reissues.pdf>, (last visited February 2, 2003). From 1988 to 1998, the number of U.S. origin patents granted annually ranged from a low of 244 to a high of 370. *Id.* at 4. Since 1999, the number of patents granted has increased: 448 in 1999, 524 in 2000, and 480 in 2001. *Id.*

¹⁴⁹ A main feature of the reissue process that the Federal Circuit repeatedly points out in reissue cases is that the "reissue statute, 35 U.S.C. § 251 (2000), is remedial in nature, based on principles of equity and fairness, and should be liberally construed." *In re Harita*, 847 F.2d 801, 809 (Fed. Cir. 1988); see also *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986). A listing of correctable errors would only limit the freedom of the PTO and the court system to grant reissues since currently, the determination of error is largely built up through case law.

¹⁵⁰ Prior to 1928, a reissued patent, once granted, would "abate[] all causes of action and all suits based on the original patent." CHISUM, *supra* note 3, § 15.05[1]. Thus, the patent holder who discovers a mistake must take a gamble: should a mistake in the original patent be quickly amended before an infringer can spot the loophole in the patent and design around it, or should the patent holder speedily conclude or terminate all suits before the reissue is granted?

¹⁵¹ Fortunately, by the late 1920s, Congress expressed its intention "to ameliorate the harsh effect of a patent's surrender" and adopted the rule that pending action and causes of action can

to allow the patent holder a patent that truly reflects the invention claimed even if it requires multiple reissue grants.¹⁵² The grant of reissue claims to the genus of non-elected claims is consistent with the ideals of the patent system¹⁵³ and technology as it stands today.¹⁵⁴

Compared with the tools available in the early 1800s when the patent system was first forming, today's science and technology requires significantly less research and development time to gather accurate and complex data about chemical structures and precision calculations.¹⁵⁵ Meanwhile, both Congress and the courts are taking proper steps to ensure that the rights of the patent holder continue to expand to reflect the changing times. The language, terms, and scientific categories to which claims are drafted today, especially in the field of biotechnology, allows the patent drafter specificity in claiming an invention. However, a basic tenant of scientific classification is that some categories overlap or are subsets within a set. This lack of a bright line classification system may be a weakness when applied to determining the scope of a patent. When patent applicants draft claims using these categorical schemes,¹⁵⁶ the patent system also becomes susceptible to the same weakness of categorization.

In allowing corrections to be made so that broader, linking claim may be inserted, the court in *Doyle* essentially recognized that this weakness in scientific categorization occasionally leads to confusion and mistakes in legal drafting. Essentially, the patent holder was a scientist who looked at the smaller picture first, before realizing that a large picture might have been claimed.¹⁵⁷

C. Is There Already A Sufficient Remedy Available to Patent Holders?

A potential counterargument to the *Doyle* decision is that the availability of a divisional application already provides a sufficient remedy for the patent holder who

stand "to the extent that the claims of the original and reissued patents are identical." *Howes v. Medical Components, Inc.*, 814 F.2d 638, 645 (Fed. Cir. 1987).

¹⁵² This comports with a basic premise behind the reissue procedure: even when the reissue applicant chooses to reject or abandon the applicant, the original patent always "remains in full force." 35 U.S.C. § 252, ¶ 1 (2000).

¹⁵³ A reissue patent is a powerful process in that the reissue claims may be enforced against infringers in a number of litigations throughout the lifetime of the patent. Allan G. Altera, *Expanding the Reissue Procedure: A Better Way to do Business*, 1 J. INTELL. PROP. L. 185, 205-06 (1993) (discussing the advantages of the reissue procedures and how the reissue framework can be ameliorated and expanded so that the archaic doctrine of equivalents may be abolished).

¹⁵⁴ The *Doyle* decision suggests the Federal Circuit believes that allow linking claims to broaden the scope of the patent is a reasonable type of correctable error under the traditional liberal interpretation of the reissue statutes.

¹⁵⁵ Of course, one could argue that while the tools have improved, the problems have gotten tougher as well.

¹⁵⁶ Even "genus" and "species," terms of art in patent law, are borrowed from terms of art from scientific classification methods.

¹⁵⁷ A good analogy is a discovery made under the microscope in which a scientist places a fly under a microscope and maneuvers the coarse focus knob up and down while looking at the specimen. The scientist may describe every part of every inch of the fly, but fail to state that it is a fly even though that was the obvious discovery. This form of mistake, under the *Doyle* ruling, is considered an inadvertent mistake correctable by reissue.

encounters a restriction requirement; thus, allowing a reissue for a failure to link claims is unnecessarily burdensome to the patent system. This argument fails, however, because it focuses on the patent system as a whole.¹⁵⁸ As the *Doyle* court explained, the focus should be on the claims of the original patent to determine if the reissue claims could have been granted in the original.¹⁵⁹

The rights of the patentee should not be considered in terms of a tradeoff against the public's benefit in getting the best mode and description of the invention in the specification. The patent system is a balance of promises; the promise to the public that scientific advances will be revealed in detail and the promise to the patent holder that what is discovered can be protected. Thus, it is proper to permit a patentee to claim what was discovered even if it requires a second, third, or *n*th draft and, therefore, takes more time than a divisional application would allow. The right to a reissue is fundamental to the operation and goals of the patent system, and it is justified that the reissue procedure should allow multiple methods to make corrections that achieve this end.

III. CONCLUSION

The goal of the patent system is to provide a patent holder the right to excluded others from making, using, and selling the patented invention in the United States. The reissue process and procedure recognizes the sometimes fallible and difficult nature of patent drafting and patent issuance and strives to strike a balance between the patentee's and the public interests in correcting oversights and mistakes. The criteria upon which the PTO examiners and Board base their rejection of reissue applications are effectively narrowed by the decision of *Doyle*. Reissue claims to the genus of non-elected claims are permissible, and the *Orita* doctrine cannot be used to preclude the reissue claims for this type of failure to link claims.

The impact of the *Doyle* holding is not likely to be all that large.¹⁶⁰ However, because *Doyle* broadens the rights of patent holders, the holders of currently valid patents issued in the past two years are well advised to revisit their files of prosecution history and take a second look at their non-elected claims and consider applying for a reissue.

¹⁵⁸ One could say this type of argument is better made to the legislature. See *Doyle*, 293 F.3d at 1363-64.

¹⁵⁹ *Id.* at 1360.

¹⁶⁰ In 2002, there was only one reported "improper broadening" case in the United States court system and the alleged infringer prevailed. "Patstat.org." University of Houston Law Center, Institute for Intellectual Property & Information Law, available at <http://www.patstats.org>, (last visited February 01, 2003). In 2001, there were five cases of "improper broadening" that went to trial: two cases were at the trial court level and ended at summary judgment; one reached final judgment at the trial court; and two cases went to the appellate level and were affirmed. *Id.* In 2000, there were no "improper broadening" cases. *Id.*