

OCTOBER 17, 2006

Medrad, Inc. v. Tyco Healthcare Group, LP

No. 06-1082, Federal Circuit (Michel, Archer, Linn)

35 U.S.C. § 251 [authorizes] reissues based on defects in inventor declarations. Specifically, [§ 251] does not require there to be an error in the specification, drawings, or claims of the patent, but rather encompasses any inadvertent error that results in underclaiming or overclaiming.

On October 16, 2006, the Federal Circuit reversed and remanded the district court's summary judgment that U.S. Reissue Patent No. 37,602, which related to patient infusion systems for use with magnetic resonance imaging systems, was invalid under 35 U.S.C. § 251. The Federal Circuit stated:

[I]f an error is without deceptive intent, [35 U.S.C. § 251] provides for reissue whenever any patent is deemed wholly or partly inoperative or invalid “by reason of the patentee claiming more or less than he had a right to claim in the patent.” The plain meaning of that phrase indicates that the error involves rendering a patent wholly or partly invalid by reason of—i.e., because of—claiming more or less than a patentee has a right to claim. Although such an error may result from the language used in a claim, the express terms of the statute do not refer only to errors in the claim language itself, as Tyco argues. Rather, [§ 251] can be read to encompass any error that causes a patentee to claim more or less than he had a right to claim. Given the remedial nature of the statute and with an eye to its liberal construction, we find such a reading to be entirely appropriate. Further, Tyco fails to identify—and we fail to find—any support in section 251, in the statutory scheme, or in the legislative history to indicate that the [disputed] phrase should be limited in the manner Tyco argues. Without an express indication from the statute, we are hesitant to adopt further limitations on the type of errors that are correctable under section 251. Accordingly, we do not interpret the disputed language in section 251—“by reason of the patentee claiming more or less than he had a right to claim in the patent”—to require that the error occur in the actual language of the claims.



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The reissue regulations, 37 C.F.R. §§ 1.171-179, require an applicant to file an oath or declaration with an application for reissue.... The regulations further provide that, “[f]or any error corrected, which is not covered by the [original reissue] oath or declaration submitted under [37 C.F.R. § 1.175(a)], applicant must submit a supplemental oath or declaration stating that every such error arose without deceptive intention on the part of the applicant.” A failure to submit a supplemental declaration, if required, renders a patent invalid.

Here, in the application for reissue that resulted in the ‘648 reissue patent, preliminary amendments were submitted to add new claims directed solely to the broadened subject matter identified in the inventors’ declarations. These amendments were supported by the original reissue declaration. Later amendments, however, narrowed existing claims and corrected inventorship. Because the later amendments were not supported by the original reissue declaration, a supplemental declaration was required under 37 C.F.R. § 1.175; however, none was filed before the ‘648 reissue patent issued. If the narrowing amendment had never been filed, there would have been no need under the rules to file a supplemental declaration, and the resulting reissue would not have been subject to a validity challenge for failure to file such supplemental declaration. However, by including changes to the language of the claims that narrowed the scope of coverage and by correcting inventorship, the resulting ‘648 reissue patent claimed more than it had a right to claim in the patent without submitting a supplemental declaration to support the narrowing subject matter and the change in inventorship. The correction of such an error meets the express terms of section 251, and thus serves as a basis for reissue.

For more information on these issues or other intellectual property law matters, please contact **Lawrence M. Sung, Ph.D.** at lsung@nixonpeabody.com or 202-585-8221.

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