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# Dependent Claims Give Rise To Improper Broadening Reissue re: Patent Applications

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In ArcelorMittal France v. AK Steel Corp., the Federal Circuit found that the addition of a dependent claim to a reissue application improperly broadened the scope of the original independent claims beyond the two-year period for a broadening reissue. While the court invoked the law-of-the-case doctrine, the same result could occur with any patent where the claims have been construed more narrowly.

## The Patent At Issue

The patent at issue was ArcelorMittal's U.S. Patent No. RE44,153, which was a reissue of U.S. Patent 6,296,805.

Claim 1 as originally granted recites:

> 1. A hot-rolled coated steel sheet comprising a hot-rolled steel sheet coated with an aluminum or aluminum alloy coating, wherein the steel in the sheet comprises the following composition by weight … and the steel sheet has a very high mechanical resistance after thermal treatment and the aluminum or aluminum alloy coating provides a high resistance to corrosion of the steel sheet.

Claims 23-25 were added during the reissue proceeding and recite:

> 23. The coated steel sheet of claim 1, wherein said mechanical resistance is in excess of 1000 MPa.
>
> 24. The coated steel sheet of claim 1, wherein said mechanical resistance is in excess of 1500 MPa.
>
> 25. The coated steel sheet of claim 24 that is composed predominantly of martensite.

## Procedural History Surrounding Claim 1

In 2010, ArcelorMittal asserted the ‘805 patent against AK Steel and others. In that proceeding, the district court construed the phrase “a very high mechanical resistance” in claim 1 as “a tensile strength greater than 1500 MPa.” On appeal, the Federal Circuit upheld that claim construction, but “reversed and remanded on other grounds.”

While the Federal Circuit appeal was pending, ArcelorMittal filed the reissue application to rectify the district court’s claim construction, adding claims 1-25.

ArcelorMittal then amended its complaint in the remanded proceeding to substitute RE153 for the ’805 patent, and brought new infringement actions against AK Steel and others. The defendants moved for summary judgment on the ground that claims 1-23 were invalid as improperly broadened in the reissue proceeding. The district court granted the motion, and also invalidated new claims 24 and 25.

## The Federal Circuit Decision

The Federal Circuit decision was authored by Judge Hughes and joined by Judges Dyk and Wallach.

As summarized by the Federal Circuit, the only change made during the reissue proceeding was “the addition of a dependent claim which has the practical effect of expanding the scope of claim 1 to cover claim scope expressly rejected by a previous claim construction ruling.”

The Federal Circuit applied the “law-of-the-case” doctrine and found that the district court was bound by its previous construction of “a very high mechanical resistance” in claim 1 as designating “a tensile strength greater than 1500 MPa.” As such, the addition of dependent claim 23, which recited a very high mechanical resistance of only “in excess of 1000 MPa,” improperly broadened the scope of claim 1 (and dependent claims 2-23) outside the two-year period of 35 USC § 251. That statute provides:

> No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent ….

The Federal Circuit explained that “[t]he law-of-the-case doctrine posits that when a court decides upon a rule of law, that decision should continue to govern the same issues in subsequent stages in the same case.” Although exceptions can be made in “extraordinary circumstances,” the Federal Circuit disagreed that the grant of the reissue patent constituted “new evidence” that would warrant an exception. Rather, the court found that such an exception “would turn the validity analysis under 35 U.S.C. § 251 on its head,” since that analysis requires comparing the scope of the claims as originally granted to the scope of the reissued claims. Thus, the Federal Circuit affirmed the district court’s finding that claims 1-23 are invalid under § 251.

The Federal Circuit remanded to the district court for separate consideration of claims 24 and 25,

citing 35 USC § 282 for the proposition that “a patent’s claims are presumed valid independent of one another.” This portion of the Federal Circuit decision reminds me of *Keurig, Inc. v. Sturm Foods, Inc.*, where the court found that patent exhaustion is not evaluated on a claim-by-claim basis. (Judge O’Malley dissented on that point.)

## Law Of The Case Or Law Of The Patent?

Although the Federal Circuit relied on the law-of-the-case doctrine, it is not clear that ArcelorMittal’s arguments would have fared any better in a different case, even against different parties. For example, in supporting its decision, the court stated:

> [T]he dispositive question is whether the original claim has the meaning sought by ArcelorMittal for the reissue claims—not what the original claim means in light of the reissue claims. …. And we have already determined the proper scope of claim 1 of the ’805 patent in ArcelorMittal I.

Wouldn’t that hold true in any case involving this patent?



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