

Examiner Reissue and Reexam Amendment Training for  
"Changes to Patent Practice and Procedure" Final Rule Package

As a result of the newly stated provisions of 37 CFR 1.121(b) and 37 CFR 1.530(d), in the "Changes to Patent Practice and Procedure" Final Rule package, amendments in reexamination proceedings and reissue applications are now made in the same manner. The criteria for reexamination and reissue amendments and the review of such amendments by the examiner will be discussed below:

***I. AMENDMENT OF SPECIFICATION AND CLAIMS***

**A. REQUIREMENTS FOR REISSUE/REEXAM AMENDMENTS**

Any reply or response *making amendments* which is filed *in a reissue application or reexamination proceeding* on or after the effective date of the 37 CFR 1.121 rule change (in the "Changes to Patent Practice and Procedure" Final Rules package) *must*:

- Completely re-present the entire text of any claim that is currently being amended (except where a claim is being canceled),
- Completely re-present the entire text of any paragraph of the specification that is currently being amended (except where an entire paragraph is being deleted),
- Set forth the status of all patent claims and all added claims as of the date of submission of the response, and
- Explain the support in the disclosure of the patent for the amendment (i.e., support for the changes made in the claim(s)).

*If a reissue/reexam amendment filed after the effective date,*

- (a) has directions to insert *specific text* in a claim or the specification,
- (b) fails to set forth the status of all patent claims and added claims as of the date of the submission, or
- (c) fails to explain the support in the disclosure of the patent for the amendment, **or**
- (d) fails to provide appropriate underlining of subject matter added and bracketing of subject matter deleted (relative to the patent) in a re-presented claim or paragraph of specification,

*then the amendment is not proper, i.e., the amendment is informal.*

*Where the amendment is informal:*

- If the informal amendment is submitted **prior to final rejection**, the examiner will send a notification to the applicant (in a reissue) or the patent owner (in a reexamination) that the reply or response is incomplete. The reissue applicant or the reexamination patent owner will be given a time period to present the amendment in proper form.
- If the informal amendment is submitted **after final rejection**, a notification of incomplete reply or response should not be used. Rather, an *advisory Office action* should be issued indicating that the amendment was not entered.

In reissue: Box 1(d) of the PTOL 303 should be checked, and in the space after "Note", it should be explained that the amendment was not entered because it does not comply with 37 CFR 1.121(b), which sets forth the manner of making amendments in reissue applications.

In reexamination: Box 4(d) of the PTOL 467 should be checked, and in Box 10 it should be explained that the amendment was not entered because it does not comply with 37 CFR 1.530(d), which sets forth the manner of making amendments in reexamination proceedings.

## **B. PRACTICE AS TO REISSUE AND REEXAMINATION AMENDMENTS**

### **1) REISSUE:**

The provisions of 37 CFR 1.121(b) (copy attached) apply to amendments in reissue applications.

The specification: *37 CFR 1.121(b)(1)*

Paragraph (b)(1) of 37 CFR 1.121 relates to the manner of making amendments to the specification. It is not to be used for making amendments to the claims or the drawings.

37 CFR 1.121(b)(1)(i) requires that all amendments which include any deletions or additions must be made by submission of a copy of *each rewritten paragraph* with markings (brackets and underlining). One exception to this rule is given in 37 CFR 1.121(b)(1)(i)- an entire paragraph of specification text may be deleted from the specification by a statement deleting the paragraph *without presentation of the text of the paragraph*. 37 CFR 1.121 (b)(1)(i) also requires that all paragraphs which are *added* to the specification be submitted as completely underlined.

37 CFR 1.121(b)(1)(ii) requires that the precise point where each amendment is to be made must be indicated by applicant.

37 CFR 1.121 (b)(1)(iii) defines the markings set forth in (b)(1)(i) as being brackets for deletion and underlining for addition.

All bracketing and underlining is made in comparison to the patent specification in effect at the date of filing the reissue application; not in comparison to the prior amendment.

The claims: *37 CFR 1.121(b)(2)*

Paragraph (b)(2) of 37 CFR 1.121 relates to the manner of making amendments to the claims in reissue applications. It is not to be used for making amendments to the specification or the drawings.

The provisions of 37 CFR 1.121(b)(2)(i)(A) require:

- For each claim that is being amended *by the amendment being submitted* (the current amendment), the entire text of the claim must be presented with appropriate markings.
- For each new claim added to the reissue *by the amendment being submitted* (the current amendment), the entire text of the added claim must be presented.
- A patent claim is canceled by a direction to cancel that claim; there is no need to present the text of the patent claim surrounded by brackets.
- A new claim (previously added in the reissue) is canceled by a direction to cancel that claim.

In 37 CFR 1.121(b)(2)(i)(B), it is pointed out that original patent claims may not be renumbered. A patent claim retains its original number even if it is canceled in the reissue proceeding, and the numbering of any added claims must begin after the last original patent claim.

37 CFR 1.121(b)(2)(i)(C) identifies the type of marking required by reference to 37 CFR 1.121(b)(2)(i)(A), i.e., underlining for added material and single brackets for material deleted relative to the patent.

In accordance with 37 CFR 1.121(b)(2)(ii), each amendment submitted must set forth the status of all patent claims and all added claims as of the date of the submission. The status to be set forth is whether the claim is live (pending) or the claim is canceled. Failure to submit the claim status in an amendment submitted **prior to final rejection** will generally result in a notification to the applicant that the reply is incomplete. See 37 CFR 1.135(c). Failure to submit the claim status in an amendment submitted **after final rejection** will generally result in an *advisory Office action* indicating that the amendment was not entered. See also page 2 (above) for further discussion.

In accordance with 37 CFR 1.121(b)(2)(iii), each claim amendment must be accompanied by an explanation of the support in the disclosure of the patent for the amendment (i.e., support for the changes made in the claim(s), support for any insertions **and deletions**). Failure to submit the explanation in an amendment submitted **prior to final rejection** will generally result in a notification to the applicant that the reply is incomplete. See 37 CFR 1.135(c). Failure to submit the explanation in an amendment submitted **after final rejection** will generally result in an *advisory Office action* indicating that the amendment was not entered. See also page 2 (above) for further discussion.

Finally, 37 CFR 1.121(b)(5) states that: (1) No reissue patent shall be granted enlarging the scope of the claims, unless applied for within two years of the grant of the original patent, (2) no amendment may introduce new matter, and (3) no amendment may be made in an expired patent.

A broadened claim can be presented within two years of the grant of the original patent, in a reissue application. In addition, a broadened claim can be presented *more than two years* from the grant, in a broadening reissue which was filed *within two years* of the grant. Where any intent to broaden is indicated in the reissue application within the two years, a broadened claim can be presented in the reissue after two years. Finally, if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing reissue application after two years. In any other situation, a broadened claim cannot be presented, and the examiner should check carefully for the improper presentation of broadened claims.

Form Paragraphs to be used:

Form Paragraph 14.20.01 may be used to advise applicant of the proper manner of making amendments in a reissue application.

& 14.20.01 Amendments to Reissue-37 CFR 1.121(b)

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.121(b).

Examiner Note:

This paragraph may be used in the first Office action to advise applicant of the proper manner of making amendments.

Form Paragraph 14.21.01 may be used to notify applicant that a proposed amendment in the reissue application filed before final rejection does not comply with 37 CFR 1.121(b).

& 14.21.01 Improper Amendment to Reissue-37 CFR 1.121(b)

The amendment filed [1] proposes amendments to [2] that do not comply with 37 CFR 1.121(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

A shortened statutory period for reply to this letter is set to expire one month from the date of this letter.

Examiner Note:

This paragraph may be used for any 37 CFR 1.121(b) informality as to an amendment submitted in a reissue application prior to final rejection. After final rejection, applicant should be informed that the amendment will not be entered in an advisory Office action.

All changes are made *vis-a-vis* the patent to be reissued:

When a reissue patent is printed, all underlined matter is printed in *italics* and all brackets are printed as inserted in the application, in order to show exactly where additions and deletions have been made to the patent being reissued. Therefore, all underlining and bracketing in the reissue application should be made relative to the text of the patent. In accordance with 37 CFR 1.121(b)(6) all amendments in the reissue application must be made relative to (i.e., *vis-a-vis*) the patent specification (including the claims) and the drawings in effect as of the date of the filing of the reissue application. If there was a prior change to the patent (made via a prior concluded reexamination certificate, reissue of the patent, certificate of correction, etc.), the first amendment of the subject reissue application must be made relative to the patent specification (including the claims) and the drawings as changed by the prior proceeding or other mechanism for changing the patent. All amendments subsequent to the first amendment must also be made relative to the patent specification (including the claims) and the drawings that are in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment.

If the original (or previously changed) patent includes a formula or equation already having underlining or bracketing therein as part of the formula or equation, any amendment of such formula or equation should be made by bracketing the entire formula and rewriting and totally underlining the amended formula in the re-presented paragraph of the specification or rewritten claim in which the changed formula or equation appears. Amendments of segments of a formula or equation should not be made.

If the original patent includes bracketing and underlining from an earlier reexamination or reissue, double brackets and double underlining should be used in the subject reissue application to identify and distinguish the present changes being made. The subject reissue, when printed, would include double brackets (indicating deletions made in the subject reissue) and boldface type (indicating material added in the subject reissue).

## 2) REEXAMINATION:

The provisions of 37 CFR 1.530(d) (copy attached) apply to amendments in reexamination proceedings.

### The specification: 37 CFR 1.530(d)(1)

Paragraph (d)(1) of 37 CFR 1.530 relates to the manner of making amendments to the reexamination "specification." It is not to be used for making amendments to the claims or the drawings.

37 CFR 1.530 (d)(1)(i) requires that all amendments which include any deletions or additions must be made by submission of a copy of each rewritten paragraph with markings (brackets and underlining). One exception to this rule is given in 37 CFR 1.530(d)(1)(i)- an entire paragraph of specification text may be deleted from the specification by a statement deleting the paragraph *without presentation of the text of the paragraph*.

37 CFR 1.530 (d)(1)(i) also requires that all paragraphs which are *added* to the specification be submitted as completely underlined.

37 CFR 1.530(d)(1)(ii) requires that the precise point where each amendment is to be made must be indicated.

37 CFR 1.530 (d)(1)(iii) defines the markings set forth in (d)(1)(i) as being brackets for deletion and underlining for addition.

All bracketing and underlining is made in comparison to the patent specification, including the claims, and drawings, in effect at the date of filing the request for reexamination; not in comparison to the prior amendment.

### The claims: 37 CFR 1.530(d)(2)

Paragraph (d)(2) of 37 CFR 1.530 relates to the manner of making amendments to the claims in a reexamination proceeding. It is not to be used for making amendments to the specification or the drawings.

The provisions of 37 CFR 1.530(d)(2)(i)(A) deal with the following, as to an amendment to be made by a reexamination patent owner:

- For each claim that is proposed to be amended *by the amendment being submitted* (the current amendment), the entire text of the claim must be presented with appropriate markings.
- For each proposed new claim which is added in the reexamination *by the amendment being submitted* (the current amendment), the entire text of the proposed new claim must be presented and it must be underlined throughout.
- A patent claim is canceled by a direction to cancel that claim; there is no need to present the text of the patent claim surrounded by brackets.
- A proposed new claim (previously added in the reexamination) is canceled by a direction to cancel that claim.

In 37 CFR 1.530(d)(2)(i)(B), it is pointed out that original patent claims may not be renumbered. A patent claim retains its original number even if it is canceled in the reexamination proceeding, and the numbering of any added claims must begin after the last original patent claim.

37 CFR 1.530(d)(2)(i)(C) identifies the type of markings required in the claim to be amended as underlining for added material and single brackets for material deleted.

In accordance with 37 CFR 1.530(d)(2)(ii), each amendment submitted must set forth the status of all patent claims and all added claims as of the date of the submission. The status to be set forth is whether the claim is live (pending) or the claim is canceled. Failure to submit the claim status in an amendment submitted **prior to final rejection** will generally result in a notification to the patent owner that the response is informal. Failure to submit the claim status in an amendment submitted **after final rejection** will generally result in an *advisory Office action* indicating that the amendment was not entered. See also page 2 (above) for further discussion.

In accordance with 37 CFR 1.530(d)(2)(iii), each claim amendment must be accompanied by an explanation of the support in the disclosure of the patent for the amendment (i.e., support for the changes made in the claim(s), support for any insertions **and deletions**). Failure to submit the explanation in an amendment submitted **prior to final rejection** will generally result in a notification to the patent owner that the response is incomplete, since support in the disclosure goes to the merits of the case. Failure to submit the explanation in an amendment submitted **after final rejection** will generally result in an *advisory Office action* indicating that the amendment was not entered. See also page 2 (above) for further discussion.

### Form Paragraphs to be Used:

Form Paragraph 22.12 may be used to advise patent owner of the proper manner of making amendments in a reexamination proceeding.

#### & 22.12 Amendments Proposed in a Reexamination-37 CFR 1.530(d)

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d).

#### Examiner Note:

This paragraph may be used in the order granting reexamination and/or in the first Office action to advise patent owner of the proper manner of making amendments in a reexamination proceeding.

Form Paragraph 22.13 may be used to notify patent owner in a reexamination proceeding that the proposed amendment filed before final rejection does not comply with 37 CFR 1.530(d).

#### & 22.13 Improper Amendment in a Reexamination-37 CFR 1.530(d)

The amendment filed [1] proposes amendments to [2] that do not comply with 37 CFR 1.530(d), which sets forth the manner of making amendments in reexamination proceedings. A supplemental paper correctly proposing amendments in the reexamination proceeding is required.

A shortened statutory period for response to this letter is set to expire one month from the date of this letter. If patent owner fails to timely correct this informality, the amendment will be held not to be an appropriate response, the present reexamination proceeding will be terminated, and a reexamination certificate will issue. 37 CFR 1.550(d).

#### Examiner Note:

This paragraph may be used for any 37 CFR 1.530(d) informality as to a proposed amendment submitted in a reexamination proceeding prior to final rejection. After final rejection, the amendment should not be entered and patent owner informed of such in an advisory Office action using Form PTOL 467.

The cover sheet to be used for mailing the notification to the patent owner will be PTOL Form 473.

As an alternative to using Form Paragraph 22.13, it would also be appropriate to use Form PTOL-475, box 4.

All changes are made *vis-a-vis* the patent being reexamined:

When a reexamination certificate is printed, all underlined matter is printed in *italics* and all brackets are printed as they were inserted in the proceeding, in order to thereby show exactly where additions and deletions have been made in the patent via the reexamination proceeding. Therefore, all underlining and bracketing should be made relative to the text of the patent, as follows:

In accordance with 37 CFR 1.530(d)(8), all amendments to the patent being reexamined must be made relative to (i.e., *vis-a-vis*) the patent specification (including the claims) and the drawings that are in effect as of the date of the filing of the request for reexamination. If there was a prior change to the patent (made via a prior reexamination certificate, a prior reissue of the patent, a prior certificate of correction, etc.), the first amendment must be made relative to the patent specification (including the claims) and the drawings, as changed by the prior proceeding or other mechanism for changing the patent.

All amendments subsequent to the first amendment must also be made relative to the patent specification (including the claims) and the drawings that are in effect as of the date of the filing of the request for reexamination, and **not** relative to the prior amendment.

### 3) EXAMPLES:

A substantial number of problems arise in the Office because of improper submission of amendments in reissue applications and in reexamination proceedings. The following examples are provided in order to assist in the preparation (and review) of amendments to reissue applications and reexamination proceedings.

#### ORIGINAL PATENT DESCRIPTION OR PATENT CLAIM AMENDED

##### Example (1):

If it is desired to change the specification at column 4 line 23, to replace "is" with --are--:

- Submit a copy of the entire paragraph of specification that includes column 4 line 23, with underlining and bracketing showing the changes, and
- Point out where the paragraph (to be replaced) is located.

Thus, the amendment would be presented as follows-

Replace the paragraph beginning at column 4 line 23 with the following:

Scanning [is]are controlled by clocks which are, in turn, controlled from the display tube line synchronization. The signals resulting from scanning the scope of the character are delivered in parallel, then converted into serial mode through a shift register wherein the shift signal frequency is controlled by a clock that is, in turn, controlled from the display tube line synchronization.

**Example (2):**

For changes to the *patent* claims, one must submit a copy of the entire patent claim with the amendments shown by underlining and bracketing.

Thus, the amendment would be presented as follows-

Amend claim 6 as follows:

Claim 6. The apparatus of claim [5] wherein the [first] second piezoelectric element is parallel to the [second] third piezoelectric element.

If the dependency of any original patent claim is to be changed by amendment, it is proper to make that original patent claim dependent upon a higher numbered claim.

CANCELLATION OF CLAIM(S)

**Example (3):**

To cancel an original patent claim:

In writing, direct cancellation of the patent claim.

Thus, the amendment would be presented as follows-

Cancel claim 6.

**Example (4):**

To cancel a new claim (previously added in the reissue):

In writing, direct cancellation of the new claim.

Thus, the amendment would be presented as follows-

Cancel claim 15.

## PRESENTATION OF NEW CLAIMS

### Example (5):

A new claim is a claim not found in the patent, i.e., one that is newly presented in the reissue application or the reexamination proceeding. Each "new claim" should be presented with underlining throughout the claim.

Thus, the amendment would be presented as follows-

Add claim 7 as follows:

Claim 7. The apparatus of claim 5 further comprising electrodes attaching to said opposite faces of the first and second piezoelectric elements.

Even though original claims may have been canceled, the numbering of the original claims does not change. Accordingly, any added claims are numbered beginning with the number next higher than the number of claims in the original patent. If *new claims have been added* to the reissue application or the reexamination proceeding *which are later canceled* prior to issuance of the reissue patent or reexamination certificate (respectively), *the examiner, when preparing the case for issue, will renumber any **remaining** new claims in numerical order to follow the number of claims in the original patent.*

## AMENDMENT OF NEW CLAIMS

### Example (6):

As pointed out above, a new claim is a claim not found in the patent. An amendment of a "new claim" must be done by:

- Presenting the entire text of the amended "new claim" containing the amendatory material, and
- completely underlining the claim.

The presentation cannot contain any bracketing or other indication of what was in the previous version of the claim. This is because all changes in the reissue or reexamination proceeding are

made *vis-a-vis* the original patent, and not in comparison to the prior amendment. Although the presentation of the amended claim does not contain any indication of what is changed from the previous version of the claim, the reissue applicant or the reexamination patent owner must point out, in the "Remarks" portion of the amendment, what has been changed. Also, as is required by 37 CFR 1.121(b)(2)(C)(iii) and 1.530(d)(2)(iii), each change made in the claim must be accompanied by an explanation of the support in the disclosure of the patent for the change.

Thus, the amendment to change claim 7 would be presented as follows-

<p>Amend claim 7 as follows:</p> <p><u>Claim 7. The apparatus of claim 5 further comprising first and second electrodes attaching to said opposite faces of the first and second piezoelectric elements.</u></p> <p><u>Remarks</u></p> <p>"First and second" is added in line 1 of claim 7 before "electrodes." The addition of "first and second" before "electrodes" is made in order to provide correspondence to the "first and second piezoelectric elements" recited at the end of claim 7, and it is supported by column 3 of the patent at lines 4-8.</p>
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AMENDMENT OF ORIGINAL PATENT  
CLAIMS MORE THAN ONCE

**Example (7):**

The following illustrates proper claim amendment of original patent claims in reissue applications:

A. The patent claim-

Claim 1. A cutting means having a handle portion and a blade portion.

B. Proper first amendment format-

Claim 1. A [cutting means] knife having a bone handle portion and a notched blade portion.

C. Proper second amendment format-

Claim 1. A [cutting means] knife having a handle portion and a serrated blade portion.

Note that the second amendment must include:

- (a) the changes previously presented in the first amendment; i.e. [cutting means] knife, and
- (b) the new changes presented in the second amendment; i.e. serrated.

The word bone which was presented in the first amendment is now to be deleted in the second amendment. Thus, "bone" is NOT to be shown in brackets in the second amendment. The word "bone" is simply omitted from the claim, since "bone" never appeared in the patent. An explanation of the deletion should appear in the remarks.

The word notched which was presented in the first amendment is replaced by the word serrated in the second amendment. The word notched is being deleted in the second amendment and did not appear in the patent; accordingly, "notched" is not shown in any form in the claim of the second amendment. The word serrated is being added in the second amendment, and accordingly "serrated" is added to the claim and is underlined.

The deletions of "notched" and "bone" in the second amendment are not changes from the original patent claim text and are therefore not shown in brackets in the second amendment. In both the first and the second amendments, the entire claim is presented only with *the changes from the original patent text*, i.e., as compared to the original patent text.

## **C. TRANSITION**

Amendments submitted before the effective date of the 37 CFR 1.121 rule change in the "Changes to Patent Practice and Procedure" Final Rule package, (under the old procedure) need not, and should not, be re-submitted under the new procedure. However, if an amendment *is in fact re-submitted*, it will be entered, unless non-entry is directed or approved by the SPE or SPRE.

The practice outlined above must be complied with for any amendment submitted on or after the effective date of the 37 CFR 1.121 rule change, in a reissue application or reexamination proceeding. Any amendment submitted prior to the effective date may (at applicant's/patent owner's option) comply with either (a) the above-outlined practice or (b) the reissue/reexamination amendment practice previously in effect (since anything submitted under the prior practice would also comply with the new practice).

## ***II. AMENDMENT OF DRAWINGS***

The revised rules which govern amendment of the drawings are as follows:

Paragraph (b)(3) of 37 CFR 1.121 relates to the manner of making amendments to the drawings in a reissue application.

Paragraph (d)(6) of 37 CFR 1.530 relates to the manner of making amendments to the drawings in a reexamination proceeding.

In 37 CFR 1.121(b)(3) and 37 CFR 1.530(d)(6), the following is provided:

- Amendments to the original patent drawing sheets are not permitted.
- Any change to (any of) the patent drawings must be in the form of a new sheet of drawings with any amended figure(s) identified as "amended" and with any added figure(s) identified as "new" for each sheet that has changed and for each added sheet.
- Prior to submitting any new sheet of formal drawings with changes, a permanent ink sketch showing *proposed changes* in red must be filed, as a separate paper, for approval by the examiner.

"Amendment of drawings" means the same thing as "changing the drawings." The procedure for amending (changing) drawings is the same for a reissue application and a reexamination proceeding. The following guidance is provided, and applies to both reissue and reexamination:

- (a) Amending (i.e., changing or physically altering) the original patent drawings sheets is not permitted. Any request to do so should be denied and **no** such requested changes should be approved.
- (b) Where a change to the drawings is desired, a request for the drawing change must be filed. The request must include a sketch in permanent ink showing proposed changes in red and must be filed for approval by the examiner. The request for the drawing change with the sketch attached must be filed as a separate paper. The examiner should inspect the sketch for the presence of new matter, for conformance with the specification as to structure and numbering, and for anything else that could result in the refusal of the request for the drawing change.
- (c) Where the drawing change request is approved, the examiner will require a formal copy of the drawing sheet(s) having the change(s). Each new sheet must identify any changed **figure** as "amended" and any added **figure** as "new." If a new sheet does not have written on it "amended" for any changed figure and "new" for any added figure, it will not be entered. If a drawing figure is to be deleted *in toto*, it should be enclosed in brackets and identified as "amended."
- (d) If the new sheet is proper, the clerk will determine if the new sheet is to replace an existing drawing sheet or is an added sheet. If there is any doubt, the clerk will check with the SPE or with the examiner. If the new sheet is to replace an existing sheet, the existing sheet will be turned over and canceled by placing a large "X" on the back of the sheet, and the new sheet added. If the new sheet is in addition to the existing sheets, the new sheet will simply be added.
- (e) If any drawing change request is not approved or if any submitted sheet of formal drawings is not entered, the examiner will so inform the reissue applicant or reexamination patent owner in the next Office action, and the examiner will set forth the reasons for same.

[The newly submitted sheets and the remaining sheets of unchanged drawings will be used in printing the reissue.]

### *III. Copies of Rules Attached*

Attached as Attachment A is:

- A copy of 37 CFR 1.121(b), which sets forth the requirements for amendments filed in a reissue application.
- A copy of 37 CFR 1.530(d), which sets forth the requirements for amendments filed in a reexamination proceeding.

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*Attachment A*

37 CFR 1.121 Manner of making amendments.

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(b) **Amendments in reissue applications:** Amendments in reissue applications are made by filing a paper, in compliance with 1.52, directing that specified amendments be made.

(1) **Specification other than the claims.** Amendments to the specification, other than to the claims, may only be made as follows:

(i) Amendments must be made by submission of the entire text of a newly added or rewritten paragraph(s) with markings pursuant to paragraph (b)(1)(iii) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph.

(ii) The precise point in the specification must be indicated where the paragraph to be amended is located.

(iii) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the amendments being made.

(2) **Claims.** Amendments to the claims may only be made as follows:

(i)(A) The amendment must be made relative to the patent claims in accordance with paragraph (b)(6) of this section and must include the entire text of each claim which is being amended by the current amendment and of each claim being added by the current amendment with markings pursuant to paragraph (b)(2)(i)(C) of this section, except that a patent claim or added claim should be cancelled by a statement cancelling the patent claim or added claim without presentation of the text of the patent claim or added claim.

(B) Patent claims must not be renumbered and the numbering of any claims added to the patent must follow the number of the highest numbered patent claim.

(C) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the amendments being made. If a claim is amended pursuant to paragraph (b)(2)(i)(A) of this section, a parenthetical expression "amended," "twice amended, etc., should follow the original claim number.

(ii) Each amendment submission must set forth the status (i.e., pending or cancelled) as of the date of the amendment, of all patent claims and of all added claims.

(iii) Each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment along with any additional comments on page(s) separate from the page(s) containing the amendment.

(3) **Drawings.**

(i) Amendments to the original patent drawings are not permitted. Any change to the patent drawings must be by way of a new sheet of drawings with the amended figures identified as "amended" and with added figures identified as "new" for each sheet changed submitted in compliance with 1.84.

(ii) Where a change to the drawings is desired, a sketch in permanent ink showing proposed changes in red, to become part of the record, must be filed for approval by the examiner and should be in a separate paper.

(4) The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(5) No reissue 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, pursuant to 35 U.S.C. 251. No amendment to the patent may introduce new matter or be made in an expired patent.

(6) All amendments must be made relative to the patent specification, including the claims, and drawings, which is in effect as of the date of filing of the reissue application.

**37 CFR 1.530 Statement; amendment by patent owner.**

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**(d) Amendments in reexamination proceedings.** Amendments in reexamination proceedings are made by filing a paper, in compliance with paragraph (d)(5) of this section, directing that specified amendments be made.

**(1) Specification other than the claims.** Amendments to the specification, other than to the claims, may only be made as follows:

(i) Amendments must be made by submission of the entire text of a newly added or rewritten paragraph(s) with markings pursuant to paragraph (d)(1)(iii) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph.

(ii) The precise point in the specification must be indicated where the paragraph to be amended is located.

(iii) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the amendments being made.

**(2) Claims.** Amendments to the claims may only be made as follows:

(i)(A) The amendment must be made relative to the patent claims in accordance with paragraph (d)(8) of this section and must include the entire text of each claim which is being proposed to be amended by the current amendment and each proposed new claim being added by the current amendment with markings pursuant to paragraph (d)(2)(i)(C) of this section, except that a patent claim or previously proposed new claim should be cancelled by a statement cancelling the patent claim or proposed new claim without presentation of the text of the patent claim or proposed new claim.

(B) Patent claims must not be renumbered and the numbering of any new claims proposed to be added to the patent must follow the number of the highest numbered patent claim.

(C) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the amendments being made. If a claim is amended pursuant to paragraph (d)(2)(i)(A) of this section, a parenthetical expression "amended," "twice amended,etc., should follow the original claim number.

(ii) Each amendment submission must set forth the status (i.e., pending or cancelled) as of the date of the amendment, of all patent claims and of all new claims currently or previously proposed.

(iii) Each amendment, when submitted for the first time, must be accompanied by an explanation of the support in the disclosure of the patent for the amendment along with any additional comments on page(s) separate from the page(s) containing the amendment.

**(3) No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment will be incorporated into the patent by certificate issued after the expiration of the patent.**

**(4) Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued.**

(5) The form of amendments other than to the patent drawings must be in accordance with the following requirements. All amendments must be in the English language and must be legibly written either by a typewriter or mechanical printer in at least 11 point type in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, non-shiny, durable, white paper. All amendments must be presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photoffset, and microfilming processes and electronic reproduction by use of digital imaging or optical character recognition. If the amendments are not of the required quality, substitute typewritten or mechanically printed papers of suitable quality will be required. The papers, including the drawings, must have each page plainly written on only one side of a sheet of paper. The sheets of paper must be the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8 and 1/2 by 11 inches). Each sheet must include a top margin of at least 2.0 cm. (3/4 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (3/4 inch), and a bottom margin of at least 2.0 cm. (3/4 inch), and no holes should be made in the sheets as submitted. The lines must be double spaced, or one and onhalf spaced. The pages must be numbered consecutively, starting with 1, the numbers being centrally located, preferably below the text, or above the text.

(6) Drawings.

(i) The original patent drawing sheets may not be altered. Any proposed change to the patent drawings must be by way of a new sheet of drawings with the amended figures identified as "amended" and with added figures identified as "new" for each sheet change submitted in compliance with 1.84.

(ii) Where a change to the drawings is desired, a sketch in permanent ink showing proposed changes in red, to become part of the record, must be filed for approval by the examiner and should be in a separate paper.

(7) The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(8) All amendments to the patent must be made relative to the patent specification, including the claims, and drawings, which is in effect as of the date of filing of the request for reexamination.