

Chapter 1400 Correction of Patents

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- 1400.01 Introduction [R-2]**
- A patent may be corrected or amended in four ways, namely:
- (A) by reissue,
 - (B) by the issuance of a certificate of correction which becomes a part of the patent,
 - (C) by disclaimer, and
 - (D) by reexamination.
- The first three ways are discussed in this chapter while the fourth way (reexamination) is discussed in MPEP Chapter 2200 >for *ex parte* reexamination and MPEP Chapter 2600 for *inter partes* reexamination<.

1401 Reissue [R-3]

35 U.S.C. 251. *Reissue of defective patents.*

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of 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, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

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 provisions of 35 U.S.C. 251 permit the reissue of a patent to correct an error in the patent made without any deceptive intention and provide criteria for the reissue. 37 CFR 1.171 through 1.178 are rules directed to reissue.

1402 Grounds for Filing [R-3]

A reissue application is filed to correct an error in the patent which was made without any deceptive intention, where, as a result of the error, the patent is deemed wholly or partly inoperative or invalid. An error in the patent arises out of an error in conduct which was made in the preparation and/or prosecution of the application which became the patent.

There must be at least one error in the patent to provide grounds for reissue of the patent. If there is no error in the patent, the patent will not be reissued. The present section provides a discussion of what may be considered an error in the patent upon which to base a reissue application.

In accordance with 35 U.S.C. 251, the error upon which a reissue is based must be one which causes the patent to be “deemed wholly or partly inoperative or invalid, by reason of 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.”

Thus, an error under 35 U.S.C. 251 *has not been presented* where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251. These corrections to a patent do not provide a basis for reissue (although these corrections may also be included in a reissue application, where a 35 U.S.C. 251 error is already present).

These corrections may be made via a certificate of correction; see MPEP § 1481.

The most common bases for filing a reissue application are:

- (A) the claims are too narrow or too broad;
- (B) the disclosure contains inaccuracies;
- (C) applicant failed to or incorrectly claimed foreign priority; and
- (D) applicant failed to make reference to or incorrectly made reference to prior copending applications.

An attorney’s failure to appreciate the full scope of the invention was held to be an error correctable through reissue in the decision of *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). The correction of misjoinder of inventors in divisional reissues has been held to be a ground for reissue. See *Ex parte Scudder*, 169 USPQ 814 (Bd. App. 1971). The Board of Appeals held in *Ex parte Scudder*, 169 USPQ at 815, that 35 U.S.C. 251 authorizes reissue application to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate.

Reissue may no longer be necessary under the facts in *Ex parte Scudder, supra*, in view of 35 U.S.C. 116 which provides, *inter alia*, that:

“Inventors may apply for a patent jointly even though . . .
(3) each did not make a contribution to the subject matter of every claim in the patent.”

See also 37 CFR 1.45(b)(3).

If the only change being made in the patent is correction of the inventorship, this can be accomplished by filing a request for a certificate of correction under the provisions of 35 U.S.C. 256 and 37 CFR 1.324. See MPEP § 1412.04 and § 1481. A Certificate of Correction will be issued if all parties are in agreement and the inventorship issue is not contested.

A reissue was granted in *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), where

the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119(a)-(d) before the patent was granted.

In *Brenner*, the claim for priority had been made in the prosecution of the original patent, and it was only necessary to submit a certified copy of the priority document in the reissue application to perfect priority. Reissue is also available to convert the “error” in failing to take any steps to obtain the right of foreign priority under 35 U.S.C. 119(a)-(d) before the patent was granted. In a situation where it is necessary to submit for the first time both the claim for priority and the certified copy of the priority document in the reissue application, and the patent to be reissued resulted from a utility or plant application which became the patent to be reissued was filed on or after November 29, 2000, the reissue applicant must (where it is necessary to submit for the first time the claim for priority) also file a petition for an unintentionally delayed priority claim under 37 CFR 1.55(c) in addition to filing a reissue application. See MPEP § 201.14(a).

The courts have not addressed the question of correction of the failure to adequately claim benefit under 35 U.S.C. 119(e) in the application (which became the patent to be reissued) via reissue. If the application which became the patent to be reissued was filed prior to November 29, 2000, correction as to benefit under 35 U.S.C. 119(e) would be permitted in a manner somewhat analogous to that of the priority correction discussed above. Under no circumstances, however, can a reissue be employed to correct an applicant’s mistake by adding or correcting a benefit claim under 35 U.S.C. 119(e) where the application, which became the patent to be reissued, was filed on or after November 29, 2000.

Section 4503 of the American Inventors Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:

No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an

amendment under this section *during the pendency of the application*. >(Emphasis added.)<

35 U.S.C. 119(e)(1), as amended by the AIPA, clearly prohibits the addition or correction of benefit claims under 35 U.S.C. 119(e) when the application is no longer pending, e.g., an issued patent. Therefore, a reissue is not a valid mechanism for adding or correcting a benefit claim under 35 U.S.C. 119(e) after a patent has been granted >(where the application which became the patent to be reissued was filed on or after November 29, 2000)<.

Correction of failure to adequately claim *>benefit< under 35 U.S.C. 120 in an earlier filed copending U.S. patent application was held a proper ground for reissue. *Sampson v. Comm’r Pat.*, 195 USPQ 136, 137 (D.D.C. 1976). If the utility or plant application which became the patent to be reissued was filed on or after November 29, 2000, the reissue applicant must file a petition for an unintentionally delayed priority claim under 37 CFR 1.78(a)(3) ** in addition to filing a reissue application. See MPEP § 201.11. For treatment of an error involving disclaimer of a *>benefit< claim under 35 U.S.C. 120, see MPEP 1405. >If the utility or plant application which became the patent to be reissued was filed prior to November 29, 2000 and therefore, not subject to the eighteen-month publication (e.g., one of the categories set forth in 37 CFR 1.78(a)(2)(ii)(A) – (C)), a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) would not be required to add/correct the benefit claim in the reissue application. This is so, even if the reissue application was filed on or after November 29, 2000. On the other hand, if applicant fails to file an amendment to add a claim for benefit of a prior-filed reissue application in a later-filed reissue application within the time period set forth in 37 CFR 1.78(a)(2), then a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) along with the surcharge set forth in 37 CFR 1.17(t) would be required if the later-filed reissue application is a utility or plant application filed on or after November 29, 2000 irrespective of whether the original application which became the original patent was filed prior to November 29, 2000. This is because the benefit claim is between the later-filed reissue application and the prior-filed reissue application and the benefit claim is not being added to make a correction as to a benefit of the original patent.<

A reissue applicant's failure to timely file a divisional application covering the non-elected invention(s) following a restriction requirement is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such applicant's error is not correctable by reissue of the original patent under 35 U.S.C. 251. See MPEP § 1412.01.

A reissue may be based on a drawing correction that is substantive in nature, because such a correction qualifies as correcting an "error" under 35 U.S.C. 251 that may properly be deemed to render the patent wholly or partly inoperative. A reissue application cannot be based on a non-substantive drawing change, such as a reference numeral correction or addition, the addition of shading, or even the addition of an additional figure merely to "clarify" the disclosure. Non-substantive drawing changes may, however, be included in a reissue application that corrects at least one substantive "error" under 35 U.S.C. 251.

1403 Diligence in Filing [R-3]

When a reissue application is filed within 2 years from the date of the original patent, a rejection on the grounds of lack of diligence or delay in filing the reissue should not normally be made. *Ex parte Lafferty*, 190 USPQ 202 (Bd. App. 1975); but see *Rohm & Haas Co. v. Roberts Chemical Inc.*, 142 F. Supp. 499, 110 USPQ 93 (S.W. Va. 1956), *rev'd on other grounds*, 245 F.2d 693, 113 USPQ 423 (4th Cir. 1957).

The fourth paragraph of 35 U.S.C. 251 states:

"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."

Where any broadening reissue application is filed within two years from the date of the original patent, 35 U.S.C. 251 presumes diligence, and the examiner should not inquire why applicant failed to file the reissue application earlier within the two year period.

See MPEP § 1412.03 for broadening reissue practice. See also *In re Graff*, 111 F.3rd 874, 42 USPQ2d 1471 (Fed. Cir. 1997); *In re Bennett*, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985); *In re Fotland*, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985).

A reissue application that is filed on the 2-year anniversary date of the patent grant is considered as being filed within 2 years. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) (a similar rule in interferences).

A reissue application can be granted a filing date without an oath or declaration, or without the >basic< filing fee>, search fee, or examination fee< being present. See 37 CFR 1.53(f). Applicant will be given a period of time to provide the missing parts and to pay the surcharge under 37 CFR 1.16(*>f<). See MPEP § 1410.01.

1404 Submission of Papers Where Reissue Patent Is in Litigation [R-2]

>Marking of envelope:< Applicants and protestors (see MPEP § 1901.03) submitting papers for entry in reissue applications of patents involved in litigation are requested to mark the outside envelope and the top right-hand portion of the papers with the words "REISSUE LITIGATION" and with the art unit or other area of the United States Patent and Trademark Office in which the reissue application is located, e.g., Commissioner for Patents, Board of Patent Appeals and Interferences, Office of Patent Legal Administration, Technology Center, Office of Patent Publication, etc. ** >Marking of papers:< Any "Reissue Litigation" papers mailed to the Office should be so marked. The markings preferably should be written in a bright color with a felt point marker. Papers marked "REISSUE LITIGATION" will be given special attention and expedited handling. >(For IFW processing, see IFW Manual.)< See MPEP § 1442.01 through § 1442.04 for examination of litigation-related reissue applications. >Protestor's participation, including the submission of papers, is limited in accordance with 37 CFR 1.291(c).<

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1405 Reissue and Patent Term [R-2]

35 U.S.C. 251 prescribes the effect of reissue on the patent term by stating that "the Director shall... reissue the patent... for the unexpired term of the original patent."

The maximum term of the original patent is fixed at the time the patent is granted. While the term may be subsequently shortened, e.g., through the filing of a terminal disclaimer, it cannot be extended through the

filing of a reissue. Accordingly, a deletion in a reissue application of an earlier-obtained benefit claim under 35 U.S.C. 120 will not operate to lengthen the term of the patent to be reissued.

When a reissue application has been filed in an attempt to delete an earlier-obtained benefit claim under 35 U.S.C. 120, it should be treated as follows:

(A) More than one “error” (as defined by 35 U.S.C. 251) is described in a reissue declaration, and one of the errors identified is the failure to delete a 35 U.S.C. 120 benefit claim in the original patent, or the erroneous making of a claim for 35 U.S.C. 120 benefit.

If one of the errors identified is the presence of the claim for 35 U.S.C. 120 benefit in the patent, and patentee (1) states a belief that this error renders the original patent wholly or partly inoperative or invalid, and (2) is seeking to eliminate this error via the reissue proceeding, the Office will permit entry of an accompanying amendment deleting the benefit claim in the continuity data, and will not object to or reject the reissue declaration. Assuming the reissue declaration appropriately identifies or describes at least one other error being corrected, the reissue declaration would not be objected to for failure to comply with the requirements of 37 CFR 1.175.

Where the reissue declaration states that the patentee is making this correction in order to extend the term of the original patent, the examiner’s Office action will merely refer to the statement in the declaration and then point out with respect to such statement that 35 U.S.C. 251 only permits reissue “... for the unexpired part of the term of the original patent.”

(B) Only one “error” (as defined by 35 U.S.C. 251) is described in a reissue declaration, and that error is the failure to delete a 35 U.S.C. 120 benefit claim in the original patent, or the erroneous making of a claim for 35 U.S.C. 120 benefit.

(1) If the only error identified in the reissue declaration is stated to be the correction or adjustment of the patent term by deleting the 35 U.S.C. 120 benefit claim, a rejection under 35 U.S.C. 251 should be made, based on the lack of an appropriate error for reissue and failure to comply with 37 CFR 1.175.

(2) If the only error identified in the reissue declaration is the need to delete a 35 U.S.C. 120 benefit claim, which the patentee seeks to now delete in the reissue application, (and no reference is made as

to increasing the term of the patent), the examiner should not make a rejection under 35 U.S.C. 251 based on lack of an appropriate error for reissue and failure to comply with 37 CFR 1.175. The examiner should examine the reissue application in accordance with 37 CFR 1.176 (MPEP § 1440). A statement should, however, be made in an Office action pointing out the lack of effect (of the change in the patent) on the patent term because 35 U.S.C. 251 only permits reissue “... for the unexpired part of the term of the original patent.”<

1406 Citation and Consideration of References Cited in Original Patent [R-3]

In a reissue application, the examiner should consider and list on a PTO-892 form all references that have been cited during the original prosecution of the patent. See MPEP § 1455. An exception to this practice might be where the references cited in the original patent may no longer be relevant, e.g., in view of a narrowing of the claim scope in the reissue application.

Should applicants wish to ensure that all of the references which were cited in the original patent are considered and cited in the reissue application, an information disclosure statement (IDS) in compliance with 37 CFR 1.97 and 1.98 should be filed in the reissue application. See MPEP § 609. **>The requirement for a copy of each U.S. patent or U.S. patent application publication listed in an IDS has been eliminated, unless required by the Office. 37 CFR 1.98(a)(2) requires

- (A) a legible copy of each foreign patent,
- (B) each publication or that portion which caused it to be listed,
- (C) each pending unpublished U.S. application unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system. The requirement in 37 CFR 1.98(a)(2)(iii) for a legible copy of the specification, including the claims and drawings of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is *sua sponte* waived where the cited pending application is stored in the Office’s IFW system. See *Waiver of the Copy Requirement in 37 CFR 1.98 for Cited*

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(D) all other information or that portion which caused it to be listed.

See MPEP § 609.04(a). The Office imposes no responsibility on a reissue applicant to resubmit, in a reissue application, all the “References Cited” in the patent for which reissue is sought. Rather, applicant has a continuing duty under 37 CFR 1.56 to timely apprise the Office of any information which is material to the patentability of the claims under consideration in the reissue application. See MPEP § 1418.

Where a copy of a reference other than a U.S. patent or U.S. patent application publication is not available and cannot be obtained through any source other than the reissue applicant (who has not submitted the copy), the examiner will not indicate on PTO-892 or PTO/SB/08 submitted by applicant that a reference has been considered.

1410 Content of Reissue Application [R-3]

37 CFR 1.171. Application for reissue.

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications.

37 CFR 1.173. Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. 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.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue

application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

The specification (including the claims and any drawings) of the reissue application is the copy of the printed patent for which reissue is requested that is submitted by applicant as part of the initial application papers. The copy of the printed patent must be submitted in double column format, each page of double column format being on only one side of the piece of paper. It should be noted that a re-typed specification is not acceptable in a reissue application; the full copy of the printed patent must be used. In addition, an applicant for reissue is required to file a reissue oath or declaration which, in addition to complying with 37 CFR 1.63, must comply with 37 CFR 1.175. Where the patent has been assigned, the reissue applicant must also provide a consent of assignee to the reissue and evidence of ownership. Where the patent has not been assigned, the reissue applicant should affirmatively state that the patent is not assigned.

An amendment may be submitted at the time of filing of a reissue application. The amendment may be made either by:

(A) physically incorporating the changes within the specification by cutting the column of the printed patent and inserting the added material and rejoining the remainder of the column and then joining the resulting modified column to the other column of the printed patent. Markings pursuant to 37 CFR 1.173(d) must be used to show the changes. The columnar structure of the printed patent must be preserved, and the physically modified page must comply with 37 CFR 1.52(a)(1). As to compliance with 37 CFR 1.52(a)(1)(iv), the “written either by a typewriter or machine printer in permanent dark ink or its equivalent” requirement is deemed to be satisfied where a caret and line are drawn from a position within the text to a newly added phrase, clause, sentence, etc. typed legibly in the margin; or

(B) providing a separate amendment paper with the reissue application.

In either case, the amendment must be made pursuant to 37 CFR 1.173(b) and must comply with all the provisions of 37 CFR 1.173(b)–(e) and (g).

>If the changes to be made to the patent are so extensive that reading and understanding the specification is extremely difficult and error-prone, a clean, typed copy of the specification may be submitted if accompanied by a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1).<

Pursuant to 37 CFR 1.173(a)(1), applicant is required to include a copy of any disclaimer (37 CFR 1.321), certificate of correction (37 CFR 1.322 – 1.324), or reexamination certificate (37 CFR 1.520) issued in the patent for which reissue is requested. It should also be noted that 37 CFR 1.178(b) requires reissue applicants to call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigation (litigation covers any papers filed in the court or issued by the court, such as, for example, motions, pleadings, and court decisions including court orders) and the results of such proceedings. This duty to submit such information is a continuing duty, and runs from the time the reissue application is filed until the reissue application is abandoned or issues as a reissue patent.

It is no longer required that the reissue applicant ****>physically< surrender the original patent, see MPEP § 1416**.**

Where appropriate, the reissue applicant may provide a claim for priority benefit under 35 U.S.C. 119

or 120, and may also file an Information Disclosure Statement.

The initial contents of a reissue application are discussed in detail in MPEP § 1410.01 through § 1418.

For expedited processing, new and continuing reissue application filings under 37 CFR 1.53(b) may be addressed to: Mail Stop REISSUE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. Mail Stop REISSUE should only be used for the initial filing of reissue applications, and should not be used for any subsequently filed correspondence in reissue applications. All new reissue filings should include a copy of a completed Reissue Patent Application Transmittal Form (PTO/SB/50) to ensure that the filing of the new application will be recognized as being for a reissue application.

The oath or declaration, any matters ancillary thereto (such as the consent of assignee), and the >basic< filing fee>, search fee, and examination fee< may be submitted after the filing date pursuant to 37 CFR 1.53(f).

The requirement for the assignee to consent to filing a reissue no longer includes a requirement for applicant to order a title report with the filing of the reissue application. Rather, the assignee entity is established by a statement on behalf of all the assignees under 37 CFR 1.172(a) and 37 CFR 3.73(b). See MPEP § 1410.01.

Form PTO/SB/50, Reissue Patent Application Transmittal, may be used for filing reissue applications.

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PTO/SB/50 (04-05)

Approved for use through 04/30/2007. OMB 0651-0033

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE PATENT APPLICATION TRANSMITTAL

Address to: Mail Stop Reissue Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Attorney Docket No.	
	First Named Inventor	
	Original Patent Number	
	Original Patent Issue Date (Month/Day/Year)	
	Express Mail Label No.	

APPLICATION FOR REISSUE OF: (Check applicable box) Utility Patent Design Patent Plant Patent

APPLICATION ELEMENTS (37 CFR 1.173)	ACCOMPANYING APPLICATION PARTS
1. <input type="checkbox"/> Fee Transmittal Form (PTO/SB/56) (Submit a duplicate copy) 2. <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. 3. <input type="checkbox"/> Specification and Claims in double column copy of patent format (amended, if appropriate) 4. <input type="checkbox"/> Drawing(s) (proposed amendments, if appropriate) 5. <input type="checkbox"/> Reissue Oath/Declaration (original or copy) (37 C.F.R. 1.175) (PTO/SB/51 or 52) 6. <input type="checkbox"/> Power of Attorney 7. <input type="checkbox"/> Original U.S. Patent currently assigned? <input type="checkbox"/> Yes <input type="checkbox"/> No (If Yes, check applicable box(es)) <input type="checkbox"/> Written Consent of all Assignees (PTO/SB/53) <input type="checkbox"/> 37 CFR 3.73(b) Statement (PTO/SB/96) 8. <input type="checkbox"/> CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table <input type="checkbox"/> Landscape Table on CD 9. Nucleotide and/or Amino Acid Sequence Submission (if applicable, items a. – c. are required) a. <input type="checkbox"/> Computer Readable Form (CRF) b. Specification Sequence Listing on: i <input type="checkbox"/> CD-ROM (2 copies) or CD-R (2 copies); or ii <input type="checkbox"/> paper c. <input type="checkbox"/> Statements verifying identity of above copies	10. <input type="checkbox"/> Statement of status and support for all changes to the claims. See 37 CFR 1.173(c). 11. <input type="checkbox"/> Foreign Priority Claim (35 U.S.C. 119) (if applicable) 12. <input type="checkbox"/> Information Disclosure Statement (IDS) PTO/SB/08 or PTO-1449 <input type="checkbox"/> Copies of foreign patent documents, publications & other information 13. <input type="checkbox"/> English Translation of Reissue Oath/Declaration (if applicable) 14. <input type="checkbox"/> Preliminary Amendment 15. <input type="checkbox"/> Return Receipt Postcard (MPEP 503) (Should be specifically itemized) 16. <input type="checkbox"/> Other:

17. CORRESPONDENCE ADDRESS

The address associated with Customer Number: OR Correspondence address below

Name			
Address			
City	State	Zip Code	
Country	Telephone	Email	
Signature			Date
Name (Print/Type)	Registration No. (Attorney/Agent)		

This collection of information is required by 37 CFR 1.173. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Reissue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
 If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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1410.01 Reissue Applicant, Oath or Declaration, and Consent of all Assignees [R-3]

37 CFR 1.172. *Applicants, assignees.*

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b) of this chapter.

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

37 CFR 3.73. *Establishing right of assignee to take action.*

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:<

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the

Office may refuse to accept the submission as an establishment of ownership.

The reissue oath must be signed and sworn to by all the inventors, or declaration made by all the inventors, except as otherwise provided in 37 CFR 1.42, 1.43, and 1.47 (see MPEP § 409). Pursuant to 37 CFR 1.172, where the reissue application does *not* seek to enlarge the scope of any of the claims of the original patent, the reissue oath may be made and sworn to, or declaration made, by the assignee of the entire interest. Depending on the circumstances, either Form PTO/SB/51, Reissue Application Declaration by the Inventor, or Form PTO/SB/52, Reissue Application Declaration by the Assignee, may be used to prepare a declaration in a reissue application. These forms are reproduced in MPEP § 1414.

If an inventor is to be added in a reissue application, a proper reissue oath or declaration including the signatures of all of the inventors is required. If one or more inventors are being deleted in a reissue application, an oath or declaration must be supplied over the signatures of the remaining inventors. Note that although an inventor being deleted in a reissue application need not sign the oath or declaration, if that inventor to be deleted has any ownership interest in the patent (*e.g.*, that inventor did not assign away his/her rights to the patent), the signature of that inventor must be supplied in the consent to filing the reissue application. See MPEP § 1412.04 as to correction of inventorship via reissue.

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I. < CONSENT TO THE REISSUE

Where no assignee exists, applicant should affirmatively state that fact. This can be done by simply checking the “NO” box of item 7 of Form PTO/SB/50 (which form may be signed by the inventors, or by a registered practitioner). If the file record is silent as to the existence of an assignee, it will be presumed that *an assignee does exist*. This presumption should be set forth by the examiner in the first Office action alerting applicant to the requirement. It should be noted that the mere filing of a written assertion of small entity status in no way relieves applicant of the requirement to affirmatively state that no assignee exists.

Where a written assertion of small entity status, or other paper in file indicates that the application/patent

is assigned, and there is no consent by the assignee named in the written assertion of small entity, the examiner should make inquiry into the matter in an Office action, even if the record otherwise indicates that the application/patent is not assigned.

The reissue oath or declaration must be accompanied by the written consent of all assignees. 35 U.S.C. 111(a) and 37 CFR 1.53(b) provide, however, for according an application a filing date if filed with a specification, including claim(s), and any required drawings. Thus, where an application is filed without an oath or declaration, or without the consent of all assignees, if the application otherwise complies with 37 CFR 1.53(b) and the reissue rules, the Office of Initial Patent Examination (OIPE) will accord a filing date and send out a notice of missing parts setting a period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(f) and 1.16(*>f<). If the reissue oath or declaration is filed but the assignee consent is lacking, the surcharge is required because, until the consent is filed, the reissue oath or declaration is defective, since it is not apparent that the signatures thereon are proper absent an indication that the assignees have consented to the filing.

The consent of assignee must be signed by a party authorized to act on behalf of the assignee. See MPEP § 324 for a discussion of parties authorized to act on behalf of the assignee. The consent to the reissue application may use language such as:

The XYZ Corporation, assignee of U.S. Patent No. 9,999,999, consents to the filing of reissue application No. 09/999,999 (or the present application, if filed with the initial application papers) for the reissue of U.S. Patent No. 9,999,999.

Lilly M. Schor

Vice President,

XYZ Corporation

Where the written consent of all the assignees to the filing of the reissue application cannot be obtained, applicant may under appropriate circumstances petition to the Office of Petitions (MPEP § 1002.02(b)) for a waiver under 37 CFR 1.183 of the requirement of 37 CFR 1.172, to permit the acceptance of the filing of the reissue application. The petition fee under 37 CFR 1.17(*>f<) must be included with the petition.

The reissue application can then be examined, but will not be allowed or issued without the consent of all the assignees as required by 37 CFR 1.172. See *Baker Hughes Inc. v. Kirk*, 921 F.Supp. 801, 809, 38 USPQ2d 1885, 1892 (D.D.C. 1995), *N. B. Fasset*, 1877 C.D. 32, 11 O.G. 420 (Comm'r Pat. 1877); *James D. Wright*, 1876 C.D. 217, 10 O.G. 587 (Comm'r Pat. 1876).

Where a **continuation** reissue application is filed with a copy of the assignee consent from the parent reissue application, and the parent reissue application is not to be abandoned, the copy of the consent should not be accepted. Where a **divisional** reissue application is filed with a copy of the assignee consent from the parent reissue application, regardless of whether or not the parent reissue application is to be abandoned, the copy of the consent should not be accepted. The copy of the consent from the parent does not indicate that the assignee has consented to the addition of the new invention of the divisional reissue application to the original patent, or to the addition of the new error correction of the continuation reissue application. (Presumably, a new correction has been added via the continuation, since the parent is still pending.) As noted above, OIPE will accord a filing date and send out a notice of missing parts stating that there is no proper consent and setting a period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(f) and 1.16(*>f<)

Where a continuation reissue application is filed with a copy of the assignee consent from the parent reissue application, and the parent reissue application is, or will be abandoned, the copy of the consent should be accepted by the Office.

Form paragraph 14.15 may be used to indicate that the consent of the assignee is lacking.

¶ *14.15 Consent of Assignee to Reissue Lacking*

This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

Examiner Note:

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.
2. If a consent document/statement has been submitted but is insufficient (e.g., not by all the assignees) or is otherwise ineffective (e.g., a conditional consent, or a copy of the consent from the parent reissue application was filed in this continuation reissue application and the parent reissue application is not being abandoned), an explanation of such is to be included following this form paragraph.
3. If the case is otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

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II. < PROOF OF OWNERSHIP OF ASSIGNEE

The assignee that consents to the filing of the reissue application (as discussed above) must also establish that it is the assignee, *i.e.*, the owner, of the patent. See 37 CFR 1.172. *Accordingly, a 37 CFR 3.73(b) paper establishing the ownership of the assignee should be submitted at the time of filing the reissue application, in order to support the consent of the assignee.* The assignee must establish its ownership in accordance with 37 CFR 3.73(b) by:

(A) filing in the reissue application documentary evidence of a chain of title from the original owner to the assignee; or

(B) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

Documents that are submitted to establish ownership may be required to be recorded. Compliance with 37 CFR 3.73(b) may be provided as part of the same paper in which the consent by assignee is provided.

Upon initial receipt of a reissue application, the examiner should inspect the application to determine

whether the submission under 37 CFR 1.172 and 37 CFR 3.73(b) establishing the ownership of the assignee is present and sufficient.

If an assignment document is attached with the 37 CFR 3.73(b) submission, the assignment should be reviewed to ensure that the named assignee is the same for the assignment document and the 37 CFR 3.73(b) statement, and that the assignment document is an assignment of the patent to be reissued to the assignee. If an assignment document is not attached with the 37 CFR 3.73(b) statement, but rather the reel and frame number where the assignment document is recorded in the USPTO is referenced in the 37 CFR 3.73(b) statement, it will be presumed that the assignment recorded in the USPTO supports the statement identifying the assignee. It will not be necessary for the examiner to obtain a copy of the recorded assignment document. If the submission under 37 CFR 1.172 and 37 CFR 3.73(b) is not present, form paragraph 14.16 may be used to indicate that the assignee has not provided evidence of ownership.

¶ *14.16 Failure of Assignee To Establish Ownership*

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

Examiner Note:

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.
2. If otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

Just as the consent of assignee must be signed by a party authorized to act on behalf of the assignee, the submission with respect to 37 CFR 3.73(b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. The signature of an attorney or agent registered to practice before the

Office is not sufficient, unless that attorney or agent is authorized to act on behalf of the assignee.

If the submission under 37 CFR 3.73(b) to establish ownership is not signed by a party authorized to act on behalf of the assignee, the appropriate paragraphs of form paragraphs 14.16.01 through 14.16.06 may be used.

¶ *14.16.01 Establishment of Ownership Not Signed by Appropriate Party*

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the assignee. 37 CFR 3.73(b)

A proper submission establishing ownership interest in the patent, pursuant to 37 CFR 1.172(a), is required in response to this action.

Examiner Note:

1. This form paragraph should be followed: (a) by one of form paragraphs 14.16.02 through 14.16.04, (b) then by form paragraph 14.16.05, (c) then optionally by form paragraph 14.16.06.
2. See MPEP § 1410.01.

¶ *14.16.02 Failure To State Capacity To Sign*

The person who signed the submission establishing ownership interest has failed to state his/her capacity to sign for the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

Examiner Note:

1. This form paragraph is to be used when the person signing the submission establishing ownership interest does not state his/her capacity (e.g., as a recognized officer) to sign for the assignee, and is not established as being authorized to act on behalf of the assignee.
2. Use form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly sign a submission establishing ownership interest.

¶ *14.16.03 Lack of Capacity To Sign*

The person who signed the submission establishing ownership interest is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

¶ *14.16.04 Attorney/Agent of Record Signs*

The submission establishing ownership interest was signed by applicant's [1]. An attorney or agent of record is not authorized to sign a submission establishing ownership interest, unless he/she

has been established as being authorized to act on behalf of the assignee. See MPEP § 324.

Examiner Note:

1. This form paragraph is to be used when the person signing the submission establishing ownership interest is an attorney or agent of record who is not an authorized officer as defined in MPEP § 324 and has not been established as being authorized to act on behalf of the assignee.
2. Use form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly sign a submission establishing ownership interest.
3. In bracket 1, insert either --attorney-- or --agent--.

¶ *14.16.06 Criteria To Accept When Signed by a Non-Recognized Officer*

It would be acceptable for a person, other than a recognized officer, to sign a submission establishing ownership interest, provided the record for the application includes a duly signed statement that the person is empowered to sign a submission establishing ownership interest and/or act on behalf of the assignee.

Accordingly, a new submission establishing ownership interest which includes such a statement above, will be considered to be signed by an appropriate official of the assignee. A separately filed paper referencing the previously filed submission establishing ownership interest and containing a proper empowerment statement would also be acceptable.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.16.02, 14.16.03 or 14.16.04.
2. When one of form paragraphs 14.16.02, 14.16.03 or 14.16.04 is used to indicate that a submission establishing ownership interest is not proper because it was not signed by a recognized officer, this form paragraph should be used to point out one way to correct the problem.
3. While an indication of the person's title is desirable, its inclusion is not mandatory when this option is employed.

Where the submission establishes the assignee's ownership as to the patent, ownership as to the reissue application will be presumed. Accordingly, a submission as to the ownership of the patent will be construed to satisfy the 37 CFR 1.172 (and 37 CFR 3.73(b)) requirements for establishing ownership of the application. Thus, a terminal disclaimer can be filed in a reissue application where ownership of the patent has been established, without the need for a separate submission under 37 CFR 3.73(b) showing ownership of the reissue application.

Even if the submission states that it is establishing ownership of the reissue application (rather than the patent), the submission should be accepted by the examiner as also establishing ownership in the patent.

The documentation in the submission establishing ownership of the reissue application must, of necessity, include chain of title as to the patent.

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III. < COMPARISON OF ASSIGNEE THAT CONSENTS TO ASSIGNEE SET FORTH IN SUBMISSION ESTABLISHING OWNERSHIP INTEREST

The examiner must inspect both the consent and documentary evidence of ownership to determine whether the requirements of 37 CFR 1.172 have been met. The assignee *->identified< by the documentary evidence must be the same assignee which signed the consent. Also, the person who signs the consent for the assignee and the person who signs the submission of evidence of ownership for the assignee must both be persons having authority to do so. See also MPEP § 324.

The reissue patent will be granted to the original patentee, his or her legal representatives or assigns as the interest may appear.

1411 Form of Specification [R-3]

37 CFR 1.173. *Reissue specification, drawings, and amendments.*

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. 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.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with

paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

The file wrappers of all /08 and earlier series reissue applications are stamped “REISSUE” above the application number on the front of the file. “Reissue” also appears below the application number on the printed label on the file wrapper of the application with 08/ and earlier series.

Reissue applications filed after July of 1998 (09/ series and later) are placed in an orange and white striped file wrapper and can be easily identified as reissue applications. (For IFW Processing, see IFW Manual.)

Reissue applications filed prior to November 7, 2000 should be furnished in the form of cut-up soft copies of the original patent, with only a single column of the printed patent securely mounted on a separate sheet of paper.

For reissue applications filed on or after November 7, 2000, 37 CFR 1.173(a)(1) requires that the application specification, including the claims, must be furnished in the form of a copy of the printed patent in double column format (so that the patent can be simply copied without cutting). Applicants are required to submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed (37 CFR 1.173(a)(2)). Any changes to the drawings must be made in accordance with 37 CFR 1.173(b)(3). Thus, a full copy of the printed patent (including the front page) is used to provide the abstract, drawings, specification, and claims of the patent for the reissue application. Each page of the patent must appear on only one side of each individual page of the specification of the reissue application; a two-sided copy of the patent is not proper. It should be noted that a re-typed specification is not acceptable in a reissue application; the full copy of the printed patent must be used. If, however, the changes to be made to the patent are so extensive/numerous that reading and understanding the specification is extremely difficult and error-prone, a clean copy of the specification may be submitted if accompanied by a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1).

Pursuant to 37 CFR 1.173(b), amendments may be made **at the time of filing** of a reissue application. The amendment may be made either by:

(A) physically incorporating the changes within the specification by cutting the column of the printed patent and inserting the added material and rejoining the remainder of the column and then joining the resulting modified column to the other column of the printed patent. Markings pursuant to 37 CFR 1.173(d) must be used to show the changes. The columnar structure of the printed patent must be preserved, and the physically modified page must comply with 37 CFR 1.52(a)(1). As to compliance with 37 CFR 1.52(a)(1)(iv), the “written either by a typewriter or machine printer in permanent dark ink or its equivalent” requirement is deemed to be satisfied where a caret and line are drawn from a position within the text to a newly added phrase, clause, sentence, etc. typed legibly in the margin;

(B) providing a preliminary amendment (a separate amendment paper) directing that specified changes be made to the copy of the printed patent.

The presentation of the insertions or deletions as part of the original reissue specification is an amendment under 37 CFR 1.173(b). An amendment of the reissue application made at the time of filing of the reissue application must be made in accordance with 37 CFR 1.173(b)-(e) and (g); see MPEP § 1453. Thus, as required by 37 CFR 1.173(c), an amendment of the claims made at the time of filing of a reissue application must include a separate paper setting forth the status of all claims (i.e., pending or canceled), and an explanation of the support in the disclosure of the patent for the changes made to the claims.

If a chart, table, or chemical formula is amended and it spans two columns of the patent, it should not be split. Rather, the chart, table, or chemical formula should be provided in its entirety *as part of the column of the patent to which it pertains*, in order to provide a continuity of the description. When doing so, the chart, table, or chemical formula may extend beyond the width of the column. Change in only a part of a word or chemical formula is not permitted. Entire words or chemical formulas must be shown as being changed. Deletion of a chemical formula should be shown by brackets which are substantially larger and darker than any in the formula.

Where a terminal disclaimer was filed in the application for the patent to be reissued, a copy of that terminal disclaimer is not needed in the reissue application file. **>For a reissue application that is

maintained in a paper file, the face of the file wrapper should be marked to indicate that a terminal disclaimer has been filed for the patent. For a reissue application that is maintained in IFW, the “Final SPRE Review” form will be filled in.<

Twice reissued patent:

Examples of the form for a twice-reissued patent are found in Re. 23,558 and Re. 28,488. Double underlining and double bracketing are used in the second reissue application, while **bold**-faced type and double bracketing appear in the printed patent (the second reissue patent) to indicate further insertions and deletions, respectively, in the second reissue patent.

When a copy of a first reissue patent is used as the specification of a second reissue application (filed as a reissue of a reissue), additions made by the first reissue will already be printed in italics, and should remain in such format. Thus, applicants need only present additions to the specification/claims in the second reissue application as double underlined text. Subject matter to be deleted from the first reissue patent should be presented in the second reissue application within sets of double brackets.

1411.01 Certificate of Correction or Disclaimer in Original Patent [R-2]

The applicant should include any changes, additions, or deletions that were made by a Certificate of Correction to the original patent grant in the reissue application without underlining or bracketing. The examiner should * make certain that all Certificate of Correction changes in the patent have been properly incorporated into the reissue application.

Certificate of Correction changes and disclaimer of claim(s) under 37 CFR 1.321(a) should be made without using underlining or brackets. Since these are part of the original patent and were made before the reissue was filed, they should show up in the printed reissue >patent< document as part of the original patent, i.e., not in italics or bracketed. If the changes are extensive and/or applicant has submitted them improperly with underlining and brackets, a clean copy of the specification with the Certificate of Correction changes in it may be requested by the examiner. >In order for the clean copy to be entered as a substitute specification, the reissue applicant must file a grantable petition under 37 CFR 1.183 for waiver of

37 CFR 1.125(d) and 37 CFR 1.173(a)(1). The examiner's request for the clean copy will generally serve as sufficient basis for granting the petition.<

1411.02 New Matter

New matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with 35 U.S.C. 251.

The claims in the reissue application must be for subject matter which the applicant had the right to claim in the original patent. Any change in the patent made via the reissue application should be checked to ensure that it does not introduce new matter. Note that new matter may exist by virtue of the omission of a feature or of a step in a method. See *United States Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 53 USPQ 6 (1942).

Form paragraph 14.22.01 may be used where new matter has been added anywhere in "the application for reissue" as prohibited by 35 U.S.C. 251.

¶ 14.22.01 Rejection, 35 U.S.C. 251, New Matter

Claim [1] rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows: [2]

Examiner Note:

1. In bracket 2, fill in the applicable page and line numbers and provide an explanation of your position, as appropriate.
2. A rejection under 35 U.S.C. 112, first paragraph, should also be made if the new matter is added to the claims or is added to the specification and affects the claims. If new matter is added to the specification and does not affect the claims, an objection should be made based upon 35 U.S.C. 132 using form paragraph 7.28.

1412 Content of Claims

The content of claims in a reissue application is somewhat limited, as is indicated in MPEP § 1412.01 through MPEP § 1412.03.

1412.01 Reissue Claims Must Be for Same General Invention [R-2]

The reissue claims must be for the same invention as that **>disclosed<** as being the invention in the original patent, as required by 35 U.S.C. 251. This does *not* mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the

claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective intent manifested by the **original patent.**" *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added). See also *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The "original patent" requirement of 35 U.S.C. 251 must be understood in light of *In re Amos*, *supra*, where the Court of Appeals for the Federal Circuit stated:

We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

953 F.2d at 618-19, 21 USPQ2d at 1275. Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

>The presence of< some disclosure (description and enablement) in the original patent should evidence that applicant intended to claim or that applicant considered the material now claimed to be his or her invention.

The original patent specification would indicate an intent not to claim the subject matter of the claims presented in the reissue application in a situation analogous to the following:

The original patent specification discloses that composition X is not suitable (or not satisfactory) for molding an item because composition X fails to provide quick drying. After the patent issues, it is found that composition X would be desirable for the molding in spite of the failure to provide quick drying, because of some other newly recognized benefit from composition X. A claim to composition X or a method of use thereof would not be permitted in a reissue application, because the original patent specification contained an explicit statement of intent *not* to claim composition X or a method of use thereof.

In most instances, however, the mere failure to claim a disclosed embodiment in the original patent (absent an explicit statement in the original patent specification of unsuitability of the embodiment) would **not** be grounds for prohibiting a claim to that embodiment in the reissue.

>FAILURE TO TIMELY FILE A DIVISIONAL APPLICATION PRIOR TO ISSUANCE OF ORIGINAL PATENT

Where a restriction requirement was made in an application and applicant permitted the elected invention to issue as a patent without the filing of a divisional application on the non-elected invention(s), the non-elected invention(s) cannot be recovered by filing a reissue application. A reissue applicant's failure to timely file a divisional application covering the non-elected invention(s) in response to a restriction requirement is not considered to be error causing a patent granted on the elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Accordingly, such error is not correctable by reissue of the original patent under 35 U.S.C. 251. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). See also *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978). In this situation, the reissue claims should be rejected under 35 U.S.C. 251 for lack of defect in the original patent and lack of error in obtaining the original patent. Compare with *In re Doyle*, 293 F.3d 1355, 63 USPQ2d 1161 (Fed. Cir. 2002) where the court

permitted the patentee to file a reissue application to present a so-called linking claim, a claim broad enough to read on or link the invention elected (and patented) together with the invention not elected. The non-elected invention(s) were inadvertently not filed as a divisional application.<

1412.02 Recapture of Canceled Subject Matter [R-3]

A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

I. THREE STEP TEST FOR RECAPTURE:

In Clement, 131 F.3d at 1468-70, 45 USPQ2d at 1164-65, the Court of Appeals for the Federal Circuit set forth a three step test for recapture analysis. In *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600, the court restated this test as follows:

Application of the recapture rule is a three-step process.

The **first step** is to 'determine whether and in what aspect the reissue claims are broader than the patent claims.'

'The **second step** is to determine whether the broader aspects of the reissued claim related to surrendered subject matter'

Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. [Emphasis added]

A. *The First Step - Was There Broadening?*

In every reissue application, the examiner must first review each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim; see MPEP § 1412.03 for guidance

as to the nature of a “broadening claim.” If the reissue claim is not broadened in any respect as compared to the patent claims, the analysis ends; there is no recapture.

B. The Second Step - Does Any Broadening Aspect of the Reissued Claim Relate to Surrendered Subject Matter?

Where a claim in a reissue application is broadened in some respect as compared to the patent claims, the examiner must next determine whether the broadening aspect(s) of that reissue claim relate(s) to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). Each limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination. This involves two sub-steps:

1. The Two Sub-Steps:

(A) It must first be determined whether there was any surrender of subject matter made in the prosecution of the original application which became the patent to be reissued.

If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant. The reliance by applicant to define the original patent claims over the art can be by way of presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art. To determine whether such reliance occurred, the examiner must review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant’s arguments made therein.

If there was no surrender of subject matter made in the prosecution of the original application, again the analysis ends and there is no recapture.

(B) If there was a surrender of subject matter in the original application prosecution, it must then be determined whether any of the broadening of the reissue claims is in the area of the surrendered subject matter. All of the broadening aspects of reissue claims

must be analyzed to determine if any of the omitted/broadened limitation(s) are directed to limitations relied upon by applicant in the original application to make the claims allowable over the art.

2. Examples of the Pannu Second Step Analysis:

(A) Example (1) - Argument without amendment:

In *Hester, supra*, the Federal Circuit held that the surrender which forms the basis for impermissible recapture “can occur through arguments alone”. 142 F.3d at 1482, 46 USPQ2d at 1649. For example, assume that limitation A of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. If the omitted limitation A was argued in the original application to make the application claims allowable over the art in the application, then the omitted limitation relates to subject matter previously surrendered in the original application, and recapture will exist. Accordingly, where claims are broadened in a reissue application, the examiner should review the prosecution history of the original patent file for recapture, even where the claims were never amended during the prosecution of the application which resulted in the patent.

Note: The argument that the claim limitation defined over the rejection must have been specific as to the limitation relied upon, rather than a general statement regarding the claims as a whole. A general ‘boiler plate’ sentence in the original application will not, by itself, be sufficient to establish surrender and recapture.

An example of a general “boiler plate” sentence of argument is:

“In closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable.”

An argument that merely states that all the limitations of the claims define over the prior art will also not, by itself, be sufficient to establish surrender and recapture. An example is:

“Claims 1-5 set forth a power-train apparatus which comprises the combination of A+B+C+D+E. The prior art of record does not disclose or render obvious a motivation to provide for a material-transfer apparatus as defined by the limitations of claim 1, including an A member and a B

member, both connected to a C member, with all three being aligned with the D and E members.”

This statement is simply a restatement of the entirety of claim 1 as allowed. No measure of surrender could be gleaned from such a statement of reasons for allowance. See *Ex parte Yamaguchi*, 61 USPQ2d 1043 (Bd. Pat. App. & Inter. 2001)(reported but unpublished, precedential).

In both of the above examples, the argument does not provide an indication of what specific limitations, e.g., specific element or step of the claims, cooperative effect, or other aspect of the claims, are being relied upon for patentability. Thus, applicant has not surrendered anything.

(B) Example (2) - Amendment of the claims without argument:

The limitation omitted in the reissue claim(s) was added in the original application claims for the purpose of making the application claims allowable over a rejection or objection made in the application. Even though applicant made no argument on the record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection. This too will establish the omitted limitation as relating to subject matter previously surrendered. To illustrate this, note the following example:

The original application claims recite limitations A+B+C, and the Office action rejection combines two references to show A+B+C. In the amendment replying to the Office action, applicant adds limitation D to A+B+C in the claims, but makes no argument as to that addition. The examiner then allows the claims. Even though there is no argument as to the addition of limitation D, it must be presumed that the D limitation was added to obviate the rejection. The subsequent deletion of (omission of) limitation D in the reissue claims would be presumed to be a broadening in an aspect of the reissue claims related to surrendered subject matter. Accordingly, the reissued claims would be barred by the recapture doctrine.

The above result would be the same whether the addition of limitation D in the original application was by way of applicant’s amendment or by way of an examiner’s amendment with authorization by applicant.

(C) Example (3) - Who can make the surrendering argument?

Assume that the limitation A omitted in the reissue claims was present in the claims of the original application. The examiner’s reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner’s reasons for allowance, and permitted the claims to issue.

Ex parte Yamaguchi, supra, held that a surrender of claimed subject matter cannot be based solely upon an applicant’s failure to respond to, or failure to challenge, an examiner’s statement made during the prosecution of an application. Applicant is bound only by applicant’s revision of the application claims or a positive argument/statement by *applicant*. An applicant’s failure to present on the record a counter statement or comment as to an examiner’s reasons for allowance does not give rise to any implication that applicant agreed with or acquiesced in the examiner’s reasoning for allowance. Thus, the failure to present a counter statement or comment as to the examiner’s statement of reasons for allowance does not give rise to any finding of surrender. **The examiner’s statement of reasons for allowance in the original application cannot, by itself, provide the basis for establishing surrender and recapture.**

It is only in the situation where applicant does file comments on the statement of reasons for allowance, that surrender may have occurred. Note the following two scenarios in which an applicant files comments:

Scenario 1- There is Surrender: The examiner’s statement of reasons for allowance in the original application stated that it was limitation C (of the combination of ABC) which distinguished over a potential combining of references X and Y, in that limitation C provided increased speed to the process. Applicant filed comments on the examiner’s statement of reasons for allowance essentially supporting the examiner’s reasons. The limitation C is thus established as relating to subject matter previously surrendered.

Scenario 2- There is No Surrender: On the other hand, if applicant’s comments on the examiner’s statement of reasons for allowance contain a counter statement that it is limitation B (of the combination of ABC), rather than C, which distinguishes the claims over the art, then limitation B

would constitute surrendered subject matter, and limitation C has not been surrendered.

C. *The Third Step - Were the reissued claims materially narrowed in other respects to compensate for the broadening in the area of surrender, and thus avoid the recapture rule?*

As pointed out above, the third prong of the recapture determination set forth in *Pannu* is directed to analysis of the broadening and narrowing effected via the reissue claims, and of the significance of the claim limitations added and deleted, using the prosecution history of the patent (to be reissued), to determine whether the reissue claims should be barred as recapture.

The following discussion addresses analyzing the reissue claims, and *which claims* are to be compared to the reissue claims in determining the issue of surrender (for reissue recapture).

When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. If the reissue claim “fails” either analysis, recapture exists.

First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution to define over the art. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. *In re Clement, supra*.

Second, it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. *Pannu v. Storz Instruments Inc., supra*. However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to

overcome an art rejection was “an orange peel,” and the reissue claim instead recites “a citrus fruit peel”, the reissue claim may not be rejected on recapture grounds.

The following discussion is provided for analyzing the reissue claims.

1. Comparison of Reissue Claims Narrowed/Broadened Vis-à-vis the Canceled Claims

DEFINITION: “Canceled claims,” in the context of recapture case law, are claims canceled from the original application to obtain the patent for which reissue is now being sought. The claims

(A) can simply be canceled and not replaced by others, or

(B) can be canceled and replaced by other claims which are more specific than the canceled claims in at least one aspect (to thereby define over the art of record). The “replacement claims” can be new claims which are narrower than the canceled claims, or can be the same claims amended to be narrower than the canceled version of the claims.

(a) Reissue Claims are Same or Broader in Scope Than Canceled Claims in All Aspects:

The recapture rule bars the patentee from acquiring, through reissue, claims that are in all aspects (A) of the same scope as, or (B) broader in scope than, those claims canceled from the original application to obtain a patent. *In re Ball Corp. v. United States*, 729 F.2d at 1436, 221 USPQ at 295.

(b) Reissue Claims are Narrower in Scope Than Canceled Claims in at Least One Aspect:

If the reissue claims are equal in scope to, or narrower than, the claims of the original patent (as opposed to the claims “canceled from the application”) in all aspects, then there can never be recapture. The discussion that follows is not directed to that situation. It is rather directed to the situation where the *reissue claims are narrower than the claims 'canceled' from the application in some aspect, but are broader than the claims of the original patent in some other aspect*.

If the reissue claims are narrower in scope than the claims canceled from the original application by inclusion of *the limitation added to define the original application claims over the art*, there will be no recapture, even if the reissue claims are broader than the canceled claims in some other aspect (i.e., an aspect not related to the surrender made in the original application).

Assume combination AB was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABC (after which the patent issued). The reissue claims are then directed to combination AB_{broadened}C. The AB_{broadened}C claims are *narrower* in scope when compared with the canceled claim subject matter AB *in respect to the addition of C* (which was added in the application to overcome the art), and there is no recapture.

As another example, assume combination ABZ was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABZC (after which the patent issued). The reissue claims are then directed to combination ABC (i.e., element Z is deleted from the canceled claims, while element C remains present). The ABC claims of the reissue are *narrower* in scope as compared to the canceled-from-the-original-application claim subject matter ABZ *in respect to the addition of C* (which was added in the application to overcome the art), and there is thus no recapture.

2. Comparison of Reissue Claims Narrowed/Broadened Via-à-vis the Patent Claims

The “patent claims,” in the context of recapture case law, are claims which issued in the original patent for which reissue is now being sought. As pointed out above, where the reissue claims are narrower than the claims of the original patent in all aspects, then there can never be recapture. If reissue claims are equal in scope to the patent claims, there is no recapture as to those reissue claims. Where, however, reissue claims are both broadened and narrowed as compared with the original patent claims, the nature of the broadening and narrowing must be examined to determine whether the reissue claims are barred as being recapture of surrendered subject matter. If the claims are 'broader than they are narrower in a manner directly pertinent to the subject matter... sur-

rendered during prosecution' (*Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166), then recapture will bar the claims. This narrowing/broadening *vis-à-vis* the patent is broken down into four possibilities that will now be addressed.

The “limitation” presented, argued, or stated to make the claims patentable over the art (in the application) “generates” the surrender of claimed subject matter. For the sake of simplification, this limitation will be referred to throughout this section as the *surrender-generating limitation*. If a claim is presented in a reissue application that omits, in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under 35 U.S.C. 251. This terminology will be used in the discussion of the four categories of narrowing/broadening *vis-à-vis* the **patent** that follows.

(a) **Reissue Claims are Narrower in Scope Than Patent Claims, in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope by Omitting Limitation(s) Added/Argued To Overcome Art Rejection in Original Prosecution:**

In this case, there is recapture.

This situation is where the patent claims are directed to combination ABC and the reissue claims are directed to ABD. Element C was either a limitation added to AB to obtain allowance of the original patent, or was argued by applicant to define over the art (or both). Thus, addition of C (and/or argument as to C) has resulted in the surrender of any combination of A & B that does not include C; this is the surrendered subject matter. Element D, on the other hand, is not related to the surrendered subject matter. Thus, the reissue claim, which no longer contains C, is broadened in an area related to the surrender, and the narrowing via the addition of D does not save the claim from recapture since D is not related to the surrendered subject matter.

Reissue claims that are broader than the original patent claims by not including the surrender-generating limitation (element C, in the example given) will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re*

Clement, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc.*, *supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

(b) Reissue Claims are Narrower or Equal in Scope, in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope in Area Not Directed to Amendment/Argument:

In this case, there is no recapture.

This situation is where the patent claims are directed to combination ABCDE and the reissue claims are directed to ABDE (element C is omitted). Assume that the combination of ABCD was present in the original application as it was filed, and element E was later added to define over that art. No argument was ever presented as to elements A-C defining over the art.

In this situation, the ABCDE combination of the patent can be broadened (in the reissue application) to omit element C, and thereby claim the combination of ABDE, where element E (the surrender generating limitation) is not omitted. There would be no recapture in this instance. (If an argument had been presented as to element C defining over the art, in addition to the addition of element E, then the ABCDE combination could not be broadened to omit element C and thereby claim combination of ABDE. This would be recapture; see the above discussion as to surrender and recapture based upon argument.)

Additionally, the reissue claims are certainly permitted to recite combination ABDE_{specific} (where surrender-generating element E is narrowed). The patent claims have been broadened in an area not directed to the surrender (by omitting element C) and narrowed in the area of surrender (by narrowing element E to E_{specific}). This is clearly permitted.

As another example, assume limitation C was added to application claims AB to obtain the patent to ABC, and now the reissue application presents claims to AC or AB_{broad}C. Such reissue claims avoid the effect of the recapture rule because they are broader in

a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). Such claims are considered to be broader in an aspect not 'germane to a prior art rejection,' and thus are not barred by recapture. Note *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

Reissue claims that are broader than the original patent claims by deletion of a limitation or claim requirement other than the "surrender-generating limitation" will avoid the effect of the recapture rule, regardless of the nature of the narrowing in the claims, and even if the claims are not narrowed at all from the scope of the patent claims.

(c) Reissue Claims are Narrower in Scope in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope in Area Not Directed to the Amendment/Argument:

In this instance, there is clearly no recapture. In the reissue application, there has been no change in the claims related to the matter surrendered in the original application for the patent.

In this instance, element C was added to the AB combination to provide ABC and define over the art, and the patent was issued. The reissue omits element B and adds element Z, to thus claim ACZ. There is no recapture since the surrender generating element C has not been modified in any way. (Note, however, that if, when element C was added to AB, applicant argued that the association of newly added C with B provides a synergistic (unexpected) result to thus define over the art, then neither B nor C could be omitted in the reissue application.)

(d) Reissue Claims Broader in Scope in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; but Reissue Claims Retain, in Broadened Form, the Limitation(s) Argued/Added to Overcome Art Rejection in Original Prosecution:

Assume the combination AB was originally claimed in the application, and was amended in reply to an art rejection to add element C and thus provide the combination ABC (after which the patent issued). A reissue application is then filed, and the reissue

application claims are directed to the combination ABC_{broadened}. The ABC_{broadened} claims are narrowed in scope when compared with the canceled claim subject matter AB, because of the addition of C_{broadened}. Thus, the claims retain, in broadened form, the limitation argued/added to overcome art rejection in original prosecution. There is no recapture, since ABC_{broadened} is narrower than canceled claim subject matter AB in an area related to the surrender. This is so, because it was element C that was added in the application to overcome the art. See *Ex Parte Eggert, supra*.

II. REISSUE TO TAKE ADVANTAGE OF 35 U.S.C. 103(b):

A patentee may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C. 103(b) treatment if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b), without an election having been made as a result of error without deceptive intent. See MPEP § 706.02(n). **This is not to be considered a recapture.** The addition of process claims, however, will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

III. REISSUE FOR ARTICLE CLAIMS WHICH ARE FUNCTIONAL DESCRIPTIVE MATERIAL STORED ON A COMPUTER-READABLE MEDIUM:

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the “article” claims) must have been made as a result of error with-

out deceptive intent. The addition of these “article” claims will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

IV. REJECTION BASED UPON RECAPTURE:

Reissue claims which recapture surrendered subject matter should be rejected using form paragraph 14.17.

**>

¶ 14.17 Rejection, 35 U.S.C. 251, Recapture

Claim[1] rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

[2]

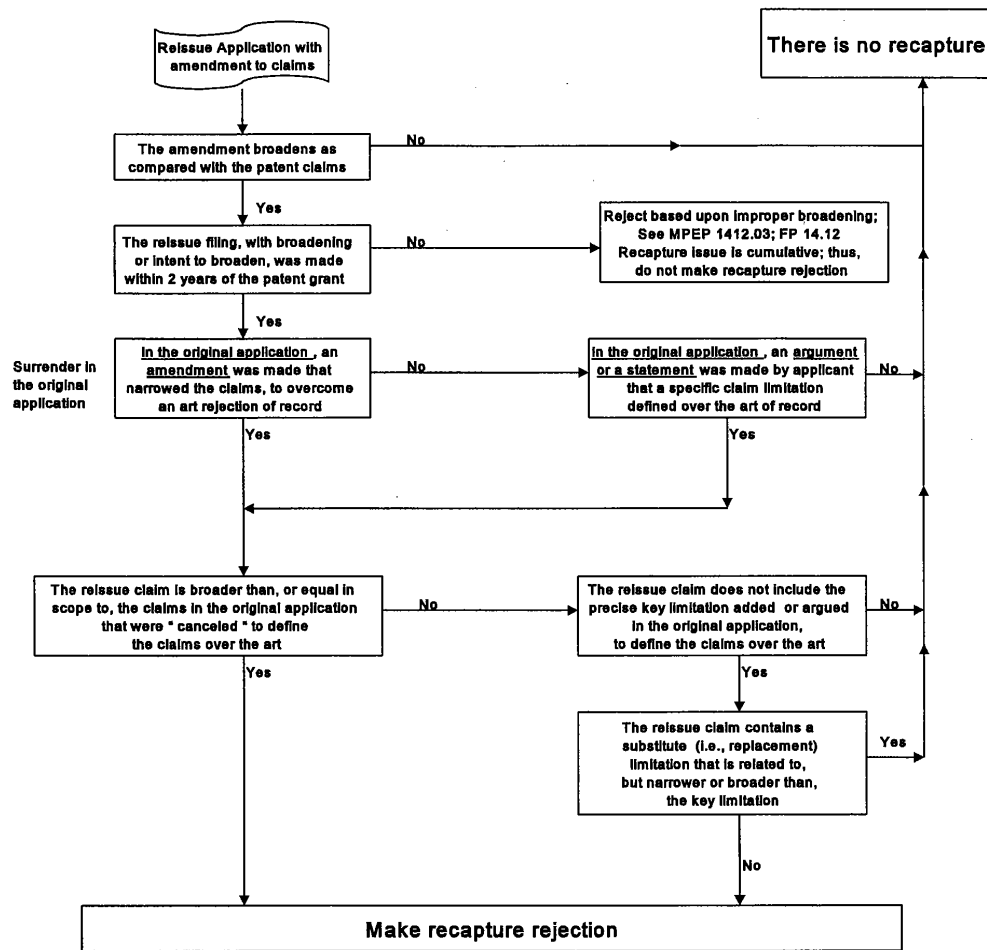
Examiner Note:

In bracket 2, the examiner should explain the specifics of why recapture exists, including an identification of the omitted/broadened claim limitations in the reissue which provide the “broadening aspect” to the claim(s), and where in the original application the narrowed claim scope was presented/argued to obviate a rejection/objection. See MPEP § 1412.02.

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See the recapture-analysis flow chart which follows for assistance in determining whether recapture is present, consistent with the case law discussed above.

Reissue Recapture - Determining its presence or absence



1412.03 Broadening Reissue Claims [R-3]

35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues:

No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.

>

I. < MEANING OF “BROADENED REISSUE CLAIM”

A broadened reissue claim is a claim which enlarges the scope of the claims of the patent, *i.e.*, a claim which is greater in scope than each and every claim of the original patent. If a disclaimer is filed in the patent prior to the filing of a reissue application, the disclaimed claims are not part of the “original patent” under 35 U.S.C. 251. The Court in *Vectra Fitness Inc. v. TNWK Corp.*, 49 USPQ2d 1144, 1147, 162 F.3d 1379, 1383 (Fed. Cir. 1998) held that a reissue application violated the statutory prohibition under 35 U.S.C. 251 against broadening the scope of the patent more than 2 years after its grant because the reissue claims are broader than the claims that remain after the disclaimer, even though the reissue claims are narrower than the claims that were disclaimed by the patentee before reissue. The reissue application was bounded by the claims remaining in the patent after a disclaimer is filed. A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least one* respect, even though it may be narrower in other respects.

A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603, 120 USPQ 185, 186 (CCPA 1958). A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any

party for infringement who previously could not have been sued for infringement. Thus, where the original patent claims only the process, and the reissue application adds (for the first time) product claims, the scope of the claims has been broadened since a party could not be sued for infringement of the product based on the claims of the original patent.

The addition of combination claims in a reissue application where only subcombination claims were present in the original patent could be a broadening of the invention. The question which must be resolved in this case is whether the combination claims added in the reissue would be for “the invention as claimed” in the original patent. See *Ex parte Wikdahl*, 10 USPQ2d at 1549. The newly added combination claims should be analyzed to determine whether they contain every limitation of the subcombination of any claim of the original patent. If the combination claims (added in the reissue) contain every limitation of the subcombination (which was claimed in the original application), then infringement of the combination must also result in infringement of the subcombination. Accordingly, the patent owner **could not**, if a reissue patent issues with the combination claims, **sue any new party** for infringement who could not have been sued for infringement of the original patent. Therefore, **broadening does not exist**, in spite of the addition of the combination.

>

II. < SCOPE OF DEPENDENT CLAIM ENLARGED-NOT BROADENING

As pointed out above, a claim will be considered a broadened reissue claim when it is greater in scope than **each and every** claim of the patent to be reissued. A corollary of this is that a claim which has been *broadened in a reissue as compared to its scope in the patent* is not a broadened reissue claim if it is narrower than, or equal in scope to, any other claim which appears in the patent. A common example of this is where dependent claim 2 is broadened via the reissue (other than the addition of a process step to convert an intermediate to a final product as discussed in the preceding subsection), but independent claim 1 on which it is based is not broadened. Since a dependent claim is construed to contain all the limitations of the claim upon which it depends, claim 2 must be at

least as narrow as claim 1 and is thus not a broadened reissue claim.

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III. < NEW CATEGORY OF INVENTION ADDED IN REISSUE - GENERALLY *>IS< BROADENING

The addition of process claims as a new category of invention to be claimed in the patent (*i.e.*, where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989). A situation may arise, however, where the reissue application adds a limitation (or limitations) to process A of making the product A claimed in the original patent claims. For example:

(1) a process of using the product A (made by the process of the original patent) to make a product B, disclosed but not claimed in the original patent; or

(2) a process of using the product A to carry out a process B disclosed but not claimed in the original patent.

Although this amendment of the claims adds a method of making product B or adds a method of using product A, this is not broadening (*i.e.*, this is not an enlargement of the scope of the original patent) because the “newly claimed invention” contains all the limitations of the original patent claim(s).

>

IV. < WHEN A BROADENED CLAIM CAN BE PRESENTED

A broadened claim can be presented within two years from the grant of the original patent in a reissue application. In addition, a broadened claim can be presented *after* two years from the grant of the original patent in a broadening reissue >application< which was filed *within* two years from the grant. Where any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period. >Thus, a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after the two years is different than the broadened claim presented within the 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 >(continuation or divisional)< reissue application after the two year period. In any other situation, a broadened claim cannot be presented, and the examiner should check carefully for the improper presentation of broadened claims.

A reissue application filed on the 2-year anniversary date from the patent grant is considered to be filed within 2 years of the patent grant. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) for a similar rule in interferences.

See also the following cases which pertain to broadened reissues:

In re Graff, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997) (Broadened claims in a continuing reissue application were properly rejected under 35 U.S.C. 251 because the proposal for broadened claims was not made (in the parent reissue application) within two years from the grant of the original patent and the public was not notified that broadened claims were being sought until after the two-year period elapsed.);

In re Fotland, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985), *cert. denied*, 476 U.S. 1183 (1986) (The failure by an applicant to include *an oath or declaration indicating a desire to seek broadened claims* within two years of the patent grant will bar a subsequent attempt to broaden the claims after the two year limit. Under the former version of 37 CFR 1.175 (the former 37 CFR 1.175(a)(4)), applicant timely sought a “no-defect” reissue, but the Court did not permit an attempt made beyond the two year limit to convert the reissue into a broadening reissue. In this case, applicant did not indicate any intent to broaden within the two years.);

In re Bennett, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985) (*en banc*) (A reissue application with broadened claims was filed within two years of the patent grant; however, the declaration was executed by the assignee rather than the inventor. The Federal Circuit permitted correction of the improperly executed declaration to be made more than two years after the patent grant.);

In re Doll, 419 F.2d 925, 928, 164 USPQ 218, 220 (CCPA 1970) (If the reissue application is timely filed within two years of the original patent grant and the

applicant indicates in the oath or declaration that the claims will be broadened, then applicant may subsequently broaden the claims in the pending reissue prosecution even if the additional broadening occurs beyond the two year limit.).

Form paragraphs 14.12 and 14.13 may be used in rejections based on improper broadened reissue claims.

¶ 14.12 Rejection, 35 U.S.C. 251, Broadened Claims After Two Years

Claim [1] rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. [2] A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See MPEP §§ 706.03(x) and 1412.03.

¶ 14.13 Rejection, 35 U.S.C. 251, Broadened Claims Filed by Assignee

Claim [1] rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. [2] A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See MPEP §§ 706.03(x) and 1412.03.

>

V. < BROADENING REISSUE - OATH/ DECLARATION REQUIREMENTS

A broadening reissue application must be applied for by all of the inventors (patentees), that is, the original reissue oath or declaration must be signed by all of the inventors. See also MPEP § 1414. If a supplemental oath or declaration in a broadening reissue application is needed in the application in order to fulfill the requirements of 37 CFR 1.175, the supplemental reissue oath or declaration must be signed by all of the inventors. See *In re Hayes*, 53 USPQ2d 1222 (Comm'r Pat. 1999) and MPEP § 1414.01.

1412.04 Correction of Inventorship [R-3]

The correction of misjoinder of inventors has been held to be a ground for reissue. See *Ex parte Scudder*, 169 USPQ 814, 815 (Bd. App. 1971) wherein the Board held that 35 U.S.C. 251 authorizes reissue applications to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate. See also *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 567 n.16, 195 USPQ 97, 106 n.16 (D.C. Cir. 1977) wherein correction of inventorship from sole inventor A to sole inventor B was permitted in a reissue application. The court noted that reissue by itself is a vehicle for correcting inventorship in a patent.

>

I. < CERTIFICATE OF CORRECTION AS A VEHICLE FOR CORRECTING INVENTORSHIP

While reissue is a vehicle for correcting inventorship in a patent, correction of inventorship should be effected under the provisions of 35 U.S.C. 256 and 37 CFR 1.324 by filing a request for a Certificate of Correction if:

(A) the only change being made in the patent is to correct the inventorship; and

(B) all parties are in agreement and the inventorship issue is not contested.

See MPEP § 1481 for the procedure to be followed to obtain a Certificate of Correction for correction of inventorship.

>

II. < REISSUE AS A VEHICLE FOR CORRECTING INVENTORSHIP

Where the provisions of 35 U.S.C. 256 and 37 CFR 1.324 do not apply, a reissue application is the appropriate vehicle to correct inventorship. The failure to name the correct inventive entity is an error in the patent which is correctable under 35 U.S.C. 251. The reissue oath or declaration pursuant to 37 CFR 1.175 must state that the applicant believes the original patent to be wholly or partly inoperative or invalid through error of a person being incorrectly named in an issued patent as the inventor, or through error of an inventor incorrectly not named in an issued patent, and that such error arose without any

deceptive intention on the part of the applicant. The reissue oath or declaration must, as stated in 37 CFR 1.175, also comply with 37 CFR 163.

The correction of inventorship does not enlarge the scope of the patent claims. Where a reissue application does not seek to enlarge the scope of the claims of the original patent, the reissue oath may be made and sworn to, or the declaration made, by the assignee of the entire interest under 37 CFR 1.172. An assignee of part interest may not file a reissue application to correct inventorship where the other co-owner did not join in the reissue application and has not consented to the reissue proceeding. See *Baker Hughes Inc. v. Kirk*, 921 F. Supp. 801, 809, 38 USPQ2d 1885, >1892< (D.D.C. 1995). See 35 U.S.C. 251, third paragraph. Thus, the signatures of the inventors are not needed on the reissue oath or declaration where the assignee of the entire interest signs the reissue oath/declaration. Accordingly, an assignee of the entire interest can add or delete >the name of< an inventor by reissue (e.g., correct inventorship from inventor A to inventors A and B) without the original inventor's consent. See also 37 CFR 3.71(a) (“One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or reexamination proceeding **to the exclusion of either the inventive entity**, or the assignee(s) previously entitled to conduct prosecution.” Emphasis added). Thus, the assignee of the entire interest can file a reissue to change the inventorship to one which the assignee believes to be correct, even though an inventor might disagree. The protection of the assignee's property rights in the application and patent are statutorily based in 35 U.S.C. 118.

>Where the name of an inventor X is to be deleted in a reissue application to correct inventorship in a patent, and inventor X has not assigned his/her rights to the patent, inventor X has an ownership interest in the patent. Inventor X must consent to the reissue (37 CFR 1.172(a)), even though inventor X's name is being deleted as an inventor and need not sign the reissue oath or declaration. If inventor X has assigned his/her rights to the patent, then inventor X's assignee must consent. In addition to providing the consent, even though inventor X does not sign the reissue oath or declaration as an inventor (since the correction of

inventorship does not enlarge the scope of the patent claims), the assignee of the entire interest must sign the reissue oath or declaration as assignee (37 CFR 1.172(a)). Thus, if inventor X has not assigned his/her patent rights, inventor X's signature must be included in the reissue oath or declaration as the assignee. If inventor X has assigned his/her patent rights, inventor X's assignee must sign the reissue oath or declaration as the assignee. For example, a patent to inventors X and Y has no assignee. A reissue application is filed by inventor Y to delete the name of inventor X as an inventor. 37 CFR 1.172(a) provides that a reissue oath or declaration may be made by the assignee/owners of the entire interest, rather than by the inventors, where the scope of the claims is not to be enlarged. However, since inventor X has not assigned his/her patent rights, inventor X must sign the reissue oath or declaration as one of the owners, and consent to the filing of the reissue application by inventor Y. See MPEP § 1410.01.<

Where a reissue to correct inventorship also changes the claims to enlarge the scope of the patent claims, the signature of all the inventors *is needed*. However, if an inventor refuses to sign the reissue oath or declaration because he or she believes the change in inventorship (to be effected) is not correct, the reissue application can still be filed with a petition under 37 CFR 1.47 without that inventor's signature ***>*provided the written consent of all owners/assignees as required by 37 CFR 1.172(a) is also submitted. In the situation where a patent to inventors X and Y has no assignee and a reissue application is filed by inventor Y to delete the name of inventor X as an inventor and to broaden the patent. Inventor X refuses to sign the reissue oath or declaration and refuses to provide the consent as required by 37 CFR 1.172(a). In this instance, a 37 CFR 1.47 petition would not be appropriate to permit the filing of the reissue application since the consent requirement of 37 CFR 1.172(a) for each owner/assignee is not met. Resort to the courts would be required to delete the name of inventor X as an inventor where X will not consent to the filing of a reissue application. As stated in the second paragraph of 35 U.S.C. 256, “[t]he court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.”<

The reissue application with its reissue oath or declaration under 37 CFR 1.175 provides a complete mechanism to correct inventorship. See *A.F. Stoddard & Co. v. Dann*, 564 F.2d at 567, 195 USPQ at 106. A request under 37 CFR 1.48 or a petition under 37 CFR 1.324 cannot be used to correct the inventorship of a reissue application. If a request under 37 CFR 1.48 or a petition under 37 CFR 1.324 is filed in a reissue application, the request or petition should be dismissed and the processing or petition fee refunded. The material submitted with the request or petition should then be considered to determine if it complies with 37 CFR 1.175. If the material submitted with the request or petition does comply with the requirements of 37 CFR 1.175 (and the reissue application is otherwise in order), the correction of inventorship will be permitted as a correction of an error in the patent under 35 U.S.C. 251.

Where a reissue application seeks to correct inventorship in the patent and the inventors are required to sign the reissue oath or declaration (rather than an assignee of the entire interest under 37 CFR 1.172) due to a broadening of any claims of the original patent, the correct inventive entity must sign the reissue oath or declaration. Where an inventor **is being added** in a reissue application to correct inventorship in a patent, the inventor being added must sign the reissue oath or declaration together with the inventors previously designated on the patent. For example, a reissue application is filed to correct the inventorship from inventors A and B (listed as inventors on the patent) to inventors A, B, and C. Inventor C is the inventor being added. In such a case, A, B, and C are the correct inventors, and accordingly, each of A, B, and C must sign the reissue oath or declaration. Where an inventor **is being deleted** in a reissue application to correct inventorship in a patent and the inventors are required to sign the oath or declaration due to a broadening of any claims of the original patent, the inventor being deleted need not sign the reissue oath or declaration. The reissue oath or declaration must be signed by the correct inventive entity. For example, a reissue application is filed to correct inventorship from inventors A, B, and C (listed as inventors on the patent) to inventors A and B. Inventor C is being deleted as a named inventor. In such a case, A and B are the correct inventors, and accordingly, inventors A and B must sign the reissue oath or

declaration but inventor C need not sign the reissue oath or declaration.

1413 Drawings [R-2]

37 CFR 1.173. Reissue specification, drawings, and amendments.

(a)(2) Drawings. Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

A clean copy (e.g., good quality photocopies free of any extraneous markings) of each drawing sheet of the printed patent must be supplied by the applicant at the time of filing of the reissue application. If the copies meet the requirements of 37 CFR 1.84, no further formal drawings will be required. New drawing sheets are not to be submitted, unless some change is made in the original patent drawings. Such changes must be made in accordance with 37 CFR 1.173(b)(3).

The prior reissue practice of transferring drawings from the patent file has been eliminated, since clean photocopies of the printed patent drawings are acceptable for use in the printing of the reissue patent.

AMENDMENT OF DRAWINGS

37 CFR 1.173. Reissue specification, drawings, and amendments.

**>

(b)(3) Drawings. One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which shall be an attachment to the amendment document. Any replacement sheet of drawings must be in compliance with § 1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled." All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings.<

The provisions of 37 CFR 1.173(b)(3) govern the manner of making amendments (changes) to the drawings in a reissue application. The following guidance is provided as to the procedure for amending drawings:

(A) Amending the original or printed patent drawing sheets by physically changing or altering them is not permitted. Any request to do so should be denied.

(B) Where a change to the drawings is desired, ** applicant must submit a replacement sheet for each sheet of drawings containing a Figure to be revised. Any replacement sheet must comply with 37 CFR 1.84 and include all of the figures appearing on the original version of the sheet, even if only one figure is being amended. Each figure that is amended must be identified by placing the word “Amended” at the bottom of that figure. Any added figure must be identified as “New.” In the event that a figure is canceled, the figure must be identified as “Canceled” and also surrounded by brackets. All changes to the figure(s) must be explained, in detail, beginning on a separate sheet which accompanies the papers including the amendment to the drawings.

(C) If desired, applicant may include a marked-up copy of any amended drawing figure, including annotations indicating the changes made. Such a marked-up copy must be clearly labeled as “Annotated Marked-up Drawings”, and it must be presented in the amendment or remarks section that explains the change to the drawings.

In addition, the examiner may desire a marked-up copy of any amended drawing figure, and so state in an Office action. A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.<

(D) For each proper new drawing sheet being added, the new sheet should be inserted after the existing drawing sheets. For each proper * drawing sheet >being added< which replaces an existing drawing sheet, the existing sheet should be canceled by placing the sheet face down in the file and placing a large “X” on the back of the sheet. The new sheet should be inserted in place of the turned over existing sheet.

(E) If any drawing change * is not * >approved,< or if any submitted sheet of formal drawings is not entered, the examiner will so inform the reissue appli-

cant in the next Office action, and the examiner will set forth the reasons for same.

1414 Content of Reissue Oath/Declaration [R-3]

37 CFR 1.175. Reissue oath or declaration.

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(i) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

>

(e) The filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration which, pursuant to paragraph (a)(1) of this section, identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application. All other requirements relating to oaths or declarations must also be met.<

The reissue oath/declaration is an essential part of a reissue application and must be filed with the application, or within the time period set under 37 CFR 1.53(f) along with the required surcharge as set forth in 37 CFR 1.16(*>f<) in order to avoid abandonment.

The question of the sufficiency of the reissue oath/declaration filed under 37 CFR 1.175 must in each case be reviewed and decided personally by the primary examiner.

Reissue oaths or declarations must contain the following:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid—

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, *i.e.*, as the basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

These elements will now be discussed:

I. A STATEMENT THAT THE APPLICANT BELIEVES THE ORIGINAL PATENT TO BE WHOLLY OR PARTLY INOPERATIVE OR INVALID BY REASON OF A DEFECTIVE SPECIFICATION OR DRAWING, OR BY REASON OF THE PATENTEE CLAIMING MORE OR LESS THAN PATENTEE HAD THE RIGHT TO CLAIM IN THE PATENT.

In order to satisfy this requirement, a declaration can state >as for example<:

“Applicant believes the original patent to be partly inoperative or invalid by reason of a defective specification or drawing.”

**

“Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more ** than patentee had a right to claim in the patent.”

>

“Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming less than patentee had a right to claim in the patent.”

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Where the specification or drawing is defective and patentee claimed >both< more *>and< less than patentee had the right to claim in the patent, then *>all three< statements should be included in the reissue oath/declaration. See MPEP § 1412.04 for an exemplary declaration statement when the error being corrected is an error in inventorship.

The above examples will be sufficient to satisfy this requirement without any further statement.

Form paragraph 14.01 may be used where the reissue oath/declaration does not provide the required statement as to applicant’s belief that the original patent is wholly or partly inoperative or invalid.

¶ 14.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of Defect in the Patent

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant’s belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. [1]

Examiner Note:

1. Use this form paragraph when applicant: (a) fails to allege that the original patent is inoperative or invalid and/or (b) fails to state the reason of a defective specification or drawing, or of patentee claiming more or less than patentee had the right to claim in the patent. In bracket 1, point out the specific defect to applicant by using the language of (a) and/or (b), as it is appropriate.
2. Form paragraph 14.14 must follow this form paragraph.

II. A STATEMENT OF AT LEAST ONE ERROR WHICH IS RELIED UPON TO SUPPORT THE REISSUE APPLICATION (I.E., THE BASIS FOR THE REISSUE).

(A) A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). A change or departure from the original specification or claims represents an “error” in the original patent under 35 U.S.C. 251. See MPEP § 1402 for a discussion of grounds for filing a reissue that may constitute the “error” required by 35 U.S.C. 251. Not all changes with respect to the patent constitute the “error” required by 35 U.S.C. 251.

(B) Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied. Applicant may specify more than one error.

Where more than one error is specified in the oath/declaration and some of the designated “errors” are found to not be “errors” under 35 U.S.C. 251, any remaining error which is an error under 35 U.S.C. 251 will still support the reissue.

The “at least one error” which is relied upon to support the reissue application must be set forth in the oath/declaration. It is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered. If an applicant chooses to point out these matters, the statements directed to these matters will not be reviewed by the examiner, and the applicant should be so informed in the next Office action. All that is needed for the oath/declaration statement as to error is the identification of “at least one error” relied upon.

In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid. The corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration. If the initial reissue oath/declaration “states at least one error” in the original patent, and, *in addition*, recites the specific corrective action taken in the reissue application, the oath/declaration would be considered acceptable, even though the corrective action statement is not required.

(C) It is not sufficient for an oath/declaration to merely state “this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure.” Rather, the oath/declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), *cert. denied*, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.

>A statement of “...failure to include a claim directed to...” and then presenting a newly added claim, would not be considered a sufficient “error” statement since applicant has not pointed out what the other claims lacked that the newly added claim has, or vice versa. Such a statement would be no better than

saying in the reissue oath or declaration that “this application is being filed to correct errors in the patent which may be noted from the change made by adding new claim 10.” In both cases, the error has not been identified.<

(D) Where a continuation reissue application is filed with a copy of the reissue oath/declaration from the parent reissue application, and the parent reissue application is not to be abandoned, the reissue oath/declaration should be accepted by the Office of Initial Patent Examination without further evaluation, since it is an oath/declaration, albeit improper under 35 U.S.C. 251. The examiner should>, however,< reject the claims of the continuation reissue application under 35 U.S.C. 251 as being based on an oath/declaration that does not identify an error being corrected by the continuation reissue application, and should require a new oath/declaration. >37 CFR 1.175(e) states that “the filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration, which pursuant to [37 CFR 1.175(a)(1)], identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application.” One of form paragraphs 14.01.01 through 14.01.03 may be used.<

Where a continuation reissue application is filed with a copy of the reissue oath/declaration from the parent reissue application, and the parent reissue application is, or will be abandoned, the copy of the reissue oath/declaration should be accepted by OIPE, and the examiner should check to ensure that the oath/declaration identifies an error which is still being corrected in the continuation application. If a preliminary amendment was filed with the continuation reissue application, the examiner should check for the need of a supplemental reissue oath/declaration. Pursuant to 37 CFR 1.175 (b)(1), for any error corrected via the preliminary amendment which is not covered by the oath or declaration submitted in the parent reissue application, applicant must submit a supplemental oath/declaration stating that such error arose without any deceptive intention on the part of the applicant. See MPEP § 1414.01.

Where a divisional reissue application is filed with a copy of the reissue oath/declaration from the parent reissue application, the reissue oath/declaration should be accepted by OIPE, since it is an oath/

declaration, though it may be improper under 35 U.S.C. 251. The examiner should check the copy of the oath/declaration to ensure that it identifies an error being corrected by the divisional reissue application. The copy of the oath/declaration from the parent reissue application may or may not cover an error being corrected by the divisional reissue application since the divisional reissue application is (by definition) directed to a new invention. If it does not, the examiner should reject the claims of the divisional reissue application under 35 U.S.C. 251 as being based on an oath/declaration that does not identify an error being corrected by the divisional reissue application, and require a new oath/declaration. If the copy of the reissue oath/declaration from the parent reissue application does in fact cover an error being corrected in the divisional reissue application, no such rejection should be made. However, since a new invention is being added by the filing of the divisional reissue application, a supplemental reissue oath/declaration pursuant to 37 CFR 1.175 (b)(1) will be required. See MPEP § 1414.01.

Form paragraph 14.01.01 may be used where the reissue oath/declaration does not identify an error.

¶ 14.01.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of a Specific Error

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath or declaration does not contain any statement of an error which is relied upon to support the reissue application.
2. This form paragraph can be used where the reissue oath or declaration does not even mention error. It can also be used where the reissue oath or declaration contains some discussion of the concept of error but never in fact identifies a specific error to be relied upon. For example, it is not sufficient for an oath or declaration to merely state “this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure.”
3. Form paragraph 14.14 must follow this form paragraph.

Where the reissue oath/declaration does identify an error or errors, the oath/declaration must be checked carefully to ensure that at least one of the errors identified is indeed an “error” which will support the filing of a reissue, i.e., an “error” that will provide grounds for reissue of the patent. See MPEP § 1402. If the error identified in the oath/declaration is not an appropriate error upon which a reissue can be based, then the oath/declaration must be indicated to be defective in the examiner’s Office action.

Form paragraphs 14.01.02 and 14.01.03 may be used where the reissue oath/declaration fails to provide at least one error upon which a reissue can be based.

¶ 14.01.02 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1)-The Identified “Error” Is Not Appropriate Error

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration identifies only one error which is relied upon to support the reissue application, and that one error is not an appropriate error upon which a reissue can be based.
2. Form paragraph 14.14 must follow this form paragraph.

¶ 14.01.03 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - Multiple Identified “Errors” Not Appropriate Errors

The reissue oath/declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration identifies more than one error relied upon to support the reissue application, and none of the errors are appropriate errors upon which a reissue can be based.
2. Note that if the reissue oath/declaration identifies more than one error relied upon, and at least one of the errors is an error upon which reissue can be based, this form paragraph should not be used, despite the additional reliance by applicant on “errors” which do not support the reissue. Only one appropriate error is needed to support a reissue.
3. Form paragraph 14.14 must follow this form paragraph.

III. A STATEMENT THAT ALL ERRORS WHICH ARE BEING CORRECTED IN THE REISSUE APPLICATION UP TO THE TIME OF SIGNING OF THE OATH/DECLARATION AROSE WITHOUT ANY DECEPTIVE INTENTION ON THE PART OF THE APPLICANT.

In order to satisfy this requirement, the following statement may be included in an oath or declaration:

“All errors in the present reissue application up to the time of signing of this oath/declaration, or errors which are being corrected by a paper filed concurrently with this oath/declaration which correction of errors I/we have reviewed, arose without any deceptive intention on the part of the applicant.”

Nothing more is required. The examiner will determine only whether the reissue oath/declaration contains the required averment; the examiner will not make any comment as to whether it appears that there was in fact deceptive intention (see MPEP § 2022.05). It is noted that a reissue oath/declaration will not be effective for any errors which are corrected by a filing made after the execution of the reissue oath/declaration, unless it is clear from the record that the parties executing the document were aware of the nature of the correction when they executed the document. Further, a reissue oath/declaration with an early date of execution cannot be filed after a correction made later in time, to cover the correction made after the execution date. This is so, even if the reissue oath/declaration states that *all errors up to the filing of the oath/declaration* arose without any deceptive intention on the part of the applicant.

Form paragraph 14.01.04 may be used where the reissue oath/declaration does not provide the required statement as to “without any deceptive intention on the part of the applicant.”

¶ 14.01.04 *Defective Reissue Oath/Declaration, 37 CFR 1.175- Lack of Statement of “Without Any Deceptive Intention”*

The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration does not contain the statement required by 37 CFR 1.175 that all errors being corrected in the reissue application arose without any deceptive intention on the part of the applicant.
2. This form paragraph is appropriate to use for a failure by applicant to comply with the requirement, as to any of 37 CFR 1.175(a)(2), 37 CFR 1.175(b)(1), or 37 CFR 1.175(b)(2).
3. Form paragraph 14.14 must follow.

IV. THE REISSUE OATH/DECLARATION MUST COMPLY WITH 37 CFR 1.63.

The reissue oath/declaration must include the averments required by 37 CFR 1.63(a) and (b), *e.g.*, that applicants for reissue

(A) have reviewed and understand the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath/declaration;

(B) believe the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and

(C) acknowledge the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56. See also the discussion regarding the requirements of an oath/declaration beginning at MPEP § 602.

The examiner should check carefully to ensure that all the requirements of 37 CFR 1.63 are met. Form paragraph 14.01.05 should be used in conjunction with the content of form paragraphs *>6.05< through *>6.05.20< as appropriate, where the reissue oath/declaration fails to comply with the requirements of 37 CFR 1.63.

¶ 14.01.05 *Defective Reissue Oath/Declaration, 37 CFR 1.175 - General*

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration does not comply with 37 CFR 1.175, and none of form paragraphs 14.01 - 14.01.04 or 14.05.02 apply.
2. This form paragraph must be followed by an explanation of why the reissue oath/declaration is defective.
3. Form paragraph 14.14 must follow the explanation of the defect.

See MPEP § 1414.01 for a discussion of the requirements for a supplemental reissue oath/declaration.

Depending on the circumstances, either form PTO/SB/51, Reissue Application Declaration By The

Inventor, or form PTO/SB/52, Reissue Application Declaration By The Assignee may be used to prepare a declaration in a reissue application.

CORRECTION OF PATENTS

1414

PTO/SB/51 (04-05)
 Approved for use through 04/30/2007. OMB 0651-0033
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 2)		Docket Number (Optional)		
All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.				
Note: To appoint a power of attorney, use form PTO/SB/81.				
Correspondence Address: Direct all communications about the application to:				
<input type="checkbox"/> The address associated with Customer Number: 				
OR				
<input type="checkbox"/> Firm or Individual Name				
Address				
City		State		Zip
Country				
Telephone		Email		
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.				
Full name of sole or first inventor (given name, family name)				
Inventor's signature			Date	
Residence			Citizenship	
Mailing Address				
Full name of second joint inventor (given name, family name)				
Inventor's signature			Date	
Residence			Citizenship	
Mailing Address				
Full name of third joint inventor (given name, family name)				
Inventor's signature			Date	
Residence			Citizenship	
Mailing Address				
<input type="checkbox"/> Additional joint inventors or legal representative(s) are named on separately numbered sheets forms PTO/SB/02A or 02LR attached hereto.				

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

CORRECTION OF PATENTS

1414

PTO/SB/52 (04-05)

Approved for use through 04/30/2007. OMB 0651-0033

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE APPLICATION DECLARATION BY THE ASSIGNEE	Docket Number (optional)										
<p>I hereby declare that:</p> <p>The residence, mailing address and citizenship of the inventors are stated below.</p> <p>I am authorized to act on behalf of the following assignee: _____</p> <p>and the title of my position with said assignee is: _____</p> <p>The entire title to the patent identified below is vested in said assignee.</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%; padding: 2px;">Inventor</td> <td style="width: 50%; padding: 2px;">Citizenship</td> </tr> <tr> <td colspan="2" style="padding: 2px;">Residence/Mailing Address</td> </tr> <tr> <td style="padding: 2px;">Inventor</td> <td style="padding: 2px;">Citizenship</td> </tr> <tr> <td colspan="2" style="padding: 2px;">Residence/Mailing Address</td> </tr> </table> <p><input type="checkbox"/> Additional Inventors are named on separately numbered sheets attached hereto.</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%; padding: 2px;">Patent Number</td> <td style="width: 50%; padding: 2px;">Date of Patent Issued</td> </tr> </table> <p>I believe said inventor(s) to be the original and first inventor(s) of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention entitled:</p> <div style="border: 1px solid black; height: 40px; margin: 5px 0;"></div> <p>the specification of which</p> <p><input type="checkbox"/> is attached hereto.</p> <p><input type="checkbox"/> was filed on _____ as reissue application number _____ / _____</p> <p>and was amended on _____</p> <p style="text-align: center;">(If applicable)</p> <p>I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.</p> <p>I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.</p> <p><input type="checkbox"/> I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b). Attached is form PTO/SB/02B (or equivalent) listing the foreign applications.</p> <p>I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)</p> <p><input type="checkbox"/> by reason of a defective specification or drawing.</p> <p><input type="checkbox"/> by reason of the patentee claiming more or less than he had the right to claim in the patent.</p> <p><input type="checkbox"/> by reason of other errors.</p>		Inventor	Citizenship	Residence/Mailing Address		Inventor	Citizenship	Residence/Mailing Address		Patent Number	Date of Patent Issued
Inventor	Citizenship										
Residence/Mailing Address											
Inventor	Citizenship										
Residence/Mailing Address											
Patent Number	Date of Patent Issued										

[Page 1 of 2]

This collection of information is required by 37 CFR 1.175. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/52 (04-05)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE	Docket Number (Optional)										
At least one error upon which reissue is based is described as follows:											
[Attach additional sheets, if needed.]											
All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.											
I hereby appoint:											
<input type="checkbox"/> Practitioners associated with Customer Number:											
OR											
<input type="checkbox"/> Practitioner(s) named below:											
<table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th style="width: 50%;">Name</th> <th style="width: 50%;">Registration Number</th> </tr> </thead> <tbody> <tr><td> </td><td> </td></tr> <tr><td> </td><td> </td></tr> <tr><td> </td><td> </td></tr> <tr><td> </td><td> </td></tr> </tbody> </table>	Name	Registration Number									
Name	Registration Number										
as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.											
Correspondence Address: Direct all communications about the application to:											
<input type="checkbox"/> The address associated with Customer Number:											
OR											
<input type="checkbox"/> Firm or Individual Name											
Address											
City	State										
Country	Zip										
Telephone	Email										
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.											
Signature	Date										
Full name of person signing (given name, family name)											
Address of Assignee											

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

<

1414.01 Supplemental Reissue Oath/Declaration [R-3]

If additional defects or errors are corrected in the reissue after the filing of the application and the original reissue oath or declaration, a supplemental reissue oath/declaration must be filed, unless all additional errors corrected are spelling, grammar, typographical, editorial or clerical errors which are not errors under 35 U.S.C. 251 (see MPEP § 1402). In other words, a supplemental oath/declaration is required where any “error” under 35 U.S.C. 251 has been corrected and the error was not identified in the original reissue oath/declaration.

The supplemental reissue oath/declaration must state that every error which was corrected in the reissue application not covered by the prior oath(s)/declaration(s) submitted in the application arose without any deceptive intention on the part of the applicant.

An example of acceptable language is as follows:

“Every error in the patent which was corrected in the present reissue application, and is not covered by the prior declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

A supplemental reissue oath/declaration will not be effective for any errors which are corrected by a filing made after the execution of the supplemental reissue oath/declaration, unless it is clear from the record that the parties executing the document were aware of the nature of the correction when they executed the document. Further, a supplemental reissue oath/declaration with an early date of execution cannot be filed after a correction made later in time, to cover the correction made after the execution date. This is so, even if the supplemental reissue oath/declaration states that *all errors up to the filing of the supplemental reissue oath/declaration* arose without any deceptive intention on the part of the applicant.

>

I. < WHEN AN ERROR MUST BE STATED IN THE SUPPLEMENTAL OATH/DECLARATION

In the supplemental reissue oath/declaration, there is **no need to state an error** which is relied upon to support the reissue application **if**:

(A) an error to support a reissue has been previously and properly stated in a reissue oath/declaration in the application; and

(B) that error is still being corrected in the reissue application.

If applicant chooses to state any further error at this point (even though such is not needed), the examiner should not review the statement of the further error.

The supplemental reissue oath/declaration must state an error which is relied upon to support the reissue application only where one of the following is true:

(A) the prior reissue oath/declaration failed to state an error;

(B) the prior reissue oath/declaration attempted to state an error but did not do so properly; or

(C) all errors under 35 U.S.C. 251 stated in the prior reissue oath(s)/declaration(s) are no longer being corrected in the reissue application.

>

II. < WHEN A SUPPLEMENTAL OATH/DECLARATION MUST BE SUBMITTED

The supplemental oath/declaration in accordance with 37 CFR 1.175(b)(1) must be submitted before allowance. See MPEP § 1444 for a discussion of the action to be taken by the examiner to obtain the supplemental oath/declaration in accordance with 37 CFR 1.175(b)(1), where such is needed.

Where applicant seeks to correct an error after allowance of the reissue application, a supplemental reissue oath/declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant. The supplemental reissue oath/declaration submitted after allowance will be directed to the error applicant seeks to correct after allowance. This supplemental oath/declaration need not cover any earlier errors, since all earlier errors should have been covered by a reissue oath/declaration submitted prior to allowance.

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III. < SUPPLEMENTAL OATH/DECLARATION IN BROADENING REISSUE

A broadening reissue application must be applied for by all of the inventors (patentees), that is, the original reissue oath/declaration must be signed by all of the inventors. See MPEP § 1414. If a supplemental oath/declaration in a broadening reissue application is subsequently needed in the application in order to fulfill the requirements of 37 CFR 1.175, the supplemental reissue oath/declaration must be signed by all of the inventors. *In re Hayes*, 53 USPQ2d 1222, 1224 (Comm'r Pat. 1999) (“37 CFR 1.175(b)(1), taken in conjunction with Section 1.172, requires a supplemental declaration be signed by all of the inventors. This is because all oaths or declarations necessary to

fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and declaration must bear the appropriate signatures of all the inventors.”).

If a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by all the available inventors may be filed provided it is accompanied by a petition under 37 CFR 1.183 along with the petition fee, requesting waiver of the signature requirement of the nonsigning inventor.

Form PTO/SB/51S, Supplemental Declaration For Reissue Patent Application To Correct “Errors” Statement (37 CFR 1.175), may be used to prepare a supplemental reissue declaration.

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PTO/SB/51S (09-04)

Approved for use through 04/30/2007. OMB 0651-0033

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

**SUPPLEMENTAL DECLARATION
FOR REISSUE
PATENT APPLICATION
TO CORRECT "ERRORS" STATEMENT
(37 CFR 1.175)**

Attorney Docket Number	
First Named Inventor	
COMPLETE if known	
Application Number	
Filing Date	
Art Unit	
Examiner Name	

I/We hereby declare that:

Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration(s) submitted in this application, arose without any deceptive intention on the part of the applicant.

I/We hereby declare that all statements made herein of my/our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any])		Family Name or Surname	
Inventor's Signature		Date	
Name of Second Inventor:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any])		Family Name or Surname	
Inventor's Signature		Date	
Name of Third Inventor:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any])		Family Name or Surname	
Inventor's Signature		Date	
Name of Fourth Inventor:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any])		Family Name or Surname	
Inventor's Signature		Date	

Additional inventors or legal representatives(s) are being named on the _____ supplemental sheets PTO/SB/02A or 02LR attached hereto.

This collection of information is required by 37 CFR 1.175. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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1415 Reissue *>Application< and Issue Fees [R-3]

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I. BASIC REISSUE APPLICATION FILING, SEARCH, AND EXAMINATION FEES

The Consolidated Appropriations Act, 2005 (Consolidated Appropriations Act), effective December 8, 2004, provides for a separate reissue application filing fee, search fee, and examination fee during fiscal years 2005 and 2006. For reissue applications filed on or after December 8, 2004, the following fees are required: basic filing fee as set forth in 37 CFR 1.16(e)(1); search fee as set forth in 37 CFR 1.16(n); examination fee as set forth in 37 CFR 1.16(r); application size fee, if applicable (see subsection II. below); and excess claims fees, if applicable (see subsection III. below).

For reissue applications filed prior to December 8, 2004, the following fees are required: basic filing fee as set forth in 37 CFR 1.16(e)(2); and excess claims fees, if applicable (see subsection III below). No search and examination fees are required for reissue applications filed before December 8, 2004.

The basic filing, search and examination fees are due on filing of the reissue application. These fees may be paid on a date later than the filing date of the reissue application provided they are paid within the time period set forth in 37 CFR 1.53(f) and include the surcharge set forth in 37 CFR 1.16(f). For reissue applications filed on or after December 8, 2004 but prior to July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(b), if the search and/or examination fees are paid on a date later than the filing date of the reissue application, the surcharge under 37 CFR 1.16(f) is not required. For reissue applications filed on or after July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(b), if any of the basic filing fee, the search fee, or the examination fee are paid on a date later than the filing date of the reissue application, the surcharge under 37 CFR 1.16(f) is required.

II. APPLICATION SIZE FEE

The Consolidated Appropriations Act also provides for an application size fee. 37 CFR 1.16(s) sets forth the application size fee for reissue applications filed

on or after December 8, 2004, the specification and drawings of which, excluding a sequence listing or computer program listing filed in an electronic medium in compliance with the rules (see 37 CFR 1.52(f)), exceed 100 sheets of paper. The application size fee does not apply to reissue applications filed before December 8, 2004. The application size fee applies for each additional 50 sheets or fraction thereof over 100 sheets of paper. Any sequence listing in an electronic medium in compliance with 37 CFR 1.52(e) and 37 CFR 1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with 37 CFR 1.52(e) and 1.96, will be excluded when determining the application size fee required by 37 CFR 1.16(s). See also MPEP § 607.

III. EXCESS CLAIMS FEES

37 CFR 1.16(h) sets forth the excess claims fee for each independent claim in excess of three. 37 CFR 1.16(i) sets forth the excess claims fee for each claim (whether independent or dependent) in excess of twenty. The excess claims fees specified in 37 CFR 1.16(h) and (i) apply to all reissue applications pending on or after December 8, 2004. The excess claims fees specified in 37 CFR 1.16(h) and (i) apply to any excess claims fee paid on or after December 8, 2004, regardless of the filing date of the reissue application and regardless of the date on which the claim necessitating the excess claims fee payment was added to the reissue application. Under 35 U.S.C. 41(a)(2) as amended by the Consolidated Appropriations Act, the claims in the original patent are not taken into account in determining the excess claims fee for a reissue application.

Example 1:

Applicant filed a reissue application before December 8, 2004, with the same number of claims as in the patent. The patent has more than 3 independent claims and more than 20 total claims. If applicant added one more independent claim in the reissue application by filing an amendment before December 8, 2004, but did not pay for the excess claims fees prior to December 8, 2004, on or after December 8, 2004, applicant will have to pay for one additional independent claim per the fee set forth in 37 CFR 1.16(h) and one additional total claim per the fee set forth in 37 CFR 1.16(i).

Example 2:

Applicant filed a reissue application on or after December 8, 2004, with the same number of claims as in the patent. The patent has 4 independent claims and 21 total claims. Excess claims fees for the 4th independent claim (one additional independent claim per the fee set forth in 37 CFR 1.16(h)) and the 21st claim (one additional total claim per the fee set forth in 37 CFR 1.16(i)) are required. Under 35 U.S.C. 41(a)(2) as amended by the Consolidated Appropriations Act, the claims in the original patent are not taken into account in determining the excess claims fees for a reissue application.

The excess claims fees, if any, due with an amendment are required prior to any consideration of the amendment by the examiner. Upon submission of an amendment (whether entered or not) affecting the claims, payment of fees for those claims in excess of the number previously paid for is required. The additional fees, if any, due with an amendment are calculated on the basis of the claims (total and independent) which would be present, if the amendment were entered. If an amendment is limited to revising the existing claims and it does not result in the addition of any new claim, there is no excess claim fee. Excess claims fees apply only to the addition of claims. It is to be noted that where excess claims fees have been previously paid, a later amendment affecting the claims cannot serve as the basis for granting any refund. See 37 CFR 1.26(a).

Amendments filed before a first Office action, or otherwise not filed in reply to an Office action, presenting additional claims in excess of the number already paid for, not accompanied by the full addi-

tional claims fee due, will not be entered in whole or in part and applicant will be so notified. Such amendments filed in reply to an Office action will be regarded as being non-responsive to the Office action and the practice set forth in MPEP § 714.03 will be followed.

An amendment canceling claims accompanying the papers constituting the reissue application will be effective to diminish the number of claims to be considered in calculating the filing fees to be paid. A preliminary amendment filed concurrently with a reply to a Notice To File Missing Parts of Application that required the filing fees, which preliminary amendment cancels or adds claims, will be taken into account in determining the appropriate filing fees due in response to the Notice To File Missing Parts of Application. However, no refund will be made for claims being canceled in the reply that have already been paid for.

After a requirement for restriction, non-elected claims will be included in determining the fees due in connection with a subsequent amendment unless such claims are canceled.

IV. ISSUE FEE

The issue fee for issuing each reissue patent is set forth in 37 CFR 1.18(a).

V. REISSUE APPLICATION FEE TRANSMITTAL FORM

The Office has prepared Form PTO/SB/56, Reissue Application Fee Transmittal Form which is designed to assist in the correct calculation of reissue filing fees.<

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PTO/SB/56 (6-05)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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REISSUE APPLICATION FEE TRANSMITTAL FORM							Docket Number (Optional)		
Application as Filed – Part 1									
	(1) Claims Filed in Reissue Application	(2) Minus claims included in the basic filing fee	(3) Number Extra	Small Entity		or	Other than a Small Entity		
				Rate (\$)	Fee (\$)		Rate (\$)	Fee (\$)	
Total Claims (37 CFR 1.16(i))		- 20 =		x	=		x	=	
Independent Claims (37 CFR 1.16(h))		- 3 =		x	=		x	=	
Application Size Fee (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).								
				Filing Fee (37 CFR 1.16(e))					
				Search Fee (37 CFR 1.16(n))					
				Examination Fee (37 CFR 1.16(r))					
				Total Filing Fee					
Application as Amended – Part 2									
	(1) Claims After Amendment including cancellation of claims	(2)	(3) Highest Number Previously Paid For	(3) Extra Claims Present	Small Entity		or	Other than a Small Entity	
					Rate (\$)	Fee (\$)		Rate (\$)	Fee (\$)
Total Claims (37 CFR 1.16(i))		MINUS	*	=	X	=		x	=
Independent Claims (37 CFR 1.16(h))		MINUS	**	=	x	=		x	=
Application Size Fee (37 CFR 1.16(s))				Total Additional Fee					

* Enter the greater of (a) 20 or (b) the highest number of total claims previously paid for in this reissue application.
 ** Enter the greater of (a) 3 or (b) the highest number of independent claims previously paid for in this reissue application.

Applicant claims small entity status. See 37 CFR 1.27.

Please charge Deposit Account No. _____ in the amount of _____.
A duplicate copy of this sheet is enclosed.

The Director is hereby authorized to charge any additional fees under 37 CFR 1.16 or 1.17 which may be required, or credit any overpayment to Deposit Account No. _____. A duplicate copy of this sheet is enclosed.

A check in the amount of \$ _____ to cover the filing/additional fee is enclosed.

Payment by credit card. Form PTO-2038 is attached. WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Signature

Date

Typed or printed name

Registration Number, if applicable

E-mail Address

Telephone Number

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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1415.01 Maintenance Fees on the Original Patent [R-3]

The filing of a reissue application does not alter the schedule of payments of maintenance fees on the original patent. If maintenance fees have not been paid on the original patent as required by 35 U.S.C. 41(b) and 37 CFR 1.20, and the patent has expired, no reissue patent can be granted. 35 U.S.C. 251, first paragraph, only authorizes the granting of a reissue patent for the unexpired term of the original patent. Once a patent has expired, the Director of the USPTO no longer has the authority under 35 U.S.C. 251 to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

The examiner should determine whether all required maintenance fees have been paid *prior to conducting an examination* of a reissue application. In addition, during the process of preparing the reissue application for issue, the examiner should again determine whether all required maintenance fees have been paid up to date.

The history of maintenance fees is determined by the following, all of which should be used (to provide a check on the search made):

(A) Go to the USPTO Intranet (<http://ptoweb/pto-intranet/index.htm>) and select the PALM screen, then the “General Information” screen, type in the patent number and then select the “Fees” screen.

(B) Go to the USPTO Intranet and then the “Revenue Accounting and Management” screen, then the “File History” screen. Then type in the patent number.

(C) Go to the USPTO *Internet Site (<http://www.uspto.gov>) and select “eBusiness”, then the “Patent Electronic Business Center” screen, then the “Patent Application Information Retrieval (PAIR)” screen (<http://pair.uspto.gov/cgi-bin/final/home.pl>), and type in the patent number and select the “view Maint. Statement” screen.

If the window for the maintenance fee due has closed (maintenance fees are due by the day of the 4th, 8th and 12th year anniversary of the grant of the patent), but the maintenance fee has not been paid, then the reissue should be forwarded to the Office of Patent Legal Administration (OPLA) to consider vacating and terminating the reissue proceeding (with subsequent abandonment of the reissue application).

However, if time remains for applicant to pay the maintenance fee, then the application should not be rejected under 35 U.S.C. 251 and it may be passed to issue when it is in condition for allowance, because the patent has not expired. **

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PAYMENT OF MAINTENANCE FEES WHERE THE PATENT HAS BEEN REISSUED

Pursuant to 37 CFR 1.362(b), maintenance fees are not required for a reissue patent if the original patent that was reissued did not require maintenance fees.

Where the original patent that was reissued did require maintenance fees, the schedule of payments of maintenance fees on the original patent will continue for the reissue patent. 37 CFR 1.362(h). Once an original patent reissues, maintenance fees are no longer due in the original patent, but rather the maintenance fees are due in the reissue patent. This is because upon the issuance of the reissue patent, the original patent is surrendered and ceases to exist.

In some instances, more than one reissue patents will be granted to replace a single original patent. The issuance of more than one reissue patent does not alter the schedule of payments of maintenance fees on the original patent. The existence of multiple reissue patents for one original patent can arise where multiple divisional reissue applications are filed for the same patent, and the multiple applications issue as reissue patents (all to replace the same original patent). In addition, a divisional application or continuation application of an existing reissue application may be filed, and both may then issue as reissue patents. In such instances, 35 U.S.C. 41 does not provide for the charging of more than one maintenance fee for the multiple reissues. Thus, no payment of additional maintenance fees is required for the second or subsequent reissue patents, i.e., continuation or divisional reissues, which are derived from a first reissue patent which has issued. The maintenance fee must be directed to the first reissue patent that has issued. This is unlike the instance where there is a reissue of a reissue patent, and the maintenance fee must be directed to the reissue of the reissue patent.<

See MPEP Chapter 2500 for additional information pertaining to maintenance fees.

