Chapter 1400 Correction of Patents

Errors in a patent may be corrected in three ways, namely (1) by reissue, (2) by the issuance of a certificate of correction which becomes a part of the patent, and (3) by disclaimer. Reissue filing procedures may also be used when the patentee desires the Office to consider prior art or other information relevant to patentability, not previously considered by the Office.

1401 Reissue [R–1]

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 Commissioner 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 Commissioner 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.

1402 Grounds for Filing [R–1]

The most common bases for filing a reissue application are (1) the claims are too narrow or too broad; (2) the disclosure contains inaccuracies; (3) applicant has become aware of prior art or other information relevant to patentability not previously, considered by the Office, (for example, prior patents and publications, prior public use or sale); (4) seeking a determination of inventorship which might be deemed to result in an error by the Office; (5) applicant failed to or incorrectly claimed foreign priority; (6) applicant failed to make reference to or incorrectly made reference to prior copending applications.

The correction of misjoinder of inventors has been held to be a ground for reissue: Ex parte Scudder, 169 USPQ 814. In A. F. Stoddard & Co. v. Dann, Comr. Pats., 195 USPQ 97 (1977), the Court of Appeals for the District of Columbia Circuit held that correction of an innocent error in inventorship, by changing from one inventor to a different inventor, was a ground for reissue. Citing "Stoddard", the Commissioner of Patents and Trademarks held in In re Shibata, 203 USPQ 780, 782 (1979), that

> "it is apparent that the PTO has the authority under certain conditions to allow a sole-to-sole conversion regarding the inventorships."

A reissue was granted in Brenner v. State of Israel, 862 O.G. 661, 158 USPQ 584, 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 before the patent was granted.

Correction of failure to adequately claim priority in earlier filed copending U.S. Patent application was held a proper ground for reissue in Sampson v. Comr. of Pats. 195 USPQ 136, 137 (DC.DC. 1976). Reissue applicant's failure to timely file a divisional application is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than they had a right to claim; and thus such applicant's error is not correctable by reissue of the original patent under 35 U.S.C. 251: In re Orita, Yohagi, and Enomoti, 193 USPQ 145, 148 (CCPA 1977); see also In re Mead, 581 F. 2d 257, 198 USPQ 412 (CCPA 1978).

1403 Diligence in Filing [R–1]

When a reissue application is filed within two 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, in the absence of evidence to the contrary: 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) reversed on other grounds 245 F. 2d 693, 113 USPQ 423 (4th Cir. 1957).

However, as stated in the fourth paragraph of 35 U.S.C. 251,

> 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.

See § 1412.03 for broadening reissue practice.

A reissue filed on the two year anniversary date is considered filed within two years: see Switzer Z. Ward v. Sockman & Brady, 142 USPQ 226 (CCPA 1964) for a similar rule in interferences.

1404 Submission of Papers Where Reissue Patent is in Litigation [R–1]

Applicants and protestors (see § 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 Office or group art unit of the Patent and Trademark Office in which the reissue application is located, e.g., Assistant Commissioner for Patents, Board of Appeals, Examining Group, Board of Interferences, Office of Publications, etc. Any "Reissue Litigation" papers mailed to the Office should be so marked and mailed to Box 7, Commissioner of Patents and Trademarks, Washington, D.C. 20231. 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. See §§ 1442.01–1442.04 for examination of litigation related applications.

1410 Content of Reissue Application [R–1]

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. The application must be accompanied by a certified copy of an abstract of title or an order for a title report, to be placed in the file, and by an offer to surrender the original patent (§ 1.178).

Applicants for reissue are required to file a reissue oath or declaration which, in addition to complying with the first sentence of § 1.65, must comply with § 1.175. With respect to a reissue application filed without an oath or declaration, it was held in *Potter* v. *Dann*, 201 USPQ 574, 575 (D.C. D.C. 1978):

"That, under 35 U.S.C. §§ 111, 115, 251, papers submitted to the PTO do not constitute a complete application and, hence, are not entitled to a filing date, unless accompanied by a proper oath or declaration . . .".

1411 Form of Specification [R–1]

37 CFR 1.173. Specification. The specification of the reissue application must include the entire specification and claims of the patent, with the matter to be omitted by reissue enclosed in square brackets; and any additions made by the reissue must be underlined, so that the old and the new specifications and claims may be readily compared. Claims should not be renumbered and the numbering of claims added by reissue should follow the number of the highest numbered patent claim. No new matter shall be introduced into the specification.

The file wrappers of all reissue applications are stamped "REISSUE" above the Serial Number on the front of the file. "Reissue" also appears below the Serial Number on the printed label on the file wrapper.

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 may be used in preparing the reissue specification and claims to be filed. It should be noted however that amendments to the reissue application should not be prepared in this way. After filing, the specification and claims in the reissue application must be amended by filing a paper which indicates the specific change to be made. The exact word or words to be stricken out or inserted and the precise point where the deletion or insertion is to be made must be specified in the amendment as provided in 37 CFR 1.121(e) and (a). However, insertions or deletions to the specification or claims made prior to filing should be underlined or bracketed, respectively, as indicated in § 1.173.

Examples of the form for a twice-reissued patent is found in Re. 23,558 and Re. 28,488.

Entire words or chemical formulas must be shown as being changed. Change in only a part of a word or formula is not permitted. Deletion of chemical formulas should be shown by brackets which are substantially larger and darker than any in the formula.

1411.01 Certificate of Correction in Original Patent [R–1]

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 also make certain that all Certificate of Correction changes have been properly incorporated into the reissue application.

1411.02 New Matter [R–1]

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 also be for matter which the applicant had the right to claim in the original patent. 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., 1942 C.D. 751, 315 U.S. 668, 53 USPQ 6.

1412 Content of Claims [R–1]

The content of claims in a reissue application is somewhat limited as indicated in §§ 1412.01–03.

1412.01 Reissue Claims Must be for Same General Invention [R–1]

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, is considered in determining what the patentee objectively intended as his invention. The proper test is set forth in In re Rowland, 526 F. 2d 558, 560, 187 USPQ 487, 489 (CCPA 1975), requiring "an essentially factual inquiry confined to the objective intent manifested by the original patent." (Emphasis in original). See also In re Mead, 581 F. 2d 257, 198 USPQ 412 (CCPA 1978). There should be something in the original patent evidencing that applicant intended to claim or that applicant considered the material now claimed to be his or her invention.

1412.02 Recapture of Cancelled Subject Matter [R–1]

A reissue will not normally be granted to "recapture" claimed subject matter deliberately cancelled in an application to obtain a patent: In re Willingham, 282 F. 2d 353, 127 USPQ 211 (CCPA 1960). See also, In re Richman, 161 USPQ 359, 363, 364 (CCPA 1969); and In re Wadlinger, Kerr and Rosinski, 181 USPQ 826 (CCPA 1974). See § 1412.03.

1412.03 Broadening Reissue Claims [R–1]

35 U.S.C. 251 prescribes a two 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."

A claim of a reissue enlarges the scope of the claims of the patent if it is broader than such claims in any respect, even though it may be narrower in other respects or, in other words, if it contains within its scope any conceivable apparatus or process which would not have infringed the original patents: In re Ruth, 278 F. 2d 729, 126 USPQ 155, 156, 47 CCPA 1016 (1960); In re Rogoff, 261 F. 2d 601, 120 USPQ 185, 186, 46 CCPA 733 (1958), and cases cited therein. A claim broadened in one limitation is a broadened claim even though it may be narrower in other respects. In a reissue application, filed within two years of the original patent grant, broadened claims may be presented even though such claims were not submitted until more than two years after the patent grant and were broader in scope than both the original patent claims and broadening reissue claims originally submitted: In re Doll, 164 USPQ 218, 220 (CCPA 1970).

A reissue application is considered filed within two years of the patent grant if filed on the two year anniversary date of the patent grant: see Switzer & Ward v. Sockman Z. Brady, 142 USPQ 226 (CCPA 1964) for a similar rule in interferences.

1413 Drawings [R–1]

37 CFR 1.174. Drawings. (a) The drawinge upon which the original patent was issued may be used in reissue applications if no changes whatsoever are to be made in the drawings. In such cases, when the reissue application is filed, the applicant must submit a temporary drawing which may consist of a copy of the printed drawings of the patent or a photoprint of the original drawings securely mounted by pasting on sheets of drawing board of the size required for original drawing, or an order for the same.

(b) Amendments which can be made in a reissue drawing, that is, changes from the drawing of the patent, are restricted.

If transfer of the patent drawings to the reissue application is desired, a letter requesting transfer of the drawings from the patent file should be filed along with the reissue application.

If transfer of the original drawing is contemplated, applicant must submit a copy of the original drawing or "an order for same" (37 CFR 1.174).

The drawings of the original patent may be used in lieu of new drawings, provided that no alteration whatsoever is to be made in the drawings, including canceling an entire sheet.

The mounted copy of any informal drawing should be marked "informal, AFE" (Admitted for Examination) by the draftsman, but the examiner should disregard the notation if the informality will be corrected by formal transfer of the drawing before final allowance.

When the reissue case is ready for allowance the examining group makes the formal transfer of the original drawing to the reissue case. See § 608.02(k). Additional sheets of drawings may be added but no changes can be made in the original patent drawings.

1414 Content of Reissue Oath or Declaration [R–1]

37 CFR. 1.175. Reissue oath or declaration. (a) Applicants for reissue, in addition to complying with the requirements of the first sentence of § 1.65, must also file with their applications a statement under oath or declaration as follows:

(1) When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief and the reasons why.

(2) When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly specifying such defects.

(3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

(4) When the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid, particularly specifying such prior art or other information and requesting that if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent.

(5) Particularly specifying the errors or what might be deemed to be errors relied upon, and how they arose or occurred.

(6) Stating that said errors, if any, arose "without any deceptive intention" on the part of the applicant.

(b) Corroborating affidavits or declarations of others may be filed and the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue and its object.

The reissue oath or declaration is an essential part of a reissue application. A reissue application is not entitled to a filing date, unless accom-

panied by an oath or declaration; Potter v. Dann, 201 USPQ 574, 575 (D.C.D.C. 1978).

The question of the sufficiency of the reissue oath or declaration filed under 37 CFR 1.75 must in each case be reviewed and decided personally by the primary examiner (see § 1414.03).

Reissue oaths or declarations must point out very specifically what the defects are and how and *when* the errors arose, and how and when errors were discovered. The statements in the oath or declaration must be of facts and not conclusions. All reissue oaths, whether filed under § 1.175 subsections (a)(1) to (a)(3) or (a)(4), must also comply with both subsections (a)(5) and (a)(6).

1414.01 Reissue Oath or Declaration Under § 1.175 (a)(1), (a)(2), & (a)(3) [R–1]

Reissue oaths or declarations, other than § 1.175(a)(4) type, must comply with subsection (a)(1) and the appropriate subsections (a)(2) and/or (a)(3). All reissue oaths or declarations must, in addition, comply with subsections (a)(5) and (a)(6).

Subsection (a)(1) requires a statement that "applicant verily believes the original patent to be wholly or partly inoperative or invalid," and in addition, "the reasons why." Subsection (a)(2) applies when it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing"; and requires applicant to particularly specify such defects. Subsection (a)(3) applies when it is claimed that such patent is inoperative or invalid "by reason of patentee claiming more or less than he had a right to claim in the patent"; and requires applicant, in addition, to distinctly specify the excess or insufficiency in the claims.

Failure to assert a difference in scope between the original and reissue claims in the reissue oath or declaration, has been held to be a fatal defect. The patent statutes afford no authority for the reissue of a patent merely to add claims of the same scope as those already granted: In re Wittry, 180 USPQ 320, 323 (CCPA 1974).

1414.02 Reissue Oath or Declaration under § 1.175(a)(4) [R–1]

Subsection 1.175(a)(4) recognizes that reissues may be filed to have the patentability of the original patent, without changes therein, considered in view of prior art or other information relevant to patentability which was not previously considered by the Office.

37 CFR 1.175 (a)(4) has been held to be within the rulemaking power of the Commissioner in *Sheller Globe Co. v. Mobay Chemical Corp.* Civil Action No. 78–70563, (E. D. Mich., Southern Div., 1980) BNA/PTCJ 468: A–8, 9.

Subsection (a)(4) does not contemplate, or permit, the filing of a reissue application without an oath or declaration. To the contrary, an oath or declaration is required, and such oath or declaration must comply with each of subsections (a)(4), (a)(5) and (a)(6) of § 1.175: Potter v. Dann, 201 USPQ 574, 575 (D.C. D.C. 1978).

The reissue oath or declaration of the § 1.175 (a)(4) type must

(1) state that "the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid",

(2) particularly specify "such prior art or other information"; and,

(3) request "that if the examiner so deems, applicant be permitted to amend the patent and be granted a reissue" (see § 1401.08(b)). In addition a § 1.175(a)(4) type reissue oath or declaration must comply with subsections (a)(5) and (a)(6) of § 1.175 (§§ 1401.08(c) and (d)).

However, no reissue application will be passed for issue with only a § 1.175(a)(4) type oath or declaration. Applications filed under § 1.175(a)(4) *cannot* be passed for issue *without* amendment, but will be rejected as lacking statutory basis for a reissue, if there are no other grounds of rejection, since 35 U.S.C. 251 does not authorize reissue of a patent unless the patent is deemed wholly or partly inoperative or invalid. However, the record of prosecution of the reissue will indicate that the prior art has been considered by the examiner. If a reissue filed under subsection 1.175(a)(4) is amended, even though in response to a rejection, the reissue is thereby converted into an application under subsection 1.175(a)(1), and appropriate subsections 1.175(a)(2) and/or (a)(3), and a new reissue oath or declaration must be filed containing the appropriate averments.

The new reissue oath or declaration must comply with subsections (a)(1) and (a)(2)/(a)(3), (a)(5), and (a)(6) of § 1.175, relating to actual errors rather than possible or "what might be deemed to be errors." If such a proper new oath or declaration is not filed, a rejection will be made on the basis that the reissue oath or declaration is insufficient. The supplemental oath or declaration insures compliance with 35 U.S.C. 251 by providing appropriate averments relating to actual errors rather than possible errors.

Thus, a patentee may file a reissue if he or she believes his or her patent is valid over prior art not previously considered by the Office but would like to have a reexamination. The procedure may be used at any time during the life of a patent. During litigation, a federal court may, if it chooses, stay court proceedings to permit new art to be considered by the Office.

1414.02(a) Information Considered under § 1.175(a)(4) [R–1]

The types of information contemplated under subsection 1.175(a)(4) include any information, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid. While prior art documents such as patents and publications are most often the kinds of information which are the subject of § 1.175(a)(4) type reissues, subsection 1.175(a)(4) is not limited to prior art documents. Any information "which might cause the examiner to deem the original patent wholly or partly inoperative or invalid" may be the subject of an (a)(4) type reissue. For example, such information which might demonstrate that:

(1) the patented subject matter was publicly known or used by others in this country before the invention thereof by applicant;

(2) the patented subject matter was in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States;

(3) the patentee had abandoned the invention or did not himself invent the subject matter patented;

(4) before patentee's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it;

(5) the disclosure in the patent is insufficient in some respect under 35 U.S.C. 112;

(6) the patent otherwise lacks compliance with any of the statutory requirements for patentability;

(7) "fraud" or "violation of the duty of disclosure" is present.

The information may be in different forms, such as patents or publications. However, the information may also be based on other forms of evidentiary material including, for example, litigation-related materials such as complaints, answers, depositions, answers to interrogatories, exhibits, transcripts of hearings or trials, court orders and opinions, stipulations of the parties, etc. Of course, the reissue applicant does not have to, and presumably does not, agree that the errors exist. Applicant does not have to express a personal belief as to the relevancy of the information; it is sufficient that its relevancy has been or might be asserted by someone else such as, for example, an adverse party in litigation. However, the reissue applicant must particularly specify "what might be deemed to be errors relied upon", in the reissue oath or declaration of the § 1.175(a)(4).

1414.03 Requirements of § 1.175(a)(5) [R–1]

All reissue oaths or declarations must comply with subsection 1.175(a)(5), including the 1.175(a)(4) type, by "particularly specifying the errors or what might be deemed to be errors relied upon, and how they arose or occurred." Subsection 1.175(a)(5) has two specific requirements, both of which must be complied within, or by, the reissue oath or declaration. This subsection requires applicant to particularly specify (1) "the errors or what might be deemed to be errors relied upon" and (2) "how they arose or occurred."

If applicant is seeking reexamination in view of particular prior art or other information, in a § 1.175(a)(4) type reissue, the reissue oath or declaration must point out "what might be deemed to be errors" in patentability in view of such prior art or other information. More specifically, the oath or declaration, in appropriate circumstances, might state that some or all claims might be deemed to be too broad and invalid in view of references X and Y which were not of record in the patented files. Usually, a general statement will suffice. But where appropriate, such as where the pertinence of the new references X and Y are not evident, more specificity about "what might be deemed to be errors" should be provided. Of course, as discussed in § 1414.02, the reissue applicant does not have to, and presumably does not, agree that "errors" exist. However, the reissue applicant does have to, in the reissue oath or declaration of the subsection 1.175(a)(4) type, particularly specify "what might be deemed to be errors relied upon."

It is particularly important that the reissue oath or declaration specify in detail how the errors, or what might be deemed to be errors arose or occurred. "How" includes when and under what circumstances the errors or what might be deemed to be errors arose or occurred. This means that the reissue oath or declaration must specify the manner in which that which "might be deemed to be errors" "arose or occurred." For example, if the § 1.175(a)(4) reissue is being filed for reexamination in view of prior art or other information, the reissue oath or declaration must indicate when and the

manner in which the reissue applicant became aware of the prior art or other information and of the possible error in the patent; such as, for example, through discovery of prior art or other information subsequent to issuance of patent, knowledge of prior art or other information before issuance of patent with significance being brought out after issuance by third party, through allegations made in litigation involving the patent, etc. It is particularly important that the reissue oath or declaration adequately specify how "what might be deemed to be errors" arose or occurred. If the reissue oath or declaration does not particularly specify "how," i.e., the manner in which any possible errors arose or occurred, the Office will be unable to adequately evaluate reissue applicant's statement in compliance with § 1.175(a)(6) that the "errors, if any, arose 'without any deceptive intention' on the part of the applicant;" see § 1414.04.

1414.04 Requirements of § 1.175(a)(6) [R-2]

Subsection 1.175(a)(6) specifically requires that all reissue oaths or declarations, including those filed under § 1.175(a)(4), contain the averment "that said errors, if any, arose 'without any deceptive intention' on the part of the applicant." This requirement for an absence of "deceptive intention" should not be overlooked, since it is a necessary part of any reissue application, including those of the § 1.175(a)(4) type. The examiner will determine whether the reissue oath or declaration contains the required averment that the "errors, if any, arose 'without any deceptive intention'," although the examiner will not comment as to whether it appears there was in fact deceptive intention or not (see § 2022.05).

1415 Reissue Filing Fee [R-1]

35 U.S.C. 41. Patent Fees. (a) The Commissioner shall charge the following fees:

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2. For issuing each original or reissue patent, except in design cases, $100; in addition, $10 for each page (or portion thereof) of specification as printed, and $2 for each sheet of drawing.

* * * * * * *

4. On filing each application for the reissue of a patent, $65; in addition, on filing or on presentation at any other time, $10 for each claim in independent form which is in excess of the number of independent claims of the original patent, and $2 for each claim (whether independent or dependent) which is in excess of ten and also in excess of the number of claims of the original patent. Errors in payment of the additional fees may be rectified in accordance with regulations of the Commissioner.

* * * * * * *

The applicant is permitted to present every claim that was issued in the original patent for a fee of $65. Additional claims must be paid for in the same manner as claims must be paid for in original applications. The filing fee for a design reissue application is $65. The Office has prepared a form 3.70 which is designed to assist in the correct calculation of reissue filing fees.

1416 Offer to Surrender and Return Original Patent [R-1]

37 CFR 1.178. Original patent. The application for a reissue must be accompanied by an offer to surrender the original patent. The application should also be accompanied by the original patent, or if the original is lost or inaccessible, by an affidavit or declaration to that effect. The application may be accepted for examination in the absence of the original patent or the affidavit or declaration, but one or the other must be supplied before the case is allowed. If a reissue be refused, the original patent will be returned to applicant upon his request.

The examination of the reissue application on the merits is made even though the offer to surrender the original patent, or an affidavit or declaration to the effect that the original is lost or inaccessible, has not been received. However, in such case the examiner should require one of the above in the first action. Either the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before the examiner can allow the reissue application.

If applicant request the return of the patent on abandonment of the reissue application, it will be sent to him by the Mail and Correspondence Division, and not by the examining group.

An applicant may request that a surrendered original patent be transferred from an abandoned reissue application to a continuation or divisional reissue application. The clerk making the transfer should note the transfer on the "Contents" of the abandoned application. The Serial Number and filing date of the reissue application to which it is transferred must be included in the notation. Where the original patent grant is not submitted with the reissue application as filed, patentee should include a copy of the printed original patent. Presence of a copy of the original patent is useful for the calculation of the reissue filing fee and for the verification of other identifying data.

REISSUE APPLICATION FEE DETERMINATION RECORD	ATTORNEY'S DOCKET NO.

CLAIMS AS FILED – PART I

CLAIMS IN PATENT	FOR	NUMBER FILED IN REISSUE APPLICATION	NUMBER EXTRA	RATE	FEES
(A)	TOTAL CLAIMS	(B)	**** =	X $2.00	
(C)	INDEP. CLAIMS	(D)	(D–C) =	X $10.00	
	BASIC FEE				$65.00
				TOTAL FILING FEE	

CLAIMS AS AMENDED – PART II

		(1) CLAIMS REMAINING AFTER AMENDMENT ***		(2) HIGHEST NO. PREVIOUSLY PAID FOR	(3) PRESENT EXTRA	RATE	(4) ADDITIONAL FEE
	TOTAL CLAIMS		MINUS	**	* =	X $2.00	=
	INDEP. CLAIMS		MINUS		=	X $10.00	=
						TOTAL ADDITIONAL FEE FOR THIS AMENDMENT	

** If the entry in column 1 is less than the entry in column 2, write "0" in column 3.*
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 10, write "10" in this space.*
**** After any cancelations of claims.*
***** If "A" is greater than 10, use (B—A); if "A" is 10 or less, use (B—10).*

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

☐ The Commissioner is hereby authorized to charge any additional fees 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 fee is enclosed.

_____ _____
date *Attorney of Record*

1417 Claim for Benefit Under 35 U.S.C. 119 [R–1]

A "claim" for the benefit of an earlier filing date in a foreign country under 35 U.S.C. 119 must be made in a reissue application even though such a claim was made in the application on which the original patent was granted. However, no additional certified copy of the foreign application is necessary. The procedure is similar to that for "Continuing Applications" in § 201.14(b).

The heading on printed copies will not be carried forward to the reissue from the original patent. Therefore, it is important that the file wrapper be endorsed under "Claims Foreign Priority."

1418 Prior Art Statement and Other Information [R–2]

In addition to meeting the requirements of § 1.175, the reissue applicant must, at the time of filing, also be aware of the requirements of 37 CFR 1.56, as revised effective March 1, 1977 (note § 2001).

Reissue applicants may utilize 37 CFR §§ 1.97–1.99 to comply with the duty of disclosure required by § 1.56 (note § 2002.03). However, this does not relieve applicant of the duties under § 1.175, for example, of "particularly, specifying such prior art or other information" in the reissue oath or declaration, and particularly specifying therein how and when applicant became aware of and/or came to appreciate the relevancy of such prior art or other information.

While § 1.97(a) provides for filing a prior art statement within three months of the filing of an application, reissue applicants are encouraged to file prior art statements at the time of filing in order that such statements will be available to the public during the two month period provided by § 1.176.

Subsection (b) of 37 CFR 1.175 provides that,

> "(b) Corroborating affidavits or declarations of others may be filed and the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue and its object."

Thus, applicant may under subsection 1.175 (b) file "corroborating affidavits or declarations of others . . . concerning the application for reissue and its objects." It also provides that "the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue or its object."

1420 Reissue Applicant [R–1]

37 CFR 1.172. Applicants, assignees. (a) Reissue applications must be signed and sworn to, or declaration made, by the inventor except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written assent of all assignees, if any, owning an undivided interest in the patent, but a reissue application 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.

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

The examiner must inspect the abstract of title to determine whether 37 CFR 1.172 has been complied with (note § 201.12).

Where the written assent of all the assignees to the filing of the reissue application cannot be obtained, applicant may under appropriate circumstances petition to Office of the Deputy Assistant Commissioner for Patents (§ 1002.02 (b)) for a waiver under 37 CFR 1.183 of that requirement of § 1.172, to permit the filing of the reissue application. The reissue application can be examined, but will not be allowed or issued without the assent of *all* the assignees as required by § 1.172: N. B. Fassett, 11 O.G. 420, 1877 C.D. 32; James D. Wright, 10 O.G. 587, 1876 C.D. 217, 218.

1430 Reissue Files Open to the Public [R–1]

37 CFR 1.11(b) provides that all reissue applications filed after March 1, 1977 "are open to inspection by the general public, and copies may be furnished upon the paying of a fee therefor. The filing of reissue applications will be announced in the Official Gazette." The announcement gives interested members of the public an opportunity to submit to the examiner information pertinent to the patentability of the reissue application. The announcement includes the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and the examining group to which the reissue application is initially assigned. A group director or other appropriate Office official may, under appropriate circumstances, postpone access to or the making of copies of a reissue application; such as, for example, to avoid interruption of the examination or other review of the application by an examiner. Those reissue applications already on file prior to March 1, 1977 are not automatically open to inspection, but a liberal policy is fol-

lowed by the Office of the Solicitor in granting petitions for access to such applications.

For those reissue applications filed on or after March 1, 1977, the following procedure will be observed:

1. The filing of reissue applications will be announced in the Official Gazette and will include certain identifying data as specified in Section 1.11(b). Any member of the general public may request access to a particular reissue application filed after March 1, 1977. Since no record of such request is intended to be kept, an oral request will suffice.

2. The reissue application files will be maintained in the examining groups and inspection thereof will be supervised by group personnel. Although no general limit is placed on the amount of time spent reviewing the files, the Office may impose limitations, if necessary, e.g., where the application is actively being processed.

3. Where the reissue application has left the examining group for administrative processing, requests for access should be directed to the appropriate supervisory personnel in the Division or Branch where the application is currently located.

4. Requests for copies of papers in the reissue application file must be in writing and addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 and may be either mailed or delivered to the Office mailroom. The price for copies made by the Office is thirty cents per page.

1431 Notice in Patent File [R–1]

37 CFR 1.179. Notice of reissue application. When an application for a reissue is filed, there will be placed in the file of the original patent a notice stating that an application for reissue has been filed. When the reissue is granted or the reissue application is otherwise terminated, the fact will be added to the notice in the file of the original patent.

Whenever a reissue application is filed, a form PTO–445 notice is placed in the patented file identifying the reissue application by Serial Number and its filing date. The pertinent data is filled in by the Application Division. When divisional or continuation reissue applications are filed, a separate form for each reissue application is placed in the original patented file. When the reissue is issued or abandoned, it is important that the Record Room be informed by the examining group clerical staff of that fact by written memo. Record Room personnel will update the form PTO–445 in the patented file.

1440 Examination of Reissue Application [R–1]

37 CFR 1.176 Examination of reissue. An original claim, if re-presented in the reissue application, is subject to reexamination, and the entire application will be examined in the same manner as original applications, subject to the rules relating thereto, excepting that division will not be required. Applications for reissue will be acted on by the examiner in advance of other applications, but not sooner than two months after announcement of the filing of the reissue application has appeared in the Official Gazette.

Section 1.176 provides that an original claim, if re-presented in a reissue application, will be subject to reexamination and along with the entire application, will be fully examined in the same manner subject to the same rules relating thereto, as if being presented for the first time in an original application. Reissue applications are normally examined by the same examiner who would examine a non-reissue application. In addition, the application will be examined with respect to compliance with §§ 1.171–1.179 relating specifically to reissue applications; for example, the reissue oath or declaration will be carefully reviewed for compliance with 37 CFR 1.175. Reissue applications with related litigation will be acted on by the examiner before any other special applications, and will be acted on immediately by the examiner, subject only to the 2 month delay after publication for examining reissue applications.

1441 Two-Month Delay Period [R–1]

Section 1.176 provides that reissue applications will be acted on by the examiner in advance of other applications, i.e., "special", but not sooner than two months after announcement of the filing of the reissue has appeared in the Official Gazette. The two-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. However, as set forth in § 1901.04, the public should be aware that such submissions should be made as early as possible since under certain circumstances the two-month delay period of § 1.176 may be waived. The Office will entertain petitions under 37 CFR 1.183 to waive the delay period of § 1.176. Appropriate reasons for requesting such a waiver might be, for example, that litigation has been stayed to permit the filing of the reissue application.

Since the examining group which issued the original patent is listed in the Official Gazette notice of filing of the reissue application, the indicated examining group should retain the

application file for two months after the date of the Official Gazette notice before transferring the reissue application under the procedure set forth in § 903.08(d).

1442 Special Status [R–1]

All reissue applications are taken up "special", and remain "special" even though applicant does not respond promptly.

All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other "special" applications; this means that all issues not deferred will be treated and responded to immediately. Furthermore, reissue applications involved in "litigation" will be taken up for action in advance of other reissue applications.

1442.01 Litigation Related Reissues [R–2]

During initial review, the examiner should determine whether the patent for which the reissue has been filed is involved in litigation and if so the status of that litigation. If the examiner becomes aware of litigation involving the patent sought to be reissued during examination of the reissue application, and applicant has not made the details regarding that litigation of record in the reissue application, the examiner, in the next Office action, will inquire regarding the specific details of the litigation. The following paragraph may be used for such an inquiry:

> "It has come to the attention of the examiner that the patent sought to be reissued by the application (is) (has been) involved in litigation. Any documents and/or materials, including the defenses raised against validity, or against enforceability because of fraud or inequitable conduct, which would be material to the examination of this reissue application are required to be made of record in response hereto. See 37 CFR 1.175(b)."

If the additional details of the litigation appear to be material to examination of the reissue application, the examiner may make such additional inquiries as necessary and appropriate under 37 CFR 1.175(b).

Where there is litigation, and it has not already been done, the examiner should place a prominent notation on the application file to indicate the litigation, (1) at the bottom of the face of the file in the box just to the right of the box for the retention label, and (2) on the pink Reissue Notice Card form PTO–89–31.

Applicants will normally be given one month to respond to Office actions in all reissue applications which are being examined during litigation, or after litigation has been stayed, dismissed, etc., to allow for consideration of the reissue by the Office. This one month period may be extended only upon a showing of *clear justification.* Of course, up to three months may be set for response if the examiner determines such a period is clearly justified.

1442.02 Litigation Not Stayed [R–1]

In order to avoid duplication of effort, action in reissue applications in which there is an indication of concurrent litigation will be suspended automatically unless and until it is evident to the examiner, or the applicant indicates, that: (1) a stay of the litigation is in effect; (2) the litigation has been terminated; (3) there are no significant overlapping issues between the application and the litigation; or (4) it is applicant's desire that the application be examined at that time.

1442.03 Litigation Stayed [R–2]

All reissue applications, except those under suspension because of litigation will be taken up for action ahead of other "special" applications; this means that all issues not deferred will be treated and responded to *immediately.* Furthermore reissue applications involved in "stayed litigation" will be taken up for action in advance of other reissue applications. Great emphasis is placed on the expedited processing of such reissue applications. The courts are especially interested in expedited processing in the Office where litigation is stayed.

In reissue applications with "stayed litigation," the Office will entertain petitions under 37 CFR 1.183 to waive the two month delay period under § 1.176.

Time monitoring systems have been put into effect which will closely monitor the time used by applicants, protestors, and examiners in processing reissue applications of patents involved in litigation in which the court has stayed further action. Monthly reports on the status of reissue applications with related litigation are required from each examining group. Delays in reissue processing are to be followed up.

The purpose of these procedures and those deferring consideration of certain issues is to reduce the time between filing of the reissue application and final action thereon, while still giving all parties sufficient time to be heard.

1442.04 Litigation Involving Patent [R-1]

In situations in which the patent for which reissue is being sought is, or has been, involved in litigation which raised a question material to examination of the reissue application, such as the validity of the patent, or any allegation of fraud, the existence of such litigation must be brought to the attention of the Office by the applicant at the time of, or shortly after, filing the application, either in the reissue oath or declaration, or in a separate paper, preferably accompanying the application as filed. Litigation begun after filing of the reissue application also should be promptly brought to the attention of the Office. The details and documents from the litigation, insofar as they are "material to the examination" of the reissue application as defined in 37 CFR 1.56(a), should accompany the application as filed, or be submitted as promptly thereafter as possible. For example, the defenses raised against validity of the patent, or charges of fraud or inequitable conduct in the litigation, would normally be "material to the examination" of the reissue application. It would, in most situations, be appropriate to bring such defenses to the attention of the Office by filing in the reissue application a copy of the Court papers raising such defenses. As a minimum, the applicant should call the attention of the Office to the litigation, the existence and nature of any allegations relating to validity and/or "fraud" relating to the original patent, and the nature of litigation materials relating to these issues. Enough information should be submitted to clearly inform the Office of the nature of these issues so that the Office can intelligently evaluate the need for asking for further materials in the litigation. Thus, the existence of supporting materials which may substantiate allegations of invalidity or "fraud" should, at least, be fully described, or submitted. The Office is not interested in receiving voluminous litigation materials which are not relevant to the Office's consideration of the reissue application. The status of the litigation should be updated in the reissue application as soon as significant events happen in the litigation.

When a reissue application is filed, the examiner should determine whether the original patent has been adjudicated by a court. The decision of the court and also other papers in the suit may give information essential to the examination of the reissue. The patented file will contain notices of the filing and termination of infringement suits on the patent. Such notices are required by law to be filed by the clerks of theDistrict Courts. These notices do not indicate if there was an opinion by the court, nor whether a decision was published. Shepard's Federal Citations and the cumulative digests of the United States Patents Quarterly, both of which are in the Office Law Library, contain tables of patent numbers giving the citation of published decisions concerning the patent. Where papers are not otherwise conveniently obtainable, the applicant may be requested to supply or lend copies of papers and records in suits, or the Office of the Solicitor may be requested to obtain them from the court. The information thus obtained should be carefully considered for its bearing on the proposed claims of the reissue, particularly when the reissue application was filed in view of the holding of a court.

If the examiner becomes aware of litigation involving the patent sought to be reissued during examination of the reissue application, and applicant has not made the details regarding that litigation of record in the reissue application, the examiner, in the next Office action, should inquire regarding the same. The following paragraph may be used for such an inquiry:

> "It has come to the attention of the examiner that the patent sought to be reissued by this application (is) (has been) involved in litigation. Any documents and/or materials, including the defenses raised against validity, or against enforceability because of fraud or inequitable conduct, which would be material to the examination of this reissue application are required to be made of record in response hereto. See 37 CFR 1.175(b)."

If the additional details of the litigation appear to be material to examination of the reissue application, the examiner may make such additional inquiries as necessary and appropriate under 37 CFR 1.175(b). See § 1447.

1442.05 Cases in Which Stays Were Considered [R-1]

District Courts are staying litigation in significant numbers of cases to allow for consideration of a reissue application by the Office. Relatively few courts have denied motions for stays. These cases are listed here for the convenience of the courts and the public.

In most instances, the reissue-reexamination procedure is instituted by a patent owner who voluntarily files a reissue application as a consequence of related patent litigation. However, some District Courts have required a patentee-litigant to file a reissue application, for example: *Alpine Engineering Inc.* v. *Automated Building Components Inc.*, BNA/PTCJ 367:

A–12 (S.D. Fla. 1978); *Lee-Boy Manufacturing Co.* v. *Puckett*, BNA/PTCJ 436: A–16 (D. Ga. 1978); *Choat* v. *Rome Industries Inc. et al.*, 203 USPQ 549 (N.D. Ga. 1979). Other courts have declined to so order, for example: *Bielomatik Leuze & Co.*, v. *Southwest Tablet Manufacturing Co.*, 204 USPQ 226 (N.D. Texas 1979); *RCA Corp.* v. *Applied Digital Data Systems Inc.*, 201 USPQ 451 (D. Del. 1979); *Antonious* v. *Kamata-Ri & Co. Ltd.*, 204 USPQ 294 (D. Md. 1979). Despite the voluntariness of a reissue filing, under present practice, only a patentee or his assignee may file a reissue patent application.

1442.05(a) Stays Granted [R–1]

"Stays" were ordered in the following sampling of published "decisions".

PIC Inc. v. *Prescon Corp.*, 195 USPQ 525 (D. Del. 1977).

Fisher Controls Co., Inc. v. *Control Components, Inc.*, 196 USPQ 817 (S.D. Iowa 1977). (Note also 203 USPQ 1059 denying discovery during the stay).

Alpine Engineering, Inc. v. *Automated Building Components, Inc.*, BNA/PTCJ 367: A–12 (S.D. Fla. 1978). (Dismissed a Declaratory Judgment suit with order for patentee to seek reissue in the Patent and Trademark Office).

AMI Industries, Inc. v. *E. A. Industries, Inc.*, Civil Action No. A–C–77–87, BNA/PTCJ 369: A–10 (W.D. N.C. 1978). (With dicta that if suit had not been dismissed proceedings would have been stayed for Office consideration.

Reynolds Metal Co. v. *Aluminum Co. of America*, BNA/PTCJ 375: (A–5). (N.D. Ind. 1978).

Sauder Industries, Inc. v. *Carborundum Co.*, 201 USPQ 240 (N.D. Ohio, 1978).

Rohm and Haas Co., v. *Mobil Oil Corp.*, BNA/PTCJ 414: A–10 (D. Del. 1978). (With provision for limited discovery on allegations of fraud for Office's benefit).

Lee-Boy Manufacturing Co., Inc. v. *Puckett*, BNA/PTCJ 436: A–16 (D. Ga. 1978). (Reissue ordered after discovery and during wait for trial).

Fas-Line Sales & Rentals, Inc. v. *E–Z Lay Pipe Corp. et al.*, 203 USPQ 497 (W.D. Okla. 1979).

Choat v. *Rome Industries, Inc., et al.*, 203 USPQ 549 (N.D. Ga. 1979) directed patentee to file reissue application.

In re Certain High-Voltage Circuit Interrupters and Components Thereof, BNA/PTCJ 456: A–4 (Int'l Trade Comm. 1979).

1442.05(b) Stays Denied [R–1]

"Stays" were denied in the following sampling of published "decisions".

General Tire and Rubber Co. v. *Watson-Bowman Associates, Inc.*, 193 USPQ 479 (D. Del. 1977).

Perkin-Elmer Corp. v. *Westinghouse Electric Corp.*, BNA/PTCJ 376: A–11 (E.D. N.Y. 1978).

In re Certain Ceramic Tile Setters, No. 337–TA–41, BNA/PTCJ 385: A–21 (Int'l Trade Comm. 1978).

E.C.H. Will v. *Freundlich-Gomez Machinery Corp.*, BNA/PTCJ 404: A–18 (S.D. N.Y. 1978).

RCA Corp. v. *Applied Digital Data Systems, Inc.*, 201 USPQ 451 (D.Del. 1979) denied stay where a patentee had not filed a reissue.

Bielomatik Leuze & Co. v. *Southwest Tablet Manufacturing. Co.*, 204 USPQ 226 (N.D. Texas 1979) refused to order reissue.

Antonious v. *Kamata-Ri & Co., Ltd.* 204 USPQ (D. Md. 1979) Refused to order reissue.

1443 Initial Examiner Review [R–2]

On initial receipt of a reissue application, the examiner should inspect the abstract of title to determine whether 37 CFR 1.172 has been complied with.

The examiner should determine if there is concurrent litigation and if so the status thereof (§ 1442.01, supra), and whether the reissue file has been appropriately marked.

The examiner should determine if a protest has been filed and if so it should be handled as set forth in § 1901.06.

The examiner should review the reissue application for the presence of information or allegations, such as in a protest, which might raise questions as to:

1. Prior art within the knowledge of, or which ostensibly should have been within the knowledge of, applicant or applicant's attorney or assignee during prosecution of the original application, but which was not brought to the attention of the Office;
2. "Fraud" or "inequitable" conduct on the part of applicant, applicant's attorney or agent, or other parties involved in the application;
3. "Violation of the duty of disclosure" under 37 CFR 1.56.

Where the review by the examiner reveals the presence of any such information or allegations, and the application has not earlier been referred to the Office of the Assistant Commissioner for Patents, the examiner should call this matter to the attention of the supervisory

primary examiner for such referral, via the group director (see § 2020.03).

The examiner should check that an offer to surrender the original patent, or an affidavit or declaration to the effect that the original is lost or inaccessible, has been received. An examination on the merits is made even though the above has not been complied with, but the examiner should require compliance in the first office action.

The examiner should verify that all Certificate of Correction changes have been properly incorporated into the reissue application.

1444 Review of Reissue Oath or Declaration [R–1]

When examining the reissue application the examiner will consider whether or not the reissue oath or declaration, complies with each of the requirements of 37 CFR 1.175. For example, in all reissue applications, the reissue oath or declaration must comply with the requirements of the first sentence of 37 CFR 1.65. Similarly, all reissue declarations must comply with *both* subsections (a)(5) and (a)(6) of § 1.175, see §§ 1414.03 & 1414.04. If the examination reveals a lack of compliance with any of the appropriate requirements of § 1.175, a rejection of the claims should be made on the basis that the reissue oath or declaration is insufficient.

Under no circumstances will any reissue application be passed to issue without full compliance with § 1.175. No reissue application can be passed for issue with only an (a)(4) type oath or declaration.

1444.01 Conversion from § 1.175 (a)(4) to (a)(1) Requires New Oath or Declaration [R–1]

As required by subsection 1.175(a)(4), applicant must request that if the examiner deems the original patent to be wholly or partly inoperative or invalid, that the applicant be permitted to amend the patent and be granted a reissue patent.

If applicant so amends the patent, applicant is required to file a new oath or declaration complying with § 1.175, subsections (a)(1) and (a)(2) and/or (a)(3), (a)(5), and (a)(6).

If at any time an applicant seeks to amend the specification, drawings and/or claims in a reissue application filed with a § 1.175(a)(4) type oath or declaration, applicant must file a new oath or declaration complying with § 1.175 subsections (a)(1), (a)(2) and/or (a)(3), (a)(5), and (a)(6). A new oath or declaration is required even though the amendment is in response to a rejection made in the reissue application. The filing of an amendment to the specification, drawing or claims of a 1.175(a)(4) type reissue application converts it to a reissue application of the 1.175 (a)(1),(a)(2) & (a)(3) type, and necessitates the filing of a new oath or declaration complying with subsections (a)(1), (a)(2) and/or (a)(3), (a)(5), and (a)(6) of § 1.175.

1445 Reissue Application Examined in Same Manner as Original Application [R–1]

As stated in 37 CFR 1.176, a reissue application, including all the claims therein, is subject to "be examined in the same as original applications". This means the claims, whether identical to or changed from those in the patent, are subject to any and all rejections which the examiner deems appropriate. The fact that a rejection was not made, or could have been made, or was made and dropped during prosecution of the patent does not prevent that rejection from being made in the reissue application. Likewise, the fact that during prosecution of the patent the examiner considered, may have considered, or should have considered, information such as, for example, a specific prior art document, does not have any bearing on or prevent its use as prior art during prosecution of the reissue application.

1446 Rejection Made Where No Changes in Patent and Claims Remain Patentable [R–2]

A reissue application containing only a § 1.175 (a)(4) type oath or declaration should not be passed to issue. Neither 35 U.S.C. 251 nor 37 CFR 1.175 allow or make provision for reissuance of a patent where there is in fact no actual error: In re Wittry, 180 USPQ 320, 322, 323 (CCPA 1974).

Where a reissue application is filed as a result of new prior art with no changes in the claims or specification and the examiner finds the claims patentable over the new art and no issues as to possible "fraud" or violation of duty of disclosure remain outstanding (see § 2022.03), the application will be rejected as lacking statutory basis for a reissue because 35 U.S.C. 251 does not authorize reissue of a patent unless it is deemed wholly or partly inoperative or invalid. However, the record of prosecution of the reis-

sue will indicate that the prior art has been considered by the examiner. In a reissue application filed with and containing only a §1.175(a)(4) type oath or declaration, and where all issues *except* those relating to possible "fraud" or violation of duty of disclosure have been resolved in favor of patentability, the examiner's action should so state in conformance with § 2022.03, and the application should be referred to the Office of the Assistant Commissioner for Patents for consideration of any such issues. If, and when all such issues of conduct are resolved in favor of applicant, the application will be returned to the examining group and the examiner will then reject the application as lacking statutory basis under 35 U.S.C. 251 (see § 2022.03).

1447 Additional Information, Affidavits, or Declarations Required [R–1]

37 CFR 1.175(b) provides that

"(b) Corroborating affidavits or declarations of others may be filed and the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue and its object."

Subsection (b) of § 1.175 recognizes the need, when appropriate, for additional information or affidavits or declarations, during examination of reissue applications. Section 1.175(b) provides that the examiner may require additional information or affidavits or declarations concerning the reissue application and its object.

1448 Deferral of Fraud or Duty of Disclosure Issues [R–2]

Where an examiner's review of a reissue application reveals information or allegations which might raise questions as to possible "fraud" or "violation of duty of disclosure," and the application has not earlier been referred to the Office of the Assistant Commissioner for Patents, the examiner should call this to the attention of the supervisory primary examiner for such referral via the group director (see § 2020.03)

The present office policy is to delay consideration of issues of fraud or failure to comply with the duty of disclosure in any application until all other issues are settled.

Accordingly, under this procedure, applications having issues of fraud or failure to comply with the duty of disclosure still will be referred immediately to the Office of the Assistant Commissioner for Patents. They will, however, be returned promptly, along with any appropriate examining instructions, to the director of the examining group for immediate action by the examiner. Decisions on petitions to strike applications pursuant to 37 CFR 1.56(d) will be deferred pending resolution of the patentability issues before the examiner. Any such petitions to strike filed after the Office of the Assistant Commissioner for Patents has initially reviewed the application and returned it for immediate action will be acknowledged by the examining group director and action on the petition will be deferred pending completion of the patentability issues before the examiner. Examiners will note in the Office actions the existence of issues of fraud or failure to comply with the duty of disclosure without commenting on the substance of such issues and will indicate that the issues will be considered after all other matters have been disposed of. Matters other than fraud or failure to comply with the duty of disclosure raised in a Petition to Strike, e.g., patentability in light of a reference, will be treated by the examiner or other appropriate official. Petitions relating to procedural matters involving the examination of the applications, e.g., requests for protestor participation in interviews, will be decided by the appropriate examining group director. Applications which have been referred to the Office of the Assistant Commissioner for Patents and which are required to be returned thereto before allowance or after abandonment of the application will have a notation placed on the face of the application file by the Office of the Assistant Commissioner requiring such return.

1449 Protest Filed in Reissue Where Patent is in Interference [R–1]

If a protest is filed in a reissue application related to a patent involved in a pending interference proceeding, the reissue application should be referred to the Office of the Assistant Commissioner for Patents, before considering the protest and acting on the application.

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1450 Restriction and Election of Species [R–1]

The examiner may not require restriction in a reissue application (§ 1.176 in § 1440). If the original patent contains claims to different inventions which the examiner may nevertheless consider independent and distinct, and the reissue application also claims the same inventions, the examiner should not require restriction between them or take any other action with respect to the question of plural inventions. Restriction is entirely at the option, in the first instance, of the applicant. If the reissue application contains claims to an independent and distinct invention which was not claimed in the original patent, these claims may be treated by a suitable rejection, such as: not being "for the invention disclosed in the original patent," as evidenced by the claims in the original patent, In re Rowand, 187 USPQ 487 (CCPA 1975), lack of inoperativeness of, or defect in, the original patent; lack of error; or not being for matter which might have been claimed in the original patent.

When the original patent contains claims to a plurality of species and the reissue application contains claims to the same species, election of species should not be required even though there is no allowable generic claim. If the reissue application presents claims to species not claimed in the original patent, election of species should not be required, but the added claims may be rejected on an appropriate ground which may be lack of defect in the original patent and lack of error in obtaining the original patent. Most situations require special treatment.

1451 Divisional Reissue Applications [R–1]

As is pointed out in the preceding section the examiner cannot require restriction in reissue applications, and if the original patent contains several independent and distinct inventions they can only be granted in separate reissues if the applicant demands it. The following rule sets forth the only possibility of divisional reissue applications.

37 CFR 1.177. Reissue in divisions. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of §§ 1.83 and 1.84. On filing divisional reissue applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner, all the divisions of a reissue will issue simultaneously; if there be any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner shall otherwise order.

Divisional reissue applications are required on filing to be referred to the Office of the Assistant Commissioner for Patents. Where such applications are forwarded to the examining group or examiner without having been so referred, they should be referred immediately to the Office of the Assistant Commissioner for Patents.

It is important that divisional reissue applications be appropriately marked so that they "will issue simultaneously" on the same date as required by § 1.177.

Divisional reissue cases which arrive together from the examining corps with appropriate identification on their file jackets (in the Continuing Data box) should be kept and processed together by the Patent Issue Division and throughout all stages of preparation for issue. Situations yielding divisional reissues occur infrequently and usually involve only two such files. It should be noted, however, that in rare instances in the past there have been more than two (and as many as five) divisional reissues of a patent.

Some special handling of divisional reissue applications is required in various parts of the Office.

Appropriate amendments to the continuing data entries are to be made to the file jackets and specification paragraphs for all such applications so that all "brother" divisional reissue applications are specifically identified.

1455 Allowance and Issue [R–1]

In all reissue applications prepared for issue, the number of the original patent being reissued should be placed in the box provided therefor below the box for the applicant's name.

The specifications of reissue patents will be printed in such a manner as to show the changes over the original patent by printing material omitted by reissue enclosed in heavy brackets [ ] and material added by reissue in italics. Section 1.173 (see § 1411) requires the specification of a reissue application to be presented in a specified form, specifically designed to facilitate this different manner of printing, as well as for other reasons.

The printed reissue specification will carry the following heading which will be added by the Patent Issue Division:

"Matter enclosed in heavy brackets [ ] appears in the original patent but forms no part

of this reissue specification; matter printed in italics indicates the additions made by reissue."

The examiners should see that the specification is in proper form for printing. Matter appearing in the original patent which is omitted by reissue should be enclosed in heavy brackets, while matter added by reissue should be underlined.

Any material added by amendment in the reissue application which is later canceled should be crossed through. However, cancelation of material in the original patent should be indicated by brackets.

All the claims of the patent should appear in the specification, with omitted claims enclosed in brackets. No renumbering of the original patent claims is necessary, even if the dependency of a dependent claim is changed by reissue so that it is dependent on a subsequent higher numbered claim. However, when a dependent claim in a reissue application depends upon a claim which has been canceled and no change in dependency to a remaining claim has been made, such a dependent claim must be rewritten in independent form. New claims should follow the number of the highest numbered patent claims and be underlined to indicate italics. The provisions of § 1.173 that claims should not be renumbered applies to the reissue application as filed. When the reissue is allowed, any claims remaining which are additional to the patent claims are renumbered in sequence starting with the number next higher than the number of claims in the original patent. Therefore, the number of claims allowed will not necessarily correspond to the number of the last claim in the reissue application, as allowed.

At least one claim of an allowable reissue application must be designated for printing in the Official Gazette. Whenever possible, that claim should be one which has been changed or added by the reissue. A canceled claim must not be designated as the claim for the Official Gazette.

In the case of reissue applications which have not been prepared in the indicated manner, the examiner may request from the applicant a clean copy of the reissue specification prepared in the indicated form. However, if the deletions from the original patent are small, the reissue application can be prepared for issue by putting the bracketed inserts at the appropriate places and suitably numbering the claims.

All parent application data on the original patent file wrapper should be placed on the reissue file wrapper, if it is still proper.

The list of references to be printed at the end of the reissue specification should include both the references cited during the original prosecution as well as the references cited during the prosecution of the reissue application. A patent cannot be reissued solely for the purpose of adding citations of additional prior art.

NOTE.—Transfer of drawing, § 1413.

There is no issue fee for reissue applications in which the patent being reissued was granted prior to October 25, 1965.

1460 Effect of Reissue [R–1]

35 U.S.C. 252. Effect of reissue. The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims or the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

1480 Certificates of Correction—Office Mistake [R–1]

35 U.S.C. 254. Certificate of correction of Patent and Trademark Office mistake. Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof

shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

37 CFR 1.322. Certificate of correction of Office mistake.

(a) A certificate of correction under 35 U.S.C. 254, may be issued at the request of the patentee or his assignee. Such certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notifying the patentee (including any assignee of record) and affording him an opportunity to be heard.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Commissioner may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

Mistakes incurred through the fault of the Office are the subject of Certificates of Correction under 37 CFR 1.322. If such mistakes are of such a nature that the meaning intended is obvious from the context, the Office may decline to issue a certificate and merely place the correspondence in the patented file, where it serves to call attention to the matter in case any question as to it arises.

Letters which merely call attention to errors in patents, with a request that the letter be made of record in the patented file, will not be acknowledged. Unless notification to the contrary is received within thirty days, it may be assumed that such letters have been made of record as requested.

In order to expedite all proper requests, a Certificate of Correction should be requested only for errors of consequence. Letters making errors of record should be utilized whenever possible.

Each issue of the Official Gazette (patents section) numerically lists all United States patents having Certificates of Correction. The list appears under the heading "Certificates of Correction for the week of (date)."

1481 Applicant's Mistake [R–1]

35 U.S.C. 255. Certificate of correction of applicant's mistake. Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.323. Certificate of correction of applicant's mistake. Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination.

37 CFR 1.323 relates to the issuance of Certificates of Correction for the correction of errors which were not the fault of the Office. A mistake is not of a minor character if the requested change would materially affect the scope or meaning of the patent.

The Issue Fee Transmittal Form portion (PTOL–85b) of the Notice of Allowance provides a space (item 2) for assignment data which should be completed in order to comply with 37 CFR 1.334. Unless an assignee's name and address are identified in item 2 of the Issue Fee Transmittal Form PTOL–85b, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

A request for correction of error arising from incomplete or erroneous information furnished in item 2 of PTOL–85b will not be granted as a matter of course and will be subject to adherence to all the requirements of 37 CFR 1.323.

35 U.S.C. 256. Misjoinder of inventor. Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The 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 Commissioner shall issue a certificate accordingly.

37 CFR 1.324. Correction of error in joining inventor. Whenever a patent is issued and it appears that there was a misjoinder or non-joinder of inventors and that such misjoinder or omission occurred by error and without deceptive intention, the Commissioner may, on application of all the parties and the assignees and satisfactory proof of the facts, or on order of a court before which such matter is called in question, issue a certificate deleting the misjoined inventor from the patent or adding the non-joined inventor to the patent.

The "satisfactory proof of facts" required by 37 CFR 1.324 must be of the same type and character as the proof required to justify converting an application, as described in § 201.03. An oath or declaration of the type required by 37 CFR 1.65 corresponding to the newly asserted inventorship must be submitted.

→ 1485 Handling of Requests for Certificates of Correction [R–1]

Requests for certificates of correction will be forwarded by the Correspondence and Mail Division, to the Decision and Certificate of Correction Branch of the Patent Issue Division, where they will be listed in a permanent record book.

Determination as to whether an error has been made, the responsibility for the error, if any, and whether the error is of such a nature as to justify the issuance of a certificate of correction will be made by the Decision and Certificate of Correction Branch. If a report is necessary in making such determination, the case will be forwarded to the appropriate group with a request that the report be furnished. If no certificate is to issue, the party making the request is so notified and the request, report, if any, and copy of the communication to the person making the request are placed in the file and entered thereon under "Contents" by the Decision and Certificate of Correction Branch. The case is then returned to the patented files. If a certificate is to issue, it will be prepared and forwarded to the person making the request by the Patent Issue Division. In that case, the request, the report, if any, and a copy of the letter transmitting the certificate of correction to the person making the request will be placed in the file and entered thereon under "Contents".

Applicants, or their attorneys or agents, are urged to submit the text of the correction on a special Certificate of Correction Form, PTO–1050, which can serve as the camera copy for use in direct offset printing of the certificate of correction. Both parts of form PTO–1050 must accompany the request since the second part will be placed in the application file for internal use.

A perforated space at the bottom of form PTO–1050 has been provided for the patentee's current mailing address, and for ordering any desired additional copies of the printed certificate. The fee for each additional copy ordered is 30 cents per page. The fee should accompany the request.

To facilitate the use of the Form PTO–1050, the public may obtain as many copies as needed from the Correspondence and Mail Division or from the receptionist in the lobby of building 3 at Crystal Plaza.

Where only a part of a request can be approved, or where the Office discovers and includes additional corrections, the appropriate alterations are made on the form PTO–1050 by the Office. The patentee is notified of the changes on the Notification of Approval-in-part form PTOL–404. The certificate is issued approximately 6 weeks thereafter.

Form PTO–1050 should be used exclusively regardless of the length or complexity of the subject matter. Intricate chemical formulas or page of specification or drawings may be reproduced and mounted on a blank copy of PTO–1050. Failure to use the form has frequently delayed issuance since the text must be retyped by the Office onto a PTO–1050.

The exact page and line number where the errors occur in the application file should be identified on the request. However, on form PTO–1050, only the column and line number in the printed patent should be used.

The patent grant should be retained by the patentee. The Office does not attach the certificate of correction to patentee's copy of the patent. The patent grant will be returned to the patentee if submitted.

Below is a sample form illustrating a variety of corrections and the suggested manner of setting out the format. Particular attention is directed to:

a. Identification of the exact point of error by reference to column and line number of the printed patent or to claim number and line where a claim is involved.

b. Conservation of space on the form by typing single space, beginning two lines down from the printed message.

c. Starting the correction to each separate column as a sentence, and using semicolons to separate corrections within said column, where possible.

d. Two inch space left blank at bottom of the last sheet for signature of attesting officer.

e. Use of quotation marks to enclose the exact subject matter to be deleted or cor-

rected; use of double hyphens(- -) to enclose subject matter to be added, except for formulas.

f. Where a formula is involved, setting out only that portion thereof which is to be corrected or, if necessary pasting a photocopy onto form PTO–1050.

The examiner's comments are requested on form PTO–306 revised, where, under 37 CFR 1.323, there is a question involving change in subject matter.

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

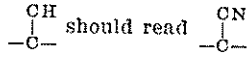
Patent No. _____ Dated April 1, 1969

James W. Worth

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In the drawings, Sheet 3, Fig. 3, the reference numeral 225 should be applied to the plate element attached to the support member 207. Column 7, lines 45 to 49, the left-hand formula should appear as follows:

Column 10, formula XXXV, that portion of the formula reading



Formula XXXVII, that portion of the formula reading "–CH_2CH–" should read -- –CHCH– --. Column 2, line 68 and column 3, lines 3, 8 and 13, for the claim reference numeral "2", each occurrence, should read --1--. Column 10, line 16, cancel beginning with "12. A sensor device" to and including "tive strips." in column 11, line 8, and insert the following claim:

12. A control circuit of the character set forth in claim 1 and for an automobile having a convertible top, and including; means for moving said top between raised and lowered retracted position; and control means responsive to said sensor relay for energizing the top moving means for moving said top from retracted position to raised position.

→ 1490 Disclaimers [R–1]

35 U.S.C. 253. Disclaimer. Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

37 CFR 1.321. Statutory disclaimer. (a) A disclaimer under 35 U.S.C. 253 must identify the patent and the claim or claims which are disclaimed, and be signed by the person making the disclaimer, who shall state therein the extent of his interest in the patent. A disclaimer which is not a disclaimer of a complete claim or claims may be refused recordation. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

(b) A terminal disclaimer, when filed in an application to obviate a double patenting rejection, must include a provision that any patent granted on that application shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection. See § 1.21 for fee.

A disclaimer is a statement filed by an owner (in part or in entirety) of a patent or of a patent to be granted, in which said owner relinquishes certain legal rights to the patent. There are two types of disclaimers; statutory and terminal.

Statutory Disclaimers

Under 37 CFR 1.321(a) the owner of a patent may disclaim a complete claim or claims of his patent. This may result from a lawsuit or because he has reason to believe that the claim or claims are too broad or otherwise invalid.

Terminal Disclaimers

37 CFR 1.321(a) also provides for the filing by an applicant or patentee of a terminal disclaimer which disclaims or dedicates to the public the entire term or any portion of the term of a patent or patent to be granted.

37 CFR 1.321(b) specifically provides for the filing of a terminal disclaimer in an application for the purpose of overcoming a rejection for double patenting.

Processing

The Decision and Certificate of Correction Branch of the Patent Issue Division is responsible for the handling of all disclaimers filed under 35 U.S.C. 253, whether the case is pending or patented. This involves:

1. Determining compliance with 35 U.S.C. 253 and 37 CFR 1.321;

2. Notifying applicant or patentee when the disclaimer is informal and thus not acceptable;
3. Recording the disclaimers; and
4. Providing the disclaimer data for printing.

Terminal disclaimers may affect the prosecution of other applications. They are brought to the examiner's attention by the Patent Issue Division which attaches a label to the file wrapper after having a title search made, endorsing the paper on the "Contents" and otherwise insuring that the patent, if issued, will be properly headed.

Terminal Disclaimer in Pending Application Practice

Since the claims of pending applications are subject to cancellation, amendment or renumbering, a terminal disclaimer directed to a particular claim or claims will not be accepted; the disclaimer must be of a terminal portion of the term of the entire patent to be granted. The statute does not provide for conditional disclaimers and accordingly, a proposed disclaimer which is made contingent on the allowance of certain claims cannot be accepted. The disclaimer should identify the disclaimant and his interest in the application and should specify the date when the disclaimer is to become effective.

Forms

Statutory Disclaimer

Form 3.43—Disclaimer in Patent

To the Commissioner of Patents and Trademarks:

Your petitioner, _____, residing at _____, in the county of _____ and State of _____, represents that he is (here state the exact interest of the disclaimant; if assignee, set out liber and page, or reel and frame, where assignment is recorded) of letters patent of the United States No. _____, granted to _____ on the _____ day of _____, 19__, for _____ and that he has reason to believe that without any deceptive intention claims of said letters patent are too broad or invalid. Your petitioner, therefore, hereby disclaims claim _____ of said patent.

Signed at _____, State of _____ this _____ day of _____, 19__.

_____
(Signature)

Terminal Disclaimer

To the Commissioner of Patents and Trademarks:

Your petitioner, John Doe, residing at _____ in the county of _____ and State of _____ represents that he is (here state exact interest of disclaimant and, if he is an assignee, set out the liber and page or reel and frame where the assignment is recorded) of Application No. _____, filed on the _____ day of _____ 19__ for _____. Your petitioner hereby disclaims all that portion of the term of any patent to be issued on the said application subsequent to _____ 19____.

The disclaimer must be accompanied by the statutory fee.

Form 3.53—Terminal Disclaimer To Obviate a Double Patenting Rejection

To the Commissioner of Patents and Trademarks:

Your petitioner, _____, residing at _____ in the county of _____ and State of _____ represents that he is (here state exact interest of the disclaimant and, if he is an assignee, set out the liber and page or reel and frame where the assignment is recorded) of application Serial No. _____, filed on the _____ day of _____, 19__ for _____. Your petitioner, _____, hereby disclaims the terminal part of any patent granted on the above-identified application, which would extend beyond the expiration date of Patent No. _____ and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to United States Patent No. _____, this agreement to run with any patent granted on the above identified application and to be binding upon the grantee, its successors or assigns.