

Advanced Patent Law Institute at the U.S. Patent and Trademark Office January 25, 2013

Reissue: Practice Highlights and Recent Developments



Kenneth M. Schor
Pinchus M. Laufer
Senior Legal Advisors
Office of the Deputy Commissioner for
Patent Examination Policy



Reissue Introduction (1 of 2)

Reissue of a patent -

- Permits errors made in the patent to be corrected.
- Reissue statute is not cure for all patent prosecution problems, nor a grant of second chance to prosecute *de novo* original application. Must be to correct "inadvertence, accident, or mistake." *In re Weiler*, 790 F.2d 1576, 229 USPQ 673 (Fed. Cir. 1986).



Reissue Introduction (2 of 2)

There can be no reissue application, unless there is “error” in the patent within the meaning of 35 U.S.C. § 251.

- No reissue solely to review a patent based on new prior art.
 - A patent owner request for *ex parte* reexamination under 37 CFR 1.510 is the traditional proper vehicle for review of prior art patents and printed publications, where there is no § 251 error.
 - As of September 16, 2012, a patent owner request for supplemental examination under 37 CFR 1.601 is also an option.

12/11/2012

3



Some Important Errors Correctable Via Reissue (1 of 3)

- Permits claims to be broadened, if broadening reissue filed within two years of issuance of original patent.
- Reissue is the only post patent proceeding in which patent claims may be broadened.
- Permits narrowing of claims to address newly found prior art.
- Permits revising claims to address failure to comply with 35 U.S.C. § 112.

12/11/2012

4



Some Important Errors Correctable Via Reissue - *Tanaka* (2 of 3)

- Permits addition of claims that are narrower in scope than the existing patent claims, without any narrowing of the existing patent claims.
 - The error can be not previously having the narrower claims, that are now added by reissue.
 - Can keep broad independent claim, while adding only new dependent claims
 - See *In re Tanaka*, 640 F. 3d 1246, 1251, 98 USPQ2d 1331, 1334 (Fed. Cir. 2011) (“the omission of a narrower claim from a patent can render a patent partly inoperative by failing to protect the disclosed invention to the full extent allowed by law.”)

12/11/2012

5



Some Important Errors Correctable Via Reissue (3 of 3)

- Permits claiming and perfecting of foreign and domestic priority benefit (35 U.S.C. §§ 119 and 120).
 - Priority information must be in ADS, not in oath/declaration or specification, for any reissue filed on or after September 16, 2012 (§ 1.76(a)).
- Permits changing inventorship of patent.
 - Useful when cannot get statement of inventor to satisfy 37 CFR 1.324.

12/11/2012

6



New Rule Making Revises Reissue Rules

- Notice of Final Rulemaking published August 14, 2012:
 - *Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR 48775 (Aug. 14, 2012) (final rule).
- The final rule revises reissue rules 1.172 and 1.175 effective for any reissue filed on or after September 16, 2012.
 - Rules 1.172 and 1.175, throughout the slides, will mean - §§ 1.172 and 1.175, as revised by the NFR.

12/11/2012

7



Requirements for Filing a Reissue

- Reissue fees for filing, search, and examination.
- Reissue “specification” – the printed patent.
- Reissue oath or declaration – routinely supplemented by ADS.
 - There are new user reissue post-AIA declaration forms.
- If patent is assigned - Statement establishing ownership pursuant to 37 CFR 3.73(c) (§ 3.73(b) for reissues filed before 9/16/12) and consent of owner (assignee) to the filing.
- Statement of error being corrected.
- Form PTO/AIA/50 is reissue transmittal form for reissue filed on or after 9/16/12; it contains checklist of items to be submitted.

12/11/2012

8

PTO/AIA/03 (01-12)
Approved for use through 08/31/2013, OMB 0951-0013
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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



REISSUE PATENT APPLICATION TRANSMITTAL

Address to: Mail Stop Reissue Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450		Attorney Docket No. First Named Inventor Original Patent Number Original Patent Issue Date (Month/Day/Year) Express Mail Label No.
APPLICATION FOR REISSUE OF: <input type="checkbox"/> Utility Patent <input type="checkbox"/> Design Patent <input type="checkbox"/> Plant Patent		
APPLICATION ELEMENTS (37 CFR 1.173)		ACCOMPANYING APPLICATION PARTS
1. <input type="checkbox"/> Fee Transmittal Form (PTO/SB/95) 2. <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. 3. <input type="checkbox"/> Specification and Claims in double column copy of patent format (amended, if appropriate) 4. <input type="checkbox"/> Drawing(s) (proposed amendments, if appropriate) 5. <input type="checkbox"/> Reissue Oath/Declaration or Substitute Statement (37 C.F.R. 1.175) (PTO/AIA/06, 07 or 98) 6. <input type="checkbox"/> Application Data Sheet. NOTE: Benefits claims under 37 CFR 1.78 and foreign priority claims under 37 CFR 1.55 MUST be set forth in an Application Data Sheet (ADS). 7. <input type="checkbox"/> Original U.S. Patent currently assigned? <input type="checkbox"/> Yes <input type="checkbox"/> No (If Yes, check applicable box(es)) <input type="checkbox"/> Written Consent of all Assignees (PTO/SB/53) <input type="checkbox"/> 37 CFR 3.73(c) Statement (PTO/SB/95) 8. <input type="checkbox"/> CD-ROM or CD-R in duplicate, Computer Program (Appendix) or type table <input type="checkbox"/> Landscape Table on CD 9. Nucleotide and/or Amino Acid Sequence Submission (if applicable, items a-c are required) a. <input type="checkbox"/> Computer Readable Form (CRF) b. <input type="checkbox"/> Specification Sequence Listing on: i. <input type="checkbox"/> CD-ROM (2 copies) or CD-R (2 copies); or ii. <input type="checkbox"/> paper c. <input type="checkbox"/> Statements verifying identity of above copies	10. <input type="checkbox"/> Statement of status and support for all changes to the claims. See 37 CFR 1.173(c). 11. <input type="checkbox"/> Power of Attorney 12. <input type="checkbox"/> Information Disclosure Statement (IDS) PTO/SB/03 or PTO-1449 <input type="checkbox"/> Copies of citations attached 13. <input type="checkbox"/> English Translation of Reissue Oath/Declaration (if applicable) 14. <input type="checkbox"/> Preliminary Amendment 15. <input type="checkbox"/> Return Receipt Postcard (MPEP § 503) (Should be specifically itemized) 16. <input type="checkbox"/> Other: _____ <input type="checkbox"/> This is a continuation reissue or divisional reissue application (i.e., a second or subsequent reissue application for the same issued patent). (Check box if applicable)	
17. CORRESPONDENCE ADDRESS		
<input type="checkbox"/> The address associated with Customer Number _____ OR <input type="checkbox"/> Correspondence address below		
Name _____		
Address _____		
City _____	State _____	Zip Code _____
Country _____	Telephone _____	Email _____
Signature _____	_____	Date _____
Name (Print/Type) _____	_____	Registration No. (Attorney/Agent) _____
<small>This collection of information is required by 37 CFR 1.173. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450; DO NOT SEND UNCOMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Reissue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.</small>		

12/11/2012 9



Reissue Oath or Declaration: Who May Sign (1 of 2)

- Reissue oath or declaration may be signed by the:
 - Sole or joint inventors.
 - Assignee applicant, where:
 - The reissue is not a broadening reissue (§ 1.175(c)(1));

OR

- The application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest (§ 1.175(c)(2)).

12/11/2012 10



Reissue Oath or Declaration: Who May Sign (2 of 2)

- Non-inventor applicant may file a 37 CFR 1.64 substitute statement in lieu of reissue oath or declaration for an inventor X, if inventor X:
 - is deceased;
 - is legally incapacitated;
 - cannot be found or reached after diligent effort; or
 - refuses to execute an oath or declaration.
- No need to provide old Rule 1.47 type (or any) evidence.

12/11/2012

11



Reissue Oath or Declaration: Basics (1 of 2) :

- Reissue oath or declaration must:
 - Comply with § 1.63, § 1.64, or § 1.67 requirements of non-reissue application,
 - Specifically identify at least one 35 U.S.C. 251 error relied upon as the basis for reissue, and
 - State that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of (a) defective specification or drawing, or (b) patentee claiming more or less than he had the right to claim in the patent, or (c) other errors.

See § 1.175(a)

12/11/2012

12



Reissue Oath or Declaration: Basics (2 of 2)

- A statement that all errors arose without any deceptive intent is no longer required;
- A supplemental reissue oath or declaration stating that all errors arose without any deceptive intent is no longer required where an amendment is made.
- A new oath or declaration would still be required where there is a failure to:
 - identify any error, or
 - Identify at least one error of the type that would support a reissue.

12/11/2012

13



Reissue Oath or Declaration: Time of Submission

- Submission of a reissue oath or declaration is due on filing of the application.
- If reissue application does not include the oath or declaration (§ 1.175), applicant will be given a period of time to submit and pay the surcharge required by § 1.16(f) to avoid abandonment.
- Must be complete prior to examination. This differs from non-reissue inventor's oaths and declaration which may be postponed until application is otherwise in condition for allowance - § 1.53(f)(3)(i).

12/11/2012

14



Claim Broadening - Basics

- Test for broadening of patent claims:
 - An amended/new claim in the reissue broadens the scope of the claims of the original patent if it is broader in at least one respect, even though it may be narrower in many other respects.
 - “Codified” by NFR in § 1.175(b).
 - The inventor’s oath or declaration must identify a claim (cannot identify all claims) that the application seeks to broaden.
 - Also in § 1.175(b).

12/11/2012

15



Claim Broadening – Until When? (1 of 2)

- No broadening of patent claims outside of two years from Patent Grant - 35 U.S.C. § 251
 - A reissue application filed within two years for reasons other than broadening may not be later broadened during prosecution outside of two years.
 - Intent to broaden (notice of broadening) must be established in the reissue application within two years –
 - See *In re Graff*, 111 F.3d 874, 877, 42 USPQ 1471, 1473-74 (Fed. Cir. 1997).

12/11/2012

16



Claim Broadening – Until When? (2 of 2) *Staats*

- *In re Staats*, 671 F.3d 1350, 101 USPQ2d 1930 (Fed. Cir. 2012) dealt with the grandchild of a reissue application filed within 2 years of the patent grant.
- The broadened claims in grandchild were to an embodiment “alternative” to, and “unrelated” to, the grandparent’s broadened claims that were filed within the 2-year limit....Was notice of broadening sufficient?
- Held: There is no basis for requiring the later (grandchild) broadened claims to be “related to, or ... directed to the same embodiment as in the original application.” *Staats*, 671 F.3d at 1355.

12/11/2012

17



No Broadening to Recapture Surrendered Claim Subject Matter (1 of 4)

- Even within 2 years of patent grant, patentee cannot recover via broadening in reissue:
 - Claimed Subject matter surrendered during the prosecution of the original application (which became the patent to be reissued) in effort to obtain allowance of patent claims over the art.
 - The “original application” includes the patent family’s entire prosecution history. *MBO v. Becton*, 602 F.3d 1306, 94 USPQ2d (Fed. Cir. 2010).
 - Limitations added to the claims for the purpose of overcoming an art rejection, or existing claim limitations relied upon (argued) to overcome an art rejection, cannot be deleted in their entirety; the claims must remain materially narrowed (see slides which follow and explain).

12/11/2012

18



No Broadening to Recapture Surrendered Claim Subject Matter (2 of 4)

If part of the added or relied-on limitation is deleted, and part is retained:

- If the retained portion of the subject matter that was added and/or argued to overcome the rejection is “well known in the prior art,” the recapture rule bars reissue.
In re Mostafazadeh et al, 643 F.3d 1353, 1361 (Fed. Cir. 2011)
- “[I]f the patentee modifies the added limitation such that it is broader than the patented claim yet still materially narrows relative to the original claim, the recapture rule does not bar reissue.”
In re Youman et al, 679 F.3d 1335, 1347 (Fed. Cir. 2012).

12/11/2012

19



No Broadening to Recapture Surrendered Claim Subject Matter (3 of 4)

- Even if the relied-upon limitation is eliminated from the reissue claims, “the [Examiner] must still determine whether the reissued claims were materially narrowed in other respects so that the claims have not been enlarged, and hence avoid the recapture rule.” *Youman et al*, 679 F.3d at 1347.
 - Materially narrowing in other respects - Still needs to be defined, but one limitation on the definition is that the narrowing must relate to what was argued by applicant in the original application, to define the claim over the art - per *Greenliant Systems* case to be discussed in next slide.

12/11/2012

20



No Broadening to Recapture Surrendered Claim Subject Matter (4 of 4)

- Patent owner is bound by the argument that applicant relied upon to overcome an art rejection in the original application for the patent to be reissued.
 - It does not matter whether the Office adopted the argument relied upon for allowance; “the sole question is whether the argument was made.”
 - Nor does it matter whether the limitation of the claim relied upon to overcome an art rejection “actually imparted the cited structural differences,” because applicant “argued that it did” in the original application.

Greenliant Systems, Inc. et al v. Xicor LLC, 692 F.3d 1261, 1271 (Fed. Cir. 2012)

12/11/2012

21



Thank You



U.S. Patent & Trademark Office

Office of the Deputy Commissioner for
Patent Examination Policy

Office of Patent Legal Administration

12/11/2012

22