

Tips on Filing Reissue Applications

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Reissue

Reissue of an original patent –

- Permits errors made in the original patent to be corrected
- Permits claims to be broadened, if broadening reissue filed within two years of issuance of original patent
- Reissue may be used to correct inventorship
- Not all errors are correctable through reissue

See 35 U.S.C. §§ 251 & 252; MPEP §1401-1470

Requirements for Filing Reissue

- Fees
- Reissue “specification” – the printed patent
- Reissue oath or declaration
- Consent of assignee to filing & statement of ownership
 - Only needed if patent is assigned
- Use Form PTO/AIA/50:
<http://www.uspto.gov/sites/default/files/forms/aia0050.pdf>

Requirements for Filing Reissue

- Reissue Application Filing Guide:
https://www.uspto.gov/sites/default/files/forms/uspto_reissue_ads_guide_Sept2014.pdf
- Provides guidance on
 - Submissions required
 - Proper content of submissions
 - Manner of making amendments
 - Additional Information on filing continuation reissue and divisional reissue applications

Reissue Oath or Declaration

- Must point out error(s) being corrected
 - Only one error need be given
 - The error must be **specifically** identified
 - An **explanation** of how the error renders the patent wholly or partly inoperative or invalid
- Reissue applications filed on or after September 16, 2012, are not required to state that all errors being corrected arose without deceptive intent

Reissue Oath or Declaration

- EXAMPLE OF INSUFFICIENT EXPLANATION:
 - The patent claims more than applicant had a right to claim in view of U.S. Patent No. 2,222,222.
- EXAMPLE OF SUFFICIENT EXPLANATION:
 - The patent claims more than applicant had a right to claim in view of U.S. Patent No. 2,222,222 which describes a plant having integrated into its genome a DNA construct containing a delta-five desaturase, wherein the plant reportedly produces dodecaenoic acid. See U.S. Patent 2,222,222, Example 12. Claim 1 of the patent is amended in this reissue application to exclude that subject matter of the '222 patent.

Reissue Oath or Declaration (*cont.*)

- A supplemental reissue oath or declaration covering additional defects or errors corrected in the reissue after the filing of the reissue oath or declaration is required in reissue applications filed before September 16, 2012, unless the additional errors are typographical, editorial, clerical, or grammatical
- A supplemental reissue oath or declaration covering additional defects or errors corrected in the reissue after the filing of the reissue oath or declaration is **not** required in reissue applications filed on or after September 16, 2012
 - If all errors identified in the original reissue oath or declaration are no longer being corrected, an error being relied upon as the current basis for reissue must be explicitly identified on the record (e.g., in the remarks accompanying an amendment). See 37 CFR 1.175(d) and (f)(2). Identification of the error must be conspicuous and clear and must comply with 35 U.S.C. 251
 - However, if error as originally provide was not an error upon reissue can be based, then a new reissue declaration will be required

Reissue Oath or Declaration (*cont.*)

- Reissue oath/declaration must include the requirements of 37 CFR 1.63
 - PTO/AIA/05: Oath or declaration signed by the inventors.
 - PTO/AIA/06: Oath or declaration signed by the assignee of the entire interest only if:
 - The reissue application does not seek to enlarge the scope of the claims of the original patent; or
 - The application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest. See 37 CFR 1.175(c)
 - This option is available if the application for the original patent was filed on or after September 16, 2012
 - NOTE: Do not check box on page 2 if patent was filed before September 16, 2012.
- The application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest.
- PTO/AIA/07: Substitute Statement In Lieu of Oath or Declaration
 - Do not use PTO/AIA/02 – it does not have the required reissue language

Consent of Assignee to the Reissue

- If the patent is assigned, the assignee(s) must consent to filing the reissue even where the oath/declaration is signed by the inventor(s)
- If the patent is not assigned, no formal consent is needed but there should be an affirmative statement of non-assignment
 - Affirmative statement can be made on PTO/AIA/50 (Item 8) or on PTO/AIA/53
 - In the absence of an affirmative statement or clear indication of non-assignment in the record, assignment will be presumed and consent will be required
- Lack of proper consent will delay examination

Consent of Assignee to the Reissue

- PTO/AIA/53: CONSENT OF ASSIGNEE; STATEMENT OF NON/ASSIGNMENT
 - Consent must be signed by a party authorized to act on behalf of assignee
 - Requires identification of title of person signing for assignee(s) – See MPEP 325(V) for acceptable titles conveying apparent authority
 - Consent must be supported by a 37 CFR 3.73(c) statement establishing ownership of assignee(s)

Establishing Assignee Ownership of Patent

- Statement under 37 CFR 3.73(c) must:
 - Identify each assignee
 - Identify the reel or frame number where assignment is recorded, or attach a copy of the assignment document(s)
 - Be signed by a party having apparent authority to act on behalf of the assignee, **or** include a statement that the party signing the submission is authorized to act on behalf of the assignee
- For applications filed on or after September 16, 2012, a patent practitioner of record may sign the statement (see 37 CFR 3.73(d)(3))
- Individual signing 3.73(c) asserts authority to act on behalf of assignee and therefore may also sign Consent

Filing Continuation Reissue Applications and/or Divisional Reissue Applications

- Application Data Sheet must indicate that reissue application is **both**
 - a reissue application of the parent reissue application **and**
 - A continuation/divisional application of the parent reissue application
- Statement in first paragraph of the specification must identify application as either a continuation reissue or a divisional reissue. See MPEP 1451 for acceptable identification language
- Corrections to the Application Data Sheet must follow instructions associated with PTO/AIA/14 - the information being added or deleted must be indicated by underlining for additions, and strike through or brackets for deletions

Reissue Specification and Drawings

- File a clean copy of the printed patent to provide
 - Reissue specification (including claims) must be in double-column format
 - Reissue drawings
 - Transfer of drawings from patent file to reissue application is not permitted
 - Use clean copy from printed patent
 - New drawings sheets are required for any new or amended figures

See 37 CFR 1.84 and 1.173

Amendments

- Always made **relative to the original patent** in accordance with 37 CFR 1.173(c) but do not have to be submitted in double column format
- Claims
 - Use brackets for deletions and underlining for additions
 - Do **not** use strike-through and italics
 - Amendment paper must also supply status of all claims, and explanation of support in the patent for changes made to the claims
- Specification
 - All amendments which include any deletions or additions must be made by submission of the entire text of each added or rewritten paragraph with markings (as defined above)
 - Exception for entire paragraphs of specification text which may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph

Amendments Relative to Original Patent

- 1. (Original) A composition comprising acetylsalicylic acid, 95% ethanol and distilled water.
- 1. (Amended) A composition [comprising] consisting essentially of acetylsalicylic acid, 95% ethanol and distilled water.
- 1. (Twice Amended) A composition [comprising] consisting essentially of acetylsalicylic acid, 95% ethanol and [distilled] water.
- 5. (New) A composition of claim 1 which also includes a pharmaceutical carrier .
- 5. (New-amended) A composition of claim 1 which, besides including a pharmaceutical carrier, also includes an additional headache medicament besides acetylsalicylic acid.

Sequence Compliance

- Sequence Listing does not convey in a reissue from the original patent
- A reissue application that contains sequences must comply with the sequence rules like any other application. See 37 CFR 1.821-1.825
- This may be accomplished by filing a new sequence listing
- Compliance may also be accomplished by the less-preferred process of requesting transfer of the sequence listing from the patented file with a paper copy plus statement accompanying the transfer request

Sources of Information on Reissue

- Statutes: 35 U.S.C. §§ 251, 252
- Rules: 37 CFR 1.171 – 1.178
- MPEP Chapter 1400

Questions?

Thank you!

