



UNITED STATES PATENT AND TRADEMARK OFFICE

BROADENING REISSUES

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35 U.S.C. 251 ¶4 : Broadening Reissue

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

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, for reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

No new matter shall be introduced into the application for reissue.

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

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

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

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)



MPEP 1412.03: “Broadened Reissue Claim”

- Definition: A claim which enlarges the scope of the claims of the patent, *i.e.*, a claim which is greater in scope than each and every claim of the original patent
- A reissue claim enlarges the scope of the patented claims if it is broader in *at least one* respect, even though it may be narrower in other respects
- Tip: Compare reissue claims to broadest patented claims.



Infringement Test

- Infringement Test: A claim is broadened if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement
- Example: where the original patent claims only a process of making, and the reissue application newly adds a product claim, the scope has been broadened because a party could not necessarily be sued for infringement of the product based on the claims of the original patent if it were made by a different process.



MPEP 1412.03 II: Broadening Scope of Patented “Dependent Claims”

- **General Rule: broadening the scope of patented dependent claims is NOT BROADENING**
- Example: where dependent patented claim 2 is broadened via the reissue, but independent claim 1 on which it is based is not broadened.
 - Rationale: A dependent claim is construed to contain all the limitations of the claim upon which it depends, thus claim 2 must be at least as narrow as claim 1



MPEP 1412.03 III. NEW CATEGORY OF INVENTION ADDED IN REISSUE - GENERALLY IS BROADENING

- Adding process claims as a new category of invention to be claimed in the patent (*i.e.*, where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989).
- Exception: reissue claims use product A claimed in the original patent claims.
- Example:
 - (1) a process of using the product A (made by the process of the original patent) to make a product B, disclosed but not claimed in the original patent;
or
 - (2) a process of using the product A to carry out a process B disclosed but not claimed in the original patent.
 - Although this amendment of the claims adds a method of making product B or adds a method of using product A, this is not broadening because the "newly claimed invention" contains all the limitations of the original patent claim(s).



Bars To Obtaining Broadening Reissues

1. Bars To Obtaining Broadening Reissues:
 - a. Two Year bar (35 USC 251; MPEP 1412.03);
 - b. New Matter and Restriction/Election bar (35 USC 251; MPEP 1412.01)
 - c. Recapture bar (MPEP 1412.02)



MPEP 1412.03 IV. WHEN A BROADENED CLAIM CAN BE PRESENTED

- A broadened claim can be presented within two years from the grant of the original patent in a reissue application. See 35 U.S.C. 251 ¶4;
- A reissue application filed on the 2-year anniversary date from the patent grant is considered to be filed within 2 years of the patent grant. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) for a similar rule in interferences.



BROADENED CLAIM: “unequivocal intent” to broaden

- A broadened claim can be presented *after* two years from the grant of the original patent in a broadening reissue application which was filed *within* two years from the grant where any intent to broaden is “*unequivocally*” indicated in the reissue application within the two years from the patent grant. See MPEP 1412.03 IV.
 - A statement that “the patent is wholly or partly inoperative by reason of claiming more or less than applicant had a right to claim“ (without more) is NOT an unequivocal statement of an intent to broaden.



BROADENED CLAIM: SUBMITTED AFTER TWO YEARS

- Thus, a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after the two years is different than the broadened claim presented within the two years.
- Finally, if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing (continuation or divisional) reissue application after the two year period.
- In any other situation, a broadened claim cannot be presented.



MPEP 1414: Content of Reissue Oath/Declaration (“Intent To Broaden”)

- Reissue oaths or declarations must contain the following:
 - (A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid —
 - (1) by reason of a defective specification or drawing, or
 - (2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;
 - (B) A statement of at least one error which is relied upon to support the reissue application, i.e., the basis for the reissue.

- See also 37 CFR 1.175 (a)(1).



Broadening Reissue Oath

- Relevant “Inventor Oath Portion” (See: Reissue Inventor Oath Form: PTO/SB/51 at www.uspto.gov/forms/index.jsp).

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

by reason of a defective specification or drawing.

by reason of the patentee claiming more or less than he had the right to claim in the patent.

by reason of other errors.

At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, such must be stated with an explanation as to the nature of the broadening:



MPEP 1414 II: THE “SPECIFIC” BASIS FOR THE REISSUE

- The “at least one error” which is relied upon to support the reissue application must be set forth in the oath or declaration
- The oath/declaration must specifically identify an error
- Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error



MPEP 1414 II: NON-SPECIFIC BASIS

- Insufficient assertions of errors

Ex. 1: merely reproduce the claims with brackets and underlining and state that such will identify the error

Ex. 2: a statement of "... failure to include a claim directed to ..." and then presenting a newly added claim



MPEP 1412.03: Broadening Case Law

***In re Doll*, 419 F.2d 925, 928, 164 USPQ 218, 220 (CCPA 1970)**

(If the reissue application is timely filed within two years of the original patent grant and the applicant indicates in the oath or declaration that the claims will be broadened, then applicant may subsequently broaden the claims in the pending reissue prosecution even if the additional broadening occurs beyond the two year limit.)

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

***In re Fotland*, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985), *cert. denied*, 476 U.S. 1183 (1986)** (The failure by an applicant to include *an oath or declaration indicating a desire to seek broadened claims* within two years of the patent grant will bar a subsequent attempt to broaden the claims after the two year limit. There was no broadening amendment or statement of record in *Fotland* that would have shown an intent to broaden, even without a statement of broadening in the reissue oath or declaration.).



MPEP 1414 II: Continuation Reissue

- 37 CFR 1.175(e) "the filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration, which pursuant to [37 CFR 1.175(a)(1)], identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application."
 - Not a reissuable “error”, where a continuation reissue application is filed with a copy of the reissue oath from the parent reissue application, and the parent reissue application is not to be abandoned



MPEP1451:Divisional Reissue Applications; Continuation Reissue Applications Where the Parent is Pending

- Nonetheless, the mere fact that the application purports to be a continuation or divisional of a parent reissue application does not make it a reissue application itself, since it is possible to file a 35 U.S.C. 111(a) continuing application of a reissue application. *In re Bauman*, 683 F.2d 405, 214 USPQ 585 (CCPA 1982).
 - There must be an identification, on filing, that the application is a continuation reissue application, as opposed to a continuation of a reissue application (i.e., a *Bauman* type continuation application).



Broadening Case Law: Continuing Reissue

- *In re Graff*, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997) (Broadened claims in a continuing reissue application were properly rejected under **35 U.S.C. 251** because the proposal for broadened claims was not made (in the parent reissue application) within two years from the grant of the original patent and the **public was not notified** that broadened claims were being sought until after the two-year period elapsed.) (with emphasis).
- 35 U.S.C. § 251, ¶4 does not permit a continuing reissue application to broaden the patented claims beyond the two-year statutory period *in a manner unrelated* to the broadening aspect that was identified within the two-year period. ***Ex parte* ERIK STAATS and ROBIN D. LASH**, (B.P.A.I. Appeal 2009-0071621 Application 11/503,541): Decided: April 26, 2010: appealed on June 24, 2010 to CAFC.
- Rationale: since broadening was “completely unforeseeable” by the public within the two-year statutory period-it runs counter to the *Graff* public notice function underpinning § 251



MPEP 1412.01: Reissue Claims Must Be for Same General Invention- No New Matter

- 35 U.S.C. 251 ¶ 1: Reissue of defective patents.
Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, **reissue the patent for the invention disclosed in the original patent**, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.
No new matter shall be introduced into the application for reissue.

- The 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. No New Matter is permitted. See MPEP 1412.01.



MPEP 1412.01: Restriction/Election Bar

- Restriction or an election of species requirement made without timely filing of a divisional directed to non-elected invention (s) cannot be recovered by filing a reissue application i.e. not considered to be “reissuable error”.
 - Thus, failure to timely file a divisional application prior to issuance of original patent cannot be cured in a reissue.



MPEP 1412.02: Recapture of Canceled Subject Matter: 3 Part Test

- A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent
- THREE STEP TEST FOR RECAPTURE:
 - (1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims;
 - (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and
 - (3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule

North American Container, 415 F.3d at 1349, 75 USPQ2d 1545 at 1556 (Fed. Cir. 2005).



Recapture: 1st Step

A. The First Step - Was There Broadening?

- Compare reissue claim scope with scope of patented claims
- A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim
 - see MPEP § 1412.03 previously discussed
 - If the reissue claim is not broadened in any respect as compared to the patent claims, the analysis ends; there is no recapture



Recapture: 1st Step Summary

Where the reissue claims:

- a. are narrower than the claims of the original patent in all aspects OR
- b. are equal in scope to the patent claims,
 - there is no recapture as to those reissue claims.

Where, reissue claims are:

- a. broader in at least one respect; OR
- b. both broadened and narrowed compared with the patent claims
 - the nature of the broadening and narrowing must be examined to determine whether the reissue claims are barred as being recapture of surrendered subject matter



Recapture: 1st step (cancelled claims)

Comparing Reissue Claims with Canceled Claims:

- "Canceled claims": claims canceled from the original application to obtain the patent for which reissue is now being sought:
 - (A) can simply be canceled and not replaced by others, or
 - (B) can be canceled and replaced by other claims which are more specific than the canceled claims in at least one aspect to thereby define over the art of record.



Recapture: 1st step (cancelled claims)

- The recapture rule bars the patentee from acquiring, through reissue, claims that are in all aspects
(A) of the same scope as, or
(B) broader in scope than, those claims canceled from the original application to obtain a patent. *Ball Corp. v. United States*, 729 F.2d 1429 at 1436, 221 USPQ 289 at 295 (Fed. Cir. 1984).



Recapture: 2nd step

- B. Second Step: determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution
- “Surrender-generating limitation” – The “limitation” presented, argued, or stated to make the claims patentable over the art (in the application) “generates” the surrender of claimed subject matter



Recapture: 3rd Step

- C. The Third Step - Were the reissue claims materially narrowed in other respects, so as to avoid the recapture rule?
- test: If, the reissue claim(s) are really claiming additional inventions/ embodiments/ species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.
- *Hester Industries* addressed this concept of overlooked aspects, stating:
[T]his principle [i.e., avoidance of the recapture rule], in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects. [Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) at 1482-83; 1649-50.



Recapture General Rules

- A reissue claim
 - a. Avoids recapture: by retaining the full scope of the “surrender-generating limitation”;
 - b. Triggers recapture:
 - by omitting the “surrender-generating limitation” or
 - by broadening the “surrender-generating limitation”
- unless the reissue claims were materially narrowed in other respects, so as to avoid the recapture rule (3rd step exception).



MPEP 1412.02 IV: Recapture Rejection

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

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



MPEP 1412.02 V: Rebuttal by the reissue applicant

- The reissue applicant may rebut a recapture rejection by demonstrating that a claim rejected for recapture includes one or more claim limitations that “materially narrow” the reissue claims.
- A limitation is said to “materially narrow” the reissue claims if the narrowing limitation is directed to one or more “overlooked aspects” of the invention. *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50.
 - NOTE: A limitation that had been prosecuted in the original patent application is not directed to “overlooked aspects” of the disclosed invention and will not overcome the recapture rejection.



Example 1

- Application claim to AB was amended in response to an art rejection to add C to obtain issued claim ABC (i.e. $AB \rightarrow ABC$)
- Reissue claim to $AB_{\text{broadened}}C$:
 - no recapture because:
 1. it is narrower in scope than canceled claim ABand
 - 2. it retains the surrender-generating limitation C



Example 2

- Application claim to ABZ was amended in response to an art rejection to add element C to obtain issued claim ABZC
 - ABZ → ABZC (C is the “surrender generating limitation”)
- Reissue claim ABC (i.e., element Z is deleted):
 - No recapture because:
 1. ABC is narrower in scope as compared to cancelled ABZ in respect to the addition of C and
 2. it retains the surrender-generating limitation C.



Example 3

- Patent claimed ABC : where element C was either a limitation added to AB to obtain allowance of the original patent, or was argued by applicant to define over the art (or both) i.e. C is the “surrender generating limitation”)
- Reissue: claims ABD.
 - Recapture triggered because it omits the “surrender generating limitation” C
- NOTE: even though the reissue claim is narrower than patent claim ABC by the addition of D, adding D (which is unrelated to the surrendered subject matter) does not save the claim from recapture, unless
 - the reissue claims were materially narrowed in other overlooked aspect(s) i.e. 3rd step exception applies.



Example 4

- Original application claimed a method of making a glass lens, where the ion implantation step used a molten bath to diffuse ions into the lens. The molten bath diffusion step was amended to recite a pressure of 50-60 PSI and temperature between 150-200 degrees C - to define over the art
- Reissue claim was drawn to a method of making a glass lens using a plasma stream* (rather than a molten bath) to diffuse ions into the lens without reciting pressure and temperature.

*NOTE: plasma stream was not claimed in the patented application and there was no restriction.



Example 4: Cont.

- NO RECAPTURE: 3rd prong exception to recapture:
 - applicant's failure to claim a disclosed embodiment to plasma ion implantation (i.e., the “overlooked aspect” of using a plasma stream rather than a molten bath to provide the ions), was a proper 35 U.S.C. 251 error, which can be corrected by reissue (e.g. no election/restriction bar); and
 - the temperature/pressure molten bath limitation is incompatible for use in a plasma stream.



Questions

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