



UNITED STATES PATENT AND TRADEMARK OFFICE

REISSUE OVERVIEW

35 USC 251

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Reissue

35 U.S.C. 251 & 252

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.

See MPEP 1401-1470



Reissue

35 U.S.C. 251

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.

...

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.



FILING REQUIREMENTS

37 CFR § 1.171 Application for reissue.

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

37 CFR § 1.172 Applicants, assignees.

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



FILING REQUIREMENTS

Filing fees; *Additional* fees for added claims.

Form PTO/SB/56, reissue application fee transmittal form, for calculation of fees.

Reissue “specification” – **the printed patent.**

Reissue oath or declaration.

Consent of assignee to filing & statement of ownership.
--- Only needed if patent is assigned ---

Form PTO/SB/50 is reissue transmittal form; it contains checklist of items to be submitted.



Reissue Oath or Declaration

Rules – 37 CFR 1.175 and 1.172

Must point out an error being corrected.

Only one error need be given.

The error must be specifically identified, and why it renders the patent wholly or partly inoperative or invalid.

Error in the claims must be identified by reference to specific claim language that addresses the error.

Verbatim recitation of entire claim(s) in oath/declaration does not properly identify the error.

Must state that all errors being corrected arose without deceptive intent.

See MPEP 1414



Supplemental Reissue Declarations

Applicant must file a supplemental declaration where any “error” has been corrected that was not covered by the original oath or declaration. It is immaterial that the same “identified” error is being corrected; the issue is whether additional changes to the patent are being made subsequent to the last filed declaration.

Any necessary supplemental oath or declaration must be submitted before allowance. (MPEP 1414.01(II))

A new supplemental oath or declaration is not required when an amendment is resubmitted to comply with 1.173 (e.g., to reflect changes shown relative to the patent, and the changes themselves are identical to those presented in the previous amendment).



Reissue Oath or Declaration

Reissue oath/declaration must include the requirements of 37 CFR 1.63, as is required for any non-provisional application.

Where the claims are broadened, all inventors are required to sign the oath/dec, except for a 37 CFR 1.42, 1.43, and 1.47 filing.

If no broadening, assignee of entire interest may sign the oath/dec. (37 CFR 1.172) as alternative to the inventors.

Note that the Office will not accept “duty of disclosure” language that fails to comply with 37 CFR 1.63(b)(3) in any reissue application filed on or after June 1, 2008.



Grounds for Filing

A specific error statement is required in the oath or declaration. Statements such as “claim 1 is too narrow to encompass applicant’s invention” or “claim 15 is indefinite” do not suffice. (MPEP § 1414(II)(C))

Applicant must properly identify the “error.” For example, “the limitation X is not necessary for patentability” or “the widget lacks antecedent basis in the claim.”

The filing of additional claims narrower than the broadest claim(s) of a patent, without cancellation of such broader patent claim(s), is not an error that will support reissue. See MPEP 1402 and www.uspto.gov/web/offices/pac/dapp/opla/documents/reissue_narrower_claims_11152007.pdf



Grounds for Filing (Benefit Claims)

Where a reissue applicant (1) submits for the first time both (a) a claim for foreign priority and (b) the certified copy of the priority document in the reissue application, and (2) the patent to be reissued resulted from an application filed on or after 11/29/00, a petition for an unintentionally delayed priority claim under 1.55(c) is required together with the petition fee.

Where domestic (35 U.S.C. §120) benefit is being claimed for the first time and the patent to be reissued resulted from an application filed on or after 11/29/00, a petition for an unintentionally delayed benefit claim under 1.78(a)(3) is required together with the petition fee.

Where a domestic (35 U.S.C. § 119(e)) benefit claim is being added and the patent to be reissued was filed on or after 11/29/00, a petition for unintentionally delayed claim is **NOT** required.



Consent of Assignee to the Reissue

If patent is not assigned, no formal consent is needed.

Inventors signatures are consent of owners.

Should inform USPTO at filing that **patent is not assigned**; if not USPTO presumes patent assigned.

--Can check Box 7 of Form PTO/SB/50 (if used).

If patent is assigned, assignee must consent to filing of reissue.

Consent must be signed by **a party authorized to act** on behalf of **assignee**.

Consent must be supported by § 3.73(b) statement establishing ownership of assignee (see next slide).

Without proper consent, oath/dec. is incomplete.

Thus, § 1.16(e) surcharge required if consent missing for assigned reissue.



Establishing Assignee Ownership of Patent

Consent of assignee is a “taking of action” by the assignee pursuant to 37 CFR 3.73(b). Thus, must be accompanied by proof of ownership, i.e., statement under 37 CFR 3.73(b), which must:

- » Identify the assignee.
- » Identify reel/frame number where assignment recorded or attach copy of assignment document(s)*.
- » Be signed by party authorized to act on behalf of assignee.
 - Title signifying apparent authority, or
 - Authorizing statement, or
 - Assignee “resolution”

See MPEP 324 and sample § 3.73(b) statement.

Recordation of assignment in assignment records of USPTO is not sufficient; § 3.73(b) statement must be filed in application.



Limitations on Reissue (1 of 5): In General

No reissue application, unless “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.

» Reexamination is proper vehicle for such a review.

Reissue statute 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*, 229 USPQ 673 (Fed. Cir. 1986).



Limitations on Reissue (2 of 5): In General

Expired patent is not eligible for reissue.

Patent is reissued “for the unexpired part of the term of the original patent.” 35 U.S.C. 251.

Different than reexamination, where proceeding continues after expiration, as long as patent is enforceable.

Failure to pay maintenance fees may result in termination of the reissue

Term of patent cannot be extended by eliminating 35 U.S.C. 120 priority benefits in a reissue; original term remains in effect.

Subject matter surrendered to obtain the original patent cannot be recaptured by filing a reissue (Recapture discussed later)



Limitation on Reissue (3 of 5): Claim Broadening

No broadening of patent claims outside of two years from Patent Grant.

35 USC 251 - “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.”

Reissue application in which no intent to broaden is shown until after two years may not be later broadened during prosecution outside of two years.

Intent to broaden must be established in the reissue application within two years – *In re Graff*, 42 USPQ2d 1471.



Limitation on Reissue (4 of 5): Claim Broadening See MPEP 1412.03(I) – Broadening Reissue Claims

Test for broadening of patent claims:

Any amended/new claim in the reissue that contains within its scope any conceivable invention which would not have infringed the existing patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 4 USPQ2d 1450 (Fed. Cir. 1987).

» Could reissued patent be used to catch at least one new infringer?

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.

See MPEP 1412.03(I) – Broadening Reissue Claims



Limitation on Reissue (5 of 5): Claims Non-elected in Application

If a restriction was made in the application that became the patent and the non-elected claims in the application were not re-filed in a divisional, they cannot be recovered via reissue.

Rationale: Failure to file a divisional application on the non-elected claims is not considered to be an “error” correctable under 35 U.S.C. 251 by reissue of the original patent.

In re Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977).

In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).



Recapture Rule

Even within 2 years of patent grant, patentee cannot recover via broadening in reissue subject matter surrendered in an effort to obtain allowance of the original patent claims over the art.

Rationale: deliberate withdrawal of claimed subject matter or amendment in order to obtain allowance of the patent over the art cannot be “error” as required by statute.



Recapture – Basic Concept

35 U.S.C. § 251 permits a patentee to apply for a reissue patent “enlarging the scope of the original patent,” if the reissue is “applied for within two years from the grant of the original patent.”

However, 35 U.S.C. § 251 only permits correction of an “error” as defined therein. If an error asserted by the reissue applicant is not an “error” within the meaning of the reissue statute, a reissue patent may not be granted.

MPEP § 1412.02 discusses **one example of an “error” that is not correctible by reissue** because it is not an error within the meaning of the statute: a broadening that attempts to “recapture claimed subject matter which was surrendered in an application to obtain the original patent.”



Recapture: *Ex Parte Eggert*

The Board of Patent Appeals and Interferences “(BPAI”) decision in *Ex Parte Eggert*, 67 USPQ2d 1715, (Bd. Pat. App. & Inter. 2003 (precedential) was the controlling precedent in the Office regarding recapture. *Eggert* may be summarized as follows:

FACTS:

- (1) Claim as filed in original application = ABCD
- (2) Claim as amended and allowed in patent = ABCDE
- (3) Broadened reissue application claim = ABCDE_{BROAD}



Recapture: *Ex Parte Eggert* (cont.)

TERMINOLOGY USED IN *EGGERT*:

- (1) **S**urrender **G**enerating **L**imitation (“**SGL**”) = the limitation added and/or argued to obtain allowance. (In this case, limitation **E**.)
- (2) **S**urrendered **S**ubject **M**atter (“**SSM**”) = the original patent application claim prior to amendment (in *Eggert*, ABCD) and any broader claim.



Recapture: *Ex Parte Eggert* (cont.)

Holding: Recapture rejections reversed because there is no recapture when the **SGL** is retained in any form. ABCDE was broadened to ABCDE_{BROAD} and so the **SGL E** was retained.

Dicta: No recapture for any reissue claim narrower than the **SSM**. Thus no recapture for ABCDQ and ABCD_{SPECIFIC} because each is narrower than ABCD. No need to retain the **SGL E**.



Recapture: *Ex Parte Eggert* (cont.)

Office practice had been to follow the *Eggert* holding, but to not follow the *Eggert dicta*.

The Office is now following the later decision in *North American Container, Inc. v. Plastipak Packing, Inc.*, 415 F.3d 1335, 1349, 75 USPQ2d 1545, 1556 (Fed. Cir. 2005), as interpreted in later BPAI decisions.

The subsequent slides explain the current Office policy on reissue recapture practice, and how it differs from the practice under *Eggert*.



Recapture: Post-Eggert Recapture Test MPEP 1412.02

In *North American Container, Inc. v. Plastipak Packing, Inc.*, 415 F.3d 1335, 1349, 75 USPQ2d 1545, 1556 (Fed. Cir. 2005) the court stated:

“We apply the recapture rule as a three-step process:

- (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.”

See *North American Container* for additional Federal Circuit authorities that support the recapture test stated above.



Recapture: Post-Eggert Recapture Test (cont.)

New Definition for Surrendered Subject Matter

SSM = The subject matter of an application claim which was amended or canceled **and**, on a limitation-by-limitation basis, the territory falling between the scope of (a) the application claim which was canceled or amended and (b) the patent claim which was ultimately issued.

Example: Application claim is ABCD. During prosecution, claim is amended to read ABCDE and is allowed. **SSM** is ABCD and the territory between ABCD and ABCDE.



Recapture: Post-Eggert Recapture Test (cont.)

The Recapture Test is applied as Follows:

In a broadening reissue application, the examiner has the burden of determining, on a claim-by-claim basis, whether the broadening in the reissue application relates to subject matter that was surrendered during the examination of the patent that is the subject of the reissue application because such subject matter was added and/or argued to overcome an art rejection. **If “surrendered subject matter” has been entirely eliminated from a claim in the reissue application, or has been in any way broadened, then a recapture rejection under 35 U.S.C. § 251 is proper and must be made for that claim.**



Recapture: Post-Eggert Recapture Test (cont.)

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. The inclusion of such a limitation in a claim rejected for recapture will overcome the recapture rejection.

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.



Recapture: Post-Eggert Recapture Test (cont.)

Assume original application claim ABCD is amended during prosecution and results in patent claim ABCDE. Examples of reissue application claims that are to be rejected for recapture under 35 U.S.C. § 251 include:

1. ABCD → Eliminates **E**, the **SGL**.
2. ABCDF → Eliminates **E**, the **SGL**, adds narrowing limitation **F**.
3. ABCDE_{BROADER} → Broadens **E**, the **SGL**.
4. ABCDE_{BROADER}**F** → Broadens **E**, the **SGL**, adds narrowing limitation **F**.

Applicant may attempt to rebut rejections 2 and 4 by showing that **F** “materially narrows” the reissue claims because it is directed to an “overlooked aspect” of the disclosed invention. The examiner will then determine whether **F**, or a limitation “similar to” **F**, had been prosecuted in the application for the original patent. If so, then the recapture rejection will not be overcome.



Recapture: Post-Eggert

The following post-*Eggert* BPAI recapture decisions are the basis for current Office recapture practice, consistent with *North American Container*:

Ex Parte Kip Van Steenburg, Appeal 2006-1865, Application 09/660,433 (2007) MacDonald, APJ (McKelvey, Garris, and MacDonald)

Ex Parte Raanan Liebermann, Appeal 2007-012, Application 09/603,247 (2007) MacDonald, APJ (McKelvey, Blankenship and MacDonald)

Ex Parte Franklin C. Bradshaw et al, Appeal 2006-2744, Application 09/664,794 (2007) Garris, APJ (McKelvey, Garris, and MacDonald)