

Chapter 1400: Correction of Patents

1400.01 Introduction

1401 Reissue

1402 Grounds for Filing

- I. ERROR BASED ON SCOPE OF CLAIMS
- II. INVENTORSHIP ERROR
- III. ERROR RELATED TO PRIORITY TO FOREIGN APPLICATION
- IV. ERROR IN BENEFIT CLAIM TO DOMESTIC APPLICATION
- V. ERROR IN DRAWING

1403 Diligence in Filing

1404 Submission of Papers Where Reissue Patent Is in Litigation

1405 Reissue and Patent Term

1406 Citation and Consideration of References Cited in Original Patent

1410 Content of Reissue Application

1410.01 Reissue Applicant and Inventor's Oath or Declaration

- I. REISSUE APPLICATION FILED ON OR AFTER SEPTEMBER 16, 2012
- II. REISSUE APPLICATION FILED BEFORE SEPTEMBER 16, 2012

1410.02 Assignee Consent to the Reissue

- I. WRITTEN CONSENT
- II. PROOF OF OWNERSHIP OF ASSIGNEE
- III. COMPARISON OF ASSIGNEE THAT CONSENTS TO ASSIGNEE SET FORTH IN SUBMISSION ESTABLISHING OWNERSHIP INTEREST

1411 Form of Specification

1411.01 Certificate of Correction or Disclaimer in Original Patent

1411.02 New Matter

1412 Content of Claims

1412.01 Reissue Claims Must Be for Same General Invention

I. FAILURE TO TIMELY FILE A DIVISIONAL APPLICATION PRIOR TO ISSUANCE OF ORIGINAL PATENT

1412.02 Recapture of Canceled Subject Matter

I. THREE STEP TEST FOR RECAPTURE:

A. The First Step - Was There Broadening?

B. The Second Step - Does Any Broadening Aspect of the Reissued Claim Relate to Surrendered Subject Matter?

1. The Two Sub-Steps:

2. Examples of the Second Step Analysis:

C. The Third Step - Were the reissued claims materially narrowed in other respects, and hence avoid the recapture rule?

1. Comparing Reissue Claims Narrowed/Broadened Vis-à-vis the Canceled Claims

(a) Reissue Claims Are Same or Broader in Scope Than Canceled Claims in All Aspects:

(b) Reissue Claims are Narrower in Scope Than Canceled Claims in at Least One Aspect:

2. Comparing Reissue Claims Narrowed/Broadened Vis-à-vis the Patent Claims

(a) Reissue Claims are Narrower in Scope Than Patent Claims, in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope by Omitting Limitation(s) Added/Argued To Overcome Art Rejection in Original Prosecution:

(b) Reissue Claims are Narrower or Equal in Scope, in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope in Area Not Directed to Amendment/Argument:

(c) Reissue Claims are Narrower in Scope in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in

Original Prosecution; are Broader in Scope in Area Not Directed to the Amendment/Argument:

(d) Reissue Claims Broader in Scope in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; but Reissue Claims Retain, in Broadened Form, the Limitation(s) Argued/Added to Overcome Art Rejection in Original Prosecution:

- II. REISSUE TO TAKE ADVANTAGE OF pre-AIA 35 U.S.C. 103(b):
- III. REISSUE FOR ARTICLE CLAIMS WHICH ARE FUNCTIONAL DESCRIPTIVE MATERIAL STORED ON A COMPUTER-READABLE MEDIUM:
- IV. REJECTION BASED UPON RECAPTURE:
- V. REBUTTAL BY THE REISSUE APPLICANT
- VI. FLOWCHART

1412.03 Broadening Reissue Claims

- I. MEANING OF "BROADENED REISSUE CLAIM"
- II. SCOPE OF DEPENDENT CLAIM ENLARGED - NOT BROADENING
- III. NEW CATEGORY OF INVENTION ADDED IN REISSUE - GENERALLY IS BROADENING
- IV. WHEN A BROADENED CLAIM CAN BE PRESENTED
- V. BROADENING REISSUE - OATH/DECLARATION REQUIREMENTS
 - A. Reissue Application Filed On or After September 16, 2012
 - B. Reissue Application Filed Before September 16, 2012

1412.04 Correction of Inventorship By Reissue

- I. CERTIFICATE OF CORRECTION AS A VEHICLE FOR CORRECTING INVENTORSHIP
- II. REISSUE AS A VEHICLE FOR CORRECTING INVENTORSHIP

1412.05 Correction of Inventorship in a Broadening Reissue Application

- I. Reissue Application Filed On or After September 16, 2012
- II. Reissue Application Filed Before September 16, 2012

1413 Drawings

1414 Content of Reissue Oath/Declaration

I. A STATEMENT THAT THE APPLICANT BELIEVES THE ORIGINAL PATENT TO BE 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 PATENTEE HAD THE RIGHT TO CLAIM IN THE PATENT

II. A STATEMENT OF AT LEAST ONE ERROR WHICH IS RELIED UPON TO SUPPORT THE REISSUE APPLICATION (I.E., THE BASIS FOR THE REISSUE)

1414.01 Reissue Oath or Declaration in Reissue Application Filed On or After September 16, 2012

1414.02 Reissue Oath or Declaration in Reissue Application Filed Before September 16, 2012

I. ERROR WITHOUT DECEPTIVE INTENT

II. THE REISSUE OATH/DECLARATION MUST COMPLY WITH PRE-AIA 37 CFR 1.63

1414.03 Supplemental Reissue Oath/Declaration

I. REISSUE APPLICATION FILED ON OR AFTER SEPTEMBER 16, 2012

II. REISSUE APPLICATION FILED BEFORE SEPTEMBER 16, 2012

A. When An Error Must Be Specifically Identified In The Supplemental Oath/Declaration

B. Supplemental Oath/Declaration Must Be Submitted Before Allowance

C. Supplemental Oath/Declaration In Broadening Reissue

1415 Reissue Application and Issue Fees

I. BASIC REISSUE APPLICATION FILING, SEARCH, AND EXAMINATION FEES

II. APPLICATION SIZE FEE

III. EXCESS CLAIMS FEES

IV. ISSUE FEE

V. REISSUE APPLICATION FEE TRANSMITTAL FORM

1415.01 Maintenance Fees on the Original Patent

I. PAYMENT OF MAINTENANCE FEES WHERE THE PATENT HAS BEEN REISSUED

1416 No Physical Surrender of Original Patent

1417 Claim for Priority Under 35 U.S.C. 119(a)-(d)

I. PRIORITY UNDER 35 U.S.C. 119(a)-(d) WAS PERFECTED IN THE ORIGINAL PATENT

II. PRIORITY UNDER 35 U.S.C. 119(a)-(d) IS NEWLY PERFECTED IN THE REISSUE APPLICATION

1418 Notification of Prior/Concurrent Proceedings and Decisions Thereon, and of Information Known To Be Material to Patentability

1430 Reissue Files Open to the Public and, Notice of Filing Reissue Announced in, Official Gazette

1440 Examination of Reissue Application

I. DETERMINING PATENTABILITY OVER THE PRIOR ART

1441 Two-Month Delay Period

1441.01 Protest and Preissuance Submission in Reissue Applications

I. PROTESTS, BUT NOT PREISSUANCE SUBMISSIONS, ARE PERMITTED IN REISSUE APPLICATIONS

II. TIME PERIOD FOR FILING PROTEST

1442 Special Status

1442.01 Litigation-Related Reissues

1442.02 Concurrent Litigation

1442.03 Litigation Stayed

1442.04 Litigation Involving Patent

1442.05 Court Ordered Filing of Reissue Application

1443 Initial Examiner Review

1444 Review of Reissue Oath/Declaration

I. REQUIREMENTS OF REISSUE OATH OR DECLARATION

II. REVIEW OF REISSUE OATH OR DECLARATION

III. ERRORS PREVIOUSLY IDENTIFIED NO LONGER RELIED UPON AS THE BASIS FOR REISSUE

A. Application filed on or after September 16, 2012

B. Application filed before September 16, 2012

IV. SUPPLEMENTAL REISSUE OATH/DECLARATION UNDER PRE-AIA 37 CFR 1.175(b)(1):

V. AFTER ALLOWANCE

1445 Reissue Application Examined in Same Manner as Original Application

1448 Fraud, Inequitable Conduct, or Duty of Disclosure Issues

I. ADMISSION OR JUDICIAL DETERMINATION

1449 Protest Filed in Reissue Where Patent Is in Interference or Contested Case

1449.01 Concurrent Office Proceedings

I. CONCURRENT REEXAMINATION PROCEEDINGS

A. Reexamination Certificate Is To Be Issued for a Patent, While a Reissue Application for the Patent Is Pending

II. CONCURRENT INTERFERENCE AND OTHER CONTESTED CASE PROCEEDINGS

III. CONCURRENT REISSUE PROCEEDINGS

1449.02 Interference in Reissue

I. REISSUE APPLICATION FILED WHILE PATENT IS IN INTERFERENCE

1449.03 Reissue Application in Derivation Proceeding

1450 Restriction and Election of Species Made in Reissue Application

1451 Divisional Reissue Applications; Continuation Reissue Applications Where the Parent is Pending

I. DIVISIONAL REISSUE APPLICATIONS

II. CONTINUATION REISSUE APPLICATIONS

1452 Request for Continued Examination of Reissue Application

1453 Amendments to Reissue Applications

I. THE SPECIFICATION

II. THE CLAIMS

III. THE DRAWINGS

IV. ALL CHANGES ARE MADE VIS-À-VIS THE PATENT TO BE REISSUED

A. The Subject Patent Already Has Underlining or Bracketing

V. EXAMPLES OF PROPER AMENDMENTS

A. Original Patent Description or Patent Claim Amended

B. Cancellation of Claim(s)

C. Presentation of New Claims

D. Amendment of New Claims

E. Amendment of Original Patent Claims More Than Once

VI. ADDITIONAL EXAMPLES

1454 Appeal Brief

1455 Allowance and Issue

I. ISSUE CLASSIFICATION

II. CHANGES TO THE ORIGINAL PATENT

III. CLAIM NUMBERING

IV. CLAIM DESIGNATED FOR PRINTING

V. PROVIDING PROPER FORMAT

VI. PARENT APPLICATION DATA

VII. REFERENCES CITED AND PRINTED

VIII. EXAMINER'S AMENDMENT AND REISSUE OATH OR DECLARATION

IX. FINAL REVIEW OF THE REISSUE APPLICATION BY THE EXAMINER

1456 Reissue Review

1457 Design Reissue Applications and Patents

- I. EXPEDITED EXAMINATION PROCEDURE
- II. DESIGN REISSUE FEE
- III. MULTIPLE DESIGN REISSUE APPLICATIONS
- IV. CONVERSION TO UTILITY PATENT
- V. CONVERSION TO A DESIGN PATENT

1460 Effect of Reissue

1470 Public Access of Reissue Applications

1480 Certificates of Correction — Office Mistake

- I. THIRD PARTY INFORMATION ON MISTAKES IN PATENT
- II. PUBLICATION IN THE OFFICIAL GAZETTE

1480.01 Expedited Issuance of Certificates of Correction - Error Attributable to Office

1481 Certificates of Correction - Applicant's Mistake 1481.01-Correction of Assignees' Names

1481.02 Correction of Named Inventor

- I. REQUEST FILED ON OR AFTER SEPTEMBER 16, 2012, TO CORRECT NAMED INVENTOR
- II. REQUEST FILED BEFORE SEPTEMBER 16, 2012, TO CORRECT NAMED INVENTOR
- III. PETITION UNDER 37 CFR 1.324 BY SPE

1481.03 Correction of 35 U.S.C. 119 and 35 U.S.C. 120 Benefits

- I. CORRECTION TO PERFECT CLAIM FOR 35 U.S.C. 119 (a)-(d) AND (f) BENEFITS
- II. CORRECTION AS TO 35 U.S.C. 120 AND 35 U.S.C. 119(e) BENEFITS
 - A. For Applications Filed On or After March 16, 2013
 - B. For Applications Filed on or After November 29, 2000 and Before March 16, 2013
 - C. For Application Filed Before November 29, 2000

1485 Handling of Request for Certificates of Correction

I. ELECTRONIC PUBLICATION OF CERTIFICATES OF CORRECTION WITH LATER LISTING IN THE OFFICIAL GAZETTE

1490 Disclaimers

I. SIGNING AND SUPPORTING A DISCLAIMER

A. Disclaimer in Application Filed On or After September 16, 2012

B. Disclaimer in Application Filed Before September 16, 2012

II. STATUTORY DISCLAIMERS

III. TERMINAL DISCLAIMERS

IV. PROCESSING IN CERTIFICATE OF CORRECTION BRANCH

V. PROCESSING OF TERMINAL DISCLAIMER IN PENDING APPLICATION

VI. OTHER MATTERS DIRECTED TO TERMINAL DISCLAIMERS

A. Requirements of Terminal Disclaimers

B. Effect of Disclaimers in Continuing Applications and in Reissues

C. Disclaimer Identifies the Wrong Target Application or Patent

D. Two or More Copending Applications

VII. FORM PARAGRAPHS

VIII. WITHDRAWING A RECORDED TERMINAL DISCLAIMER

A. Before Issuance Of Patent

B. After Issuance Of Patent

IX. TERMINAL DISCLAIMER FORMS