

# PATENT REISSUE

## FREQUENTLY ASKED QUESTIONS



# Patent Reexamination

## *Frequently Asked Questions<sup>1</sup>*

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# Patent Reexamination

## *Frequently Asked Questions<sup>2</sup>*

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### *1. What is a reissue patent application?*

A reissue patent application is filed post-grant to correct an error in an issued patent where the error renders the patent wholly or partially inoperable or invalid. The procedure has long been recognized by courts and was later codified in 35 U.S.C. § 251:

The USPTO director, upon request by the patentee, will correct errors in the patent and reissue the new amended patent. The term of the reissue patent will be the remaining unexpired term of the original patent,<sup>3</sup> and the reissued patent cannot contain new matter. The reissue must be for the same invention.

### *2. What types of situations call for a reissued patent?*

A broad range of errors may qualify under the reissue statute. Typical errors correctable by a reissue include a defective specification or drawing, claims that are too narrow or too broad, or failure to correctly reference priority documents.<sup>4</sup> The error may be the result of an accident or mistake, but cannot be purposeful<sup>5</sup> or deceptive. A patent may even reissue based on the prosecuting attorney's misunderstanding of the scope of the invention.

### *3. Why choose patent reissue rather than patent reexamination?*

Patent reexamination can only be performed for issues concerning novelty and obviousness.<sup>6</sup> Thus, if the patent is inoperable or invalid due to an error in the specification or issues relating to utility, written description or enablement, patent reexamination is inappropriate. For a limited time after issuance, a patent reissue may also allow the patentee to broaden the scope of his claims — a procedure that is totally precluded in a reexamination.

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<sup>3</sup> See MPEP § 1405

<sup>4</sup> 35 U.S.C. § 251

<sup>5</sup> See Question Concerning the Rule Against Recapture

<sup>6</sup> See Generally 35 U.S.C. §§ 301-318

4. *May I broaden the scope of a claim in a reissue?*

Yes, but only within two years from the grant of the original patent.<sup>7</sup> Any broadening reissue that occurs outside the two-year window will be deemed invalid. When seeking a broadening reissue, the patentee must unequivocally indicate this intent in the reissue application.

The term *broadening reissue* is a claim that enlarges the scope of the claims of the patent; *i.e.*, a claim that is greater in scope than each and every claim of the original patent.<sup>8</sup>

5. *When can I file a reissue application?*

If the patent has not expired, a patentee may file for a narrowing reissue at any time. However, once a patent expires, no reissue of any kind will be granted.<sup>9</sup> As noted in Question 4 above, a broadening reissue may only be filed within two years of the original patent grant.

6. *What is required in the oath and declaration of the reissue application?*

The reissue oath and declaration must comply with the requirements of the original oath and declaration, and further state that:

(1) 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 the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.<sup>10</sup>

In addition, supplemental oaths and/or declarations may be required for supplemental errors or corrections, or if a continuing reissue application is filed.

7. *How is a reissue application examined?*

A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other

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<sup>7</sup> See U.S.C. § 251

<sup>8</sup> See MPEP § 1412.03

<sup>9</sup> See MPEP § 1415.01

<sup>10</sup> See MPEP § 1414

applications.<sup>11</sup> Reissue applications are normally examined by the same examiner who issued the patent for which reissue is requested.<sup>12</sup>

#### 8. *What is the rule against recapture?*

The rule against recapture of subject matter is an important limitation to reissue. A reissue will not be granted to “recapture” claimed subject matter that was surrendered during the prosecution of an application for the original patent.<sup>13</sup>

The rule “prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.”<sup>14</sup> The Federal Circuit applies the following three-step test for recapture analysis:<sup>15</sup>

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.

If it is determined that reissue claims recapture subject matter previously surrendered, the reissue claims will be rejected during reissue examination.

#### 9. *What effect do reissued claims have on the enforceability of an original patent?*

If a reissued patent is granted, the original patent must be surrendered. However, 35 U.S.C. § 252 provides for continuity between “substantially identical” claims between the original and reissued patents. A patentee may recover for all infringement that occurred since the date of the original patent if the respective claims are substantially identical. If the reissued claims are not substantially identical to the original claims, the original claims are unenforceable, and the patentee cannot recover for any infringing activity prior to the date of reissue.

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<sup>11</sup> See MPEP § 1440

<sup>12</sup> Id.

<sup>13</sup> See MPEP § 1412.02

<sup>14</sup> See *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997)

<sup>15</sup> See *North American Container, Inc. v. Plastipak, Inc.*, 415 F.3d 1335, 1349, 75 USPQ2d 1545, 1556 (Fed. Cir. 2005)

#### 10. *What is the doctrine of intervening rights?*

Under the doctrine of intervening rights, a patentee's ability to recover for infringing activity based on reissued claims may be limited:

A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent.<sup>16</sup>

The doctrine protects third parties who have made decisions based on the scope of the original patent, only to find themselves infringing the reissued patent.

#### 11. *What is a certificate of correction?*

A certificate of correction may be used in lieu of a reissue application.

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law as if the same had been originally issued in such corrected form.<sup>17</sup>

Furthermore, the USPTO may issue a certificate of correction for their own mistakes, with no charge to the patentee, if those mistakes are clear on the record.<sup>18</sup>

#### 12. *What happens to the original patent if my reissue application is rejected or abandoned?*

The original patent remains in effect until a reissue is granted. Thus, even if the reissue is denied or abandoned, the original patent will still be enforceable. However, any file history related to a reissue will remain public.<sup>19</sup>

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<sup>16</sup> 35 U.S.C. § 252

<sup>17</sup> See 35 U.S.C. § 255

<sup>18</sup> See 35 U.S.C. § 254

<sup>19</sup> See MPEP § 1416

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MAIER & MAIER PLLC specializes in the practice of Intellectual Property and is conveniently located in Alexandria, Virginia next to the United States Patent and Trademark Office.

Our practice areas include, but are not limited to: patent searches, patent application drafting, patent opinions, patent prosecution, patent litigation, trademarks, copyrights, trade secrets and licensing. Our experienced, dedicated lawyers are focused on, and take great pride in, advising and obtaining patent protection for a wide scale of technologies.

Our attorneys and agents have garnered vast amounts of intellectual property expertise and experience while serving middle market companies from a variety of venues. Our distinctive approach to client service is rooted in a common guiding principle of exceeding client expectations by delivering the highest quality advice and excellence in execution, built upon a foundation of uncompromising integrity.

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