Chapter 1400 Correction of Patents

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1400.01 Introduction [R-11.2013]

A patent may be corrected or amended in seven ways, namely by:

(1) reissue,
(2) the issuance of a certificate of correction which becomes a part of the patent,
(3) disclaimer,
(4) reexamination,
(5) *inter partes* review,
(6) post grant review, and
(7) covered business method review.

The first three ways are discussed in this chapter. The fourth way (reexamination) is discussed in MPEP Chapter **2200** for *ex parte* reexamination: see MPEP Chapter **2600** for *inter partes* reexamination requests (as of September 16, 2012 no new requests may be filed). The fifth, sixth, and seventh ways *(inter partes* review, post grant review, and covered business method review) are discussed in the Office Patent Trial Practice Guide available at **http://www. uspto.gov/ip/boards/bpai/board_trial_rules_and_practice_guide. jsp**.

1401 Reissue [R-11.2013]

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

(a) IN GENERAL.—Whenever any patent is, through error, 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.

(b) MULTIPLE REISSUED PATENTS.— 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.

(c) APPLICABILITY OF THIS TITLE.— 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 or the application for the original patent was filed by the assignee of the entire interest.

(d) REISSUE PATENT ENLARGING SCOPE OF CLAIMS.—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.

35 U.S.C. 251 (pre-AIA) 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 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.

In this chapter, for reissue applications filed before September 16, 2012, all references to pre-AIA 35 U.S.C. 251 and 253 and pre-AIA 37 CFR 1.172, 1.175, 1.321, and 3.73 are to the law and rules in effect on September 15, 2012.

35 U.S.C. 251 and pre-AIA 35 U.S.C. 251 permit the reissue of a patent to correct an error in the patent and provide criteria for the reissue. Pre-AIA 35 U.S.C. 251 requires that any error to be corrected must have been made "without deceptive intention." Effective September 16, 2012, Public Law 112-29, sec. 20, 125 Stat. 284 (Leahy-Smith America Invents Act (AIA)), amended 35 U.S.C. 251 to eliminate the "without deceptive intention" clause. This law as amended applies to reissue applications filed on or after September 16, 2012. **37 CFR 1.171** through **1.178** are rules directed to reissue.

1402 Grounds for Filing [R-11.2013]

A reissue application is filed to correct an error in the patent, where, as a result of the error, the patent is deemed wholly or partly inoperative or invalid. An error in the patent arises out of an error in

conduct which was made in the preparation and/or prosecution of the application which became the patent.

There must be at least one error in the patent to provide grounds for reissue of the patent. If there is no error in the patent, the patent will not be reissued. The present section provides a discussion of what may be considered an error in the patent upon which to base a reissue application.

In accordance with **35 U.S.C. 251**, the error upon which a reissue is based must be one which causes the patent to be "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." Thus, an error under **35 U.S.C. 251** *has not been presented* where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in **35 U.S.C. 251**. These corrections to a patent do not provide a basis for reissue (although these corrections may also be included in a reissue application, where a **35 U.S.C. 251** error is already present), and may be made via a certificate of correction; see **MPEP § 1481**.

The most common bases for filing a reissue application are:

(A) the claims are too narrow or too broad;
(B) the disclosure contains inaccuracies;
(C) applicant failed to or incorrectly claimed foreign priority; and
(D) applicant failed to make reference to or incorrectly made reference to prior copending applications.

I. ERROR BASED ON SCOPE OF CLAIMS

The reissue error may be directed solely to the failure to previously present narrower claims, which are being added by reissue. *In re Tanaka*, 640 F.3d 1246, 1251, 98 USPQ2d 1331, 1334 (Fed. Cir. 2011) provides that "the omission of a narrower claim from a patent can render a patent partly inoperative by failing to protect the disclosed invention to the full extent allowed by law." This permits submission of additional claims that are narrower in scope than the preexisting patent claims, without any narrowing of the preexisting patent claims. For example, a reissue applicant can retain the broad independent claims of the patent while adding only new dependent claims.

A reissue applicant's failure to timely file a divisional application covering the non-elected invention(s) following a restriction requirement is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such applicant's error is not correctable by reissue of the original patent under **35 U.S.C. 251**. See **MPEP § 1412.01**.

An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue in the decision of *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). In *Medrad, Inc. v. Tyco Healthcare Group LP*, 466 F.3d 1047, 80 USPQ2d 1526 (Fed. Cir. 2006), the court rejected an argument that a **35 U.S.C. 251** error was limited to defects in the specification, drawings, and claims. Instead, the court explained that the correctable error could be "any error that causes a patentee to claim more or less than he had a right to claim." 466 F.3d at 1052, 80 USPQ2d at 1529. In *Medrad*, the specific error was the failure to submit a supplemental reissue declaration during prosecution of a prior reissue patent.

II. INVENTORSHIP ERROR

The correction of misjoinder of inventors in divisional reissues has been held to be a ground for reissue. See *Ex parte Scudder*, 169 USPQ 814 (Bd. App. 1971). The Board of Appeals held in *Ex parte Scudder*, 169 USPQ at 815, that **35 U.S.C. 251** authorizes reissue applications to correct misjoinder of inventors where **35 U.S.C. 256** is inadequate.

If the only change being made in the patent is correction of the inventorship, this can be accomplished by filing a request for a certificate of correction under the provisions of **35 U.S.C. 256** and **37 CFR 1.324**. See **MPEP § 1412.04** and **§ 1481**. A Certificate of Correction will be issued if all parties are in agreement and the inventorship issue is not contested. However, if applicant chooses

to file a reissue application to correct the inventorship (as opposed to choosing the Certificate of Correction route), applicant may do so because misjoinder of inventors is an error that is correctable by reissue under **35 U.S.C. 251**.

III. ERROR RELATED TO PRIORITY TO FOREIGN APPLICATION

A reissue was granted in *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under **35 U.S.C. 119(a)-(d)** before the patent was granted.

In *Brenner* , the claim for priority had been made in the prosecution of the original patent, and it was only necessary to submit a certified copy of the priority document in the reissue application to perfect priority. Reissue is also available to convert the "error" in failing to take any steps to obtain the right of foreign priority under **35 U.S.C. 119(a)-(d)** before the patent was granted. See *Fontijn v. Okamoto*, 518 F.2d 610, 622, 186 USPQ 97, 106 (CCPA 1975) ("a patent may be reissued for the purpose of establishing a claim to priority which was not asserted, or which was not perfected during the prosecution of the original application"). In a situation where it is necessary to submit for the first time both the claim for priority and the certified copy of the priority document in the reissue application, and the patent to be reissued resulted from a utility or plant application which became the patent to be reissued was filed on or after November 29, 2000, the reissue applicant must (where it is necessary to submit for the first time the claim for priority) also file a petition for an unintentionally delayed priority claim under **37 CFR 1.55(c)** (for applications filed on or after November 29, 2000 and before March 16, 2013) or under 37 CFR 1.55(e) (for applications filed on or after March 16, 2013) in addition to filing a reissue application. See **MPEP § 214** *et. seq.*

IV. ERROR IN BENEFIT CLAIM TO DOMESTIC APPLICATION

The courts have not addressed the question of correction of the failure to adequately claim benefit under **35 U.S.C. 119(e)** in the application (which became the patent to be reissued) via reissue. If the application which became the patent to be reissued was filed before November 29, 2000, correction as to benefit under **35 U.S.C. 119(e)** would be permitted in a manner somewhat analogous to that of the priority correction discussed above. Where the application, which became the patent to be reissued, was filed on or after November 29, 2000, reissue may be employed to correct an applicant's mistake by adding or correcting a benefit claim under **35 U.S.C. 119(e)**. A petition under **37 CFR 1.78(a)(6)** for an unintentionally delayed claim under **35 U.S.C. 119(e)** would not be required in addition to filing a reissue application.

35 U.S.C. 119(e)(1) to states in part that:

> No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section ***during the pendency of the application***. (Emphasis added.)

As discussed in subsection III above, the court in *Fontijn* held that **35 U.S.C. 251** was sufficiently broad to correct a patent where the applicant failed to assert or failed to perfect a claim for foreign priority during the prosecution of the original application even though **35 U.S.C. 119(b)** at that time required a claim and a certified copy of the foreign application to be filed *before the patent is granted*. Similarly, the Office may grant a reissue for adding or correcting a benefit claim under **35 U.S.C. 119(e)** that requires the benefit claim to a provisional application be submitted *during the pendency of the application*.

Correction of failure to adequately claim benefit under **35 U.S.C. 120** in an earlier filed copending

U.S. patent application was held a proper ground for reissue. *Sampson v. Comm'r Pat.* , 195 USPQ 136, 137 (D.D.C. 1976). If the utility or plant application which became the patent to be reissued was filed on or after November 29, 2000, the reissue applicant must file a petition for an unintentionally delayed priority claim under pre-AIA **37 CFR 1.78(a)(3)** (for applications filed on or after November 29, 2000 and before March 16, 2013) or under 37 CFR 1.78(d) (for applications filed on or after March 16, 2013) in addition to filing a reissue application. See **MPEP § 211.04** For treatment of an error involving disclaimer of a benefit claim under **35 U.S.C. 120**, see **MPEP § 1405**.

If the utility or plant application which became the patent to be reissued was filed before November 29, 2000 and therefore, not subject to eighteen-month publication, a petition for an unintentionally delayed benefit claim under **37 CFR 1.78(a)(3)** would not be required to add/correct the benefit claim in the reissue application. This is so, even if the reissue application was filed on or after November 29, 2000. On the other hand, if applicant fails to file an amendment to add a claim for benefit of a utility or plant reissue application filed on or after November 29, 2000 in a later-filed reissue application within the time period set forth in **37 CFR 1.78**, then a petition for an unintentionally delayed benefit claim under pre-AIA **37 CFR 1.78(a)(3)** (for applications filed on or after November 29, 2000 and before March 16, 2013) or under 37 CFR 1.78(d) (for applications filed on or after March 16, 2013) along with the surcharge set forth in **37 CFR 1.17(t)** would be required. This is so even if the original application which became the original patent was filed before November 29, 2000. This is because the benefit claim is between the later-filed reissue application and the prior-filed reissue application and the benefit claim is not being added to make a correction as to a benefit of the original patent.

V. ERROR IN DRAWING

A reissue may be based on a drawing correction that is substantive in nature, because such a correction qualifies as correcting an "error" under **35 U.S.C. 251** that may properly be deemed to render the patent wholly or partly inoperative. A reissue application cannot be based on a non-substantive drawing change, such as a reference numeral correction or addition, the addition of shading, or even the addition of an additional figure merely to "clarify" the disclosure. Non-substantive drawing changes may, however, be included in a reissue application that corrects at least one substantive "error " under **35 U.S.C. 251**.

1403 Diligence in Filing [R-11.2013]

When a reissue application is filed within 2 years from the date of the original patent, a rejection on the grounds of lack of diligence or delay in filing the reissue should not normally be made. *Ex parte Lafferty*, 190 USPQ 202 (Bd. App. 1975); but see *Rohm & Haas Co. v. Roberts Chemical Inc.*, 142 F. Supp. 499, 110 USPQ 93 (S.W. Va. 1956), *rev'd on other grounds*, 245 F.2d 693, 113 USPQ 423 (4th Cir. 1957).

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

(d) REISSUE PATENT ENLARGING SCOPE OF CLAIMS.—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.

35 U.S.C. 251(d) corresponds to the provisions of pre-AIA 35 U.S.C. 251, fourth paragraph

Where any broadening reissue application is filed within two years from the date of the original patent, **35 U.S.C. 251** presumes diligence, and the examiner should not inquire why applicant failed to file the reissue application earlier within the two year period.

See **MPEP § 1412.03** for broadening reissue practice. See also *In re Graff*, 111 F.3rd 874, 42 USPQ2d 1471 (Fed. Cir. 1997); *In re Bennett*, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985); *In re Fotland*, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985).

A reissue application that is filed on the 2-year anniversary date of the patent grant is considered as being filed within 2 years. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) (a similar rule in interferences).

A reissue application can be granted a filing date without an oath or declaration, or without the basic filing fee, search fee, or examination fee being

present. See **37 CFR 1.53(f)**. Applicant will be given a period of time to provide the missing parts and to pay the surcharge under **37 CFR 1.16(f)**. See **MPEP § 1410.01**.

1404 Submission of Papers Where Reissue Patent Is in Litigation [R-11.2013]

Marking of envelope: Applicants and protestors (see **MPEP § 1901.03**) submitting papers for entry in reissue applications of patents involved in litigation are requested to mark the outside envelope and the top right-hand portion of the papers with the words "REISSUE LITIGATION" and with the art unit or other area of the United States Patent and Trademark Office in which the reissue application is located, e.g., Commissioner for Patents, Patent Trial and Appeal Board, Office of Patent Legal Administration, Technology Center, Office of Data Management, etc.

Marking of papers: Any "Reissue Litigation" documents submitted to the Office should be clearly marked as such. Papers marked "REISSUE LITIGATION" will be given special attention and expedited handling. See **MPEP § 1442.01** through § **1442.04** for examination of litigation-related reissue applications. Protestor's participation, including the submission of papers, is limited in accordance with **37 CFR 1.291(c)**.

1405 Reissue and Patent Term [R-11.2013]

35 U.S.C. 251 prescribes the effect of reissue on the patent term by stating that "the Director shall… reissue the patent… for the unexpired term of the original patent."

The maximum term of the original patent is fixed at the time the patent is granted. While the term may be subsequently shortened, e.g., through the filing of a terminal disclaimer, it cannot be extended through the filing of a reissue. Accordingly, a deletion in a reissue application of an earlier-obtained benefit claim under **35 U.S.C. 120** will not operate to lengthen the term of the patent to be reissued.

When a reissue application has been filed in an attempt to delete an earlier-obtained benefit claim under **35 U.S.C. 120**, it should be treated as follows:

(A) More than one "error" (as defined by **35 U.S.C. 251**) is described in a reissue declaration, and one of the errors identified is the failure to delete a **35 U.S.C. 120** benefit claim in the original patent, or the erroneous making of a claim for 35 U.S.C. 120 benefit.If one of the errors identified is the presence of the claim for **35 U.S.C. 120** benefit in the patent, and patentee (1) states a belief that this error renders the original patent wholly or partly inoperative or invalid, and (2) is seeking to eliminate this error via the reissue proceeding, the Office will permit deletion of the benefit claim in the continuity data and will not object to or reject the reissue declaration on these grounds. For applications filed on or after September 16, 2012, applicant may do so by filing a corrected application data sheet in compliance with 37 CFR 1.76(c) deleting the reference to the prior-filed application. For applications filed prior to September 16, 2012, applicant may do so by amending the specification (if the benefit claim is in the specification) or by submitting a supplemental new application data sheet in compliance with pre-AIA 37 CFR 1.76(c)(no supplemental declaration is necessary) to delete any references to prior applications. Assuming the reissue declaration appropriately identifies or describes at least one other error being corrected, the reissue declaration would not be objected to for failure to comply with the requirements of **37 CFR 1.175**.Where the reissue declaration states that the patentee is making this correction in order to extend the term of the original patent, the examiner's Office action will merely refer to the statement in the declaration and then point out with respect to such statement that **35 U.S.C. 251** only permits reissue "... for the unexpired part of the term of the original patent." (B) Only one "error" (as defined by **35 U.S.C. 251**) is described in a reissue declaration, and that error is the failure to delete a **35 U.S.C. 120** benefit claim in the original patent, or the erroneous making of a claim for **35 U.S.C. 120** benefit.

(1) If the only error identified in the reissue declaration is stated to be the correction or adjustment of the patent term by deleting the **35 U.S.C. 120** benefit claim, a rejection under **35 U.S.C. 251** should be made, based on the lack of an

appropriate error for reissue and failure to comply with **37 CFR 1.175**.

(2) If the only error identified in the reissue declaration is the need to delete a **35 U.S.C. 120** benefit claim, which the patentee seeks to now delete in the reissue application, (and no reference is made as to increasing the term of the patent), the examiner should not make a rejection under **35 U.S.C. 251** based on lack of an appropriate error for reissue and failure to comply with **37 CFR 1.175**. The examiner should examine the reissue application in accordance with **37 CFR 1.176** (**MPEP § 1440**). A statement should, however, be made in an Office action pointing out the lack of effect (of the change in the patent) on the patent term because **35 U.S.C. 251** only permits reissue "... for the unexpired part of the term of the original patent."

1406 Citation and Consideration of References Cited in Original Patent [R-08.2012]

In a reissue application, the examiner should consider all references that have been cited during the original prosecution of the patent, and list on a PTO-892 form any reference again cited/applied in the reissue application. See **MPEP § 1455**. It is noted that a referencecited in the original patent may no longer be relevant, e.g., in view of a narrowing of the claim scope in the reissue application, and therefore may not need to be listed on the PTO-892 form.

Should applicants wish to ensure that all of the references which were cited in the original patent are considered and cited in the reissue application, an information disclosure statement (IDS) in compliance with **37 CFR 1.97** and **1.98** should be filed in the reissue application. See **MPEP § 609**. The requirement for a copy of each U.S. patent or U.S. patent application publication listed in an IDS has been eliminated, unless required by the Office. **37 CFR 1.98(a)(2)** requires a legible copy of:

(A) each foreign patent;

(B) each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;

(C) for each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(D) all other information or that portion which caused it to be listed.

See **MPEP § 609.04(a)**. The Office imposes no responsibility on a reissue applicant to resubmit, in a reissue application, all the "References Cited" in the patent for which reissue is sought. Rather, applicant has a continuing duty under **37 CFR 1.56** to timely apprise the Office of any information which is material to the patentability of the claims under consideration in the reissue application. See **MPEP §1418**.

Where a copy of a reference other than a U.S. patent or U.S. patent application publication that was cited in the original patent is not available and cannot be obtained through any source other than the reissue applicant (who has not submitted the copy), the examiner will not consider that reference and therefore, will not list that reference on the PTO-892 form. If that reference was listed by the reissue applicant on a PTO/SB/08 form but a copy has not been provided, the examiner will line-through the reference to indicate that the reference has not been considered.

1407-1409 [Reserved]

1410 Content of Reissue Application [R-11.2013]

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 1.173 Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. No reissue 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, pursuant to **35 U.S.C. 251.**

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for

papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

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The specification (including the claims and any drawings) of the reissue application is the copy of the printed patent for which reissue is requested that is submitted by applicant as part of the initial application papers. The copy of the printed patent must be submitted in double column format, each page of double column format being on only one side of the piece of paper. It should be noted that a re-typed specification is not acceptable in a reissue application; the full copy of the printed patent must be used. In addition, an applicant for reissue is required to file a reissue oath or declaration which, in addition to complying with **37 CFR 1.63**, must comply with **37 CFR 1.175**. Where the patent has been assigned, the reissue applicant must also provide a consent of assignee to the reissue and evidence of ownership. Where the patent has not been assigned, the reissue applicant should affirmatively state that the patent is not assigned.

An amendment may be submitted at the time of filing of a reissue application. The amendment may be made either by:

(A) physically incorporating the changes within the specification by cutting the column of the printed patent and inserting the added material and rejoining the remainder of the column and then joining the resulting modified column to the other column of the printed patent. Markings pursuant to **37 CFR 1.173(d)** must be used to show the changes. The columnar structure of the printed patent must be preserved, and the physically modified page must comply with **37 CFR 1.52(a)(1)**. As to compliance with **37 CFR 1.52(a)(1)(iv)**, the "written either by a typewriter or machine printer in permanent dark ink or its equivalent" requirement is deemed to be satisfied where a caret and line are drawn from a position within the text to a newly added phrase, clause, sentence, etc. typed legibly in the margin; or

(B) providing a separate amendment paper with the reissue application.

In either case, the amendment must be made pursuant to **37 CFR 1.173(b)** and must comply with all the provisions of **37 CFR 1.173(b)– (e) and (g)**.

If the changes to be made to the patent are so extensive that reading and understanding the specification is extremely difficult and error-prone, a clean, typed copy of the specification may be submitted if accompanied by a grantable petition under **37 CFR 1.183** for waiver of **37 CFR 1.125(d)** and **37 CFR 1.173(a)(1)**.

Pursuant to **37 CFR 1.173(a)(1)**, applicant is required to include a copy of any disclaimer (**37 CFR 1.321**), certificate of correction (**37 CFR 1.322 – 1.324**), or reexamination certificate (**37 CFR 1.520**) issued in the patent for which reissue is requested. It should also be noted that **37 CFR 1.178(b)** requires reissue applicants to call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigation (litigation covers any papers filed in the court or issued by the court, such as, for example, motions, pleadings, and court decisions including court orders) and the results of such proceedings. This duty is a continuing duty, and runs from the time the reissue application is filed until the reissue application is abandoned or issues as a reissue patent.

It is no longer required that the reissue applicant physically surrender the original patent, see **MPEP § 1416**.

Where appropriate, the reissue applicant may provide a claim for priority/benefit under **35 U.S.C. 119** or **120**, and may also file an Information Disclosure Statement. For any reissue filed on or after September 16, 2012, the priority/benefit information must be in an application data sheet (ADS) under 37 CFR 1.76. An ADS is also required if an application under 35 U.S.C. 111(a) is made by a person other than the inventor under 37 CFR 1.46(a)

or if the oath or declaration does not identify the entire inventive entity.

The initial contents of a reissue application are discussed in detail in **MPEP § 1410.01** through **§ 1418**.

For expedited processing, new and continuing reissue application filings under **37 CFR 1.53(b)** may be addressed to: Mail Stop REISSUE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. Mail Stop REISSUE should only be used for the initial filing of reissue applications, and should not be used for any subsequently filed correspondence in reissue applications. Effective July 9, 2007, the Office began accepting reissue applications and "follow-on" papers (i.e., subsequent correspondence in reissue applications) submitted via the Office's Web-based electronic filing system (EFS-Web). See the "Legal Framework for EFS-Web" which may be accessed at: **www.uspto.gov/patents/process/file/efs/guidance/New_legal_framework.jsp**. When filing a reissue application electronically, an applicant should choose the "reissue" radio button. Regardless of the manner of filing, all new reissue filings should include a copy of a completed Reissue Patent Application Transmittal Form (PTO/AIA/50) to ensure that the filing of the new application will be recognized as a reissue application.

The oath or declaration, any matters ancillary thereto (such as the consent of assignee), and the basic filing fee, search fee, and examination fee may be submitted after the filing date pursuant to **37 CFR 1.53(f)**.

The assignee entity is established by a statement on behalf of all the assignees under **37 CFR 1.172(a)** and **37 CFR 3.73**. See **MPEP § 1410.01**.

Form PTO/AIA/50, Reissue Patent Application Transmittal, which may be used for filing reissue applications, is reproduced below.

PTO/AIA/50 (03-13)
Approved for use through 08/31/2013. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number

REISSUE PATENT APPLICATION TRANSMITTAL

Address to:

Mail Stop Reissue
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attorney Docket No.	
First Named Inventor	
Original Patent Number	
Original Patent Issue Date (Month/Day/Year)	
Express Mail Label No.	

APPLICATION FOR REISSUE OF:
(*Check applicable box*) ☐ Utility Patent ☐ Design Patent ☐ Plant Patent

APPLICATION ELEMENTS (37 CFR 1.173)

1. ☐ **Fee Transmittal Form** (PTO/SB/56)
2. ☐ **Applicant asserts small entity status.** See 37 CFR 1.27
3. ☐ **Applicant certifies micro entity status.** See 37 CFR 1.29. Applicant must attach form PTO/SB/15A or B or equivalent.
4. ☐ **Specification and Claims** in double column copy of patent format (*amended, if appropriate*)
5. ☐ **Drawing(s)** (*proposed amendments, if appropriate*)
6. ☐ **Reissue Oath/Declaration or Substitute Statement** (37 CFR 1.175) (PTO/AIA/05, 06, or 07)
7. ☐ **Application Data Sheet** NOTE: Benefit claims under 37 CFR 1.78 and foreign priority claims under 37 CFR 1.55 MUST be set forth in an Application Data Sheet (ADS).
8. ☐ **Original U.S. Patent currently assigned?** ☐ Yes ☐ No (*if Yes, check applicable box(es)*)
   - ☐ Written Consent of all Assignees (PTO/AIA/53)
   - ☐ 37 CFR 3.73(c) Statement (PTO/AIA/96)
9. ☐ **CD-ROM or CD-R** in duplicate, Computer Program (*Appendix*) or large table
   - ☐ Landscape Table on CD
10. **Nucleotide and/or Amino Acid Sequence Submission** (*if applicable, items a. – c. are required*)
    - a. ☐ Computer Readable Form (CRF)
    - b. ☐ Specification Sequence Listing on:
      - i. ☐ CD-ROM (2 copies) or CD-R (2 copies); **or**
      - ii. ☐ Paper
    - c. ☐ Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

11. ☐ **Statement of status and support for all changes to the claims.** See 37 CFR 1.173(c).
12. ☐ **Power of Attorney**
13. ☐ **Information Disclosure Statement (IDS)** PTOSB/08 or PTO-1449
    - ☐ Copies of citations attached
14. ☐ **English translation of Reissue Oath/Declaration** (*if applicable*)
16. ☐ **Return Receipt Postcard** (MPEP § 503) (Should be specifically itemized)
17. ☐ **Other:** _____

☐ This is a continuation reissue or divisional reissue application (*i.e.*, a second or subsequent reissue application for the same issued patent). (*Check box if applicable.*)

18. CORRESPONDENCE ADDRESS

☐ The address associated with Customer Number: _____ **OR** ☐ Correspondence address below

Name					
Address					
City		State		Zip Code	
Country		Telephone			
Email					
Signature				Date	
Name (Print/Type)				Registration No.	

This collection of information is required by 37 CFR 1.173. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Reissue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

1410.01 Reissue Applicant and Inventor's Oath or Declaration [R-11.2013]

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

[Editor Note: See subsection II., below, for reissue applications filed before September 16, 2012.]

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

*****

(c) APPLICABILITY OF THIS TITLE.— 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 or the application for the original patent was filed by the assignee of the entire interest.

*****

37 CFR 1.172 Reissue Applicant.

(a) The reissue applicant is the original patentee, or the current patent owner if there has been an assignment. A reissue application must be accompanied by the written consent of all assignees, if any, currently owning an undivided interest in the patent. All assignees consenting to the reissue must establish their ownership in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(c).

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

37 CFR 1.175 Reissue oath or declaration.

*****

(c) The inventor, or each individual who is a joint inventor of a claimed invention, in a reissue application must execute an oath or declaration for the reissue application, except as provided for in § 1.64, and except that the inventor's oath or declaration for a reissue application may be signed by the assignee of the entire interest if:

(1) The application does not seek to enlarge the scope of the claims of the original patent; or

(2) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

*****

For reissue applications filed on or after September 16, 2012, the reissue applicant is the original patentee, or the current patent owner, if there has been an assignment. However the inventor, or each individual inventor who is a joint inventor of a claimed invention, must execute an oath or declaration for the reissue application, except as otherwise provided in 37 CFR 1.175(c). A reissue applicant may file a supplemental statement in lieu of the inventor's oath or declaration as provided for in 37 CFR 1.64 (see MPEP § 604). In addition, the inventor's oath or declaration may be signed by the assignee of the entire interest if (a) the reissue application does not seek to enlarge the scope of the claims of the original patent (37 CFR 1.175(c)(1)), or (b) the application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest (37 CFR 1.175(c)(2)).

For continuation or divisional reissue applications, a copy of the inventor's oath or declaration from the earlier-filed reissue application may be used, provided that: (1) the inventor, or each joint inventor of a claimed invention, in the reissue application executed an inventor's oath or declaration for the earlier-filed reissue application, except as provided in 37 CFR 1.64; (2) the continuing reissue application does not seek to enlarge the scope of the claims of the original patent; or (3) the application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest. Depending on the circumstances, either Form PTO/AIA/05, Reissue Application Declaration by the Inventor, or Form PTO/AIA/06, Reissue Application Declaration by the Assignee, may be used to prepare a declaration in a reissue application. These forms are reproduced in MPEP § 1414, which includes addition information pertaining to reissue oaths or declarations.

II. REISSUE APPLICATION FILED BEFORE SEPTEMBER 16, 2012

[Editor Note: See subsection I., above, for reissue applications filed on or after September 16, 2012.]

35 U.S.C. 251 (pre-AIA) Reissue of defective 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.

*****

Pre-AIA 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.

For reissue applications filed before September 16, 2012, the reissue application must be made by the inventor or the person(s) applying for a patent in place of the inventor as provided in pre-AIA 37 CFR 1.42, 1.43, and 1.47 (see MPEP §§ 409.01(b) and 409.03 et seq.), except that the application for reissue may be 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. See pre-AIA 35 U.S.C. 251, third paragraph.

The reissue oath must be signed and sworn to by all the inventors, or declaration made by all the inventors, except as otherwise provided in **pre-AIA 37 CFR 1.42**, **1.43**, and **1.47**. Alternatively, pursuant to **pre-AIA 37 CFR 1.172**, where the reissue application does *not* seek to enlarge the scope of any of the claims of the original patent, the reissue oath may be made and sworn to, or declaration made, by the assignee of the entire interest. Depending on the circumstances, either Form PTO/SB/51, Reissue Application Declaration by the Inventor, or Form PTO/SB/52, Reissue Application Declaration by the Assignee, may be used to prepare a declaration in a reissue application. These forms are reproduced in **MPEP § 1414**, which includes additional information pertaining to reissue oaths or declarations.

If an inventor is to be added in a reissue application, a proper reissue oath or declaration including the signatures of all of the inventors is required, except where the assignee of the entire interest can properly sign the reissue oath or declaration. If one or more inventors are being deleted in a reissue application, an oath or declaration must be supplied over the signatures of the remaining inventors, except where the assignee of the entire interest can properly sign the reissue oath or declaration. Note that although an inventor being deleted in a reissue application need not sign the oath or declaration, if that inventor to be deleted has any ownership interest in the patent (e.g., that inventor did not assign away his/her rights to the patent), the signature of that inventor must be supplied in aconsent to to the filing of the reissue application. See MPEP § 1410.02 as to consent of assignee and § **1412.04** as to correction of inventorship via reissue.

1410.02 Assignee Consent to the Reissue [R-11.2013]

I. WRITTEN CONSENT

A reissue application, whether filed before, on, or after September 16, 2012, must be accompanied by the written consent of all assignees, if any, currently owning an undivided interest in the patent. In addition, all assignees consenting to the reissue must establish their ownership in the patent by filing in the reissue application a submission in accordance with the provisions of 37 CFR 3.73.

Where no assignee exists, applicant should affirmatively state that fact. This can be done by simply checking the "NO" box of item 8 of Form PTO/AIA/50 (for applications filed on or after September 16, 2012) or item 7 of Form PTO/SB/50 (for applications filed before September 16, 2012), which form may be signed by the inventors, or by a registered practitioner). If the file record is silent as to the existence of an assignee, it will be presumed that *an assignee does exist*. This presumption should be set forth by the examiner in the first Office action alerting applicant to the requirement. It should be noted that the mere filing of a written assertion of small entity status (see MPEP § 509.03) or a certification of micro entity status (see MPEP § 509.04) in no way relieves applicant of the requirement to affirmatively state that no assignee exists.

Where a written assertion of small entity status, a certification of micro entity status, or other paper in file indicates that the application/patent is assigned, and there is no consent by the assignee named in the written assertion of small entity status or the certification of micro entity status, the examiner should make inquiry into the matter in an Office action, even if the record otherwise indicates that the application/patent is not assigned.

The reissue oath or declaration must be accompanied by a written consent of all assignees. **35 U.S.C. 111(a)** and **37 CFR 1.53(b)** provide, however, for according an application a filing date if filed with a

specification, including claim(s), and any required drawings. Thus, where an application is filed without an oath or declaration, or without the consent of all assignees, if the application otherwise complies with **37 CFR 1.53(b)** and the reissue rules, the Office of Patent Application Processing (OPAP) will accord a filing date and send out a notice of missing parts setting a period of time for filing the missing part and for payment of any surcharge required under **37 CFR 1.53(f)** and **37 CFR 1.16(f)**. If the reissue oath or declaration is filed but the assignee consent is lacking, the surcharge is required because, until the consent is filed, the reissue oath or declaration is defective, since it is not apparent that the signatures thereon are proper absent an indication that the assignees have consented to the filing.

The consent of assignee must be signed by a party authorized to act on behalf of the assignee. For a discussion of parties authorized to act on behalf of the assignee. See **MPEP § 324** (for applications filed before September 16, 2012) and § 325 (for applications filed on or after September 16, 2012). The consent to the reissue application may use language such as:

> The XYZ Corporation, assignee of U.S. Patent No. 9,999,999, consents to the filing of reissue application No. 99/999,999 (or the present application, if filed with the initial application papers) for the reissue of U.S. Patent No. 9,999,999.
>
> _____
> Jane Doe
> Vice President,
> XYZ Corporation

Where the written consent of all the assignees to the filing of the reissue application cannot be obtained, applicant may under appropriate circumstances petition to the Office of Petitions (**MPEP § 1002.02(b)**) for a waiver under **37 CFR 1.183** of the requirement of **37 CFR 1.172**, to permit the acceptance of the filing of the reissue application. The petition fee under **37 CFR 1.17(f)** must be included with the petition.

The reissue application can then be examined, but will not be allowed or issued without the consent of all the assignees as required by **37 CFR 1.172**. See *Baker Hughes Inc. v. Kirk*, 921 F.Supp. 801, 809, 38 USPQ2d 1885, 1892 (D.D.C. 1995), N. B. Fassett, 1877 C.D. 32, 11 O.G. 420 (Comm'r Pat. 1877); *James D. Wright*, 1876 C.D. 217, 10 O.G. 587 (Comm'r Pat. 1876).

Where a **continuation** reissue application is filed with a copy of the assignee consent from the parent reissue application, and the parent reissue application is not to be abandoned, the copy of the consent should not be accepted. Other than the exception noted below, where a **divisional** reissue application is filed with a copy of the assignee consent from the parent reissue application, regardless of whether or not the parent reissue application is to be abandoned, the copy of the consent should not be accepted. The copy of the consent from the parent does not indicate that the assignee has consented to the addition of the new invention of the divisional reissue application to the original patent, or to the addition of the new error correction of the continuation reissue application. (Presumably, a new correction has been added via the continuation, because the parent is still pending.) As noted above, OPAP will accord a filing date and send out a notice of missing parts stating that there is no proper consent and setting a period of time for filing the missing part and for payment of any surcharge required under **37 CFR 1.53(f)** and **37 CFR 1.16(f)**. If, however, a divisional reissue application is being filed in response to a restriction requirement made in the parent reissue application, the assignee need not file a consent to the divided out invention now being submitted in the divisional application because consent has already been provided in the parent reissue application. See **MPEP § 1451**, Subsection I.

Where a continuation reissue application is filed with a copy of the assignee consent from the parent reissue application, and the parent reissue application is, or will be abandoned, the copy of the consent should be accepted by the Office.

Form paragraph 14.15 may be used to indicate that the consent of the assignee is lacking.

¶ *14.15 Consent of Assignee to Reissue Lacking*

This application is objected to under **37 CFR 1.172(a)** as lacking the written consent of all assignees owning an undivided interest in the

patent. The consent of the assignee must be in compliance with **37 CFR 1.172**. See **MPEP § 1410.01**.

A proper assent of the assignee in compliance with **37 CFR 1.172** and **3.73** is required in reply to this Office action.

Examiner Note:

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.

2. If a consent document/statement has been submitted but is insufficient (e.g., not by all the assignees) or is otherwise ineffective (e.g., a conditional consent, or a copy of the consent from the parent reissue application was filed in this continuation reissue application and the parent reissue application is not being abandoned), an explanation of such is to be included following this form paragraph.

3. If the case is otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

II. PROOF OF OWNERSHIP OF ASSIGNEE

The assignee that consents to the filing of the reissue application (as discussed above) must also establish that it is the assignee, *i.e.* , the owner, of the patent. See **37 CFR 1.172**. *Accordingly, a **37 CFR 3.73** paper establishing the ownership of the assignee should be submitted at the time of filing the reissue application, in order to support the consent of the assignee.* The assignee must establish its ownership in accordance with **37 CFR 3.73** by:

(A) filing in the reissue application documentary evidence of a chain of title from the original owner to the assignee; or

(B) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

Compliance with **37 CFR 3.73** may be provided as part of the same paper in which the consent by assignee is provided.

In connection with option (A) above, the submission of the documentary evidence to establish ownership must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owners to the assignee was, or concurrently is, submitted for recordation pursuant to **37 CFR 3.11**. Thus, when filing a **37 CFR 3.73** statement to establish ownership, an applicant or patent owner must also submit the relied-upon assignment document(s) to the Office for recordation, unless such a submission has already been previously made. If the **37 CFR 3.73** statement is not accompanied by a statement affirming that the documentary evidence was, or concurrently is, submitted for recordation pursuant to **37 CFR 3.11**, then the **37 CFR 3.73** statement will **not** be accepted, and the assignee(s) will not have established the right to take action in the patent application or the patent for which the **37 CFR 3.73** statement was submitted. This could result, for example, in an incomplete response, where a party stated to be the "assignee" signs a consent to the reissue to obviate a requirement for submission of assignee consent made in an Office action.

Upon initial receipt of a reissue application, the examiner should inspect the application to determine whether the submission under **37 CFR 1.172** and **37 CFR 3.73** establishing the ownership of the assignee is present and sufficient.

If an assignment document is attached with the **37 CFR 3.73** submission, the assignment should be reviewed to ensure that the named assignee is the same for the assignment document and the **37 CFR 3.73** statement, and that the assignment document is an assignment of the patent to be reissued to the assignee. If an assignment document is not attached with the **37 CFR 3.73** statement, but rather the reel and frame number where the assignment document is recorded in the USPTO is referenced in the **37 CFR 3.73** statement, it will be presumed that the assignment recorded in the USPTO supports the statement identifying the assignee. It will not be necessary for the examiner to obtain a copy of the recorded assignment document. If the submission under 37 CFR 1.172 and 37 CFR 3.73 is not present, form paragraph 14.16 may be used to indicate that the assignee has not provided evidence of ownership.

¶ *14.16 Failure of Assignee To Establish Ownership*

This application is objected to under **37 CFR 1.172(a)** as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by **37 CFR 1.172(a)***. The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See **MPEP § 1410.01**.

An appropriate paper satisfying the requirements of **37 CFR 3.73** must be submitted in reply to this Office action.

Examiner Note:

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.

2. If otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

Just as the consent of assignee must be signed by a party authorized to act on behalf of the assignee, the submission with respect to **37 CFR 3.73(b)** to establish ownership must be signed by a party 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)). For applications filed before September 16, 2012, the signature of an attorney or agent registered to practice before the Office is not sufficient, unless that attorney or agent is authorized to act on behalf of the assignee.

If the submission under **37 CFR 3.73(b)** to establish ownership is not signed by a party authorized tosign pursuant to 37 CFR 3.73, the appropriate paragraphs of form paragraphs 14.16.01 through 14.16.06 may be used.

¶ *14.16.01 Establishment of Ownership Not Signed by Appropriate Party*

This application is objected to under **37 CFR 1.172(a)** as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by* **37 CFR 1.172(a)**. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the assignee. See **37 CFR 3.73**.

A proper submission establishing ownership interest in the patent, pursuant to **37 CFR 1.172(a)**, is required in response to this action.

Examiner Note:

1. This form paragraph should be followed: by one of form paragraphs 14.16.02 through 14.16.04.fti, and then optionally by form paragraph 14.16.06.

2. See **MPEP § 1410.02**.

¶ *14.16.02 Failure To State Capacity To Sign*

The person who signed the submission establishing ownership interest has failed to state his/her capacity to sign for the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee. For reissue applications filed on or after September 16, 2012, the submission establishing ownership may be signed by a patent practitioner of record. See **37 CFR 3.73**; **MPEP § 325**.

Examiner Note:

1. This form paragraph is to be used when the person signing the submission establishing ownership interest does not state his/her capacity (e.g., as a recognized officer) to sign for the assignee, and is not established as being authorized to act on behalf of the assignee. For reissue applications filed on or after September 16, 2012, the submission establishing ownership may be signed by a patent practitioner of record (i.e., who has been given power in a power of attorney document in the file).

2. Use form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly sign a submission establishing ownership interest.

¶ *14.16.03 Lack of Capacity To Sign*

The person who signed the submission establishing ownership interest is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See **MPEP § 324** (for applications filed before September 16, 2012) and § 325 (for applications filed on or after September 16, 2012).

¶ *14.16.04.fti Attorney/Agent of Record Signs - Application Filed Before Sept. 16, 2012*

The submission establishing ownership interest was signed by applicant's **[1]**. For reissue applications filed before September 16, 2012, an attorney or agent of record is not authorized to sign a submission establishing ownership interest, unless he/she has been established as being authorized to act on behalf of the assignee. See **MPEP § 324**.

Examiner Note:

1. This form paragraph is to be used in reissue applications filed before September 16, 2012, when the person signing the submission establishing ownership interest is an attorney or agent of record who is not an authorized officer as defined in **MPEP § 324** and has not been established as being authorized to act on behalf of the assignee. For reissue applications filed on or after September 16, 2012, the submission may be signed by a patent practitioner of record. See **37 CFR 3.73(d)(3)**.

2. Use form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly sign a submission establishing ownership interest.

3. In bracket 1, insert either --attorney-- or --agent--.

¶ *14.16.06 Criteria To Accept When Signed by a Non-Recognized Officer*

It would be acceptable for a person, other than a recognized officer, to sign a submission establishing ownership interest, provided the record for the application includes a duly signed statement that the person is empowered to sign a submission establishing ownership interest and/or act on behalf of the assignee.

Accordingly, a new submission establishing ownership interest which includes such a statement above, will be considered to be signed by an appropriate official of the assignee. A separately filed paper referencing the previously filed submission establishing ownership interest and containing a proper empowerment statement would also be acceptable.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.16.02, 14.16.03 or 14.16.04.fti.

2. When one of form paragraphs 14.16.02, 14.16.03 or 14.16.04.fti is used to indicate that a submission establishing ownership interest is not proper because it was not signed by a recognized officer, this form paragraph should be used to point out one way to correct the problem.

3. While an indication of the person's title is desirable, its inclusion is not mandatory when this option is employed.

Where the submission establishes the assignee's ownership as to the patent, the assignee's ownership as to the reissue application will be presumed. Accordingly, a submission as to the ownership of the patent will be construed to satisfy the **37 CFR 1.172** (and **37 CFR 3.73**) requirements for establishing ownership of the application. Thus, a terminal disclaimer can be filed in a reissue application where ownership of the patent has been established, without the need for a separate submission under **37 CFR 3.73** showing ownership of the reissue application. However, if there is a submission under 37 CFR 3.73 present in the patent file, but there is no copy in the reissue application file, a copy of the submission under **37 CFR 3.73** for the patent must be submitted in the reissue file.

Even if the submission states that it is establishing ownership of the reissue application (rather than the patent), the submission should be accepted by the examiner as also establishing ownership in the patent. The documentation in the submission establishing ownership of the reissue application must, of necessity, include chain of title as to the patent.

III. COMPARISON OF ASSIGNEE THAT CONSENTS TO ASSIGNEE SET FORTH IN SUBMISSION ESTABLISHING OWNERSHIP INTEREST

The examiner must inspect both the consent and documentary evidence of ownership to determine whether the requirements of **37 CFR 1.172** have been met. The assignee identified by the documentary evidence must be the same assignee which signed the consent. Also, the person who signs the consent for the assignee and the person who signs the submission of evidence of ownership for the assignee must both be persons having authority to do so. See also **MPEP §§ 324** and **325**.

The reissue patent will be granted to the original patentee, his or her legal representatives or assigns as the interest may appear.

1411 Form of Specification [R-11.2013]

37 CFR 1.173 Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application*. An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. No reissue 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, pursuant to **35 U.S.C. 251**.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § **1.52**. Additionally, a copy of any disclaimer (§ **1.321**), certificate of correction (§§ **1.322** through **1.324**), or reexamination certificate (§ **1.570**) issued in the patent must be included. (See also § **1.178**).

(2) *Drawings* . Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § **1.84**, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

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Pursuant to **37 CFR 1.173(a)(1)** the application specification, including the claims, must be furnished in the form of a copy of the printed patent in double column format (so that the patent can be simply copied without cutting). Applicants are required to submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed (**37 CFR 1.173(a)(2)**). Any changes to the drawings must be made in accordance with **37 CFR 1.173(b)(3)**. Thus, a full copy of the printed patent (including the front page) is used to provide the abstract, drawings, specification, and claims of the patent for the reissue application. Each page of the patent must appear on only one side of each individual page of the specification of the reissue application; a two-sided copy of the patent is not proper. It should be noted that a re-typed specification is not acceptable in a reissue application; the full copy of the printed patent must

be used. If, however, the changes to be made to the patent are so extensive/numerous that reading and understanding the specification is extremely difficult and error-prone, a clean copy of the specification may be submitted if accompanied by a grantable petition under **37 CFR 1.183** for waiver of **37 CFR 1.125(d)** and **37 CFR 1.173(a)(1)**.

Pursuant to **37 CFR 1.173(b)**, amendments may be made **at the time of filing** of a reissue application. The amendment may be made either by:

(A) physically incorporating the changes within the specification by cutting the column of the printed patent and inserting the added material and rejoining the remainder of the column and then joining the resulting modified column to the other column of the printed patent. Markings pursuant to **37 CFR 1.173(d)** must be used to show the changes. The columnar structure of the printed patent must be preserved, and the physically modified page must comply with **37 CFR 1.52(a)(1)**. As to compliance with **37 CFR 1.52(a)(1)(iv)**, the "written either by a typewriter or machine printer in permanent dark ink or its equivalent" requirement is deemed to be satisfied where a caret and line are drawn from a position within the text to a newly added phrase, clause, sentence, etc. typed legibly in the margin; or

(B) providing a preliminary amendment (a separate amendment paper) directing that specified changes be made to the copy of the printed patent.

The presentation of the insertions or deletions as part of the original reissue specification is an amendment under **37 CFR 1.173(b)**. An amendment of the reissue application made at the time of filing of the reissue application must be made in accordance with **37 CFR 1.173(b)-(e) and (g)**; see **MPEP § 1453**. Thus, as required by **37 CFR 1.173(c)**, an amendment of the claims made at the time of filing of a reissue application must include a separate paper setting forth the status of all claims (i.e., pending or canceled), and an explanation of the support in the disclosure of the patent for the changes made to the claims.

If a chart, table, or chemical formula is amended and it spans two columns of the patent, it should not be split. Rather, the chart, table, or chemical formula should be provided in its entirety *as part of the column of the patent to which it pertains*, in order to provide a continuity of the description. When doing so, the chart, table, or chemical formula may extend beyond the width of the column. Change in only a part of a word or chemical formula is not permitted. Entire words or chemical formulas must be shown as being changed. Deletion of a chemical formula should be shown by brackets which are substantially larger and darker than any in the formula.

Where a terminal disclaimer was filed in the application for the patent to be reissued, a copy of that terminal disclaimer is not needed in the reissue application file. To identify this information, an internal review form will be filled out at the appropriate point and placed into the file for the reissue application.

Twice reissued patent:

Examples of the form for a twice-reissued patent are found in Re. 23,558 and Re. 28,488. Double underlining and double bracketing are used in the second reissue application, while **bold**-faced type and double bracketing appear in the printed patent (the second reissue patent) to indicate further insertions and deletions, respectively, in the second reissue patent.

When a copy of a first reissue patent is used as the specification of a second reissue application (filed as a reissue of a reissue), additions made by the first reissue will already be printed in italics, and should remain in such format. Thus, applicants need only present additions to the specification/claims in the second reissue application as double underlined text. Subject matter to be deleted from the first reissue patent should be presented in the second reissue application within sets of double brackets.

1411.01 Certificate of Correction or Disclaimer in Original Patent [R-08.2012]

The applicant should include any changes, additions, or deletions that were made by a Certificate of Correction to the original patent grant in the reissue application without underlining or bracketing. This includes changes made by a Certification of Correction dated before the filing of the reissue

application or dated during the pendency of the reissue application. The examiner should make certain that all Certificate of Correction changes in the patent have been properly incorporated into the reissue application.

Certificate of Correction changes and disclaimer of claim(s) under **37 CFR 1.321(a)** should be made without using underlining or brackets. Because these are retroactively a part of the original patent and are made before the reissue application will issue as a patent, they must show up in the printed reissue patent document as part of the original patent, i.e., not in italics or bracketed. If the changes are submitted improperly with underlining and brackets, the examiner will require correction by the applicant in the form of a replacement paragraph (or paragraphs) without such markings. If the changes are extensive, a clean copy of the specification with the Certificate of Correction changes in it may be required by the examiner after consulting with his/her supervisor. For the clean copy of the specification to be entered as a substitute specification, the reissue applicant must file a grantable petition under **37 CFR 1.183** for waiver of **37 CFR 1.125(d)** and **37 CFR 1.173(a)(1)**. The examiner's requirement for the clean copy will generally serve as sufficient basis for granting the petition.

1411.02 New Matter [R-11.2013]

New matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with **35 U.S.C. 251**.

The claims in the reissue application must be for subject matter which the applicant had the right to claim in the original patent. *Any* change in the patent made via the reissue application should be checked to ensure that it does not introduce new matter. Note that new matter may exist by virtue of the omission of a feature or of a step in a method. See *United States Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 53 USPQ 6 (1942).

Form paragraph 14.22.01 may be used where new matter has been added anywhere in "the application for reissue" as prohibited by **35 U.S.C. 251**.

¶ *14.22.01 Rejection, 35 U.S.C. 251, New Matter*

Claim **[1]** rejected under **35 U.S.C. 251** as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows: **[2]**

Examiner Note:

1. In bracket 2, fill in the applicable page and line numbers and provide an explanation of your position, as appropriate.

2. A rejection under **35 U.S.C. 112(a)** or **pre-AIA 35 U.S.C. 112**, first paragraph, should also be made if the new matter is added to the claims or is added to the specification and affects the claims. If new matter is added to the specification and does not affect the claims, an objection should be made based upon **35 U.S.C. 132** using form paragraph 7.28.

1412 Content of Claims [R-08.2012]

The content of claims in a reissue application is somewhat limited, as is indicated in **MPEP § 1412.01** through **MPEP § 1412.03**.

1412.01 Reissue Claims Must Be for Same General Invention [R-08.2012]

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**. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective intent manifested by the **original patent**." *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added); See also *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The "original patent" requirement of **35 U.S.C. 251** must be understood in light of *In re Amos*, *supra*, where the Court of Appeals for the Federal Circuit stated:

> We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed,

> not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

953 F.2d at 618-19, 21 USPQ2d at 1275. Claims presented in a reissue application are considered to satisfy the requirement of **35 U.S.C. 251** that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that **35 U.S.C. 112**, first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

The presence of some disclosure (description and enablement) in the original patent should evidence that applicant intended to claim or that applicant considered the material now claimed to be his or her invention.

The original patent specification would indicate an intent not to claim the subject matter of the claims presented in the reissue application in a situation analogous to the following:

The original patent specification discloses that composition X is not suitable (or not satisfactory) for molding an item because composition X fails to provide quick drying. The patent issues with claims directed only to composition Y. After the patent issues, it is found that composition X would be desirable for the molding in spite of the failure to provide quick drying, because of some other newly recognized benefit from composition X. The addition of a claim to composition X or a method of use thereof would not be permitted in a reissue application, because the original patent specification contained an explicit statement of intent *not* to claim composition X or a method of use thereof. One should understand, however, that the mere failure to claim a disclosed embodiment in the original patent (absent an explicit statement in the original patent specification of unsuitability of the embodiment) would **not** be grounds for prohibiting a claim to that embodiment in the reissue.

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

Where a restriction (or an election of species) requirement was made in an application and applicant permitted the elected invention to issue as a patent without filing a divisional application on the non-elected invention(s), the non-elected invention(s) cannot be recovered by filing a reissue application. A reissue applicant's failure to timely file a divisional application covering the non-elected invention(s) in response to a restriction (or an election of species) requirement is not considered to be error causing a patent granted on the elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Accordingly, this is not correctable by reissue of the original patent under 35 U.S.C. 251. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977); See also *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978). In this situation, the reissue claims should be rejected under 35 U.S.C. 251 for lack of defect in the original patent and lack of error in obtaining the original patent. Compare with *In re Doyle*, 293 F.3d 1355, 63 USPQ2d 1161 (Fed. Cir. 2002) where the court permitted the patentee to file a reissue application to present a so-called linking claim, a claim broad enough to read on or link the invention elected (and patented) together with the invention not elected.

The non-elected invention(s) were inadvertently not filed as a divisional application.

1412.02 Recapture of Canceled Subject Matter [R-11.2013]

A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. *Greenliant Systems, Inc. v. Xicor LLC*, 692 F.3d 1261, 103 USPQ2d 1951 (Fed. Cir. 2012); *In re Mostafazadeh*, 643 F.3d 1353, 98 USPQ2d 1639 (Fed. Cir. 2011); *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005); *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); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960). The question as to whether a reissue patent violates the rule against recapture of subject matter surrendered during original prosecution is a question of law. *Mostafazadeh*, 643 F.3d at 1358, 98 USPQ2d at 1642.

I. THREE STEP TEST FOR RECAPTURE:

In *Clement*, 131 F.3d at 1468-70, 45 USPQ2d at 1164-65, the Court of Appeals for the Federal Circuit set forth a three step test for recapture analysis. In *North American Container*, 415 F.3d at 1349, 75 USPQ2d at 1556, the court restated this test as follows:

> 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.

In *North American Container*, the court cited *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600; *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; and *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164-65 as cases that lead to, and explain the language in, the *North American Container* recapture test.

A. The First Step - Was There Broadening?

In every reissue application, the examiner must first review each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim; see **MPEP § 1412.03** for guidance as to the nature of a "broadening claim." If the reissue claim is not broadened in any respect as compared to the patent claims, the analysis ends; there is no recapture.

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

Where a claim in a reissue application is broadened in some respect as compared to the patent claims, the examiner must next determine whether the broadening aspect(s) of that reissue claim relate(s) to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). The "original application" includes the patent family's entire prosecution history. *MBO Laboratories, Inc. v. Becton, Dickinson & Co.*, 602 F.3d 1306, 94 USPQ2d 1598 (Fed. Cir. 2010). Each limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination. This involves two sub-steps:

1. The Two Sub-Steps:

(A) One must first determine whether applicant surrendered any subject matter in the prosecution of

the original application that became the patent to be reissued.If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant. The reliance by applicant to define the original patent claims over the art can be by presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art. To determine whether such reliance occurred, the examiner must review the prosecution history of the original application file (of the patent to be reissued) for surrender of claimed subject matter which may result in recapture. The prosecution history includes the rejections and applicant's arguments made therein.With respect to whether applicant surrendered any subject matter, it is to be noted that a patent owner (reissue applicant) is bound by the argument that applicant relied upon to overcome an art rejection in the original application for the patent to be reissued, regardless of whether the Office adopted the argument in allowing the claims. *Greenliant Systems, Inc. v. Xicor LLC*, 692 F.3d 1261, 1271, 103 USPQ2d 1951, 1958 (Fed. Cir. 2012). As pointed out by the court, "[i]t does not matter whether the examiner or the Board adopted a certain argument for allowance; the sole question is whether the argument was made." *Id.*If applicant did not surrender any subject matter in the prosecution of the original application, the analysis ends and there is no recapture.

(B) If applicant did surrender subject matter in the original application prosecution, the examiner must then determine whether any of the broadening of the reissue claims is in the area of the surrendered subject matter. The examiner must analyze all of the broadening aspects of the reissue claims to determine if any of the omitted/broadened limitation(s) are directed to limitations relied upon by applicant in the original application to make the claims allowable over the art.

With respect to the "second step" in the recapture analysis, it is to be noted that if the reissue claim(s), are broadened with respect to thepreviously surrendered subject matter, then recapture will be present regardless of other unrelated narrowing limitations. In the decision of *In re Mostafazadeh*, 643 F.3d 1353, 98 USPQ2d 1639 (Fed. Cir. 2011), the Federal Circuit stated:

> [T]he recapture rule is violated when a limitation added during prosecution is eliminated entirely, even if other narrowing limitations are added to the claim. If the added limitation is modified but not eliminated, the claims must be materially narrowed relative to the surrendered subject matter such that the surrendered subject matter is not entirely or substantially recaptured. *Id.* at 1361.

But the focus in the analysis of the second step must be on the subject matter that was surrendered during the original application prosecution in the context of the then-existing claims, not separate inventions/embodiments/species, which do not even trigger a recapture analysis.

In the decision of *In re Youman*, 679 F.3d 1335, 102 USPQ2d 1862 (Fed. Cir. 2012), the Federal Circuit explained:

> Whereas the recapture rule applies when surrendered subject matter is being reclaimed, overlooked aspects by definition were never claimed and thus never surrendered. *See Mostafazadeh*, 643 F.3d at 1360 [98 USPQ2d at 1644]. Rather, as we explained in *Mostafazadeh*, "overlooked aspects" is a separate inquiry under reissue that is independent of whether or not the recapture rule applies.

679 F.3d at 1347, 102 USPQ2d at 1870.

Note the following examples illustrating the above:

> Assume that, in the original prosecution of the patent, applicant claimed a method of making a glass lens, where the ion implantation step used a molten bath to diffuse ions into the lens, and that step was amended to recite a pressure of 50-60 PSI and temperature between 150-200 degrees C - to define over the art. That pressure and temperature range-set is "frozen" in place for any molten bath ion implantation claim, and

> it cannot be deleted or broadened by reissue. However, if in the original application, applicant had failed to claim a disclosed embodiment to plasma ion implantation (i.e., using a plasma stream rather than a molten bath to provide the ions), that is a proper 35 U.S.C. 251 error, which can be corrected by reissue. Applicant can, in a reissue application, add a set of claims to plasma ion implantation, without including the "50-60 PSI and temperature between 150-200 degrees C" limitation. The "50-60 PSI - 150-200 degrees C limitation" is totally irrelevant to plasma implantation. Also, if in the original application, applicant failed to claim the method of placing two lenses made by the invention in a specified series to modulate a laser for cutting chocolate, that too is a proper 35 U.S.C. 251 error, which can be corrected by reissue. In this lens placement method, it does not matter how the specific lens having the implanted ion gradient was made, and the "50-60 PSI and temperature between 150-200 degrees C" limitation is again not relevant. Hester Industries, Inc. v. Stein, Inc., supra, 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.

142 F.3d at 1482-83, 46 USPQ2d at 1649-50. (Emphasis added)

See also *B.E. Meyers & Co. v. United States*, 47 Fed.Cl. 200, 56 USPQ2d 1110 (Fed. Cl. 2000), where the Court of Federal Claims permitted the complete removal of a limitation that was added to obtain the patent, where the replacement limitation provided a separate invention.

2. Examples of the Second Step Analysis:

(A) Example (1) - Argument without amendment:

In *Hester*, *supra*, the Federal Circuit held that the surrender that forms the basis for impermissible recapture "can occur through arguments alone". 142 F.3d at 1482, 46 USPQ2d at 1649. For example, assume that limitation A of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. If the omitted limitation A was argued in the original application to make the application claims allowable over the art in the application, then the omitted limitation relates to subject matter previously surrendered in the original application, and recapture will exist. Accordingly, where claims are broadened in a reissue application, the examiner should review the prosecution history of the original patent file for recapture, <u>even where the claims were never amended</u> during the prosecution of the application which resulted in the patent. Note: The argument that the claim limitation defined over the rejection must have been specific as to the limitation relied upon, rather than a general statement regarding the claims as a whole. A general "boiler plate" sentence in the original application will not, by itself, be sufficient to establish surrender and recapture.

An example of a general "boiler plate" sentence of argument is:

> In closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable.

An argument that merely states that all the limitations of the claims define over the prior art will also not, by itself, be sufficient to establish surrender and recapture. An example is:

> Claims 1-5 set forth a power-train apparatus which comprises the combination of A+B+C+D+E. The prior art of record does not disclose or otherwise teach, providing a material-transfer apparatus as defined by the limitations of claim 1, including an A member

and a B member, both connected to a C member, with all three being aligned with the D and E members.

This statement is simply a restatement of the entirety of claim 1 as allowed. No measure of surrender could be gleaned from such a statement of reasons for allowance. See *Ex parte Yamaguchi*, 61 USPQ2d 1043 (Bd. Pat. App. & Inter. 2001)(reported but unpublished, precedential).

In both of the above examples, the argument does not provide an indication of what specific limitations, e.g., specific element or step of the claims, cooperative effect, or other aspect of the claims, are being relied upon for patentability. Thus, applicant has not surrendered anything.

(B) Example (2) - Amendment of the claims without argument:

The limitation omitted in the reissue claim(s) was added in the original application claims for the purpose of making the application claims allowable over a rejection or objection made in the application. Even though applicant made no argument on the record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection. This too will establish the omitted limitation as relating to subject matter previously surrendered. To illustrate this, note the following example:

The original application claims recite limitations A+B+C, and the Office action rejection combines two references to show A+B+C. In the amendment replying to the Office action, applicant adds limitation D to A+B+C in the claims, but makes no argument as to that addition. The examiner then allows the claims. Even though there is no argument as to the addition of limitation D, it must be presumed that the D limitation was added to obviate the rejection. The subsequent deletion of (omission of) limitation D in the reissue claims would be presumed to be a broadening in an aspect of the reissue claims related to surrendered subject matter. Accordingly, the reissued claims would be barred by the recapture doctrine. The above result would be the same whether the addition of limitation D in the original application was by way of applicant's amendment or by way of an examiner's amendment with authorization by applicant.

(C) Example (3) - Who can make the surrendering argument?

Assume that the limitation A omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue.

Ex parte Yamaguchi, *supra*, held that a surrender of claimed subject matter cannot be based solely upon an applicant's failure to respond to, or failure to challenge, an examiner's statement made during the prosecution of an application. Applicant is bound only by applicant's revision of the application claims or a positive argument/statement by *applicant*. An applicant's failure to present on the record a counter statement or comment as to an examiner's reasons for allowance does not give rise to any implication that applicant agreed with or acquiesced in the examiner's reasoning for allowance. Thus, the failure to present a counter statement or comment as to the examiner's statement of reasons for allowance does <u>not</u> give rise to any finding of surrender. **The examiner's statement of reasons for allowance in the original application cannot, *by itself*, provide the basis for establishing surrender and recapture**.

It is only in the situation where applicant does file comments on the statement of reasons for allowance, that surrender <u>may have</u> occurred. Note the following two scenarios in which an applicant files comments:

Scenario 1- There is Surrender: The examiner's statement of reasons for allowance in the original application stated that it was limitation C (of the combination of ABC) which distinguished over a potential combining

of references X and Y, in that limitation C provided increased speed to the process. Applicant filed comments on the examiner's statement of reasons for allowance essentially supporting the examiner' s reasons. The limitation C is thus established as relating to subject matter previously surrendered.

Scenario 2- There is No Surrender: On the other hand, if applicant's comments on the examiner's statement of reasons for allowance contain a counter statement that it is limitation B (of the combination of ABC), rather than C, which distinguishes the claims over the art, then limitation B would constitute surrendered subject matter, and limitation C has not been surrendered.

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

As pointed out above, the third prong of the recapture determination set forth in *North American Container* considers the significance of the claim limitations that were added and deleted, during prosecution of the patent (to be reissued) to determine whether the reissue claims should be barred as recapture.

The following discussion addresses analyzing the reissue claims, and *which claims* are to be compared to the reissue claims in determining the issue of surrender (for reissue recapture).

When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. If the reissue claim "fails" either analysis, recapture exists.

First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad as, or broader in scope than any claim that was canceled or amended in the original prosecution to define over the art. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

Second, it must be determined whether the reissue claim omits or broadens any limitation that was added or argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it is accompanied by other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. *Pannu*, 258 F.3d at 1371-72, 59 USPQ2d at 1600. In any broadening reissue application, the examiner will determine, on a claim-by-claim basis, whether the broadening in the reissue application claim(s) relates to subject matter that was surrendered during the examination of the patent for which reissue is requested) by an amendment narrowing claim scope in order to overcome a rejection and/or argument relying on a claim limitation in order to overcome a rejection.

A) If surrendered subject matter has been entirely eliminated from a claim present in the reissue application, then a recapture rejection under **35 U.S.C. 251** is proper and must be made for that claim. Stated another way, if a claim limitation present in the original patent that was added to overcome a rejection or that was argued by applicant to distinguish over the prior art is entirely eliminated from a claim in the reissue application, then a recapture rejection under 35 U.S.C. 251 is proper and must be made for that claim.

B) If the surrendered subject matter has not been entirely eliminated from a claim in the reissue application (i.e., the amendment narrowing the claim or the argued limitation has not been entirely eliminated from the claim in the reissue application), but rather it has been made less restrictive in the reissue application claim (such that the claim is broadened), the analysis (based on *In re Mostafazadeh*, 643 F.3d 1353, 98 USPQ2d 1639 (Fed. Cir. 2011) and *In re Youman*, 679 F.3d 1335, 102 USPQ2d 1862 (Fed. Cir. 2012)) is as follows:

It must be determined what portion of the amendment or argued limitation has been retained, and whether the retained portion materially narrows the original claims to avoid recapture. See *Youman*, 679 F.3d at 1346 n.4, 102 USPQ2d at 1870 n.4

("'original claims' are defined as 'the claims before surrender'"). "[I]f the patentee modifies the added [or argued] limitation such that it is broader than the patented claim yet still materially narrows relative to the original claim, the recapture rule does not bar reissue." *Id.* at 1347, 102 USPQ2d at 1870. On the other hand, if the retained portion of the modified limitation is "well known in the prior art," impermissible recapture has not been avoided. See *Mostafazadeh*, 643 F.3d at 1361, 98 USPQ2d at 1644. It is to be noted that if the portion of the modified limitation is well known in the prior art, then impermissible recapture exists, even in a case where a further limitation which is not related to the surrendered subject matter (i.e., a limitation that does not materially narrow the claims) has been added to define the claims over the art. *Id.*

Even "[i]f the modified limitation does not materially narrow (or, in other cases, the limitation is eliminated)," it may be that "the reissued claims were materially narrowed in other respects so that the claims have not been enlarged, and hence avoid the recapture rule." *Youman*, 679 F.3d at 1347, 102 USPQ2d at 1870. In other words, even if the modified limitation does not materially narrow, the reissue applicant may have added a new limitation that still relates to surrendered subject matter. The material narrowing must relate to what was argued by applicant in the original application, to define the claim over the art. *Greenliant Systems, Inc. et al v. Xicor LLC*, 692 F.3d 1261, 1271, 103 USPQ2d 1951, 1958 (Fed. Cir. 2012). If the reissue applicant believes that "the reissued claims were materially narrowed in other respects," the reissue applicant should point out explicitly what limitation has been added to the claims to materially narrow and how it materially narrows the claims.

The following discussion is provided for analyzing the reissue claims.

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

DEFINITIONS:

"Canceled claims," in the context of recapture case law, are claims canceled from the original application to obtain the patent for which reissue is now being sought. The claims

(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). The "replacement claims" can be new claims which are narrower than the canceled claims, or can be the same claims amended to be narrower than the canceled version of the claims.

"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. For the sake of simplification, this limitation will be referred to throughout this section as the *surrender-generating limitation*.

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

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 at 1436, 221 USPQ at 295.

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

If the reissue claims are equal in scope to, or narrower than, the claims of the original patent (as opposed to the claims "canceled from the application") in all aspects, then there can never be recapture. The discussion that follows is not directed to that situation. It is rather directed to the situation where the *reissue claims are narrower than the claims 'canceled' from the application in some aspect, but are broader than the claims of the original patent in some other aspect*.

If the reissue claims are narrower in scope than the claims canceled from the original application by inclusion of *the entirety of the limitation added to define the original application claims over the art*, there will be no recapture, even if the reissue claims are broader than the canceled claims in some other

aspect (i.e., an aspect not related to the surrender made in the original application).

Assume combination AB was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABC (after which the patent issued). The reissue claims are then directed to combination $AB_{broadened}C$. The $AB_{broadened}C$ claims are *narrower* in scope when compared with the canceled claim subject matter AB *with respect to the addition of C* (which was added in the application to overcome the art), and they retain surrender-generating limitation C; thus, there is no recapture.

As another example, assume combination ABZ was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABZC (after which the patent issued). The reissue claims are then directed to combination ABC (i.e., element Z is deleted from the canceled claims, while element C remains present). The ABC claims of the reissue are *narrower* in scope as compared to the canceled-from-the-original-application claim subject matter ABZ *with respect to the addition of C* (which was added in the application to overcome the art), and they retain surrender-generating limitation C; thus, there is no recapture.

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

The "patent claims," in the context of recapture case law, are claims that issued in the original patent for which reissue is now being sought. As pointed out above, where the reissue claims are narrower than the claims of the original patent in all aspects, then there can never be recapture. If reissue claims are equal in scope to the patent claims, there is no recapture as to those reissue claims. Where, however, reissue claims are both broadened and narrowed as compared with the original 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. If the claims are "broader than they are narrower in a manner directly pertinent to the subject matter... surrendered during prosecution" (*Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166), then recapture will bar the claims. This narrowing/broadening *vis-à-vis* the patent is broken down into four possibilities that will now be addressed.

If a claim is presented in a reissue application that omits, in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under **35 U.S.C. 251**. Note, however, subsection V., below, "REBUTTAL BY THE REISSUE APPLICANT," which points out how the recapture finding of the Office can be rebutted by applicant, in some limited instances, by showing that material narrowing is present in the 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:

In this case, there is recapture.

This situation is where the patent claims are directed to combination ABC and the reissue claims are directed to ABD. 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). Thus, addition of C (and/or argument as to C) has resulted in the surrender of any combination of A & B that does not include C; this is the surrendered subject matter. Element D, on the other hand, is not related to the surrendered subject matter. Thus, the reissue claim, which no longer contains C, is broadened in an area related to the surrender, and the narrowing by the addition of D does not save the claim from recapture because D is not related to the surrendered subject matter.

Reissue claims that are broader than the original patent claims by not including the surrender-generating limitation (element C, in the example given) will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is

broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu*, 258 F.3d 1366, 59 USPQ2d 1597, provides a fact situation in which this scenario was held to be recapture.

(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:

In this case, there is no recapture.

This situation is where the patent claims are directed to combination ABCDE and the reissue claims are directed to ABDE (element C is omitted). Assume that the combination of ABCD was present in the original application as it was filed, and element E was later added to define over that art. No argument was ever presented as to elements A-C defining over the art.

In this situation, the ABCDE combination of the patent can be broadened (in the reissue application) to omit element C, and thereby claim the combination of ABDE, where element E (the surrender generating limitation) is not omitted. There would be no recapture in this instance. (If an argument had been presented as to element C defining over the art, in addition to the addition of element E, then the ABCDE combination could not be broadened to omit element C and thereby claim combination of ABDE. This would be recapture; see the above discussion as to surrender and recapture based upon argument.)

Additionally, the reissue claims are certainly permitted to recite combination $ABDE_{specific}$ (where surrender-generating element E is narrowed). The patent claims have been broadened in an area not directed to the surrender (by omitting element C) and narrowed in the area of surrender (by narrowing element E to $E_{specific}$). This is clearly permitted.

As another example, assume limitation C was added to application claims AB to obtain the patent to ABC, and now the reissue application presents claims to AC or $AB_{broad}C$. Such reissue claims avoid the effect of the recapture rule because they are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). Such claims are considered to be broader in an aspect not "germane to a prior art rejection," and thus are not barred by recapture. Note *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

Reissue claims that are broader than the original patent claims by deletion of a limitation or claim requirement other than the "surrender-generating limitation"will avoid the effect of the recapture rule, regardless of the nature of the narrowing in the claims, and even if the claims are not narrowed at all from the scope of the patent claims.

(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:

In this instance, there is clearly no recapture. In the reissue application, there has been no change in the claims related to the matter surrendered in the original application for the patent.

In this instance, element C was added to the AB combination to provide ABC and define over the art, and the patent was issued. The reissue omits element B and adds element Z, to thus claim ACZ. There is no recapture because the surrender generating element C has not been modified in any way. (Note, however, that if, when element C was added to AB, applicant argued that the association of newly added C with B provides a synergistic (unexpected) result to thus define over the art, then neither element B nor element C could be omitted in the reissue application.)

(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:

In this case, there may be recapture.

Assume the combination AB was originally claimed in the application, and was amended in reply to an art rejection to add element C and thus provide the combination ABC (after which the patent issued). A reissue application is then filed, and the reissue application claims are directed to the combination $ABC_{broadened}$. The $ABC_{broadened}$ claims are narrowed in scope when compared with the canceled claim subject matter AB, because of the addition of $C_{broadened}$. Thus, the claims retain, in broadened form, the limitation argued/added to overcome art rejection in original prosecution. In this instance, a recapture rejection can be made even though $ABC_{broadened}$ is narrower than canceled claim subject matter AB , but only if $C_{broadened}$ was "well known in the prior art". See *In re Mostafazadeh*, 643 F.3d 1353, 1361, 98 USPQ2d 1639, 1644 (Fed. Cir. 2011). On the other hand, "if the patentee modifies the added limitation such that it is broader than the patented claim yet still materially narrows relative to the original claim, the recapture rule does not bar reissue." *In re Youman et al*, 679 F.3d 1335, 1347, 102 USPQ2d 1862, 1870 (Fed. Cir. 2012). Any recapture of surrendered subject matter that was in prior art of the original prosecution forms the ceiling for determining whether the modified limitation is materially narrowing. *Id.*

II. REISSUE TO TAKE ADVANTAGE OF pre-AIA 35 U.S.C. 103(b):

For patents issued on an application subject to the pre-AIA prior art regime (pre-AIA patents), a patentee may file a reissue application to permit consideration of process claims which qualify for **pre-AIA 35 U.S.C. 103(b)** treatment if a patent is granted on an application entitled to the benefit of **pre-AIA 35 U.S.C. 103(b)**, without an election having been made as a result of error without deceptive intent. See **MPEP § 706.02(n)**. **This is not to be considered a recapture.** The addition of process claims, however, will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent, or in an appropriate continuing broadening reissue application claiming the benefit of a prior filed broadening reissue application filed within two years of the grant of the original patent. See also **MPEP § 1412.03** as to broadened claims.

III. REISSUE FOR ARTICLE CLAIMS WHICH ARE FUNCTIONAL DESCRIPTIVE MATERIAL STORED ON A COMPUTER-READABLE MEDIUM:

A patentee may file a reissue application to permit consideration of article of manufacture claims (not presented in the patent to be reissued) which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The addition of these "article" claims will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also **MPEP § 1412.03** as to broadened claims.

IV. REJECTION BASED UPON RECAPTURE:

Reissue claims which recapture surrendered subject matter should be rejected using form paragraph 14.17.

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

Claim**[1]** rejected under **35 U.S.C. 251** as being an impermissible recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Greenliant Systems, Inc. et al v. Xicor LLC*, 692 F.3d 1261, 103 USPQ2d 1951 (Fed. Cir. 2012); *In re Shahram Mostafazadeh and Joseph O. Smith*, 643 F.3d 1353, 98 USPQ2d 1639 (Fed. Cir. 2011); *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005); *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 claimed 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.

[2]

Examiner Note:

In bracket 2, the examiner should explain the specifics of why recapture exists, including an identification of the omitted/broadened claim limitations in the reissue which provide the "broadening aspect" to the claim(s), and where in the original application the narrowed claim scope was presented/argued to obviate a rejection/objection. See **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 in a way that relates to the subject matter surrendered during original prosecution.

Examples of reissue application claims that are to be rejected for recapture under **35 U.S.C. 251** include:

Assume that the original application claim ABCD was amended during prosecution and results in a patent claim ABCD**E**.

1. ABCD Eliminates **E**, the surrender generating limitation (SGL).

2. ABCD**F** Eliminates **E**, the SGL; adds narrowing limitation **F**.

3. ABCD$\mathbf{E}_{BROADER}$ Broadens **E**, the SGL; $E_{BROADER}$ is well known in the art.

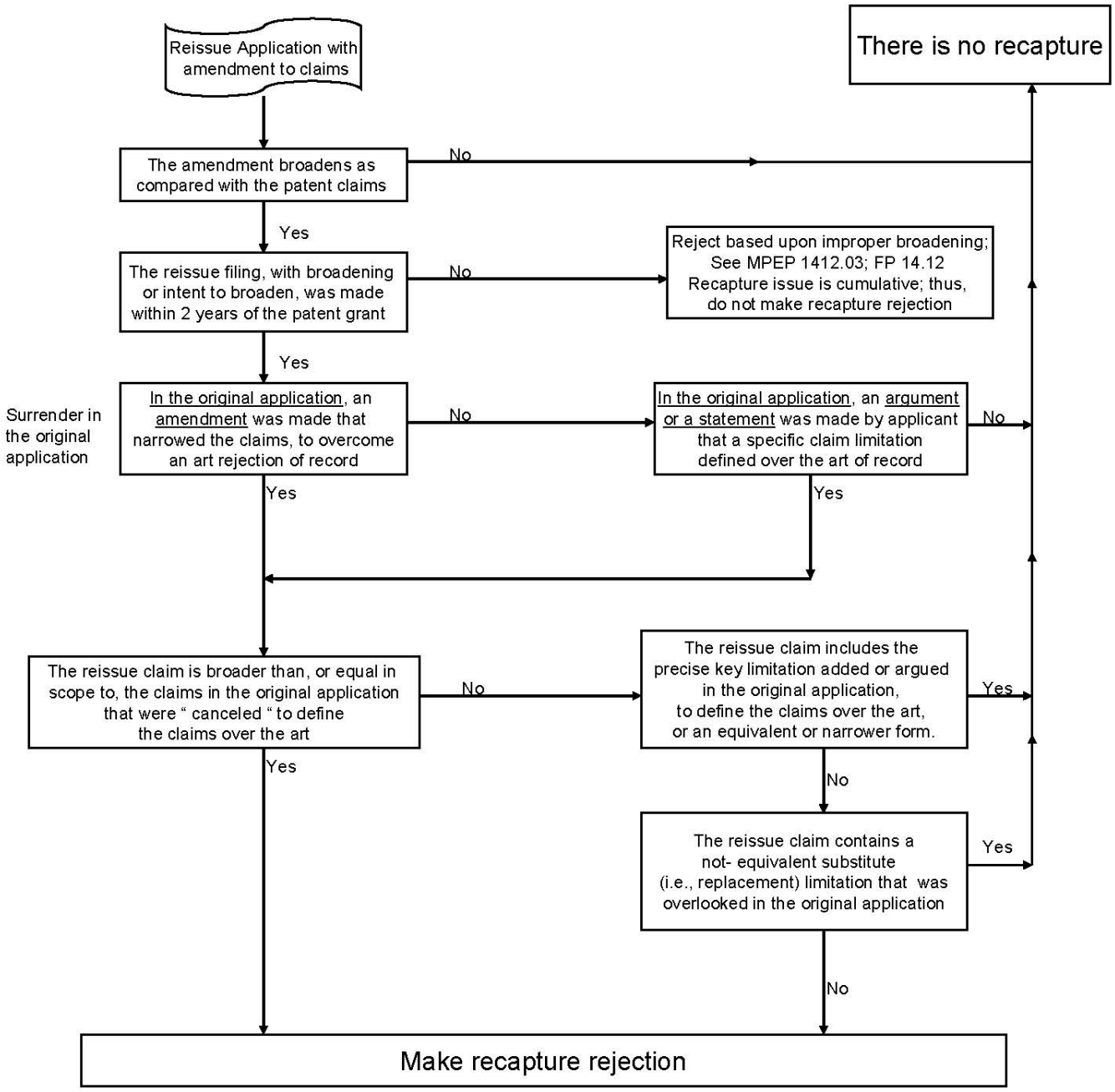
4. ABCD$\mathbf{E}_{BROADER}$**F** Broadens **E**; $E_{BROADER}$ is well known in the art; adds narrowing limitation **F**.

In these four examples, a recapture rejection would be made. For examples 2 and 4, applicant may try to rebut the recapture rejections by showing that limitation **F** "materially narrows" the reissue claims in a way that relates to the subject matter surrendered during original prosecution. If such is the case, the reissue applicant should point out explicitly what limitation has been added to the claims (in this case, limitation F) and how it materially narrows the claims.

VI. FLOWCHART

See the recapture-analysis flow chart which follows for assistance in determining whether recapture is present, consistent with the case law discussed above.

Reissue Recapture - Determining its presence or absence



1412.03 Broadening Reissue Claims [R-11.2013]

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

(d) REISSUE PATENT ENLARGING SCOPE OF CLAIMS.—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.

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35 U.S.C. 251(d) and the corresponding final paragraph of pre-AIA 35 U.S.C. 251 prescribe a 2-year limit for filing applications for broadening reissues.

I. MEANING OF "BROADENED REISSUE CLAIM"

A broadened reissue claim is 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. If a disclaimer is filed in the patent prior to the filing of a reissue application, the disclaimed claims are not part of the "original patent" under **35 U.S.C. 251**. The Court in *Vectra Fitness Inc. v. TNWK Corp.*, 162 F.3d 1379, 1383, 49 USPQ2d 1144, 1147 (Fed. Cir. 1998) held that a reissue application violated the statutory prohibition under **35 U.S.C. 251** against broadening the scope of the patent more than 2 years after its grant because the reissue claims are broader than the claims that remain after the disclaimer, even though the reissue claims are narrower than the claims that were disclaimed by the patentee before reissue. The reissue application was bounded by the claims remaining in the patent after a disclaimer is filed. A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least one* respect, even though it may be narrower in other respects. See, e.g., 37 CFR 1.175(b). A claim in the reissue application which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603, 120 USPQ 185, 186 (CCPA 1958). A claim which covers something that the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement. Thus, where the original patent claims only the process, and the reissue application newly adds product claims, the scope of the claims 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).

The addition of combination claims in a reissue application where only subcombination claims were present in the original patent could be a broadening of the invention. The question which must be resolved in this case is whether the combination claims added in the reissue would be for "the invention as claimed" in the original patent. See *Ex parte Wikdahl*, 10 USPQ2d at 1549. The newly added combination claims should be analyzed to determine whether they contain every limitation of the subcombination of any claim of the original patent. If the combination claims (added in the reissue) contain every limitation of the subcombination (which was claimed in the original application), then infringement of the combination must also result in infringement of the subcombination. Accordingly, the patent owner **could not**, if a reissue patent issues with the combination claims, **sue any new party** for infringement who could not have been sued for infringement of the original patent. Therefore, **broadening does not exist**, in spite of the addition of the combination. However, filing a reissue application to merely add combination claim(s) that require all the limitations of a subcombination claim, which subcombination claim was present in the original patent, would not provide an error that is correctable by reissue as defined by **35 U.S.C. 251**; see the discussion in **MPEP § 1402**.

II. SCOPE OF DEPENDENT CLAIM ENLARGED - NOT BROADENING

As pointed out above, a claim will be considered a broadened reissue claim when it is greater in scope

than **each and every** claim of the patent to be reissued. A corollary of this is that a claim which has been *broadened in a reissue as compared to its scope in the patent* is not a broadened reissue claim if it is narrower than, or equal in scope to, any other claim which appears in the patent. A common example of this is where dependent claim 2 is broadened via the reissue (other than the addition of a process step to convert an intermediate to a final product), but independent claim 1 on which it is based is not broadened. Because a dependent claim is construed to contain all the limitations of the claim upon which it depends, claim 2 must be at least as narrow as claim 1 and is thus not a broadened reissue claim.

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

The addition of 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 1549 (Bd. Pat. App. & Inter. 1989). A situation may arise, however, where the reissue application adds a limitation (or limitations) to process A of making the product A claimed in the original patent claims. For 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, <u>this is not broadening</u> (i.e., this is not an enlargement of the scope of the original patent) because the "newly claimed invention" contains all the limitations of the original patent claim(s).

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. In addition, 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, a broadened claim can subsequently be presented in the reissue after the two year period. (Note: A statement that "the patent is wholly or partly inoperative by reason of claiming more or less than applicant had a right to claim" is NOT an unequivocal statement of an intent to broaden.) 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. See *In re Staats*, 671 F.3d 1350, 101 USPQ2d 1930 (Fed. Cir. 2012) which dealt with a continuation of a first reissue application in which the first reissue application was filed within two years of the patent grant. The broadened claims in the continuation reissue application were to an embodiment "alternative" to, and "unrelated" to, the broadened claims of the first reissue application that were filed within the 2-year limit. Notice of broadening was found to be sufficient in this instance, with the court holding that there is no basis for requiring the later broadened claims in the continuation reissue application to be related to, or directed to the same embodiment as in the first reissue application. *Id.* at 1355, 101 USPQ2d at 1934. "[A]fter a broadening reissue application has been filed within the two year statutory period, an applicant is 'not barred from making further broadening changes' after the two year period" regardless of whether the further broadening changes are unrelated to the prior broadening reissue application. *Id.* 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.

See also the following cases which pertain to broadened reissues:

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.);

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.

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 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.).

Form paragraphs 14.12 and 14.13 may be used in rejections based on improper broadened reissue claims.

¶ *14.12 Rejection, 35 U.S.C. 251, Broadened Claims After Two Years*

Claim **[1]** rejected under **35 U.S.C. 251** as being broadened in a reissue application filed outside the two year statutory period. **[2]** A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See **MPEP §§ 706.03(x)** and **1412.03**.

¶ *14.13 Rejection, 35 U.S.C. 251, Broadened Claims Filed by Assignee*

Claim **[1]** rejected under **35 U.S.C. 251** as being improperly broadened in a reissue application made and sworn to by the assignee. The application for reissue may be made and sworn to by the assignee of the entire interest only if the application does not seek to enlarge the scope of the claims of the original patent or, for reissue applications filed on or after September 16, 2012, the application for the original patent was filed by the assignee of the entire interest under **37 CFR 1.46**.

[2] A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See **MPEP §§ 706.03(x)** and **1412.03**.

V. BROADENING REISSUE - OATH/DECLARATION REQUIREMENTS

A. *Reissue Application Filed On or After September 16, 2012*

A broadening reissue application filed on or after September 16, 2012 must be applied for by all of the inventors (patentees), that is, the original reissue oath or declaration must be signed by all of the inventors, unless the application for the patent (for which reissue is requested) was filed under **37 CFR 1.46** by the assignee of the entire interest (see 37 CFR 1.175(c)(2)). See also **MPEP § 1414**. A supplemental oath or declaration to account for errors corrected subsequent to the original oath or declaration is not needed for the application; however, a replacement oath or declaration would still be required where there is a failure to identify any error, or a failure to identify at least one error of the type that would support a reissue. Such a replacement oath or declaration must be signed by all of the inventors, unless the application for the patent (for which reissue is requested) was filed

under 37 CFR 1.46 by the assignee of the entire interest.

For any reissue application filed on or after September 16, 2012, the inventor's oath or declaration must identify a specific claim that the application seeks to broaden. See 37 CFR 1.175(b). A general statement, e.g., that all claims are broadened, is not sufficient to satisfy this requirement.

B. *Reissue Application Filed Before September 16, 2012*

A broadening reissue application filed before September 16, 2012 must be applied for by all of the inventors (patentees), that is, the original reissue oath or declaration must be signed by all of the inventors. See also **MPEP § 1414**. The error in not presenting broader claims must have been made without deceptive intent. If a supplemental oath or declaration in a broadening reissue application is needed in the application in order to fulfill the requirements of **37 CFR 1.175**, the supplemental reissue oath or declaration must be signed by all of the inventors. See In re Hayes, 53 USPQ2d 1222 (Comm'r Pat. 1999) and MPEP § 1414.03.

1412.04 Correction of Inventorship By Reissue [R-11.2013]

The correction of misjoinder of inventors has been held to be a ground for reissue. See *Ex parte Scudder*, 169 USPQ 814, 815 (Bd. App. 1971) wherein the Board held that **35 U.S.C. 251** authorizes reissue applications to correct misjoinder of inventors where **35 U.S.C. 256** is inadequate. See also *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 567 n.16, 195 USPQ 97, 106 n.16 (D.C. Cir. 1977) wherein correction of inventorship from sole inventor A to sole inventor B was permitted in a reissue application. The court noted that reissue by itself is a vehicle for correcting inventorship in a patent.

See **MPEP §§ 602.01(c)** et seq. for correction of inventorship in an application other than a reissue application.

I. CERTIFICATE OF CORRECTION AS A VEHICLE FOR CORRECTING INVENTORSHIP

While reissue is a vehicle for correcting inventorship in a patent, correction of inventorship should be effected under the provisions of **35 U.S.C. 256** and **37 CFR 1.324** by filing a request for a Certificate of Correction if:

(A) the only change being made in the patent is to correct the inventorship; and

(B) all parties are in agreement and the inventorship issue is not contested.

See **MPEP § 1481.02** for the procedure to be followed to obtain a Certificate of Correction for correction of inventorship.

II. REISSUE AS A VEHICLE FOR CORRECTING INVENTORSHIP

Where the provisions of **35 U.S.C. 256** and **37 CFR 1.324** do not apply, a reissue application is the appropriate vehicle to correct inventorship. The failure to name the correct inventive entity is an error in the patent which is correctable under **35 U.S.C. 251**. The reissue oath or declaration pursuant to **37 CFR 1.175** must state that the applicant believes the original patent to be wholly or partly inoperative or invalid through error of a person being incorrectly named in an issued patent as the inventor, or through error of an inventor incorrectly not named in an issued patent, and, for applications filed before September 16, 2012, must also state that such error arose without any deceptive intention on the part of the applicant. The reissue oath or declaration must, as stated in **37 CFR 1.175**, also comply with one of **37 CFR 1.63**, **1.64**, or **1.67** if the reissue application is filed on or after September 16, 2012, or comply with pre-AIA 37 CFR 1.63 if filed before September 16, 2012.

The reissue application with its reissue oath or declaration under **37 CFR 1.175** provides a complete mechanism to correct inventorship. See *A.F. Stoddard & Co. v. Dann*, 564 F.2d at 567, 195 USPQ at 106. A request under **37 CFR 1.48** or a petition under **37 CFR 1.324** cannot be used to correct the inventorship of a reissue application. If a request under **37 CFR 1.48** or a petition under **37**

CFR 1.324 is filed in a reissue application, the request or petition should be dismissed and the processing or petition fee refunded. The material submitted with the request or petition should then be considered to determine if it complies with **37 CFR 1.175**. If the material submitted with the request or petition does comply with the requirements of **37 CFR 1.175** (and the reissue application is otherwise in order), the correction of inventorship will be permitted as a correction of an error in the patent under **35 U.S.C. 251**.

The correction of inventorship does not enlarge the scope of the patent claims. Where a reissue application does not seek to enlarge the scope of the claims of the original patent, the reissue oath may be made and sworn to, or the declaration made, by the assignee of the entire interest under **37 CFR 1.172**. An assignee of part interest may not file a reissue application to correct inventorship where the other co-owner did not join in the reissue application and has not consented to the reissue proceeding. See *Baker Hughes Inc. v. Kirk*, 921 F.Supp. 801, 809, 38 USPQ2d 1885, 1892 (D.D.C. 1995). See **35 U.S.C. 251**. On the other hand, an assignee of the entire interest can consent to and sign the reissue oath/declarationthat adds or deletes the name of an inventor by reissue (*e.g.* , correct inventorship from inventor A to inventors A and B) without the original inventor's consent. Thus, the assignee of the entire interest can file a reissue to change the inventorship to one which the assignee believes to be correct, even though an inventor might disagree. The protection of the assignee's property rights in the application and patent are statutorily based in **35 U.S.C. 118**. For additional information pertaining to the right of an assignee to take action, see MPEP § 324 (for applications filed before September 16, 2012) and § 325 (for applications filed on or after September 16, 2012). Where the name of an inventor X is to be deleted in a reissue application to correct inventorship in a patent, and inventor X has not assigned his/her rights to the patent, inventor X has an ownership interest in the patent. Inventor X must consent to the reissue (**37 CFR 1.172(a)**), even though inventor X's name is being deleted as an inventor. If X's name is being deleted as an inventor, X consents to the reissue application, and the remaining inventors sign the reissue oath or declaration, X need not sign. If, however, an assignee signs the reissue oath or declaration, inventor X's signature must also be included in the reissue oath or declaration as an assignee.

1412.05 Correction of Inventorship in a Broadening Reissue Application [R-11.2013]

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

[Editor Note: See subsection II., below, for reissue applications filed before September 16, 2012.]

Where a reissue application to correct inventorship is filed on or after September 16, 2012, and the application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest, the assignee may sign the inventor's oath or declaration even where the application also seeks to enlarge the scope of the claims of the original patent. If the application for the original patent was not filed under 37 CFR 1.46 by the assignee of the entire interest, then the signature of all of the inventors is needed on the oath or declaration except as provided for in 37 CFR 1.64. Note that under 37 CFR 1.64, the assignee of the entire interest may sign a substitute statement where the inventor is deceased, legally incapacitated, refuses to execute the reissue oath or declaration, or cannot be found or reached after diligent effort. See MPEP § 604.

In situations where a reissue application seeks to correct inventorship in the patent and the inventors sign the reissue oath or declaration for a broadening reissue application, the correct inventive entity must sign the reissue oath or declaration. . If an inventor is being deleted in a reissue application to correct inventorship in a patent and the inventors are required to sign the oath or declaration, the inventor being deleted need not sign the reissue oath or declaration. For example, a reissue application is filed to correct inventorship from inventors A, B, and C (listed as inventors on the patent) to inventors A and B. Inventor C is being deleted as a named inventor. In such a case, A and B are the correct inventors, and accordingly, (in situations where the assignee is not permitted to sign) inventors A and B must sign the reissue oath or declaration but inventor C need not sign the reissue oath or declaration.

If an inventor **is being deleted** in a reissue application to correct inventorship in a patent and the inventors are required to sign the oath or declaration, the inventor being deleted need not sign the reissue oath or declaration. For example, a reissue application is filed to correct inventorship from inventors A, B, and C (listed as inventors on the patent) to inventors A and B. Inventor C is being deleted as a named inventor. In such a case, A and B are the correct inventors, and accordingly, (in situations where the assignee is not permitted to sign) inventors A and B must sign the reissue oath or declaration but inventor C need not sign the reissue oath or declaration.

If an inventor **is being added** in a reissue application to correct inventorship in a patent, the inventor being added must sign the reissue oath or declaration together with the inventors previously designated on the patent. For example, a reissue application is filed to correct the inventorship from inventors A and B (listed as inventors on the patent) to inventors A, B, and C. Inventor C is the inventor being added. In such a case, A, B, and C are the correct inventors, and accordingly, each of A, B, and C must sign the reissue oath or declaration. If inventor C refuses to sign, the assignee of the entire interest may sign a substitute statement under 37 CFR 1.64. Thus, even where an application changes the claims to enlarge the scope of the patent claims in addition to the inventorship change, and the application for the original patent was not filed under 37 CFR 1.46 by the assignee of the entire interest, the assignee can add an inventor who refuses to sign by making use of 37 CFR 1.64.

II. Reissue Application Filed Before September 16, 2012

[Editor Note: See subsection I., above, for reissue applications filed on or after September 16, 2012.]

Where a reissue application to correct inventorship is filed before September 16, 2012, and that application also changes the claims to enlarge the scope of the patent claims, the signature of all the inventors *is needed* . However, if an inventor refuses to sign the reissue oath or declaration because he or she believes the change in inventorship (to be effected) is not correct, the reissue application can still be filed with a petition under **pre-AIA 37 CFR 1.47** without that inventor's signature, provided the written consent of all owners/assignees as required by **pre-AIA 37 CFR 1.172(a)** is also submitted. Compare, however, the situation where a patent to inventors X and Y has no assignee, a reissue application is filed by inventor Y to delete the name of inventor X as an inventor and to broaden the patent. Inventor X refuses to sign the reissue oath or declaration and refuses to provide the consent as required by **pre-AIA 37 CFR 1.172(a)**. In this instance, a **pre-AIA 37 CFR 1.47** petition would not be appropriate to permit the filing of the reissue application because the consent requirement of **pre-AIA 37 CFR 1.172(a)** for each owner/assignee is not met. Resort to the courts would be required to delete the name of inventor X as an inventor where X will not consent to the filing of a reissue application. As stated in the second paragraph of **pre-AIA 35 U.S.C. 256**, "[t]he court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly."

1413 Drawings [R-11.2013]

37 CFR 1.173 Reissue specification, drawings, and amendments.

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(a) (2) *Drawings* . Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § **1.84**, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

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A clean copy (e.g., good quality photocopies free of any extraneous markings) of each drawing sheet of the printed patent must be supplied by the applicant at the time of filing of the reissue application. If the copies meet the requirements of **37 CFR 1.84**, no further formal drawings will be required. New drawing sheets are not to be submitted, unless some change is made in the original patent drawings. Such changes must be made in accordance with **37 CFR 1.173(b)(3)**.

AMENDMENT OF DRAWINGS

37 CFR 1.173 Reissue specification, drawings, and amendments.

*****

(b) (3) *Drawings.* One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which shall be an attachment to the amendment document. Any replacement sheet of drawings must be in compliance with § 1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled." All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings.

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The provisions of 37 CFR 1.173(b)(3) govern the manner of making amendments (changes) to the drawings in a reissue application. The following guidance is provided as to the procedure for amending drawings:

(A) Amending the original or printed patent drawing sheets by physically changing or altering them is not permitted. Any request to do so should be denied.

(B) Where a change to the drawings is desired, applicant must submit a replacement sheet for each sheet of drawings containing a Figure to be revised. Any replacement sheet must comply with 37 CFR 1.84 and include all of the figures appearing on the original version of the sheet, even if only one figure is being amended. Each figure that is amended must be identified by placing the word "Amended" at the bottom of that figure. Any added figure must be identified as "New." In the event that a figure is canceled, the figure must be identified as "Canceled" and also surrounded by brackets. All changes to the figure(s) must be explained, in detail, beginning on a separate sheet which accompanies the papers including the amendment to the drawings.

(C) If desired, applicant may include a marked-up copy of any amended drawing figure, including annotations indicating the changes made. Such a marked-up copy must be clearly labeled as "Annotated Marked-up Drawings", and it must be presented in the amendment or remarks section that explains the change to the drawings. In addition, the examiner may desire a marked-up copy of any amended drawing figure, and so state in an Office action. A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(D) If any drawing change is not approved, or if any submitted sheet of drawings is not entered, the examiner will so inform the reissue applicant in the next Office action, and the examiner will set forth the reasons for same.

1414 Content of Reissue Oath/Declaration [R-11.2013]

The reissue oath/declaration as required by 37 CFR 1.175 is an essential part of a reissue application and must be filed with the application, or within the time period set under 37 CFR 1.53(f) along with the required surcharge as set forth in 37 CFR 1.16(f) in order to avoid abandonment. The question of the sufficiency of the reissue oath/declaration filed under 37 CFR 1.175 must in each case be reviewed and decided personally by the primary examiner.

Much of the required content of a reissue oath or declaration will differ based on the filing date of the reissue application. However, all 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; and

(B) A statement of at least one error which is relied upon to support the reissue application, *i.e.*, as the basis for the reissue;

Subsections I and II below describe the requirements for each of the aforementioned statements. See MPEP § 1414.01 for the remaining requirements for the reissue oath or declaration in a reissue application filed on or after September 16, 2012; § 1414.02 for the remaining requirements of a reissue oath or declaration in a reissue application filed before September 16, 2012; and § 1414.03 for supplemental reissue oaths or declarations in reissue applications filed before September 16, 2012.

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

In order to satisfy this requirement, a declaration can state for example:

1. "Applicant believes the original patent to be partly inoperative or invalid by reason of a defective specification or drawing."
2. "Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more than patentee had a right to claim in the patent."
3. "Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming less than patentee had a right to claim in the patent."

It should be noted that the reissue oath/declaration must also satisfy the requirement for a statement of at least one error being relied upon as the basis for reissue, in the manner set forth in subsection II. below.

Even though only one error upon which reissue is based needs to be described in the reissue oath/declaration, if PTO/SB/51 or PTO/SB/52 form is used (or PTO/AIA/05 or PTO/AIA/06, for applications filed on or after September 16, 2012), applicant needs to check the appropriate box(es) on the form identifying each of the reasons why the patent is wholly or partly inoperative or invalid. Even if a PTO form is not used, applicant needs to state all the reasons why the patent is wholly or partly inoperative or invalid in the reissue oath/declaration.

Form paragraph 14.01.05 may be used where the reissue oath/declaration does not provide the required statement as to applicant's belief that the original patent is wholly or partly inoperative or invalid.

¶ *14.01.05 Defective Reissue Oath/Declaration, 37 CFR 1.175 - No Statement of Defect in the Patent*

The reissue oath/declaration filed with this application is defective because it fails to contain the statement(s) required under **37 CFR 1.175** as to applicant's belief that the original patent is wholly or partly inoperative or invalid. **[1]**

Examiner Note:

1. Use this form paragraph when applicant: (a) fails to allege that the original patent is inoperative or invalid and/or (b) fails to state the reason of a defective specification or drawing, or of patentee claiming more or less than patentee had the right to claim in the patent. In bracket 1, point out the specific defect to applicant by using the language of (a) and/or (b), as it is appropriate.

2. Form paragraph 14.14 must follow this form paragraph.

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

(A) A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). A change or departure from the original specification or claims represents an "error" in the original patent under **35 U.S.C. 251**. See **MPEP § 1402** for a discussion of grounds for filing a reissue that may constitute the "error" required by **35 U.S.C. 251**. Not all changes with respect to the patent constitute the "error" required by **35 U.S.C. 251**. It is noted that an error to be corrected under **35 U.S.C. 251** may be the addition of a claim or claims that is/are narrower in scope than the existing patent claims, without any narrowing of the existing patent claims. See *In re Tanaka*, 640 F.3d 1246, 1251, 98 USPQ2d 1331, 1334 (Fed. Cir. 2011).

(B) Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied. Applicant may specify more than one error.Where more than one error is specified in the oath/declaration and some of the designated "errors" are found to not be "errors" under **35 U.S.C. 251**, any remaining error which is an error under **35 U.S.C. 251** will still support the reissue.The "at least one error" which is relied upon to support the reissue application must be set forth in the oath/declaration. It is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered. If an applicant chooses to point out these matters, the statements directed to these matters will

not be reviewed by the examiner, and the applicant should be so informed in the next Office action. What is needed for the oath/declaration statement as to error is the identification of "at least one error" relied upon. For an application filed on or after September 16, 2012 that seeks to enlarge the scope of the claims of the patent, the reissue oath or declaration must also identify a claim that the application seeks to broaden. A general statement, e.g., that all claims are broadened, is not sufficient to satisfy this requirement. In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid. The corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration. If the initial reissue oath/declaration "states at least one error" in the original patent, and, *in addition*, recites the specific corrective action taken in the reissue application, the oath/declaration would be considered acceptable, even though the corrective action statement is not required.

(C) It is not sufficient for an oath/declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." Rather, the oath/declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), *cert. denied*, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.A statement in the oath/declaration of "…failure to include a claim directed to…" and then reciting all the limitations of a newly added claim, would not be considered a sufficient "error" statement because applicant has not pointed out what the other claims lacked that the newly added claim has, or vice versa. Such a statement would be no better than saying in the reissue oath or declaration that "this application is being filed to correct errors in the patent which may be noted from the change made by adding new claim 10." In both cases, the error has not been identified.Likewise, a statement of the error as "…the inclusion of claims 3-5 which were unduly broad…" and then canceling claims 3-5, would not be considered a sufficient "error" statement because applicant has not pointed out what the canceled claims lacked that the remaining claims contain. The statement of what the remaining claims contain need not identify specific limitations, but rather may provide a general identification, such as "Claims 3-5 did not provide for any of the tracking mechanisms of claims 6-12, nor did they provide an attachment mechanism such as those in claims 1-2 and 9-16."

(D) Where a continuation reissue application is filed with a copy of the reissue oath/declaration from the parent reissue application, and the parent reissue application is not to be abandoned, the reissue oath/declaration should be accepted by the Office of Patent Application Processing (OPAP) without further evaluation, because it is an oath/declaration, albeit improper under **35 U.S.C. 251**. The examiner should, however, reject the claims of the continuation reissue application under **35 U.S.C. 251** as being based on an oath/declaration that does not identify an error being corrected by the continuation reissue application, and should require a new oath/declaration. See **37 CFR 1.175(f)(2)** for reissue applications filed on or after September 16, 2012, and **pre-AIA 37 CFR 1.175(e)** for reissue applications filed before September 16, 2012. One of form paragraphs 14.01.01 through 14.01.03 may be used. If the same error corrected in the parent is also being corrected in the continuation reissue application, but the error is being corrected in a different way, a petition under 37 CFR 1. 183 will be needed to waive pre-AIA 37 CFR 1.175(e) for a reissue application filed before September 16, 2012. If the reissue application was filed on or after September 16, 2012, a petition under 37 CFR 1. 183 is no longer needed; however, a statement is needed to explain compliance with 37 CFR 1.175(f)(2). Where a continuation reissue application is filed with a copy of the reissue oath/declaration from the parent reissue application, and the parent reissue application is, or will be abandoned, the copy of the reissue oath/declaration should be accepted by the Office of Patent Application Processing (OPAP), and the examiner should check to ensure that the oath/declaration identifies an error which is still being corrected in the continuation application. For reissue applications filed before September 16, 2012, pursuant to **pre-AIA 37 CFR 1.175(b)(1)**, for any error corrected via the preliminary amendment which is not covered by the oath or declaration submitted in the parent reissue application, applicant must

submit a supplemental oath/declaration stating that such error arose without any deceptive intention on the part of the applicant. See **MPEP § 1414.03**. Where a divisional reissue application is filed with a copy of the reissue oath/declaration from the parent reissue application, the reissue oath/declaration should be accepted by OPAP, because it is an oath/declaration, though it may be improper under **35 U.S.C. 251**. The examiner should check the copy of the oath/declaration to ensure that it identifies an error being corrected by the divisional reissue application. The copy of the oath/declaration from the parent reissue application may or may not cover an error being corrected by the divisional reissue application because the divisional reissue application is (by definition) directed to a new invention. If the copy of the oath/declaration does not cover an error being corrected by the divisional reissue application, the examiner should reject the claims of the divisional reissue application under **35 U.S.C. 251** as being based on an oath/declaration that does not identify an error being corrected by the divisional reissue application, and require a new oath/declaration. Even where the divisional reissue application was filed on or after September 16, 2012, a new reissue oath/declaration will be required, because the divisional reissue application is a new application, and a new application requires the error to be set forth in the oath/declaration. If the copy of the reissue oath/declaration from the parent reissue application does in fact cover an error being corrected in the divisional reissue application, no such rejection should be made. See **MPEP § 1414.01**. Form paragraph 14.01.01 may be used where the reissue oath/declaration does not identify an error.

¶ *14.01.01 Defective Reissue Oath/Declaration, 37 CFR 1.175 - No Statement of a Specific Error*

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See **37 CFR 1.175** and **MPEP § 1414**.

Examiner Note:

1. Use this form paragraph when the reissue oath or declaration does not contain any statement of an error which is relied upon to support the reissue application.

2. This form paragraph can be used where the reissue oath or declaration does not even mention error. It can also be used where the reissue oath or declaration contains some discussion of the concept of error but never in fact identifies a specific error to be relied upon. For example, it is not sufficient for an oath or declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure."

3. Form paragraph 14.14 must follow this form paragraph.

Where the reissue oath/declaration does identify an error or errors, the oath/declaration must be checked carefully to ensure that at least one of the errors identified is indeed an "error" which will support the filing of a reissue, i.e., an "error" that will provide grounds for reissue of the patent. See **MPEP § 1402**. If the error identified in the oath/declaration is not an appropriate error upon which a reissue can be based, then the oath/declaration must be indicated to be defective in the examiner's Office action.

Form paragraphs 14.01.02 and 14.01.03 may be used where the reissue oath/declaration fails to provide at least one error upon which a reissue can be based.

¶ *14.01.02 Defective Reissue Oath/Declaration, 37 CFR 1.175 - The Identified "Error" Is Not Appropriate Error*

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See **37 CFR 1.175** and **MPEP § 1414**.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration identifies only one error which is relied upon to support the reissue application, and that one error is not an appropriate error upon which a reissue can be based.

2. Form paragraph 14.14 must follow this form paragraph.

¶ *14.01.03 Defective Reissue Oath/Declaration, 37 CFR 1.175 - Multiple Identified "Errors" Not Appropriate Errors*

The reissue oath/declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See **37 CFR 1.175** and **MPEP § 1414**.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration identifies more than one error relied upon to support the reissue application, and none of the errors are appropriate errors upon which a reissue can be based.

2. Note that if the reissue oath/declaration identifies more than one error relied upon, and at least one of the errors is an error upon which reissue can be based, this form paragraph should not be used, despite the additional reliance by applicant on "errors" which do not support the reissue. Only one appropriate error is needed to support a reissue.

3. Form paragraph 14.14 must follow this form paragraph.

¶ *14.01.06 Defective Reissue Oath/Declaration, 37 CFR 1.175 - General*

The reissue oath/declaration filed with this application is defective (see **37 CFR 1.175** and **MPEP § 1414**) because of the following:

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration does not comply with **37 CFR 1.175**, and none of form paragraphs 14.01.01 - 14.01.05 or 14.05.02 apply.

2. This form paragraph must be followed by an explanation of why the reissue oath/declaration is defective.

3. Form paragraph 14.14 must follow the explanation of the defect.

¶ *14.14 Rejection, Defective Reissue Oath or Declaration*

Claim **[1]** rejected as being based upon a defective reissue **[2]** under **35 U.S.C. 251** as set forth above. See **37 CFR 1.175**.

The nature of the defect(s) in the **[3]** is set forth in the discussion above in this Office action.

Examiner Note:

1. In bracket 1, list all claims in the reissue application. See **MPEP § 706.03(x)**.

2. This paragraph must be preceded by form paragraph 14.01 and should be preceded by form paragraphs 14.01.01 to 14.01.06 as appropriate

3. In brackets 2 and 3, insert either --oath-- or --declaration--.

1414.01 Reissue Oath or Declaration in Reissue Application Filed On or After September 16, 2012 [R-11.2013]

[Editor Note: See MPEP § 1414.02 for reissue applications filed before September 16, 2012.]

37 CFR 1.175 Inventor's oath or declaration for a reissue application

(a) The inventor's oath or declaration for a reissue application, in addition to complying with the requirements of § 1.63, § 1.64, or § 1.67, must also specifically identify at least one error pursuant to 35 U.S.C. 251 being relied upon as the basis for reissue and state 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 the patentee had the right to claim in the patent.

(b) If the reissue application seeks to enlarge the scope of the claims of the patent (a basis for the reissue is the patentee claiming less than the patentee had the right to claim in the patent), the inventor's oath or declaration for a reissue application must identify a claim that the application seeks to broaden. A claim is a broadened claim if the claim is broadened in any respect.

(c) The inventor, or each individual who is a joint inventor of a claimed invention, in a reissue application must execute an oath or declaration for the reissue application, except as provided for in § 1.64, and except that the inventor's oath or declaration for a reissue application may be signed by the assignee of the entire interest if:

(1) The application does not seek to enlarge the scope of the claims of the original patent; or

(2) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

(d) If errors previously identified in the inventor's oath or declaration for a reissue application pursuant to paragraph (a) of this section are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(e) The inventor's oath or declaration for a reissue application required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f), except that the provisions of § 1.53(f)(3) do not apply to a reissue application.

(f) (1) The requirement for the inventor's oath or declaration for a continuing reissue application that claims the benefit under 35 U.S.C. 120, 121, or 365(c) in compliance with § 1.78 of an earlier-filed reissue application may be satisfied by a copy of the inventor's oath or declaration from the earlier-filed reissue application, provided that:

(i) The inventor, or each individual who is a joint inventor of a claimed invention, in the reissue application executed an inventor's oath or declaration for the earlier-filed reissue application, except as provided for in § 1.64;

(ii) The continuing reissue application does not seek to enlarge the scope of the claims of the original patent; or

(iii) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

(2) If all errors identified in the inventor's oath or declaration from the earlier-filed reissue application are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(g) An oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1), will be placed in the file record of the reissue application, but may not necessarily be reviewed by the Office.

The inventor's oath or declaration for a reissue application must comply with the requirements of 37 CFR 1.63, 1.64, or 1.67. Therefore, in addition to identifying the inventor or joint inventor and the application to which it is directed, the reissue oath/declaration must

(A) include a statement that the person executing the oath or declaration believes the named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed invention in the application; and
(B) state that the application was made or was authorized to be made by the person executing the oath or declaration.

In accordance with 37 CFR 1.63(c), a person may not execute an oath or declaration for an application unless that person has reviewed and understand the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to the patentability as defined in **37 CFR 1.56**. See also the discussion regarding the requirements of an oath/declaration beginning at **MPEP § 602**. See also **MPEP § 604** for the requirements of a substitute statement under **37 CFR 1.64**.

Depending on the circumstances, either form PTO/AIA/05, Reissue Application Declaration By The Inventor, or form PTO/AIA/06, Reissue Application Declaration By The Assignee, may be used to prepare a declaration in a reissue application.

Doc Code: REIS.DECL
Document Description: Reissue Declaration Filed In Accordance With MPEP 1414

PTO/AIA/05 (06-12)
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REISSUE APPLICATION DECLARATION BY THE INVENTOR	Docket Number (Optional)

I hereby declare that:
Each inventor's residence and mailing address are stated below next to their name.
I believe I am the original inventor or an original joint inventor of the subject matter which is described and claimed in patent number _____, granted _____ and for which a reissue patent is sought on the invention titled _____,
_____,
the specification of which

☐ is attached hereto.

☐ was filed on _____ as reissue application number _____ .

The above-identified application was made or authorized to be made by me.

I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

I 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, a claim that the application seeks to broaden must be identified:

[Page 1 of 2]

This collection of information is required by 37 CFR 1.175. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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(REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 2)

Docket Number (Optional)

Note: To appoint a power of attorney, use form PTO/AIA/81.

Correspondence Address: Direct all communications about the application to:

☐ The address associated with Customer Number: ____

OR

☐ Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone		Email			

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Legal name of sole or first inventor (*E.g.*, Given Name (first and middle (if any) and Family Name or Surname)			
Inventor's Signature		Date (Optional)	
Residence: City	State	Country	
Mailing Address			
City	State	Zip	Country

☐ Additional joint inventors are named on the ______ supplemental sheet(s) PTO/AIA/10 attached hereto.

[Page 2 of 2]

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Doc Code: REIS.DECL
Document Description: Reissue Declaration Filed In Accordance With MPEP 1414

PTO/AIA/06 (06-12)
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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE	Docket Number (optional)

I hereby declare that:

The residence and mailing address of the inventor or joint inventors are stated below.

I am authorized to act on behalf of the following assignee: _____

The entire title to the patent identified below is vested in said assignee.

Inventor		
Residence: City	State	Country

Mailing Address			
City	State	Zip	Country

☐ Additional Inventors are named on separately numbered sheets attached hereto.

Patent Number	Date of Patent Issued

I believe said inventor(s) to be the original inventor or original joint inventors of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention titled:

the specification of which

☐ is attached hereto.

☐ was filed on _____ as reissue application number _____.

The above-identified application was made or authorized to be made by me.

I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

I 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.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.175. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE	Docket Number (Optional)

At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, a claim that the application seeks to broaden must be identified and the box below must be checked:

[Attach additional sheets, if needed.]

☐ **The application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest.**

I hereby appoint:

☐ Practitioners associated with Customer Number: ☐

OR

☐ Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Correspondence Address: Direct all communications about the application to:

☐ The address associated with Customer Number: ☐

OR

☐ Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone		Email			

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Signature	Date (Optional)
Full name of person signing (given name, family name)	
Address of Assignee	

[Page 2 of 2]

Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

1414.02 Reissue Oath or Declaration in Reissue Application Filed Before September 16, 2012 [R-11.2013]

[Editor Note: See MPEP § 1414.01 for reissue applications filed on or after September 16, 2012.]

Pre-AIA 37 CFR 1.175

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also 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.

(b) (1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(i) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

(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 paragraph (a)(1) of this section, identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application. All other requirements relating to oaths or declarations must also be met.

I. ERROR WITHOUT DECEPTIVE INTENT

A statement in the reissue oath or declaration that all errors being corrected in the reissue application arose without any deceptive intention on the part of the applicant is required for a reissue application filed before September 16, 2012. In order to satisfy this requirement, the following statement may be included:

> "All errors corrected in the present reissue application up to the time of signing of this oath/declaration, or errors which are being corrected by a paper filed concurrently with this oath/declaration which correction of errors I/we have reviewed, arose without any deceptive intention on the part of the applicant."

Nothing more is required. The examiner will determine only whether the reissue oath/declaration contains the required averment; the examiner will not make any comment as to whether it appears that there was in fact deceptive intention (see **MPEP § 2022.05**). It is noted that a reissue oath/declaration will not be effective for any errors which are corrected by a filing made after the execution of the reissue oath/declaration, unless it is clear from the record that the parties executing the document were aware of the nature of the correction when they executed the document. Further, a reissue oath/declaration with an early date of execution cannot be filed after a correction made later in time, to cover the correction made after the execution date. This is so, even if the reissue oath/declaration states that all errors up to the filing of the oath/declaration arose without any deceptive intention on the part of the applicant.

Form paragraph 14.01.04 may be used where the reissue oath/declaration does not provide the required statement as to "without any deceptive intention on the part of the applicant."

¶ *14.01.04.fti Defective Reissue Oath/Declaration in Application Filed Before Sept. 16, 2012, 37 CFR 1.175- Lack of Statement of "Without Any Deceptive Intention"*

The reissue oath/declaration filed with this application, which has a filing date before September 16, 2012, is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See **pre-AIA 37 CFR 1.175** and **MPEP § 1414**.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration does not contain the statement required by **pre-AIA 37 CFR 1.175** that all errors being corrected in the reissue application arose without any deceptive intention on the part of the applicant.

2. This form paragraph is appropriate to use for a failure by applicant to comply with the requirement, as to any of **pre-AIA 37 CFR 1.175(a)(2)**, **37 CFR 1.175(b)(1)**, or **37 CFR 1.175(b)(2)**.

3. Form paragraph 14.14 must follow.

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

The Office of Patent Application Processing (OPAP) should review the reissue oath/declaration for compliance with pre-AIA 37 CFR 1.63; thus, the examiner is not required to do such review.

The reissue oath/declaration must include the averments required by 37 CFR 1.63(a) and (b), e.g., that applicants for reissue

> (A) have reviewed and understand the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath/declaration;
> (B) believe the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and
> (C) acknowledge the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56. See also the discussion regarding the requirements of an oath/declaration beginning at MPEP § 602.

See MPEP § 1414.03 for a discussion of the requirements for a supplemental reissue oath/declaration.

Depending on the circumstances, either form PTO/SB/51, Reissue Application Declaration By The Inventor, or form PTO/SB/52, Reissue Application Declaration By The Assignee, may be used to prepare a declaration in a reissue application.

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REISSUE APPLICATION DECLARATION BY THE INVENTOR	Docket Number (Optional)

I hereby declare that:
Each inventor's residence, mailing address and citizenship are stated below next to their name.
I believe the inventors named below to be the original and first inventor(s) of the subject matter which is described and claimed in patent number _____, granted _____ and for which a reissue patent is sought on the invention entitled _____,

_____,

the specification of which

☐ is attached hereto.

☐ was filed on _____ as reissue application number _____

and was amended on _____ .
(If applicable)

I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. This application was made or was authorized to be made by me.
I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

☐ I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b). Attached is form PTO/SB/02B (or equivalent) listing the foreign applications.

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:

[Page 1 of 2]

This collection of information is required by 37 CFR 1.175. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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(REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 2)

Docket Number (Optional)

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.

Note: To appoint a power of attorney, use form PTO/SB/81.

Correspondence Address: Direct all communications about the application to:

☐ The address associated with Customer Number:

OR

☐ Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone		Email			

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed. I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 35 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

Full name of sole or first inventor (given name, family name)	
Inventor's signature	Date
Residence	Citizenship
Mailing Address	
Full name of second joint inventor (given name, family name)	
Inventor's signature	Date
Residence	Citizenship
Mailing Address	

☐ Additional joint inventors or legal representative(s) are named on separately numbered sheets forms PTO/SB/02A or 02LR attached hereto.

[Page 2 of 2]

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE	Docket Number (optional)

I hereby declare that:

The residence, mailing address and citizenship of the inventors are stated below.

I am authorized to act on behalf of the following assignee: _____

and the title of my position with said assignee is: _____

The entire title to the patent identified below is vested in said assignee.

Inventor	Citizenship
Residence/Mailing Address	
Inventor	Citizenship
Residence/Mailing Address	
☐ Additional Inventors are named on separately numbered sheets attached hereto.	
Patent Number	Date of Patent Issued

I believe said inventor(s) to be the original and first inventor(s) of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention entitled:

the specification of which

☐ is attached hereto.

☐ was filed on _____ as reissue application number_____ /_____

and was amended on _____
(If applicable)

I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above. This application was made or was authorized to be made by me.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

☐ I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b). Attached is form PTO/SB/02B (or equivalent) listing the foreign applications.

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.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.175. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE	Docket Number (Optional)

At least one error upon which reissue is based is described as follows:

[Attach additional sheets, if needed.]

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.

I hereby appoint:

☐ Practitioners associated with Customer Number:

OR

☐ Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Correspondence Address: Direct all communications about the application to:

☐ The address associated with Customer Number:

OR

☐ Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone		Email			

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed. I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

Signature	Date

Full name of person signing (given name, family name)

Address of Assignee

[Page 2 of 2]

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

1414.03 Supplemental Reissue Oath/Declaration [R-11.2013]

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

[Editor Note: See subsection II., below, for reissue applications filed before September 16, 2012.]

Pursuant to 37 CFR 1.67(a), the applicant may submit an inventor's oath or declaration meeting the requirements of 37 CFR 1.63, 1.64, or 1.162 to correct any deficiencies or inaccuracies present in an earlier-filed inventor's oath or declaration.

For applications filed on or after September 16, 2012, if additional defects or errors are corrected in the reissue after the filing of the reissue oath or declaration, a supplemental reissue oath or declaration is **not** required. However, where all errors previously identified in the reissue oath/declaration are no longer being replied upon as the basis for reissue, the applicant must explicitly identify on the record an error being relied upon as the basis for reissue (e.g., in the remarks accompanying an amendment). See **37 CFR 1.175(d)**. Identification of the error must be conspicuous and clear, and must comply with **35 U.S.C. 251**.

II. REISSUE APPLICATION FILED BEFORE SEPTEMBER 16, 2012

[Editor Note: See subsection I., above, for reissue applications filed on or after September 16, 2012.]

For applications filed before September 16, 2012, if additional defects or errors are corrected in the reissue after the filing of the application and the original reissue oath or declaration, a supplemental reissue oath/declaration must be filed, unless all additional errors corrected are spelling, grammar, typographical, editorial or clerical errors which are not errors under 35 U.S.C. 251 (see MPEP § 1402). In other words, a supplemental oath/declaration is required where any "error" under 35 U.S.C. 251 has been previously corrected, or is being corrected at the time the supplemental reissue oath/declaration is submitted, and the error was not identified in a previously filed reissue oath/declaration.

The supplemental reissue oath/declaration must state that every error which was corrected in the reissue application not covered by the prior oath(s)/declaration(s) submitted in the application arose without any deceptive intention on the part of the applicant

An example of acceptable language is as follows:

> "Every error in the patent which was corrected in the present reissue application, and is not covered by the prior declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

A supplemental reissue oath/declaration will not be effective for any errors which are corrected by a filing made after the execution of the supplemental reissue oath/declaration, unless it is clear from the record that the parties executing the document were aware of the nature of the correction when they executed the document. Further, a supplemental reissue oath/declaration with an early date of execution cannot be filed after a correction made later in time, to cover the correction made after the execution date. This is so, even if the supplemental reissue oath/declaration states that all errors up to the filing of the supplemental reissue oath/declaration oath or declaration arose without any deceptive intention on the part of the applicant.

Form PTO/SB/51S, "Supplemental Declaration For Reissue Patent Application To Correct 'Errors' Statement (**37 CFR 1.175**)," may be used to prepare a supplemental reissue declaration. Form PTO/SB/51S serves to indicate that every error in the patent that was corrected in the reissue application, but was not covered by a prior reissue oath/declaration submitted in the reissue application, arose without any deceptive intention on the part of the applicant.

In the event that the applicant for a reissue applicant is required to file a supplemental reissue oath/declaration that also includes a specific statement of the error being corrected by reissue in

accordance with **pre-AIA 37 CFR 1.175(c)**, as discussed in subsection A. below, applicant must also include in the supplemental declaration language equivalent to the "Every error …" language in the example of acceptable language set forth above. Therefore, if either form PTO/SB/51, "Reissue Application Declaration By The Inventor," or form PTO/SB/52, "Declaration By The Assignee" (see **MPEP § 1414**) is used for the purpose of filing such supplemental reissue oath/declaration, the form must be completed so that it is clear that the supplemental reissue oath/declaration addresses all errors corrected subsequent to the date upon which the last previous reissue oath/declaration (whether original or supplemental) was filed. For example, the form could be completed by specifying the date upon which the reissue application was originally filed, the reissue application number, and the date(s) of every amendment filed subsequent to the date upon which the last reissue oath/declaration (whether original or supplemental) was filed. Any manner of completing the form so that affiant/declarant unambiguously states that every error corrected subsequent to the filing of the last filed reissue oath/declaration (whether original or supplemental) arose without deceptive intent will be acceptable. It will not be acceptable for a newly filed supplemental oath/declaration to simply refer to the reissue application as filed, even though the new oath/declaration may be submitted after an amendment.

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

In the supplemental reissue oath/declaration, there is **no need to specifically identify any additional error** which is relied upon to support the reissue application **if**:

(A) an error to support a reissue has been previously and properly stated in a reissue oath/declaration in the publication; and

(B) that error is still being corrected in the reissue application.

If applicant chooses to state any further error at this point (even though such is not needed), the examiner should not review the statement of the further error.

The supplemental reissue oath/declaration must specifically identify an error which is relied upon to support the reissue application only where one of the following is true:

(A) the prior reissue oath/declaration failed to state an error;

(B) the prior reissue oath/declaration attempted to state an error but did not do so properly; or

(C) all errors under **35 U.S.C. 251** stated in the prior reissue oath(s)/declaration(s) are no longer being corrected in the reissue application.

B. Supplemental Oath/Declaration Must Be Submitted Before Allowance

The supplemental oath/declaration in accordance with **pre-AIA 37 CFR 1.175(b)(1)** must be submitted before allowance. See **MPEP § 1444** for a discussion of the action to be taken by the examiner to obtain the supplemental oath/declaration in accordance with **pre-AIA 37 CFR 1.175(b)(1)**, where such is needed.

Where applicant seeks to correct an error after allowance of the reissue application, a supplemental reissue oath/declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant. The supplemental reissue oath/declaration submitted after allowance will be directed to the error applicant seeks to correct after allowance. This supplemental oath/declaration need not cover any earlier errors, because all earlier errors should have been covered by a reissue oath/declaration submitted before allowance.

C. Supplemental Oath/Declaration In Broadening Reissue

A broadening reissue application must be applied for by all of the inventors (patentees), that is, the original reissue oath/declaration must be signed by all of the inventors. See MPEP § 1414. If a supplemental oath/declaration in a broadening reissue application is subsequently needed in the application in order to fulfill the requirements of 37 CFR 1.175, the supplemental reissue oath/declaration must be signed by all of the inventors. *In re Hayes*, 53 USPQ2d 1222, 1224 (Comm'r Pat. 1999) ("37 CFR 1.175(b)(1), taken in conjunction with Section

1.172, requires a supplemental declaration be signed by all of the inventors. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and declaration must bear the appropriate signatures of all the inventors.”).

If a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by all the available inventors may be filed provided it is accompanied by a petition under **37 CFR 1.183** along with the petition fee, requesting waiver of the signature requirement of the nonsigning inventor.

1415 Reissue Application and Issue Fees [R-11.2013]

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

For reissue applications, the following fees are required: basic filing fee as set forth in **37 CFR 1.16(e)**; search fee as set forth in **37 CFR 1.16(n)**; examination fee as set forth in **37 CFR 1.16(r)**; application size fee, if applicable (see subsection II. below); and excess claims fees, if applicable (see subsection III. below).

The basic filing, search and examination fees are due on filing of the reissue application. These fees may be paid on a date later than the filing date of the reissue application provided they are paid within the time period set forth in **37 CFR 1.53(f)** and include the surcharge set forth in **37 CFR 1.16(f)**.

For reissue applications in which a petition under **37 CFR 1.138(d)** to expressly abandon the application was filed applicant may file a request for refund of the search fee and excess claims fee paid in the application. See **MPEP § 711.01**.

II. APPLICATION SIZE FEE

37 CFR 1.16(s) sets forth the application size fee the specification and drawings of which, excluding a sequence listing or computer program listing filed in an electronic medium in compliance with the rules (see **37 CFR 1.52(f)**), exceed 100 sheets of paper. The application size fee applies for each additional 50 sheets or fraction thereof over 100 sheets of paper. Any sequence listing in an electronic medium in compliance with **37 CFR 1.52(e)** and **37 CFR 1.821(c)** or (e), and any computer program listing filed in an electronic medium in compliance with **37 CFR 1.52(e)** and **1.96**, will be excluded when determining the application size fee required by **37 CFR 1.16(s)**. See also **MPEP § 607**.

III. EXCESS CLAIMS FEES

37 CFR 1.16(h) sets forth the excess claims fee for each independent claim in excess of three. **37 CFR 1.16(i)** sets forth the excess claims fee for each claim (whether independent or dependent) in excess of twenty. For reissue applications filed on or after December 8, 2004, in which a petition under **37 CFR 1.138(d)** to expressly abandon the application was filed on or after March 10, 2006, applicant may file a request for refund of the search fee and excess claims fee paid in the application. See **MPEP § 711.01**.

Under 37 CFR 1.16(h) and (i), the number of claims in the original patent is <u>not</u> relevant in determining the excess claims fee for a reissue application.

Example:

Applicant filed a reissue application with the same number of claims as in the patent. The patent has 4 independent claims and 21 total claims. Excess claims fees for the 4th independent claim (one additional independent claim per the fee set forth in **37 CFR 1.16(h)**) and the 21st claim (one additional total claim per the fee set forth in **37 CFR 1.16(i)**) are required. Under **37 CFR 1.16(h)** and **(i)** , the number of claims in the original patent is not relevant in determining the excess claims fees for a reissue application.

The excess claims fees, if any, due with an amendment are required before any consideration of the amendment by the examiner. Upon submission of an amendment (whether entered or not) affecting the claims, payment of fees for those claims in excess of the number previously paid for is required. The additional fees, if any, due with an amendment are calculated on the basis of the claims (total and independent) which would be present, if the

amendment were entered. If an amendment is limited to revising the existing claims and it does not result in the addition of any new claim, there is no excess claim fee. Excess claims fees apply only to the addition of claims. It is to be noted that where excess claims fees have been previously paid, a later amendment affecting the claims cannot serve as the basis for granting any refund. See **37 CFR 1.26(a)**.

Amendments filed before a first Office action, or otherwise not filed in reply to an Office action, presenting additional claims in excess of the number already paid for, not accompanied by the full additional claims fee due, will not be entered in whole or in part and applicant will be so notified. Such amendments filed in reply to an Office action will be regarded as being non-responsive to the Office action and the practice set forth in **MPEP § 714.03** will be followed.

An amendment canceling claims accompanying the papers constituting the reissue application will be effective to diminish the number of claims to be considered in calculating the filing fees to be paid. A preliminary amendment filed concurrently with a reply to a Notice To File Missing Parts of Application that required the filing fees, which preliminary amendment cancels or adds claims, will be taken into account in determining the appropriate filing fees due in response to the Notice To File Missing Parts of Application. However, no refund will be made for claims being canceled in the reply that have already been paid for. After a requirement for restriction, non-elected claims will be included in determining the fees due in connection with a subsequent amendment unless such claims are canceled.

IV. ISSUE FEE

The issue fee for issuing each reissue patent is set forth in **37 CFR 1.18(a)**.

V. REISSUE APPLICATION FEE TRANSMITTAL FORM

The Office has prepared Form PTO/SB/56, Reissue Application Fee Transmittal Forms which are designed to assist in the correct calculation of reissue filing fees. For reissue applications filed on or after September 16, 2012, use Form PTO/AIA/50; for reissue applications filed before September 16, 2012, use Form PTO/SB/56. These forms are available at http://www.uspto.gov/forms/index.jsp.

1415.01 Maintenance Fees on the Original Patent [R-11.2013]

The filing of a reissue application does not alter the schedule of payments of maintenance fees on the original patent. If maintenance fees have not been paid on the original patent as required by **35 U.S.C. 41(b)** and **37 CFR 1.20**, and the patent has expired, no reissue patent can be granted. **35 U.S.C. 251**, only authorizes the granting of a reissue patent for the unexpired term of the original patent. Once a patent has expired, the Director of the USPTO no longer has the authority under **35 U.S.C. 251** to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

The examiner should determine whether all required maintenance fees have been paid *before conducting an examination* of a reissue application. In addition, during the process of preparing the reissue application for issue, the examiner should again determine whether all maintenance fees required to date have been paid.

The history of maintenance fees is determined by the following, all of which should be used (to provide a check on the search made):

(A) Go to the USPTO Intranet and select the PALM screen, then the “General Information” screen, type in the patent number and then select the “Fees” screen.

(B) Go to the USPTO Intranet and then the “Revenue Accounting and Management” screen, then the “Fee History” screen. Then type in the patent number.

(C) Go to the USPTO Internet Site at http://www.uspto.gov/patents/process/status/, select Public PAIR, type in the patent number and select the "Fees" screen.If the window for the maintenance fee due has closed (maintenance fees are due by the day of the 4th, 8th and 12th year anniversary of the grant of the patent), but the maintenance fee has not been paid, the Office of Patent Legal Administration (OPLA) should be contacted by the Technology

Center (TC) Special Program Examiner (SPRE) or appropriate Quality Assurance Specialist (TC QAS) for instructions as to what appropriate action to take.

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

Pursuant to **37 CFR 1.362(b)**, maintenance fees are not required for a reissue patent if the original patent that was reissued did not require maintenance fees. Design and plant patents do not require the payment of maintenance fees. See 37 CFR 1.362(b).

Where the original patent that was reissued did require maintenance fees, the schedule of payments of maintenance fees on the original patent will continue for the reissue patent. **37 CFR 1.362(h)**. Once an original patent reissues, maintenance fees are no longer due in the original patent, but rather the maintenance fees are due in the reissue patent. This is because upon the issuance of the reissue patent, the original patent is surrendered and ceases to exist.

In some instances, more than one reissue patent will be granted to replace a single original patent. The issuance of more than one reissue patent does not alter the schedule of payments of maintenance fees on the original patent. The existence of multiple reissue patents for one original patent can arise where multiple divisional reissue applications are filed for the same patent, and the multiple applications issue as reissue patents (all to replace the same original patent). In addition, a divisional application or continuation application of an existing reissue application may be filed, and both may then issue as reissue patents. A single maintenance fee is required for all reissue patents that replace the single original patent. The maintenance fee must be directed to the latest reissue patent that has issued, i.e., the reissue patent with the highest reissue patent number.

See **MPEP Chapter 2500** for additional information pertaining to maintenance fees.

1416 No Physical Surrender of Original Patent [R-11.2013]

37 CFR 1.178 Original patent; continuing duty of applicant.

(a) The application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent. Until a reissue application is granted, the original patent shall remain in effect.

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Pursuant to 37 CFR 1.178(a), surrender of the patent for which reissue is requested is automatic upon the grant of the reissue patent; physical surrender is not required. Prior to October 21, 2004, a reissue applicant was required to physically surrender the letters patent (i.e., the "ribbon copy" of the patent for which reissue was requested) before the reissue application would be granted. Where the patentee has submitted the original letters patent in a reissue application the Office may, in response to a timely request, return the original letters patent, when it can be readily retrieved from where it is stored, namely, the paper application file, or the artifact storage area for an Image File Wrapper (IFW) file. Any request for return of the letters patent which is submitted after the issue fee has been paid will require a petition pursuant to 37 CFR 1.59(b) to expunge from the file and return the original letters patent. Where the original letters patent cannot be readily retrieved, or in the rare instance that it has been subsequently misplaced, the Office will not be able to return the original letters patent and will not create a new one.

1417 Claim for Priority Under 35 U.S.C. 119(a)-(d) [R-11.2013]

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

A claim for priority to an earlier filing date in a foreign country under **35 U.S.C. 119(a)-(d)** must be made in a reissue application, even though such a claim was previously made in the application for the original patent to be reissued. However, no additional certified copy of the foreign application is necessary. See **MPEP § 215** For reissue applications filed on or after September 16, 2012, the foreign priority information for the priority claim must be presented in an application data sheet (ADS) under 37 CFR 1.76. For applications filed prior to September 16, 2012, unless provided in an application data sheet, pre-AIA 37 CFR 1.63 requires that the oath or declaration must identify the foreign application for patent or inventor's certificate for which priority is claimed under 37 CFR 1.55, and any foreign applications having a filing date before that of the application on which priority is claimed, by

specifying the application number, country, day, month, and year of its filing. See MPEP § 214.01.

The examiner should note that the heading on printed copies of the patent will not be carried forward to the reissue from the original patent. Therefore, it is important that the PALM bibliographic data sheet accurately list the application number, country (or intellectual property authority), day, month, and year of each foreign application that the U.S. application is claiming the priority of. Should there be an error, the examiner should make the appropriate corrections on the PALM bib-data sheet by crossing out incorrect information with the Strike-Out Line tool in Adobe Acrobat and using the Typewriter tool to insert corrections. The examiner must also indicate on the Office action and on the PALM bib-data sheet whether the conditions of 35 U.S.C. 119(a)-(d) or (f) have been met.

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

A reissue was granted in *Brenner v. State of Israel* , 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under **35 U.S.C. 119(a)-(d)** before the patent was granted. In *Brenner* , the claim for priority had been made in the prosecution of the original patent, and it was only necessary to submit a certified copy of the priority document in the reissue application to perfect priority (the claim for priority must be repeated in the reissue application). Reissue is also available to correct the "error" in failing to take any steps to obtain the right of foreign priority under **35 U.S.C. 119(a)-(d)** before the original patent was granted. See *Fontijn v. Okamoto* , 518 F.2d 610, 622, 186 USPQ 97, 106 (CCPA 1975) ("a patent may be reissued for the purpose of establishing a claim to priority which was not asserted, or which was not perfected during the prosecution of the original application") In a situation where it is necessary to submit for the first time both the claim for priority and the certified copy of the priority document in the reissue application and the patent to be reissued resulted from a utility or plant application filed on or after November 29, 2000, the reissue applicant will have to file a petition for an unintentionally delayed priority claim under 37 CFR 1.55(e) (for reissue applications filed on or after March 16, 2013) or **pre-AIA 37 CFR 1.55(c)** (for reissue applications filed before March 16, 2013) in addition to filing a reissue application. See **MPEP § 214.02**. See **MPEP § 1481.03** for correction of a benefit claim via a Certificate of Correction.

1418 Notification of Prior/Concurrent Proceedings and Decisions Thereon, and of Information Known To Be Material to Patentability [R-11.2013]

37 CFR 1.178 Original patent; continuing duty of applicant.

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(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigations and the results of such proceedings (see also § **1.173(a)(1)).**

37 CFR 1.178(b) requires reissue applicants to call to the attention of the Office any prior or concurrent proceeding in which the patent (for which reissue is requested) is or was involved and the results of such proceedings. These proceedings would include interferences or trials before the Patent Trial and Appeal Board, reissues, reexaminations, and litigations. Litigation would encompass any papers filed in the court or issued by the court, which may include, for example, motions, pleadings, and court decisions. This duty to submit information is continuing, and runs from the time the reissue application is filed until the reissue application is abandoned or issues as a reissue patent.

In addition, a reissue application is subject to the same duty of disclosure requirements as is any other nonprovisional application. A person may not execute an oath or declaration unless that person is "aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56." **37 CFR 1.63**. For reissue applications filed before September 16, 2012, the provisions of **pre-AIA 37 CFR 1.63** require acknowledgment of this duty of disclosure in the reissue oath or declaration. Note that the Office imposes no responsibility on a reissue applicant to resubmit, in a reissue application, all the "References Cited" in the patent for which reissue is sought. Rather, applicant has a continuing duty under **37 CFR 1.56** to timely apprise the Office

of any information which is material to the patentability of the claims under consideration in the reissue application.

37 CFR 1.97 and 37 CFR 1.98 provide a mechanism to submit information known to applicants to be material to patentability. Information submitted in compliance with **37 CFR 1.97** and **37 CFR 1.98** will be considered by the Office. See **MPEP § 609**. Although a reissue applicant may utilize **37 CFR 1.97** and **37 CFR 1.98** to comply with the duty of disclosure required by **37 CFR 1.56**, this does not relieve applicant of the duties under **37 CFR 1.175** of, for example, stating "at least one error being relied upon."

While **37 CFR 1.97(b)** provides for the filing of an information disclosure statement within 3 months of the filing of an application or before the mailing date of a first Office action, reissue applicants are encouraged to file information disclosure statements at the time of filing of the reissue application so that such statements will be available to the public during the 2-month period provided in **MPEP § 1441**. Form paragraph 14.11.01 may be used to remind applicant of the duties to timely make the Office aware of (A) any prior or concurrent proceeding (e.g., litigation or Office proceedings) in which the patent to be reissued is or was involved, and (B) any information which is material to patentability of the claims in the reissue application.

¶ *14.11.01 Reminder of Duties Imposed by 37 CFR 1.178(b) and 37 CFR 1.56*

Applicant is reminded of the continuing obligation under **37 CFR 1.178(b)**, to timely apprise the Office of any prior or concurrent proceeding in which Patent No. **[1]** is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under **37 CFR 1.56**, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also **MPEP §§ 1404**, **1442.01** and **1442.04**.

Examiner Note:

1. This form paragraph is to be used in the first action in a reissue application.

2. In bracket 1, insert the patent number of the original patent for which reissue is requested.

1419-1429 [Reserved]

1430 Reissue Files Open to the Public and, Notice of Filing Reissue Announced in, *Official Gazette* [R-11.2013]

37 CFR 1.11 Files open to the public.

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(b) All reissue applications, all applications in which the Office has accepted a request to open the complete application to inspection by the public, and related papers in the application file, are open to inspection by the public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications, other than continued prosecution applications under § 1.53(d) of reissue applications, will be announced in the *Official Gazette*. The announcement shall include at least the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and examining group to which the reissue application is assigned.

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Under **37 CFR 1.11(b)** all reissue applications filed are open to inspection by the general public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications (except for continued prosecution applications (CPA's) filed under **37 CFR 1.53(d)**) will be announced in the *Official Gazette*. The announcement gives interested members of the public an opportunity to submit to the examiner information pertinent to the patentability of the reissue application. The announcement includes the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor(s), name of the owner of record, name of the attorney or agent of record, and the Technology Center (TC) to which the reissue application is initially assigned. Where a reissue application seeks to change the inventorship of a patent, the names of the inventors of record of the patent file are set forth in the announcement, not the filing receipt, which sets forth the names of the inventors that the reissue application is seeking to make of record upon reissue of the patent.

IFW reissue application files are open to inspection by the general public by way of Public PAIR via the USPTO Internet site. In viewing the images of the files, members of the public will be able to view the entire content of the reissue application file history. To access Public PAIR, a member of the public

would go to the USPTO Web site at **www.uspto.gov/patents/process/status/**, and click on "Public PAIR."

Where a "Notice to File Missing Parts of Reissue Application – Filing Date Granted" has been mailed by the Office for a reissue application, the reissue application will not necessarily be announced in the *Official Gazette* until all elements of the Notice to File Missing Parts have been complied with. This is because the information required by **37 CFR 1.11(b)** for the *Official Gazette* announcement may be missing as indicated in the Notice to File Missing Parts. A notice of a reissue application in the *Official Gazette* should be published before any examination of the application. If an inadvertent failure to publish notice of the filing of the reissue application in the *Official Gazette* is recognized later in the examination, action should be taken to have the notice published as quickly as possible, and action on the application may be delayed until two months after the publication, allowing for any protests to be filed. For a discussion of protests, see MPEP Chapter **1900**.

The filing of a continued prosecution application (CPA) of a design reissue application under **37 CFR 1.53(d)** (effective July 14, 2003, CPA practice was eliminated as to utility and plant applications) will not be announced in the *Official Gazette.* Although the filing of a CPA of a design reissue application constitutes the filing of a reissue application, the announcement of the filing of such CPA would be redundant in view of the announcement of the filing of the prior reissue application in the *Official Gazette* and the fact that the same application number and file will continue to be used for the CPA.

If applicant files a Request for Continued Examination (RCE) of the reissue application under **37 CFR 1.114** (which can be filed on or after May 29, 2000 for a reissue application filed on or after June 8, 1995), such filing will not be announced in the *Official Gazette*. An RCE continues prosecution of the existing reissue application and is not a filing of a new application.

The filing of all reissue applications, except for design reissue CPAs filed under **37 CFR 1.53(d)**, (note that effective July 14, 2003, CPA practice has been eliminated as to utility and plant application) will be announced in the *Official Gazette* and will include certain identifying data as specified in **37 CFR 1.11(b)**.

1431-1439 [Reserved]

1440 Examination of Reissue Application [R-11.2013]

37 CFR 1.176 Examination of reissue.

(a) 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 applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

37 CFR 1.176 provides that an original claim, if re-presented in a reissue application, will be fully examined in the same manner, and subject to the same rules as if being presented for the first time in an original non-reissue, nonprovisional application, except that division will not be required by the examiner. See **MPEP § 1450** and § **1451**. As discussed below, however, the prior art available during the examination of the reissue application may differ from that available during the examination of the patent for which reissue is requested depending on the effective filing date of the claims in the reissue application. In addition, the application will be examined with respect to compliance with **37 CFR 1.171**-**1.178** relating specifically to reissue applications, for example, the reissue oath or declaration will be carefully reviewed for compliance with **37 CFR 1.175**. See **MPEP § 1444** for handling applications in which the oath or declaration lacks compliance with **37 CFR 1.175**. Reissue applications with related litigation will be acted on by the examiner before any other special applications, and will be acted on immediately by the examiner, subject only to a 2-month delay after publication for examining reissue applications; see **MPEP § 1441**.

The original patent file wrapper/file history should always be reviewed when examining a reissue application thereof.

I. DETERMINING PATENTABILITY OVER THE PRIOR ART

The Leahy-Smith America Invents Act (AIA) revised 35 U.S.C. 102 and thereby, the standard to determine what prior art is available during examination of an application. See Public Law 112-29, 125 Stat. 284 (2011). The changes to 35 U.S.C. 102 and 103 in the AIA (first inventor to file provisions) do not apply to any application filed before March 16, 2013. Thus, any application filed before March 16, 2013, is governed by pre-AIA 35 U.S.C. 102 and 103. AIA 35 U.S.C. 102 and 103 apply to any patent application that contains or contained at any time a claim to a claimed invention that has an effective filing date that is on or after March 16, 2013. See MPEP §§ 2159 et seq. to determine whether an application is subject to examination under the AIA first inventor to file provisions, and MPEP §§ 2150 et seq. for examination of applications subject to those provisions.

The available prior art that can be applied during the examination of a reissue application is generally the same as that under which the original application was examined. In some cases, however, the reissue is subject to different available prior art than was the original application.

For example, a situation may arise where an application filed April 1, 2013, has a benefit claim to a prior application having a filing date of December 12, 2012, and all claims are fully supported by the 2012 application. In this situation, the 2013 application would be examined with respect to the prior art available under pre-AIA35 U.S.C. 102 and 103. If a reissue application is filed on the subsequent patent in which a claim presented must rely on the April 1, 2013 disclosure for 35 U.S.C. 112 support (i.e., cannot rely solely on the parent application), that newly presented claim has an effective filing date of April 1, 2013. In this situation, the ENTIRE reissue application is now subject to the prior art available under AIA first inventor to file provisions. See MPEP §§ 2151-2156 for a discussion of the prior art available under the first inventor to file provisions of the AIA. In addition, this reissue application would be subject to pre-AIA 35 U.S.C. 102(g), because pre-AIA 35 U.S.C. 102(g) applies to each claim of an application for patent, and any patent issued thereon, if such application or patent contains, or contained at any time: (1) A claim to an invention having an effective filing date as defined in 35 U.S.C. 100(i) that occurs before March 16, 2013; or (2) a specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or application that contains, or contained at any time, such a claim. See MPEP § 2159.03.

Another situation may arise in which a benefit claim to an application filed before March 16, 2013, is added in a reissue application based on an AIA patent. If all the claims ever presented in the reissue application and underlying patent are fully supported by the prior application filed before March 16, 2013, then the reissue application would be examined only under pre-AIA 35 U.S.C. 102 and 103 because the application was entitled to the benefit of the earlier filed application as evidenced by appropriate benefit claim to the filing date of the prior filed application.

1441 Two-Month Delay Period [R-08.2012]

37 CFR 1.176 provides that reissue applications will be acted on by the examiner in advance of other applications, i.e., "special." Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette* . The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under **37 CFR 1.291(a)**. For a discussion as to protests under **37 CFR 1.291(a)** in reissue applications, see **MPEP § 1441.01**. As set forth in **MPEP § 1901.04**, the public should be aware that such submissions should be made as early as possible, because under certain circumstances, the 2-month delay period will not be employed. For example, the Office may act on a continuation or a divisional reissue application before the expiration of the 2-month period after announcement. Additionally, the Office will entertain a petition under **37 CFR 1.182** which is accompanied by the required petition fee (**37 CFR 1.17(f)**) to act

on a reissue application without delaying for 2 months. Accordingly, protestors to reissue applications (see **MPEP § 1441.01**) cannot automatically assume that a full 2-month delay period will always be available. Appropriate reasons for requesting that the 2-month delay period not be employed include that litigation involving a patent has been stayed to permit the filing of an application for the reissue of the patent. Where the basis for the petition is ongoing litigation, the petition must clearly identify the litigation, and detail the specifics of the litigation that call for prompt action on the reissue application before the expiration of the 2-month delay period. Such petitions are decided by the Office of Patent Legal Administration.

1441.01 Protest and Preissuance Submission in Reissue Applications [R-11.2013]

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

A protest pursuant to **37 CFR 1.291** may be filed throughout the pendency of a reissue application, before the date of mailing of a notice of allowance, subject to the timing constraints of the examination, as set forth in **MPEP § 1901.04**. While a reissue application is not published under **37 CFR 1.211**, the reissue application is published pursuant to **35 U.S.C. 122(b)(1)(A)** via an announcement in the *Official Gazette* (and public availability of the file content) per **37 CFR 1.11(b)**. Such a publication does not preclude the filing of a protest. **35 U.S.C. 122(c)** states:

> (c) PROTEST AND PRE-ISSUANCE OPPOSITION- The Director shall establish appropriate procedures to ensure that **no protest or other form of pre-issuance opposition** to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.[Emphasis added.]

A protest is precluded after publication for an application for an original patent, as a "form of pre-issuance opposition." A reissue application is a post-issuance proceeding. A protest filed in a reissue application is not a "form of pre-issuance opposition to the grant of a patent" because the patent to be reissued has already been granted. Thus, the prohibition against the filing of a protest after publication of an application under **35 U.S.C. 122(c)** is not applicable to a reissue application and a protest is permitted after publication of the reissue application.

Because a reissue application is a post-issuance proceeding, a preissuance submission under 35 U.S.C. 122(e) is not permitted to be filed in a reissue application; 35 U.S.C. 122(e) is limited to preissuance submissions by third parties in patent applications. Third parties who have a need to submit information in a reissue application are advised to avail themselves of the protest provisions of 37 CFR 1.291. In an instance when a preissuance submission under 35 U.S.C. 122(e) is filed in a reissue application, the preissuance submission will be treated by the Office as a protest, if the preissuance submission complies with the provisions of 37 CFR 1.291.

II. TIME PERIOD FOR FILING PROTEST

A protest with regard to a reissue application should be filed within the 2-month period following the announcement of the filing of the reissue application in the Official Gazette. A potential protestor should be aware that reissue applications are taken up "special" and a protest filed outside the 2-month delay period may be received after action by the examiner. Further, if a protest is filed after a final rejection has been issued or prosecution on the merits has been otherwise closed for the reissue application, a petition for entry of the protest under 37 CFR 1.182 is required. The petition must include an explanation as to why the additional time was necessary and the nature of the protest intended. A copy of the petition must be served upon the applicant in accordance with **37 CFR 1.248**. The petition should be directed to the Office of Petitions. A protest not filed prior to the date a notice of allowance under 37 CFR 1.311 is given or mailed will not be entered.

If the protest of a reissue application cannot be filed within the 2-month delay period, the protestor may petition to request (A) an extension of the 2-month period following the announcement in the *Official*

Gazette , and (B) a delay of the examination until the extended period expires. Such a request will be considered only if filed in the form of a petition under **37 CFR 1.182** and accompanied by the petition fee set forth in **37 CFR 1.17(f)**. The petition under **37 CFR 1.182** and the petition fee must be filed before the expiration of the 2-month period following the announcement of the filing of the reissue application in the *Official Gazette* . The petition must explain why the additional time is necessary and the nature of the protest intended. A copy of the petition must be served upon applicant in accordance with **37 CFR 1.248**. The petition should be directed to the appropriate Technology Center (TC) which will forward the petition to the Office of Patent Legal Administration.

If the protest is a "REISSUE LITIGATION" protest, it is particularly important that it be filed early if protestor wishes it considered at the time the Office first acts on the reissue application. Protestors should be aware that the Office will entertain petitions from the reissue applicants under **37 CFR 1.182** to waive the 2-month delay period in appropriate circumstances. Accordingly, protestors to reissue applications cannot automatically assume that the full 2-month delay period will always be available.

The Technology Center (TC) to which the reissue application is assigned is listed in the *Official Gazette* notice of filing of the reissue application. Accordingly, the indicated TC should retain jurisdiction over the reissue application file for 2 months after the date of the *Official Gazette* notice before transferring the reissue application under the procedure set forth in **MPEP § 903.08(d)**.

The publication of a notice of a reissue application in the *Official Gazette* should be done before to any examination of the reissue application. If an inadvertent failure to publish notice of the filing of the reissue application in the *Official Gazette* is recognized later in the examination, action should be taken to have the notice published as quickly as possible, and action on the reissue application may be delayed until 2 months after the publication, allowing for any protests to be filed.

See **MPEP § 1901.06** for general procedures on examiner treatment of protests in reissue applications.

1442 Special Status [R-08.2012]

All reissue applications are taken up "special," and remain "special" even if applicant does not respond promptly.

All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other "special" applications; this means that all issues not deferred will be treated and responded to immediately. Furthermore, reissue applications involved in litigation will be taken up for action in advance of other reissue applications.

1442.01 Litigation-Related Reissues [R-11.2013]

During initial review, the examiner should determine whether the patent for which the reissue has been filed is involved in litigation, and if so, the status of that litigation. If the examiner becomes aware of litigation involving the patent sought to be reissued during examination of the reissue application, the examiner should first check MPEP § 1442.02 to determine whether prosecution in the reissue application should be suspended. If prosecution will not be suspended, and applicant has not made the details regarding that litigation of record in the reissue application, the examiner, in the next Office action, will inquire regarding the specific details of the litigation.

Form paragraph 14.06 may be used for such an inquiry.

¶ *14.06 Litigation-Related Reissue*

The patent sought to be reissued by this application **[1]** involved in litigation. Any documents and/or materials which would be material to patentability of this reissue application are required to be made of record in response to this action.

Due to the related litigation status of this application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF **37 CFR 1.136(a)** WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION.

Examiner Note:

In bracket 1, insert either —is— or —has been—.

If additional details of the litigation appear to be material to examination of the reissue application, the examiner may make such additional inquiries as necessary and appropriate.

For reissue application files that are maintained in the Image File Wrapper (IFW) system, if the existence of litigation has not already been noted, the examiner should annotate the printed bibliographic data sheet such that adequate notice is provided of the existence of the litigation.

Applicants will normally be given 1 month to reply to Office actions in all reissue applications that are being examined during litigation, or after litigation had been stayed, dismissed, etc., to allow for consideration of the reissue by the Office. This 1-month period may be extended only upon a showing of *clear justification* under **37 CFR 1.136(b)**. The Office action will inform applicant that the provisions of **37 CFR 1.136(a)** are not available. Of course, up to 3 months may be initially set for reply if the examiner, consultating with his/her supervisor, determines such a period is clearly justified.

1442.02 Concurrent Litigation [R-11.2013]

To avoid duplicating effort, action in reissue applications in which there is an indication of concurrent litigation will be suspended *sua sponte* unless and until it is evident to the examiner, or the applicant indicates, that any one of the following applies:

(A) a stay of the litigation is in effect;
(B) the litigation has been terminated;
(C) there are no significant overlapping issues between the application and the litigation; or
(D) it is applicant's desire that the application be examined at that time.

Where any of (A) - (D) above apply, form paragraphs 14.08-14.10 may be used to deny a suspension of action in the reissue, i.e., to deny a stay of the reissue proceeding.

¶ *14.08 Action in Reissue Not Stayed — Related Litigation Terminated*

Since the litigation related to this reissue application is terminated and final, action in this reissue application will NOT be stayed. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF **37 CFR 1.136(a)** WILL NOT BE PERMITTED.

¶ *14.09 Action in Reissue Not Stayed — Related Litigation Not Overlapping*

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because there are no significant overlapping issues between the application and that litigation. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF **37 CFR 1.136(a)** WILL NOT BE PERMITTED.

¶ *14.10 Action in Reissue Not Stayed — Applicant's Request*

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF **37 CFR 1.136(a)** WILL NOT BE PERMITTED.

Where none of (A) through (D) above apply, action in the reissue application in which there is an indication of concurrent litigation will be suspended by the examiner. The examiner should consult with the Technology Center Training Quality Assurance Specialist (TQAS)before suspending action in the reissue application. Form paragraph 14.11 may be used to suspend action, i.e., stay action, in a reissue application with concurrent litigation.

¶ *14.11 Action in Reissue Stayed - Related Litigation*

In view of concurrent litigation, and in order to avoid duplication of effort between the two proceedings, action in this reissue application is STAYED until such time as it is evident to the examiner that (1) a stay of the litigation is in effect, (2) the litigation has been terminated, (3) there are no significant overlapping issues between the application and the litigation, or (4) applicant requests that the application be examined.

An *ex parte* reexamination proceeding will **not** be stayed where there is litigation. See *Ethicon v. Quigg* , 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). Thus, where a reissue application has been merged with an *ex parte* reexamination proceeding, the merged proceeding will **not** be stayed where there is litigation. In a merged *ex parte* reexamination/reissue proceeding, the *ex parte* reexamination will control because of the *statutory* (**35 U.S.C. 305**) requirement that *ex parte* reexamination proceedings be conducted with special dispatch. See **MPEP § 2285** and § **2286**. As to a stay or suspension where reissue proceedings are merged

with *inter partes* reexamination proceedings, see **37 CFR 1.937** and **MPEP § 2686**.

1442.03 Litigation Stayed [R-11.2013]

All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other "special" applications; this means that all issues not deferred will be treated and responded to *immediately*. Furthermore, reissue applications involved in "stayed litigation" will be taken up for action in advance of other reissue applications. Great emphasis is placed on the expedited processing of such reissue applications. The courts are especially interested in expedited processing in the Office where litigation is stayed.

In reissue applications with "stayed litigation," the Office will entertain petitions under **37 CFR 1.182**, which are accompanied by the fee under **37 CFR 1.17(f)**, to not apply the 2-month delay period stated in MPEP § 1441. Such petitions are decided by the Office of Patent Legal Administration.

Time-monitoring systems have been put into effect which will closely monitor the time used by applicants, protestors, and examiners in processing reissue applications of patents involved in litigation in which the court has stayed further action. Monthly reports on the status of reissue applications with related litigation are required from each Technology Center (TC). Delays in reissue processing are to be followed up. The TC Training Quality Assurance Specialist (TQAS) is responsible for oversight of reissue applications with related litigation.

The purpose of these procedures and those deferring consideration of certain issues, until all other issues are resolved or the application is otherwise ready for consideration by the P (note **MPEP § 1448**), is to reduce the time between filing of the reissue application and final action thereon, while still giving all parties sufficient time to be heard.

Requests for stays or suspension of action in reissues where litigation has been stayed may be answered with form paragraph 14.07.

¶ *14.07 Action in Reissue Not Stayed or Suspended — Related Litigation Stayed*

While there is a stay of the concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed or suspended because a stay of that litigation is in effect for the purpose of awaiting the outcome of these reissue proceedings. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF **37 CFR 1.136(a)** WILL NOT BE PERMITTED.

If concurrently a reissue application and an *inter partes* review, post grant review proceeding, or covered business method review ("PTAB Review Proceeding") are copending, the Director may determine the manner in which the PTAB Review Proceeding and the other proceeding or matter (*e.g.*, the reissue application) may proceed, including a stay, transfer, consolidation or termination of such matter or proceeding. See 35 U.S.C. 315(d) and 35 U.S.C. 325(d) and 37 CFR 42.122 and 37 CFR 42.222.

1442.04 Litigation Involving Patent [R-11.2013]

37 CFR 1.178 Original patent; continuing duty of applicant.

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(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigations and the results of such proceedings (see also § **1.173(a)(1)**).

Where the patent for which reissue is being sought is, or has been, involved in litigation, the applicant should bring the existence of such litigation to the attention of the Office. **37 CFR 1.178(b)**. This should be done at the time of, or shortly after, the applicant files the application, either in the reissue oath or declaration, or in a separate paper, preferably accompanying the application as filed. Litigation begun after filing of the reissue application also should be promptly brought to the attention of the Office. Additional proceedings that should be called to the attention of the Office include derivation, post-grant review, inter partes review, and covered business method proceedings.

Litigation encompasses any papers filed in the court or issued by the court. This may include, for example, motions, pleadings, and court decisions, as well as the results of such proceedings. When applicant notifies the Office of the existence of the litigation, enough information should be submitted so that the Office can reasonably evaluate the need for asking for further materials in the litigation. Note

that the existence of supporting materials which may substantiate allegations of invalidity should, at least, be fully described, and preferably submitted. The Office is not interested in receiving voluminous litigation materials which are not relevant to the Office's consideration of the reissue application. The status of the litigation should be updated in the reissue application as soon as significant events happen in the litigation. When a reissue application is filed, the examiner should determine whether the original patent has been adjudicated by a court. The decision(s) of the court, and also other papers in the suit, may provide information essential to the examination of the reissue. Examiners should inform the applicant of the duty to supply information as to litigation involving the patent. Form paragraph 14.11.01 may be used for this purpose. See **MPEP § 1418**.

Additionally, the patented file will contain notices of the filing and termination of infringement suits on the patent. Such notices are required by law to be filed by the clerks of the Federal District Courts. These notices do not indicate if there was an opinion by the court, nor whether a decision was published. *Shepard's Federal Citations* and the cumulative digests of the *United States Patents Quarterly*, contain tables of patent numbers giving the citation of published decisions concerning the patent.

A litigation computer search by the Scientific and Technical Information Center (STIC) should be requested by the examiner to determine whether the patent has been, or is, involved in litigation. For IFW reissue application files, the "Search Notes" box on the OACS "Search Notes" page is annotated to indicate that the review was conducted, and the OACS "Search Notes" page is then scanned into the reissue application file history.

Additional information or guidance as to making a litigation search may be obtained from the library of the Office of the Solicitor. Where papers are not otherwise conveniently obtainable, the applicant may be requested to supply copies of papers and records in suits, or the Office of the Solicitor may be requested to obtain them from the court. The information thus obtained should be carefully considered for its bearing on the proposed claims of the reissue, particularly when the reissue application was filed in view of the holding of a court.

If the examiner becomes aware of litigation involving the patent sought to be reissued during examination of the reissue application, and applicant has not made the details regarding that litigation of record in the reissue application, the examiner, in the next Office action, should inquire regarding the same. Form paragraph 14.06 may be used for such an inquiry. See **MPEP § 1442.01**.

If the additional details of the litigation appear to be material to patentability of the reissue application, the examiner may make such additional inquiries as necessary and appropriate.

1442.05 Court Ordered Filing of Reissue Application [R-08.2012]

In most instances, the reissue-examination procedure is instituted by a patent owner who voluntarily files a reissue application as a consequence of related patent litigation. Some Federal district courts in earlier decisions have required a patentee-litigant to file a reissue application as a consequence of the patent litigation. However, the Court of Appeals for the Federal Circuit held in *Green v. The Rich Iron Co.*, 944 F.2d 852, 853, 20 USPQ2d 1075, 1076 (Fed. Cir. 1991) that a Federal district court in an infringement case could not compel a patentee to seek reissue by the USPTO.

It is to be noted that only a patentee or his or her assignee may file a reissue patent application. An order by a court for a different party to file a reissue will not be binding on the Office.

1443 Initial Examiner Review [R-11.2013]

As part of an examiner's preparation for the examination of a reissue application, the Examiner Reissue Guide and Checklist should be consulted for basic guidance and suggestions for handling the prosecution. The Technology Center (TC) Training Quality Assurance Specialists (TQASs) should make the Guide and Checklist available at the time a reissue application is docketed to an examiner.

On initial receipt of a reissue application, the examiner should inspect the submission under **37 CFR 1.172** as to documentary evidence of a chain of title from the original owner to the assignee to determine whether the consent requirement of **37 CFR 1.172** has been met. The examiner will compare the consent and documentary evidence of ownership; the assignee indicated by the documentary evidence must be the same assignee which signed the consent. Also, the person who signs the consent for the assignee and the person who signs the submission of evidence of ownership for the assignee must both be persons having authority to do so. See also **MPEP § 324** and **325**.

Where the application is assigned, and there is no submission under **37 CFR 1.172** as to documentary evidence in the application, the examiner should require the submission using form paragraph 14.16. Once the submission under **37 CFR 1.172** as to documentary evidence is received, it must be compared with the consent to determine whether the assignee indicated by the documentary evidence is the same assignee which signed the consent. See **MPEP § 1410.01** for further discussion as to the required consent and documentary evidence.

Where there is a statement of record that the application is **not** assigned, there should be no submission under **37 CFR 1.172** as to documentary evidence of ownership in the application, and none should be required by the examiner.

The filing of all reissue applications, except for continued prosecution applications (CPAs) (only available for design applications) filed under **37 CFR 1.53(d)**, must be announced in the *Official Gazette* . Accordingly, for any reissue application other than a CPA, the examiner should determine if the filing of the reissue application has been announced in the *Official Gazette* as provided in **37 CFR 1.11(b)**. The contents entry on the PALM Intranet Contents screen should be checked for the presence of "NRE" and "NOTICE OF REISSUE PUBLISHED IN *OFFICIAL GAZETTE*" entries in the contents, and the date of publication. If the filing of the reissue application has not been announced in the *Official Gazette*, jurisdiction over the reissue application should be returned to the Office of Patent Application Processing (Special Processing) to handle the announcement. The examiner should not further act on the reissue until 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. See **MPEP § 1440**.

The examiner should determine if there is concurrent litigation, and if so, the status thereof (**MPEP § 1442.01**), and whether the reissue file history has been appropriately marked. Note **MPEP § 1404**.

The examiner should determine if a protest has been filed, and if so, it should be handled as set forth in **MPEP § 1901.06**. For a discussion of protests under **37 CFR 1.291** in reissue applications, see **MPEP § 1441.01**.

The examiner should determine whether the patent is involved in an interference, and if so, should refer to **MPEP § 1449.01** before taking any action on the reissue application.

The examiner should verify that all Certificate of Correction changes have been properly incorporated into the reissue application. See **MPEP § 1411.01**.

The examiner should verify that the patent on which the reissue application is based has not expired, either because its term has run or because required maintenance fees have not been paid. Once a patent has expired, the Director of the USPTO no longer has the authority under **35 U.S.C. 251** to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1992). See also **MPEP § 1415.01**.

1444 Review of Reissue Oath/Declaration [R-11.2013]

I. REQUIREMENTS OF REISSUE OATH OR DECLARATION

The question of the sufficiency of the reissue oath/declaration filed under **37 CFR 1.175** must in each case be reviewed and decided personally by the primary examiner.

Much of the required content of a reissue oath or declaration will differ based on the filing date of the

reissue application. However, all 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; and

(B) A statement of at least one error which is relied upon to support the reissue application, i.e., as the basis for the reissue.

MPEP § 1414 describes the requirements for each of the aforementioned statements. See MPEP § 1414.01 for the remaining requirements for the reissue oath or declaration in a reissue application filed on or after September 16, 2012; § 1414.02 for the remaining requirements of a reissue oath or declaration in a reissue application filed before September 16, 2012; and § 1414.03 for supplemental reissue oaths or declarations in reissue applications.

II. REVIEW OF REISSUE OATH OR DECLARATION

An initial reissue oath/declaration is submitted with the reissue application (or within the time period set for filing the oath/declaration in a Notice To File Missing Parts under **37 CFR 1.53(f)**). Where the reissue oath/declaration fails to comply with **37 CFR 1.175(a)**, the examiner will so notify the applicant in an Office action, rejecting the claims under **35 U.S.C. 251**. In reply to the Office action, a replacement reissue oath/declaration should be submitted dealing with the noted defects in the reissue oath/declaration.

The examiner should carefully review the reissue oath/declaration in conjunction with the discussion in MPEP §§ 1414 et seq. in order to ensure that each element is provided in the oath/declaration. If the examiner's review of the oath/declaration reveals a lack of compliance with any of the requirements of **37 CFR 1.175**, a rejection of all the claims under **35 U.S.C. 251** should be made on the basis that the reissue oath/declaration is insufficient.

In preparing an Office action, the examiner should use form paragraphs 14.01 through 14.01.04 to state the objection(s) to the oath/declaration, i.e., the defects in the oath/declaration. These form paragraphs are reproduced in **MPEP § 1414**. The examiner should then use form paragraph 14.14 to reject the claims under **35 U.S.C. 251**, based upon the improper oath/declaration.

¶ *14.14 Rejection, Defective Reissue Oath or Declaration*

Claim **[1]** rejected as being based upon a defective reissue **[2]** under **35 U.S.C. 251** as set forth above. See **37 CFR 1.175**.

The nature of the defect(s) in the **[3]** is set forth in the discussion above in this Office action.

Examiner Note:

1. In bracket 1, list all claims in the reissue application. See **MPEP § 706.03(x)**.

2. This paragraph must be preceded by form paragraph 14.01 and should be preceded by form paragraphs 14.01.01 to 14.01.06 as appropriate

3. In brackets 2 and 3, insert either --oath-- or --declaration--.

A lack of the inventor's signature on a reissue oath/declaration (except as otherwise provided in 37 CFR 1.64 and 1.175(c) for applications filed on or after September 16, 2012, and **pre-AIA 37 CFR 1.42**, **1.43**, and **1.47** and in **37 CFR 1.172** for applications filed before September 16, 2012) would be considered a lack of compliance with **37 CFR 1.175(a)** and result in a rejection, including final rejection, of all the claims on the basis that the reissue oath/declaration is insufficient. If the unsigned reissue oath/declaration is submitted as part of a reply which is otherwise properly signed and responsive to the outstanding Office action, the reply should be accepted by the examiner as proper and responsive, and the oath/declaration considered fully in the next Office action. The reply should not be treated as an unsigned or improperly signed amendment (see **MPEP § 714.01(a)**), nor do the holdings of *Ex parte Quayle* apply in this situation. The lack of signature, along with any other oath/declaration deficiencies, should be noted in the next Office action *rejecting* the claims as being based upon an insufficient reissue oath/declaration.

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

A different situation may arise where the initial reissue oath/declaration does properly identify one or more errors under **35 U.S.C. 251** as being the basis for reissue, however, because of changes or amendments made during prosecution, none of the identified errors are relied upon any more. The required action will differ based on the filing date of the reissue application.

A. Application filed on or after September 16, 2012

For reissue applications filed on or after September 16, 2012 a supplemental reissue oath or declaration is not required where all errors previously identified in the reissue oath/declaration are no longer being relied upon as the basis for reissue. However, the applicant must explicitly identify an error being relied upon as the basis for reissue (e.g., in the remarks accompanying an amendment). See 37 CFR 1.175(f)(2). Identification of the error must be conspicuous and clear and must comply with 35 U.S.C. 251. Additionally, since applicant is not required to identify the new error in a reissue oath/declaration, identification of the error may not be deferred until the application is otherwise in condition for allowance.

B. Application filed before September 16, 2012

For reissue applications filed before September 16, 2012, where all errors previously identified in the reissue oath/declaration are no longer being replied upon as the basis for reissue, a supplemental oath/declaration will be needed to identify at least one error now being relied upon as the basis for reissue, even if a prior oath/declaration was earlier found proper by the examiner. The supplemental oath/declaration is not required to indicate that the error(s) identified in the prior oath(s)/declaration(s) is/are no longer being corrected. In this instance, applicant's submission of the supplemental reissue oath/declaration to obviate the rejection under 35 U.S.C. 251 may, at applicant's option, be deferred until the application is otherwise in condition for allowance. The submission can be deferred because a proper statement of error was provided in the initial reissue oath/declaration, and therefore applicant does not need to supply a supplemental reissue oath/declaration each time the error being corrected is changed. Applicant need only conspicuously and clearly identify the new error in the remarks section of the reply and request that submission of the supplemental reissue oath/declaration be deferred until allowance. Such a request will be considered a complete reply to the rejection.

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

*[Editor Note: This subsection **only applies** to reissue applications filed before September 16, 2012.]*

For applications filed before September 16, 2012, pre-AIA 37 CFR 1.175(b)(1) requires that for any error corrected which is not covered by a previously submitted compliant reissue oath or declaration, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant.

Once the reissue oath/declaration is found to comply with **pre-AIA 37 CFR 1.175(a)**, it is not required, nor is it suggested, that a new reissue oath/declaration be submitted together with each new amendment and correction of error in the patent. During the prosecution of a reissue application, amendments are often made and additional errors in the patent are corrected. The Office suggests that the reissue applicant wait until the case is in condition for allowance, and then submit a cumulative supplemental reissue oath/declaration pursuant to **pre-AIA 37 CFR 1.175(b)(1)**.

See **MPEP § 1414.03** for a discussion of the required content of a supplemental reissue oath/declaration under **pre-AIA 37 CFR 1.175(b)(1)**.

A supplemental oath/declaration under **pre-AIA 37 CFR 1.175(b)(1)** must be submitted before allowance. It may be submitted with any reply before allowance. It may be submitted to overcome a rejection under **35 U.S.C. 251** made by the examiner, where it is indicated that the submission of the

supplemental oath/declaration will overcome the rejection.

A supplemental oath/declaration under **pre-AIA 37 CFR 1.175(b)(1)** will be required where:

(A) the application is otherwise (other than the need for this supplemental oath/declaration) in condition for allowance;

(B) amendments or other corrections of errors in the patent have been made subsequent to the last oath/declaration filed in the application; and

(C) at least one of the amendments or other corrections corrects an error under **35 U.S.C. 251**.

When a supplemental oath/declaration under **pre-AIA 37 CFR 1.175(b)(1)** directed to the amendments or other corrections of error is required, the examiner is encouraged to telephone the applicant and request the submission of the supplemental oath/declaration by EFS-Web or fax. If the circumstances do not permit making a telephone call, or if applicant declines or is unable to promptly submit the oath/declaration, the examiner should issue a final Office action (final rejection) and use form paragraph 14.05.02 where the action issued is a second or subsequent action on the merits.

¶ *14.05.02.fti Supplemental Oath or Declaration Required Prior to Allowance - Application Filed Before Sept. 16, 2012*

In accordance with **pre-AIA 37 CFR 1.175(b)(1)**, for applications filed before September 16, 2012, a supplemental reissue oath/declaration must be received before this reissue application can be allowed.

Claim **[1]** rejected as being based upon a defective reissue **[2]** under **35 U.S.C. 251**. See **37 CFR 1.175**. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration will overcome this rejection. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

> "Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

See **MPEP § 1414.01**.

Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert either --oath-- or --declaration--.
3. This form paragraph is used in an Office action to: (a) remind applicant of the requirement for submission of the supplemental reissue oath/declaration under **pre-AIA 37 CFR 1.175(b)(1)** before allowance and (b) at the same time, reject all the claims since the reissue application is defective until the supplemental oath/declaration is submitted.
4. Do not use this form paragraph in a reissue application filed on or after September 16, 2012.
5. Do not use this form paragraph if no amendments (or other corrections of the patent) have been made subsequent to the last oath/declaration filed in the case; instead allow the case.
6. This form paragraph cannot be used in an *Ex parte Quayle* action to require the supplemental oath/declaration, because the rejection under **35 U.S.C. 251** is more than a matter of form.
7. Do not use this form paragraph in an examiner's amendment. The supplemental oath/declaration must be filed prior to mailing of the Notice of Allowability.

As noted above, the examiner will issue a final Office action where the application is otherwise in condition for allowance, and amendments or other corrections of error in the patent have been made subsequent to the last oath/declaration filed in the application. The examiner will be introducing (via form paragraph 14.05.02) a rejection into the case for the first time in the prosecution, when the claims have been determined to be otherwise allowable. This introduction of a new ground of rejection under **35 U.S.C. 251** will not prevent the action from being made final on a second or subsequent action because of the following factors:

(A) The finding of the case in condition for allowance is the first opportunity that the examiner has to make the rejection;

(B) The rejection is being made in reply to, i.e., was caused by, an amendment of the application (to correct errors in the patent);

(C) All applicants are on notice that this rejection will be made upon finding of the case otherwise in condition for allowance where errors have been corrected subsequent to the last oath/declaration filed in the case, so that the rejection should have been expected by applicant; and

(D) The rejection will not prevent applicant from exercising any rights to cure the rejection, because applicant need only submit a supplemental oath/declaration with the above-described language, and it will be entered to cure the rejection.

Where the application is in condition for allowance and **no amendments or other corrections of error in the patent have been made subsequent to the**

last oath/declaration filed in the application, a supplemental reissue oath/declaration under **pre-AIA 37 CFR 1.175(b)(1)should not be required by the examiner**. Instead, the examiner should issue a Notice of Allowability indicating allowance of the claims.

V. AFTER ALLOWANCE

Where applicant seeks to correct an error after allowance of the application, any amendment of the patent correcting the error must be submitted in accordance with **37 CFR 1.312**. As set forth in **37 CFR 1.312**, no amendment may be made as a matter of right in an application after the mailing of the notice of allowance. An amendment filed under **37 CFR 1.312** must be filed before or with the payment of the issue fee and may be entered on the recommendation of the primary examiner, and approved by the supervisory patent examiner, without withdrawing the case from issue.

Because the amendment seeks to correct an error in the patent, the amendment will affect the disclosure, the scope of a claim, or add a claim. Thus, in accordance with **MPEP § 714.16**, the remarks accompanying the amendment must fully and clearly state:

(A) why the amendment is needed;
(B) why the proposed amended or new claims require no additional search or examination;
(C) why the claims are patentable; and
(D) why they were not presented earlier.

For reissue applications field before September 16, 2012, a supplemental reissue oath/declaration must accompany the amendment. The supplemental reissue oath/declaration must state that the error(s) to be corrected arose without any deceptive intention on the part of the applicant. The supplemental reissue oath/declaration submitted after allowance must be directed to the error(s) applicant seeks to correct after allowance. This oath/declaration need not cover any earlier errors, because all earlier errors should have been covered by a reissue oath/declaration submitted before allowance.

Occasionally, correcting an error after allowance does not include an amendment of the specification or claims of the patent. For example, the correction of the error could be the filing of a certified copy of the original foreign application (before the payment of the issue fee. See **37 CFR 1.55(g)(1)**(for applications filed on or after March 16, 2013) and **pre-AIA 37 CFR 1.55(a)(2)** (for applications filed before March 16, 2013) to obtain the right of foreign priority under **35 U.S.C. 119** also see *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968) (the claim for foreign priority had been timely made in the application for the original patent). In such a case, the requirements of **37 CFR 1.312** must still be met. This is so, because the correction of the patent is an amendment of the patent, even though no amendment is physically entered into the case. Thus, for a reissue oath/declaration submitted after allowance to correct an additional error (or errors), the reissue applicant must comply with **37 CFR 1.312** in the manner discussed above.

1445 Reissue Application Examined in Same Manner as Original Application [R-11.2013]

As stated in **37 CFR 1.176**, a reissue application, including all the claims therein, is subject to "be examined in the same manner as a non-reissue, non-provisional application." Even in rare cases where, because of an amendment to the claims, the prior art available under 35 U.S.C. 102 and 103 during examination of the reissue application differs from that applied to the original application (see discussion in MPEP § 1440), the overall examination of the reissue application is conducted in the same manner as was the parent. Accordingly, the claims in a reissue application are subject to any and all rejections which the examiner deems appropriate. It does not matter whether the claims are identical to those of the patent or changed from those in the patent. It also does not matter that a rejection was not made in the prosecution of the patent, or could have been made, or was in fact made and dropped during prosecution of the patent; the prior action in the prosecution of the patent does not prevent that rejection from being made in the reissue application. Claims in a reissue application enjoy no "presumption of validity." *In re Doyle*, 482 F.2d 1385, 1392, 179 USPQ 227, 232-233 (CCPA 1973); *In re Sneed*, 710 F.2d 1544, 1550 n.4, 218 USPQ 385, 389 n.4 (Fed. Cir. 1983). Likewise, the fact that during prosecution of the patent the examiner

considered, may have considered, or should have considered information such as, for example, a specific prior art document, does not have any bearing on, or prevent, its use as prior art during prosecution of the reissue application.

1446-1447 [Reserved]

1448 Fraud, Inequitable Conduct, or Duty of Disclosure Issues [R-11.2013]

The Office does not investigate or reject reissue applications under **37 CFR 1.56**. The Office will not comment upon duty of disclosure issues which are brought to the attention of the Office in reissue applications except to note in the application, in appropriate circumstances, that such issues are no longer considered by the Office during its examination of patent applications. Examination as to the lack of deceptive intent requirement in reissue applications filed before September 16, 2012 will continue but without any investigation of fraud, inequitable conduct, or duty of disclosure issues. Applicant's statement in the reissue oath or declaration of lack of deceptive intent will be accepted as dispositive except in special circumstances such as an admission or judicial determination of fraud, inequitable conduct, or violation of the duty of disclosure.

I. ADMISSION OR JUDICIAL DETERMINATION

*[Editor Note: This subsection is **only applicable** to reissue applications filed before September 16, 2012.]*

An admission or judicial determination of fraud, inequitable conduct, or violation of the duty of disclosure is a special circumstance, because no investigation need be made. Accordingly, for a reissue application filed before September 16, 2012, after consulting with the Technology Center (TC) Training Quality Assurance Specialist (TQAS), a rejection should be made using the appropriate one of form paragraphs 14.21.09.fti or 14.22 as reproduced below.

Any admission of fraud, inequitable conduct or violation of the duty of disclosure must be explicit, unequivocal, and not subject to other interpretation. Where a rejection is made based upon such an admission (see form paragraph 14.22.fti below) and applicant responds with any reasonable interpretation of the facts that would not lead to a conclusion of fraud, inequitable conduct or violation of the duty of disclosure, the rejection should be withdrawn. Alternatively, if applicant argues that the admission noted by the examiner was not in fact an admission, the rejection should also be withdrawn.

Form paragraph 14.21.09.fti should be used for applications filed before September 16, 2012, where the examiner becomes aware of a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant **independently of the record of the case,** i.e. the examiner has external knowledge of the judicial determination.

Form paragraph 14.22.fti should be used for applications filed before September 16, 2012, where, **in the application record,** there is (a) an explicit, unequivocal admission by applicant of fraud, inequitable conduct or violation of the duty of disclosure which is not subject to other interpretation, or (b) information as to a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant. External information which the examiner believes to be an *admission* by applicant should never be used by the examiner, and such external information should never be made of record in the reissue application.

¶ *14.21.09.fti Rejection, Pre-AIA 35 U.S.C. 251, No Error Without Deceptive Intention - Application filed Before Sept. 16, 2012, External Knowledge*

Claims **[1]** rejected under **pre-AIA 35 U.S.C. 251** because this application was filed before September 16, 2012 and error "without any deceptive intention" has not been established. In view of the judicial determination in **[2]** of **[3]** on the part of applicant, a conclusion that any error was "without deceptive intention" cannot be supported. **[4]**

Examiner Note:

1. In bracket 1, list all claims in the reissue application.

2. In bracket 2, list the Court or administrative body which made the determination of fraud or inequitable conduct on the part of applicant.

3. In bracket 3, insert --fraud--, --inequitable conduct-- and/or --violation of duty of disclosure--.

4. In bracket 4, point out where in the opinion (or holding) of the Court or administrative body the determination of fraud, inequitable conduct or violation of duty of disclosure is set forth. Page number, column number, and paragraph information should be given as to the opinion (or holding) of the Court or administrative body. The examiner may add explanatory comments.

5. Do not use this form paragraph in a reissue application filed on or after September 16, 2012.

¶ *14.22.fti Rejection, Pre-AIA 35 U.S.C. 251, No Error Without Deceptive Intention-- Application filed Before Sept. 16, 2012, Evidence in the Application*

Claims **[1]** rejected under **pre-AIA 35 U.S.C. 251** because this application was filed before September 16, 2012 and error "without any deceptive intention" has not been established. In view of the reply filed on **[2]**, a conclusion that any error was "without deceptive intention" cannot be supported. **[3]**

Examiner Note:

1. In bracket 1, list all claims in the reissue application.

2. In bracket 2, insert the filing date of the reply which provides an admission of fraud, inequitable conduct or violation of duty of disclosure, or that there was a judicial determination of same.

3. In bracket 3, insert a statement that there has been an admission or a judicial determination of fraud, inequitable conduct or violation of duty of disclosure which provide circumstances why applicant's statement in the oath or declaration of lack of deceptive intent should not be taken as dispositive. Any admission of fraud, inequitable conduct or violation of duty of disclosure must be explicit, unequivocal, and not subject to other interpretation.

4. Do not use this form paragraph in a reissue application filed on or after September 16, 2012.

See **MPEP § 2012** for additional discussion as to fraud, inequitable conduct or violation of duty of disclosure in a reissue application.

1449 Protest Filed in Reissue Where Patent Is in Interference or Contested Case [R-11.2013]

If a protest (see MPEP Chapter 1900) is filed in a reissue application related to a patent involved in a pending interference proceeding or contested case before the Patent Trial and Appeal Board (PTAB), the reissue application should be referred to the PTAB before considering the protest and taking any action on the reissue application.

In consultation with the examiner and the PTAB, a TC TQAS will check to see that:

(A) all parties to the interference or contested case are aware of the filing of the reissue; and

(B) the Office does not allow claims in the reissue which are unpatentable over the pending interference count(s), or found unpatentable in the interference proceeding or contested case. After the reissue application has been reviewed by the PTAB, the reissue application with the protest will be returned to the examiner. See **MPEP § 1441.01** for a discussion as to protests under **37 CFR 1.291** in reissue applications.

It is particularly important that the reissue application not be allowed without the administrative patent judge's approval.

1449.01 Concurrent Office Proceedings [R-11.2013]

I. CONCURRENT REEXAMINATION PROCEEDINGS

37 CFR 1.565(d) provides that if "a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to **37 CFR 1.525** has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings." **37 CFR 1.991** provides that if "a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to **37 CFR 1.931** has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings." If an examiner becomes aware that a reissue application and an *ex parte* or *inter partes* reexamination proceeding are both pending for the same patent, he or she should immediately inform his or her Technology Center (TC) Training Quality Assurance Specialist (TQAS).

Under **37 CFR 1.177**, a patent owner may file more than one reissue application for the same patent. If an examiner becomes aware that multiple reissue applications are pending for the same patent, and an *ex parte* or *inter partes* reexamination proceeding is pending for the same patent, he or she should immediately inform his or her TC TQAS.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, *and an order granting reexamination has been issued* for the reexamination proceeding, the Office of Patent Legal Administration (OPLA) must be notified (by e-mail to a lead Senior Legal Advisor responsible for reexamination) that the proceedings are ready for a decision as to whether to merge the reissue and the reexamination, or stay one of the two. See **MPEP § 2285** for the procedure of notifying OPLA and general guidance, if a reissue application and an *ex parte* reexamination proceeding are both pending for the same patent, and an *inter partes* reexamination proceeding is not involved. See **MPEP § 2686.03** where a reissue application and an *inter partes* reexamination proceeding are both pending for the same patent, regardless of whether an *ex parte* reexamination proceeding is also pending.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, the patent owner, i.e., the reissue applicant, has a responsibility to notify the Office of the concurrent proceeding. **37 CFR 1.178(b)**, **37 CFR 1.565(a)**, and **37 CFR 1.985(a)**. The patent owner should file in the reissue application, as early as possible, a Notification of Concurrent Proceedings pursuant to **37 CFR 1.178(b)** in order to alert the Office of the existence of the reexamination proceeding on the same patent. See **MPEP § 1418**. In addition, the patent owner should file in the reexamination proceeding, as early as possible, a Notification of Concurrent Proceedings pursuant to **37 CFR 1.565(a)** or **1.985(a)** (for an *ex parte* reexamination proceeding or an *inter partes* reexamination proceeding, respectively) to provide a notification to the Office in the reexamination proceeding of the existence of the two concurrent proceedings.

The patent owner may file a petition under **37 CFR 1.182** in a reissue application to merge the reissue application with the reexamination proceeding, or to stay one of the proceedings because of the other. This petition must be filed after the order to reexamine is issued (**37 CFR 1.525**, **37 CFR 1.931**) in the reexamination proceeding. If the petition is filed before the reexamination order, it will not be considered, and will not be entered into the Image File Wrapper (IFW) or will be expunged from the record, if entered into the Image File Wrapper (IFW) before discovery that the petition is an improper paper. If the petition is filed after the order to reexamine is issued, the petition and any other materials for the files for the reissue application and the reexamination proceeding will be forwarded/referred to OPLA for decision. An e-mail will be sent to one of the lead Senior Legal Advisors of OPLA responsible for reexamination, providing notification that the petition is ready to be addressed.

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

The following provides guidance to address the situation where a reexamination certificate is to be issued for a patent, while a reissue application for the patent is pending and will not be merged with the reexamination. This can occur, for example, where a reissue application prosecution is stayed or suspended, and the prosecution of a reexamination proceeding for the patent (for which reissue is requested) is permitted to proceed. It can also occur where a reissue application is filed after the reexamination proceeding has entered the publication process, such that it is too late to consider the question of stay or merger.

(A) The examiner will not act on the reissue application until the reexamination certificate issues and publishes.

(B) After the reexamination certificate issues and publishes--At the time that the reexamination certificate is issued and published, the Office will resume examination of the reissue application--

(1) An Office action will be issued giving the patent owner (applicant) one month to submit an amendment of the reissue application claims, based upon the results of the concluded reexamination proceeding.

(2) The reissue application will then be examined. Any claim canceled by the reexamination certificate will be treated the same way as a claim lost in litigation, and stated in the next action to be deemed as canceled. The remaining claims will be examined. If the reissue application is subsequently allowed, the claims that were canceled by the reexamination certificate will be formally canceled in the reissue application by examiner's amendment

(unless they have already been canceled by the applicant).It is to be noted that the patent owner/applicant will have been advised in any decision suspending the copending reissue application to bring to the attention of the Office the issuance of the reexamination certificate, request a resumption of examination of the reissue application, and to include an amendment of the reissue application claims at that time, if it is deemed appropriate based upon the results of the reexamination proceeding.

(3) Generally, further prosecution will be limited to claims narrower than those claims canceled as a result of the reexamination certificate (this includes any existing patent claims and any claims added in the reexamination proceeding). Any claims added thereafter, which are equal in scope to claims canceled as a result of the reexamination certificate, or are broader than the scope of the claims canceled as a result of the reexamination certificate, will generally be deemed as surrendered based on the patent owner's failure to prosecute claims of equal scope, and to present claims of broader scope in the reexamination proceeding. Such claims will be rejected under **35 U.S.C. 251**. Further, a rejection of such claims based on estoppel will be made, citing to **MPEP § 2308.03** as to treatment of claims lost in a proceeding before the Office, and noting that a reexamination is a "proceeding."An exception to the guidance stated in part (3) above: claims that are broader than the scope of the claims canceled as a result of the reexamination certificate may be presented where:

(a) The broader claims in the reissue application can be patentable, despite the fact that the claims in the reexamination are not; and

(b) The broader claims in the reissue application could not have been presented in the reexamination proceeding.Criterion (a) can occur if the broadened claims in the reissue application have an earlier effective date than those canceled by the reexamination certificate (as where the claims in the reissue application are supported by a parent application, and the reexamination claims are not). Criterion (a) can also occur if the subject matter of the broadened claims in the reissue application can be sworn behind, and the more specific subject matter of the reexamination claims cannot be sworn behind. Criterion (b) can occur if the claims in the reissue application are broader than all claims of the patent as it existed during reexamination (e.g., claims directed to a distinct invention).

(4) What happened in the concluded reexamination proceeding must be taken into account by the examiner as to any new claims presented by the reissue application. This is in addition to any other issue that may be addressed in any reissue application.

(5) If all of the patent claims were canceled by the reexamination certificate, action on the reissue application can still proceed, as will be discussed below; however, patent owner/applicant must first file a petition under **37 CFR 1.183** to waive **37 CFR 1.570** and/or **37 CFR 1.997(d)**, depending on whether the certificate was issued for an *ex parte* reexamination proceeding, an *inter partes* reexamination proceeding, or a merger of the two. The petition would be grantable where the patent owner/applicant shows that either:

(a) The reissue claims are narrower than those claims canceled as a result of the reexamination certificate; or

(b) Criteria (a) and (b) of part (3) above are satisfied by the claims of the reissue application. The claims satisfying this requirement may only be provided where a petition accompanies the amendment providing the claims

(C) The reissue application can still proceed even where all of the patent claims were canceled by the reexamination certificate, based on the following. Where the reexamination certificate issues and publishes to cancel all existing patent claims, the reissue application can continue in the Office to correct the **35 U.S.C. 251**"error" of presenting the existing claims, which were in-fact unpatentable. Of course, what happened in the concluded reexamination proceeding must be taken into account by the examiner, as to any new claims presented by the reissue application. See the discussion in part (B)(3)(b) above. If a reissue application is filed after a reexamination certificate issues and publishes to cancel all existing patent claims, then the matter should be forwarded to OPLA for resolution.

II. CONCURRENT INTERFERENCE AND OTHER CONTESTED CASE PROCEEDINGS

If the original patent is involved in an interference or another contested case, the examiner must consult with the TQAS before taking any action on the

reissue application. It is particularly important that the reissue application not be allowed without the PTAB's approval. See MPEP **Chapter 2300**.

The Leahy-Smith America Invents Act amended 35 U.S.C. 315(d) and added 35 U.S.C. 325(d) to provide that, during the pendency of an *inter partes* review, post grant review or covered business method review ("PTAB Review Proceeding"), if another proceeding (e.g., a reissue application) or matter involving the patent is before the Office, the Director may determine the manner in which the PTAB Review Proceeding and other proceeding or matter may proceed, including providing for stay, transfer, consolidation or termination of such matter or proceeding. Accordingly, if an examiner becomes aware of a PTAB Review Proceeding for the same patent that is being examined as a reissue application, the examiner is to consult with the TQAS who will coordinate with the PTAB before taking any action on the reissue application.

III. CONCURRENT REISSUE PROCEEDINGS

When more than one reissue application is pending concurrently on the same patent, see **MPEP §§ 1450** and **1451**.

1449.02 Interference in Reissue [R-11.2013]

[Editor Note: This section is only appliable to reissue applications subject to pre-AIA 35 U.S.C. 102(g). See MPEP § 2159 et seq.]

37 CFR 41.8 Mandatory notices.

(a) In an appeal brief (§§ **41.37**, **41.67**, or **41.68**) or at the initiation of a contested case (§ **41.101**), and within 20 days of any change during the proceeding, a party must identify:

(1) Its real party-in-interest, and

(2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

(b) For contested cases, a party seeking judicial review of a Board proceeding must file a notice with the Board of the judicial review within 20 days of the filing of the complaint or the notice of appeal. The notice to the Board must include a copy of the complaint or notice of appeal. See also §§ **1.301** to **1.304** of this title.

37 CFR 41.202 Suggesting an interference.

(a) *Applicant*. An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

(1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,

(2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,

(3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § **41.203(a)**,

(4) Explain in detail why the applicant will prevail on priority,

(5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and

(6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

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(c) *Examiner*. An examiner may require an applicant to add a claim to provoke an interference. Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the applicant must also comply with paragraphs (a)(2) through (a)(6) of this section. The claim the examiner proposes to have added must, apart from the question of priority under **35 U.S.C. 102(g)**:

(1) Be patentable to the applicant, and

(2) Be drawn to patentable subject matter claimed by another applicant or patentee.

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In appropriate circumstances, a reissue application subject to pre-AIA (first to invent) 35 U.S.C. 102(g) may be placed into interference with a patent or pending application. A patentee may thus seek to provoke an interference with a patent or pending application by filing a reissue application, if the reissue application includes an appropriate reissue error as required by **35 U.S.C. 251**. Reissue error must be based upon applicant error; a reissue cannot be based solely on the error of the Office for failing to declare an interference or to suggest copying claims for the purpose of establishing an interference. See *In re Keil*, 808 F.2d 830, 1 USPQ2d 1427 (Fed. Cir. 1987); *In re Dien*, 680 F.2d 151, 214 USPQ 10 (CCPA 1982); *In re Bostwick*, 102 F.2d 886, 888, 41 USPQ 279, 281 (CCPA 1939); and *In re Guastavino*, 83 F.2d 913, 916, 29 USPQ 532, 535 (CCPA 1936). See also *Slip Track Systems, Inc. v. Metal Lite, Inc.*, 159 F.3d 1337, 48 USPQ2d 1055 (Fed. Cir. 1998) (Two patents issued claiming the same patentable subject matter, and the patentee with the earlier filing date requested reexamination of the patent with the later filing date (Slip Track's patent). A stay of litigation in a priority of invention suit under **35 U.S.C. 291**, pending the outcome of the reexamination, was reversed. The suit under **35 U.S.C. 291** was the only option available to Slip Track to determine priority of invention. Slip Track could not file a reissue

application solely to provoke an interference proceeding before the Office because it did not assert that there was any error as required by **35 U.S.C. 251** in the patent.). A reissue application can be employed to provoke an interference if the reissue application:

(A) adds copied claims which are not present in the original patent;

(B) amends claims to correspond to those of the patent or application with which an interference is sought; or

(C) contains at least one error (not directed to provoking an interference) appropriate for the reissue.

In the first two situations, the reissue oath/declaration must assert that applicant erred in failing to include claims of the proper scope to provoke an interference in the original patent application, and must include an identification of the claims added to provoke the interference. Furthermore, the subject matter of the copied or amended claims in the reissue application must be supported by the disclosure of the original patent under **35 U.S.C. 112**, first paragraph. See *In re Molins*, 368 F.2d 258, 261, 151 USPQ 570, 572 (CCPA 1966) and *In re Spencer*, 273 F.2d 181, 124 USPQ 175 (CCPA 1959).

A reissue applicant cannot present added or amended claims to provoke an interference, if the claims were deliberately omitted from the patent in a reissue application filed before September 16, 2012. If there is evidence that the claims were not inadvertently omitted from the original patent, e.g., the subject matter was described in the original patent as being undesirable, the reissue application may lack proper basis for the reissue. See *In re Bostwick*, 102 F.2d at 889, 41 USPQ at 282 (CCPA 1939) (reissue lacked a proper basis because the original patent pointed out the disadvantages of the embodiment that provided support for the copied claims).

The issue date of the patent, or the publication date of the application publication (whichever is applicable under **pre-AIA 35 U.S.C. 135(b)**), with which an interference is sought must be less than 1 year before the presentation of the copied or amended claims in the reissue application. See **pre-AIA 35 U.S.C. 135(b)** and **MPEP § 715.05** and MPEP **Chapter 2300**. If the reissue application includes broadened claims, the reissue application must be filed within two years from the issue date of the original patent. See **35 U.S.C. 251** and **MPEP § 1412.03**.

In a reissue application subject to pre-AIA 35 U.S.C. 102 and 103an examiner may, pursuant to **37 CFR 41.202(c)**, require a reissue applicant to add a claim to provoke an interference, unless the reissue applicant cannot present the added claim to provoke an interference based upon the provisions of the reissue statute and rules, e.g., if the claim was deliberately omitted from the patent and the reissue application was filed before September 16, 2012, or if the claim enlarges the scope of the claims of the original patent and was not "applied for within two years from the grant of the original patent." Failure to satisfy the requirement within a time period (not less than one month) that the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the reissue applicant must also comply with **37 CFR 41.202(a)(2)** through **(a)(6)**. The claim the examiner proposes to have added must, apart from the question of priority under **35 U.S.C. 102(g)**, be patentable to the reissue applicant, and be drawn to patentable subject matter claimed by another applicant or patentee.

I. REISSUE APPLICATION FILED WHILE PATENT IS IN INTERFERENCE

If a reissue application is filed while the original patent is in an interference proceeding, the reissue applicant must promptly notify the Patent Trial and Appeal Board of the filing of the reissue application within 20 days from the filing date. See **37 CFR 41.8** and MPEP **Chapter 2300**.

1449.03 Reissue Application in Derivation Proceeding [R-11.2013]

[Editor Note: This section is only appliable to reissue applications subject to 35 U.S.C. 102 as amended by the AIA. See MPEP § 2159 et seq.]

Effective March 16, 2013, an applicant for patent, including a reissue applicant, may file a petition to institute a derivation proceeding in the Office in

applications subject to derivation proceedings. See 37 CFR 42.402.

1450 Restriction and Election of Species Made in Reissue Application [R-11.2013]

37 CFR 1.176 Examination of reissue.

(a) 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 applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

37 CFR 1.176(b) permits the examiner to require restriction in a reissue application between claims newly added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims. The criteria for making a restriction requirement in a reissue application between the newly added claims and the original claims are the same as that applied in a non-reissue application. See **MPEP §§ 806** through **806.05(i)**. The authority to make a "restriction" requirement under **37 CFR 1.176(b)** extends to and includes the authority to make an election of species. For reissue applications of patents issued from a U.S. national stage application submitted under **35 U.S.C. 371**, the "restriction" requirement should not be made under the PCT unity of invention standard as set forth in MPEP Chapter **1800**, because a reissue application is filed under **35 U.S.C. 251**, and not under **35 U.S.C. 371**.

Where a restriction requirement is made by the examiner, the original patent claims will be held to be constructively elected (except for the limited situation where a disclaimer is filed as discussed in the next paragraph). Thus, the examiner will issue an Office action in the reissue application (1) providing notification of the restriction requirement, (2) holding the added claims to be constructively non-elected and withdrawn from consideration, (3) treating the original patent claims on the merits, and (4) informing applicant that if the original claims are found allowable, and a divisional application has been filed for the non-elected claims, further action in the application will be suspended, pending resolution of the divisional application.

If a disclaimer of all the original patent claims is filed in the reissue application containing newly added claims that are separate and distinct from the original patent claims, only the newly added claims will be present for examination. In this situation, the examiner's Office action will treat the newly added claims in the reissue application on the merits. The disclaimer of all the original patent claims must be filed in the reissue application before the issuance of the examiner's Office action containing the restriction requirement, in order for the newly added claims to be treated on the merits. Once the examiner has issued the Office action providing notification of the restriction requirement and treating the patent claims on the merits, it is too late to obtain an examination on the added claims in the reissue application by filing a disclaimer of all the original patent claims. If reissue applicant wishes to have the newly added claims be treated on the merits, a divisional reissue application must be filed to obtain examination of the added claims. Reissue applicants should carefully note that once a disclaimer of the patent claims is filed, it cannot be withdrawn. It does not matter whether the reissue application is still pending, or whether the reissue application has been abandoned or issued as a reissue patent. For all these situations, **37 CFR 1.176(b)** states that the disclaimer cannot be withdrawn; the disclaimer will be given effect. Note that cancellation of all the original patent claims in the reissue application will not be effective as an alternative to disclaiming all the original patent claims, and 37 CFR 1.176(b) will not be waived to permit the same. This is because the patent owner can subsequently file a reissue continuation presenting the original patent claims.

Claims elected pursuant to a restriction requirement will receive a complete examination on the merits, while the non-elected claims (to any added invention(s)) will be held in abeyance in a withdrawn status, and will only be examined if filed in a divisional reissue application. If the reissue application containing only original unamended claims becomes allowable first (and no "error" under **35 U.S.C. 251** exists), further action in that reissue application will be suspended to await examination in the divisional reissue application(s) containing

the added claims. Multiple suspensions (usually six-month periods) may be necessary. The Office will not permit claims to issue in a reissue application which application does not correct any error in the original patent. Once a divisional reissue application containing the added claims is examined and becomes allowable, the examiner will issue a requirement under **37 CFR 1.177(c)** for applicant to merge the claims of the suspended first reissue application with the allowable claims of the divisional reissue application into a single application, by placing all of the claims in one of the applications and expressly abandoning the other. The Office action making this requirement will set a two-month period for compliance with the requirement. If applicant fails to timely respond to the Office action, or otherwise refuses to comply with the requirement made, then the divisional reissue application (claiming the invention which was non-elected in the now-suspended first reissue application) will be passed to issue alone, since the claims of the divisional reissue application, by themselves, do correct an error in the original patent. Prosecution will be reopened in the suspended first reissue application, and a rejection based on a lack of error under **35 U.S.C. 251** will then be made. This rejection may be made final, because applicant is on notice of the consequences of not complying with the merger requirement.

If no divisional reissue application was filed for the non-elected claims and the original unamended (elected) claims become allowable (and no "error" under **35 U.S.C. 251** exists), further action in that reissue application will be suspended, and a non-extendable three-month opportunity will be given (by way of a 3-month Notification) to the patent owner/applicant to file divisional reissue application(s) containing the non-elected claims. If a divisional reissue application is timely filed (i.e., within the three months), further suspensions (usually six-month periods) will be granted, as needed, to await examination in the divisional reissue application containing the added claims. If no such divisional reissue application is filed within the three-month period set in the Office communication suspending action in the reissue application, then a rejection based on a lack of error under **35 U.S.C. 251** will then be made in the sole reissue application. Because no error in the original patent is being corrected in the first reissue application, no reissue patent will issue. If a divisional reissue application is subsequently filed, it must be accompanied by a grantable petition (filed in the application having the elected claims) to waive the **37 CFR 1.103** provision that the Office will not suspend action if a reply by applicant to an Office action is outstanding.

If the divisional reissue application becomes abandoned, prosecution will be reopened in the suspended first reissue application, and a rejection based on a lack of error under **35 U.S.C. 251** will then be made in the first reissue application. Because no error in the original patent is being corrected in the first reissue application, no reissue patent will issue.

As stated in **37 CFR 1.176(b)**, **the examiner is not permitted to require restriction among original claims of the patent** (i.e ., among claims that were in the patent before filing the reissue application). Even where the original patent contains claims to different inventions which the examiner considers independent or distinct, and the reissue application claims the same inventions, a restriction requirement would be improper. If such a restriction requirement is made, it must be withdrawn.

Restriction between multiple inventions recited **in the newly added claims** will be permitted provided the added claims are drawn to several separate and distinct inventions. In such a situation, the original patent claims would be examined in the first reissue application, and applicant is permitted to file a divisional reissue application for each of the several separate and distinct inventions identified in the examiner's restriction requirement.

A situation will sometimes arise where the examiner makes an election of species requirement between the species claimed in the original patent claims and a species of claims added in the reissue application. (The filing of a reissue application to only add species claims that require all the limitations of an issued generic claim would not meet the requirements of **35 U.S.C. 251** – see **MPEP § 1402**; however, this situation can occur where there is another change to the patent being made, which does correct a 35 U.S.C. 251 "error.") In such a situation,

if (1) the non-elected claims to the added species depend from (or otherwise include all limitations of) a generic claim which embraces all species claims, and (2) the generic claim is found allowable, then the non-elected claims of the added species must be rejoined with the elected claims of the original patent. See **MPEP § 821.04(a)**.

1451 Divisional Reissue Applications; Continuation Reissue Applications Where the Parent is Pending [R-11.2013]

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

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(b) MULTIPLE REISSUED PATENTS - 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.

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37 CFR 1.177 Issuance of multiple reissue patents.

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under § **1.322** any reissue patent resulting from an application to which this paragraph applies that does not contain the required notice.

(b) If applicant files more than one application for the reissue of a single patent, each claim of the patent being reissued must be presented in each of the reissue applications as an amended, unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by **35 U.S.C. 251** but is otherwise in condition for allowance, the Office may suspend action in the allowable application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself.

The court in *In re Graff*, 111 F.3d 874, 876-77, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997) stated that "[t]he statute does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue applications are met." Following the decision in *Graff*, the Office has adopted a policy of treating continuations and divisionals of reissue applications, to the extent possible, in the same manner as continuations and divisionals of non-reissue applications.

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. See *In re Bauman*, 683 F.2d 405, 409, 214 USPQ 585, 589 (CCPA 1982) (a patentee may file a regular continuation of a reissue application that obtains the benefit of the reissue application's filing date). 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). Likewise, there must be an identification, on filing, that the application is a divisional reissue application, as opposed to a divisional of a reissue application. Thus, the specification must be amended to state that the application is a "continuation reissue application" or "divisional reissue application" of its parent reissue application. If the specification is amended to state that the application is a "continuation" or "divisional" of its parent reissue application, the application may very well be treated as a *Bauman* type continuation or divisional application. In general, an application which is a continuing application of a reissue application will be a Bauman application where there are no indicia that a continuing reissue application is being filed. Indicia that a continuing reissue application is being filed are:

1. A 37 CFR 1.175 reissue oath/declaration, which is not merely a copy of the parent's reissue oath/declaration.
2. A specification and/or claims in proper double column reissue format per 37 CFR 1.173.
3. Amendments in proper format per 37 CFR 1.175.
4. A 37 CFR 3.73 statement of assignee ownership and consent by assignee.
5. A correct transmittal letter identifying the application as a reissue filing under 35 U.S.C. § 251. It is recommended that Form PTO/AIA/50 be used.
6. An identification of the application as being "a reissue continuation of application number [the parent reissue application]" or "a continuation and reissue of application number [the parent reissue

application]" or equivalent language, rather than being "a continuation of reissue application number [the parent reissue application]."

The following are examples of acceptable identification providing the appropriate continuity language for a continuation or divisional reissue application (as opposed to a Bauman type non-reissue continuing application).

Example 1: This application is a continuation reissue of application no. 15/123,456, which is an application for reissue of U.S. Patent No. 9,234,567.

Example 2: This application is a continuation reissue of application no. 15/123,456, which is an application for reissue of U.S. Patent No. 9,234,567, now Re 99,999.

Example 3: This application is a reissue continuation of application no. 15/123,456, which is an application for reissue of U.S. Patent No. 9,234,567.

Example 4: This application is a reissue divisional of application no. 15/123,456, which is an application for reissue of U.S. Patent No. 9,234,567.

Example 5: This is an application for reissue of U.S. Patent No. 9,234,567, and is a continuation of application no. 15/123,456, which is also an application for reissue of U.S. Patent No. 9,234,567.

Example 6: This is an application for reissue of U.S. Patent No. 9,234,567, and is a divisional of application no. 15/123,456, which is also an application for reissue of U.S. Patent No. 9,234,567.

Example 7: This is an application for reissue of U.S. Patent No. 9,234,567 and claims benefit under 35 U.S.C. 120 as a continuation of application no. 15/123,456, which is an application for reissue of U.S. Patent No. 9,234,567.

Example 8: This is an application for reissue of U.S. Patent No. 9,234,567 and claims benefit under 35 U.S.C. 120 as a continuation of application no. 15/123,456.

Example 9: This is an application for reissue of U.S. Patent No. 9,234,567. This application claims benefit under 35 U.S.C. 120 as a continuation of application no. 15/123,456, which is an application for reissue of U.S. Patent No. 9,234,567.

Note: For applications filed on or after September 16, 2012, domestic benefit claims under 37 CFR 1.78 must be made in an application data sheet (ADS) under 37 CFR 1.76. However, it is recommended that the first line of the specification still contain language set forth in the above examples to help ensure that the Office recognizes the application as a continuation reissue application or divisional reissue application (as opposed to a Bauman type non-reissue continuing application).

Questions relating to the propriety of divisional reissue applications and continuation reissue applications should be referred via the Technology Center (TC) Training Quality Assurance Specialist (TQAS)

I. DIVISIONAL REISSUE APPLICATIONS

37 CFR 1.176(b) permits the examiner to require restriction in a reissue application between the original claims of the patent and any newly added claims which are directed to a separate and distinct invention(s). See also **MPEP § 1450**. As a result of such a restriction requirement, divisional reissue applications may be filed for each of the inventions identified in the restriction requirement.

In addition, applicant may initiate a division of the claims by filing more than one reissue application in accordance with **37 CFR 1.177**. The multiple reissue applications which are filed may contain different groups of claims from among the original patent claims, or some of the reissue applications may contain newly added groups (not present in the original patent). There is no requirement that the claims of the multiple reissue applications be independent and distinct from one another; if they are not independent and distinct from one another, the examiner must apply the appropriate double patenting rejections.

There is no requirement that a family of divisional reissue applications issue at the same time; however, it is required that they contain a cross reference to each other in the specification. **37 CFR 1.177(a)** requires that all multiple reissue applications resulting from a single patent must include as the first sentence of their respective specifications a cross reference to the other reissue application(s). Accordingly, the first sentence of each reissue specification must provide(in addition to the statement of continuity – see above) notice stating that more than one reissue application has been filed, and it must identify each of the reissue applications and their relationship within the family of reissue applications, and to the original patent. An example of the suggested language to be inserted is as follows:

Notice: More than one reissue application has been filed for the reissue of Patent No. 9,999,999. The reissue applications are application numbers 09/999,994 (the present application), 09/999,995, and 09/999,998, all of which are divisional reissues of Patent No. 9,999,999.

The examiner should object to the specification and require an appropriate amendment if applicant fails to include such a cross reference to the other reissue applications in the first sentence of the specification of each of the reissue applications.

Where one of the divisional reissue applications of the family has issued without the required cross reference to the other reissue application(s), the examiner will refer the matter to his/her Supervisory Patent Examiner (SPE). The SPE will initiate a certificate of correction under **37 CFR 1.322** to include the appropriate cross reference in the already issued first reissue patent before passing the pending reissue application to issue. Form paragraph 10.19 may be used for such purpose. After the SPE prepares the memorandum as per form paragraph 10.19, the patent file with the memorandum should be forwarded to the Certificates of Correction Branch for issuance of a certificate. The examiner should make a reference in the pending divisional reissue application to the fact that an actual request for a Certificate of Correction has been initiated in the first reissue patent pursuant to **37 CFR 1.177(a)**, e.g., by an entry in the search notes or in an examiner's amendment.

¶ *10.19 Memorandum - Certificate of Correction (Cross-Reference to Other Reissues in Family)*

DATE: **[1]**

TO: Certificates of Correction Branch

FROM: **[2]**, SPE, Art Unit **[3]**

SUBJECT: Request for Certificate of Correction

Please issue a Certificate of Correction in U. S. Letters Patent No. **[4]** as specified on the attached Certificate.

_____

[5], SPE

Art Unit **[6]**

UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE

Patent No. **[7]**

Patented: **[8]**

The present reissue patent issued from an application that is one of a family of divisional reissue applications resulting from Patent No. **[9].** The present reissue patent has issued without the cross reference to the other reissue application(s) of the family which is required pursuant to **37 CFR 1.177(a)**. Accordingly, insert in the first sentence of the specification as follows:

Notice: More than one reissue application has been filed for the reissue of patent **[9].** The reissue applications are **[10]**.

_____

[11], Supervisory Patent Examiner

Art Unit **[12]**

Examiner Note:

1 In bracket 9, insert the patent number of the patent for which multiple reissue divisional applications have been filed.

2 This is an internal memo and must not be mailed to the applicant. This memo should accompany the patented file to the Certificates of Correction Branch as noted in form paragraphs 10.13 and 10.14.

3. In brackets 5 and 11, insert the name of SPE and provide the signature of the SPE above each line.

4. In brackets 6 and 12, insert the Art Unit number.

5. Two separate pages of USPTO letterhead will be printed when using this form paragraph.

6. In bracket 10, identify each of the reissue applications (including the present application) and their relationship within the family of reissue applications, and to the original patent.

In addition to the amendment to the first sentence of the specification, the reissue application cross references will also be reflected in the file. For an IFW reissue application file, a copy of the bibliographic data sheet from the IFW file history should be printed and the examiner should annotate the printed sheet such that adequate notice is provided that more than one reissue application has been filed for a single original patent. The annotated sheet should be scanned into IFW.

Pursuant to **37 CFR 1.177(b)** all of the claims of the patent to be reissued must be presented in each reissue application in some form, i.e., as amended, as unamended or as canceled. Further, any added claims must be numbered beginning with the next

highest number following the last patent claim. It is noted that the same claim of the patent cannot be presented for examination in more than one of the divisional reissue applications, as a pending claim, in either its original or amended versions. If a patent claim is presented in one of the divisional reissue applications of a reissue application "family," as a pending claim, then that patent claim must be presented as a canceled claim in all the other reissue applications of that family. Once a claim in the patent has been reissued, it does not exist in the original patent; thus, it cannot be reissued from the original patent in another reissue application. If the same claim of the patent, e.g., patent claim 1 is presented for examination in more than one of the reissue applications, in different amended versions, the following rejections should be made in the reissue applications with that patent claim:

A rejection under **35 U.S.C. 251**, in that the reissue application is not correcting an error in the original patent, because original claim 1 would be superseded by the reissuance of claim 1 in the other reissue application.

A rejection under **35 U.S.C. 112**, in that claim 1 is indefinite because the invention of claim 1 is not particularly pointed out and distinctly claimed. Claim 1 presents one coverage in divisional reissue application _X and another in the present reissue application. This is inconsistent.

The reissue applicant should then be advised to follow a procedure similar to the following example:

If there are patent claims 1 – 10 in two divisional reissue applications and an applicant wishes to revise claim 1, which is directed to AB (for example) to ABC in one divisional reissue application, and to ABD in a second divisional reissue application, applicant should do the following: Claim 1 in the first divisional reissue application can be revised to recite ABC. Claim 1 in the second divisional reissue application would be canceled, and new claim 11 would be added to recite ABD. The physical cancellation of claim 1 in the second divisional reissue application will not prejudice applicant's rights in the amended version of claim 1 because those rights are retained via the first reissue application. Claim 1 continues to exist in the first reissue application, and both the first and second reissue applications taken together make up the totality of the correction of the original patent.

If the same or similar claims are presented in more than one of the multiple reissue applications, the possibility of statutory double patenting (**35 U.S.C. 101**) or non-statutory (judicially created doctrine) double patenting should be considered by the examiner during examination, and the appropriate rejections made. A terminal disclaimer may be filed to overcome an obviousness type double patenting rejection. The terminal disclaimer is necessary in order to ensure common ownership of the reissue patents throughout the remainder of the unexpired term of the original patent.

Whenever a divisional reissue application is filed with a copy of the oath/declaration and assignee consent from the parent reissue application, the copy of the assignee consent from the parent reissue application should not be accepted, unless the divisional reissue application is being filed in response to a restriction requirement. *The copy of the consent from the parent reissue application does not indicate that the assignee has consented to the addition of the new invention of the divisional reissue application to the original patent* . The Office of Patent Application Processing (OPAP) should accord a filing date and send out a notice of missing parts stating that there is no proper consent and setting a period of time for filing the missing part and for payment of any surcharge required under **37 CFR 1.53(f)** and **1.16(f)**. See **MPEP § 1410.01**. In a divisional reissue application filed in response to a restriction requirement made in the parent reissue application, the assignee need not file a consent to the divided-out invention now being provided in the divisional reissue application, because consent has already been provided in the parent reissue application.

The copy of the reissue oath/declaration in the divisional reissue application should be accepted by OPAP, because it is an oath/declaration, even though it may be improper under **35 U.S.C. 251** or **37 CFR 1.175**. The examiner should check the copy of the oath/declaration to ensure that it identifies an error being corrected by the divisional reissue application. The copy of the oath/declaration from the parent

reissue application may or may not cover the error being corrected by the divisional reissue application because the divisional reissue application is (by definition) directed to a new invention. If it does not, the examiner should reject the claims of the divisional reissue application under **35 U.S.C. 251** as being based on an oath/declaration that does not identify an error being corrected by the divisional reissue application, and require a new oath/declaration. See **MPEP § 1414**. Even for applications filed on or after September 16, 2012, a new oath/declaration is required for identification of the error, as opposed to identification of the error in the remarks accompanying an amendment, because 37 CFR 1.175(f)(2) states that "[i]f all errors identified in the inventor's oath or declaration from the earlier-filed reissue application are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue," and in this instance the initial oath/declaration (the copy filed) never stated a proper "error." If the copy of the reissue oath/declaration from the parent reissue application does in fact cover an error being corrected in the divisional reissue application, no such rejection should be made. For applications filed before September 16, 2012, even though the copy of the reissue oath/declaration from the parent covers an error being corrected, a supplemental reissue oath/declaration pursuant to **pre-AIA 37 CFR 1.175 (b)(1)** will be required. See **MPEP § 1414.03**. **37 CFR 1.175** requires that the oath/declaration of the divisional reissue application identify at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application. Thus, where a divisional reissue application corrects the same error in a different way than its parent reissue application does, different oaths/declarations must be presented in the two reissue applications.

Example: Patent Broad claim – ABC

Parent Reissue Claim to ABC canceled and replaced by ABC**D** to define over the art.

Divisional Reissue Claim to ABC canceled and replaced by ABC**E** to define over the art.

The parent reissue oath/declaration error statement would be that ABC is too broad, and it was an error not to include D for patentability. The divisional reissue oath/declaration error statement would be that ABC is too broad and it was an error not to include E for patentability.

Situations yielding divisional reissues occur infrequently and usually involve only two such files. It should be noted, however, that in rare instances in the past, there have been more than two (and as many as five) divisional reissues of a patent. For treatment of a plurality of divisional reissue applications resulting from a requirement to restrict to distinct inventions or a requirement to elect species, see **MPEP § 1450**.

II. CONTINUATION REISSUE APPLICATIONS

A continuation reissue application of a parent reissue application is not ordinarily filed "for distinct and separate parts of the thing patented" as called for in the second paragraph of **35 U.S.C. 251**. The decision of *In re Graff*, 111 F.3d 874, 42 USPQ2d 1471 (Fed. Cir. 1997) interprets **35 U.S.C. 251** to permit multiple reissue patents to issue even where the multiple reissue patents are not for "distinct and separate parts of the thing patented." The court stated:

> Section 251[2] is plainly intended as enabling, not as limiting. Section 251[2] has the effect of assuring that a different burden is not placed on divisional or continuation reissue applications, compared with divisions and continuations of original applications, by codifying the Supreme Court decision [*The Corn-Planter Patent*, 90 U.S. 181, 227-28 (1874)] which recognized that more than one patent can result from a reissue proceeding. Thus § 251[2] places no greater burden on Mr. Graff's continuation reissue application than upon a continuation of an original application; § 251[2] neither overrides, enlarges, nor limits the statement in § 251[3] that the provisions of Title 35 apply to reissues.

In re Graff, 111 F.3d at 877, 42 USPQ2d at 1473. Accordingly, prosecution of a continuation reissue application of a parent reissue application will be permitted (despite the existence of the pending parent reissue application) where the continuation reissue application complies with the rules for reissue.

The parent and the continuation reissue applications should be examined together if possible. In order that the parent-continuation relationship of the reissue applications be specifically identified and notice be provided of both reissue applications for *both the parent and the continuation reissue applications*, the following is done:

(A) An appropriate amendment to the continuing data entries must be made to the first sentence of the specification, (see the discussion above under the heading "Divisional Reissue Applications").

(B) For an IFW reissue application file, a copy of the bibliographic data sheet from the IFW file history should be printed and the examiner should annotate the printed sheet such that adequate notice is provided that more than one reissue application has been filed for a single original patent. The annotated sheet should be scanned into IFW.

As is true for the case of multiple divisional reissue applications, all of the claims of the patent to be reissued must be presented in both the parent reissue application and the continuation reissue application in some form, i.e., as amended, as unamended, or as canceled. The same claim of the patent cannot, however be presented for examination in both the parent reissue application and the continuation reissue application, as a pending claim, in either its original or amended versions. See the discussion in subsection I. above for treatment of this situation. Further, any added claims must be numbered beginning with the next highest number following the past original patent claims.

Where the parent reissue application issues before the examination of the continuation reissue application, the claims of the continuation reissue application should be carefully reviewed for double patenting over the claims of the parent reissue application. Where the parent and the continuation reissue applications are examined together, a provisional double patenting rejection should be made in both cases as to any overlapping claims. See **MPEP § 804** - **§ 804.04** as to double patenting rejections. Any terminal disclaimer filed to obviate an obviousness-type double patenting rejection ensures common ownership of the reissue patents throughout the remainder of the unexpired term of the original patent.

If the parent reissue application issues without any cross reference to the continuation reissue application, amendment of the parent reissue patent to include a cross-reference to the continuation reissue application must be effected at the time of allowance of the continuation reissue application by Certificate of Correction. See the discussion above under the heading "Divisional Reissue Applications" as to how the Certificate of Correction is to be provided.

Again, the examiner should make reference in the pending continuation reissue application to the fact that an actual request for a Certificate of Correction has been generated in the first reissue patent pursuant to **37 CFR 1.177(a)**, e.g., by an entry in the search notes or in an examiner's amendment.

Generally, where a continuation reissue application is filed with a copy of the oath/declaration and assignee consent from the parent reissue application, and the parent reissue application is not to be abandoned, the copy of the consent of the parent reissue application should not be accepted. *The copy of the consent of the parent reissue application does not indicate that the assignee has consented to the addition of the new error correction of the continuation reissue application to the original patent. Presumably, a new correction has been added, because the parent reissue application is still pending* . OPAP should accord a filing date and send out a notice of missing parts stating that there is no proper consent and setting a period of time for filing the missing part and for payment of any surcharge required under **37 CFR 1.53(f)** and **1.16(f)**. See **MPEP § 1410.01**. The copy of the reissue oath/declaration should be accepted by OPAP, because it is an oath/declaration, albeit improper under **35 U.S.C. 251**. The examiner should reject the claims of the continuation reissue application under **35 U.S.C. 251** as being based on an oath/declaration that does not identify an error being corrected by the continuation reissue application, and should require a new oath/declaration. See **37 CFR 1.175**. Even for applications filed on or after September 16, 2012, a new oath/declaration is required for identification of the error, as opposed to identification of the error in the remarks accompanying an amendment, because 37 CFR 1.175(f)(2) states that "[i]f all errors

identified in the inventor's oath or declaration from the earlier-filed reissue application are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue," and in this instance the initial oath/declaration (the copy filed) never stated a proper "error." 37 CFR 1.175(f)(2) allows for the identification of the reissuable error in the remarks only where a proper reissuable error was previously entered into the application. One of form paragraphs 14.01.01 through 14.01.03 may be used. See **MPEP § 1414**.

As an exception to the general practice, there may be a situation where: (a) the original declaration of a parent reissue application may identify an error X, but as a result of an amendment to the claims, error X is no longer being corrected in the parent reissue application, with a supplemental declaration being included to provide a new error statement, and (b) a continuation reissue application is filed to correct error X. In this situation, applicant may provide in the continuation reissue application a copy of the original declaration and consent filed in the parent reissue application. The applicant is to point out this exception to the general practice in the remarks accompanying the continuation reissue application. **37 CFR 1.175** requires that the filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration which, pursuant to paragraph (a)(1) of this section, identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application. In this instance, the continuation reissue application would identify at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application by virtue of the copy of the original declaration (whose error is different from that of the parent reissue application which now has the supplemental declaration). Two examples of this exception are provided:

Example 1

Patent Broad claim – ABC Dependent claim – ABCE Dependent claim – ABCF

Parent Reissue Broad claim – ABC**D originally** presented in the reissue, and then canceled during prosecution. During prosecution, dependent claims rewritten as independent claims – ABC**D**E**Q** and ABC**D**F**Q**

Continuation Reissue Broad claim – ABC**D**

The parent reissue application's supplemental declaration describes the addition of Q and D to the dependent claims, which have been rewritten as independent claims. A copy of the original reissue declaration from the parent reissue application, which describes the addition of D to the original independent patent claim, was filed in the continuation reissue application. Thus, the declarations of the parent reissue application and the continuation reissue application correct different errors. Further, the copy of the original consent from the parent reissue application filed in the continuation reissue application covers the error described in the copy of the declaration filed in the continuation reissue application. A non-statutory double patenting rejection should be considered by the examiner, with the requirement of a terminal disclaimer in each application. *In re Berg*, 140 F.3d 1428, 1435, 46 USPQ2d 1226, 1232 (Fed. Cir. 1998) ("The two-way exception can only apply when the applicant could not avoid separate filings, and even then, only if the PTO controlled the rates of prosecution to cause the later filed species claims to issue before the claims for a genus in an earlier application…In Berg's case, the two applications could have been filed as one, so it is irrelevant to our disposition who actually controlled the respective rates of prosecution.").

Example 2:

Patent Broad claim – ABC Dependent claim – ABCE Dependent claim – ABCF

Parent Reissue Broad claim – ABC**D originally** presented in the reissue, and then canceled during prosecution. During prosecution, dependent claims rewritten as independent claims – ABC**D**E and ABC**D**F

Continuation Reissue Broad claim – ABC**D**

The parent reissue application's supplemental declaration describes the addition of D to the ABCE and ABCF combinations, correcting an error in the original dependent claims. The copy of the original reissue declaration from the parent reissue application filed in the continuation reissue application describes the addition of D to the broad

claim, correcting an error in the original independent claim. This is permitted because the applicant is free to split the correction of an error as to different claims into different reissue applications, where one is a continuing application of another. See *In re Graff* , 111 F.3d at 877, 42 USPQ2d at 1473, where the Federal Circuit stated that **35 U.S.C. 251** places "no greater burden on Mr. Graff's continuation reissue application than upon a continuation of an original application…" Again a non-statutory double patenting rejection should be considered by the examiner, with the requirement of a terminal disclaimer in each application. *In re Berg* , 140 F.3d at 1437, 46 USPQ2d at 1233. To the extent that **37 CFR 1.175** requires a waiver to accommodate this situation, it is hereby waived.

Where a continuation reissue application is filed with a copy of the oath/declaration and assignee consent from the parent reissue application, and the parent reissue application is, or will be abandoned, the copy of the consent should be accepted by both OPAP and the examiner. The reissue oath/declaration should be accepted by OPAP, and the examiner should check to ensure that the oath/declaration identifies an error that is being corrected in the continuation reissue application. See **MPEP § 1414**.

For applications filed before September 16, 2012, if a preliminary amendment was filed with the continuation reissue application, the examiner should check for the need of a supplemental reissue oath/declaration. Pursuant to **37 CFR 1.175(b)(1)**, for any error corrected via the preliminary amendment which is not covered by the oath or declaration submitted in the parent reissue application, applicant must submit a supplemental oath/declaration stating that every such error arose without any deceptive intention on the part of the applicant. See **MPEP § 1414** and § **1414.03**.

1452 Request for Continued Examination of Reissue Application [R-11.2013]

A request for continued examination (RCE) under **37 CFR 1.114** is available for a reissue application for reissue of a utility or plant patent. Effective May 29, 2000, an applicant in a reissue application may file a request for continued examination of the reissue application, if the reissue application was filed on or after June 8, 1995. This applies even where the application, which resulted in the original patent, was filed before June 8, 1995.

An RCE continues the prosecution of the existing reissue application and is not a filing of a new reissue application. Thus, the filing of an RCE will not be announced in the *Official Gazette*. Additionally, if a reissue application is merged with a reexamination proceeding (see **MPEP § 1449.01**), the filing of an RCE will not dissolve the merger, because the reissue application does not become abandoned. The Office, however, may choose to dissolve the merger based on the individual facts and circumstances of the case, e.g., to promote the statutorily mandated requirement for special dispatch in reexamination.

1453 Amendments to Reissue Applications [R-11.2013]

37 CFR 1.121 Manner of making amendments in application.

*****

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § **1.173**.

*****

37 CFR 1.173 Reissue specification, drawings, and amendments.

*****

(b) *Making amendments in a reissue application*. An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made, as follows:

(1) *Specification other than the claims* . Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ **1.52(e)(1)** and **1.821(c)**, but not for discs submitted under § **1.821(e)**).

(2) *Claims*. An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) *Drawings.* One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which shall be an attachment to the amendment document. Any replacement sheet of

drawings must be in compliance with § 1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled." All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings.

(i) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings.

(ii) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(c) *Status of claims and support for claim changes*. Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) *Changes shown by markings*. Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)). Matter added by reissue on compact discs must be preceded with "U" and end with "/U" to properly identify the material being added.

(e) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

(f) *Amendment of disclosure may be required*. The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) *Amendments made relative to the patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

The provisions of 37 CFR 1.173(b)-(g) and those of 37 CFR 1.121(i) apply to amendments in reissue applications. Any amendments submitted in a reissue application **must** comply with 37 CFR 1.173(b).

Amendments submitted in a reissue application, including preliminary amendments (i.e., amendments filed as a separate paper to accompany the filing of a reissue application), must comply with the practice outlined below in this section; however, for examiner's amendments to the specification and claims, 37 CFR 1.121(g) provides certain exceptions to that practice in the interest of expediting prosecution. The exceptions set forth in 37 CFR 1.121(g) also apply in reissue applications.

Pursuant to 37 CFR 1.173(a), no amendment in a reissue application may enlarge the scope of the claims, unless "applied for within two years from the grant of the original patent." Further, the amendment may not introduce new matter. See MPEP § 1412.03 for further discussion as to the time limitation on enlarging the scope of the patent claims in a reissue application.

All amendment changes must be made relative to the patent to be reissued. Pursuant to 37 CFR 1.173(d), any such changes which are made to the specification, including the claims, must be shown by employing the following "**markings**:"

(A) The matter to be omitted by reissue must be enclosed in brackets; and

(B) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (pursuant to 37 CFR 1.96 for computer printouts or programs, and 37 CFR 1.825 for sequence listings). Matter added by reissue on compact discs must be preceded with "U" and end with "/U" to properly identify the material being added.

I. THE SPECIFICATION

37 CFR 1.173(b)(1) relates to the manner of making amendments to the specification other than the claims. It is not to be used for making amendments to the claims or the drawings.

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), except that an entire paragraph of specification text may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. Applicant must indicate the precise point where each amendment is made. All bracketing and underlining is made in comparison to the original patent, not in comparison to any prior amendment in the reissue application. Thus, all paragraphs which are newly *added* to the specification of the original patent must be submitted as completely underlined each time they are re-submitted in the reissue application.

II. THE CLAIMS

37 CFR 1.173(b)(2) relates to the manner of making amendments to the claims in reissue applications. It is not to be used for making amendments to the remainder of the specification or to the drawings. **37 CFR 1.173(b)(2)** requires that:

(A) For each claim that is being amended *by the amendment being submitted* (the current amendment), the entire text of the claim must be presented with markings as defined above;

(B) For each new claim added to the reissue *by the amendment being submitted* (the current amendment), the entire text of the added claim must be presented completely underlined;

(C) A patent claim should be canceled by a direction to cancel that claim, there is no need to present the patent claim surrounded by brackets; and

(D) A new claim (previously added in the reissue) should be canceled by a direction to cancel that claim.

Original patent claims are never to be renumbered; see **37 CFR 1.173(e)**. A patent claim retains its number even if it is canceled in the reissue proceeding, and the numbering of any added claims must begin after the last original patent claim.

Pursuant to **37 CFR 1.173(c)**, each amendment submitted must set forth the status of all patent claims and all added claims as of the date of the submission. The status to be set forth is whether the claim is pending or canceled. The failure to submit the claim status will generally result in a notification to applicant that the amendment *before final rejection* is not completely responsive (see **37 CFR 1.135(c)**). Such an amendment *after final rejection* will not be entered.

Also pursuant to **37 CFR 1.173(c)**, each claim amendment must be accompanied by an explanation of the support in the disclosure of the patent for the amendment (i.e., support for all changes made in the claim(s), whether insertions or deletions). The failure to submit an explanation will generally result in a notification to applicant that the amendment *before final rejection* is not completely responsive (see **37 CFR 1.135(c)**). Such an amendment *after final rejection* will not be entered.

III. THE DRAWINGS

37 CFR 1.173(a)(2) states that amendments to the original patent drawings are not permitted, and that any change to the drawings must be by way of **37 CFR 1.173(b)(3)**. See **MPEP § 1413** for the manner of making amendments to the drawings in a reissue application.

Form paragraph 14.20.01 may be used to advise applicant of the proper manner of making amendments in a reissue application.

¶ *14.20.01 Amendments To Reissue-37 CFR 1.173(b)*

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with **37 CFR 1.173(b)**. In addition, for reissue applications filed before September 16, 2012, when any substantive amendment is filed in the reissue application, which amendment otherwise places the reissue application in condition for allowance, a supplemental oath/declaration will be required. See **MPEP § 1414.01**.

Examiner Note:

This form paragraph may be used in the first Office action to advise applicant of the proper manner of making amendments, and to notify applicant of the need to file a supplemental oath/declaration before the application can be allowed.

Form paragraph 14.21.01 may be used to notify applicant that proposed amendments filed **before** final rejection in the reissue application do not comply with 37 CFR 1.173(b).

¶ *14.21.01 Improper Amendment To Reissue - 37 CFR 1.173(b)*

The amendment filed **[1]** proposes amendments to **[2]** that do not comply with **37 CFR 1.173(b)**, which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

A shortened statutory period for reply to this letter is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

Examiner Note:

1. This form paragraph may be used for any **37 CFR 1.173(b)** informality as to an amendment submitted in a reissue application prior to final rejection. After final rejection, applicant should be informed that the amendment will not be entered by way of an Advisory Office action.

2. In bracket 2, specify the proposed amendments that are not in compliance.

Note that if an informal amendment is submitted **after final rejection,** form paragraph 14.21.01 should not be used. Rather, an advisory Office action should be issued using Form PTO-303 indicating

that the amendment was not entered because it does not comply with **37 CFR 1.173(b)**, which sets forth the manner of making amendments in reissue applications.

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

When a reissue patent is printed, all underlined matter is printed in *italics* and all brackets are printed as inserted in the application, in order to show exactly which additions and deletions have been made to the patent being reissued. Therefore, all underlining and bracketing in the reissue application should be made relative to the text of the patent, as follows. In accordance with **37 CFR 1.173(g)**, all amendments in the reissue application must be made relative to (i.e. *vis-à-vis*) the patent specification in effect as of the date of the filing of the reissue application. The patent specification includes the claims and drawings. If there was a prior change to the patent (made via a prior concluded reexamination certificate, reissue of the patent, certificate of correction, etc.), the first amendment of the subject reissue application must be made relative to the patent specification as changed by the prior proceeding or other mechanism for changing the patent. All amendments subsequent to the first amendment must also be made relative to the patent specification in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment.

A. The Subject Patent Already Has Underlining or Bracketing

If the original (or previously changed) patent includes a formula or equation already having underlining or bracketing therein as part of the formula or equation, any amendment of such formula or equation should be made by bracketing the entire formula and rewriting and totally underlining the amended formula in the re-presented paragraph of the specification or rewritten claim in which the changed formula or equation appears. Amendments of segments of a formula or equation should not be made. If the original patent includes bracketing and underlining from an earlier reissue, double brackets and double underlining should be used in the subject reissue application to identify and distinguish the present changes being made. The subject reissue, when printed, would include double brackets (indicating deletions made in the subject reissue) and boldface type (indicating material added in the subject reissue). If the original patent includes bracketing and underlining from an earlier reexamination, the reissue application must be presented as if the changes made to the original patent text via the reexamination certificate are a part of the original patent. Thus, all italicized text of the reexamination certificate is presented in the amendment (made in the reissue application) without italics. Further, any text found in brackets in the reexamination certificate is omitted in the amendment (made in the reissue application). Any canceled claims resulting from the reexamination will be lined through.

V. EXAMPLES OF PROPER AMENDMENTS

A substantial number of problems arise in the Office because of improper submission of amendments in reissue applications. The following examples are provided to assist in preparation of proper amendments to reissue applications.

A. Original Patent Description or Patent Claim Amended

Example (1)

If it is desired to change the specification at column 4, line 23, to replace "is" with --are--, submit a copy of the entire paragraph of specification of the patent being amended with underlining and bracketing, and point out where the paragraph is located, e.g.,

> Replace the paragraph beginning at column 4, line 23 with the following:
>
> Scanning [is] <u>are</u> controlled by clocks which are, in turn, controlled from the display tube line synchronization. The signals resulting from scanning the scope of the character are delivered in parallel, then converted into serial mode through a shift register wherein the shift signal frequency is controlled by a clock that is, in turn, controlled from the display tube line synchronization.

Example (2)

For changes to the claims, one must submit a copy of the entire patent claim with the amendments shown by underlining and bracketing, e.g.,

Amend claim 6 as follows:

Claim 6 (Amended). The apparatus of claim [5] 1 wherein the [first] second piezoelectric element is parallel to the [second] third piezoelectric element.

If the dependency of any original patent claim is to be changed by amendment, it is proper to make that original patent claim dependent upon a later filed higher numbered claim.

B. Cancellation of Claim(s)

Example (3)

To cancel an original patent claim, in writing, direct cancellation of the patent claim, e.g.,

Cancel claim 6.

Example (4)

To cancel a new claim (previously added in the reissue), in writing, direct cancellation of the new claim, e.g.,

Cancel claim 15.

C. Presentation of New Claims

Example (5)

Each new claim (i.e., a claim not found in the patent, that is newly presented in the reissue application) should be presented with underlining throughout the claim, e.g.,

Add claim 7 as follows:

Claim 7 (new). The apparatus of claim 5 further comprising electrodes attaching to said opposite faces of the first and second piezoelectric elements.

Even though original claims may have been canceled, the numbering of the original claims does not change. Accordingly, any added claims are numbered beginning with the number next higher than the number of claims in the original patent. If new claims have been added to the reissue application which are later canceled before issuance of the reissue patent, the examiner will renumber any remaining new claims in numerical order to follow the number of claims in the original patent.

D. Amendment of New Claims

An amendment of a "new claim" (i.e., a claim not found in the patent, that was previously presented in the reissue application) must be done by presenting the amended "new claim" containing the amendatory material, and completely underlining the claim. The presentation cannot contain any bracketing or other indication of what was in the previous version of the claim. This is because all changes in the reissue are made *vis-à-vis* the original patent, and not in comparison to the prior amendment. Although the presentation of the amended claim does not contain any indication of what is changed from the previous version of the claim, applicant must point out what is changed in the "Remarks" portion of the amendment. Also, per **37 CFR 1.173(c)**, each change made in the claim must be accompanied by an explanation of the support in the disclosure of the patent for the change.

E. Amendment of Original Patent Claims More Than Once

The following illustrates proper claim amendment of original patent claims in reissue applications:

A. Patent claim.

Claim 1. A cutting means having a handle portion and a blade portion.

B. Proper first amendment format.

Claim 1 (Amended). A [cutting means] knife having a bone handle portion and a notched blade portion.

C. Proper second amendment format.

Claim 1 (Twice Amended). A [cutting means] knife having a handle portion and a serrated blade portion.

Note that the second amendment must include the remaining changes previously presented in the first amendment, i.e., [cutting means] knife, as well as the new changes presented in the second amendment, i.e., serrated.

The word bone was presented in the first amendment and is now to be deleted in the second amendment.

The word "bone" is NOT to be shown in brackets in the second amendment. Rather, the word "bone" is simply omitted from the claim, because "bone" never appeared in the patent. An explanation of the deletion should appear in the remarks.

The word notched which was presented in the first amendment is replaced by the word serrated in the second amendment. The word notched is being deleted in the second amendment and did not appear in the patent; accordingly, "notched" is not shown in any form in the claim. The word serrated is being added in the second amendment, and accordingly "serrated" is added to the claim and is underlined.

In the second amendment, the deletions of "notched" and "bone" are not changes from the original patent claim text and therefore are not shown in brackets in the second amendment. In both the first and the second amendments, the entire claim is presented only with the changes from the original patent text.

VI. ADDITIONAL EXAMPLES

(A) For a reissue application, where the patent was previously reissued: As per **MPEP § 1411**, double underlining and double bracketing are used in the second reissue application to show amendments made relative to the first reissued patent

(B) For a reissue application, where the patent was previously reexamined and a reexamination certificate has issued for the patent:An amendment in the reissue application must be presented as if the changes made to the original patent text via the reexamination certificate are a part of the original patent. Thus, all italicized text of the reexamination certificate is presented in the amendment (made in the reissue application) without italics. Further, any text found in brackets in the reexamination certificate is omitted in the amendment (made in the reissue application). A claim canceled by the reexamination certificate must be deleted by a direction to strike through the claim, i.e., the canceled claim(s) should be lined through, and not surrounded by brackets.

(C) For a reissue application, where a certificate of correction has issued for the patent:An amendment in the reissue application must be presented as if the changes made to the original patent text via the certificate of correction are a part of the original patent. Thus, all text added by certificate of correction is presented in the amendment (made in the reissue application) without italics. Further, any text deleted by certificate of correction is entirely omitted in the amendment (made in the reissue application). A claim canceled by the certificate of correction must be deleted by a direction to strike through the claim, i.e., the canceled claim(s) should be lined through, and not surrounded by brackets.

(D) For a reissue application, where a statutory disclaimer has issued for the patent:Any claim statutorily disclaimed is no longer in the patent, and such a claim cannot be amended. A disclaimed claim must be deleted by a direction to strike through the claim, i.e., the statutorily disclaimed claim(s) should be lined through, and not surrounded by brackets.

(E) Making amendments in an application for reissue of a previously reissued patent:When a copy of a first reissue patent is presented as the specification of a second reissue application (filed as a reissue of a reissue), additions made by the first reissue will already be printed in italics, and should remain in such format. Thus, applicants need only present additions to the specification/claims in the second reissue application as double underlined text. Subject matter to be deleted from the first reissue patent should be presented in the second reissue application within sets of double brackets. Examples of the form for a twice-reissued patent (a reissue of a reissue) are found in Re. 23,558 and Re. 28,488. Double underlining and double bracketing are used in the second reissue application, while **bold**-faced type and double bracketing appear in the printed patent (the second reissue patent) to indicate further insertions and deletions, respectively, in the second reissue patent.

1454 Appeal Brief [R-11.2013]

The requirements for an appeal brief are set forth in **37 CFR 41.37** and **MPEP § 1205**, and they apply to a reissue application in the same manner that they apply to a non-reissue application. There is, however, a difference in practice as to presentation of the copy of the claims in the appeal brief for a reissue application. The claims on appeal presented in an appeal brief for a reissue application should include all underlining and bracketing necessary to reflect the changes made to the patent claims during the prosecution of the reissue application. In addition,

any new claims added in the reissue application should be completely underlined.

1455 Allowance and Issue [R-11.2013]

I. ISSUE CLASSIFICATION

The examiner completes the Issue Classification information in the same manner as for a non-reissue application. In addition, a copy of an internal review form must also be completed.

II. CHANGES TO THE ORIGINAL PATENT

The specifications of reissue patents will be printed in such a manner as to show the changes over the original patent text by enclosing any material omitted by the reissue in heavy brackets [ ] and printing material added by the reissue in *italics* . **37 CFR 1.173** (see **MPEP § 1411**) requires the specification of a reissue application to be presented in a specified form, specifically designed to facilitate this different manner of printing, as well as for other reasons.

The printed reissue patent specification will carry the following heading, which will be added by the Office of Data Management:

> "Matter enclosed in heavy brackets [ ] appears in the original patent but forms no part of this reissue specification; matter printed in italics indicates the additions made by reissue."

The examiners should see that the specification is in proper form for printing. Examiners should carefully check the entry of all amendments to ensure that the changes directed by applicant will be accurately printed in any reissue patent that may ultimately issue. Matter appearing in the original patent which is omitted by reissue should be enclosed in brackets, while matter added by reissue should be underlined. Any material added by amendment in the reissue application (as underlined text) which is later canceled should be crossed through, *and not bracketed*. Material canceled from the original patent should be enclosed in brackets, *and not lined through.*

All the claims of the original patent should appear in the reissue patent, with canceled patent claims being enclosed in brackets.

III. CLAIM NUMBERING

No renumbering of the original patent claims is permitted, even if the dependency of a dependent patent claim is changed by reissue so that it is to be dependent on a subsequent higher numbered claim.

When a dependent claim in a reissue application depends upon a claim which has been canceled, and the dependent claim is not thereafter made dependent upon a pending claim, such a dependent claim must be rewritten in independent form.

New claims added during the prosecution of the reissue application should follow the number of the highest numbered patent claim and should be completely underlined to indicate they are to be printed in italics on the printed patent. Often, as a result of the prosecution and examination, some new claims are canceled while other new claims remain. When the reissue application is allowed, any claims remaining which are additional to the patent claims (i.e., claims added via the reissue application) should be renumbered in sequence starting with the number next higher than the number of the last claim in the original patent (the printed patent). Therefore, the number of claims allowed will not necessarily correspond to the number of the last claim in the reissue application, as allowed. The number of claims appearing in the "Total Claims Allowed" box on the Issue Classification sheet at the time of allowance should be consistent with the number of claims indicated as allowable on the Notice of Allowability (Form PTOL-37).

IV. CLAIM DESIGNATED FOR PRINTING

At least one claim of an allowable reissue application must be designated for printing in the *Official Gazette.* Whenever at least one claim has been amended or added in the reissue, the claim (claims) designated for printing must be (or include) a claim which has been changed or added by the reissue. A canceled claim is not to be designated as the claim for the *Official Gazette.*

If there is no change in the claims of the allowable reissue application (i.e., when they are the same as the claims of the original patent) or, if the only change in the claims is the cancellation of claims, then the most representative pending *allowed* claim is designated for printing in the *Official Gazette.*

V. PROVIDING PROPER FORMAT

Where a reissue application has not been prepared in the above-indicated manner, the examiner may obtain from the applicant a clean copy of the reissue specification prepared in the indicated form, or a proper submission of a previously improperly submitted amendment. However, if the deletions from the original patent are small, the reissue application can be prepared for issue by putting the bracketed inserts at the appropriate places and suitably numbering the added claims.

When applicant submits a clean copy of the reissue specification, or a proper submission of a previous improper amendment, a supplemental reissue declaration should **not** be provided to address this submission, because the correction of format does not correct a **35 U.S.C. 251** error in the patent.

VI. PARENT APPLICATION DATA

All parent application data on the bibliographic data sheet of the original patent file (or front face of the original patent file wrapper if the original patent is a paper file) should be present on the bibliographic data sheet of the reissue application.

It sometimes happens that the reissue is a continuation reissue application of another reissue application, and there is also original-patent parent application data. The examiner should ensure that the parent application data on the original patent is properly combined with the parent application data of the reissue, in the text of the specification (if present therein) and on the bibliographic data sheet. The combined statement as to parent application data should be checked carefully for proper bracketing and underlining.

VII. REFERENCES CITED AND PRINTED

The examiner should list on a PTO-892 form any reference that was cited during the original prosecution of the patent which is again cited/applied in the reissue application. It is noted that the Office will not print in the reissue patent "References Cited" section any reference cited in the patent but not again cited in the reissue application. Accordingly, should an applicant wish to ensure that all of the references which were cited in the original patent are cited in the reissue application, an information disclosure statement (IDS) in compliance with **37 CFR 1.97** and **1.98** should be filed in the reissue application. A patent cannot be reissued solely for the purpose of adding citations of additional prior art.

VIII. EXAMINER'S AMENDMENT AND REISSUE OATH OR DECLARATION

When it is necessary to amend the reissue application in order to place the application in condition for allowance, the examiner may:

(A) request that applicant provide the amendments (e.g., by facsimile transmission or by hand-carry); or

(B) make the amendments, with the applicant's approval, by a formal examiner's amendment.

If the changes are made by a formal examiner's amendment, the *entire* paragraph(s) or claim(s) being amended need not be presented in rewritten form for any deletions or additions. Changes to the specification including the claims of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. **37 CFR 1.121(g)**.

For applications filed on or after September 16, 2012, if additional defects or errors are corrected in the reissue after the filing of the reissue oath or declaration, a supplemental reissue oath or declaration is not required. However, where all errors previously identified in the reissue oath/declaration are no longer being replied upon as the basis for reissue, the applicant must explicitly identify on the record an error being relied upon as the basis for

reissue (e.g., in the remarks accompanying an amendment). See 37 CFR 1.175(d). Identification of the error must be conspicuous and clear, and must comply with 35 U.S.C. 251.

If the reissue application was filed before September 16, 2012 and the amendment corrects an "error" under **35 U.S.C. 251**, then a supplemental oath or declaration will be required. See **MPEP § 1414.03MPEP § 1444**. The examiner should telephone applicant and request the supplemental oath or declaration, which must be filed before the application can be counted as an allowance.

IX. FINAL REVIEW OF THE REISSUE APPLICATION BY THE EXAMINER

Before forwarding a reissue application to the Technology Center (TC) Training Quality Assurance Specialist (TQAS) for final review, the examiner should complete and initial an Examiner Reissue Checklist. A copy of the checklist should be available from the TQAS or from the Paralegal Specialist of the TC.

1456 Reissue Review [R-11.2013]

All reissue applications are monitored and reviewed in the Technology Centers (TCs) by the appropriate Training Quality Assurance Specialist (TQAS) (which includes TC TQASs, paralegals or other technical support who might be assigned as backup) at several stages during the prosecution. The review by the Office of the TC TQASs is made to check that practice and procedure unique to reissue has been carried out for the reissue application. In addition , a patentability review is made in a sample of reissue applications by the TC TQAS in the manner previously carried out by the former Office of Patent Quality Review. In order to ensure that TQASs are aware of the reissue applications in their TCs, a pair of terminal-specific PALM flags have been created which must be set by the TQAS before certain PALM transactions can be completed. First, when a new reissue application enters the TC, a TQAS must set a PALM "flag" by entering the reissue application number in an Office-wide computer grouping before a docketing transaction will be accepted. By having to set this first flag, the TQAS is made aware of the assignment of the reissue application to the TC and can take steps, as may be appropriate, to instruct the examiner on reissue-specific procedures before the examination process begins, as well as throughout the examination of the reissue application. Second, the TQAS must remove the above-described PALM "flag" before a Notice of Allowance can be generated or the PALM transaction for an issue revision can be entered, thereby ensuring that the TQAS is made aware of when the reissue application is being allowed so that the TQAS may be able to conduct a final review of the reissue application, if appropriate.

1457 Design Reissue Applications and Patents [R-11.2013]

A reissue application can be filed for a design patent in the same manner that a reissue application is filed for a utility patent. There are, however, a few procedures specific to design reissue applications as explained below.

I. EXPEDITED EXAMINATION PROCEDURE

Design reissue applications requesting expedited examination and complying with the requirements of **37 CFR 1.155** are examined with priority and undergo expedited processing throughout the entire course of prosecution in the Office, including appeal, if any, to the Patent Trial and Appeal Board. All processing is expedited from the date the request is granted.

Design reissue applicants seeking expedited examination may file a design reissue application in the Office together with a corresponding request under **37 CFR 1.155** pursuant to the guidelines set forth in **MPEP § 1504.30**.

The design reissue application and the request are processed by the Office of Patent Application Processing (OPAP). OPAP enters the appropriate information into PALM specifying when notice of the design reissue application will be published in the *Official Gazette* (see **MPEP § 1441**). After processing in OPAP, the design reissue application and the request are forwarded to the Design TC Director's Office. Upon a decision by the Design TC Director to grant the request for expedited

examination, fees are immediately processed, and the application papers are promptly assigned an application number. The design reissue application file is then forwarded to the Office of Patent Legal Administration (OPLA) for a decision under **37 CFR 1.182** to *sua sponte* waive the requirement for delaying action in the application until 2 months after announcement of the design reissue application filing is published in the *Official Gazette* (see **MPEP § 1441**). Once the decision under **37 CFR 1.182** is mailed, the design reissue application file will be returned to the Design TC Director's Office. In accordance with the waiver, the Design Group will begin expedited examination of the application under **37 CFR 1.155** promptly after the return of the design reissue application file from OPLA, rather than delay examination until after 2 months from the date the announcement is published in the *Official Gazette* and the applicant will be notified that examination is being expedited. The decision under **37 CFR 1.182** will require that no Notice of Allowance be mailed in the design reissue application until after 2 months from the date the announcement is published in the *Official Gazette* . For example, if the design reissue application is allowed on the first Office action, then jurisdiction over the reissue application will be retained in the TC, and the Notice of Allowance will not be mailed until the expiration of 2 months after publication of the filing of the design reissue application in the *Official Gazette* (plus time for matching any protest filed with the application). The examiner will check the PALM contents to ascertain when publication actually occurred. The delay in the mailing of the Notice of Allowance is to ensure that any potential protests complying with **37 CFR 1.291** submitted within the 2-month delay period will be considered by the Office. (see **MPEP § 1441.01**).

The expedited examination procedure under **37 CFR 1.155** occurs through initial examination processing and throughout the entire prosecution in the Office. Once a request for expedited examination is granted, prosecution of the design reissue application will proceed according to the procedure under **37 CFR 1.155**, and there is no provision for "withdrawal" from expedited examination procedure.

II. DESIGN REISSUE FEE

The design reissue application fee is set forth for in **37 CFR 1.16(e)**. A search fee (**37 CFR 1.16(n)**) and an examination fee (**37 CFR 1.16(r)**) are also required. The additional fees in **37 CFR 1.16(h)** and **37 CFR 1.16(i)** do not apply for a design reissue application because more than one claim in not permitted in a design application pursuant to the last sentence of **37 CFR 1.153(a)**.

The fee for issuing a design reissue patent is set forth in **37 CFR 1.18(b)**.

III. MULTIPLE DESIGN REISSUE APPLICATIONS

The design reissue application can be filed based on the "error" of failing to include a design for a patentably distinct segregable part of the design claimed in the original patent or a patentably distinct subcombination of the claimed design. A reissue design application claiming both the entire article and the patentably distinct subcombination or segregable part would be proper under **35 U.S.C. 251**, if such a reissue application is filed within two years of the issuance of the design patent, because it is considered a broadening of the scope of the patent claim. Restriction will be required under **37 CFR 1.176(b)** in such a reissue design application, and the added design to the segregable part or subcombination will be held to be constructively non-elected and withdrawn from consideration. See **MPEP § 1450**. In the Office action containing the restriction requirement, the examiner should suggest to the applicant that a divisional design reissue application directed to the constructively non-elected segregable part or subcombination subject matter may be filed. The claim to the patented design for the entire article will then be examined and, <u>if found allowable without change from the patent</u>, a rejection will be made under **35 U.S.C. 251** based on the fact that there is no "error" in the non-amended original patent claim. In the Office action making this rejection, applicant should be advised that a proper response to the rejection must include (A) a request to suspend action in this original reissue application pending completion of examination of a divisional reissue application directed to the constructively non-elected segregable part or

subcombination subject matter, (B) the filing of the divisional reissue application, or a statement that one has already been filed (identifying it at least by application number), and (C) an argument that a complete response to the rejection has been made based upon the filing of the divisional reissue application and the request for suspension. Action in the original design reissue application will then be suspended, and the divisional will be examined.

If, after examination, the divisional design reissue application is also determined to be allowable, a requirement must be made in the divisional design reissue application to submit a petition under **37 CFR 1.183** requesting waiver of **37 CFR 1.153** in order to permit the rejoining of the designs to the entire article (of the original application) and the segregable part or subcombination (of the divisional) under a single claim into a single design reissue application for issuance, the single application being the first design reissue application.

It should be noted that the filing of a design reissue application would not be proper if applicant did in fact include the design for a segregable part or subcombination thereof in the original design patent application, a restriction was thus made, and then applicant failed to file a divisional reissue application for a non-elected invention that was canceled in view of a restriction requirement (before issue of the original application. See *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977).

IV. CONVERSION TO UTILITY PATENT

A design patent cannot be converted to a utility patent via reissue.

35 U.S.C. 251 requires that the "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"; however, the design patent (for which the reissue application would be filed) is not wholly or partly inoperative or invalid. There is no error in the design patent. Also, converting a design patent to a utility patent will, in most instances, involve the introduction of new matter into the patent. The disclosure of a design patent is not directed to how the invention is made and used, and the introduction of new matter is required to bridge this gap and provide support for the utility patent. Accordingly, the examiner should consider rejections based on the introduction of new matter under **35 U.S.C. 251** and lack of enablement and/or description under **35 U.S.C. 112**, when a reissue application is filed to convert a design patent to a utility patent.

Further, the term of a design patent may not be extended by reissue. *Ex parte Lawrence*, 70 USPQ 326 (Comm'r Pat. 1946). Thus, any reissue application filed to convert a design patent to a utility patent, which conversion would thereby extend the term of the patent, should be rejected as failing to comply with **35 U.S.C. 251**, which permits reissue only "for the unexpired part of the term of the original patent." The statute requires that the reissued patent shall not extend the term of the original patent.

V. CONVERSION TO A DESIGN PATENT

35 U.S.C. 251 requires that the "patent is, through error , 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"; however, the utility patent is not wholly or partly inoperative or invalid. There is no error in the utility patent. It is also noted that conversion of a design patent would exempt the existing utility patent from maintenance fees, and there is no statutory basis for exempting an existing patent from maintenance fees. Finally, **35 U.S.C. 251** provides that "the Director shall…reissue the patent…for the unexpired part of the term of the original patent"; a conversion from utility patent to a design patent via reissue would impermissibly provide a mechanism for circumventing the 14-year statutory term of a design

patent, in cases where the unexpired term of the original utility patent is more than 14 years.

1458-1459 [Reserved]

1460 Effect of Reissue [R-08.2012]

35 U.S.C. 252 Effect of reissue.

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

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. The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, used, or imported as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or for the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

The effect of the reissue of a patent is stated in **35 U.S.C. 252**. With respect to the Office treatment of the reissued patent, the reissued patent will be viewed as if the original patent had been originally granted in the amended form provided by the reissue. With respect to intervening rights resulting from the reissue of an original patent, the second paragraph of **35 U.S.C. 252** provides for two separate and distinct defenses to patent infringement under the doctrine of intervening rights: "Absolute" intervening rights are available for a party that "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," and "equitable" intervening rights may be provided where "substantial preparation was made before the grant of the reissue." See *BIC Leisure Prods., Inc., v. Windsurfing Int'l, Inc.*, 1 F.3d 1214, 1220, 27 USPQ2d 1671, 1676 (Fed. Cir. 1993).

1461-1469 [Reserved]

1470 Public Access of Reissue Applications [R-11.2013]

37 CFR 1.11(b) opens all reissue applications to inspection by the general public. **37 CFR 1.11(b)** also provides for announcement of the filings of reissue applications in the *Official Gazette* (except for continued prosecution applications filed under **37 CFR 1.53(d)**). This announcement will give interested members of the public an opportunity to submit to the examiner information pertinent to patentability of the reissue application.

The filing of a continued prosecution application (CPA) under **37 CFR 1.53(d)** of a design reissue application (effective July 14, 2003, CPAs are only available in design applications) will not be announced in the *Official Gazette*. Although the filing of a continued prosecution application of a reissue application constitutes the filing of a reissue application, the announcement of the filing of such continued prosecution application would be redundant in view of the announcement of the filing of the prior reissue application in the *Official Gazette*.

IFW reissue application files are open to inspection by the general public by way of Public PAIR via the USPTO Internet site. In viewing the images of the files, members of the public will be able to view the entire content of the reissue application file history. To access Public PAIR, a member of the public would (A) go to the USPTO Web site at

http://www.uspto.gov/patents/process/status/ and click on Public PAIR.

1471-1479 [Reserved]

1480 Certificates of Correction — Office Mistake [R-11.2013]

35 U.S.C. 254 Certificate of correction of Patent and Trademark Office mistake.

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

37 CFR 1.322 Certificate of correction of Office mistake.

(a) (1) The Director may issue a certificate of correction pursuant to **35 U.S.C. 254** to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office:

(i) At the request of the patentee or the patentee's assignee;

(ii) Acting *sua sponte* for mistakes that the Office discovers; or

(iii) Acting on information about a mistake supplied by a third party.

(2) (i) There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section.

(ii) Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office.

(3) If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § **41.121(a)(2)** or § **41.121(a)(3)** of this title.

(4) The Office will not issue a certificate of correction under this section without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in **§ 1.33(a)** and affording the patentee or an assignee an opportunity to be heard.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

Mistakes incurred through the fault of the Office may be the subject of Certificates of Correction under **37 CFR 1.322**. The Office, however, has discretion under **35 U.S.C. 254** to decline to issue a Certificate of Correction even though an Office mistake exists. If Office mistakes are of such a nature that the meaning intended is obvious from the context, the Office may decline to issue a certificate and merely place the correspondence in the patented file, where it serves to call attention to the matter in case any question as to it subsequently arises. Such is the case, even where a correction is requested by the patentee or patentee's assignee.

In order to expedite all proper requests, a Certificate of Correction should be requested only for errors of consequence. Instead of a request for a Certificate of Correction, letters making errors of record should be utilized whenever possible. Thus, where errors are of a minor typographical nature, or are readily apparent to one skilled in the art, a letter making the error(s) of record can be submitted in lieu of a request for a Certificate of Correction. There is no fee for the submission of such a letter.

It is strongly advised that the text of the correction requested be submitted on a Certificate of Correction form, PTO/SB/44 (also referred to as PTO-1050). Submission of this form in duplicate is not necessary. The location of the error in the printed patent should be identified on form PTO/SB/44 by column and line number or claim and line number. See **MPEP § 1485** for a discussion of the preparation and submission of a request for a Certificate of Correction.

A request for a Certificate of Correction should be addressed to:

Commissioner for Patents
Office of Data Mangagement Attention: Certificates of Correction Branch
P.O. Box 1450
Alexandria, VA 22313-1450

I. THIRD PARTY INFORMATION ON MISTAKES IN PATENT

Third parties do not have standing to demand that the Office issue, or refuse to issue, a Certificate of Correction. *See Hallmark Cards, Inc. v. Lehman*, 959 F. Supp. 539, 543-44, 42 USPQ2d 1134, 1138 (D.D.C. 1997). **37 CFR 1.322(a)(2)** makes it clear that third parties do not have standing to demand that the Office act on, respond to, issue, or refuse to issue a Certificate of Correction. The Office is, however, cognizant of the need for the public to have

correct information about published patents and may therefore accept information about mistakes in patents from third parties. **37 CFR 1.322(a)(1)(iii)**. Where appropriate, the Office may issue certificates of correction based on information supplied by third parties, whether or not such information is accompanied by a specific request for issuance of a Certificate of Correction. While third parties are permitted to submit information about mistakes in patents which information will be reviewed, the Office need not act on that information nor respond to accompanying request for issuance of a Certificate of Correction. Accordingly, a fee for submission of the information by a third party has not been imposed. The Office may, however, choose to issue a Certificate of Correction on its own initiative based on the information supplied by a third party, if it desires to do so. Regardless of whether the third party information is acted upon, the information will not be made of record in the file that it relates to, nor be retained by the Office. **37 CFR 1.322(a)(2)(ii)**.

When such third party information (about mistakes in patents) is received by the Office, the Office will not correspond with third parties about the information they submitted either (1) to inform the third parties of whether it intends to issue a Certificate of Correction, or (2) to issue a denial of any request for issuance of a Certificate of Correction that may accompany the information. The Office will confirm to the party submitting such information that the Office has in fact received the information if a stamped, self-addressed post card has been submitted. See **MPEP § 503**.

II. PUBLICATION IN THE OFFICIAL GAZETTE

Each issue of the *Official Gazette* (patents section) numerically lists all United States patents having Certificates of Correction. The list appears under the heading "Certificates of Correction for the week of (date)."

1480.01 Expedited Issuance of Certificates of Correction - Error Attributable to Office [R-11.2013]

In an effort to reduce the overall time required in processing and granting Certificate of Correction requests, the Office will expedite processing and granting of patentee requests where such requests are accompanied by evidence to show that the error is attributable solely to the Office (i.e., requests filed pursuant to **37 CFR 1.322** only).

The following requirements must be met for consideration of expedited issuance of Certificates of Correction:

The text of the correction requested should be submitted on a Certificate of Correction form, PTO/SB/44 (also referred to as PTO-1050). Submission of this form in duplicate is not necessary. The location of the error in the printed patent should be identified on form PTO/SB/44 by column and line number or claim and line number. See also **MPEP § 1485**.

Where the correction requested was incurred through the fault of the Office, and the matter is clearly disclosed in the records of the Office, and is accompanied by documentation that unequivocally supports the patentee's assertion(s), a Certificate of Correction will be expeditiously issued. Such supporting documentation can consist of relevant photocopied receipts, manuscript pages, correspondence dated and received by the Office, photocopies of Examiners' responses regarding entry of amendments, or any other validation that supports the patentee's request so that the request can be processed without the patent file.

Where only part of a request can be approved, the appropriate modifications will be made on the form PTO/SB/44 and the patentee then notified by mail. Further consideration will be given to initially rejected requests upon a request for reconsideration. In this instance, however, or in the case where it is determined that the Office was not responsible for

the error(s) cited by the patentee, accelerated issuance of Certificates of Correction cannot be anticipated (although the Office will make every effort to process the request expeditiously).

As in the case of a request for a Certificate of Correction, a Request for Expedited Issuance of Certificate of Correction should be addressed to:

Commissioner for Patents
Office of Data Management Attention: Certificates of Correction Branch
P.O. Box 1450
Alexandria, VA 22313-1450

1481 Certificates of Correction - Applicant's Mistake [R-11.2013]

35 U.S.C. 255 Certificate of correction of applicant's mistake.

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 on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.323 Certificate of correction of applicant's mistake.

The Office may issue a certificate of correction under the conditions specified in **35 U.S.C. 255** at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in § **1.20(a)**. If the request relates to a patent involved in an interference or trial before the Patent Trial and Appeal Board, the request must comply with the requirements of this section and be accompanied by a motion under § **41.121(a)(2)**, § **41.121(a)(3)** or § **42.20** of this title.

37 CFR 1.323 relates to the issuance of Certificates of Correction for the correction of errors which were not the fault of the Office. Mistakes in a patent which are not correctable by Certificate of Correction may be correctable via filing a reissue application (see **MPEP § 1401** - § **1460**). See *Novo Industries, L.P. v. Micro Molds Corporation*, 350 F.3d 1348, 69 USPQ2d 1128 (Fed. Cir. 2003) (The Federal Circuit stated that when Congress in 1952 defined USPTO authority to make corrections with prospective effect, it did not deny correction authority to the district courts. A court, however, can correct only if "(1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation...").

In re Arnott, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991) specifies the criteria of **35 U.S.C. 255** (for a Certificate of Correction) as follows:

> Two separate statutory requirements must be met before a Certificate of Correction for an applicant's mistake may issue. The first statutory requirement concerns the nature, i.e., type, of the mistake for which a correction is sought. The mistake must be:
> (1) of a clerical nature,
> (2) of a typographical nature, or
> (3) a mistake of minor character.
>
> The second statutory requirement concerns the nature of the proposed correction. The correction must not involve changes which would:
> (1) constitute new matter or
> (2) require reexamination.

If the above criteria are not satisfied, then a Certificate of Correction for an applicant's mistake will not issue, and reissue must be employed as the vehicle to "correct" the patent. Usually, any mistake affecting claim scope must be corrected by reissue.

A mistake is not considered to be of the "minor" character required for the issuance of a Certificate of Correction if the requested change would materially affect the scope or meaning of the patent. See also **MPEP § 1412.04** as to correction of inventorship via certificate of correction or reissue.

The fee for providing a correction of applicant's mistake, other than inventorship, is set forth in **37 CFR 1.20(a)**. The fee for correction of inventorship in a patent is set forth in **37 CFR 1.20(b)**.

1481.01 Correction of Assignees' Names [R-08.2012]

The Fee(s) Transmittal Form portion (PTOL-85B) of the Notice of Allowance provides a space (item

3) for assignment data which should be completed in order to comply with **37 CFR 3.81**. Unless an assignee's name and address are identified in the appropriate space for specifying the assignee, (i.e., item 3 of the Fee(s) Transmittal Form PTOL-85B), the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

Any request for the issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee must:

(A) state that the assignment was submitted for recordation as set forth in **37 CFR 3.11** before issuance of the patent;

(B) include a request for a certificate of correction under **37 CFR 1.323** along with the fee set forth in **37 CFR 1.20(a)**; and

(C) include the processing fee set forth in **37 CFR 1.17(i)**.

See **37 CFR 3.81(b)**.

1481.02 Correction of Named Inventor [R-11.2013]

35 U.S.C. 256 permits the Director to issue a certificate correcting the inventors named in a patent; 37 CFR 1.324 provides the criteria for requests to correct inventorship in a patent. Pre-AIA 35 U.S.C. 256 requires that any error to be corrected must have been made "without deceptive intention." Effective September 16, 2012, Public Law 112-29, sec. 20, 125 Stat. 284 (Leahy-Smith America Invents Act (AIA)), amended 35 U.S.C. 256 to eliminate the "without deceptive intention" clause. See subsection I., below, for the requirements of a petition filed on or after September 16, 2012 to correct inventorship in a patent, and subsection II., below, for the requirements of such a petition filed before September 16, 2012.

While a request under **37 CFR 1.48** is appropriate to correct inventorship in a nonprovisional *application* , a petition under **37 CFR 1.324** is the appropriate vehicle to correct inventorship in a *patent* . If a request under **37 CFR 1.48** is inadvertently filed in a patent, the request may be treated as a petition under **37 CFR 1.324**, and if it is grantable, form paragraph 10.14 set forth in subsection III., below should be used.

Similarly, if a request under **37 CFR 1.48(a), (b), or (c)** is filed in a pending application but not acted upon until after the application becomes a patent, the request may be treated as a petition under **37 CFR 1.324**, and if it is grantable, form paragraph 10.14 set forth below should be used.

The statutory basis for correction of inventorship in a patent under **37 CFR 1.324** is **35 U.S.C. 256**. It is important to recognize that **35 U.S.C. 256** is stricter than **35 U.S.C. 116**, the statutory basis for corrections of inventorship in applications under **37 CFR 1.48**. **35 U.S.C. 256** requires "on application of all the parties and assignees," while **35 U.S.C. 116** does not have the same requirement. Correction of inventorship in a patent under **37 CFR 1.324** requires petition of all the parties, i.e., originally named inventors and assignees, in accordance with statute (**35 U.S.C. 256**) and thus the requirement cannot be waived.

I. REQUEST FILED ON OR AFTER SEPTEMBER 16, 2012, TO CORRECT NAMED INVENTOR

[Editor Note: See subsection II., below, for requests filed before September 16, 2012.]

35 U.S.C. 256 Correction of named inventor.

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

37 CFR 1.324 Correction of inventorship in patent, pursuant to 35 U.S.C. 256.

(a) Whenever through error a person is named in an issued patent as the inventor, or an inventor is not named in an issued patent, the Director, pursuant to **35 U.S.C. 256**, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) A statement from each person who is being added as an inventor and each person who is currently named as an inventor either agreeing to the change of inventorship or stating that he or she has no disagreement in regard to the requested change;

(2) A statement from all assignees of the parties submitting a statement under paragraph (b)(1) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(c) of this chapter; and

(3) The fee set forth in § 1.20(b).

(c) For correction of inventorship in an application, see §§ 1.48.

(d) In an interference under part 41, subpart D, of this title, a request for correction of inventorship in an application must be in the form of a motion under § 41.121(a)(2) of this title. In a contested case under part 42, subpart D, of this title, a request for correction of inventorship in an application must be in the form of a motion under § 42.22 of this title. The motion under § 41.121(a)(2) or § 42.22 of this title must comply with the requirements of this section.

In requesting the Office to effectuate a court order correcting inventorship in a patent pursuant to **35 U.S.C. 256**, a copy of the court order and a Certificate of Correction under **37 CFR 1.323** should be submitted to the Certificates of Corrections Branch.

A petition filed on or after September 16, 2012 to correct the inventorship in a patent must be accompanied by all of the following:

(1) A statement from each person who is being added as in inventor and each person who is currently named as an inventor. Each inventor statement must either agree to the change of inventorship or state that the inventor has no disagreement in regard to the requested change. See 37 CFR 1.324(b)(1).

(2) A statement is required from the assignee(s) of the parties submitting a statement under 37 CFR 1.324(b)(1) agreeing to the change of inventorship in the patent, which statement must comply with the requirements of 37 CFR 3.73(c).See 37 CFR 1.324(b)(2). See MPEP § 325 as to the requirements of a statement under 37 CFR 3.73(c). A statement is required by each entity having an ownership interest in the patent.

(3) (3) The fee set forth in 37 CFR 1.20(b).

If an inventor is not available, or refuses, to submit a statement, the assignee of the patent may wish to consider filing a reissue application to correct inventorship, because the inventor's statement is not required for a non-broadening reissue application to correct inventorship. See **MPEP § 1412.04**.

For correction of inventorship in an application in an interference under 37 CFR part 41, subpart D, 37 CFR 1.324(d) provides that a request for correction of inventorship must be in the form of a motion under 37 CFR 41.121(a)(2). For correction of inventorship in a contested case under 37 CFR part 42, subpart D, 37 CFR 1.324(d) provides that a request for correction of inventorship in an application must be in the form of a motion under 37 CFR 42.22. 37 CFR 1.324(d) further provides that the motion made under 37 CFR 41.121(a)(2) or 42.22 must comply with the requirements of 37 CFR 1.324.

II. REQUEST FILED BEFORE SEPTEMBER 16, 2012, TO CORRECT NAMED INVENTOR

[Editor Note: See subsection I., above, for requests filed on or after September 16, 2012.]

Pre-AIA 35 U.S.C. 256 Correction of named inventor

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

Pre-AIA 37 CFR 1.324

(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to **35 U.S.C. 256**, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;

(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and

(4) The fee set forth in § 1.20(b).

(c) For correction of inventorship in an application, see §§ 1.48 and 1.497.

(d) In a contested case before the Board of Patent Appeals and Interferences under part 41, subpart D, of this title, a request for correction of a patent must be in the form of a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.

In requesting the Office to effectuate a court order correcting inventorship in a patent pursuant to **35 U.S.C. 256**, a copy of the court order and a Certificate of Correction under **37 CFR 1.323** must be submitted to the Certificates of Corrections Branch. A petition filed before September 16, 2012 to correct the inventorship in a patent must comply with the requirements of **pre-AIA 37 CFR 1.324**, and must include the statements and fee required by **pre-AIA 37 CFR 1.324(b)**.

Under pre-AIA 37 CFR 1.324(b)(1), a statement is required from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part. In order to satisfy this, a statement such as the following is sufficient:

> "The inventorship error of failing to include John Smith as an inventor of the patent occurred without any deceptive intention on the part of John Smith."

Nothing more is required. The examiner will determine only whether the statement contains the required language; the examiner will not make any comment as to whether or not it appears that there was in fact deceptive intention (see **MPEP § 2022.05**).

Under **pre-AIA 37 CFR 1.324(b)(2)**, all current inventors who did not submit a statement under **pre-AIA 37 CFR 1.324(b)(1)** must submit a statement either agreeing to the change of inventorship, or stating that they have no disagreement with regard to the requested change. "Current inventors" include the inventor(s) being retained as such and the inventor(s) to be deleted. These current inventors need not make a statement as to whether the inventorship error occurred without deceptive intention. If an inventor is not available, or refuses, to submit a statement, the assignee of the patent may wish to consider filing a reissue application to correct inventorship, because the inventor's statement is not required for a non-broadening reissue application to correct inventorship. See **MPEP § 1412.04**.

Under **pre-AIA 37 CFR 1.324(b)(2)**, a statement is required from the assignee(s) of the patent agreeing to the change of inventorship in the patent. The assignee statement agreeing to the change of inventorship must be accompanied by a proper statement under **pre-AIA 37 CFR 3.73(b)** establishing ownership, unless such a proper statement is already in the file. See **MPEP § 324** as to the requirements of a statement under **pre-AIA 37 CFR 3.73(b)**.

III. PETITION UNDER 37 CFR 1.324 BY SPE

Correction of inventorship requests under 37 CFR 1.324 should be directed to the Supervisory Patent Examiner (SPE) whose unit handles the subject matter of the patent. Form paragraphs 10.13 through 10.18 may be used.

¶ *10.13 Petition Under 37 CFR 1.324, Granted*

In re Patent No. **[1]** : Issue Date: **[2]** : **DECISION** Appl. No.: **[3]** : **GRANTING** Filed: **[4]** : **PETITION** For: **[5]** : **37 CFR 1.324**

This is a decision on the petition filed **[6]** to correct inventorship under **37 CFR 1.324**.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

_____

[7]

Supervisory Patent Examiner,

Art Unit **[8]**,

Technology Center **[9]**

[10]

Examiner Note:

1. Petitions to correct inventorship of an issued patent are decided by the Supervisory Patent Examiner, as set forth in the Commissioner's memorandum dated June 2, 1989.
2. In bracket 10, insert the correspondence address of record.
3. This form paragraph is printed with the USPTO letterhead.
4. Prepare Certificate using form paragraph 10.15.

¶ *10.14 Treatment of Request Under 37 CFR 1.48 Petition Under 37 CFR 1.324, Petition Granted*

In re Patent No. **[1]** : Issue Date: **[2]** : **DECISION** Appl. No.: **[3]** : **GRANTING** Filed: **[4]** : **PETITION** For: **[5]** : **37 CFR 1.324**

This is a decision on the request under 37 CFR 1.48, filed **[6]**. In view of the fact that the patent has already issued, the request under 37 CFR 1.48 has been treated as a petition to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

_____

[7]

Supervisory Patent Examiner,

Art Unit **[8]**,

Technology Center **[9]**

[10]

Examiner Note:

1. Petitions to correct inventorship of an issued patent are decided by the Supervisory Patent Examiner, as set forth in the Commissioner's memorandum dated June 2, 1989.

2. This form paragraph is printed with the USPTO letterhead.

3. Prepare Certificate using form paragraph 10.15.

4. In bracket 10, insert the correspondence address of record.

¶ *10.15 Memorandum - Certificate of Correction (Inventorship)*

DATE: **[1]**TO: Certificates of Correction BranchFROM: **[2]**, SPE, Art Unit **[3]**SUBJECT: Request for Certificate of Correction

Please issue a Certificate of Correction in U. S. Letters Patent No. **[4]** as specified on the attached Certificate.

_____

[5], SPE

Art Unit **[6]**

UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE

Patent No. **[7]**Patented: **[8]**

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

[9]

_____

[10], Supervisory Patent Examiner

Art Unit **[11]**

Examiner Note:

1. In bracket 9, insert the full name and residence (City, State) of each actual inventor.

2. This is an internal memo, not to be mailed to applicant, which accompanies the patented file to Certificates of Correction Branch as noted in form paragraphs 10.13 and 10.14.

3. In brackets 5 and 10, insert name of SPE; in brackets 6 and 11 the Art Unit and sign above each line.

4. Two separate pages of USPTO letterhead will be printed when using this form paragraph.

¶ *10.16.fti Petition Under 37 CFR 1.324 filed prior to September 16, 2012, Dismissed*

In re Patent No. **[1]** : Issue Date: **[2]** : **DECISION** Appl. No.: **[3]** : **DISMISSING** Filed: **[4]** : **PETITION** For: **[5]** : 37 CFR 1.324

This is a decision on the petition filed **[6]** to correct inventorship under 37 CFR 1.324.

The petition is dismissed.

A petition to correct inventorship under 37 CFR 1.324 filed before September 16, 2012, requires (1) a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part, (2) a statement from the current named inventors (including any "inventor" being deleted) who have not submitted a statement as per "(1)" either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change, (3) a statement in compliance with 3.73(b) from all assignees of the parties submitting a statement under "(1)" and "(2)" agreeing to the change of inventorship in the patent; and (4) the fee set forth in 37 CFR 1.20(b).This petition lacks item(s) **[7]**.

_____

[8]

Supervisory Patent Examiner,

Art Unit **[9]**,

Technology Center **[10]**

[11]

Examiner Note:

1. If each of the four specified items has been submitted but one or more is insufficient, the petition should be denied. See form paragraph 10.17. However, if the above noted deficiency can be cured by the submission of a renewed petition, a dismissal would be appropriate.

2. If the petition includes a request for suspension of the rules (37 CFR 1.183) of one or more provisions of 37 CFR 1.324 that are required by the statute (35 U.S.C. 256), form paragraph 10.18 should follow this form paragraph.

3. In bracket 7, pluralize as necessary and insert the item number(s) which are missing.

4. In bracket 11, insert correspondence address of record.

5. This form paragraph is printed with the USPTO letterhead.

6 This form paragraph should only be used if the petition under **37 CFR 1.324** was filed before September 16, 2012. If the petition was filed on or after September 16, 2012, use form paragraph 10.16.01.

¶ *10.16.01 Petition Under 37 CFR 1.324 filed on or after September 16, 2012, Dismissed*

In re Patent No. **[1]** :

Issue Date: **[2]** : **DECISION**

Appl. No.: **[3]** : **DISMISSING**

Filed: **[4]** : **PETITION**

For: **[5]** : **37 CFR 1.324**

This is a decision on the petition filed **[6]** to correct inventorship under **37 CFR 1.324**.

The petition is dismissed.

A petition to correct inventorship under **37 CFR 1.324** filed on or after September 16, 2012, requires (1) a statement from each person who is being added as an inventor and each person who is currently named as an inventor (including any "inventor" being deleted) either agreeing to the change of inventorship or stating that he or she has no disagreement in regard to the requested change, (2) a statement in compliance with **37 CFR 3.73(c)** from all assignees of the parties submitting a statement under "(1)" agreeing to the change of inventorship in the patent; and (3) the fee set forth in **37 CFR 1.20(b)**. This petition lacks item(s) **[7]**.

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[8]

Supervisory Patent Examiner,

Art Unit **[9]**,

Technology Center **[10]**

[11]

Examiner Note:

1. If each of the three specified items has been submitted but one or more is insufficient, the petition should be denied. See form paragraph 10.17. However, if the above noted deficiency can be cured by the submission of a renewed petition, a dismissal would be appropriate.

2. If the petition includes a request for suspension of the rules (**37 CFR 1.183**) of one or more provisions of **37 CFR 1.324** that are required by the statute (**35 U.S.C. 256**), form paragraph 10.18 should follow this form paragraph.

3. In bracket 7, pluralize as necessary and insert the item number(s) which are missing.

4. In bracket 11, insert correspondence address of record.

5. This form paragraph is printed with the USPTO letterhead.

¶ *10.17 Petition Under 37 CFR 1.324, Denied*

In re Patent No. **[1]**: Issue Date: **[2]**:**DECISION DENYING PETITION**Appl. No.: **[3]**: ***37 CFR 1.324*** Filed: **[4]**: For: **[5]**:

This is a decision on the petition filed **[6]** to correct inventorship under **37 CFR 1.324**.

The petition is denied.

[7]

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[8]

Supervisory Patent Examiner,

Art Unit **[9]**,

Technology Center **[10]**

[11]

Examiner Note:

1. In bracket 7, a full explanation of the deficiency must be provided.

2. If the petition lacks one or more of the required parts set forth in **37 CFR 1.324**, it should be dismissed using form paragraph 10.14 or 10.20, rather than being denied.

3. In bracket 11, insert correspondence address of record.

4. This form paragraph is printed with the USPTO letterhead.

¶ *10.18 Waiver of Requirements of 37 CFR 1.324 Under 37 CFR 1.183, Dismissed*

Suspension of the rules under **37 CFR 1.183** may be granted for any requirement of the regulations which is not a requirement of the statutes. In this instance, **35 U.S.C. 256** requires **[1]**. Accordingly, the petition under **37 CFR 1.183** is dismissed.

Examiner Note:

1. This form paragraph should follow form paragraph 10.16 whenever the petition requests waiver of one or more of the provisions of **37 CFR 1.324** that are also requirements of **35 U.S.C. 256**.

2. If the petition requests waiver of requirements of **37 CFR 1.324** that are not specific requirements of the statute (i.e., the fee or the oath or declaration by all inventors), the application must be forwarded to a

petitions attorney in the Office of the Deputy Commissioner for Patent Examination Policy for decision.

1481.03 Correction of 35 U.S.C. 119 and 35 U.S.C. 120 Benefits [R-11.2013]

I. CORRECTION TO PERFECT CLAIM FOR 35 U.S.C. 119 (a)-(d) AND (f) BENEFITS

See **MPEP § 216.01** for a discussion of when **35 U.S.C. 119(a)-(d)** and **(f)** benefits can be perfected by certificate of correction.

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

[Editor Note: See subsection B., below, for applications filed before March 16, 2013 and on or after November 29, 2000. See subsection C., below, for applications filed before November 29, 2000.]

37 CFR 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application. An applicant in a nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim the benefit of one or more prior-filed provisional applications under the conditions set forth in 35 U.S.C. 119(e) and this section.

(1) The nonprovisional application or international application designating the United States of America must be filed not later than twelve months after the date on which the provisional application was filed, or be entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of an application that was filed not later than twelve months after the date on which the provisional application was filed. This twelve-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)).

(2) Each prior-filed provisional application must name the inventor or a joint inventor named in the later— filed application as the inventor or a joint inventor. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(d) must have been paid for such provisional application within the time period set forth in § 1.53(g).

(3) Any nonprovisional application or international application designating the United States of America that claims the benefit of one or more prior-filed provisional applications must contain, or be amended to contain, a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number). If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)).

(4) The reference required by paragraph (a)(3) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed provisional application. Except as provided in paragraph (b) of this section, failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) of the prior-filed provisional application.

(5) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, the applicant will be notified and given a period of time within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an application data sheet eliminating the reference under paragraph (a)(3) of this section to the prior-filed provisional application, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned

(6) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed provisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(b) Delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application. If the reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(4) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if submitted during the pendency of the later-filed application and if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

(1) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted;

(2) The surcharge set forth in § 1.17(t); and

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (a)(4) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) Claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application. An applicant in a nonprovisional application (including an international application entering the national stage under 35 U.S.C. 371) or an international application designating the United States of America may claim the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America under the conditions set forth in 35 U.S.C. 120, 121, or 365(c) and this section.

(1) Each prior-filed application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, each prior-filed application must either be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) A nonprovisional application under 35 U.S.C. 111(a) that is entitled to a filing date as set forth in § 1.53(b) or (d) for which the basic filing fee set forth in § 1.16 has been paid within the pendency of the application.

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application, or international application designating the United States of America, that claims the benefit of one or more prior-filed nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application or international application.

(3) The reference required by 35 U.S.C. 120 and paragraph (c)(2) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. Except as provided in paragraph (d) of this section, failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (c)(2) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to the prior-filed application. The time periods in this paragraph do not apply in a design application.

(4) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(5) Cross-references to other related applications may be made when appropriate (see § 1.14), but cross-references to applications for which a benefit is not claimed under title 35, United States Code, must not be included in an application data sheet (§ 1.76(b)(5)).

(6) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a nonprovisional application or an international application designating the United States of America filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the later-filed application. An applicant is not required to provide such a statement if either:

(i) The application claims the benefit of a nonprovisional application in which a statementunder § 1.55(j), paragraph (a)(6) of this section, or this paragraph that the application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013 has been filed; or

(ii) The applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the later filed application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(d) Delayed claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional application or international application. If the reference required by 35 U.S.C. 120 and paragraph (c)(2) of this section is presented after the time period provided by paragraph (c)(3) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

(1) The reference required by 35 U.S.C. 120 and paragraph (c)(2) of this section to the prior-filed application, unless previously submitted;

(2) The surcharge set forth in § 1.17(t); and

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (c)(3) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(e) Applications containing patentably indistinct claims. Where two or more applications filed by the same applicant contain patentably indistinct claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

(f) Applications or patents under reexamination naming different inventors and containing patentably indistinct claims. If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person and contain patentably indistinct claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on the effective filing date (as defined in § 1.109), or on the date of the invention, as applicable, of the later claimed invention, the Office may require the applicant to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on such date. Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person on the effective filing date (as defined in § 1.109), or on the date of the invention, as applicable, of the later claimed invention, the patentably indistinct claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

(g) Time periods not extendable. The time periods set forth in this section are not extendable.

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Under no circumstances can a Certificate of Correction be employed to correct an applicant's mistake by adding or correcting a priority claim under **35 U.S.C. 119(e)** for an application filed on or after November 29, 2000.

Section 4503 of the American Inventors Protection Act of 1999 (AIPA) amended **35 U.S.C. 119(e)(1)** to state that:

> No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section ***during the pendency of the application***. (emphasis added)

A Certificate of Correction is NOT a valid mechanism for adding or correcting a priority claim under **35 U.S.C. 119(e)** after a patent has been granted on an application filed on or after November 29, 2000.

Under certain conditions as specified below, however, a Certificate of Correction can still be used, with respect to **35 U.S.C. 120** priority, to correct:

(A) the failure to make reference to a prior copending application pursuant to **37 CFR 1.78(a)(2)**; or

(B) an incorrect reference to a prior copending application pursuant to **37 CFR 1.78(a)(2)**.

Where priority is based upon **35 U.S.C. 120** to **a national application**, the following conditions must be satisfied:

(A) all requirements set forth in **37 CFR 1.78(a)(1)** must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see **MPEP § 211** *et seq.*); and

(C) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed, including a surcharge as set forth in **37 CFR 1.17(t)**, as required by **37 CFR 1.78(a)(3)**.

Where **35 U.S.C. 120** and **365(c)** priority based on **an international application** is to be asserted or corrected in a patent via a Certificate of Correction, the following conditions must be satisfied:

(A) all requirements set forth in **37 CFR 1.78(a)(1)** must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see **MPEP § 211** *et seq.*);

(C) the patentee must submit together with the request for the certificate, copies of documentation showing designation of states and any other information needed to make it clear from the record that the **35 U.S.C. 120** priority is appropriate (see **MPEP § 213** *et seq.* as to the requirements for **35 U.S.C. 120** priority based on an international application; and

(D) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed, including a surcharge as set forth in **37 CFR 1.17(t)**, as required by **37 CFR 1.78(a)(3)**.

If all the above-stated conditions are satisfied, a Certificate of Correction can be used to amend the patent to make reference to a prior copending application, or to correct an incorrect reference to the prior copending application, for benefit claims under **35 U.S.C. 120** and **365(c)**.

If any of the above-stated conditions is not satisfied, the filing of a reissue application (see **MPEP § 1401** - § **1460**) may be appropriate to pursue the desired correction of the patent for benefit claims under **35 U.S.C. 120** and **365(c)**.

B. For Applications Filed on or After November 29, 2000 and Before March 16, 2013

[Editor Note: See subsection A., above, for applications filed on or after March 16, 2013. See subsection C., below, for applications filed before November 29, 2000.]

Pre-AIA 37 CFR 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) (1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of **35 U.S.C. 112**. In addition, each prior-filed application must be:

(i) An international application entitled to a filing date in accordance with **PCT Article 11** and designating the United States of America; or

(ii) Entitled to a filing date as set forth in § **1.53(b)** or § **1.53(d)** and have paid therein the basic filing fee set forth in § **1.16** within the pendency of the application.

(2) (i) Except for a continued prosecution application filed under § **1.53(d)**, any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § **1.14**).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under **35 U.S.C. 111(a)**, this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with **35 U.S.C. 371**, this reference must also be submitted within the later of four months from the date on which the national stage commenced under **35 U.S.C. 371(b)** or **(f)** in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by **35 U.S.C. 120** and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under **35 U.S.C. 120,121,** or **365(c)** to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under **35 U.S.C. 111(a)** before November 29, 2000; or

(C) A nonprovisional application which entered the national stage after compliance with **35 U.S.C. 371** from an international application filed under **35 U.S.C. 363** before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ **1.76**), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

(iv) The request for a continued prosecution application under **§ 1.53(d)** is the specific reference required by **35 U.S.C. 120** to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by **35 U.S.C. 120** to every such application assigned that application number.

(3) If the reference required by **35 U.S.C. 120** and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under **35 U.S.C. 120**, **121**, or **365(c)** for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under **35 U.S.C. 120**, **121**, or **365(c)** for the benefit of a prior-filed application must be accompanied by:

(i) The reference required by **35 U.S.C. 120** and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;

(ii) The surcharge set forth in § **1.17(t)**; and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(4) A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim an invention disclosed in one or more prior-filed provisional applications. In order for an application to claim the benefit of one or more prior-filed provisional applications, each prior-filed provisional application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of **35 U.S.C. 112**. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § **1.53(c)**, and the basic filing fee set forth in § **1.16(d)** must be paid within the time period set forth in § **1.53(g)**.

(5) (i) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under **35 U.S.C. 111(a)**, this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with **35 U.S.C. 371**, this reference must also be submitted within the later of four months from the date on which the national stage commenced under **35 U.S.C. 371(b)** or **(f)** in the later-filed international application or sixteen months from the filing date of the prior-filed provisional application. These time periods are not extendable. Except as provided in paragraph(a)(6) of this section, the failure to timely submit the reference is considered a waiver of any benefit under **35 U.S.C. 119(e)** to such prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application filed under **35 U.S.C. 111(a)** before November 29, 2000; or

(B) A nonprovisional application which entered the national stage after compliance with **35 U.S.C. 371** from an international application filed under **35 U.S.C. 363** before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ **1.76(b)(5)**), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

(iv) If the prior-filed provisional application was filed in a language other than English and both an English language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, applicant will be notified and given a period of time within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending

nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an application data sheet eliminating the reference under this paragraph to the prior-filed provisional application, or the nonprovisional application will be abandoned.

(6) If the reference required by **35 U.S.C. 119(e)** and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(5)(ii) of this section, the claim under **35 U.S.C. 119(e)** for the benefit of a prior filed provisional application may be accepted during the pendency of the later-filed application if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under **35 U.S.C. 119(e)** for the benefit of a prior filed provisional application must be accompanied by:

(i) The reference required by **35 U.S.C. 119(e)** and paragraph (a)(5) of this section to the prior-filed provisional application, unless previously submitted;

(ii) The surcharge set forth in § **1.17(t)**; and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(5)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

(c) If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person and contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the Office may require the assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and if not, indicate which named inventor is the prior inventor. Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made, the conflicting claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

Under no circumstances can a Certificate of Correction be employed to correct an applicant's mistake by adding or correcting a priority claim under **35 U.S.C. 119(e)** for an application filed on or after November 29, 2000.

35 U.S.C. 119(e)(1) states in part that:

> No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section ***during the pendency of the application***. (emphasis added)

A Certificate of Correction is NOT a valid mechanism for adding or correcting a priority claim under **35 U.S.C. 119(e)** after a patent has been granted on an application filed on or after November 29, 2000.

Under certain conditions as specified below, however, a Certificate of Correction can still be used, with respect to **35 U.S.C. 120** priority, to correct:

(A) the failure to make reference to a prior copending application pursuant to **pre-AIA 37 CFR 1.78(a)(2)**; or

(B) an incorrect reference to a prior copending application pursuant to **pre-AIA 37 CFR 1.78(a)(2)**.

Where 35 U.S.C. 120 priority is based upon a national application, the following conditions must be satisfied:

(A) all requirements set forth in **pre-AIA 37 CFR 1.78(a)(1)** must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see **MPEP § 211**); and

(C) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed, including a surcharge as set forth in **37 CFR 1.17(t)**, as required by **pre-AIA 37 CFR 1.78(a)(3)**.

Where **35 U.S.C. 120** and **365(c)** priority based on an international application is to be asserted or corrected in a patent via a Certificate of Correction, the following conditions must be satisfied:

(A) all requirements set forth in **pre-AIA 37 CFR 1.78(a)(1)** must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see **MPEP § 211**);

(C) the patentee must submit together with the request for the certificate, copies of documentation showing designation of states and any other

information needed to make it clear from the record that the 35 U.S.C. 120 priority is appropriate (see MPEP § 213.06 as to the requirements for 35 U.S.C. 120 priority based on an international application); and

(D) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed, including a surcharge as set forth in 37 CFR 1.17(t), as required by pre-AIA 37 CFR 1.78(a)(3). If all the above-stated conditions are satisfied, a Certificate of Correction can be used to amend the patent to make reference to a prior copending application, or to correct an incorrect reference to the prior copending application, for benefit claims under 35 U.S.C. 120 and 365(c).

If any of the above-stated conditions is not satisfied, the filing of a reissue application (see MPEP § 1402) may be appropriate to pursue the desired correction of the patent for benefit claims under 35 U.S.C. 120 and 365(c).

C. For Application Filed Before November 29, 2000

[Editor Note: See subsection A., above, for applications filed on or after March 16, 2013. See subsection B., above, for applications filed on or after November 29, 2000 and before March 16, 2013.]

For applications filed before November 29, 2000, it is the version of 37 CFR 1.78, which was in effect on November 28, 2000, that applies. The pre-November 29, 2000 version reads as follows:

Former 37 CFR 1.78

(a) (1) A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or copending international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or copending international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of . In addition, each prior application must be:

(i) An international application entitled to a filing date in accordance with and designating the United States of America; or

(ii) Complete as set forth in § 1.51(b); or

(iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or

(iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(f).

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Unless the reference required by this paragraph is included in an application data sheet (§), the specification must contain or be amended to contain such reference in the first sentence following any title. The request for a continued prosecution application under § 1.53(d) is the specific reference required by to the prior application. The identification of an application by application number under this section is the specific reference required by to every application assigned that application number. Cross-references to other related applications may be made when appropriate (see § 1.14(a)).

(3) A nonprovisional application other than for a design patent may claim an invention disclosed in one or more prior filed copending provisional applications. In order for a nonprovisional application to claim the benefit of one or more prior filed copending provisional applications, each prior provisional application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of . In addition, each prior provisional application must be entitled to a filing date as set forth in § , have any required English-language translation filed therein within the time period set forth in § , and have paid therein the basic filing fee set forth in § within the time period set forth in § .

(4) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number). Unless the reference required by this paragraph is included in an application data sheet (§), the specification must contain or be amended to contain such reference in the first sentence following any title.

*****

Under certain conditions specified below, a Certificate of Correction can be used, with respect to 35 U.S.C. 120 and 119(e) priority, to correct:

(A) the failure to make reference to a prior copending application pursuant to 37 CFR 1.78(a)(2) and (a)(4) as set forth immediately above; or

(B) an incorrect reference to a prior copending application pursuant to 37 CFR 1.78(a)(2) and (a)(4) as set forth immediately above.

For all situations other than where priority is based upon 35 U.S.C. 365(c), the conditions are as follows:

(A) for 35 U.S.C. 120 priority, all requirements set forth in 37 CFR 1.78(a)(1) as set forth immediately above must have been met in the application which became the patent to be corrected;

(B) for 35 U.S.C. 119(e) priority, all requirements set forth in 37 CFR 1.78(a)(3) as set forth immediately above must have been met in the

application which became the patent to be corrected; and

(C) it must be clear from the record of the patent and the parent application(s) that priority is appropriate. See MPEP § § 211 et seq. for requirements under 35 U.S.C. 119(e) and 120.

1482-1484 [Reserved]

1485 Handling of Request for Certificates of Correction [R-11.2013]

A request for a Certificate of Correction should be addressed to:

Commissioner for Patents
Office of Data Management Attention: Certificates of Correction Branch
P.O. Box 1450
Alexandria, VA 22313-1450

Requests for Certificates of Correction will be forwarded to the Certificate of Correction Branch of the Office of Data Management, where they will be listed in a permanent record book.

If the patent is involved in an interference under 37 CFR part 41, subpart D, a Certificate of Correction under **37 CFR 1.324** will not be issued unless a corresponding motion under **37 CFR 41.121(a)(2)** or **41.121(a)(3)** has been granted by the administrative patent judge. If the patent is involved in a contested case under 37 CFR part 42, subpart D, a Certificate of Correction under 37 CFR 1.324 will not be issued unless a corresponding motion under 37 CFR 42.22 has been granted by the administrative patent judge. Otherwise, determination as to whether an error has been made, the responsibility for the error, if any, and whether the error is of such a nature as to justify the issuance of a Certificate of Correction will be made by the Certificate of Correction Branch. If a report is necessary in making such determination, the case will be forwarded to the appropriate group with a request that the report be furnished. If no certificate is to issue, the party making the request is so notified and the request, report, if any, and copy of the communication to the person making the request are entered into the file history by the Certificate of Correction Branch. If a certificate is to issue, it will be prepared and forwarded to the person making the request by the Office of Data Management. In that case, the request, the report, if any, and a copy of the letter transmitting the Certificate of Correction to the person making the request will be entered into the file history.

Applicants, or their attorneys or agents, are urged to submit the text of the correction on a special Certificate of Correction form, PTO/SB/44 (also referred to as Form PTO-1050), which can serve as the camera copy for use in direct offset printing of the Certificate of Correction.

Where only a part of a request can be approved, or where the Office discovers and includes additional corrections, the appropriate alterations are made on the form PTO/SB/44 by the Office. The patentee is notified of the changes on the Notification of Approval-in-part form PTOL-404. The certificate is issued approximately 6 weeks thereafter.

Form PTO/SB/44 should be used exclusively regardless of the length or complexity of the subject matter. Intricate chemical formulas or page of specification or drawings may be reproduced and mounted on a blank copy of PTO/SB/44. Failure to use the form has frequently delayed issuance because the text must be retyped by the Office onto a PTO/SB/44.

The exact page and line number where the errors occur in the application file should be identified on the request. However, on form PTO/SB/44, only the column and line number in the printed patent should be used.

The patent grant should be retained by the patentee. The Office does not attach the Certificate of Correction to patentee's copy of the patent. The patent grant will be returned to the patentee if submitted.

Below is a sample form illustrating a variety of corrections and the suggested manner of setting out the format. Particular attention is directed to:

(A) Identification of the exact point of error by reference to column and line number of the printed patent for changes in the specification or to claim number and line where a claim is involved.

(B) Conservation of space on the form by typing single space, beginning two lines down from the printed message.

(C) Starting the correction to each separate column as a sentence, and using semicolons to separate corrections within the same column, where possible.

(D) Leaving a two-inch space blank at bottom of the last sheet for the signature of the attesting officer.

(E) Using quotation marks to enclose the exact subject matter to be deleted or corrected; using double hyphens (-- --) to enclose subject matter to be added, except for formulas.

(F) Where a formula is involved, setting out only that portion thereof which is to be corrected or, if necessary, pasting a photocopy onto form PTO/SB/44.

UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION
Patent No.: 9,999,999
Application No.: 10/999,999
Issue Date: May 1, 2002
Inventor(s): Eli Y. Rosenthal

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In the drawings, Sheet 3, Fig. 3, the reference numeral 225 should be applied to the plate element attached to the support member 207:

Column 2, line 68 and column 3, lines 3, 8 and 13, for the claim reference numeral '2', each occurrence, should read -1-.

Column 7, lines 45 to 49, the left-hand formula should appear as follows:

$-R_3$ -CHF

Column 8, Formula XVII, that portion of the formula reading “-CHClCH-” should read --$CHFCH_2$ --; line 5, “chlorine” should be changed to --fluorine--.

Column 10, line 29, cancel the text beginning with “12. A sensor device” to and ending “active strips.” in column 11, line 10, and insert the following claim:

12. A control circuit of the character set forth in claim 4 and for an automobile having a convertible top, and including; means for moving the top between a raised and lowered retracted position; and control means responsive to a sensor relay for energizing the top moving means for moving said top from a retracted position to a raised position.

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

Effective August 2001, the U.S. Patent and Trademark Office (USPTO) publishes on the USPTO Web site at **www.uspto.gov/patents/process/search/authority/certofcorrect. jsp** a listing by patent number of the patents for which certificates of correction are being issued.

Under the automated publication process for certificates of correction, each issue of certificates of correction will be electronically published on the USPTO Web site at **www.uspto.gov/patents/process/search/authority/certof correct.jsp**, and will also subsequently be listed in the *Official Gazette* (and in the *Official Gazette Notices* posted at www.uspto.gov/news/og/index.jsp) approximately three weeks thereafter. The listing of certificates of correction in the *Official Gazette* will include the certificate’s date of issuance.

On the date on which the listing of certificates of correction is electronically published on the USPTO Web site: (A) the certificate of correction will be e entered into the file history and will be available to the public; (B) a printed copy of the certificate of correction will be mailed to the patentee or the patent’s assignee; and (C) an image of the printed certificate of correction will be added to the image of the patent on the patent database at patft.uspto.gov/. The date on which the USPTO

makes the certificate of correction available to the public (e.g., by adding the certificate of correction to the file history aqfter signature) will be regarded as the date of issuance of the certificate of correction, not the date of the certificate of correction appearing in the *Official Gazette*. Certificates of correction published in the above-described manner will provide the public with prompt notice and access, and this is consistent with the legislative intent behind the American Inventors Protection Act of 1999. See 35 U.S.C. 10(a) (authorizing the USPTO to publish in electronic form).

The listing of certificates of correction can be electronically accessed on the day of issuance at **www.uspto.gov/patents/process/search/authority/certofcorrect. jsp**. The electronic image of the printed certificate of correction can be accessed on the patent database at patft.uspto.gov/ and the listing of the certificates of correction, as published in the *Official Gazette* three weeks later, will be electronically accessible at **www.uspto.gov/patents/process/search/authority/certofcorrect. jsp**.

PTO/SB/44 (09-07)
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(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

Page _____ of _____

PATENT NO. :

APPLICATION NO.:

ISSUE DATE :

INVENTOR(S) :

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

MAILING ADDRESS OF SENDER (Please do not use customer number below):

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

1486-1489 [Reserved]

1490 Disclaimers [R-11.2013]

35 U.S.C. 253 Disclaimer.

(a) IN GENERAL.—Whenever a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

(b) ADDITIONAL DISCLAIMER OR DEDICATION.—In the manner set forth in subsection (a), any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. 253(a) corresponds to the provisions of pre-AIA 35 U.S.C. 253, first paragraph except that the first sentence of pre-AIA 35 U.S.C. 251 includes the phrase “, without any deceptive intention,” between “Whenever” and “a claim.” Effective September 16, 2012, Public Law 112-29, sec. 20, 125 Stat. 284 (Leahy-Smith America Invents Act (AIA)), amended 35 U.S.C. 253 to eliminate the “without any deceptive intention” clause. 35 U.S.C. 253(b) corresponds to the provisions of pre-AIA 35 U.S.C. 252, second paragraph.

A disclaimer is a statement filed by an owner (in part or in entirety) of a patent or of a patent to be granted (i.e., an application), in which said owner relinquishes certain legal rights to the patent. There are two types of disclaimers: a statutory disclaimer and a terminal disclaimer. The owner of a patent or an application is the original inventor(s) who has/have not assigned away their rights or the assignee(s) of the original inventor(s), or a combination of the two. The patent or application is assigned by one assignment or by multiple assignments which establish a chain of title from the inventor(s) to the assignee(s).

I. SIGNING AND SUPPORTING A DISCLAIMER

37 CFR 1.321 Statutory disclaimers, including terminal disclaimers.

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the *Official Gazette* and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed by the patentee, or an attorney or agent of record;

(2) identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term, will be refused recordation;

(3) state the present extent of patentee’s ownership interest in the patent; and

(4) be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed:

(i) by the applicant, or

(ii) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or

(iii) if there is an assignee of record of the entire interest, by such assignee, or

(iv) by an attorney or agent of record;

(2) specify the portion of the term of the patent being disclaimed;

(3) state the present extent of applicant’s ownership interest in the patent to be granted; and

(4) be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

(d) A terminal disclaimer, when filed in a patent application or in a reexamination proceeding to obviate double patenting based upon a patent or application that is not commonly owned but was disqualified as prior art as set forth in either § **1.104(c)(4)(ii)** or **(c)(5)(ii)** as resulting from activities undertaken within the scope of a joint research agreement, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or be signed in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding;

(3) Include a provision waiving the right to separately enforce any patent granted on that application or any patent subject to the reexamination proceeding and the patent or any patent granted on the application which formed the basis for the double patenting, and that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent and the patent, or any patent granted on the application, which formed the basis for the double patenting are not separately enforced.

Pursuant to 37 CFR 1.321(a), a disclaimer filed in a patent or a reexamination proceeding must be signed by either (1) the patentee (the assignee, the

inventor(s) if the patent is not assigned, or the assignee and the inventors if the patent is assigned-in-part), or (2) an attorney or agent of record. A registered practitioner acting in a representative capacity under **37 CFR 1.34** is not permitted to sign the disclaimer. Where the attorney or agent of record signs the disclaimer, there is no need to comply with 37 CFR 3.73.

37 CFR 1.321(b) sets forth the signature requirements for a terminal disclaimer. Note that the signature requirements for terminal disclaimers filed in a pending application differ depending on the filing date of the application. If the application filing date is on or after September 16, 2012, see subsection A., below; if the application was filed was filed before September 16, 2012, see subsection B., below.

Note that the signature on the disclaimer need not be an original signature. Pursuant to 37 CFR 1.4(d)(1)(ii), the submitted disclaimer can be a copy, such as a photocopy or facsimile transmission of an original disclaimer.

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

A disclaimer filed in a pending application that was filed on or after September 16, 2012 must be signed by the applicant or an attorney or agent of record.

The word "applicant," in this context, refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in 37 CFR 1.43, 1.45, or 1.46. Under 37 CFR 1.43, "applicant" refers to the legal representative of a deceased or legally incapacitated inventor. Under 37 CFR 1.45, "applicant" refers to the inventors; if fewer than all joint inventors are applying for a patent as provided in 37 CFR 1.45, the phrase "the applicant" means the joint inventors who are applying for the patent without the omitted inventor(s). Under 37 CFR 1.46, "applicant" refers to the assignee, the person to whom the inventor is under an obligation to assign the invention, or the person who otherwise shows sufficient proprietary interest in the matter, who is applying for a patent under 37 CFR 1.46 and not the inventor.

An assignee which is not an applicant must file a request to change the applicant under 37 CFR 1.46(c), an application data sheet under 37 CFR 1.76 specifying the applicant in the application information section, and a 37 CFR 3.73(c) statement to become the 37 CFR 1.321(b)(1) applicant in order to file and sign a disclaimer.

In order to obviate a non-statutory double patenting rejection, the entirety of the ownership must sign the terminal disclaimer disclaiming with respect to the reference on which the rejection is based, or multiple terminal disclaimers so disclaiming. Thus, if a 37 CFR 1.321(b)(1) applicant who is not the owner (e.g., an inventor who assigned away the application) signs a disclaimer, the disclaimer will not be entered and the non-statutory double patenting rejection will not be withdrawn by the examiner. The same is true if a 37 CFR 1.321(b)(1) applicant representing less than the entirety of the ownership (see 37 CFR 1.42(c)) signs a disclaimer, and a disclaimer from the remainder of the ownership has not also been filed.

The disclaimer may also be filed by an attorney or agent of record (a registered practitioner acting in a representative capacity under **37 CFR 1.34** is not permitted to sign the disclaimer). Where the attorney or agent of record signs the disclaimer, there is no need to comply with 37 CFR 3.73.

B. Disclaimer in Application Filed Before September 16, 2012

The owner of the patent or application can sign a disclaimer, and a person empowered by the owner to sign the disclaimer can also sign it. For a disclaimer to be accepted, it must be signed by the proper party as follows: (A) A disclaimer filed in an application must be signed by

(1) the applicant where the application has not been assigned,

(2) the applicant and the assignee where each owns a part interest in the application,

(3) the assignee where assignee owns the entire interest in the application, or

(4) an attorney or agent of record.

Where the assignee signs the disclaimer, there is a requirement to comply with pre-AIA 37 CFR 3.73(b)

in order to satisfy pre-AIA 37 CFR 1.321, unless an attorney or agent of record signs the disclaimer. In order to comply with pre-AIA 37 CFR 3.73(b), the assignee's ownership interest must be established by:

(1) filing in the application or patent evidence of a chain of title from the original owner to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11, or

(2) specifying in the record of the application or patent where such evidence is recorded in the Office (e.g., reel and frame number, etc.). The submission with respect to pre-AIA 37 CFR 3.73(b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See also MPEP § 324 as to compliance with pre-AIA 37 CFR 3.73(b). A copy of the "Statement Under 37 CFR 3.73 (b)," which is reproduced in MPEP § 324, may be sent by the examiner to applicant to provide an acceptable way to comply with the requirements of pre-AIA 37 CFR 3.73 (b).

A statement of assignee interest in a terminal disclaimer that "A and B are the owners of 100% of the instant application..." is sufficient to satisfy the pre-AIA 37 CFR 1.321(b)(3) requirement that a terminal disclaimer "state the present extent of applicant's or assignee's ownership interest in the patent to be granted." Although the quoted statement does not identify what specific percentage is owned by A and what specific percentage is owned by B, the statement does provide consent to the terminal disclaimer by the entirety of the ownership of the application (A and B own all of the invention, regardless of the individual percentages they own).

The disclaimer may also be filed by an attorney or agent of record (a registered practitioner acting in a representative capacity under 37 CFR 1.34 is not permitted to sign the disclaimer). Where the attorney or agent of record signs the disclaimer, there is no need to comply with 37 CFR 3.73.

II. STATUTORY DISCLAIMERS

Under **37 CFR 1.321(a)** the owner of a patent may disclaim a complete claim or claims of his or her patent. This may result from a lawsuit or because he or she has reason to believe that the claim or claims are too broad or otherwise invalid. If the patent is involved in an interference or contested case, see **37 CFR 41.121(a)**.

As noted above, a statutory disclaimer is a statement in which a patent owner relinquishes legal rights to one or more claims of a patent. A statutory disclaimer is not, however, a vehicle for adding or amending claims, because there is no provision for such in the statute (**35 U.S.C. 253**) nor the rules (**37 CFR 1.321**). Thus, claims of a patent cannot be disclaimed in favor of new claims to be added to the patent or an amendment to existing claims.

III. TERMINAL DISCLAIMERS

37 CFR 1.321(a) and (b)also provide for the filing by a patentee or applicant of a terminal disclaimer which disclaims or dedicates to the public the entire term or any terminal part of the term of a patent or patent to be granted.

37 CFR 1.321(c) specifically provides for the filing of a terminal disclaimer in an application or a reexamination proceeding for the purpose of overcoming a nonstatutory double patenting rejection. See **MPEP § 804.02**.

37 CFR 1.321(d) specifically provides for the filing of a terminal disclaimer in an application or a reexamination proceeding for the purpose of overcoming a nonstatutory double patenting rejection based on a U.S. patent or application that is not commonly owned but was disqualified pursuant to either 37 CFR 1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement.

IV. PROCESSING IN CERTIFICATE OF CORRECTION BRANCH

The Certificate of Correction Branch is responsible for the processing of all statutory disclaimers filed under the first paragraph of **35 U.S.C. 253**, whether the case is pending or patented, and all terminal disclaimers (filed under **35 U.S.C. 253**) except for those filed in a pending application or reexamination proceeding. This processing involves:

(A) Determining the compliance of the disclaimer with 35 U.S.C. 253 and 37 CFR 1.321 and 3.73;

(B) Notifying applicant or patentee when the disclaimer is informal and thus not acceptable;

(C) Recording the disclaimers in the record of the application file; and

(D) Providing the disclaimer data for printing in the *Official Gazette*.

V. PROCESSING OF TERMINAL DISCLAIMER IN PENDING APPLICATION

The Office provides for the submission of eTerminal Disclaimers (eTDs) via EFS-Web. A web-based eTD may be filled out completely online using web-screens. An eTD that meets all requirements is auto-processed, approved immediately upon submission, and directly loads into the USPTO databases which will increase accuracy and facilitate faster processing. Note that eTDs are accepted only for nonprovisional utility applications (including national stage and reissue) and design applications (including reissue). Requests for terminal disclaimers for plant patent applications, reexaminations, and terminal disclaimers based on a joint research agreement must be filed by paper or a scanned image PDF submitted via EFS-Web. For more information about eTerminal Disclaimers, refer to http://www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I. jsp.

Where a terminal disclaimer other than an eTD is filed in an application pending in a TC, it will be processed by a Paralegal Specialist of the Patent Legal Research Center or a paralegal of the Office of the Special Program Examiner or appropriate Training Quality Assurance Specialist (TQAS) of the TC having responsibility for the application. The paralegal will:

(A) Determine compliance with 35 U.S.C. 253 and 37 CFR 1.321 and 3.73, and ensure that the appropriate terminal disclaimer fee set forth in 37 CFR 1.20(d) is/was applied;

(B) Notify the examiner having charge of the application whether the terminal disclaimer is acceptable or not by completing a Terminal Disclaimer review decision form;

(C) Where the terminal disclaimer is not acceptable, indicate the nature of the informalities so that the examiner can inform applicant in the next Office action.

The paralegal completes a Terminal Disclaimer review decision form to notify the examiner of the nature of any informalities in the terminal disclaimer. The examiner should notify the applicant of the informalities in the next Office action, or by interview with applicant if such will expedite prosecution of the application.

VI. OTHER MATTERS DIRECTED TO TERMINAL DISCLAIMERS

A. Requirements of Terminal Disclaimers

A proper terminal disclaimer must disclaim the terminal part of the statutory term of any patent granted on the application being examined which would extend beyond the expiration date of the full statutory term, shortened by any terminal disclaimer, of the patent (or of any patent granted on the application) to which the disclaimer is directed. Note the exculpatory language in the second paragraph of the sample terminal disclaimer forms, PTO/SB/25, PTO/SB/26 and PTO/AIA/25 and PTO/AIA/26, provided at the end of this Chapter. That language ("In making the above disclaimer, the owner does not disclaim...") is permissible in a terminal disclaimer.

A terminal disclaimer filed to obviate a nonstatutory double patenting rejection based on a commonly owned patent or application must comply with the requirements of 37 CFR 1.321(c). The terminal disclaimer must state that any patent granted on the application being examined will be enforceable only for and during the period that it and the patent to which the disclaimer is directed or the patent granted on the application to which the disclaimer is directed are commonly owned. See MPEP § 706.02(1)(2) for examples of common ownership, or lack thereof.

A terminal disclaimer filed to obviate a nonstatutory double patenting rejection based on a non-commonly owned patent or application disqualified under 35 U.S.C. 102(b)(2)(C) or under pre-AIA 35 U.S.C. 103(c) as a result of activities undertaken within the scope of a joint research agreement under 35 U.S.C. 102(c) or pre-AIA 35 U.S.C. 103(c)(2) and (3) must comply with 37 CFR 1.321(d), which sets forth

signature, waiver rights and enforceability requirements.

The terminal disclaimer must include a provision:

(1) waiving the right to separately enforce (a) any patent granted on that application or the patent being reexamined and (b) the reference patent, or any patent granted on the reference application which formed the basis for the double patenting; and

(2) agreeing that any patent granted on that application or patent being reexamined shall be enforceable only for and during such period that said patent and the reference patent, or any patent granted on the reference application, which formed the basis for the double patenting are not separately enforced.

A terminal disclaimer must state that the agreement is to run with any patent granted on the application being examined and is to be binding upon the grantee, its successors, or assigns.

The appropriate one of form paragraphs 14.27.04 to 14.27.08 (reproduced below) may be used to provide applicant or patent owner with an example of acceptable terminal disclaimer language. Additionally, copies of forms PTO/SB/25, PTO/SB/26, PTO/AIA/25 and PTO/AIA/26 (provided at the end of this Chapter) may be attached to the Office action to provide sample terminal disclaimers.

Pursuant to the last sentence of **35 U.S.C. 253**, "any patentee or applicant may disclaim or dedicate to the public... any terminal part of the term, of the patent granted or to be granted". Accordingly, the disclaimer must be of a terminal portion of the term of the entire patent to be granted. A disclaimer of a terminal portion of the term of an individual claim, or individual claims will not be accepted. A disclaimer of the term of individual claims would not be appropriate because the claims of a pending application or proceeding are subject to cancellation, amendment, or renumbering. It is further noted that the statute does not provide for conditional disclaimers (whether they are terminal disclaimers or statutory disclaimers) and accordingly, a proposed disclaimer that is made contingent on the allowance of certain claims or the granting of a petition, is improper and cannot be accepted. The disclaimer should identify the disclaimant and his or her interest in the application and should specify the date when the disclaimer is to become effective.

B. Effect of Disclaimers in Continuing Applications and in Reissues

A terminal disclaimer filed to obviate a nonstatutory double patenting rejection is effective only with respect to the application identified in the disclaimer unless by its terms it extends to continuing applications (in which case, applicant must file a copy of the disclaimer in the continuing application, to obviate any nonstatutory double patenting rejection to which the disclaimer is directed). *See President and Fellows of Harvard College v. Rea,* 2013 WL 2152635 (E.D.Va. May 15, 2013) (NO. 1:12-CV-1034). For example, a terminal disclaimer filed in a parent application normally has no effect on a continuing application claiming filing date benefits of the parent application under **35 U.S.C. 120**. A terminal disclaimer filed in a parent application to obviate a nonstatutory double patenting rejection *does, however, carry over* to a continued prosecution application (CPA) filed under **37 CFR 1.53(d)** (effective July 14, 2003, CPAs are only available in design applications). The terminal disclaimer filed in the parent application carries over because the CPA retains the *same application number* as the parent application, i.e., the application number to which the previously filed terminal disclaimer is directed. If applicant does not want the terminal disclaimer to carry over to the CPA, applicant must file a petition under **37 CFR 1.182**, along with the required petition fee, requesting the terminal disclaimer filed in the parent application not be carried over to the CPA; see below "Withdrawing a Terminal Disclaimer" (paragraph "A. Before Issuance of Patent"). If applicant files a Request for Continued Examination (RCE) of an application under **37 CFR 1.114** (which can be filed on or after May 29, 2000 for an application filed on or after June 8, 1995), any terminal disclaimer present will continue to operate, because a new application has not been filed, but rather prosecution has been continued in the existing application. A petition under **37 CFR 1.182**, along with the required petition fee, may be filed, if withdrawal of the terminal disclaimer is to be requested. Reissue applications: Where a terminal disclaimer was filed in an original application, a copy of that terminal

disclaimer is not required to be filed by applicant in the reissue.

An internal review form will be filled out to indicate that a terminal disclaimer has been filed for the patent (and will be effective for the patent as it will be reissued). Further, a copy of the terminal disclaimer should be placed into the reissue application file history by the Technology Center.

C. Disclaimer Identifies the Wrong Target Application or Patent

In some instances a terminal disclaimer filed to obviate a nonstatutory double patenting rejection will identify the wrong target application or patent (i.e., an application or patent which is not the basis for the double patenting rejection). In these instances, a replacement terminal disclaimer identifying the correct target application or patent would be required by the examiner. Once a correct replacement terminal disclaimer is received, the next Office action should make it clear that "the second terminal disclaimer replaces the first terminal disclaimer, and the first terminal disclaimer is thus void." A second terminal disclaimer fee should not be assessed/charged, because the first fee is applied to the second terminal disclaimer.

D. Two or More Copending Applications

If two (or more) pending applications are filed, in *each* of which a rejection of one claimed invention over the other on the ground of provisional nonstatutory double patenting (ODP) is proper, the provisional ODP rejection will be made in each application. If the provisional ODP rejection is the only rejection remaining in the earlier-filed of the two pending applications, (but the later-filed application is rejectable on other grounds), the examiner should then withdraw the provisional ODP rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the provisional ODP rejection is the only rejection remaining in the later-filed application, (while the earlier-filed application is rejectable on other grounds), a terminal disclaimer must be required in the later-filed application, before the provisional ODP rejection can be withdrawn.

If the provisional ODP rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw the provisional ODP rejection in the earlier-filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the provisional ODP rejection can be withdrawn and the application be permitted to issue.

The phrase "earlier-filed" for determining in which application the terminal disclaimer need not be filed, is to be interpreted as follows:

(A) Where there is no benefit claim in the two applications, the "earlier-filed" application is the one having the earlier actual filing date;

(B) (1) Where at least one of the two applications is entitled to the benefit of a U.S. nonprovisional application under **35 U.S.C. 120**, **121**, or **365(c)**, the "earlier-filed" application is the one having the earliest date to which it is entitled benefit under **35 U.S.C. 120**, **121**, and/or **365(c)**. (2) Where two applications are entitled to the benefit of the same U.S. nonprovisional application under **35 U.S.C. 120**, **121**, or **365(c)**, if all the conflicting claims of one of the applications are not appropriately supported in the parent application (and therefore, not entitled to the benefit of the filing date of the parent application), while the conflicting claims of the other application are appropriately supported in the parent application (and therefore, entitled to the benefit of the filing date of the parent application), then the other application is the earlier-filed application. If none of the conflicting claims of either application are appropriately supported in the parent application, then the actual filing dates of the two applications govern.

(C) A **35 U.S.C. 119(e)** benefit is NOT taken into account in determining which is the "earlier-filed" application.

(D) A foreign priority claim under **35 U.S.C. 119(a)** is NOT taken into account in determining which is the "earlier-filed" application.

For items (C) and (D), it is to be noted that patent term does not begin from the date of the 35 U.S.C. 119 filing. Thus, if a patent # 1 has a 35 U.S.C. 119 filing date prior to patent # 2, but has a U.S. application filing date after patent # 2, then patent

1 will expire later than patent # 2, and patent # 2 will be determined to be the "earlier-filed" application. See 35 U.S.C. 154(a)(2) and (a)(3).

If both applications are filed on the same day, the provisional ODP rejection made in each of the applications should be maintained until applicant overcomes the rejections by either filing a reply showing that the claims subject to the provisional ODP rejections are patentably distinct or filing a terminal disclaimer in each of the pending applications.

If both applications are entitled to the benefit of the same U.S. nonprovisional application under **35 U.S.C. 120**, **121**, or **365(c)** , and (B)(2) above does not apply, then the provisional ODP rejection made in each of the applications should be maintained until applicant overcomes the rejections by either filing a reply showing that the claims subject to the provisional ODP rejections are patentably distinct or filing a terminal disclaimer in each of the pending applications.

Where there are three applications containing claims that conflict such that a provisional ODP rejection is made in each application based upon the other two, it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. Rather, an appropriate terminal disclaimer must be filed in at least two of the applications to link all three together. This is because a terminal disclaimer filed to obviate a nonstatutory double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed; it is not effective to link the other two applications to each other.

VII. FORM PARAGRAPHS

The following form paragraphs may be used to inform the applicant (or patent owner) of the status of a submitted terminal disclaimer.

¶ *14.23 Terminal Disclaimer Proper*

The terminal disclaimer filed on **[1]** disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of **[2]** has been reviewed and is accepted. The terminal disclaimer has been recorded.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.

2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.

3. See **MPEP § 1490** for discussion of requirements for a proper terminal disclaimer.

4. Use form paragraph 14.23.01 for reexamination proceedings.

5. For improper terminal disclaimers, see form paragraphs 14.24 *et seq*.

¶ *14.23.01 Terminal Disclaimer Proper (Reexamination Only)*

The terminal disclaimer filed on **[1]** disclaiming the terminal portion of the patent being reexamined which would extend beyond the expiration date of **[2]** has been reviewed and is accepted. The terminal disclaimer has been recorded.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.

2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.

3. See **MPEP § 1490** for discussion of requirements for a proper terminal disclaimer.

4. For improper terminal disclaimers, see the form paragraphs which follow.

¶ *14.24 Terminal Disclaimer Not Proper - Introductory Paragraph*

The terminal disclaimer filed on **[1]** disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of **[2]** has been reviewed and is NOT accepted.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.

2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.

3. One or more of the appropriate form paragraphs 14.26 to 14.32 MUST follow this form paragraph to indicate why the terminal disclaimer is not accepted.

4. Form paragraph 14.35 may be used to inform applicant that an additional disclaimer fee will not be required for the submission of a replacement or supplemental terminal disclaimer.

5. Do not use in reexamination proceedings, use form paragraph 14.25 instead.

¶ *14.25 Terminal Disclaimer Not Proper - Introductory Paragraph (Reexamination Only)*

The terminal disclaimer filed on **[1]** disclaiming the terminal portion of the patent being reexamined which would extend beyond the expiration date of **[2]** has been reviewed and is NOT accepted.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.

2. In bracket 2, list the Patent Number and/or the Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.

3. One or more of the appropriate form paragraphs 14.26 to 14.32 MUST follow this form paragraph to indicate why the terminal disclaimer is not accepted.

4. Form paragraph 14.35 may be used to inform applicant that an additional disclaimer fee will not be required for the submission of a replacement or supplemental terminal disclaimer.

¶ *14.26 Does Not Comply With 37 CFR 1.321 "Sub-Heading" Only*

The terminal disclaimer does not comply with **37 CFR 1.321** because:

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 and followed by one or more of the appropriate form paragraphs 14.26.01 to 14.27.03.

¶ *14.26.01 Extent of Interest Not Stated*

The person who has signed the disclaimer has not stated the extent of his/her interest, or the business entity's interest, in the application/patent. See **37 CFR 1.321(b)(3)**.

Examiner Note:

This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

¶ *14.26.02 Directed to Particular Claim(s)*

It is directed to a particular claim or claims, which is not acceptable, since "the disclaimer must be of a terminal portion of the term of the entire [patent or] patent to be granted." See **MPEP § 1490**.

Examiner Note:

This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

¶ *14.26.03 Not Signed*

The terminal disclaimer was not signed.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

¶ *14.26.04 Application/Patent Not Identified*

The application/patent being disclaimed has not been identified.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

¶ *14.26.05 Application/Patent Improperly Identified*

The application/patent being disclaimed has been improperly identified since the number used to identify the **[1]** being disclaimed is incorrect. The correct number is **[2]**.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

2. In bracket 1, insert --application-- or --patent--.

3. In bracket 2, insert the correct Application Number (including series code and serial no.) or the correct Patent Number being disclaimed.

4. A terminal disclaimer is acceptable if it includes the correct Patent Number or the correct Application Number or the serial number together with the proper filing date or the proper series code.

¶ *14.26.06.fti fti Not Signed by All Owners - Application Filed Before Sept. 16, 2012*

This application was filed before September 16, 2012. The terminal disclaimer was not signed by all owners and, therefore, supplemental terminal disclaimers are required from the remaining owners.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

2. Do not use this form paragraph in an application filed on or after September 16, 2012.

¶ *14.26.07 No Disclaimer Fee Submitted*

The disclaimer fee of $ **[1]** in accordance with **37 CFR 1.20(d)** has not been submitted, nor is there any authorization in the application file to charge a specified Deposit Account or credit card.

Examiner Note:

1. In bracket 1, insert the fee for a disclaimer.

2. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26. If the disclaimer fee was paid for a terminal disclaimer which was not accepted, applicant does not have to pay another disclaimer fee when submitting a replacement or supplemental terminal disclaimer, and this form paragraph should not be used.

¶ *14.26.08 Terminal Disclaimer Not Properly Signed - Application Filed On or After Sept. 16, 2012*

This application was filed on or after September 16, 2012. The person who signed the terminal disclaimer is not the applicant, the patentee or an attorney or agent of record. See **37 CFR 1.321(a)** and **(b)**.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

2. Do not use this form paragraph in an application filed before September 16, 2012.

¶ *14.26.09 Failure To State Capacity To Sign - Application Filed On or After Sept. 16, 2012*

This application was filed on or after September 16, 2012. The person who signed the terminal disclaimer has failed to state his/her capacity to sign for the juristic entity, and he/she has not been established as being authorized to act on behalf of the applicant.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

2. Do not use this form paragraph in an application filed before 9/16/12.

¶ *14.26.10 Terminal Disclaimer Identifies Party Who Is Not The Applicant - Application Filed On or After Sept. 16, 2012*

This application was filed on or after September 16, 2012. The party identified in the terminal disclaimer is not the applicant of record. A request to change the applicant under **37 CFR 1.46(c)** must be filed and must include an application data sheet specifying the applicant in the applicant information section and comply with **37 CFR 3.71** and **3.73**. To be reconsidered, the terminal disclaimer must be filed with the request under **37 CFR 1.46(c)**.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

2. Do not use this form paragraph in an application filed before 9/16/12.

¶ *14.27.01 Lacks Clause of Enforceable Only During Period of Common Ownership*

It does not include a recitation that any patent granted shall be enforceable only for and during such period that said patent is commonly owned with the application(s) or patent(s) which formed the basis for the double patenting rejection. See **37 CFR 1.321(c)(3)** .

Examiner Note:

This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND 14.26.

¶ *14.27.011 Lacks 37 CFR 1.321(d) statement for joint research agreement under 35 U.S.C. 102(c) or pre-AIA 35 U.S.C. 103(c)(2)&(3)*

It does not include the waiver and enforceability provisions of **37 CFR 1.321(d)**. The terminal disclaimer must include a provision:

(1) waiving the right to separately enforce (a) any patent granted on that application or the patent being reexamined and (b) the reference patent, or any patent granted on the reference application which formed the basis for the double patenting rejection; and

(2) agreeing that any patent granted on that application or patent being reexamined shall be enforceable only for and during such period that said patent and the reference patent, or any patent granted on the reference application, which formed the basis for the double patenting are not separately enforced.

See **37 CFR 1.321(d)(3)**.

Examiner Note:

1. For applications filed before September 16, 2012, this form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26, and should be followed by either form paragraph 14.27.07 or form paragraph 14.27.08.

2. For applications filed on or after September 16, 2012, this form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26, and should be followed by either form paragraph 14.27.07.1 or form paragraph 14.27.08.

¶ *14.27.02 Fails To Disclaim Terminal Portion of Any Patent Granted On Subject Application*

It fails to disclaim the terminal portion of any patent granted on the subject application.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

2. Use this form paragraph when the period disclaimed is not the correct period or when no period is specified at all.

3. When using this form paragraph, give an example of proper terminal disclaimer language using form paragraph 14.27.04.fti (for applications filed before September 16, 2012) or form paragraph 14.27.04.1 (for applications filed on or after September 16, 2012) following this or the series of statements concerning the defective terminal disclaimer.

¶ *14.27.03 Fails To Disclaim Terminal Portion of Subject Patent*

It fails to disclaim the terminal portion of the subject patent.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

2. Use this form paragraph in a reissue application or reexamination proceeding when the period disclaimed is not the correct period or when no period is specified at all.

¶ *14.27.04.fti Examples of Acceptable Terminal Disclaimer Language in Patent To Be Granted -Application Filed Before Sept. 16, 2012*

This application was filed before September 16, 2012. Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, use:The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number _____, filed on _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The applicant hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:The applicant,

_____, owner of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____ as the term of said **prior patent** is presently shortened by any terminal disclaimer. The applicant hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

Alternatively, Form PTO/SB/25 may be used for situation I, and Form PTO/SB/26 may be used for situation II.

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent (e.g., for a reexamination situation), other than for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.06.

2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.07.1 for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.08 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

¶ *14.27.04.1 Examples of Acceptable Terminal Disclaimer Language in Patent To Be Granted – Application Filed On or After Sept. 16, 2012*

This application was filed before September 16, 2012. Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, use:The owner, _____, of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number _____, filed on _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:The owner, _____, of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____ as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.Alternatively, Form PTO/SB/25 may be used for situation I, and Form PTO/SB/26 may be used for situation II; a copy of each form may be found at the end of **MPEP § 1490**.

Examiner Note:

1. This form paragraph may be used in an application filed before September 16, 2012 to provide examples of acceptable terminal disclaimer language in a patent (e.g., for a reexamination situation), other than for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.06.

2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.07.fti for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.08 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

¶ *14.27.06 Examples of Acceptable Terminal Disclaimer Language in Patent (Reexamination Situation)*

Examples of acceptable language for making the disclaimer of the terminal portion of the patent being reexamined (or otherwise for an existing patent) follow:

I.If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, or is otherwise believed to be applicable to the patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of any patent granted on pending Application Number _____, filed on _____, as the term of any patent granted on said application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending application. The patent owner hereby agrees that the instant patent shall be enforceable only for and during such period that the instant patent and any patent granted on the above-listed pending application are commonly owned. This agreement is binding upon the patent owner, its successors, or assigns.

II. If an Obviousness-Type Double Patenting Rejection Over A Referenced Patent was made, or is otherwise believed to be applicable to the instant patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of referenced patent No. _____ as the term of said prior patent is presently shortened by any terminal disclaimer. The patent owner hereby agrees that the instant patent shall be enforceable only for and during such period that the instant patent and the referenced patent are commonly owned. This agreement is binding upon the patent owner, its successors, or assigns.

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent to be granted on an application (generally, an application being examined), other than for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.04.fti.

2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.07for making the disclaimer of the terminal

portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.08 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

¶ *14.27.07.fti Examples of Acceptable Terminal Disclaimer Language – Application Filed Before Sept. 16, 2012, Activities Undertaken Within the Scope of a Joint Research Agreement*

This application was filed before September 16, 2012. Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, use:The owner, _____, of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number _____, filed on _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application.The owner of the instant application waives the right to separately enforce any patent granted on the instant application and any patent granted on the **reference** application. The owner of the instant application hereby agrees that any patent granted on the instant application and any patent granted on the **reference** application shall be enforceable only for and during such period that the instant application and the **reference** application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and any patent granted on the **reference** application, and are binding upon the owner of the instant application, its successors, or assigns.

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:The owner, _____, of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____, as the term of said **prior patent** is presently shortened by any terminal disclaimer.The owner of the instant application waives the right to separately enforce the **prior patent** and any patent granted on the instant application. The owner of the instant application hereby agrees that the **prior patent** and any patent granted on the instant application shall be enforceable only for and during such period that the **prior patent** and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the owner of the instant application, its successors, or assigns.

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent (e.g., for a reexamination situation) for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.08.

2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer in a situation other than one based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.04.fti for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.06 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

¶ *14.27.07.1 Examples of Acceptable Terminal Disclaimer Language – Application Filed On or After Sept. 16, 2012, Activities Undertaken Within the Scope of a Joint Research Agreement*

This application was filed on or after September 16, 2012. Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number _____, filed on _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application.The applicant of the instant application waives the right to separately enforce any patent granted on the instant application and any patent granted on the **reference** application. The applicant of the instant application hereby agrees that any patent granted on the instant application and any patent granted on the **reference** application shall be enforceable only for and during such period that the instant application and the **reference** application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and any patent granted on the **reference** application, and are binding upon the applicant of the instant application, its successors, or assigns.

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____, as the term of said **prior patent** is presently shortened by any terminal disclaimer. The applicant of the instant application waives the right to separately enforce the **prior patent** and any patent granted on the instant application. The applicant of the instant application hereby agrees that the **prior patent** and any patent granted on the instant application shall be enforceable only for and during such period that the **prior patent** and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent (e.g., for a reexamination situation) for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.08.

2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer in a situation other than one based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.04.1 for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.06 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

¶ *14.27.08 Examples of Acceptable Terminal Disclaimer Language in Patent (Reexamination Situation; activities undertaken within the scope of a joint research agreement)*

Examples of acceptable language for making the disclaimer of the terminal portion of the patent being reexamined (or otherwise for an existing patent) follow:

I. If a provisional obviousness-type double patenting rejection over a Pending Application was made, or is otherwise believed to be applicable to the patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of any patent granted on pending Application Number _____, filed on _____, as the term of any patent granted on said application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending application.

The patent owner waives the right to separately enforce the instant patent and the above-listed pending application. The patent owner agrees that the instant patent and any patent granted on the above-listed pending application shall be enforceable only for and during such period that the instant patent and the patent granted on the above-listed pending application are not separately enforced. The waiver, and this agreement, run with any patent granted on the above-listed pending application, and are binding upon the patent owner, its successors, or assigns.

II. If an obviousness-type double patenting rejection over a Referenced Patent was made, or is otherwise believed to be applicable to the instant patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of referenced patent No. _____, as the term of said referenced patent is presently shortened by any terminal disclaimer.

The patent owner waives the right to separately enforce the instant patent and the referenced patent. The patent owner agrees that the instant patent and the referenced patent shall be enforceable only for and during such period that the instant patent and the referenced patent are not separately enforced. The waiver, and this agreement, are binding upon the patent owner, its successors, or assigns.

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent to be granted on an application (generally, an application being examined) for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.07.fti (for applications filed before September 16, 2012) or form paragraph 14.27.07.1 (for applications filed on or after September 16, 2012).

2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer in a situation other than one based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.04.fti (for applications filed before September 16, 2012) or form paragraph 14.27.04.1 (for applications filed on or after September 16, 2012) for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.06 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

¶ *14.28.fti Failure To State Capacity To Sign – Application Filed Before Sept. 16, 2012*

This application was filed before September 16, 2012. The person who signed the terminal disclaimer has failed to state his/her capacity to sign for the corporation, or other business entity or organization, and he/she has not been established as being authorized to act on behalf of the assignee.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.26.

2. Do not use this form paragraph in an application filed on or after September 16, 2012.

¶ *14.29.fti Not Recognized as Officer of Assignee – Application Filed Before Sept. 16, 2012,"Sub-Heading" Only*

This application was filed before September 16, 2012. The person who signed the terminal disclaimer is not an attorney or agent of record, is not recognized as an officer of the assignee, and has not been established as being authorized to act on behalf of the assignee. See **MPEP § 324**.

Examiner Note:

1. This form paragraph is to be used ONLY in applications filed before September 16, 2012 when the person signing the terminal disclaimer is not an authorized officer as defined in **MPEP § 324** or is an attorney or agent not of record (e.g., acting in a representative capacity under **37 CFR 1.34**).

2. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 and followed by form paragraph 14.29.02.fti when appropriate. An attorney or agent of record is always authorized to sign the terminal disclaimer, even though there is no indication that he or she is an officer of the assignee.

3. Use form paragraph 14.29.02.fti to explain how an official, other than a recognized officer, may properly sign a terminal disclaimer.

¶ *14.29.01 Attorney/Agent Not of Record*

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by **37 CFR 1.34(a)**. See **37 CFR 1.321(b)** and/or (c).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.29.

2. An attorney or agent, however, may sign a terminal disclaimer provided he/she is an attorney or agent of record or is established as an appropriate official of the assignee. To suggest to the attorney or agent, not of record, how he/she may establish status as an appropriate official of the assignee to sign a terminal disclaimer, use form paragraph 14.29.02.

¶ *14.29.02.fti Criteria To Accept Terminal Disclaimer When Signed by a Non-Recognized Officer – Application Filed Before September 16, 2012*

This application was filed before September 16, 2012. It would be acceptable for a person, other than a recognized officer, to sign a terminal disclaimer, provided the record for the application includes a statement

that the person is empowered to sign terminal disclaimers and/or act on behalf of the assignee.

Accordingly, a new terminal disclaimer which includes the above empowerment statement will be considered to be signed by an appropriate official of the assignee. A separately filed paper referencing the previously filed terminal disclaimer and containing a proper empowerment statement would also be acceptable.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND form paragraph 14.29.fti.

2. When form paragraph 14.29.fti is used to indicate that a terminal disclaimer is denied because it was not signed by a recognized officer nor by an attorney or agent of record, this form paragraph should be used to point out one way to correct the problem.

3. While an indication of the person's title is desirable, its inclusion is not mandatory when this option is employed.

4. A sample terminal disclaimer should be sent with the Office action.

¶ *14.30.fti No Evidence of Chain of Title to Assignee - Application Filed Before Sept. 16, 2012*

This application was filed before September 16, 2012. The assignee has not established its ownership interest in the application, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee and a statement affirming that the documentary evidence of the chain of title form the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to **37 CFR 3.11**, or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office (**37 CFR 3.73**).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25.

2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide a statement under **37 CFR 3.73**. Thus, this form paragraph should not be used.

3. It should be noted that the documentary evidence or the specifying of reel and frame number may be found in the terminal disclaimer itself or in a separate paper.

¶ *14.30.01 No Evidence of Chain of Title to Assignee (Reexamination Situations)*

The assignee has not established its ownership interest in the patent, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either: (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to **37 CFR 3.11**; or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office (**37 CFR 3.73**).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph or 14.25.

2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide a statement under **37 CFR 3.73**. Thus, this form paragraph should not be used.

3. It should be noted that the documentary evidence or the specifying of reel and frame number may be found in the terminal disclaimer itself or in a separate paper in the application.

¶ *14.30.02.fti Evidence of Chain of Title to Assignee - Submission Not Signed by Appropriate Party – Application Filed Before Sept. 16, 2012, Terminal Disclaimer Is Thus Not Entered*

This application was filed before September 16, 2012. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission establishing the ownership interest is authorized to sign the submission (**37 CFR 3.73**).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25.

2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide any statement under **37 CFR 3.73**. Thus, this form paragraph should not be used.

3. This form paragraph should be followed by one of form paragraphs 14.16.02 or 14.16.03. In rare situations where BOTH form paragraphs 14.16.02 and 14.16.03 do not apply and thus cannot be used, the examiner should instead follow this form paragraph with a detailed statement of why there is no authorization to sign.

4. Use form paragraph 14.16.06 to point out one way to correct the problem.

5. Do not use this form paragraph in an application filed on or after September 16, 2012.

¶ *14.32 Application/Patent Which Forms Basis for Rejection Not Identified*

The application/patent which forms the basis for the double patenting rejection is not identified in the terminal disclaimer.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25.

2. Use this form paragraph when no information is presented. If incorrect information is contained in the terminal disclaimer, use form paragraphs 14.26 and 14.26.05.

¶ *14.33 37 CFR 3.73 - Establishing Right of Assignee To Take Action*

The following is a statement of **37 CFR 3.73** as applicable to applications filed on or after September 16, 2012:

37 CFR 3.73 Establishing right of assignee to take action.

(a) The original applicant is presumed to be the owner of an application for an original patent, and any patent that may issue therefrom, unless there is an assignment. The original applicant

is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b) In order to request or take action in a trademark matter, the assignee must establish its ownership of the trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(1) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(2) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(c)(1) In order to request or take action in a patent matter, an assignee who is not the original applicant must establish its ownership of the patent property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established bu submitting a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) If the submission is by an assignee of less than the entire right, title and interest (e.g., more than one assignee exists) the Office may refuse to accept the submission as an establishment of ownership unless:

(i) Each assignee establishes the extent (by percentage) of its ownership interest, so as to account for the entire right, title and interest in the application or patent by all parties including inventors; or

(ii) Each assignee submits a statement identifying the parties including inventors who together own the entire right, title and interest and stating that all the identified parties owns the entire right, title and interest.

(3) If two or more purported assignees file conflicting statements under paragraph (c)(1) of this section, the Director will determine while, if any, purported assignees will be permitted to control prosecution of the application.

(d) The submission establishing ownership under paragraph (b) or (c) of this section must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(1) Including a statement that the person is authorized to act on behalf of the assignee;

(2) Being signed by a person having apparent authority to sign on behalf of the assignee; or

(3) For patent matters only, being signed by a practitioner of record.

The following is a statement of **pre-AIA 37 CFR 3.73** as applicable to applications filed before September 16, 2012:

Pre-AIA 37 CFR 3.73 Establishing right of assignee to take action.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.* , copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § **3.11** in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to § **3.11**; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

¶ *14.34 Requirement for Statement To Record Assignment Submitted With Terminal Disclaimer*

The assignment document filed on **[1]** is **not** acceptable as the documentary evidence required by **37 CFR 3.73**. The submission of the documentary evidence was not accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to **37 CFR 3.11**. See **37 CFR 3.11** and **MPEP § 302**.

Examiner Note:

1. In bracket 1, insert the date the assignment document was filed.

2. This form paragraph should be used when an assignment document (an original, facsimile, or copy) is submitted to satisfy **37 CFR 3.73** was not accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation, and the documentary evidence has not been recorded among the assignment records of the Office.

¶ *14.35 Disclaimer Fee Not Required Twice - Applicant*

It should be noted that applicant is not required to pay another disclaimer fee as set forth in **37 CFR 1.20(d)** when submitting a replacement or supplemental terminal disclaimer.

Examiner Note:

1. This form paragraph can be used to notify an applicant that another disclaimer fee will not be required when a replacement or supplemental terminal disclaimer is submitted.

2. Use form paragraph 14.35.01 for providing notification to patent owner, rather than an applicant.

¶ *14.35.01 Disclaimer Fee Not Required Twice - Patent Owner*

It should be noted that patent owner is not required to pay another disclaimer fee as set forth in **37 CFR 1.20(d)** when submitting a replacement or supplemental terminal disclaimer.

Examiner Note:

This form paragraph can be used to notify a patent owner that another disclaimer fee will not be required when a replacement or supplemental terminal disclaimer is submitted.

¶ *14.36 Suggestion That "Applicant" Request a Refund*

Since the required fee for the terminal disclaimer was previously paid, applicant's payment of an additional terminal disclaimer fee is not required. Applicant may request a refund of this additional terminal disclaimer fee by submitting a written request for a refund and a copy of this Office action to: Mail Stop 16, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. This form paragraph should be used to notify applicant that a refund can be obtained if another terminal disclaimer fee was paid when a replacement or supplemental terminal disclaimer was submitted.

2. Note - If applicant has authorized or requested a fee refund to be credited to a specific Deposit Account or credit card, then an appropriate credit should be made to that Deposit Account or credit card and this paragraph should NOT be used.

3. Use form paragraph 14.36.01 for providing notification to patent owner, rather than an applicant.

¶ *14.36.01 Suggestion That "Patent Owner" Request a Refund*

Since the required fee for the terminal disclaimer was previously paid, patent owner's payment of an additional terminal disclaimer fee is not required. Patent owner may request a refund of this additional terminal disclaimer fee by submitting a written request for a refund and a copy of this Office action to: Mail Stop 16, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. This form paragraph should be used to notify patent owner that a refund can be obtained if another terminal disclaimer fee was paid when a replacement or supplemental terminal disclaimer was submitted.

2. Note - If patent owner has authorized or requested a fee refund to be credited to a specific Deposit Account or credit card, then an appropriate credit should be made to that Deposit Account or credit card and this form paragraph should NOT be used.

¶ *14.37 Information about a Terminal Disclaimer Over a Pending Application*

A terminal disclaimer may be effective to overcome a provisional obviousness-type double patenting rejection over a pending application (**37 CFR 1.321(b)** and **(c)**).

The USPTO internet Web site contains terminal disclaimer forms which may be used. Please visit http://www.uspto.gov/forms/. The filing date of the application will determine what form should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is

auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to http://www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

Examiner Note:

1. This form paragraph can be used to provide applicant information regarding the terminal disclaimer forms available on the USPTO web site that may be used to overcome a provisional obviousness-type double patenting rejection over a pending application.

¶ *14.38 Information about a Terminal Disclaimer Over a Prior Patent*

A terminal disclaimer may be effective to overcome an obviousness-type double patenting rejection over a prior patent (**37 CFR 1.321(b)** and **(c)**).

The USPTO internet Web site contains terminal disclaimer forms which may be used. Please visit http://www.uspto.gov/forms/. The filing date of the application will determine what form should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to http://www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

Examiner Note:

1. This form paragraph can be used to provide applicant information regarding the terminal disclaimer forms available on the USPTO web site that may be used to overcome an obviousness-type double patenting rejection over a prior patent.

VIII. WITHDRAWING A RECORDED TERMINAL DISCLAIMER

If timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent, or in a reexamination proceeding, before the reexamination certificate issues. After a patent or reexamination certificate issues, it is unlikely that a recorded terminal disclaimer will be nullified.

A. Before Issuance Of Patent

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Because the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).

Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under **37 CFR 1.182** requesting withdrawal of the recorded terminal disclaimer. Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered. The filing of a continuing application other than a CPA, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer. The filing of a Request for Continued Examination (RCE) of an application under **37 CFR 1.114** will not nullify the effect of a terminal disclaimer, because a new application has not been filed, but rather prosecution has been continued in the existing application.

B. After Issuance Of Patent

The mechanisms to correct a patent — Certificate of Correction (**35 U.S.C. 255**), reissue (**35 U.S.C. 251**), reexamination (**35 U.S.C. 305** and pre-AIA 35 U.S.C. 314), inter partes review (35 U.S.C. 316), post grant review (35 U.S.C. 326), and covered business method review — are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent. See, e.g., *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477, 24 USPQ 308 (1935).

Certificates of Correction (**35 U.S.C. 255**) are available for the correction of an applicant's mistake. The scope of this remedial provision is limited in two ways — by the nature of the mistake for which correction is sought and the nature of the proposed correction. *In re Arnott*, 19 USPQ2d 1049 (Comm'r Pat. 1991). The nature of the mistake for which correction is sought is limited to those mistakes that are:

(A) of a clerical nature;
(B) of a typographical nature; or
(C) of a minor character.

The nature of the proposed correction is limited to those situations where the correction does not involve changes which would:

(A) constitute new matter, or (B) require reexamination.

A mistake in filing a terminal disclaimer does not fall within any of the categories of mistake for which a certificate of correction of applicant's mistake is permissible, and any attempt to remove or nullify the effect of the terminal disclaimer would typically require reconsideration of the circumstances under which it was filed.

Although the remedial nature of reissue (**35 U.S.C. 251**) is well recognized, reissue is not available to correct all errors.Reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. First, the reissue statute only authorizes the Director of the USPTO to reissue a patent "for the unexpired part of the term of the original patent." Because the granting of a reissue patent without the effect of a recorded terminal disclaimer would result in extending the term of the original patent, reissue under these circumstances would be contrary to the statute. In *In re Yamazaki*, 702 F.3d 1327, 1332, 104 USPQ2d 2024, 2028 (Fed. Cir, 2012), the Federal Circuit stated, as to a terminal disclaimer submitted for a patent, that the statutory patent term calculation begins but does not end with 35 U.S.C. 154(a). When a patent issues subject to a terminal disclaimer, the patentee has reduced the patent's statutory term by effectively eliminating the disclaimed portion from the original patent, by operation of 35 U.S.C. 253 (which indicates that a disclaimer of patent claims "shall thereafter be considered as part of the original patent" and such applies to disclaimers of patent term). *Id.*

Second, the principle against recapturing previously patented subject matter that has been intentionally dedicated to the public dates back to *Leggett v. Avery*, 101 U.S. 256 (1879). The attempt to restore that portion of the patent term that was dedicated to the public to secure the grant of the original patent would be contrary to this recapture principle. Finally, applicants have the opportunity to challenge the need for a terminal disclaimer during the prosecution of the application that issues as a patent. "Reissue is not a substitute for Patent Office appeal procedures." *Ball Corp. v. United States*, 729 F.2d 1429, 1435, 221 USPQ 289, 293 (Fed. Cir. 1984). Where applicants did not challenge the propriety of the examiner's nonstatutory double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of **35 U.S.C. 251**. *Ex parte Anthony*, 230 USPQ 467 (Bd. App. 1982), *aff'd*, No. 84-1357 (Fed. Cir. June 14, 1985).

Finally, the nullification of a recorded terminal disclaimer would not be appropriate in reexamination *inter partes* review, post grant review, and covered business method review proceedings. There are statutory prohibitions in **35 U.S.C. 305** and pre-AIA 35 U.S.C. 314, 35 U.S.C. 316, and 35 U.S.C. 326 against enlarging the scope of a claim during reexamination *inter partes* review, post grant review, and covered business method review proceedings. As noted by the Board in *Anthony, supra*, if a terminal disclaimer was nullified, "claims would be able to be sued upon for a longer period than would the claims of the original patent. Therefore, the vertical scope, as opposed to the horizontal scope (where the subject matter is enlarged), would be enlarged." *Id.* at 470.

Where a terminal disclaimer was submitted to overcome a nonstatutory double patenting rejection (made during prosecution of an application which has now issued as a patent), and the numbers for the patent being disclaimed in the terminal disclaimer were inadvertently transposed (e.g., 6,444,316 written as 6,444,136), a petition under **37 CFR 1.182** may be filed to withdraw the terminal disclaimer with the incorrect (transposed) patent number (recorded in the issued patent), and replace it with a corrected terminal disclaimer having the correct patent number. In this instance, the inadvertency is clear from the record. If the transposing error resulted in an earlier patent term expiration date than provided by the corrected terminal disclaimer, a statement must be included in the corrected terminal disclaimer that the term is limited to the shorter

expiration date of the orginal terminal disclaimer or the corrected terminal disclaimer. The absence of such a statement will result in the Office entering the second disclaimer and not withdrawing the original disclaimer.

IX. TERMINAL DISCLAIMER FORMS

The following are forms which may be used when filing a terminal disclaimer.

Forms PTO/AIA/25 and PTO/AIA/26 may be used when filing a terminal disclaimer in an application where the application in which the terminal disclaimer is submitted was filed on or after September 16, 2012. Forms PTO/SB/25 and PTO/SB/26 may be used when filing a terminal disclaimer in an application where the application in which the terminal disclaimer is submitted was filed before September 16, 2012.

Forms PTO/SB/25a and PTO/SB/26a may be used when filing a terminal disclaimer in a patent.

PTO/AIA/25 (04-13)
Approved for use through 04/30/2013. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING "REFERENCE" APPLICATION	Docket Number (Optional)

In re Application of:

Application No.:

Filed:

For:

The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number_____, filed, _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The applicant hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the applicant does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term of any patent granted on said **reference** application, "as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application," in the event that: any such patent granted on the pending **reference** application expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ The undersigned is the applicant. If the applicant is an assignee, the undersigned is authorized to act on behalf of the assignee.

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. _____

_____ _____
Signature Date

_____
Typed or printed name

_____ _____
Title Telephone Number

☐ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

PTO/AIA/26 (04-13)
Approved for use through 04/30/2013. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT	Docket Number (Optional)

In re Application of:

Application No.:

Filed:

For:

The applicant, _____, owner of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____ as the term of said **prior patent** is presently shortened by any terminal disclaimer. The applicant hereby agrees that any patent so granted on the instant application shall be enforceable only for any during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the applicant does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

expires for failure to pay a maintenance fee;
is held unenforceable;
is found invalid by a court of competent jurisdiction;
is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
has all claims canceled by a reexamination certificate;
is reissued; or
is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ The undersigned is the applicant. If the applicant is an assignee, the undersigned is authorized to act on behalf of the assignee.

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

2. ☐ The undersigned is an attorney or agent of record. Reg. No._____

_____ _____
Signature Date

_____
Typed or printed name

_____ _____
Title Telephone Number

☐ Terminal disclaimer fee under 37 CFR 1.20(d) included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

PTO/SB/25 (08-11)
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TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING "REFERENCE" APPLICATION	Docket Number (Optional)

In re Application of:

Application No.:

Filed:

For:

The owner*, _____, of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number _____, filed _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term of any patent granted on said **reference** application, "as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application," in the event that: any such patent: granted on the pending **reference** application: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. _____

_____ _____
Signature Date

_____
Typed or printed name

_____
Telephone Number

☐ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this statement. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT	Docket Number (Optional)

In re Application of:

Application No.:

Filed:

For:

The owner*, _____, of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____ as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

expires for failure to pay a maintenance fee;
is held unenforceable;
is found invalid by a court of competent jurisdiction;
is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
has all claims canceled by a reexamination certificate;
is reissued; or
is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney or agent of record. Reg. No._____

_____ _____
Signature Date

_____
Typed or printed name

_____
Telephone Number

☐ Terminal disclaimer fee under 37 CFR 1.20(d) included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

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TERMINAL DISCLAIMER IN A PATENT OR PROCEEDING IN VIEW OF AN APPLICATION	Docket Number (Optional)

Application/Control Number:
Filing Date:
First Named Inventor:
Title:
Patent No.:

The patentee, _____, owner of _____ percent interest in the instant patent hereby disclaims, except as provided below, the terminal part of the statutory term of the instant patent which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** application No. _____, filed _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The patentee hereby agrees that the instant patent shall be enforceable only for and during such period that the instant patent and any patent granted on the **reference** application are commonly owned. This agreement runs with the instant patent and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the patentee does not disclaim the terminal part of the instant patent that would extend to the expiration date of the full statutory term of any patent granted on said **reference** application, "as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application," in the event that any such patent granted on the pending **reference** application: expires for failure to pay a maintenance fee; is held unenforceable; is found invalid by a court of competent jurisdiction; is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321; has all claims canceled by a reexamination certificate; is reissued; or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

I. Check either box 1, 2, or 3 below, as appropriate, if there is an assignment:

1. ☐ The current ownership was established by the filing of a statement under 37 CFR 3.73 during prosecution of the application that issued as the instant patent.

2. ☐ The instant patent was issued from an application filed on or after September 16, 2012, and the current patent owner was the applicant under 37 CFR 1.46.

3. ☐ A statement under 37 CFR 3.73 is attached herewith. Form PTO/SB/96 or PTO/AIA/96, as appropriate, may be used.

II. Authorization for Terminal Disclaimer - Check either box 1 or 2 below, if appropriate:

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. _____

_____ _____
Signature Date

_____ _____
Typed or printed name Telephone number

☐ The terminal disclaimer fee under 37 CFR 1.20(d) is included.

NOTE: Submit multiple forms if more than one signature is required, see below.*

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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PTO/SB/26a (02-14)
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TERMINAL DISCLAIMER IN A PATENT OR PROCEEDING IN VIEW OF ANOTHER PATENT	Docket Number (Optional)

Application/Control Number:
Filing Date:
First Named Inventor:
Title:
Patent No.:

The patentee, _____, owner of _____ percent interest in the instant patent hereby disclaims, except as provided below, the terminal part of the statutory term of the instant patent which would extend beyond the expiration date of the full statutory term of patent No. _____ (the "**reference** patent"), as the term of said **reference** patent is presently shortened by any terminal disclaimer. The patentee hereby agrees that the instant patent shall be enforceable only for and during such period that the instant patent and the **reference** patent are commonly owned. This agreement runs with the instant patent and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the patentee does not disclaim the terminal part of the instant patent that would extend to the expiration date of the full statutory term of the **reference** patent, "as the term of said **reference patent** is presently shortened by any terminal disclaimer," in the event that said **reference** patent later: expires for failure to pay a maintenance fee; is held unenforceable; is found invalid by a court of competent jurisdiction; is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321; has all claims canceled by a reexamination certificate; is reissued; or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

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3. ☐ A statement under 37 CFR 3.73 is attached herewith. Form PTO/SB/96 or PTO/AIA/96, as appropriate, may be used.

II. Authorization for Terminal Disclaimer - Check either box 1 or 2 below, if appropriate:

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. _____

_____ _____
Signature Date

_____ _____
Typed or printed name Telephone number

☐ The terminal disclaimer fee under 37 CFR 1.20(d) is included.

NOTE: Submit multiple forms if more than one signature is required, see below.*

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.