



# UNITED STATES PATENT AND TRADEMARK OFFICE

## **BEST PRACTICES IN REISSUE**

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- 1. AMENDMENTS**
- 2. CERTIFICATE OF CORRECTION**
- 3. OATHS**
- 4. CONSENT**
- 5. OWNERSHIP**
- 6. SEQ ID COMPLIANCE**
- 7. BROADENING**



# 35 U.S.C. 251 Governs Reissue

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

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

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

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

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

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



# AMENDMENTS TO CLAIMS

**The amendment must be made in accordance with 37 CFR 1.173.**

**When amending reissue claims one uses markings in comparison with the existing patent claims each time there is an amendment.**

**One does not use the markings from the previous amendment.**

(b)(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.



# AMENDMENTS 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.



# UNDERSTANDING CLAIM AMENDMENTS

A copy of a claim set from a reissued patent:

1. A [pharmaceutical] composition comprising [an active ingredient which is] *an analogue of* sulforaphane ((-)-1-isothiocyanato-(4R)-(methylsulfinyl)butane) [(CAS 4478-93-7) or an analogue thereof], said analogue being selected from the group consisting of: 6-isothiocyanato-2-hexanone [(GHP 1105)]; *exo*-2-acetyl-6-isothiocyanatonorbornane [(GHP 1066)]; *exo*-2-isothiocyanato-6-methylsulfonylnorbornane [(GHP 1068)]; 6-isothiocyanato-2-hexanol [(GHP 1106)]; 1-isothiocyanato-4-dimethylphosphonylbutane [(GHP 1078)]; *exo*-2-(1'-hydroxyethyl)-5-isothiocyanatonorbornane [(GHP 1075)]; *exo*-2-acetyl-5-isothiocyanatonorbornane [(GHP 1067)]; 1-isothiocyanato-5-methylsulfonylpentane [(GHP 1003)]; and *cis*- or *trans*-3-(methylsulfonyl)cyclohexylmethylisothiocyanate [(GHP 1079 or 1080)].

[2. The pharmaceutical composition of claim 1 wherein said active ingredient is sulforaphane.]

15. *A composition comprising an active ingredient which is sulforaphane ((-)-1-isothiocyanato-(4R)-(methylsulfinyl)butane) or an analogue thereof, said analogue being selected from the group consisting of: 6-isothiocyanato-2-hexanone; exo-2-acetyl-6-isothiocyanatonorbornane; exo-2-isothiocyanato-6-methylsulfonylnorbornane; 6-isothiocyanato-2-hexanol; 1-isothiocyanato-4-dimethylphosphonylbutane; exo-2-(1'-hydroxyethyl)-5-isothiocyanatonorbornane; exo-2-acetyl-5-isothiocyanatonorbornane; 1-isothiocyanato-5-methylsulfonylpentane; and cis- or trans-3-(methylsulfonyl)cyclohexylmethylisothiocyanate, and a suitable excipient.*



# AMENDMENT TO THE CLAIMS

## Examples

Amendment to original issued claim:

1. (Original) A composition comprising acetylsalicylic acid, 95% ethanol and distilled water.
1. (Amended) A composition [comprising] consisting essentially of acetylsalicylic acid, 95% ethanol and distilled water.

**Amendment to an amended claim.**

1. (Twice Amended) A composition [comprising] consisting essentially of acetylsalicylic acid, 95% ethanol and [distilled] water.



# AMENDMENTS TO THE CLAIMS

Examples (cont.)

5. (New) A composition of claim 1 which also includes a pharmaceutical carrier .

5. (New-amended) A composition of claim 1 which, besides including a pharmaceutical carrier, also includes an additional headache medicament besides acetylsalicylic acid.



## AMENDMENT TO THE CLAIMS

15.(amended) A method for preparing products selected from cosmetics and toiletries [compositions] which provide antimicrobial or fluorescent whitening properties comprising the step of: incorporating into said products [one of these compositions] a compound of Formula I: ABCR1 wherein R1 is selected from: a C10-C30 hydrocarbon which may be saturated, unsaturated, straight, branched, alicyclic or [an] aromatic [C10 -C30 hydrocarbon residue] , [;] [or] nonyl, 3,5,5-trimethyl-hexanyl, cis-6-nonenyl, 2-nonenyl,2-ethoxy-4-formylphenyl,and 2-phenyl- propyl, ...

The text in RED represents the issued claim.



## AMENDMENT TO THE CLAIMS

15.(amended) A method for preparing products selected from cosmetics and toiletries [compositions] which provide antimicrobial or fluorescent whitening properties **comprising** the step of: incorporating into said products [one of these compositions] a compound of Formula I: ABCR1 wherein R1 is **selected from:** a C10-C30 hydrocarbon which may be saturated, unsaturated, straight, branched, alicyclic or [an] aromatic [C10 -C30 hydrocarbon residue] , [;] [or] nonyl, 3,5,5-trimethyl-hexanyl, cis-6-nonenyl, 2-nonenyl,2-ethoxy-4-formylphenyl,and 2-phenyl- propyl, ...

- 1) The “comprising” was in the issued claim - Why is it underlined?
- 2) The “selected from:” was not in the issued claim - Why isn't it underlined?
- 3) The “comma” was in the issued claim - Why is it underlined?
- 4) The “;” and the “or” was not in the issued claim but in a previous amendment to the issued claim - Why are they bracketed?
- 5) If there was a previous amendment, why does the status identifier say amended and not (twice amended) or (four times amended)?



## AMENDMENT TO SPECIFICATION

(b)(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 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)).



# AMENDMENT TO SPECIFICATION

## EXAMPLE: IMPROPER FORMAT

**Add the following paragraph in column 1, line 32.**

- The present invention is directed to a method of regulating type II collagen gene expression in cartilage cells via the application of specific and selective fields generated by--: specific and selective electric and electromagnetic signals for the treatment of injured or diseased articular cartilage, as well as a device for generating signals. --

37 CFR 1.73 (d) (1), (2) The matter to be omitted by reissue must be enclosed in brackets; and the matter to be added by reissue must be underlined.

The markings "--" are not used in reissue, and the added matter should be underlined.



# AMENDMENT TO SPECIFICATION

## EXAMPLE: IMPROPER FORMAT

**Delete line 22 in column 2 and replace with:**

Osteoarthritis is the most common form of arthritis.

37 CFR 1.173(b)(1) - Changes to the specification must be made by submission of the entire text of an added or rewritten paragraph.

37 CFR 1.173(d)(1)(2) - The matter to be omitted by reissue must be enclosed in brackets; and the matter to be added by reissue must be underlined.

**Amend the paragraph in column 2 line 22-24 with:**

Osteoarthritis is [a] the most common form of arthritis. It is wide spread among all age groups and has been viewed as on of the fastest growing arthritis forms in the country.



# AMENDMENT TO THE SPECIFICATION

## EXAMPLE: PROPER FORMAT

**Amend the paragraph at column 3, line 5 to line 11 as follows:**

The present invention is directed to a method of [regulation] regulating [tybe] type II collagen gene expression in cartilage cells via the application of specific and selective [fileds] fields generated by specific and selective electric and electromagnetic signals for the treatment of injured or diseased articular cartilage.

**Insert new paragraph in column 3, line 5 :**

The present invention is directed to a method of regulating type II collagen gene expression in cartilage cells via the application of specific and selective fields generated by specific and selective electric and electromagnetic signals for the treatment of injured or diseased articular cartilage.



## AMENDMENT TO THE DRAWINGS

- (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.
- (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.



# AMENDMENT TO THE DRAWING IMPROPER NOT LABELED "AMENDED" NOT A REPLACEMENT SHEET

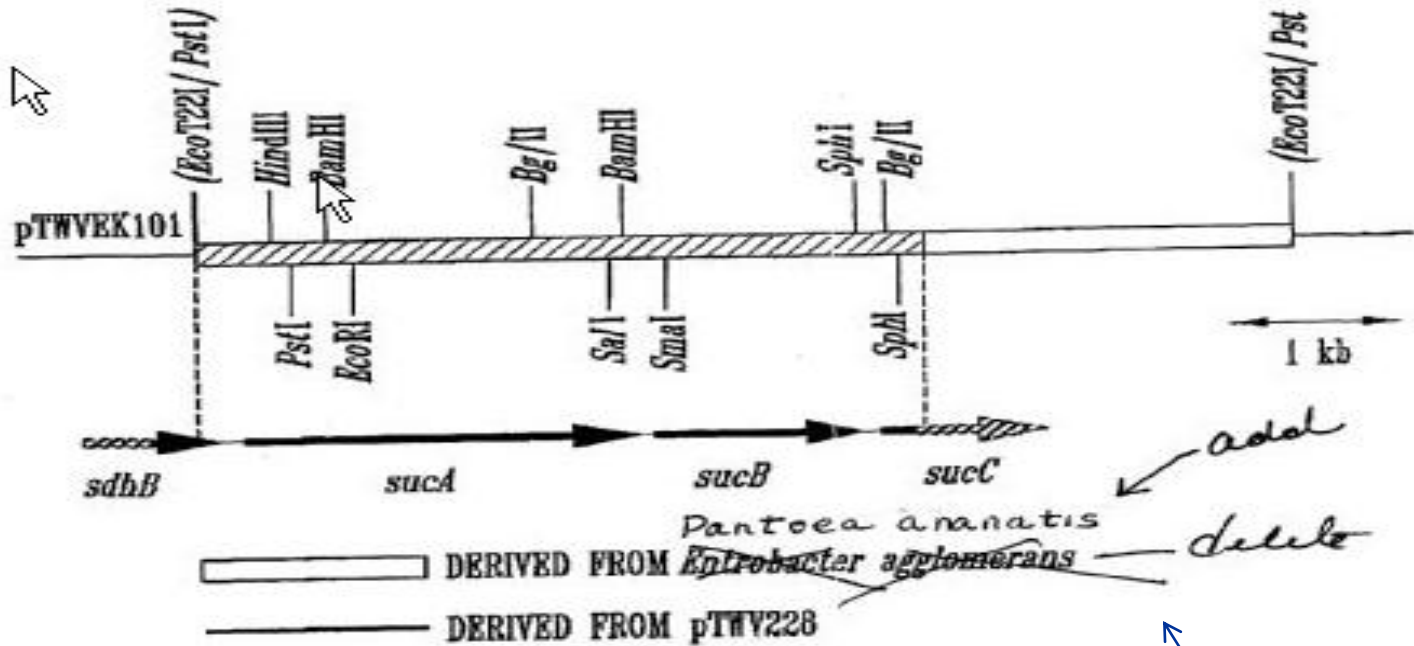


FIG. 1



# PROPER AMENDMENT TO DRAWING

REPLACEMENT SHEET  
1/4

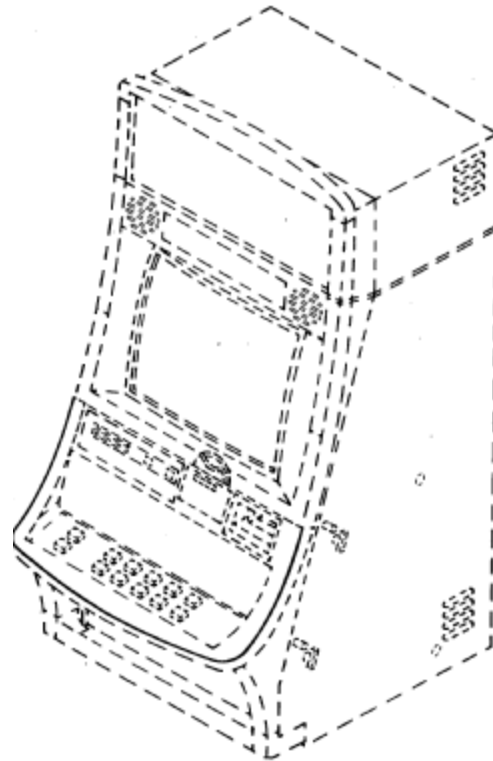
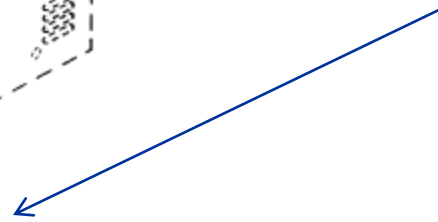


Fig. 1  
(Amended)





# PROPER AMENDMENT TO DRAWING

REPLACEMENT SHEET  
2/4

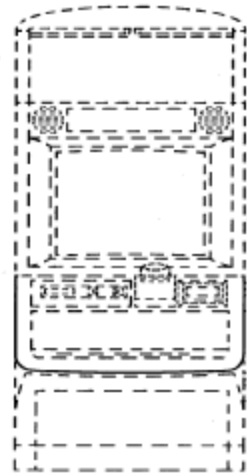


Fig. 2  
(Amended)



Fig. 3  
(Cancelled)





## CERTIFICATE OF CORRECTION

If a certificate of correction has been granted in the original patent then the certificate changes are considered part of the patent as issued.

As such the certificate changes must be made to the patent in the specification, abstract, or claims without underlining or bracketing ( See section of MPEP 1411.01 )

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

For a certificate of correction dated during the pendency of the reissue application:

As to the certificate either before or during the pendency, its changes are retroactively a part of the original patent and are thus part of the original patent; accordingly 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.



## CERTIFICATE OF CORRECTION

If the changes are extensive, a clean copy of the specification with the Certificate of Correction change maybe required by the examiner. For the clean copy of the specification to be entered, a petition must be filed 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.

Note: Applicant is required to include a copy of any certificate of correction (37 CFR 1.322 – 1.324) issued in the patent for which the reissue is requested. (MPEP 1410 - Content of Reissue)



# CERTIFICATE OF CORRECTION

## Incorrect Submission

Example

UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE OF CORRECTION

PATENT NO. : 6,683,156 B1 Page 3 of 3  
DATED : January 27, 2004  
INVENTOR(S) : Siamak Tabibzadeh

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Column 13, SEQ ID NO: 1, Column 6 of Sequence Listing.  
Line 19, "TTTAGCTA 1920" should read -- TTTAGCTAAA 1920 --

CTGGGCTTCA GCTCTAAGAA CTCATTGCC CTGGGGATCA GACAGCCCCT ACCTACCC 1800  
GCCACTCCT CTGGAGACTG AGCCTTGCCC GTGCATATTT AGGCATTTC CCACACTG 1860  
TTAGAGAACT TGCACCAGA AACCACATGT ATTTGCATGT TTTTGTAA **TTTAGCTA** 1920  
GCAATTGAAT GTAGATACTC AGAAGAAATA AAAAATGATG TT 1962

In the specification submitted in the reissue application, column 13, indicated above, has not been changed per Certificate of Correction.



# CERTIFICATE OF CORRECTION

## Correct Submission

UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE OF CORRECTION

PATENT NO. : 6,683,156 B1 Page 3 of 3  
DATED : January 27, 2004  
INVENTOR(S) : Siamak Tabibzadeh

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Column 13, SEQ ID NO: 1, Column 6 of Sequence Listing.  
Line 19, "TTAGCTA 1920" should read -- TTAGCTAAA 1920 --

CTGGGCTTCA GCTCTAAGAA CTCATTGCC CTGGGGATCA GACAGCCCCT ACCTACCC 1800  
GCCCACTCCT CTGGAGACTG AGCCTTGCCC GTGCATATT AGGTCATTTC CCACACTG 1860  
TTAGAGAACT TGTACCAGA AACCATGT ATTTGCATGT TTTTGTAA **TTAGCTAAA** 1920  
GCAATTGAAT GTAGATACTC AGAAGAAATA AAAAATGATG TT 1962



## OATH/DECLARATION

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.

37 CFR 1.63 requires the same information as a non reissue oath except that if it is an assignee oath, the inventors signatures are not required. (i.e. original and first inventor or inventors...)

37 CFR 1.175 has additional requirements for a reissue oath. Oaths filed under this rule must state that all errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without deceptive intent on the part of the applicant.



# INVENTOR OATH/DECLARATION

## 37 CFR 1.63 YELLOW, 37 CFR 1.175 RED

PTO/SB/51 (05-08)

Approved for use through 08/31/2010. 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.

<b>REISSUE APPLICATION DECLARATION BY THE INVENTOR</b>	Docket Number (Optional)
<p>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</p> <p><input type="checkbox"/> is attached hereto.</p> <p><input type="checkbox"/> was filed on _____ as reissue application number _____ and was amended on _____ (If applicable)</p> <p>I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.</p> <p><input type="checkbox"/> 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.</p>	



# INVENTOR OATH/DECLARATION

## 37CFR 1.63 YELLOW, 37 CFR 1.175 RED

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:



# INVENTOR OATH/DECLARATION 37CFR 1.63 YELLOW, 37CFR 1.175 RED

PTO/SB/51 (05-08)

Approved for use through 08/31/2010. 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 APPLICATION DECLARATION BY THE INVENTOR, page 2)		Docket Number (Optional)	
<div style="border: 1px solid red; padding: 5px;"> <p>All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.</p> </div> <p>Note: To appoint a power of attorney, use form PTO/SB/81.</p> <p>Correspondence Address: Direct all communications about the application to:</p> <p><input type="checkbox"/> The address associated with Customer Number: <input style="width: 200px;" type="text"/></p> <p><b>OR</b></p>			
<input type="checkbox"/> Firm or Individual Name			
Address			
City	State	Zip	
Country			
Telephone		Email	



# INVENTOR OATH/DECLARATION 37CFR 1.63 YELLOW, 37CFR 1.175 RED

false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

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



# OATH/DECLARATION

Two type of first or full oath in reissue:

INVENTOR OATH - PTO/SB/51 (05-08)

ASSIGNEE OATH - PTO/SB/52 (05-08)

Inventor oath must be used for broadening reissue

Assignee oath can be used for narrowing reissue or reissue not broadening the claims (e.g. inventorship change)



# ACCESSING THE PTO FORMS

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## OATH/DECLARATION

Applicant is not required to use the PTO forms but should review the language in the forms to avoid a defective oath due to improper language in a modified form.

**Example:** Forms state: “duty to disclose information which is material to **patentability**... in **37CFR 1.56.**”

Submitted non-form oath stated “duty to disclose information which is material to **examination** ... in **37CFR 1.56(a)**”

**Note:** MPEP 0200 - The term “information” as used in 37 CFR 1.56 means all of the kinds of information required to be disclosed and includes any information which is “material to patentability.”



# OATH/DECLARATION

Reissue oath must contain a SPECIFIC error and an error upon which the reissue can be based.

Not all errors can be corrected under reissue practice. See MPEP 1402 for what may constitute the “error” required by 35 USC 251.

Specificity - 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.



## OATH/DECLARATION

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 of "... failure to include a claim directed to ..." and then presenting 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. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987).



## OATH/DECLARATION

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."



## OATH/DECLARATION

**EXAMPLE OF NON SPECIFIC ERROR-** The patent claims more than applicant had a right to claim in view of U.S. Patent No. 2,222,222.

**EXAMPLE OF SPECIFIC ERROR-** in second oath submission - The patent claims more than applicant had a right to claim in view of U.S. Patent No. 2,222,222 which describes a plant having integrated into its genome a DNA construct containing a delta-five desaturase, wherein the plant reportedly produces dodecaenoic acid See, U.S. Patent 2,222,222, Example 12. Claim 1 of the patent is amended in this reissue application to exclude that subject matter of the 222' patent.



## OATH/DECLARATION

Other errors that can be grounds for a reissue include, change of inventorship, failure to file a certified copy of the original foreign application to obtain the right of foreign priority, a substantive drawing error, a substantive specification error, failure to adequately claim benefit under 35 USC 120 in earlier filed copending US patent application, and correction of problem with patent oath.

**Example non specific error** – The inventorship is being changed

**Example of specific error-** The inventorship is being change to include two additional inventors, John Smith and Jane Doe.



# OATH/DECLARATION ERROR EXAMPLES

**Example nonspecific error** - The inventorship is being changed

**Example of specific error** - The inventorship is being changed to include two additional inventors, John Smith and Jane Doe

(HINT: If the inventorship is the only thing you want to correct, then you can also file a petition under 1.324 for correction of inventorship in an issued patent)



## OATH/DECLARATION REISSUE ERROR

Other errors that can be grounds for a reissue include:

- 1) change of inventorship,
- 2) failure to file a certified copy of the original foreign application to obtain the right of foreign priority,
- 3) a substantive drawing error,
- 4) a substantive specification error,
- 5) failure to adequately claim benefit under 35 USC 120 in earlier-filed copending US patent application,
- 6) claimed less than they had a right to claim (2 year limitation), and
- 7) correction of problem with patent oath



## OATH/DECLARATION REISSUE ERROR

Please note that the filing of additional claims narrower than the broadest claim(s) of a patent, even without cancellation of such broader patent claim(s), will support reissue.

See *In re Tanaka*, 640 F.3d 1246, 98 USPQ2d 1331 (Fed. Cir. 2011).



## OATH/DECLARATION REISSUE ERROR

- Not all errors can be used as the basis of a reissue. One cannot recapture claims or limitations in claims that one gave up in the patent application. Nor can one obtain a restricted group that was non-elected in the patent application and not pursued before patent issued.
- Other errors that cannot be corrected by a reissue include
  - 1) Reissue filed to add citations
  - 2) Errors in spelling, punctuation, etc. (use certificate of correction instead)
  - 3) No defect. Applicant seeking a patentability determination via reissue rather than reexam.



# OATH/DECLARATION ERROR EXAMPLES

- 1) I believe the original U.S. Patent No. A,000,000 as issued to be partly or wholly inoperative or invalid by reason of the patentee claiming less than the patentee had the right to claim in the patent and based on an error with the wording of claim 4 as issued. (IS THIS OKAY?)
- 2) One error being relied upon as the basis for reissue is that the patent failed to claim the following, and in this respect, this reissue is a broadening reissue: A pharmaceutical composition comprising a salt of losartan; the pharmaceutical composition further comprising a material selected from the group consisting of one or more of colloidal silicon microcrystalline cellulose, and polyethylene glycol. (HINT: THIS ERROR IS IDENTICAL WITH NEW CLAIM 6. IS THIS OKAY? )



# OATH/DECLARATION ERROR EXAMPLES

In 1) on the previous slide, the error is based on patentee claiming less than the patentee had the right to claim in the patent and based on an error with the wording of claim 4 as issued.

The alleged error has not complied with the MPEP 1414(II)(C)– “ the oath/declaration must **specifically** identify an error” and “Any error in the claims must be identified by **reference to the specific claim(s)** and **the specific claim language** wherein lies the error.”

The error on the previous slide has only identified the claim number. It does not say why the wording in the claim renders it partially or wholly inoperative or invalid. Thus, it is not sufficient reissue error.



# OATH/DECLARATION ERROR EXAMPLES

For example 2) on previous slide 34 the error is cited as :

A pharmaceutical composition comprising a salt of losartan; the pharmaceutical composition further comprising a material selected from the group consisting of one or more of colloidal silicon microcrystalline cellulose, and polyethylene glycol.

If one looks at claim 6 . It is word for word the same as the error cited. MPEP 1414(II)(C) states that a statement of **“failure to include a claim directed to ...” and then presenting a newly added claim, would not be considered a sufficient error statement.** Applicant has not pointed out what the other claims lacked that the newly added claim has, or vice versa. Thus this is not considered sufficient reissue error.



# OATH/DECLARATION

## SUPPLEMENTAL OATH

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 defects and errors corrected are spelling, grammar, typographical, editorial or clerical errors which are not errors under 35 U.S.C. 251 (see MPEP §1402).



# CONSENT

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.

CONSENT FORM PTO/SB/53 (09-07) There is a place to check on the form if the patent is not assigned.

1.  Filed herein is a statement under 37 CFR 3.73(b). (Form PTO/SB/96)
2.  Ownership of the patent is in the inventor(s), and no assignment of the patent is in effect.



# CONSENT

Or applicant can check the “NO” box of item 7 of Form PTO/SB/50 (08-08) REISSUE PATENT APPLICATION TRANSMITTAL

APPLICATION FOR REISSUE OF: <i>(Check applicable box)</i>	
<input type="checkbox"/> Utility Patent	<input type="checkbox"/> Design Patent <input type="checkbox"/> Plant Patent
APPLICATION ELEMENTS (37 CFR 1.173)	ACCOMPANYING APPLICATION PARTS
1. <input type="checkbox"/> Fee Transmittal Form (PTO/SB/56) 2. <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. 3. <input type="checkbox"/> Specification and Claims in double column copy of patent format (amended, if appropriate) 4. <input type="checkbox"/> Drawing(s) (proposed amendments, if appropriate) 5. <input type="checkbox"/> Reissue Oath/Declaration (original or copy) (37 C.F.R. 1.175) (PTO/SB/51 or 52) 6. <input type="checkbox"/> Power of Attorney 7. <input type="checkbox"/> Original U.S. Patent currently assigned? <input type="checkbox"/> Yes <input type="checkbox"/> No <i>(If Yes, check applicable box(es))</i> <input type="checkbox"/> Written Consent of all Assignees (PTO/SB/53) <input type="checkbox"/> 37 CFR 3.73(b) Statement (PTO/SB/96) 8. <input type="checkbox"/> CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table <input type="checkbox"/> Landscape Table on CD 9. Nucleotide and/or Amino Acid Sequence Submission (if applicable, items a. – c. are required) a. <input type="checkbox"/> Computer Readable Form (CRF) b. Specification Sequence Listing on: i <input type="checkbox"/> CD-ROM (2 copies) or CD-R (2 copies); or ii <input type="checkbox"/> paper c. <input type="checkbox"/> Statements verifying identity of above copies	10. <input type="checkbox"/> Statement of status and support for all changes to the claims. See 37 CFR 1.173(c). 11. <input type="checkbox"/> Foreign Priority Claim (35 U.S.C. 119) (if applicable) 12. <input type="checkbox"/> Information Disclosure Statement (IDS) PTO/SB/08 or PTO-1449 <input type="checkbox"/> Copies of foreign patent documents, publications & other information 13. <input type="checkbox"/> English Translation of Reissue Oath/Declaration (if applicable) 14. <input type="checkbox"/> Preliminary Amendment 15. <input type="checkbox"/> Return Receipt Postcard (MPEP 503) (Should be specifically itemized) 16. <input type="checkbox"/> Other:



# CONSENT

If there are multiple assignees that own part of the patent then consents from each assignee are required (e.g. ABC corporation and XYZ corporation).

Often overlooked on the consent form is the typed or printed name and the TITLE of the person signing for the assignee

Signature	Date
Typed or printed name and title of person signing for assignee (if assigned)	



# CONSENT

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.

In a voluntary divisional reissue a copy of the consent from the parent reissue application should not be accepted whether or not the parent reissue is to be abandoned.

In a divisional reissue based on a restriction made in the parent reissue application , the assignee need not file a consent because the consent has already been provided in the parent reissue. MPEP 1410.01



## OWNERSHIP/ASSIGNEE

The assignee may establish ownership by

- 1) Documentary evidence of a chain from the original owner to the assignee (e.g. copy of an executed assignment)
- 2) A statement specifying where the 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). (PTO/SB/96 (07-09))

If there are multiple assignees, each assignee must file a 3.73(b) statement establishing ownership.



# OWNERSHIP/ASSIGNEE

In PTO/SB/96, applicant must state he/she is either the assignee of the entire interest or an assignee of less than the entire right, title... and then give the **percentage** of ownership or state entire interest of one of the inventors (see boxes 1-3 below). Note this if not using a PTO form.

STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: \_\_\_\_\_  
Application No./Patent No.: \_\_\_\_\_ Filed/Issue Date: \_\_\_\_\_  
Titled: \_\_\_\_\_

\_\_\_\_\_, a \_\_\_\_\_  
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1.  the assignee of the entire right, title, and interest in;
2.  an assignee of less than the entire right, title, and interest in  
(The extent (by percentage) of its ownership interest is \_\_\_\_\_ %); or
3.  the assignee of an undivided interest in the entirety of (a complete assignment from one of the joint inventors was made)

the patent application/patent identified above, by virtue of either:



## OWNERSHIP/ASSIGNEE

Also required is the reel and frame of the assignment(s) as found in either box A or B:

A.  An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy therefore is attached.

OR

B.  A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.



## OWNERSHIP/ASSIGNEE

If one makes a statement that they are authorized act on behalf of the assignee the office will accept such statement absent evidence in the record that cast doubt on the authorization. “On the PTO/SB/96 form it states

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

—

Signature	Date
Typed or printed name and title of person signing for assignee (if assigned)	



## OWNERSHIP/ASSIGNEE

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.
- (ii) Organization resolution (e.g. corporate resolution) giving authority to the person signing to bind the organization.



# OWNERSHIP/ASSIGNEE

## MPEP 324 (V) PARTY WHO MUST SIGN

(A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. 37 CFR 3.73(b)(2)(ii). An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. In foreign countries, a person who holds the title “Manager ” or “Director ” is normally an officer and is presumed to have the authority to sign on behalf of the organization.



# OWNERSHIP/ASSIGNEE

## PARTY WHO MUST SIGN (continued)

(B) The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e. ,to sign the submission on behalf of the assignee. 37 CFR 3.73(b)(2)(i).

(C) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.

Where a submission does not comply with (A), (B), or (C) above, evidence of the person's authority to sign will be required. Attorney of record in itself is not sufficient to allow the attorney to sign the 3.73(b) or consent.



# SEQUENCE COMPLIANCE

## SEQUENCE ID DATA DOES NOT CONVEY IN A REISSUE FROM THE ORIGINAL PATENT

A reissue application that contains sequences must comply with the sequence rules (37 CFR 1.821-1.825) like any other application. *This may be accomplished by filing a new sequence listing via a new diskette plus paper copy plus statement that the diskette and the paper copy are the same or via three copies of a CD plus statement or via EFS (no paper copy of statement required). Compliance may also be accomplished by the less-preferred process of requesting transfer of the sequence listing from the patented file with a paper copy plus statement accompanying the transfer request.*



## MPEP 1412.03: “Broadened Reissue Claim”

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



## Infringement Test

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



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

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



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

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



## Bars To Obtaining Broadening Reissues

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



## MPEP 1412.03 IV. WHEN A BROADENED CLAIM CAN BE PRESENTED

- A broadened claim can be presented within two years from the grant of the original patent in a reissue application. See 35 U.S.C. 251 ¶4;
- A reissue application filed on the 2-year anniversary date from the patent grant is considered to be filed within 2 years of the patent grant.



## BROADENED CLAIM: “unequivocal intent” to broaden

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



## Broadening Reissue Oath

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

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

by reason of a defective specification or drawing.

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

by reason of other errors.

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



## MPEP 1412.03: Broadening Case Law

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

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

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

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



## MPEP 1414 II: Continuation Reissue

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



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

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



## Broadening Case Law: Continuing Reissue

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



# REISSUE ASSISTANCE

**REISSUE/REEXAM HELP LINE 571-272-7703**

**In TC1600:**

**JEAN F. VOLLANO 571-272-0648 General questions**

**BENNETT CELSA 571-272-0807 Recapture**



# Thank You!

**Jean Witz**

**Quality Assurance Specialist**

**Technology Center 1600**

**571-272-0927**

**[jean.witz@uspto.gov](mailto:jean.witz@uspto.gov)**