

Chapter 1400 Correction of Patents

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Errors in a patent may be corrected in three ways. If the error is due to inadvertence, accident or mistake, the patent may be reissued. If the mistake is of a clerical nature on the part of the Office or printer, a Certificate of Correction may be issued to form a part of the patent. If the error is due to inadvertence, accident or mistake, and consists merely in the patentee's claiming more than he had a right to claim, he may file a statutory disclaimer to go with the patent.

1401 Reissue

Extract from 35 U. S. C. 64; R. S. 4916 Reissue of defective patents. Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are 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 identical with the original patent shall constitute a

continuation thereof and have effect continuously from the date of the original patent.

The usual grounds for a reissue are that the claims are too narrow or too broad, or that the disclosure has inaccuracies.

1401.01 Requisites

Rule 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. The application must be accompanied by a certified copy of an abstract of title or an order for a title report, to be placed in the file, and by an offer to surrender the original patent (rule 178).

[Old rules 85, 86]

1401.02 By Whom Filed and to Whom Granted

Rule 172 Applicants, assignees. Reissue applications must be signed and sworn to by the inventors if they be living, and must be accompanied by the written assent of all assignees, if any, owning an undivided interest in the patent. If the inventor is dead, a reissue application may be made by the assignee of the entire interest.

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

[Old Rules 85, 86]

The examiner must inspect the abstract of title to determine whether Rule 172 has been complied with.

A reissue cannot be granted to a sole applicant for a patent originally issued to joint applicants. *Ex parte Barsaloux et al.*, 1878 C. D. 158; *In re Hamilton*, 1930 C. D. 210; 394 O. G. 550.

1401.03 Notice in Original File

Rule 179 Notice of reissue application. When an application for a reissue is filed, there will be placed in the file of the original patent a notice stating that an application for reissue has been filed. When the reissue is granted or the reissue application is otherwise terminated, the fact will be added to the notice in the file of the original patent.

[Old Rule 91, par. 2]

The notice is entered on the file wrapper of the original patent, and pertinent data filled in

by the Application Branch, and entered on the register by the clerk of the division. When the reissue is granted or the prosecution of the reissue application is terminated, the clerk of the division completes the data on the notice and makes an appropriate entry on the register, giving the new patent number if the reissue has been granted or noting abandonment of the application if this is the fact.

1401.04 Offer To Surrender Original Patent and When Such Patent Is Returned

Rule 178 Original patent. The application for a reissue must be accompanied by an offer to surrender the original patent. The application should also be accompanied by the original patent, or if the original is lost or inaccessible, by an affidavit to that effect. The application may be accepted for examination in the absence of the original patent or the affidavit, but one or the other must be supplied before the case is allowed. If a reissue be refused, the original patent will be returned to applicant upon his request.

[Old Rule 91, par. 1]

The examination of the reissue application on the merits is made even though the original patent or an affidavit has not been received, but in such case the Examiner should require them in the first action.

If applicant requests the return of his patent, on abandonment of the reissue application, it will be sent to him by the Executive Officer.

1401.05 Use of Original Drawing

The drawing of the original application may be used in lieu of new drawings in the reissue application, provided that no alteration whatsoever be made in the drawings or in any sheet thereof. The complete set of original drawings must be preserved in the condition existing at the time of issue of the original patent.

When a reissue case is filed with a request for transfer of the drawing from the original file, applicant must submit a mounted copy of the original drawing, or an order for same. (Rule 174.)

The mounted copy of the drawing will be marked "Informal, AFE" (Admitted for Examination) by the Draftsman, but the Examiner should disregard this since the informality will be corrected by formal transfer of the drawing before final allowance.

When the reissue case is ready for allowance, and no change has been made in the drawing, the Clerk of the Division forwards the file with the mounted copy and the patented file and drawing to the Application Branch for formal

transfer of the original drawing to the reissue case. See 608.02 (k).

1401.06 Form of Specification and Claims

Rule 173 Specification. The specification of the reissue application must include the entire specification and claims of the patent, with the matter to be omitted by reissue enclosed in square brackets or otherwise indicated as being deleted; and any additions made by the reissue must be underlined, so that the old and the new specifications and claims may be readily compared. Claims should not be renumbered and the numbering of claims added by reissue should follow the number of the highest numbered patent claim. No new matter shall be introduced into the specification.

[Old Rule 88]

1401.07 New Matter

New matter, that is, matter not present in the patent, is excluded from a reissue application with even greater strictness than in an ordinary case. The claims in the reissue case must be for the same invention claimed in the original patent. 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.* 1942 C. D. 751; 538 O. G. 741.

1401.08 The Reissue Oath

Rule 175 Reissue oath. Applicants for reissue, in addition to complying with the requirements of the first sentence of rule 65, must also file with their applications a statement under oath as follows:

(a) That applicant verily believes the original patent to be wholly or partly inoperative or invalid, and the reasons why.

(b) When it is claimed that such patent is so inoperative or invalid "by reason of a defective or insufficient specification," particularly specifying such defects or insufficiencies.

(c) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new," distinctly specifying the part or parts so alleged to have been improperly claimed as new.

(d) Particularly specifying the errors which it is claimed constitute the inadvertence, accident, or mistake relied upon, and how they arose or occurred.

(e) That said errors arose "without any fraudulent or deceptive intention" on the part of the applicant.

(f) When any reissue claim is broader in any respect than the patent claims, applicant shall explain when and under what circumstances he became aware of the lack of breadth in the patent claims, and shall further explain any delay thereafter up to the filing of such reissue application.

Corroborating affidavits of others may be filed and the examiner may, in any case, require additional information or affidavits concerning the application for reissue and its object.

[Old Rule 87]

The question of the sufficiency of the reissue oath filed under Rule 175 must in each case be reviewed and decided personally by the Primary Examiner. (Extract from Order 2712.)

The reissue oath must point out very specifically what the defects are and how the errors arose. The statements of the oath must be of facts and not conclusions.

An allegation that the specification is insufficient merely because the claims are too narrow ordinarily satisfies paragraph (b) of the rule.

A broadened reissue claim, for the purposes of paragraph (f) of the rule, is one which brings within its scope any subject matter not embraced by the patent claims. A claim broadened in one limitation is a broadened claim though it may be narrower in other details. Where a broadened claim is asserted more than one year after the issuance of the patent, a clearly conclusive showing must be made in justification of the delay.

Relative to paragraph (d) of the rule, deliberate cancellation of a claim in the original patent application is ordinarily regarded as evidence that the failure to include claims to the involved subject matter in the patent is not due to inadvertence, accident or mistake. Claims drawn to substantially the same subject matter are not ordinarily successfully urged in the reissue. An error arising from a lack of understanding or knowledge of applicant's attorney as to the real invention may be an acceptable reason for reissue. However, where an alleged lack of understanding by applicant or his attorney is based on a new factual situation, which did not exist at the time the patent was taken out, reissue is improper.

A ruling that the oath is insufficient should be made a ground of rejection of all the claims.

1401.09 Examination of Reissue

Rule 176 Examination of reissue. An original claim, if re-presented in the reissue application, is subject to re-examination, and the entire application will be examined in the same manner as original applications, subject to the rules relating thereto, excepting that division will not be required. Applications for reissue will be acted on by the examiner in advance of other applications.

[Old Rule 90]

Thus, reissue cases are "special".

Examination of a reissue application involves two aspects, first, it is examined in the same

manner as an original application and second, it must be examined for compliance with the reissue statute and rules. The prosecution of the original patent must be carefully studied for its bearing on the reissue questions.

While an original claim is subject to re-examination, the rejection of such a claim constitutes the rejection of a previously allowed claim and must be personally considered by the Primary Examiner with great care. To be effective, a reference must be prior to the effective filing date of the original patent.

1401.09 (a) Adjudication of Original Patent

When a reissue application is filed, the Examiner should determine whether the original patent has been adjudicated by a court. The decision of the court and also other papers in the suit may give information essential to the examination of the reissue. The patented file will contain notices of the filing and termination of infringement suits on the patent, which notices are required by law to be filed by the clerks of the 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, both of which are in the Law Library, contain tables of patent numbers giving the citation of published decisions concerning the patent. Where papers are not otherwise conveniently obtainable, the applicant may be requested to supply or lend copies of papers and records in suits, or the Solicitor's office 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 made in view of the holding of a court.

1401.10 Division and Election of Species

The Examiner may not require division in a reissue application (Rule 176 in 1401.09). If the original patent contains claims to different inventions which the Examiner may nevertheless consider divisible, and the reissue application also claims the same divisible inventions the Examiner should not require division between them or take any other action with respect to the question of plural inventions. Division is entirely at the option, in the first instance, of the applicant. If the reissue application contains claims to a divisible invention which was not claimed in the original patent, these claims are

treated by a suitable rejection, such as: lack of inoperativeness or defect in the original patent; lack of inadvertence, accident or mistake; or not being for the same invention as the original patent.

When the original patent contains claims to a plurality of species and the reissue application contains claims to the same species, election of species should not be required even though there is no allowable generic claim. If the reissue application presents claims to species not claimed in the original patent, election of species should not be required, but the added claims may be rejected on an appropriate ground which may be lack of inoperativeness or defect in the original patent and lack of inadvertence, accident or mistake in obtaining the original patent. Most situations require special treatment.

1401.10 (a) Divisional Reissue Applications

As is pointed out in the preceding section the Examiner cannot require division in reissue applications, and if the original patent contains several divisible inventions they can only be granted in separate reissue if the applicant demands it. The following rule sets forth the only possibility of divisional reissue applications.

Rule 177 Reissue in divisions. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of rules 83 and 84. On filing divisional reissue applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner, all the divisions of a reissue will issue simultaneously; if there be any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner shall otherwise order.

[Old Rule 89]

1401.11 Allowance and Issue

The specifications of reissue patents will be printed in such a manner as to show the changes over the original patent by printing material omitted by reissue enclosed in heavy brackets [] and material added by reissue in italics. Rule 173 (see 1401.06) 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 specification will carry the following heading which will be added by the Issue Branch:

"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 the new style of printing. Matter appearing in the original patent which is omitted by reissue should be enclosed in heavy brackets, while matter added by reissue should be underlined. All the claims of the patent should appear in the specification, with omitted claims enclosed in brackets. New claims should follow the number of the highest numbered patent claims and be underlined to indicate italics.

In the case of reissue applications filed before the effective date of the new rules, and which have not been prepared in the indicated manner, the examiner may request from the applicant a clean copy of the reissue specification prepared in the indicated form. 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 claims.

Changes of title, assignee, or classification are not affected by this notice.

The list of references to be printed at the end of the reissue specification should include both the references cited during the original prosecution as well as the references cited during the prosecution of the reissue application, and the heading on the sheet on which the references are listed amended by adding or *the original patent*. (Notice of October 12, 1949.)

Before a reissue case is passed to issue, the file is forwarded to the Assignment Branch in order that the abstract of title may be brought down to the latest date. (Extract from Order 1838).

After the case comes back from the Assignment Branch, the Examiner must inspect their report to see that the applicant has complied with Rule 172 (see 1401.02).

NOTE: Transfer of drawing 1401.05.

The notice of allowance is not mailed from the examining division. The file with the notice is sent to the Issue and Gazette Branch, where the notice is stamped and mailed. (Extract from Order 2729).

The date of issue is stamped on the notice of allowance by the Issue and Gazette Branch and mailed. The issue date can be determined at this time because there is no final fee for a reissue application.

1401.12 Reissue Filed While Patent Is in Interference

If an application for reissue of a patent is filed while the patent is involved in interference, that application must be called to the attention of the Commissioner before any action by the Examiner is taken thereon. (Extract from Order No. 3193).

When an application for reissue of a patent is filed while the patent is involved in interference, a letter entitled in the interference is placed in the interference file and in the reissue application file, and a copy thereof is sent to each of the interfering parties, giving notice of the filing of the reissue application. (See 1111.08).

1402 Certificate of Correction

Rule 322 Certificate of correction. A certificate of correction under the act of March 4, 1925, 43 Stat. 1268, 35 U. S. C. 88, may be issued at the request of the patentee or his assignee and endorsed on the patent itself. Such certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notify-

ing the patentee (including any assignee of record) and affording him an opportunity to be heard.

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 Commissioner, with the consent of the patentee (or assignee of record, if any) may issue a reissued patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

[Old Rule 170, par. 1]

1402.01 Kind of Mistake Corrected

Mistakes incurred through the fault of the Office and of clerical and typographical nature are the subject of Certificates of Correction.

Rule 323 Other mistakes not corrected. Mistakes not incurred through the fault of the Office, and not affording legal grounds for reissue, will not be corrected after the date of the patent.

Changes or corrections will not be made in a patent after the date thereof except as provided in rule 322. [Old Rule 170, pars. 2, 3]

1402.02 Handling

Requests for Certificates of Correction will be forwarded by the Register, Correspondence and Mail Branch to Issue and Gazette Branch, where they will be listed in a permanent record book.

When the error is a printer's error, or an error originating in Issue and Gazette Branch, the Chief of Issue and Gazette Branch will state the facts and forward the file with the request for a certificate of correction to the Commissioner for action. If there is an office error which did not originate in Issue and Gazette Branch, the Chief of Issue and Gazette Branch will obtain a report thereof from the Division responsible for the error and forward it with the file to the Commissioner for action. So far as possible, all reports, if more than one is necessary, will be on a single sheet of paper. After action by the Commissioner, the paper and the file will be returned to Issue and Gazette Branch. If the certificate of correction is ordered to issue, it will be prepared and forwarded to the person making the request, by Issue and Gazette Branch.

The request, the report, and a copy of the letter transmitting the certificate of correction to the person making the request will be placed in the file and entered on the index by Issue and Gazette Branch, after which the file will be returned to the patented files.

If the certificate of correction is refused, the request, the report, and a copy of the communication to the person making the request will be placed in the file and entered on the index by Issue and Gazette Branch, after which the file will be returned to the patented files. (Order No. 2737, Revised).

1403 Statutory Disclaimer

Rule 321 Statutory disclaimer in patent. A disclaimer under R. S. 4917; 35 U. S. C. 65, must comply with the requirements of the statute and must also identify the patent, specify that the claiming of more than the patentee had a right to claim occurred through inadvertence, accident or mistake and without any fraudulent or deceptive intention, identify the claim or claims subject to the disclaimer, and be signed by the person making the disclaimer. Such disclaimers are not examined except as to formal matters, but a disclaimer observed not to be a disclaimer in fact may be refused, and the recording of a disclaimer does not indicate that it is considered by the Patent Office to be proper or valid or that the patent after disclaimer, or any claim thereof, is considered valid. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. See rule 21 for fee for disclaimer.

[Old Rule 181]

According to the common law a patent with an invalid claim was wholly void. In order to mitigate the effect of this common law rule the statute on disclaimers was enacted. Under the statute, if the patentee disclaims the invalid portion of his patent without unreasonable delay he may recover that part which is truly and justly his own.

The examination as to formal matters of the disclaimer is performed by the Issue and Gazette Branch.

A disclaimer cannot be used to avoid a rejection on double patenting. Moreover, one cannot publish a disclaimer of certain subject matter and thereafter file a reissue including the matter disclaimed.