# Chapter 1400 Correction of Patents



Errors in a patent may be corrected in three ways, namely by reissue, by the issuance of a certificate which becomes a part of the patent, and by disclaimer.

## 1401 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 Commissioner 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 Commissioner 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.

The usual grounds for a reissue are that the claims are too narrow or too broad, or that the disclosure has inaccuracies. A reissue was refused in Ex parte Arkless, 1958 C.D. 19; 726 O.G. 635, where the only ground urged was failure to make a claim under 35 U.S.C. 119 for priority within the time limit set by Rule 55. The correction of misjoinder of inventors was held not to be a ground for reissue in Ex parte Johnson, 1958 C.D. 22; 731 O.G. 6.

When a reissue application is filed within two years from the date of the original patent, a rejection on the ground of lack of diligence or delay in filing the reissue should not be made.

### 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).

### 1401.02 By Whom Filed and to Whom Granted

*Rule 172. (a) Applicants, assignees.* Reissue applications must be signed and sworn to by the inventors except as otherwise provided (see rules 42, 43, 47), and must be accompanied by the written assent of all assignees, if any, owning an undivided interest in the patent, but a reissue application 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.

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

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

## 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.

The notice is entered on the file wrapper of the original patent and pertinent data filled in by the Application Branch. When the reissue is granted or the prosecution of the reissue application is terminated, it is important that the Record Room be informed of that fact by written memo and the information is applied by the Record Room on the notice in the patented file.

## 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.

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 Mail and Correspondence Branch and not by the examining group.

## 1401.05 Use of Original Drawing

Applicant must submit a mounted copy of the original drawing or "an order for same" (Rule 174) if transfer of the original drawing is contemplated.

Provided that no alteration whatsoever is to be made in the drawings, including adding or cancelling an entire sheet, the drawings of the original patent may be used in lieu of new drawings.

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, the file with the mounted copy and the patented file and drawing are forwarded to the Application Branch for formal transfer of the original drawing to the reissue case. No formal request from applicant for such transfer is necessary. 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; 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.

Cut up soft copies of the original patent, with each COLUMN securely mounted on a separate sheet may be used in preparing the specification and claims. It should be noted that *amendments* to the reissue applications should not be prepared in this way.

An example of the form for a twice-reissued patent is found in Re. 23,558.

## 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 also be for matter which the applicant had the right to claim 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.* (a) 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:

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

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

(3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

(4) Particularly specifying the errors relied upon, and how they arose or occurred.

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

(b) 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.

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. (Basis: 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 (a)(2) of the rule.

A broadened reissue claim 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.

Relative to paragraph (a)(4) of the rule, deliberate cancelation 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 error. 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 reexamination, 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.

Reissue cases are "special" and remain "special" even though applicant does not respond promptly.

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 reexamination, 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 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 made in view of the holding of a court.

## 1401.10 Restriction and Election of Species

The Examiner may not require restriction in a reissue application (Rule 176 in 1401.09. If the original patent contains claims to different inventions which the Examiner may nevertheless consider independent and distinct, and the reissue application also claims the same inventions, the Examiner should not require restric-

tion between them or take any other action with respect to the question of plural inventions. Restriction is entirely at the option, in the first instance, of the applicant. If the reissue application contains claims to an independent and distinct invention which was not claimed in the original patent, these claims may be treated by a suitable rejection, such as: lack of inoperativeness of, or defect in, the original patent; lack of error; or not being for matter which might have been claimed in 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 of, or defect in, the original patent and lack of error 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 restriction in reissue applications, and if the original patent contains several independent and distinct inventions they can only be granted in separate reissues 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 reissued 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.

## 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. The provisions of Rule 173 that claims should not be renumbered applies to the reissue application as filed. When the reissue is allowed, any claims remaining which are additional to the patent claims are renumbered in sequence starting with the number next higher than the number of claims in the original patent. Therefore, the number of claims allowed will not necessarily corespond to the number of the last claim in the reissue application, as allowed.

In the case of reissue applications 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.* (Basis: 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 up to date.

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

NOTE.—Transfer of drawing, 1401.05.

There is no issue fee for reissue applications in which the patent being reissued was granted prior to October 25, 1965. For reissue applications in which the patent being reissued was granted after October 25, 1965, the issue fee is the same as for original applications. (35 U.S.C. 41(a)2).

## 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.

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 Certificates of Correction—Office Mistake

*Rule 322. Certificate of correction of Office mistake.* (a) A certificate of correction under 35 U.S.C. 254, 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 notifying the patentee (including any assignee of record) and affording him 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 Commissioner 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 are the subject of Certificates of Correction under Rule 322. If such 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 arises.

Letters which merely call attention to errors in patents, with a request that the letter be made of record in the patented file, will not be acknowledged. Unless notification to the contrary is received within thirty days, it may be assumed that such letters have been made of record as requested.

In order to expedite all proper requests for Certificates of Correction the following suggestions, if observed will materially reduce the burden on the Patent Office:

(1) Request certificates only for errors of consequence, utilizing the "make of record" letters for all other errors.

(2) Return the patent with the request, thereby relieving the Office of the need to write a letter merely asking for the return of the patent.

(3) Identify the error by page and line in the application file as well as by column and line in the printed patent.

## 1402.01 Applicant's Mistake

*Rule 323. 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 Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, which shall be endorsed on the patent itself, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination.

Rule 323 relates to the issuance of Certificates of Correction for the correction of errors which were not the fault of the Office. A mistake is not of a minor character if the requested change would materially affect the scope or meaning of the patent.

*Rule 324. Correction of error in joining inventor.* Whenever a patent is issued and it appears that there was a misjoinder or non-joinder of inventors and that such misjoinder or omission occurred by error and without deceptive intention, the Commissioner may, on application of all the parties and the assignees and satisfactory proof of the facts, or on order of a court before which such matter is called in question, issue a certificate deleting the misjoined inventor from the patent or adding the non-joined inventor to the patent.

The "satisfactory proof of facts" required by Rule 324 must be of the same type and character as the proof required to justify converting an application, as described in 201.03. An oath of the type required by Rule 65 corresponding to the newly asserted inventorship must be submitted, together with the original patent grant for attachment of the certificate.

## 1402.02 Handling of Requests for Certificates of Correction

Requests for certificates of correction will be forwarded by the Correspondence and Mail

Branch, to the Solicitor's Office, where they will be listed in a permanent record book.

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 Solicitor's office. If a report is necessary in making such determination, the case will be forwarded to the appropriate group or branch with a request that the report be furnished. If no certificate is to issue, the party making the request is so notified by the Solicitor's Office, and the request, report, if any, and copy of the communication to the person making the request are placed in the file and entered thereon under "Contents" by the Solicitor's Office. The case is then returned to the patented files. If a certificate is to issue, it will be prepared and forwarded to the person making the request by the Issue and Gazette Branch. 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 placed in the file and entered thereon under "Contents".

## 1403 Statutory Disclaimer

*Rule 321. Statutory disclaimer in patent.* A disclaimer under 35 U.S.C. 253 must identify the patent and the claim or claims which are disclaimed, and be signed by the person making the disclaimer, who shall state therein the extent of his interest in the patent. A disclaimer not a disclaimer of a complete claim or claims may be refused recordation. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. In like manner 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.

See rule 21 for fee.

The examination as to formal matters is done by the Issue and Gazette Branch.

*Terminal* disclaimers may affect the prosecution of other applications. They are brought to the Examiner's attention by the Issue and Gazette Branch which attaches a label to the file wrapper and forwards the file containing them to the Examining Group after having a title search made, endorsing the paper on the "Contents" and otherwise insuring that the patent, if issued, will be properly headed.