# Chapter 1400 Correction of Patents



## 1400.01 Introduction

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

(A) by reissue,

(B) by the issuance of a certificate of correction which becomes a part of the patent,

(C) by disclaimer, and

(D) by reexamination.

The first three ways are discussed in this chapter while the fourth way (reexamination) is discussed in MPEP Chapter 2200.

## 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 provisions of 35 U.S.C. 251 permit the reissue of a patent to correct an error in the patent made without any deceptive intention and provide criteria for the reissue. 37 CFR 1.171 through 1.179 are rules directed to reissue.

## 1402 Grounds for Filing

A reissue application is filed to correct an error in the patent which was made without any deceptive intention,

where, as a result of the error, the patent is deemed wholly or partly inoperative or invalid. An error in the patent arises out of an error in conduct which was made in the preparation and/or prosecution of the application which became the patent.

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

In accordance with 35 U.S.C. 251, the error upon which a reissue is based must be one which causes the patent to be "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." Thus, an error under 35 U.S.C. 251 *has not been presented* where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251. These corrections to a patent do not provide a basis for reissue (although these corrections may also be included in a reissue application, where a 35 U.S.C. 251 error is already present).

The most common bases for filing a reissue application are:

(A) the claims are too narrow or too broad;

(B) the disclosure contains inaccuracies;

(C) applicant failed to or incorrectly claimed foreign priority; and

(D) applicant failed to make reference to or incorrectly made reference to prior copending applications.

An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue in *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). The correction of misjoinder of inventors in divisional reissues has been held to be a ground for reissue. See *Ex parte Scudder*, 169 USPQ 814 (Bd. App. 1971).The Board of Appeals held in *Ex parte Scudder*, 169 USPQ at 815, that 35 U.S.C. 251 authorizes reissue application to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate.

Reissue may no longer be necessary under the facts in *Ex parte Scudder, supra,* in view of 35 U.S.C. 116 which provides, *inter alia*, that:

> "Inventors may apply for a patent jointly even though . . . (3) each did not make a contribution to the subject matter of every claim in the patent."

See also 37 CFR 1.45(b)(3).

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

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

Correction of failure to adequately claim priority in an earlier filed copending U.S. Patent application was held a proper ground for reissue. *Sampson v. Comm'r Pat.*, 195 USPQ 136, 137 (D.D.C. 1976). Reissue applicant's failure to timely file a divisional application is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such applicant's error is not correctable by reissue of the original patent under 35 U.S.C. 251. *In re Orita,* 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). See also *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978).

## 1403 Diligence in Filing

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

The fourth paragraph of 35 U.S.C. 251 states:

> "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."

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

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

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

A reissue application can be granted a filing date without an oath or declaration, or without the filing fee being present. See 37 CFR 1.53(f). Applicant will be given a period of time to provide the missing parts and to pay the surcharge under 37 CFR 1.16(e). See MPEP § 1410.01.

## 1404 Submission of Papers Where Reissue Patent Is in Litigation

Applicants and protestors (see MPEP § 1901.03) submitting papers for entry in reissue applications of patents involved in litigation are requested to mark the outside envelope and the top right–hand portion of the papers with the words "REISSUE LITIGATION" and with the group art unit or other area of the Patent and Trademark Office in which the reissue application is located, e.g., Assistant Commissioner for Patents, Board of Patent Appeals and Interferences, Examining Group, Office of Patent Publication, etc. Protestor's participation, including the submission of papers, is limited in accordance with 37 CFR 1.291(c). Any "Reissue Litigation" papers mailed to the Office should be so marked and mailed to Box 7, Assistant Commissioner for Patents, Washington, D.C. 20231. The markings preferably should be written in a bright color with a felt point marker. Papers marked "REISSUE LITIGATION" will be given special attention and expedited handling. See MPEP § 1442.01 through § 1442.04 for examination of litigation related reissue applications.

## 1410 Content of Reissue Application

*37 CFR 1.171. Application for reissue.*

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications.

The specification (including the claims and any drawings) of the reissue application is the copy of the patent for which reissue is requested that is submitted by applicant as part of the initial application papers. In addition, an applicant for reissue is required to file a reissue oath or declaration which, in addition to complying with 37 CFR 1.63, must comply with 37 CFR 1.175. Where the patent is assigned, the reissue applicant must also provide a consent of assignee to the reissue and evidence of ownership. In addition, the reissue applicant should file an offer to surrender the original patent; however, this is not a requirement for filing of the reissue. It is only necessary that the patent be surrendered before the application is allowed. Where appropriate, the reissue applicant may provide a claim for priority under 35 U.S.C. 119 or 120, and may also file an Information Disclosure Statement. The initial contents of a reissue application are discussed in detail in MPEP § 1410.01 through § 1418.

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

The requirement for the assignee to consent to filing a reissue no longer includes a requirement for applicant to order a title report with the filing of the reissue application. Rather, the assignee entity is established by a statement on behalf of all the assignees under 37 CFR 1.172(a) and 37 CFR 3.73(b). See MPEP § 1410.01.

Form PTO/SB/50, Reissue Patent Application Transmittal, may be used for filing reissue applications.

Please type a plus sign (+) inside this box → ☐

PTO/SB/50 (4/98)
Approved for use through 09/30/2000. OMB 0651-0033
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REISSUE PATENT APPLICATION TRANSMITTAL

*Address to:*
**Assistant Commissioner for Patents**
**Box Patent Application**
**Washington, DC 20231**

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

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

## APPLICATION ELEMENTS

1. ☐ * Fee Transmittal Form *(PTO/SB/56)* *(Submit an original, and a duplicate for fee processing)*
2. ☐ Specification and Claims (*amended, if appropriate*)
3. ☐ Drawing(s) *(proposed amendments, if appropriate)*
4. ☐ Reissue Oath / Declaration (original or copy) *(37 C.F.R. § 1.175)(PTO/SB/51 or 52)*
5. Original U.S. Patent
   - ☐ Offer to Surrender Original Patent *(37 C.F.R. § 1.178)* *(PTO/SB/53 or PTO/SB/54)*
   - *or*
   - ☐ Ribboned Original Patent Grant
   - ☐ Affidavit / Declaration of Loss *(PTO/SB/55)*
6. Original U.S. Patent currently assigned?
   - ☐ Yes ☐ No

   *(If Yes, check applicable box(es))*
   - ☐ Written Consent of all Assignees *(PTO/SB/53 or 54)*
   - ☐ 37 C.F.R. § 3.73(b) Statement ☐ Power of Attorney

## ACCOMPANYING APPLICATION PARTS

7. ☐ Foreign Priority Claim *(35 U.S.C. 119)* *(if applicable)*
8. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
9. ☐ English Translation of Reissue Oath/Declaration *(if applicable)*
10. ☐ * Small Entity Statement(s) *(PTO/SB/09-12)* ☐ Statement filed in prior application, Status still proper and desired
11. ☐ Preliminary Amendment
12. ☐ Return Receipt Postcard *(MPEP 503)* *(Should be specifically itemized)*
13. ☐ Other: .....

*NOTE FOR ITEMS 1 & 10: IN ORDER TO BE ENTITLED TO PAY SMALL ENTITY FEES, A SMALL ENTITY STATEMENT IS REQUIRED (37 C.F.R. § 1.27), EXCEPT IF ONE FILED IN A PRIOR APPLICATION IS RELIED UPON (37 C.F.R. § 1.28).*

## 14. CORRESPONDENCE ADDRESS

☐ *Customer Number or Bar Code Label* *(Insert Customer No. or Attach bar code label here)* *or* ☐ *Correspondence address below*

| | | | | | |
|---|---|---|---|---|---|
| *Name* | | | | | |
| *Address* | | | | | |
| *City* | | *State* | | *Zip Code* | |
| *Country* | | *Telephone* | | *Fax* | |

| | | | |
|---|---|---|---|
| *NAME (Print/Type)* | | *Registration No. (Attorney/Agent)* | |
| *Signature* | | *Date* | |

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

## 1410.01 Reissue Applicant, Oath or Declaration, and Consent of All Assignees

*37 CFR 1.172. Applicants, assignees.*

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b) of this chapter.

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

*37 CFR 3.73. Establishing right of assignee to take action.*

*****

(b) When an assignee seeks to take action in a matter before the Office with respect to a patent application, trademark application, patent, registration, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. Ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment submitted for recording) or by specifying (*e.g.*, reel and frame number) where such evidence is recorded in the Office. The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

The reissue oath must be signed and sworn to by all the inventors, or declaration made by all the inventors, except as otherwise provided in 37 CFR 1.42, 1.43, and 1.47 (see MPEP § 409). Where the reissue application does *not* seek to enlarge the scope of any of the claims of the original patent, the reissue oath may be made and sworn to or declaration made by the assignee of the entire interest. Depending on the circumstances, either Form PTO/SB/51 Reissue Application Declaration by the Inventor, or Form PTO/SB/52 Reissue Application by the Assignee, may be used to prepare a declaration in a reissue application.

### CONSENT TO THE REISSUE

Where no assignee exists, applicant should affirmatively state that fact. If the file record is silent as to the existence of an assignee, it will be presumed that *an assignee does exist*. This presumption should be set forth by the examiner in the first Office action alerting applicant to the requirement. It should be noted that the mere filing of a small entity statement in no way relieves applicant of the requirement to affirmatively state that no assignee exists.

Where a small entity statement indicates that the application/patent is assigned, and there is no consent by the assignee named in the small entity statement, the examiner should make inquiry into the matter in an Office action, even if the record otherwise indicates that the application/patent is not assigned.

The reissue oath or declaration must be accompanied by the written consent of all assignees. 35 U.S.C. 111(a) and 37 CFR 1.53(b) provide, however, for according an application a filing date if filed with a specification, including claim(s), and any required drawings. Thus, where an application is filed without an oath or declaration, or without the consent of all assignees, if the application otherwise complies with 37 CFR 1.53(b) and the reissue rules, the Office of Initial Patent Examination (OIPE) will accord a filing date and send out a notice of missing parts setting a period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(f) and 1.16(e). If the reissue oath or declaration is filed but the assignee consent is lacking, the surcharge is required because, until the consent is filed, the reissue oath or declaration is defective, since it is not apparent that the signatures thereon are proper absent an indication the assignees have consented to the filing.

The consent of assignee must be signed by a party authorized to act on behalf of the assignee. See MPEP § 324 for a discussion of parties authorized to act on behalf of the assignee. The consent to the reissue application may use language such as:

> The XYZ Corporation, assignee of U.S. Patent No. 9,999,999, consents to the filing of reissue application No. 09/999,999 (or the present application, if filed with the initial application papers) for the reissue of U.S. Patent No. 9,999,999.
>
> _____
> Lilly M. Schor
> Vice President,
> XYZ Corporation

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

The reissue application can then be examined, but will not be allowed or issued without the consent of all the assignees as required by 37 CFR 1.172. *See N. B. Fassett*, 1877 C.D. 32, 11 O.G. 420 (Comm'r Pat. 1877); *James D. Wright*, 1876 C.D. 217, 10 O.G. 587 (Comm'r Pat. 1876).

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

¶ *14.15 Consent of Assignee to Reissue Lacking*

This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

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

**Examiner Note:**

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.
2. If otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

## PROOF OF OWNERSHIP OF ASSIGNEE

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

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

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

Documents that are submitted to establish ownership may be required to be recorded. Compliance with 37 CFR 3.73(b) may be provided as part of the same paper in which the consent by assignee is provided.

Upon initial receipt of a reissue application, the examiner should inspect the application to determine whether the submission under 37 CFR 1.172 and 37 CFR 3.73(b) establishing the ownership of the assignee is present and sufficient. If the submission is not present, form paragraph 14.16 may be used to indicate that the assignee has not provided evidence of ownership.

¶ *14.16 Failure of Assignee To Establish Ownership*

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

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

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

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

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

**Examiner Note:**

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.
2. If otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

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

If the submission under 37 CFR 3.73(b) to establish ownership is not signed by a party authorized to act on behalf of the assignee, the appropriate paragraphs of Form Paragraphs 14.16.01 through 14.16.06 may be used.

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

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

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

**Examiner Note:**

1. This form paragraph should be followed: (a) by one of form paragraphs 14.16.02 through 14.16.04, (b) then by form paragraph 14.16.05, (c) then optionally by form paragraph 14.16.06.
2. See MPEP § 1410.01.

¶ *14.16.02 Failure To State Capacity To Sign*

The person who signed the submission establishing ownership interest has failed to state his/her capacity to sign for the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

**Examiner Note:**

1. This form paragraph is to be used when the person signing the submission establishing ownership interest does not state his/her capacity (e.g., as a recognized officer) to sign for the assignee, and is not established as being authorized to act on behalf of the assignee.
2. Use form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly execute a submission establishing ownership interest.

¶ *14.16.03 Lack of Capacity To Sign*

The person who signed the submission establishing ownership interest is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

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

¶ *14.16.04 Attorney/Agent of Record Signs*

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

**Examiner Note:**

1. This form paragraph is to be used when the person signing the submission establishing ownership interest is an attorney or agent of record who is not an authorized officer as defined in MPEP § 324 and has not been established as being authorized to act on behalf of the assignee.
2. Use form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly execute a submission establishing ownership interest.
3. In bracket 1, insert either --attorney-- or --agent--.

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

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

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

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.16.02, 14.16.03 or 14.16.04.
2. When one of form paragraphs 14.16.02, 14.16.03 or 14.16.04 is used to indicate that a submission establishing ownership interest is not proper because it was not signed by a recognized officer, this form paragraph should be used to point out one way to correct the problem.
3. While an indication of the person's title is desirable, its inclusion is not mandatory when this option is employed.

Where the submission establishes the assignee's ownership as to the patent, ownership as to the reissue application will be presumed. Accordingly, a submission as to the ownership of the patent will be construed to satisfy the 37 CFR 1.172 (and 37 CFR 3.73(b)) requirements for establishing ownership of the application. Thus, a terminal disclaimer can be filed in a reissue application where ownership of the patent has been established without the need for a separate submission under 37 CFR 3.73(b) showing ownership of the reissue application.

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

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

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

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

## 1411 Form of Specification

*37 CFR 1.173. 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.

The file wrappers of all reissue applications are stamped "REISSUE" above the application number on the front of the file. "Reissue" also appears below the ap-

plication number on the printed label on the file wrapper of application with 08/ and earliest series.

Cut–up soft copies of the original patent, with only a single column of the printed patent securely mounted on a separate sheet of paper, should be used in preparing the reissue specification and claims to be filed. It should be noted, however, that amendments to the reissue application should not be prepared in this way. After filing, the specification and claims in the reissue application must be amended in the manner set forth by 37 CFR 1.121(b) and MPEP § 1453. However, insertions or deletions to the patent specification or claims filed as part of the original reissue specification and claims should be underlined or bracketed, respectively, as indicated in 37 CFR 1.173. The presentation of the insertions or deletions as part of the original reissue specification or claims is not an amendment under 37 CFR 1.121.

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

Entire words or chemical formulas must be shown as being changed. Change in only a part of a word or formula is not permitted. Deletion of a chemical formula should be shown by brackets which are substantially larger and darker than any in the formula.

Where a chart, table, or chemical formula spans two columns of the patent, it should not be split. Rather, the chart, table, or formula should be provided in its entirety *as part of the column of the patent to which it pertains*, in order to provide a continuity of the description. When doing so, the chart, table, or chemical formula will extend beyond the width of the column.

## 1411.01 Certificate of Correction or Disclaimer in Original Patent

The applicant should include any changes, additions, or deletions that were made by a Certificate of Correction to the original patent grant in the reissue application without underlining or bracketing. The examiner should also make certain that all Certificate of Correction changes in the patent have been properly incorporated into the reissue application.

Certificate of Correction changes and disclaimer of claim(s) under 37 CFR 1.321(a) should be made without using underlining or brackets. Since these are part of the original patent and were made before the reissue was filed, they should show up in the printed reissue document as part of the original patent, i.e., not in italics or bracketed. If the changes are extensive and/or applicant has submitted them improperly with underlining and brackets, a clean copy of the specification with the Certificate of Correction changes in it may be requested by the examiner.

## 1411.02 New Matter

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

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

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

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

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

**Examiner Note:**

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

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

## 1412 Content of Claims

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

## 1412.01 Reissue Claims Must Be for Same General Invention

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

> We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

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

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

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

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

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

The original patent specification discloses that composition X is not suitable (or not satisfactory) for molding an item because composition X fails to provide quick drying. After the patent issues, it is found that composition X would be desirable for the molding in spite of the failure to provide quick drying, because of some other newly recognized benefit from composition X. A claim to composition X or a method of use thereof would not be permitted in a reissue application, because the original patent specification contained an explicit statement of intent *not* to claim composition X or a method of use thereof.

In most instances, however, the mere failure to claim a disclosed embodiment in the original patent (absent an explicit statement in the original patent specification of unsuitability of the embodiment) would **not** be grounds for prohibiting a claim to that embodiment in the reissue.

## 1412.02 Recapture of Canceled Subject Matter

A reissue will not be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent. *In re Clement,* 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1989); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363–64 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960). The Federal Circuit stated the following principles in *Clement*:

(1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

131 F.3d at 1469–70, 45 USPQ2d at 1165. See MPEP § 1412.03 as to broadening claims.

Impermissible recapture occurs in a reissue where the claims in the reissue are of the same scope as, or are broader in scope than, claims deliberately canceled in an application to obtain a patent. Where such claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. If the narrowing limitation has a material aspect to it, then there is no recapture. However, if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. 251 using form paragraph 14.17.

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

Claim [1] rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp.* v. *United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

> "The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application."
> [2]

**Examiner Note:**

In bracket 2, the examiner should explain the specifics of why recapture exists. See MPEP § 1412.02

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

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the "article" claims) or in canceling claims directed to this statutory category of invention must have been made as a result of error without deceptive intent. The addition of these "article" claims will generally be considered to be a *broadening* of the invention (*Ex Parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

## 1412.03 Broadening Reissue Claims

35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues:

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

### MEANING OF "BROADENED REISSUE CLAIM"

A broadened reissue claim is a claim which enlarges the scope of the claims of the patent, *i.e.*, a claim which is greater in scope than each and every claim of the patent. A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least one* respect, even though it may be narrower in other respects.

A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable apparatus or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603, 120

USPQ 185, 186 (CCPA 1958). A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for direct infringement who previously could not have been sued for direct infringement.

The addition of process claims as a new category of invention to be claimed in the patent (*i.e.*, where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex Parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989).

**WHEN A BROADENED CLAIM CAN BE PRESENTED**

A broadened claim can be presented within two years from the grant of the original patent in a reissue application. In addition, a broadened claim can be presented *after* two years from the grant in a broadening reissue which was filed *within* two years from the grant. Where any intent to broaden is indicated in the reissue application within the two years, a broadened claim can be presented in the reissue after two years. Finally, if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing reissue application after two years. In any other situation, a broadened claim cannot be presented, and the examiner should check carefully for the improper presentation of broadened claims.

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

See also the following cases which pertain to broadened reissues:

*In re Graff*, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473–74 (Fed. Cir. 1997) (Broadened claims in a continuing reissue application were properly rejected under 35 U.S.C. 251 because the proposal for broadened claims was not made (in the parent reissue application) within two years from the grant of the original patent and the public was not notified that broadened claims were being sought until after the two–year period elapsed.);

*In re Fotland*, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985), *cert. denied*, 476 U.S. 1183 (1986) (The failure by an applicant to include *an oath or declaration indicating a desire to seek broadened claims* within two years of the patent grant will bar a subsequent attempt to broaden the claims after the two year limit. Under the former version of 37 CFR 1.175 (the former 37 CFR 1.175(a)(4)), applicant timely sought a "no–defect" reissue, but the Court did not permit an attempt made beyond the two year limit to convert the reissue into a broadening reissue. In this case, applicant did not indicate any intent to broaden within the two years.);

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

*In re Doll*, 419 F.2d 925, 928, 164 USPQ 218, 220 (CCPA 1970) (If the reissue application is timely filed within two years of the original patent grant and the applicant indicates in the oath or declaration that the claims will be broadened, then applicant may subsequently broaden the claims in the pending reissue prosecution even if the additional broadening occurs beyond the two year limit.).

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

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

Claim [1] rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. [2]

**Examiner Note:**

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

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

Claim [1] rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. [2]

**Examiner Note:**

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

## 1413 Drawings

*37 CFR 1.174. Drawings.*

(a) The drawings upon which the original patent was issued may be used in reissue applications if no changes whatsoever are to be made in the drawings. In such cases, when the reissue application is filed, the applicant must submit a temporary drawing which may consist of a copy of the printed drawings of the patent or a photoprint of the original drawings of the size required for original drawing.

(b) Amendments which can be made in a reissue drawing, that is, changes from the drawing of the patent, are restricted.

If transfer of the patent drawings to the reissue application is desired, a letter requesting transfer of the drawings from the patent file should be filed along with the reissue application. The Reissue Patent Application Transmittal Form, PTO/SB/50, includes a provision to request a transfer of the drawings from the original patent file to the reissue application. The box to be checked for this request was added to relieve applicants of having to file a separate paper requesting transfer of the drawings; however, it does not excuse applicants from having to include a copy of the drawings with the filing of the reissue application in order to provide a complete application and to obtain a filing date, as required by 37 CFR 1.53 and 1.81. See also MPEP § 601.01.

The drawings of the original patent may be used in lieu of new drawings, provided that no alteration whatsoever is made in the original patent drawings. A sheet of original drawings cannot be amended and should not be transferred from the original patent to the reissue when drawing amendments are expected.

If an amendment is to be made to drawings in a reissue application, a sketch in permanent ink showing proposed changes in red, to become part of the record, must be filed for approval by the examiner and should be in a separate paper. See 37 CFR 1.121(b)(3). After approval by the examiner, a new sheet of formal drawings must be submitted for every sheet to be amended. A reissue applicant may direct cancellation of an entire sheet of the original patent drawings and provide a substitute sheet with changes desired by the applicant. 37 CFR 1.121(b)(3) specifies that amendments to the patent drawing sheets are not permitted. Any change to any of the patent drawings must be in the form of a *new sheet of drawings* with any amended figure(s) identified as "amended" and any added figure(s) identified as "new" for each sheet that has changed and for each added sheet.

When the reissue application is ready for allowance, the examining group makes the formal transfer of the original drawing to the reissue application, notation thereof being entered on the file wrapper of the patented file. This transfer should not be carried out prior to allowance, because the reissue application might become abandoned, and as such, the original drawings must remain in place.

## 1414 Content of Reissue Oath/Declaration

*37 CFR 1.175. Reissue oath or declaration.*

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

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

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

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

(i) With any amendment prior to allowance; or

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

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

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

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

The reissue oath/declaration is an essential part of a reissue application and must be filed with the application, or within the time period set under 37 CFR 1.53(f) along with the required surcharge as set forth in 37 CFR 1.16(e) in order to avoid abandonment.

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

Reissue oaths or declarations must contain the following:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid–

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

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

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

These elements will now be discussed:

## I. A STATEMENT THAT THE APPLICANT BELIEVES THE ORIGINAL PATENT TO BE WHOLLY OR PARTLY INOPERATIVE OR INVALID BY REASON OF A DEFECTIVE SPECIFICATION OR DRAWING, OR BY REASON OF THE PATENTEE CLAIMING MORE OR LESS THAN PATENTEE HAD THE RIGHT TO CLAIM IN THE PATENT.

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

> "Applicant believes the original patent to be partly inoperative or invalid by reason of a defective specification or drawing."

Alternatively, a declaration can state:

> "Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more or less than patentee had the right to claim in the patent."

Where the specification or drawing is defective and patentee claimed more or less than patentee had the right to claim in the patent, then *both* statements should be included in the reissue oath/declaration. See MPEP § 1412.04 for an exemplary declaration statement when the error being corrected is an error in inventorship.

The above examples will be sufficient to satisfy this requirement without any further statement.

Form paragraph 14.01 may be used where the reissue oath/declaration does not provide the required statement as to applicant's belief that the original patent is wholly or partly inoperative or invalid.

¶ *14.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) – No Statement of Defect in the Patent*

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. **[1]**

**Examiner Note:**

1. Use this form paragraph when applicant: (a) fails to allege that the original patent is inoperative or invalid and/or (b) fails to state the reason of a defective specification or drawing, or of patentee claiming more or less than patentee had the right to claim in the patent. In bracket 1, point out the specific defect to applicant by using the language of (a) and/or (b), as it is appropriate.
2. Form paragraph 14.14 must follow this form paragraph.

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

A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). A change or departure from the original specification or claims represents an "error" in the original patent under 35 U.S.C. 251. See MPEP § 1402 for a discussion of grounds for filing a reissue that may constitute the "error" required by 35 U.S.C. 251. Not all changes with respect to the patent constitute the "error" required by 35 U.S.C. 251.

Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied. Applicant may specify more than one error.

Where more than one error is specified in the oath/declaration and some of the designated "errors" are found to not be "errors" under 35 U.S.C. 251, any remaining error which is an error under 35 U.S.C. 251 will still support the reissue.

The "at least one error" which is relied upon to support the reissue application must be set forth in the oath/declaration. It is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered. If an applicant chooses to point out these matters, the statements directed to these matters will not be reviewed by the examiner, and the applicant should be so informed in the next Office action. All that is needed for the oath/declaration statement as to error is the identification of "at least one error" relied upon.

In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inop-

erative or invalid. The corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration. If the initial reissue oath/declaration "states at least one error" in the original patent, and, *in addition*, recites the specific corrective action taken in the reissue application, the oath/declaration would be considered acceptable, even though the corrective action statement is not required.

It is not sufficient for an oath/declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." Rather, the oath/declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), *cert. denied*, 484 U.S. 894 (1987).

Form paragraph 14.01.01 may be used where the reissue oath/declaration does not identify an error.

¶ *14.01.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) – No Statement of a Specific Error*

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

**Examiner Note:**

1. Use this form paragraph when the reissue oath or declaration does not contain any statement of an error which is relied upon to support the reissue application.
2. This form paragraph can be used where the reissue oath or declaration does not even mention error. It can also can be used where the reissue oath or declaration contains some discussion of the concept of error but never in fact identifies a specific error to be relied upon. For example, it is not sufficient for an oath or declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure."
3. Form paragraph 14.14 must follow this form paragraph.

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

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

¶ *14.01.02 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) – The Identified "Error" Is Not Appropriate Error*

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

**Examiner Note:**

1. Use this form paragraph when the reissue oath/declaration identifies only one error which is relied upon to support the reissue application, and that one error is not an appropriate error upon which a reissue can be based.
2. Form paragraph 14.14 must follow this form paragraph.

¶ *14.01.03 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) – Multiple Identified "Errors" Not Appropriate Errors*

The reissue oath/declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

**Examiner Note:**

1. Use this form paragraph when the reissue oath/declaration identifies more than one error relied upon to support the reissue application, and none of the errors are appropriate errors upon which a reissue can be based.
2. Note that if the reissue oath/declaration identifies more than one error relied upon, and at least one of the errors is an error upon which reissue can be based, this form paragraph should not be used, despite the additional reliance by applicant on "errors" which do not support the reissue. Only one appropriate error is needed to support a reissue.
3. Form paragraph 14.14 must follow this form paragraph.

## III. A STATEMENT THAT ALL ERRORS WHICH ARE BEING CORRECTED IN THE REISSUE APPLICATION UP TO THE TIME OF FILING OF THE OATH/DECLARATION AROSE WITHOUT ANY DECEPTIVE INTENTION ON THE PART OF THE APPLICANT.

In order to satisfy this requirement, the following statement may be included in an oath or declaration:

> "All errors which are being corrected in the present reissue application up to the time of filing of this declaration arose without any deceptive intention on the part of the applicant."

Nothing more is required. The examiner will determine only whether the reissue oath/declaration contains the required averment; the examiner will not make any comment as to whether it appears that there was in fact deceptive intention (see MPEP § 2022.05).

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

¶ *14.01.04 Defective Reissue Oath/Declaration, 37 CFR 1.175 – Lack of Statement of "Without Any Deceptive Intention"*

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

**Examiner Note:**

1. Use this form paragraph when the reissue oath/declaration does not contain the statement required by 37 CFR 1.175 that all errors being corrected in the reissue application arose without any deceptive intention on the part of the applicant.
2. This form paragraph is appropriate to use for a failure by applicant to comply with the requirement, as to any of 37 CFR 1.175(a)(2), 37 CFR 1.175(b)(1), or 37 CFR 1.175(b)(2).
3. Paragraph 14.14 must follow.

**IV. THE REISSUE OATH/DECLARATION MUST COMPLY WITH 37 CFR 1.63.**

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

(A) have reviewed and understand the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath/declaration;

(B) believe the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and

(C) acknowledge the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

See also the discussion regarding the requirements of an oath/declaration beginning at MPEP § 602.

The examiner should check carefully to ensure that all the requirements of 37 CFR 1.63 are met. Form paragraph 14.01.05 should be used in conjunction with the content of form paragraph 6.03 through 6.09 as appropriate, where the reissue oath/declaration fails to comply with the requirements of 37 CFR 1.63.

¶ *14.01.05 Defective Reissue Oath/Declaration, 37 CFR 1.175 – General*

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

**Examiner Note:**

1. Use this form paragraph when the reissue oath/declaration does not comply with 37 CFR 1.175, and none of form paragraphs 14.01 – 14.01.04 or 14.05.02 apply.
2. This form paragraph must be followed by an explanation of why the reissue oath/declaration is defective.
3. Form paragraph 14.14 must follow the explanation of the defect.

See MPEP § 1414.01 for a discussion of the requirements for a supplemental reissue oath/declaration.

## 1414.01 Supplemental Reissue Oath/Declaration

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

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

An example of acceptable language is as follows:

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

**WHEN AN ERROR MUST BE STATED IN THE SUPPLEMENTAL OATH/DECLARATION**

In the supplemental reissue oath/declaration, there is **no need to state an error** which is relied upon to support the reissue application **if**:

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

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

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

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

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

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

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

**WHEN A SUPPLEMENTAL OATH/DECLARATION MUST BE SUBMITTED**

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

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

## 1415 Reissue Filing and Issue Fees

The reissue applicant is permitted to present every claim that was issued in the original patent for the basic filing fee. In addition to the basic filing fee, the filing or later presentation of each independent claim which is in excess of the number of independent claims in the original patent requires a fee. In addition, the filing or later presentation of each claim (whether independent or dependent) in excess of 20, and also in excess of the number of claims in the original patent, requires a fee. The Office has prepared Form PTO/SB/56, Reissue Application Fee Transmittal Form, which is designed to assist in the correct calculation of reissue filing fees.

PTO/SB/56 (12-97)
Approved for use through 9/30/00. OMB 0651-0033
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 FEE TRANSMITTAL FORM**

Docket Number (Optional)

Claims as Filed - Part 1

| Claims in Patent | For | Number Filed in Reissue Application | (3) Number Extra | Small Entity Rate | Small Entity Fee | | Other than a Small Entity Rate | Other than a Small Entity Fee |
|---|---|---|---|---|---|---|---|---|
| (A) | Total Claims (37 CFR 1.16(j)) | (B) | **** = | x $___ = | | or | x $___ = | |
| (C) | Independent Claims (37 CFR 1.16(i)) | (D) | * = | x $___ = | | | x $___ = | |
| | | | Basic Fee (37 CFR 1.16(h)) | | $___ | | | $___ |
| | | | Total Filing Fee | | $ | | OR | $ |

Claims as Amended - Part 2

| | (1) Claims Remaining After Amendment | | (2) Highest Number Previously Paid For | (3) Extra Claims Present | Small Entity Rate | Small Entity Fee | | Other than a Small Entity Rate | Other than a Small Entity Fee |
|---|---|---|---|---|---|---|---|---|---|
| Total Claims (37 CFR 1.16(j)) | *** | MINUS | ** | * = | x $___ = | | or | x $___ = | |
| Independent Claims (37 CFR 1.16(i)) | *** | MINUS | ***** | = | x $___ = | | | x $___ = | |
| | | | | Total Additional Fee | | $ | | OR | $ |

* If the entry in (D) is less than the entry in (C), Write "0" in column 3.
** If the "Highest Number of Total Claims Previously Paid For" is less than 20, Write "20" in this space.
*** After any cancelation of claims
**** If "A" is greater than 20, use (B -A); if "A" is 20 or less, use (B - 20).
***** "Highest Number of Independent Claims Previously Paid For" or Number of Independent Claims in Patent (C).

☐ Please charge Deposit Account No. _____ in the amount of _____.
A duplicate copy of this sheet is enclosed.

☐ The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 or 1.17 which may be required, or credit any overpayment to Deposit Account No. _____.
A duplicate copy of this sheet is enclosed.

☐ A check in the amount of $ _____ to cover the filing / additional fee is enclosed.

_____
Date

_____
Signature of Applicant, Attorney or Agent of Record

_____
Typed or printed name

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

## 1415.01 Maintenance Fees on the Original Patent

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

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

PALM may be used to determine the history of maintenance fees by entering 2970 and then the patent number. This PALM screen shows when any maintenance fees have been paid and when the next maintenance fee is due to be paid.

If the window for the maintenance fee due has closed (maintenance fees are due by the day of the 4th, 8th and 12th year anniversary of the grant of the patent), but the maintenance fee has not been paid, then the reissue should be rejected under 35 U.S.C. 251 as having expired and may not be passed to issue. However, if time remains for applicant to pay the maintenance fee, then the application should not be rejected under 35 U.S.C. 251 and it may be passed to issue when it is in condition for allowance, because the patent has not expired.

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

## 1416 Offer to Surrender and Return Original Patent

*37 CFR 1.178. 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 or declaration to that effect. The application may be accepted for examination in the absence of the original patent or the affidavit or declaration, 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.

An examination on the merits of the reissue application is made even though the offer to surrender the original patent, the actual surrender, or an affidavit or declaration to the effect that the original is lost or inaccessible, has not been received. However, in such case, the examiner should require the surrender or the affidavit or declaration in the first Office action. Either the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before the examiner can allow the reissue application.

Form paragraph 14.05 may be used to require an offer to surrender the original patent.

¶ *14.05 No Offer To Surrender Original Patent*

This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

**Examiner Note:**

An examination on the merits of the reissue application is made even though this requirement has not been met. This requirement should be made in the first Office action.

Form paragraph 14.05.01 may be used to notify applicant that the original patent or an affidavit or declaration as to loss is required before allowance.

¶ *14.05.01 Original Patent Required Prior to Allowance*

The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

**Examiner Note:**

1. This form paragraph may be used in an Office action to remind applicant of the requirement for submission of the original patent before allowance.

2. It may also be used in an *Ex parte Quayle* action to require such submission.

3. Do not use this form paragraph in an examiner's amendment. The original patent or declaration of loss must be filed prior to mailing of the "Notice of Allowability".

If applicant requests the return of the surrendered original patent upon abandonment of the reissue application, the original patent will be sent to the applicant by the Examining Group.

An applicant may request that a surrendered original patent be transferred from an abandoned reissue application to a continuation or divisional reissue application. The clerk making the transfer should note the transfer on the "Contents" of the abandoned application. The application number and filing date of the reissue application to which it is transferred must be

included in the notation. Where the original patent grant is not submitted with the reissue application as filed, patentee should include a copy of the printed original patent. Presence of a copy of the original patent is useful for the calculation of the reissue filing fee and for the verification of other identifying data.

Depending on the circumstances, PTO/SB/53 (Reissue Application By The Inventor, Offer To Surrender Patent), PTO/SB/54 (Reissue Application By The Assignee, Offer To Surrender Patent), or PTO/SB/55 (Declaration As To Loss Of Letters Patent) may be used for filing an offer to surrender the original patent or a declaration to the effect that the original patent is lost.

PTO/SB/53 (12-97)
Approved for use through 9/30/00. OMB 0651-0033
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 BY THE INVENTOR, OFFER TO SURRENDER PATENT | Docket Number (Optional) |
|---|---|

This is part of the application for a reissue patent based on the original patent identified below.

| Name of Patentee(s) | |
|---|---|
| Patent Number | Date Patent Issued |
| Title of Invention | |

I am the inventor of the original patent.

I offer to surrender the original patent.

1. ☐ Filed herein is a certificate under 37 CFR 3.73(b).

2. ☐ Ownership of the patent is in the inventor(s), and no assignment of the patent has been made.

One of boxes 1 or 2 above must be checked.

The written consent of all assignees owning an undivided interest in the original patent is included in this application for reissue.

| Signature | Date |
|---|---|
| Typed or printed name | |

The assignee owning an undivided interest in said original patent is _____, and the assignee consents to the accompanying application for reissue.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application, any patent issued thereon, or any patent to which this declaration is directed.

| Name of assignee | |
|---|---|
| Signature of person signing for assignee | Date |
| Typed or printed name and title of person signing for assignee | |

Burden Hour Statement: This form is estimated to take 0.1 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

PTO/SB/54 (12-97)
Approved for use through 9/30/00. OMB 0651-0033
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 BY THE ASSIGNEE, OFFER TO SURRENDER PATENT | Docket Number (Optional) |
|---|---|

This is part of the application for a reissue patent based on the original patent identified below.

Name of Patentee(s):

| Patent Number | Date Patent Issued |
|---|---|
| | |

Title of Invention

_____ is the assignee of the entire interest in the original patent.

I offer to surrender the original patent.

☐ A certificate under 37 CFR 3.73(b) is attached.

I am authorized to act on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application, any patent issued thereon, or any patent to which this declaration is directed.

Name of assignee

| Signature of person signing for assignee | Date |
|---|---|
| | |

Typed or printed name and title of person signing for assignee

Burden Hour Statement: This form is estimated to take 0.1 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

PTO/SB/55 (12-97)
Approved for use through 9/30/00. OMB 0651-0033
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.

| DECLARATION AS TO LOSS OF LETTERS PATENT | Docket Number (Optional) |
|---|---|

I hereby declare that:

I am the applicant for a reissue patent based on the original patent identified below.

Name of Patentee(s)

Patent Number

Title of Invention

Reissue application number (if known)

The said original patent is lost or inaccessible.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Signature

| Typed or printed name | Date |
|---|---|
| | |

Burden Hour Statement: This form is estimated to take 0.05 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

## 1417 Claim for Benefit Under 35 U.S.C. 119(a)–(d)

A "claim" for the benefit of an earlier filing date in a foreign country under 35 U.S.C. 119(a)–(d) must be made in a reissue application, even though such a claim was previously made in the application on which the original patent was granted. However, no additional certified copy of the foreign application is necessary. The procedure is similar to that for "Continuing Applications" in MPEP § 201.14(b).

In addition, 37 CFR 1.63 requires that in *any* application in which a claim for foreign priority is made pursuant to 37 CFR 1.55, the oath or declaration must identify the foreign application for patent or inventors' certificate on which priority is claimed, and any foreign applications having a filing date before that of the application on which priority is claimed, by specifying:

(A) the application number of the foreign application;

(B) the foreign country; and

(C) the day, month, and year of the filing of the foreign application.

The examiner should note that the heading on printed copies of the patent will not be carried forward to the reissue from the original patent. Therefore, it is important that the file wrapper be endorsed by the examiner under "FOREIGN APPLICATIONS."

## 1418 Information Disclosure Statement and Other Information

A reissue application is subject to the same duty of disclosure requirements as is any other nonprovisional application. The provisions of 37 CFR 1.63 require acknowledgment in the reissue oath or declaration of the "duty to disclose to the Office all information known to the [applicants] to be material to patentability as defined in § 1.56." Form paragraph 14.11.01 may be used to remind applicant of the duty to disclose any litigation information which is material to patentability.

¶ *14.11.01 Duty Of Disclosure Reminder*

Applicant is reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. [1] , which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

**Examiner Note:**

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

Reissue applicants may utilize 37 CFR 1.97 and 1.98 to comply with the duty of disclosure required by 37 CFR 1.56. This does not, however, relieve applicant of the duties under 37 CFR 1.175 of, for example, stating "at least one error being relied upon."

While 37 CFR 1.97(b) provides for filing an information disclosure statement within 3 months of the filing of an application or before the mailing date of a first Office action, reissue applicants are encouraged to file information disclosure statements at the time of filing so that such statements will be available to the public during the 2–month period provided by 37 CFR 1.176.

## 1430 Reissue Files Open to the Public and Notice of Filing Reissue Announced in *Official Gazette*

*37 CFR 1.11(b). Files open to the public.*

*****

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

*****

*37 CFR 1.176. 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, but not sooner than two months after announcement of the filing of the reissue application has appeared in the *Official Gazette*.

37 CFR 1.11(b) provides that all reissue applications filed after March 1, 1977 are open to inspection by the general public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications (except for continued prosecution applications (CPA's) filed under 37 CFR 1.53(d)) will be announced in the

*Official Gazette*. The announcement gives interested members of the public an opportunity to submit to the examiner information pertinent to the patentability of the reissue application. The announcement includes the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and the Examining Group to which the reissue application is initially assigned. A Group Director or other appropriate Office official may, under appropriate circumstances, postpone access to or the making of copies of a reissue application, such as, for example, to avoid interruption of the examination or other review of the application by an examiner. Those reissue applications already on file prior to March 1, 1977 are not automatically open to inspection, but a liberal policy is followed by the Office of the Assistant Commissioner for Patents in granting petitions for access to such applications.

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

The filing of a continued prosecution application (CPA) under 37 CFR 1.53(d) of a reissue application will not be announced in the *Official Gazette*. Although the filing of a CPA of a reissue application constitutes the filing of a reissue application, the announcement of the filing of such CPA would be redundant in view of the announcement of the filing of the prior reissue application in the *Official Gazette* and the fact that the same application number and file will continue to be used for the CPA.

For those reissue applications filed on or after March 1, 1977, the following procedure will be observed:

(A) The filing of all reissue applications, except for CPAs filed under 37 CFR 1.53(d), will be announced in the *Official Gazette* and will include certain identifying data as specified in 37 CFR 1.11(b). Any member of the general public may request access to a particular reissue application filed after March 1, 1977. Since no record of such request is intended to be kept, an oral request will suffice.

(B) The reissue application files will be maintained in the Examining Groups and inspection thereof will be supervised by Group personnel. Although no general limit is placed on the amount of time spent reviewing the files, the Office may impose limitations, if necessary, e.g., where the application is actively being processed.

(C) Where the reissue application has left the Examining Group for administrative processing, requests for access should be directed to the appropriate supervisory personnel where the application is currently located.

(D) Requests for copies of papers in the reissue application file must be in writing and addressed to the Commissioner of Patents and Trademarks, Box 10, Washington, D.C. 20231 and may be either mailed or delivered to the Office Customer Service Window (See MPEP § 502). The price for copies made by the Office is set forth in 37 CFR 1.19.

## 1431 Notice in Patent File

*37 CFR 1.179. 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.

Whenever a reissue application is filed, a Form PTO–445 notice is placed in the patented file identifying the reissue application by application number and its filing date. The pertinent data is filled in by the Office of Initial Patent Examination. When divisional or continuation reissue applications are filed, a separate form for each reissue application is placed in the original patent file. When the reissue is issued, it is important that the File Information Unit (Record Room) be informed by the Examining Group technical support staff of that fact by written memo. File Information Unit (Record Room) personnel will update the Form PTO–445 in the patented file.

## 1440 Examination of Reissue Application

*37 CFR 1.176. 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, but not sooner than two months after announcement of the filing of the reissue application has appeared in the *Official Gazette*.

37 CFR 1.176 provides that an original claim, if re-presented in a reissue application, will be subject to reexamination. Along with the entire application, the re-presented claim will be fully examined in the same manner subject to the same rules relating thereto, as if being presented for the first time in an original application, except that division will not be required by the examiner. See MPEP § 1450 and § 1451. Reissue applications are normally examined by the same examiner who issued the patent for which reissue is requested. In addition, the application will be examined with respect to compliance with 37 CFR 1.171-1.179 relating specifically to reissue applications, for example, the reissue oath or declaration will be carefully reviewed for compliance with 37 CFR 1.175. See MPEP § 1444 for handling applications in which the oath or declaration lacks compliance with 37 CFR 1.175. Reissue applications with related litigation will be acted on by the examiner before any other special applications, and will be acted on immediately by the examiner, subject only to the 2-month delay after publication for examining reissue applications.

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

## 1441 Two-Month Delay Period; Protest in Reissue Applications

37 CFR 1.176 provides that reissue applications will be acted on by the examiner in advance of other applications, i.e., "special," but not sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under 37 CFR 1.291(a). As set forth in MPEP § 1901.04, the public should be aware that such submissions should be made as early as possible, since under certain circumstances the 2-month delay period of 37 CFR 1.176 may be waived. The Office will entertain petitions under 37 CFR 1.183 which are accompanied by the required petition fee (37 CFR 1.17(h)) to waive the delay period of 37 CFR 1.176. Accordingly, protestors to reissue applications cannot automatically assume that the full 2-month delay period of 37 CFR 1.176 will always be available. Appropriate reasons for requesting a waiver of the 2-month delay period of 37 CFR 1.176 might be, for example, that litigation has been stayed to permit the filing of the reissue application. Such petitions are decided by the Office of the Deputy Assistant Commissioner for Patent Policy and Projects.

If the protest of a reissue application cannot be filed within the 2-month period provided by 37 CFR 1.176, the protest can be submitted at a later time. Where the protest is submitted after the 2-month period, no petition under 37 CFR 1.182 or 1.183 is needed with respect to the protest being submitted after the 2 months provided for in 37 CFR 1.176 unless a final rejection has been issued or prosecution on the merits has been closed for the reissue application.

Where the protest is submitted after the 2-month period, the protest might be received after the first Office action by the examiner, since reissue applications are taken up "special." Once the first Office action is mailed (after the 2-month period), a member of the public may still submit pertinent information in the form of a protest under 37 CFR 1.291(a), and the examiner will consider the information submitted in the next Office action, to the extent that such consideration is appropriate. See MPEP § 1901.04 and § 1901.06 for the timeliness and content criteria as to when a protest is considered.

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

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

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

## 1442 Special Status

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

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

## 1442.01 Litigation Related Reissues

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

Form paragraph 14.06 may be used for such an inquiry.

¶ *14.06 Litigation Related Reissue*

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

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

**Examiner Note:**

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

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

Where there is litigation, and it has not already been done, the examiner should place a prominent notation on the application file to indicate the litigation (1) at the bottom of the face of the file in the box just to the right of the box for the retention label, and (2) on the pink Reissue Notice Card form.

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

## 1442.02 Concurrent Litigation

In order to avoid duplication of effort, action in reissue applications in which there is an indication of concurrent litigation will be suspended automatically unless and until it is evident to the examiner, or the applicant indicates, that any one of the following applies:

(A) a stay of the litigation is in effect;

(B) the litigation has been terminated;

(C) there are no significant overlapping issues between the application and the litigation; or

(D) it is applicant's desire that the application be examined at that time.

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

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

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

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

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

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

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

Where none of (A) through (D) above apply, action in the reissue application in which there is an indication of concurrent litigation will be suspended by the examiner. The examiner should consult with the Group Special Program Examiner prior to suspending action in the reissue. Form paragraph 14.11 may be used to suspend action, i.e., stay action, in a reissue application with concurrent litigation.

¶ *14.11 Action in Reissue Stayed – Related Litigation*

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

If the reissue application has been merged with a reexamination proceeding, the merged proceeding generally will **not** be stayed where there is litigation. In a merged reexamination/reissue proceeding, the reexamination will control because of the *statutory* (35 U.S.C. 305) requirement that reexamination proceedings be conducted with special dispatch. See MPEP § 2285 and § 2286.

## 1442.03 Litigation Stayed

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

In reissue applications with "stayed litigation," the Office will entertain petitions under 37 CFR 1.183, which are accompanied by the fee under 37 CFR 1.17(h), to waive the 2–month delay period under 37 CFR 1.176. Such petitions are decided by the Office of the Deputy Assistant Commissioner for Patent Policy and Projects.

Time–monitoring systems have been put into effect which will closely monitor the time used by applicants, protestors, and examiners in processing reissue applications of patents involved in litigation in which the court has stayed further action. Monthly reports on the status of reissue applications with related litigation are required from each Examining Group. Delays in reissue processing are to be followed up. The Group Special Program Examiner is responsible for oversight of reissue applications with related litigation.

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

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

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

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

## 1442.04 Litigation Involving Patent

Where the patent for which reissue is being sought is, or has been, involved in litigation which raised a question material to patentability of the reissue application, such as the validity of the patent, the existence of such litigation must be brought to the attention of the Office by the applicant. This should be done at the time of, or shortly after, filing the application, either in the reissue oath or declaration, or in a separate paper, preferably accompanying the application as filed. Litigation begun after filing of the reissue application also should be promptly brought to the attention of the Office. The details and documents from the litigation, insofar as they are "material to patentability" of the reissue application as defined in 37 CFR 1.56(b), should accompany the application as filed, or be submitted as promptly thereafter as possible. For example, the defenses raised against validity of the patent would normally be "material to patentability" of the reissue application. It would, in most situations, be appropriate to bring such defenses to the attention of the Office by filing in the reissue application a copy of the Court papers raising such defenses. As a minimum, the applicant should call the attention of the Office to the litigation, the existence and nature of any allegations having a bearing on the validity of the original patent, and the nature of litigation materials relating to these issues. Enough information should be submitted to clearly in-

form the Office of the nature of these issues so that the Office can intelligently evaluate the need for asking for further materials in the litigation. Thus, the existence of supporting materials which may substantiate allegations of invalidity should, at least, be fully described, or submitted. The Office is not interested in receiving voluminous litigation materials which are not relevant to the Office's consideration of the reissue application. The status of the litigation should be updated in the reissue application as soon as significant events happen in the litigation.

When a reissue application is filed, the examiner should determine whether the original patent has been adjudicated by a court. The decision of the court, and also other papers in the suit, may provide 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. Such notices are required by law to be filed by the clerks of the Federal District Courts. These notices do not indicate if there was an opinion by the court, nor whether a decision was published. *Shepard's Federal Citations* and the cumulative digests of the *United States Patents Quarterly*, both of which are in the Lutrelle F. Parker, Sr., Memorial Law Library (located in Crystal Park 1–520), contain tables of patent numbers giving the citation of published decisions concerning the patent. A litigation computer search by the Scientific and Technical Information Center (STIC) should be requested by the examiner to determine whether the patent has been, or is, involved in litigation. The "Search Notes" box on the application file wrapper can then be completed to indicate that the review was conducted. A copy of the STIC search should be hole–punched and placed in the reissue file. Additional information or guidance as to making a litigation search may be obtained from the library of the Office of the Solicitor.

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

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

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

## 1442.05 Cases in Which Stays Were Considered

Federal District Courts stay litigation in significant numbers of cases to permit consideration of a reissue application by the Office. Several exemplary cases are listed here for the convenience of the Office, the courts and the public.

In most instances, the reissue–examination procedure is instituted by a patent owner who voluntarily files a reissue application as a consequence of related patent litigation. However, some District Courts have required a patentee–litigant to file a reissue application, for example:

*Alpine Engineering Inc. v. Automated Building Components Inc.*, BNA/PTCJ 367: A–12 (S.D. Fla. 1978);

*Lee–Boy Mfg. Co. v. Puckett*, 202 USPQ 573 (D. Ga. 1978);

*Choat v. Rome Industries Inc.* 203 USPQ 549 (N.D. Ga. 1979).

Other courts have declined to so order, for example:

*Bielomatik Leuze & Co., v. Southwest Tablet Mfg. Co.*, 204 USPQ 226 (N.D. Texas 1979);

*RCA Corp. v. Applied Digital Data Systems Inc.*, 201 USPQ 451 (D. Del. 1979);

*Antonious v. Kamata–Ri & Co. Ltd.*, 204 USPQ 294 (D. Md. 1979).

Only a patentee or his assignee may file a reissue patent application. An order for a different party to file a reissue will not be binding on the Office.

### 1442.05(a) Stays Granted

"Stays" of court or administrative proceedings in litigation were ordered in the following sampling of published decisions.

*PIC Inc. v. Prescon Corp.*, 195 USPQ 525 (D. Del. 1977).

*Fisher Controls Co. Inc. v. Control Components, Inc.*, 196 USPQ 817 (S.D. Iowa 1977) (Note also 203 USPQ 1059 denying discovery during the stay.).

*Alpine Engineering Inc. v. Automated Building Components Inc.*, BNA/PTCJ 367: A–12 (S.D. Fla. 1978) (dismissed a Declaratory Judgment suit with order for patentee to seek reissue in the Office).

*AMI Industries, Inc. v. E. A. Industries, Inc.*, 204 USPQ 568 (W.D. N.C.1978) (with dicta that if suit had not been dismissed, proceedings would have been stayed for Office consideration).

*Reynolds Metal Co. v. Aluminum Co. of America*, 198 USPQ 529 (N.D. Ind. 1978).

*Sauder Industries, Inc. v. Carborundum Co.*, 201 USPQ 240 (N.D. Ohio 1978).

*Rohm and Haas Co. v. Mobil Oil Corp.*, 201 USPQ 80 (D. Del. 1978) (with provision for limited discovery on allegations of fraud for Office's benefit).

*Lee–Boy Mfg. Co. v. Puckett*, 202 USPQ 573 (D. Ga. 1978) (reissue ordered after discovery and during wait for trial).

*Fas–Line Sales & Rentals, Inc. v. E–Z Lay Pipe Corp.*, 203 USPQ 497 (W.D. Okla. 1979).

*Choat v. Rome Industries Inc.*, 203 USPQ 549 (N.D. Ga. 1979) (directed patentee to file reissue application).

*In re Certain High–Voltage Circuit Interrupters and Components Thereof*, 204 USPQ 50 (Int'l Trade Comm'n 1979).

## 1442.05(b) Stays Denied

"Stays" of court or administrative proceedings in litigation were denied in the following sampling of published decisions.

*General Tire and Rubber Co. v. Watson–Bowman Associates, Inc.*, 193 USPQ 479 (D. Del. 1977).

*Perkin–Elmer Corp. v. Westinghouse Electric Corp.*, BNA/PTCJ 376: A–11 (E.D. N.Y. 1978).

*In re Certain Ceramic Tile Setters*, No. 337–TA–41, BNA/PTCJ 385: A–21 (Int'l Trade Comm'n 1978).

*E.C.H. Will v. Freundlich–Gomez Machinery Corp.*, 201 USPQ 476 (S.D. N.Y. 1978).

*RCA Corp. v. Applied Digital Data Systems Inc.*, 201 USPQ 451 (D. Del. 1979) (denied stay where a patentee had not filed a reissue).

*Bielomatik Leuze & Co., v. Southwest Tablet Mfg. Co.*, 204 USPQ 226 (N.D. Texas 1979) (refused to order reissue).

*Antonious v. Kamata–Ri & Co. Ltd.*, 204 USPQ 294 (D. Md. 1979) (refused to order reissue).

## 1443 Initial Examiner Review

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

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

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

The filing of all reissue applications, except for continued prosecution applications (CPAs) filed under 37 CFR 1.53(d), must be announced in the *Official Gazette*. Accordingly, for any reissue application other than a CPA, the examiner should determine if the filing of the reissue application has been announced in the *Official Gazette* as provided in 37 CFR 1.11(b), especially where the reissue is a file wrapper continuation under former 37 CFR 1.62. The date of the *Official Gazette* notice can usually be found on the pink "REISSUE" tag which protrudes from the top of the application file of 08 or earlier series. Where the date is missing from the tag, or where the tag itself is missing, the PALM screen (2952) should be

checked for the presence of an "NRE" entry in the contents. For 09 series reissue applications, the *Official Gazette* publication date appears on the face of the file wrapper. If the filing of the reissue application has not been announced in the *Official Gazette,* the reissue application should be returned to the Office of Initial Patent Examination (Special Processing) to handle the announcement. The examiner should not further act on the reissue until 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. See MPEP § 1440 and 37 CFR 1.176.

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

The examiner should determine if a protest has been filed, and if so, it should be handled as set forth in MPEP § 1901.06.

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

The examiner should check that an offer to surrender the original patent, or an affidavit or declaration to the effect that the original is lost or inaccessible, has been received. An examination on the merits is made even though the above has not been complied with, but the examiner should require compliance in the first office action. See MPEP § 1416.

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

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

## 1444 Review of Reissue Oath/Declaration

In accordance with 37 CFR 1.175, the following is required in the reissue oath/declaration:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid–

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

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

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

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

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

¶ *14.14 Rejection, Defective Reissue Oath or Declaration*

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

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

**Examiner Note:**

1. In bracket 1, list all claims in the reissue application. See MPEP § 706.03(x).
2. This paragraph should be preceded by at least one of the paragraphs 14.01 to 14.01.04.
3. In brackets 2 and 3, insert either --oath-- or --declaration--.

A lack of signature on a reissue oath/declaration would be considered a lack of compliance with 37 CFR 1.175(a) and result in a rejection, including final rejection, of all the claims on the basis that the reissue oath/declaration is insufficient. If the unsigned reissue oath/declaration is submitted as part of a reply which is otherwise properly signed and responsive to the outstanding Office action, the reply should be accepted by the examiner as proper and responsive, and the oath/declara-

tion considered fully in the next Office action. The reply should not be treated as an unsigned or improperly signed amendment (see MPEP § 714.01(a)), nor do the provisions of *Ex Parte Quayle* apply in this situation. The lack of signature, along with any other oath/declaration deficiencies, should be noted in the next Office action *rejecting* the claims as being based upon an insufficient reissue oath/declaration.

**HANDLING OF THE REISSUE OATH/DECLARATION DURING THE REISSUE PROCEEDING**

An initial reissue oath/declaration is submitted with the reissue application. Where the reissue oath/declaration fails to comply with 37 CFR 1.175(a), the examiner will so notify the applicant in an Office action, rejecting the claims under 35 U.S.C. 251 as discussed above. In reply to the Office action, a supplemental reissue oath/declaration should be submitted dealing with the noted defects in the reissue oath/declaration.

Where the initial reissue oath/declaration (1) failed to provide *any* error statement, or (2) attempted to provide an error statement, but failed to identify any error under 35 U.S.C. 251 upon which reissue can be based (see MPEP § 1402), the examiner should reject all the claims as being based upon a defective reissue oath/declaration under 35 U.S.C. 251. To support the rejection, the examiner should point out the failure of the initial oath/declaration to comply with 37 CFR 1.175 because an error under 35 U.S.C. 251 upon which reissue can be based was not identified therein. In reply to the rejection under 35 U.S.C. 251, a supplemental reissue oath/declaration must be submitted stating an error under 35 U.S.C. 251 which can be relied upon to support the reissue application. Submission of this supplemental reissue oath/declaration to obviate the rejection cannot be deferred by applicant until the application is otherwise in condition for allowance. In this instance, a proper statement of error *was never provided in the initial reissue oath/declaration,* thus a supplemental oath/declaration is required *in reply to the Office action* in order to properly establish grounds for reissue.

A different situation may arise where the initial reissue oath/declaration does properly identify one or more errors under 35 U.S.C. 251 as being the basis for reissue, however, because of changes or amendments made during prosecution, none of the identified errors are relied upon any more. A supplemental oath/declaration will be needed to identify at least one error *now* being relied upon as the basis for reissue, even though the prior oath/declaration was found proper by the examiner. The supplemental oath/declaration need *not* also indicate that the error(s) identified in the prior oath(s)/declaration(s) is/are no longer being corrected. In this instance, applicant's submission of the supplemental reissue oath/declaration to obviate the rejection under 35 U.S.C. 251 can, at applicant's option, be deferred until the application is otherwise in condition for allowance. The submission can be deferred because a proper statement of error was provided in the initial reissue oath/declaration. Applicant need only request that submission of the supplemental reissue oath/declaration be deferred until allowance, and such a request will be considered a complete reply to the rejection.

**SUPPLEMENTAL REISSUE OATH/DECLARATION UNDER 37 CFR 1.175(b)(1):**

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

See MPEP § 1414.01 for a discussion of the required content of a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1).

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

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

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

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

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

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

¶ *14.05.02 Supplemental Oath or Declaration Required Prior to Allowance*

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

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

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

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

**Examiner Note:**

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

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

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

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

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

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

Where the application is in condition for allowance and **no amendments or other corrections of error in the patent have been made subsequent to the last oath/declaration** filed in the application, a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) **should not be required by the examiner.** Instead, the examiner should issue a Notice of Allowability indicating allowance of the claims.

## AFTER ALLOWANCE

Where applicant seeks to correct an error after allowance of the application, any amendment of the patent correcting the error must be submitted in accordance with 37 CFR 1.312. As set forth in 37 CFR 1.312, no amendment may be made as a matter of right in an application after the mailing of the notice of allowance. An amendment filed before the payment of the issue fee may be entered on the recommendation of the primary examiner, approved by the supervisory patent examiner, without withdrawing the case from issue. An amendment filed after the date the issue fee is paid must be accompanied by a petition including the fee set forth in 37 CFR 1.17(i) and a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. This petition is decided by the Group Director.

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

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

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

Occasionally an error to be corrected after allowance does not include an amendment of the specification or claims of the patent. For example, the correction of the error could be the filing of a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119 (see *Brenner v. State of Israel,* 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968)). In such a case, the requirements of 37 CFR 1.312 must still be met. This is so, because the correction of the patent is an amendment of the patent, even though no amendment is physically entered into the case. Thus, for a reissue oath/declaration submitted after allowance to correct an additional error (or errors), the reissue applicant must comply with 37 CFR 1.312 in the manner discussed above.

## 1445 Reissue Application Examined in Same Manner as Original Application

As stated in 37 CFR 1.176, a reissue application, including all the claims therein, is subject to "be examined in the same manner as original applications." Accordingly, the claims in a reissue application are subject to any and all rejections which the examiner deems appropriate. It does not matter whether the claims are identical to those of the patent or changed from those in the patent. It also does not matter that a rejection was not made in the prosecution of the patent, or could have been made, or was in fact made and dropped during prosecution of the patent; the prior action in the prosecution of the patent does not prevent that rejection from being made in the reissue application. Claims in a reissue application enjoy no "presumption of validity." *In re Doyle*, 482 F.2d 1385, 1392, 179 USPQ 227, 232–233 (CCPA 1973); *In re Sneed*, 710 F.2d 1544, 1550 n.4, 218 USPQ 385, 389 n.4 (Fed. Cir. 1983). Likewise, the fact that during prosecution of the patent the examiner considered, may have considered, or should have considered information such as, for example, a specific prior art document, does not have any bearing on or prevent its use as prior art during prosecution of the reissue application.

## 1448 Fraud, Inequitable Conduct, or Duty of Disclosure Issues

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

### ADMISSION OR JUDICIAL DETERMINATION

An admission or judicial determination of fraud, inequitable conduct, or violation of the duty of disclosure is a special circumstance, because no investigation need be made. Accordingly, after consulting with the Group Special Program Examiner, a rejection should be made using the appropriate one of form paragraphs 14.21.09 or 14.22 as reproduced below.

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

be withdrawn. Alternatively, if applicant argues that the admission noted by the examiner was not in fact an admission, the rejection should also be withdrawn.

Form Paragraph 14.21.09 should be used where the examiner becomes aware of a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant **independently of the record of the case,** i.e., the examiner has external knowledge of the judicial determination.

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

¶ *14.21.09 Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention – External Knowledge*

Claims [1] rejected under 35 U.S.C. 251 since error "without any deceptive intention" has not been established. In view of the judicial determination in [2] of [3] on the part of applicant, a conclusion that any error was "without deceptive intention" cannot be supported. [4]

**Examiner Note:**

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, list the Court or administrative body which made the judicial determination of fraud or inequitable conduct on the part of applicant.
3. In bracket 3, insert --fraud--, --inequitable conduct-- and/or --violation of duty of disclosure--.
4. In bracket 4, point out where in the opinion (or holding) of the Court or administrative body the judicial determination of fraud, inequitable conduct or violation of duty of disclosure is set forth. Page number, column number, and paragraph information should be given as to the opinion (or holding) of the Court or administrative body. The examiner may add explanatory comments.

¶ *14.22 Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention–Evidence in the Application*

Claims [1] rejected under 35 U.S.C. 251 since error "without any deceptive intention" has not been established. In view of Paper No. [2], filed [3], a conclusion that any error was "without deceptive intention" cannot be supported.

[4]

**Examiner Note:**

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert the paper number providing an admission of fraud, inequitable conduct or violation of duty of disclosure, or that there was a judicial determination of same.
3. In bracket 3, insert the filing date of the paper.
4. In bracket 4, insert a statement that there has been an admission or a judicial determination of fraud, inequitable conduct or violation of duty of disclosure which provide circumstances why applicant's statement in the oath or declaration of lack of deceptive intent should not be taken as dispositive. Any admission of fraud, inequitable conduct or violation of duty of disclosure must be explicit, unequivocal, and not subject to other interpretation.

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

## 1449 Protest Filed in Reissue Where Patent Is in Interference

If a protest is filed in a reissue application related to a patent involved in a pending interference proceeding, the reissue application should be referred to the Special Program Law Office (SPLO) before considering the protest and acting on the application.

The SPLO will check to see that:

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

(B) the Office does not allow claims in the reissue which are unpatentable over the pending interference count(s), or found unpatentable in the interference proceeding.

## 1449.01 Concurrent Office Proceedings

37 CFR 1.565(d) provides that if "a reissue application and a reexamination proceeding on which an order pursuant to 37 CFR 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings." If an examiner becomes aware that a reissue application and a reexamination proceeding are both pending for the same patent, he or she should inform the Group Special Program Examiner immediately.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, *and an order granting reexamination has been issued* for the reexamination proceeding, the files for the reissue application and the reexamination will be forwarded to the Office of the Deputy Assistant Commissioner for Patent Policy and Projects for a decision whether to merge the reissue and the reexamination, or stay one of the two. See *In re Onda,* 229 USPQ 235 (Comm'r Pat. 1985). See also MPEP § 2285.

If the original patent is involved in an interference, the examiner must consult the administrative patent judge in charge of the interference before taking any action on the reissue application. It is particularly important that

the reissue application not be granted without the administrative patent judge's approval. See MPEP § 2360.

## 1450 Restriction and Election of Species

The examiner may **not** require restriction in a reissue application (37 CFR 1.176 and MPEP § 1440). Even where the original patent contains claims to different inventions which the examiner considers independent and distinct, and the reissue application claims the same inventions, the examiner should not require restriction between them or take any other action with respect to the question of plural inventions. Restriction may only be requested by the applicant (37 CFR 1.177 and MPEP § 1451). In situations where a reissue applicant presents claims for the first time that are distinct and separate from the claims of the patent, the examiner must follow the practice resulting from *In re Amos,* 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) as set forth in MPEP § 1412.01.

A reissue applicant's failure to timely file a divisional application is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such error is not correctable by reissue of the original patent under 35 U.S.C. 251. *In re Watkinson,* 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita,* 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). See also *In re Mead,* 581 F. 2d 251, 198 USPQ 412 (CCPA 1978). Likewise, if the original patent specification shows an intent not to claim the newly presented invention, that invention cannot be added by reissue. In these situations, the reissue claims should be rejected under 35 U.S.C. 251 for lack of defect in the original patent and lack of error in obtaining the original patent. See also MPEP § 1412.01.

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, where appropriate, for lack of defect in the original patent and lack of error in obtaining the original patent as discussed above.

## 1451 Divisional Reissue Applications; Continuation Reissue Applications Where the Parent is Pending

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

*****

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.

*****

*37 CFR 1.177. Reissue in divisions.*

The Commissioner may, in his or her 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 §§ 1.83 and 1.84. On filing divisional reissue applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner upon petition and payment of the fee set forth in § 1.17(i), all the divisions of a reissue will issue simultaneously; if there is any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner orders otherwise.

Questions relating to the propriety of divisional reissue applications and continuation reissue applications should be referred via the Group Special Program Examiner to the Special Program Law Office.

### DIVISIONAL REISSUE APPLICATIONS

As is pointed out in MPEP § 1450, the examiner cannot require restriction in a reissue application; only applicant can initiate a division of the claims by demand in accordance with 37 CFR 1.177. Where the original patent claims contain several independent and distinct inventions, they can be divided into separate divisional reissues if the applicant demands it. 37 CFR 1.177 sets forth a possibility for filing divisional reissue applications.

When divisional reissue applications are filed, appropriate amendments to the continuing data entries are to be made to the first sentence of the specification, and to the file wrappers, for all such applications, so that all "sibling" divisional reissue applications are specifically identified and notice is provided of all the "siblings."

Situations yielding divisional reissues occur infrequently and usually involve only two such files. It should

be noted, however, that in rare instances in the past, there have been more than two (and as many as five) divisional reissues of a patent.

### CONTINUATION REISSUE APPLICATIONS

A continuation of a reissue is by definition not "for distinct and separate parts of the thing patented" as called for in the second paragraph of 35 U.S.C. 251. The decision of *In re Graff,* 111 F.3d 874, 42 USPQ2d 1471 (Fed. Cir. 1997) interprets 35 U.S.C. 251 to permit multiple reissue patents to issue even where the multiple reissue patents are not for "distinct and separate parts of the thing patented." The court stated:

> Section 251[2] is plainly intended as enabling, not as limiting. Section 251[2] has the effect of assuring that a different burden is not placed on divisional or continuation reissue applications, compared with divisions and continuations of original applications, by codifying the Supreme Court decision which recognized that more than one patent can result from a reissue proceeding. Thus § 251[2] places no greater burden on Mr. Graff's continuation reissue application than upon a continuation of an original application; § 251[2] neither overrides, enlarges, nor limits the statement in § 251[3] that the provisions of Title 35 apply to reissues.

111 F.3d at 877, 42 USPQ2d at 1473. Accordingly, a continuation of a reissue application will be permitted to issue (despite the presence of the parent reissue) where the continuation complies with the rules for reissue.

The parent and the continuation reissue applications should be examined together if possible. An appropriate amendment to the continuing data entries is to be made to the first sentence of the specification, and to the file wrappers, for *both the parent and the continuation* reissue applications, so that the parent–continuation relationship of the reissue applications is specifically identified and notice is provided of both reissue applications.

Where the parent reissue application issues prior to the examination of the continuation, the claims of the continuation should be carefully reviewed for double patenting over the claims of the parent. Where the parent and the continuation reissue applications are examined together, a provisional double patenting rejection should be made in both cases as to any overlapping claims. See MPEP § 804 – § 804.04 as to double patenting rejections.

If the parent reissue application issues without any cross reference to the continuation, amendment of the parent reissue patent to include a cross–reference to the continuation should be required, which applicant should do by requesting a Certificate of Correction.

## 1453 Amendments to Reissue Applications

*37 CFR 1.121. Manner of making amendments.*

*****

(b) *Amendments in reissue applications*: Amendments in reissue applications are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(1) *Specification other than the claims.* Amendments to the specification, other than to the claims, may only be made as follows:

(i) Amendments must be made by submission of the entire text of a newly added or rewritten paragraph(s) with markings pursuant to paragraph (b)(1)(iii) 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.

(ii) The precise point in the specification must be indicated where the paragraph to be amended is located.

(iii) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the amendments being made.

(2) *Claims.* Amendments to the claims may only be made as follows:

(i)(A) The amendment must be made relative to the patent claims in accordance with paragraph (b)(6) of this section and must include the entire text of each claim which is being amended by the current amendment and of each claim being added by the current amendment with markings pursuant to paragraph (b)(2)(i)(C) of this section, except that a patent claim or added claim should be cancelled by a statement cancelling the patent claim or added claim without presentation of the text of the patent claim or added claim.

(B) Patent claims must not be renumbered and the numbering of any claims added to the patent must follow the number of the highest numbered patent claim.

(C) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the amendments being made. If a claim is amended pursuant to paragraph (b)(2)(i)(A) of this section, a parenthetical expression "amended," "twice amended," *etc.*, should follow the original claim number.

(ii) Each amendment submission must set forth the status (*i.e.*, pending or cancelled) as of the date of the amendment, of all patent claims and of all added claims.

(iii) Each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment along with any additional comments on page(s) separate from the page(s) containing the amendment.

(3) *Drawings.*

(i) Amendments to the original patent drawings are not permitted. Any change to the patent drawings must be by way of a new sheet of drawings with the amended figures identified as "amended" and with added figures identified as "new" for each sheet changed submitted in compliance with § 1.84.

(ii) Where a change to the drawings is desired, a sketch in permanent ink showing proposed changes in red, to become part of the record, must be filed for approval by the examiner and should be in a separate paper.

(4) The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(5) No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251. No amendment to the patent may introduce new matter or be made in an expired patent.

(6) All amendments must be made relative to the patent specification, including the claims, and drawings, which is in effect as of the date of filing of the reissue application.

*****

The provisions of 37 CFR 1.121(b) apply to amendments in reissue applications. The practice outlined in this section must be complied with for any amendment submitted in a reissue application on or after December 1, 1997.

Amendments submitted before December 1, 1997 (under the prior practice) need not, and should not, be re-submitted under the current practice. However, if an amendment *is in fact re-submitted,* it will be entered, unless non-entry is directed or approved by the SPE or SPRE.

**THE SPECIFICATION**

37 CFR 1.121(b)(1) relates to the manner of making amendments to the specification other than the claims. It is not to be used for making amendments to the claims or the drawings.

37 CFR 1.121 (b)(1)(i) requires that all amendments which include any deletions or additions must be made by submission of a copy of each rewritten paragraph with markings (brackets and underlining), with the exception that an entire paragraph of specification text may be deleted by a statement deleting the paragraph *without presentation of the text of the paragraph.* 37 CFR 1.121 (b)(1)(i) also requires that all paragraphs which are *added* to the specification be submitted as completely underlined. In 37 CFR 1.121(b)(1)(ii), it is required that the precise point where each amendment is made must be indicated by applicant. 37 CFR 1.121(b)(1)(iii) defines the markings set forth in (b)(1)(ii) as being brackets for deletion and underlining for addition.

All bracketing and underlining is made in comparison to the original patent, not in comparison to the prior amendment.

Where a change is made in one sentence, paragraph or page, and the change increases or decreases the size of the sentence, paragraph or page, this will have no effect on the body of the reissue specification. This is because all insertions are made as blocked additions of paragraphs, which are not physically inserted within the specification papers. Rather, each blocked paragraph is assigned a letter and number, and a caret written in the specification papers indicates where the blocked paragraph is to be incorporated. In view of this, a reissue applicant need not be concerned with page formatting considerations when presenting amendments to the Office.

**THE CLAIMS**

37 CFR 1.121(b)(2) relates to the manner of making amendments to the claims in reissue applications. It is not to be used for making amendments to the remainder of the specification or to the drawings.

The provisions of 37 CFR 1.121(b)(2)(i)(A) require:

(A) For each claim that is being amended *by the amendment being submitted* (the current amendment), the entire text of the claim must be presented with markings;

(B) For each new claim added to the reissue *by the amendment being submitted* (the current amendment), the entire text of the added claim must be presented;

(C) A patent claim should be canceled by a direction to cancel that claim; there is no need to present the patent claim surrounded by brackets; and

(D) A new claim (previously added in the reissue) should be canceled by a direction to cancel that claim.

37 CFR 1.121(b)(2)(i)(B) states that original patent claims must not be renumbered. A patent claim retains its number even if it is cancelled in the reissue proceeding, and the numbering of any added claims must begin after the last original patent claim. 37 CFR 1.121(b)(2)(i)(C) identifies the type of marking required by reference to 37 CFR 1.121(b)(2)(i)(A), i.e., underlining for added material and single brackets for material deleted.

In accordance with 37 CFR 1.121(b)(2)(ii), each amendment submitted must set forth the status of all patent claims and all added claims as of the date of the submission. The status to be set forth is whether the claim is pending or canceled. The failure to submit the claim status will generally result in a notification to applicant that the amendment *prior to final rejection* is not

completely responsive (see 37 CFR 1.135(c)). Such an amendment *after final rejection* will not be entered.

In accordance with 37 CFR 1.121(b)(2)(iii), each claim amendment must be accompanied by an explanation of the support in the disclosure of the patent for the amendment (i.e., support for the changes made in the claim(s), including support for any insertions **and deletions**). The failure to submit an explanation will generally result in a notification to applicant that the amendment *prior to final rejection* is not completely responsive (see 37 CFR 1.135(c)). Such an amendment *after final rejection* will not be entered. Finally, 37 CFR 1.121(b)(5) provides that:

(A) No reissue patent shall be granted enlarging the scope of the claims, unless applied for within two years from the grant of the original patent,

(B) no amendment may introduce new matter, and

(C) no amendment may be made in an expired patent.

See MPEP § 1412.03 for further discussion as to the time limitation on enlarging the scope of the patent claims in a reissue application.

## THE DRAWINGS

37 CFR 1.121(b)(3) relates to the manner of making amendments to the drawings.

In 37 CFR 1.121(b)(3), it is clarified that amendments to the original patent drawings are not permitted, and that any change must be by way of a new sheet of drawings with the amended figures being identified as "amended" and with added figures identified as "new" for each sheet that has changed. See also MPEP § 1413 for a further discussion as to the drawings.

Form paragraph 14.20.01 may be used to advise applicant of the proper manner of making amendments in a reissue application.

¶ *14.20.01 Amendments To Reissue–37 CFR 1.121(b)*

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.121(b).

**Examiner Note:**

This form paragraph may be used in the first Office action to advise applicant of the proper manner of making amendments.

Form paragraph 14.21.01 may be used to notify applicant that proposed amendments **filed prior to final rejection** in the reissue application do not comply with 37 CFR 1.121(b).

¶ *14.21.01 Improper Amendment To Reissue – 37 CFR 1.121(b)*

The amendment filed [1] proposes amendments to [2] that do not comply with 37 CFR 1.121(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

A shortened statutory period for reply to this letter is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

**Examiner Note:**

This paragraph may be used for any 37 CFR 1.121(b) informality as to an amendment submitted in a reissue application prior to final rejection. After final rejection, applicant should be informed that the amendment will not be entered in an Advisory Office action.

Note that if an informal amendment is submitted **after final rejection,** form paragraph 14.21.01 should not be used. Rather, an advisory Office action should be issued using Form PTO–303 indicating that the amendment was not entered because it does not comply with 37 CFR 1.121(b), which sets forth the manner of making amendments in reissue applications.

## ALL CHANGES ARE MADE *VIS–A–VIS* THE PATENT TO BE REISSUED

When a reissue patent is printed, all underlined matter is printed in *italics* and all brackets are printed as inserted in the application, in order to show exactly which additions and deletions have been made to the patent being reissued. Therefore, all underlining and bracketing in the reissue application should be made relative to the text of the patent, as follows. In accordance with 37 CFR 1.121(b)(6), all amendments in the reissue application must be made relative to (i.e., *vis–a–vis*) the patent specification in effect as of the date of the filing of the reissue application. The patent specification includes the claims and drawings. If there was a prior change to the patent (made via a prior concluded reexamination certificate, reissue of the patent, certificate of correction, etc.), the first amendment of the subject reissue application must be made relative to the patent specification as changed by the prior proceeding or other mechanism for changing the patent. All amendments subsequent to the first amendment must also be made relative to the patent specification in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment.

*The Subject Patent Already Has Underlining or Bracketing*

If the original (or previously changed) patent includes a formula or equation already having underlining or bracketing therein as part of the formula or equation, any amendment of such formula or equation should be made by bracketing the entire formula and rewriting and totally underlining the amended formula in the re-presented paragraph of the specification or rewritten claim in which the changed formula or equation appears. Amendments of segments of a formula or equation should not be made. If the original patent includes bracketing and underlining from an earlier reexamination or reissue, double brackets and double underlining should be used in the subject reissue application to identify and distinguish the present changes being made. The subject reissue, when printed, would include double brackets (indicating deletions made in the subject reissue) and boldface type (indicating material added in the subject reissue).

**EXAMPLES OF PROPER AMENDMENTS**

A substantial number of problems arise in the Office because of improper submission of amendments in reissue applications. The following examples are provided to assist in preparation of proper amendments to reissue applications.

*Original Patent Description or Patent Claim Amended*

Example (1)

If it is desired to change the specification at column 4 line 23, to replace "is" with --are--, submit a copy of the entire paragraph of specification of the patent being amended with underlining and bracketing, and point out where the paragraph is located, e.g.,

> Replace the paragraph beginning at column 4, line 23 with the following:
>
> Scanning [is] are controlled by clocks which are, in turn, controlled from the display tube line synchronization. The signals resulting from scanning the scope of the character are delivered in parallel, then converted into serial mode through a shift register wherein the shift signal frequency is controlled by a clock that is, in turn, controlled from the display tube line synchronization.

Example (2)

For changes to the claims, one must submit a copy of the entire patent claim with the amendments shown by underlining and bracketing, e.g.,

> Amend claim 6 as follows:
>
> Claim 6 (Amended). The apparatus of claim [5] 1 wherein the [first] second piezoelectric element is parallel to the [second] third piezoelectric element.

If the dependency of any original patent claim is to be changed by amendment, it is proper to make that original patent claim dependent upon a later filed higher numbered claim.

*Cancellation of Claim(s)*

Example (3)

To cancel an original patent claim, in writing, direct cancellation of the patent claim, e.g.,

> Cancel claim 6.

Example (4)

To cancel a new claim (previously added in the reissue), in writing, direct cancellation of the new claim, e.g.,

> Cancel claim 15.

*Presentation of New Claims*

Example (5)

Each new claim (i.e., a claim not found in the patent, that is newly presented in the reissue application) should be presented with underlining throughout the claim, e.g.,

> Add claim 7 as follows:
>
> Claim 7. The apparatus of claim 5 further comprising electrodes attaching to said opposite faces of the first and second piezoelectric elements.

Even though original claims may have been canceled, the numbering of the original claims does not change. Accordingly, any added claims are numbered beginning with the number next higher than the number of claims in the original patent. If new claims have been added to the reissue application which are later canceled prior to issuance of the reissue patent, the examiner will renumber any remaining new claims in numerical order to follow the number of claims in the original patent.

*Amendment of New Claims*

An amendment of a "new claim" (i.e., a claim not found in the patent, that was previously presented in the reissue application) must be done by presenting the amended "new claim" containing the amendatory material, and completely underlining the claim. The presentation cannot contain any bracketing or other indication of what was in the previous version of the claim. This is because all changes in the reissue are made *vis–a–vis* the original patent, and not in comparison to the prior amendment. Although the presentation of the amended claim does not contain any indication of what is changed from the previous version of the claim, applicant must point out what is changed, in the "Remarks" portion of the amendment. Also, as per 37 CFR 1.121(b)(2)(C)(iii), each change made in the claim must be accompanied by an explanation of the support in the disclosure of the patent for the change.

*Amendment of Original Patent Claims More Than Once*

The following illustrates proper claim amendment of original patent claims in reissue applications:

A. Patent claim.

Claim 1. A cutting means having a handle portion and a blade portion.

B. Proper first amendment format.

Claim 1 (Amended). A [cutting means] knife having a bone handle portion and a notched blade portion.

C. Proper second amendment format.

Claim 1 (Twice Amended). A [cutting means] knife having a handle portion and a serrated blade portion.

Note that the second amendment must include the changes previously presented in the first amendment, i.e., [cutting means] knife, as well as the new changes presented in the second amendment, i.e., serrated.

The word bone was presented in the first amendment and is now to be deleted in the second amendment. The word "bone" is NOT to be shown in brackets in the second amendment. Rather, the word "bone" is simply omitted from the claim, since "bone" never appeared in the patent. An explanation of the deletion should appear in the remarks.

The word notched which was presented in the first amendment is replaced by the word serrated in the second amendment. The word notched is being deleted in the second amendment and did not appear in the patent; accordingly, "notched" is not shown in any form in the claim. The word serrated is being added in the second amendment, and accordingly "serrated" is added to the claim and is underlined.

In the second amendment, the deletions of "notched" and "bone" are not changes from the original patent claim text and therefore are not shown in brackets in the second amendment. In both the first and the second amendments, the entire claim is presented only with the changes from the original patent text.

## 1454 Appeal Brief

The requirements for an appeal brief are set forth in 37 CFR 1.192 and MPEP § 1206, and they apply to a reissue application in the same manner that they apply to a non–reissue application. There is, however, a difference in practice as to presentation of the copy of the claims in the appeal brief for a reissue application. The claims on appeal presented in an appeal brief for a reissue application should include all underlining and bracketing necessary to reflect the changes made to the patent claims during the prosecution of the reissue application. In addition, any new claims added in the reissue application should be completely underlined.

## 1455 Allowance and Issue

**"BLUE SLIP"**

In all reissue applications prepared for issue, the patent number of the original patent which is being reissued should be placed in the box provided therefor below the box for the applicant's name on the blue Issue Classification Slip (form PTO–270). Otherwise, the Issue Classification Slip is prepared in the same manner as for a non–reissue application.

For 09/ series applications, the patent number of the original patent which is being reissued should be placed on the face of the file wrapper above the box "PREPARED AND APPROVED FOR ISSUE" just after "(Exr. Initials)" in the line reading "SURRENDER OF ORIGINAL PATENT_____(Exr. Initials)."

**CHANGES TO THE ORIGINAL PATENT**

The specifications of reissue patents will be printed in such a manner as to show the changes over the original

patent text by enclosing any material omitted by the reissue in heavy brackets [ ] and printing material added by the reissue in *italics*. 37 CFR 1.173 (see MPEP § 1411) requires the specification of a reissue application to be presented in a specified form, specifically designed to facilitate this different manner of printing, as well as for other reasons.

The printed reissue patent specification will carry the following heading, which will be added by the Publishing Division of the Office of Patent Publication:

> "Matter enclosed in heavy brackets [ ] appears in the original patent but forms no part of this reissue specification; matter printed in italics indicates the additions made by reissue."

The examiners should see that the specification is in proper form for printing. Examiners should carefully check the entry of all amendments to ensure that the changes directed by applicant will be accurately printed in any reissue patent that may ultimately issue. Matter appearing in the original patent which is omitted by reissue should be enclosed in heavy brackets, while matter added by reissue should be underlined.

Any material added by amendment in the reissue application which is later canceled should be crossed through, *and not bracketed*. Material cancelled from the original patent should be enclosed in brackets, *and not lined through.*

All the claims of the original patent should appear in the reissue patent, with canceled patent claims being enclosed in brackets.

## CLAIM NUMBERING

No renumbering of the original patent claims is permitted, even if the dependency of a dependent patent claim is changed by reissue so that it is to be dependent on a subsequent higher numbered claim.

When a dependent claim in a reissue application depends upon a claim which has been canceled, and the dependent claim is not thereafter made dependent upon a pending claim, such a dependent claim must be rewritten in independent form.

New claims added during the prosecution of the reissue application should follow the number of the highest numbered patent claim and should be completely underlined to indicate they are to be printed in italics. Often, as a result of the prosecution and examination, some new claims are canceled while other new claims remain. When the reissue is allowed, any claims remaining which are additional to the patent claims (i.e., claims added via the reissue) should be 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 correspond to the number of the last claim in the reissue application, as allowed.

## CLAIM DESIGNATED FOR PRINTING

At least one claim of an allowable reissue application must be designated for printing in the *Official Gazette.* Whenever at least one claim has been amended or added in the reissue, the claim (claims) designated must be (or include) a claim which has been changed or added by the reissue. A canceled claim is not to be designated as the claim for the *Official Gazette.*

If there is no change in the claims of the allowable reissue application (i.e., they are the same as the claims of the original patent) or, if the only change in the claims is the cancellation of claims, then the most representative pending *allowed* claim is designated for printing in the *Official Gazette.*

## PROVIDING PROPER FORMAT

Where a reissue application has not been prepared in the above–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 added claims.

## PARENT APPLICATION DATA

All parent application data on the front face of the original patent file wrapper should be placed on the front face of the reissue file wrapper, if it is still proper.

It sometimes happens that the reissue is a continuation of another reissue application, and there is also original–patent parent application data. The examiner should ensure that the parent application data on the original patent is properly combined with the parent application data of the reissue, in the text of the specification and on the front face of the reissue file wrapper. The combined statement as to parent application data should be checked carefully for proper bracketing and underlining.

**REFERENCES CITED AND PRINTED**

The list of references to be printed in the reissue patent should include both the references cited during the original prosecution as well as the references cited during the prosecution of the reissue application. A patent cannot be reissued solely for the purpose of adding citations of additional prior art.

**TRANSFER OF DRAWINGS**

Where there are no formal drawings in the reissue application, the examiner should carefully inspect the reissue file for the presence of a request by applicant to transfer the drawings from the patent to the reissue application. If the request is present, the drawings should be transferred at the time of allowance, with the appropriate transfer notation being made on the patent file and the reissue file. See MPEP § 1413.

**EXAMINER'S AMENDMENT AND SUPPLEMENTAL DECLARATION**

When it is necessary to amend the reissue application in order to place the application in condition for allowance, the examiner may:

(A) request that applicant provide the amendments (e.g., by facsimile transmission or by hand–carry); or

(B) make the amendments, with the applicant's approval, by a formal examiner's amendment.

If the changes are made by a formal examiner's amendment, the *entire* paragraph(s) or claim(s) being amended must be presented in rewritten form for any deletions or additions (other than the cancellation of a claim or deletion of a paragraph, where *instructions* to delete the entire paragraph or claim would be sufficient). See MPEP § 1453. An examiner's amendment must comply with 37 CFR 1.121(b) in the same manner as an amendment submitted by applicant must comply with 37 CFR 1.121(b). Even where the amendments to the claims or specification are minor in nature, the examiner's amendment must present the *entire* claim(s) or the *entire* paragraph(s) being amended in rewritten form for any deletions or additions.

If it is necessary to amend a claim or the specification in order to correct an "error" under 35 U.S.C. 251 and thereby place the application in condition for allowance, then a supplemental oath or declaration will be required. See MPEP § 1444. The examiner should telephone applicant and request the supplemental oath or declaration, which must be filed before the application can be counted as an allowance.

## 1456 Reissue Review

All reissue applications are monitored and reviewed in the Examining Groups by the Office of the Special Program Examiner (includes SPRE, paralegal or other technical support who might be assigned as backup) at several stages during the prosecution. In order to ensure that SPREs are aware of the reissue applications in their groups, a pair of terminal–specific PALM flags have been created which must be set by the SPRE before certain PALM transactions can be completed. First, when a new reissue application enters the Examining Group, a PALM flag must be set at a SPRE PALM terminal before a docketing transaction will be accepted. By having to set this first flag, the SPRE is made aware of the assignment of the reissue application to the Group and can take steps, as may be appropriate, to instruct the examiner on reissue–specific procedures before the examination process begins, as well as throughout the period that the examiner is handling the reissue application. Further, a second PALM flag must be set at a SPRE PALM terminal before a Notice of Allowance can be generated or the PALM transaction for an issue revision can be entered, thereby ensuring that the SPRE is made aware of when the reissue application is being allowed so that the SPRE may be able to conduct a final review of the reissue application, if appropriate.

After leaving the Examining Groups, all reissue applications go through a screening process which is currently performed in the Special Program Law Office. The screening process which includes review of the reissue oath or declaration for compliance with 37 CFR 1.175, review of the presentation and entry of reissue amendments for compliance with 37 CFR 1.121(b), and review of other matters to ensure adherence to current reissue practices. A patentability review is made in a sample of reissue applications by the Office of Patent Quality Review. The screening process and the patentability review are appropriate vehicles for correcting errors, identifying problem areas and recognizing trends, providing information on the uniformity of practice, and providing feedback to the Examining Groups.

## 1460 Effect of Reissue

*35 U.S.C. 252. Effect of reissue.*

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are 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.

A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, used, or imported as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or for the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

The effect of the reissue of a patent is stated in 35 U.S.C. 252. With respect to the Office treatment of the reissued patent, the reissued patent will be viewed as if the original patent had been originally granted in the amended form provided by the reissue.

## 1480 Certificates of Correction — Office Mistake

*35 U.S.C. 254. Certificate of correction of Patent and Trademark Office mistake.*

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

*37 CFR 1.322. Certificate of correction of Office mistake.*

(a) A certificate of correction under 35 U.S.C. 254 may be issued at the request of the patentee or the patentee's assignee. 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 the patentee an opportunity to be heard. When the request relates to a patent involved in an interference, the request shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

(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 37 CFR 1.322. 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.

In order to expedite all proper requests, a Certificate of Correction should be requested only for errors of consequence. Instead of a request for a Certificate of Correction, letters making errors of record should be utilized whenever possible.

Each issue of the *Official Gazette* (patents section) numerically lists all United States patents having Certificates of Correction. The list appears under the heading "Certificates of Correction for the week of (date)."

## 1481 Applicant's Mistake

*35 U.S.C. 255. Certificate of correction of applicant's mistake.*

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

*37 CFR 1.323. Certificate of correction of applicant's mistake.*

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 fee set forth in § 1.20(a), issue a certificate, if the correction does not involve such changes in the patent

as would constitute new matter or would require reexamination. A request for a certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

37 CFR 1.323 relates to the issuance of Certificates of Correction for the correction of errors which were not the fault of the Office. Mistakes in a patent which are not correctable by Certificate of Correction may be correctable via filing a reissue application (see MPEP § 1401 – § 1460).

*In re Arnott,* 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991) specifies the criteria of 35 U.S.C. 255 (for a certificate of correction) as follows:

> Two separate statutory requirements must be met before a certificate of correction for an applicant's mistake may issue. The first statutory requirement concerns the nature, i.e., type, of the mistake for which a correction is sought. The mistake must be:
>
> (1) of a clerical nature,
> (2) of a typographical nature, or
> (3) a mistake of minor character.
>
> The second statutory requirement concerns the nature of the proposed correction. The correction must not involve changes which would:
>
> (1) constitute new matter or
> (2) require reexamination.

If the above is not satisfied, then reissue must be used. Usually, any mistake affecting claim scope must be corrected by reissue.

A mistake is not considered to be of the "minor" character required for the issuance of a Certificate of Correction if the requested change would materially affect the scope or meaning of the patent. See also MPEP § 1412.04 as to correction of inventorship via certificate of correction or reissue.

The fee for providing a correction of applicant's mistake, other than inventorship, is set forth in 37 CFR 1.20(a). The fee for correction of inventorship is set forth in 37 CFR 1.20(b).

## CORRECTION OF ASSIGNEES' NAMES

The Issue Fee Transmittal Form portion (PTOL–85B) of the Notice of Allowance provides a space (item 3) for assignment data which should be completed in order to comply with 37 CFR 3.81. Unless an assignee's name and address are identified in the appropriate space for specifying the assignee, (i.e., item 3 of the Issue Fee Transmittal Form PTOL–85B), the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

A request for a certificate of correction under 37 CFR 1.323 arising from incomplete or erroneous assignee's name furnished in item 3 of PTOL–85B will not be granted unless a petition under 37 CFR 1.183 has been granted. Any such petition under 37 CFR 1.183 should be directed to the Office of Petitions and should include:

(A) the petition fee required by 37 CFR 1.17(h);

(B) a request that 37 CFR 3.81(a) be waived to permit the correct name of the assignee to be provided after issuance of the patent;

(C) a statement that the failure to include the correct assignee name on the PTOL–85B was inadvertent; and

(D) a copy of the Notice of Recordation of Assignment Document.

## CORRECTION OF INVENTORS' NAMES

*35 U.S.C. 256. Correction of named inventor.*

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

In requesting the Office to effectuate a court order correcting inventorship in a patent pursuant to 35 U.S.C. 256, a copy of the court order and a certificate of correction under 37 CFR 1.323 should be submitted to the Certificates of Corrections Branch.

*37 CFR 1.324. Correction of inventorship in patent.*

(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Commissioner may, on petition, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 1.634.

(b) Any petition pursuant to paragraph (a) of this section must be accompanied by:

(1) A statement from each person who is being added as an inventor and from each person who is being deleted as an inventor that the inventorship error occurred without any deceptive intention on his or her part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;

(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and

(4) The fee set forth in § 1.20(b).

The petition to correct inventorship under 37 CFR 1.324 must include the statements and fee required by 37 CFR 1.324(b).

Under 37 CFR 1.324(b)(1), a statement is required from each person who is being added as an inventor, and each person who is being deleted as an inventor, that the inventorship error occurred without any deceptive intention on their part. In order to satisfy this, a statement such as the following is sufficient:

> "The inventorship error of failing to include John Smith as an inventor of the patent occurred without any deceptive intention on the part of the applicant."

Nothing more is required. The examiner will determine only whether the statement contains the required language; the examiner will not make any comment as to whether or not it appears that there was in fact deceptive intention (see MPEP § 2022.05).

Under 37 CFR 1.324(b)(2), all other inventors who did not submit a statement under 37 CFR 1.324(b)(1) must submit a statement either agreeing to the change of inventorship, or stating that they have no disagreement with regard to the requested change. These "other" inventors need not make a statement as to whether the inventorship error occurred without deceptive intention.

Under 37 CFR 1.324(b)(3), a statement is required from the assignee(s) of the patent agreeing to the change of inventorship in the patent. The statement must comply with the requirements of 37 CFR 3.73(b). See MPEP § 324 as to compliance with the requirements of 37 CFR 3.73(b).

While a petition under 37 CFR 1.48(a) is appropriate to request correction of inventorship in a nonprovisional *application*, a petition under 37 CFR 1.324 is the appropriate vehicle to correct inventorship in a *patent*. If a petition under 37 CFR 1.48(a) is inadvertently filed in a patent, the petition may be treated as a petition under 37 CFR 1.324, and if it is grantable, form paragraph 10.14 set forth below should be used.

Unlike correction of inventorship in a nonprovisional application under 37 CFR 1.48(a), where the requirement for a statement by each originally named inventor may be waived pursuant to 37 CFR 1.183, any correction of inventorship in a patent under 37 CFR 1.324 requires petition of all the parties, i.e., originally named inventors and assignees, in accordance with statute (35 U.S.C. 256) and thus the requirement cannot be waived. Correction of inventorship requests under 37 CFR 1.324 should be directed to the Supervisory Patent Examiner whose unit handles the subject matter of the patent. Form paragraphs 10.13 through 10.18 may be used.

¶ *10.13 Petition Under 37 CFR 1.324, Granted*

| | |
|---|---|
| | Paper No. **[1]** |
| In re Patent No. **[2]** | : |
| Issue Date: **[3]** | : **DECISION** |
| Appl. No.: **[4]**: | : **GRANTING** |
| Filed: **[5]** | : **PETITION** |
| For: **[6]** | : 37 CFR 1.324 |

This is a decision on the petition filed **[7]** to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

---

**[8]**
Supervisory Patent Examiner,
Art Unit **[9]**,
Patent Examining Group **[10]**
**[11]**

**Examiner Note:**

1. Petitions to correct inventorship of an issued patent are decided by the Supervisory Patent Examiner, as set forth in the Commissioner's memorandum dated June 2, 1989.
2. In bracket 11, insert the correspondence address of record.
3. This form paragraph is printed with the PTO letterhead.
4. Prepare Certificate using form paragraph 10.15.

¶ *10.14 Treatment of 37 CFR 1.48 Petition Under 37 CFR 1.324, Granted*

| | |
|---|---|
| | Paper No. **[1]** |
| In re Patent No. **[2]** | : |
| Issue Date: **[3]** | : **DECISION** |
| Appl. No.: **[4]** | : **GRANTING** |
| Filed: **[5]** | : **PETITION** |
| For: **[6]** | : 37 CFR 1.324 |

This is a decision on the petition under 37 CFR 1.48, filed **[7]**. In view of the fact that the patent has already issued, the petition has been treated as a petition to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

[8]
Supervisory Patent Examiner,
Art Unit [9],
Patent Examining Group [10]

[11]

**Examiner Note:**

1. Petitions to correct inventorship of an issued patent are decided by the Supervisory Patent Examiner, as set forth in the Commissioner's memorandum dated June 2, 1989.
2. This form paragraph is printed with the PTO letterhead.
3. Prepare Certificate using form paragraph 10.15.
4. In bracket 11, insert the correspondence address of record.

¶ *10.15 Memorandum – Certificate of Correction*

DATE: [1]
TO: Certificate of Corrections Branch
FROM: [2], SPE, Art Unit [3]
SUBJECT: Request for Certificate of Correction

Please Issue a Certificate of Correction in U.S. Letters Patent No. [4] as specified on the attached Certificate.

[5], SPE
Art Unit [6]

**UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE**

Patent No. [7]
Patented: [8]

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent, through error and without deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

[9]

[10], SPE
Art Unit [11]

**Examiner Note:**

1. In bracket 9, insert the full name and residence (City, State) of each actual inventor.
2. This is an internal memo, not to be mailed to applicant, which accompanies the patented file to Certificates of Corrections Branch as noted in form paragraphs 10.13 and 10.14.
3. In brackets 5 and 10, insert name of SPE; in brackets 6 and 11 the Art Unit and sign above each line.
4. Two separate pages of PTO letterhead will be printed when using this form paragraph.

¶ *10.16 Petition Under 37 CFR 1.324, Dismissed*

Paper No. [1]

| | |
|---|---|
| In re Patent No. [2] | : |
| Issue Date: [3] | : **DECISION** |
| Appl. No.: [4] | : **DISMISSING** |
| Filed: [5] | : **PETITION** |
| For: [6] | : 37 CFR 1.324 |

This is a decision on the petition filed [7] to correct inventorship under 37 CFR 1.324.

The petition is dismissed.

A petition to correct inventorship as provided by 37 CFR 1.324 requires (1) a statement from each person who is being added as an inventor and from each person who is being deleted as an inventor that the inventorship error occurred without any deceptive intention on their part, (2) a statement from the current named inventors who have not submitted a statement as per "(1)" either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change, (3) a statement from all assignees of the parties submitting a statement under "(1)" and "(2)" agreeing to the change of inventorship in the patent; such statement must comply with the requirements of 37 CFR 3.73(b); and (4) the fee set forth in 37 CFR 1.20(b). This petition lacks item(s) [8].

[9]
Supervisory Patent Examiner,
Art Unit [10],
Patent Examining Group [11]
[12]

**Examiner Note:**

1. If each of the four specified items has been submitted but one or more is insufficient, the petition should be denied. See paragraph 10.17. However, if the above noted deficiency can be cured by the submission of a renewed petition, a dismissal would be appropriate.
2. If the petition includes a request for suspension of the rules (37 CFR 1.183) of one or more provisions of 37 CFR 1.324 that are required by the statute (35 U.S.C. 256), form paragraph 10.18 should follow this paragraph.
3. In bracket 8, pluralize as necessary and insert the item number(s) which are missing.
4. In bracket 12, insert correspondence address of record.
5. This form paragraph is printed with the PTO letterhead.

¶ *10.17 Petition Under 37 CFR 1.324, Denied*

Paper No. [1]

| | |
|---|---|
| In re Patent No. [2] | : |
| Issue Date: [3] | :**DECISION DENYING PETITION** |
| Appl. No.: [4] | :*37 CFR 1.324* |
| Filed: [5] | : |
| For: [6] | : |

This is a decision on the petition filed [7] to correct inventorship under 37 CFR 1.324.
The petition is denied.

[8]

[9]
Supervisory Patent Examiner,
Art Unit [10],
Patent Examining Group [11]

[12]

**Examiner Note:**

1. In bracket 8, a full explanation of the deficiency must be provided.

2. If the petition lacks one or more of the required parts set forth in 37 CFR 1.324, it should be dismissed using paragraph 10.14 or 7.99, rather than being denied.

3. In bracket 12, insert correspondence address of record.

4. This form paragraph is printed with the PTO letterhead.

¶ *10.18 Waiver of Requirements of 37 CFR 1.324 Under 37 CFR 1.183, Dismissed*

Suspension of the rules under 37 CFR 1.183 may be granted for any requirement of the regulations which is not a requirement of the statutes. In this instance, 35 U.S.C. 256 requires [1]. Accordingly, the petition under 37 CFR 1.183 is dismissed as moot.

**Examiner Note:**

1. This paragraph should follow paragraph 10.16 whenever the petition requests waiver of one or more of the provisions of 37 CFR 1.324 that are also requirements of 35 U.S.C. 256.

2. If the petition requests waiver of requirements of 37 CFR 1.324 that are not specific requirements of the statute (i.e., the fee or the oath or declaration by all inventors), the application must be forwarded to a petitions examiner in the Office of the Deputy Assistant Commissioner for Patent Policy and Projects for decision.

## CORRECTION TO PERFECT CLAIM FOR 35 U.S.C. 119 (a)–(d) BENEFITS

See MPEP § 201.06 for a discussion of when 35 U.S.C. 119 (a)–(d) benefits can be perfected by certificate of correction.

## CORRECTION AS TO 35 U.S.C. 120 AND 35 U.S.C. 119(e) BENEFITS

*37 CFR 1.78. Claiming benefit of earlier filing date and cross–references to other applications.*

(a)(1) A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or copending international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or copending international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior application must be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) Complete as set forth in § 1.51(b); or

(iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or

(iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(f).

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior application. The identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number. Cross–references to other related applications may be made when appropriate (see § 1.14(a)).

(3) A nonprovisional application other than for a design patent may claim an invention disclosed in one or more prior filed copending provisional applications. Since a provisional application can be pending for no more than twelve months, the last day of pendency may occur on a Saturday, Sunday, or Federal holiday within the District of Columbia which for copendency would require the nonprovisional application to be filed on or prior to the Saturday, Sunday, or Federal holiday. In order for a nonprovisional application to claim the benefit of one or more prior filed copending provisional applications, each prior provisional application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior provisional application must be:

(i) Complete as set forth in § 1.51(c); or

(ii) Entitled to a filing date as set forth in § 1.53(c) and include the basic filing fee set forth in § 1.16(k).

(4) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number).

*****

Under certain conditions as specified below, a certificate of correction can be used, with respect to 35 U.S.C. 120 and 119(e) priority, to correct:

(A) the failure to make reference to a prior copending application pursuant to 37 CFR 1.78(a)(2) and (a)(4); or

(B) an incorrect reference to a prior copending application pursuant to 37 CFR 1.78(a)(2) and (a)(4).

For all situations other than where priority is based upon 35 U.S.C. 365(c), the conditions are as follows:

(A) for 35 U.S.C. 120 priority, all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) for 35 U.S.C. 119(e) priority, all requirements set forth in 37 CFR 1.78(a)(3) must have been met in the application which became the patent to be corrected;

(C) the prior copending application to be added via the certificate of correction must be identified elsewhere (other than the first sentence of the specification following the title) in the application papers; and

(D) it must be clear from the record of the patent and the parent application(s) that priority is appropriate.

Where 35 U.S.C. 120 and 365(c) priority based on an international application is to be asserted or corrected in a patent via a certificate of correction, the following conditions must be satisfied:

(A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) the prior copending application to be added via the certificate of correction must be identified in the application papers other than in the first sentence of the specification following the title and other than in a claim under 35 U.S.C. 119(a)–(d)

(C) it must be clear from the record of the patent and the parent application(s) that priority is appropriate; and

(D) the patentee must submit with the request for the certificate copies of documentation showing designation of states and any other information needed to make it clear from the record that the 35 U.S.C. 120 priority is appropriate. See MPEP § 201.13(b) as to the requirements for 35 U.S.C. 120 priority based on an international application.

If all the above–stated conditions are satisfied, a certificate of correction can be used to amend the patent to make reference to a prior copending application, or to correct an incorrect reference to the prior copending application. Note *In re Schuurs,* 218 USPQ 443 (Comm'r Pat. 1983) which suggests that a certificate of correction is an appropriate remedy for correcting, in a patent, reference to a prior copending application. Also, note *In re Lambrech,* 202 USPQ 620 (Comm'r Pat. 1976), citing *In re Van Esdonk,* 187 USPQ 671 (Comm'r Pat. 1975).

If any of the above–stated conditions is not satisfied, the filing of a reissue application (see MPEP § 1401 – § 1460) would be appropriate to pursue the desired correction of the patent.

## 1485 Handling of Request for Certificates of Correction

A request for a certificate of correction should be addressed to the attention of the Certificate of Correction Branch, Assistant Commissioner for Patents, Washington, DC 20231. Requests for certificates of correction will be forwarded to the Certificate of Correction Branch of the Office of Patent Publication, where they will be listed in a permanent record book.

If the patent is involved in an interference, a certificate of correction under 37 CFR 1.324 will not be issued unless a corresponding motion under 37 CFR 1.634 has been granted by the administrative patent judge. See MPEP § 2334. Otherwise, determination as to whether an error has been made, the responsibility for the error, if any, and whether the error is of such a nature as to justify the issuance of a certificate of correction will be made by the Certificate of Correction Branch. If a report is necessary in making such determination, the case will be forwarded to the appropriate group with a request that the report be furnished. If no certificate is to issue, the party making the request is so notified and the request, report, if any, and copy of the communication to the person making the request are placed in the file and entered thereon under "Contents" by the Certificate of Correction Branch. 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 Office of Patent Publication. 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".

Applicants, or their attorneys or agents, are urged to submit the text of the correction on a special Certificate of Correction form, PTO–1050, which can serve as the camera copy for use in direct offset printing of the certificate of correction. Form PTO/SB/44 may also be used. Both parts of form PTO–1050 must accompany the request since the second part will be placed in the application file for internal use.

A perforated space at the bottom of form PTO–1050 has been provided for the patentee's current mailing ad-

dress, and for ordering any desired additional copies of the printed certificate. The fee for each additional copy ordered is set forth in 37 CFR 1.19(a)(1). The fee should accompany the request.

Where only a part of a request can be approved, or where the Office discovers and includes additional corrections, the appropriate alterations are made on the form PTO–1050 by the Office. The patentee is notified of the changes on the Notification of Approval–in–part form PTOL–404. The certificate is issued approximately 6 weeks thereafter.

Form PTO–1050 (or PTO/SB/44) should be used exclusively regardless of the length or complexity of the subject matter. Intricate chemical formulas or page of specification or drawings may be reproduced and mounted on a blank copy of PTO–1050. Failure to use the form has frequently delayed issuance since the text must be retyped by the Office onto a PTO–1050.

The exact page and line number where the errors occur in the application file should be identified on the request. However, on form PTO–1050, only the column and line number in the printed patent should be used.

The patent grant should be retained by the patentee. The Office does not attach the Certificate of Correction to patentee's copy of the patent. The patent grant will be returned to the patentee if submitted.

Below is a sample form illustrating a variety of corrections and the suggested manner of setting out the format. Particular attention is directed to:

(A) Identification of the exact point of error by reference to column and line number of the printed patent or to claim number and line where a claim is involved.

(B) Conservation of space on the form by typing single space, beginning two lines down from the printed message.

(C) Starting the correction to each separate column as a sentence, and using semicolons to separate corrections within said column, where possible.

(D) Two–inch space left blank at bottom of the last sheet for signature of attesting officer.

(E) Use of quotation marks to enclose the exact subject matter to be deleted or corrected; use of double hyphens (–– ––) to enclose subject matter to be added, except for formulas.

(F) Where a formula is involved, setting out only that portion thereof which is to be corrected or, if necessary, pasting a photocopy onto form PTO–1050.

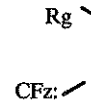
The examiner's comments are requested on form PTO–306 where, under 37 CFR 1.323, there is a question involving change in subject matter.

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

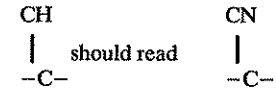
Patent No. ———— Dated April 1, 1969
James W. Worth

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

In the drawings, Sheet 3, Fig. 3, the reference numeral 225 should be applied to the plate element attached to the support member 207. Column 7, lines 45 to 49, the left–hand formula should appear as follows:




Column 10, formula XXXV, that portion of the formula reading




Formula XXXVII, that portion of the formula reading "–CH2CH–" should read —-CHCH– —. Column 2, line 68 and column 3, lines 3, 8 and 13, for the claim reference numeral "2", each occurrence, should read —1—. Column 10, line 16, cancel beginning with "12. A sensor device" to and including "tive strips." in column 11, line 8, and insert the following claim:

12. A control circuit of the character set forth in claim 1 and for an automobile having a convertible top, and including; means for moving said top between raised and lowered retracted position; and control means responsive to said sensor relay for energizing the top moving means for moving said top from retracted position to raised position.

## 1490 Disclaimers

*35 U.S.C. 253. Disclaimer.*

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

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.

*37 CFR 1.321. Statutory disclaimers, including terminal disclaimers.*

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like

manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the *Official Gazette* and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed by the patentee, or an attorney or agent of record;

(2) identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term, will be refused recordation;

(3) state the present extent of patentee's ownership interest in the patent; and

(4) be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed:

(i) by the applicant, or

(ii) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or

(iii) if there is an assignee of record of the entire interest, by such assignee, or

(iv) by an attorney or agent of record;

(2) specify the portion of the term of the patent being disclaimed;

(3) state the present extent of applicant's or assignee's ownership interest in the patent to be granted; and

(4) be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

A disclaimer is a statement filed by an owner (in part or in entirety) of a patent or of a patent to be granted (i.e., an application), in which said owner relinquishes certain legal rights to the patent. There are two types of disclaimers: a statutory disclaimer and a terminal disclaimer. The owner of a patent or an application is the original inventor(s) or the assignee of the original inventor(s). The patent or application is assigned by one assignment or by multiple assignments which establish a chain of title from the inventor(s) to the assignee(s). The owner of the patent or application can sign a disclaimer, and a person empowered to sign the disclaimer can also sign it. Per 37 CFR 1.321(b)(1)(iv), an attorney or agent of record is permitted to sign the disclaimer. For a disclaimer to be accepted, it must be signed by the proper party as follows:

(A) A disclaimer filed in an application must be signed by either

(1) the applicant where the application has not been assigned,

(2) the applicant and the assignee where each owns a part interest in the application,

(3) the assignee where assignee owns the entire interest in the application, or

(4) an attorney or agent of record.

(B) A disclaimer filed in a patent or a reexamination proceeding must be signed by either

(1) the patentee (the assignee, the inventor(s) if the patent is not assigned, or the assignee and the inventors if the patent is assigned–in–part), or

(2) an attorney or agent of record.

(C) Where the assignee (of an application or of a patent being reexamined or to be reissued) signs the disclaimer, there is a requirement to comply with 37 CFR 3.73(b) in order to satisfy 37 CFR 1.321, unless an attorney or agent of record signs the disclaimer. In order to comply with 37 CFR 3.73(b), the assignee's ownership interest must be established by:

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

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

The submission with respect to 37 CFR 3.73(b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See also MPEP § 324 as to compliance with 37 CFR 3.73(b). A copy of the "Certificate Under 37 CFR 3.73 (b)," which is reproduced in MPEP § 324, may be sent by the examiner to applicant to provide an acceptable way to comply with the requirements of 37 CFR 3.73 (b).

(D) Where the attorney or agent of record signs the disclaimer, **there is no need** to comply with 37 CFR 3.73(b).

(E) The signature on the disclaimer need not be an original signature. Pursuant to 37 CFR 1.4(d)(2), the submitted disclaimer can be a copy, such as a photocopy or facsimile transmission of an original disclaimer.

**STATUTORY DISCLAIMERS**

Under 37 CFR 1.321(a) the owner of a patent may disclaim a complete claim or claims of his patent. This may result from a lawsuit or because he has reason to believe that the claim or claims are too broad or otherwise invalid. If the patent is involved in an interference, see MPEP § 2362.

**TERMINAL DISCLAIMERS**

37 CFR 1.321(a) also provides for the filing by an applicant or patentee of a terminal disclaimer which disclaims or dedicates to the public the entire term or any portion of the term of a patent or patent to be granted.

37 CFR 1.321(c) specifically provides for the filing of a terminal disclaimer in an application or a reexamination proceeding for the purpose of overcoming a judicially created double patenting rejection. See MPEP § 804.02.

**PROCESSING**

The Certificates of Corrections Branch is responsible for the handling of all statutory disclaimers filed under the first paragraph of 35 U.S.C. 253, whether the case is pending or patented, and all terminal disclaimers (filed under the second paragraph of 35 U.S.C. 253) except for those filed in an application pending in an Examining Group. This involves:

(A) Determining compliance with 35 U.S.C. 253 and 37 CFR 1.321 and 3.73;

(B) Notifying applicant or patentee when the disclaimer is informal and thus not acceptable;

(C) Recording the disclaimers; and

(D) Providing the disclaimer data for printing.

**TERMINAL DISCLAIMER IN PENDING APPLICATION PRACTICE**

Where a terminal disclaimer is filed in an application pending in an Examining Group, it will be processed by the paralegal of the Office of the Special Program Examiner of the Examining Group having responsibility for the application. The paralegal will:

(A) Determine compliance with 35 U.S.C. 253 and 37 CFR 1.321 and 3.73;

(B) Notify the examiner having charge of the application whether the terminal disclaimer is acceptable or not;

(C) Where the terminal disclaimer is not acceptable, indicate the nature of the informalities so that the examiner can inform applicant in the next Office action;

(D) Where the terminal disclaimer is acceptable, record the terminal disclaimer; and

(E) Where the terminal disclaimer is acceptable, provide the appropriate terminal disclaimer data for printing.

The paralegal will identify a terminal disclaimer as being present in an application by:

(A) Attaching a green label to the file wrapper;

(B) Stamping a notice on the file of the term which has been disclaimed;

(C) Endorsing the paper containing the terminal disclaimer submission on the "Contents" flap of the application file; and

(D) Entering the terminal disclaimer into the PALM system records, for the application.

The Group's paralegal completes a Terminal Disclaimer Informal Memo to notify the examiner of the nature of any informalities in the terminal disclaimer. The examiner should notify the applicant of the informalities in the next Office action, or by interview with applicant if such will expedite prosecution of the application. Further, the examiner should initial and date the Terminal Disclaimer Informal Memo and return it to the paralegal to indicate that the examiner has appropriately notified applicant about the terminal disclaimer, and so that the Terminal Disclaimer Informal Memo may be discarded.

**T. D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT**

DATE: _____

TO: EXAMINER _____ APPL. S.N.: _____

FROM: _____ ART UNIT: _____
PARALEGAL SPECIALIST

SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: _____

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

[ ] The T.D. is PROPER and has been recorded (see ¶14.23).

[ ] The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶14.24):

- [ ] The recording fee of $ _____ has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶14.26.07).
- [ ] The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶14.26 & 14.26.01).
- [ ] The T.D. lacks the enforceable only during common ownership clause - needed to overcome a double patenting rejection, Rule 321(b) (see ¶14.27.01)
- [ ] The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be a terminal portion of the term of the entire patent to be granted." (MPEP 1490) (see ¶¶14.26 & 14.26.02).
- [ ] The person who signed the T.D.:
  - [ ] is not an attorney "of record" (see ¶¶14.29 and 14.29.01).
  - [ ] has failed to state his/her capacity to sign for the business entity (see ¶14.28),
  - [ ] is not recognized as an officer of the assignee (see ¶¶14.29 & possibly 14.29.02).
- [ ] No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶14.30).
- [ ] The T.D. is not signed (see ¶¶14.26 & 14.26.03).
- [ ] The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶14.32).
- [ ] The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶¶14.26, 14.26.04 or 14.26.05).
- [ ] The period disclaimed is incorrect or not specified (see ¶¶14.26, 14.27.02 or 14.27.03).
- [ ] Other:
- [ ] Suggestion to request refund (see ¶14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: _____. Date: _____

RETURN THIS MEMO TO CPK2-2D25. (Rev. 5/98)

Since the claims of pending applications are subject to cancellation, amendment, or renumbering, a terminal disclaimer directed to a particular claim or claims will not be accepted; the disclaimer must be of a terminal portion of the term of the entire patent to be granted. The statute does not provide for conditional disclaimers and accordingly, a proposed disclaimer which is made contingent on the allowance of certain claims cannot be accepted. The disclaimer should identify the disclaimant and his or her interest in the application and should specify the date when the disclaimer is to become effective.

A terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application identified in the disclaimer unless by its terms it extends to continuing applications. For example, a terminal disclaimer filed in a parent application normally has no effect on a continuing application claiming filing date benefits of the parent application under 35 U.S.C. 120. A terminal disclaimer filed in a parent application to obviate a double patenting rejection *does, however, carry over* to a continued prosecution application (CPA) filed under 37 CFR 1.53(d). The terminal disclaimer filed in the parent application carries over because the CPA retains the *same application number* as the parent application, i.e., the application number to which the previously filed terminal disclaimer is directed. If applicant does not want the terminal disclaimer to carry over to the CPA, applicant must file a petition under 37 CFR 1.182 along with the required petition fee, requesting the terminal disclaimer filed in the parent application not be carried over to the CPA; see below "Withdrawing a Terminal Disclaimer" (paragraph "A. Before Issuance of Patent"). If two (or more) pending applications are filed, in *each* of which a rejection of one claimed invention over the other on the ground of obviousness–type double patenting is proper, the rejection will be made in each application. An appropriate terminal disclaimer must be filed in *each* application. This is because a terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application identified in the disclaimer. Moreover, the filing of an appropriate terminal disclaimer in each application will prevent a potential improper timewise extension of patent rights in the last application to be issued.

The following form paragraphs may be used to inform the applicant (or patent owner) of the status of a submitted terminal disclaimer.

¶ *14.23 Terminal Disclaimer Proper*

The terminal disclaimer filed on [1] disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of [2] has been reviewed and is accepted. The terminal disclaimer has been recorded.

**Examiner Note:**

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.) preceded by the phrase – – any patent granted on Application Number– –.
3. If an assignment is submitted to support the terminal disclaimer, also use form paragraph 14.34 to suggest that the assignment be separately submitted for recording in the Office.
4. See MPEP § 1490 for discussion of requirements for a proper terminal disclaimer.
5. Use form paragraph 14.23.01 for reexamination proceedings.
6. For improper terminal disclaimers, see the form paragraphs which follow.

¶ *14.23.01 Terminal Disclaimer Proper (Reexamination Only)*

The terminal disclaimer filed on [1] disclaiming the terminal portion of the patent being reexamined which would extend beyond the expiration date of [2] has been reviewed and is accepted. The terminal disclaimer has been recorded.

**Examiner Note:**

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.) preceded by the phrase – – any patent granted on Application Number– –.
3. If an assignment is submitted to support the terminal disclaimer, also use 14.34 to suggest that the assignment be separately submitted for recording in the Office.
4. See MPEP § 1490 for discussion of requirements for a proper terminal disclaimer.
5. For improper terminal disclaimers, see the form paragraphs which follow.

¶ *14.24 Terminal Disclaimer Not Proper – Introductory Paragraph*

The terminal disclaimer filed on [1] disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of [2] has been reviewed and is NOT accepted.

**Examiner Note:**

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.) preceded by the phrase – – any patent granted on Application Number– –.
3. One or more of the appropriate form paragraphs 14.26 to 14.32 MUST follow this form paragraph to indicate why the terminal disclaimer is not accepted.
4. Form paragraph 14.33 includes the full text of rule 37 CFR 3.73 and may be included in the Office action when deemed appropriate.
5. Form paragraph 14.35 may be used to inform applicant that an additional disclaimer fee will not be required for the submission of a replacement or supplemental terminal disclaimer.
6. Do not use in reexamination proceedings, use form paragraph 14.25 instead.

¶ *14.25 Terminal Disclaimer Not Proper – Introductory Paragraph (Reexamination Only)*

The terminal disclaimer filed on [1] disclaiming the terminal portion of the patent being reexamined which would extend beyond the expiration date of [2] has been reviewed and is NOT accepted.

**Examiner Note:**

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or the Application Number (including series code and serial no.) preceded by the phrase --any patent granted on Application Number--.
3. One or more of the appropriate form paragraphs 14.26 to 14.32 MUST follow this form paragraph to indicate why the terminal disclaimer is not accepted.
4. Form paragraph 14.33 includes the full text of rule 37 CFR 3.73 and may be included in the Office action when deemed appropriate.
5. Form paragraph 14.35 may be used to inform applicant that an additional disclaimer fee will not be required for the submission of a replacement or supplemental terminal disclaimer.

¶ *14.26 Does Not Comply With 37 CFR 1.321(b) and/or (c) "Sub-Heading" Only*

The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 and followed by one or more of the appropriate form paragraphs 14.26.01 to 14.27.03.

¶ *14.26.01 Extent of Interest Not Stated*

The person who has signed the disclaimer has not stated the extent of his/her interest, or the business entity's interest, in the application/patent. See 37 CFR 1.321(b)(3).

**Examiner Note:**

This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ *14.26.02 Directed to Particular Claim(s)*

It is directed to a particular claim or claims, which is not acceptable, since "the disclaimer must be of a terminal portion of the term of the entire [patent or] patent to be granted." See MPEP § 1490.

**Examiner Note:**

This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ *14.26.03 Not Signed*

The terminal disclaimer was not signed.

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ *14.26.04 Application/Patent Not Identified*

The application/patent being disclaimed has not been identified.

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ *14.26.05 Application/Patent Improperly Identified*

The application/patent being disclaimed has been improperly identified since the number used to identify the [1] being disclaimed is incorrect. The correct number is [2].

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.
2. In bracket 1, insert --application-- or --patent--.
3. In bracket 2, insert the correct Application Number (including series code and serial no.) or the correct Patent Number being disclaimed.
4. A terminal disclaimer is acceptable if it includes the correct Patent Number or the correct Application Number or the serial number together with the proper filing date or the proper series code.

¶ *14.26.06 Not Signed by All Owners*

It was not signed by all owners and, therefore, supplemental terminal disclaimers are required from the remaining owners.

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ *14.26.07 No Disclaimer Fee Submitted*

The disclaimer fee of $[1] in accordance with 37 CFR 1.20(d) has not been submitted, nor is there any authorization in the application file to charge a specified Deposit Account.

**Examiner Note:**

1. In bracket 1, insert the fee for a disclaimer.
2. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26. If the disclaimer fee was paid for a terminal disclaimer which was not accepted, applicant does not have to pay another disclaimer fee when submitting a replacement or supplemental terminal disclaimer, and this paragraph should not be used.

¶ *14.27.01 Lacks Clause of Enforceable Only During Period of Common Ownership*

It does not include a recitation that any patent granted shall be enforceable only for and during such period that said patent is commonly owned with the application(s) or patent(s) which formed the basis for the double patenting rejection. See 37 CFR 1.321(c)(3).

**Examiner Note:**

This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ *14.27.02 Fails To Disclaim Terminal Portion of Any Patent Granted On Subject Application*

It fails to disclaim the terminal portion of any patent granted on the subject application.

**Examiner Note:**

1 This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.
2. Use this form paragraph when the period disclaimed is not the correct period or when no period is specified at all.
3. When using this form paragraph, give an example of proper terminal disclaimer language using form paragraph 14.27.04 following this or the series of statements concerning the defective terminal disclaimer.

¶ *14.27.03 Fails To Disclaim Terminal Portion of Subject Patent*

It fails to disclaim the terminal portion of the subject patent.

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.
2. Use this paragraph in a reissue application or reexamination proceeding when the period disclaimed is not the correct period or when no period is specified at all.
3. When using this form paragraph, give an example of proper terminal disclaimer language using form paragraph 14.27.05 (for reissue) or form paragraph 14.27.06 (for reexamination proceeding) following this or the series of statements concerning the defective terminal disclaimer.

¶ *14.27.04 Examples of Acceptable Terminal Disclaimer Language in Patent To Be Granted*

Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Obviousness–Type Double Patenting Rejection Over A Pending Application was made, use:

> Petitioner hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of any patent granted on Application No. ___/_____, filed on _____, as shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the above–listed application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

II. If an Obviousness–Type Double Patenting Rejection Over A Prior Patent was made, use:

> Petitioner hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of Patent No. _____, as presently shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the above listed patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

### ¶ *14.27.05 Examples of Acceptable Terminal Disclaimer Language in An Existing Patent*

Examples of acceptable language for making the disclaimer of the terminal portion of the subject patent follow:

I. If a Provisional Obviousness–Type Double Patenting Rejection Over A Pending Application was made, use:

> Petitioner hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of any patent granted on Application No. ___/_____, filed on _____, as shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the above–listed application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

II. If an Obviousness–Type Double Patenting Rejection Over A Prior Patent was made, use:

> Petitioner hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of Patent No. _____, as presently shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the above listed patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

### ¶ *14.27.06 Examples of Acceptable Terminal Disclaimer Language in Patent (Reexamination Situation)*

Examples of acceptable language for making the disclaimer of the terminal portion of the patent being reexamined follow:

I. If a Provisional Obviousness–Type Double Patenting Rejection Over A Pending Application was made, use:

> Petitioner hereby disclaims, except as provided below, the terminal part of the patent being reexamined, which would extend beyond the expiration date of any patent granted on Application No. ___/_____, filed on _____, as shortened by any terminal disclaimer. Petitioner hereby agrees that the patent being reexamined shall be enforceable only for and during such period that it and any patent granted on the above–listed application are commonly owned. This agreement runs with any reexamination certificate issued on the instant patent and is binding upon the grantee, its successors, or assigns.

II. If an Obviousness–Type Double Patenting Rejection Over A Prior Patent was made, use:

> Petitioner hereby disclaims, except as provided below, the terminal part of the patent being reexamined, which would extend beyond the expiration date of Patent No. _____, as presently shortened by any terminal disclaimer. Petitioner hereby agrees that the patent for which a reexamination certificate is issued as a result of this proceeding shall be enforceable only for and during such period that it and the above listed patent are commonly owned. This agreement runs with any reexamination certificate issued on the instant patent and is binding upon the grantee, its successors, or assigns.

### ¶ *14.28 Failure To State Capacity To Sign*

The person who signed the terminal disclaimer has failed to state his/her capacity to sign for the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee.

**Examiner Note:**

1. This form paragraph MUST be <u>preceded</u> by form paragraphs 14.24 OR 14.25 and 14.26.

### ¶ *14.29 Not Recognized as Officer of Assignee – "Sub–Heading" Only*

The person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

**Examiner Note:**

1. This form paragraph is to be used when the person signing the terminal disclaimer is not an authorized officer as defined in MPEP § 324.
2. This form paragraph MUST be <u>preceded</u> by form paragraphs 14.24 or 14.25 and <u>followed</u> by form paragraphs 14.29.01 and/or 14.29.02 when appropriate. An attorney or agent of record is always authorized to sign the terminal disclaimer, even though there is no indication that he or she is an officer of the assignee.
3. Use form paragraph 14.29.02 to explain how an official, other than a recognized officer, may properly execute a terminal disclaimer.

### ¶ *14.29.01 Attorney/Agent Not <u>of Record</u>*

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.29.
2. An attorney or agent, however, may sign a terminal disclaimer provided he/she is an attorney or agent of record or is established as an appropriate official of the assignee. To suggest to the attorney or agent, not of record, how he/she may establish status as an appropriate official of the assignee to execute a terminal disclaimer, use form paragraph 14.29.02.

### ¶ *14.29.02 Criteria To Accept Terminal Disclaimer When Signed by a Non–Recognized Officer*

It would be acceptable for a person, other than a recognized officer, to execute a terminal disclaimer, provided the record for the application includes a statement that the person is empowered to sign terminal disclaimers and/or act on behalf of the organization.

Accordingly, a new terminal disclaimer which includes the above empowerment statement will be considered to be executed by an appropriate official of the assignee. A separately filed paper referencing the previously filed terminal disclaimer and containing a proper empowerment statement would also be acceptable.

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.29.
2. When form paragraph 14.29 is used to indicate that a terminal disclaimer is denied because it was not signed by a recognized officer nor by an attorney or agent of record, this form paragraph should be used to point out one way to correct the problem.
3. While an indication of the person's title is desirable, its inclusion is not mandatory when this option is employed.
4. A sample terminal disclaimer should be sent with the Office action.

### ¶ *14.30 No Evidence of Chain of Title to Assignee – Application*

The assignee has not established its ownership interest in the application, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee, or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office (37 CFR 3.73(b)).

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25.
2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide a statement under 37 CFR 3.73(b). Thus, this form paragraph should not be used.
3. It should be noted that the documentary evidence or the specifying of reel and frame number may be found in the terminal disclaimer itself or in a separate paper.

### ¶ *14.30.01 No Evidence of Chain of Title to Assignee – Patent*

The assignee has not established its ownership interest in the patent, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee, or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office (37 CFR 3.73(b)).

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25.
2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide a statement under 37 CFR 3.73(b). Thus, this form paragraph should not be used.
3. It should be noted that the documentary evidence or the specifying of reel and frame number may be found in the terminal disclaimer itself or in a separate paper in the application.

### ¶ *14.30.02 Evidence of Chain of Title to Assignee – Submission Not Signed by Appropriate Party – Terminal Disclaimer Is Thus Not Entered*

The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission establishing the ownership interest is authorized to sign the submission (37 CFR 3.73(b)).

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25.
2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide any statement under 37 CFR 3.73(b). Thus, this form paragraph should not be used.
3. This form paragraph should be followed by one of form paragraphs 14.16.02 or 14.16.03. In rare situations where BOTH form paragraphs 14.16.02 and 14.16.03 do not apply and thus cannot be used, the examiner should instead follow this form paragraph with a detailed statement of why the there is no authorization to sign.
4. Use form paragraph 14.16.06 to point out one way to correct the problem.

### ¶ *14.32 Application/Patent Which Forms Basis for Rejection Not Identified*

The application/patent which forms the basis for the double patenting rejection is not identified in the terminal disclaimer.

**Examiner Note:**

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25.
2. Use this form paragraph when no information is presented. If incorrect information is contained in the terminal disclaimer, use form paragraphs 14.26 and 14.26.05.

### ¶ *14.33 37 CFR 3.73 – Establishing Right of Assignee To Prosecute*

The following is a statement of 37 CFR 3.73, which became effective on September 4, 1992, and was revised to its present form in 1997:

> 37 CFR 3.73 Establishing right of assignee to prosecute.
>
> (a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application unless there is an assignment.
>
> (b) When an assignee seeks to take action in a matter before the Office with respect to a patent application, trademark application, patent, registration, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. Ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording or by specifying (e.g., reel and frame number) where such evidence is recorded in the Office. The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

¶ *14.34 Suggestion To Record Assignment Submitted With Terminal Disclaimer*

The assignment document filed on [1] is acceptable as the documentary evidence required by 37 CFR 3.73. If the assignment document is not already recorded with the Patent and Trademark Office, it is suggested that the assignment document be submitted for recording among the Office assignment records. See 37 CFR 3.11 and MPEP § 302.

**Examiner Note:**

1. In bracket 1, insert the date the assignment document was filed.
2. This form paragraph should be used when an assignment document (an original, facsimile, or copy) is submitted for recording among the assignment records of the Office.

¶ *14.35 Disclaimer Fee Not Required Twice – Applicant*

It should be noted that applicant is not required to pay another disclaimer fee as set forth in 37 CFR 1.20(d) when submitting a replacement or supplemental terminal disclaimer.

**Examiner Note:**

1 This form paragraph can be used to notify an applicant that another disclaimer fee will not be required when a replacement or supplemental terminal disclaimer is submitted.
2. Use form paragraph 14.35.01 for providing notification to patent owner, rather than an applicant.

¶ *14.35.01 Disclaimer Fee Not Required Twice – Patent Owner*

It should be noted that patent owner is not required to pay another disclaimer fee as set forth in 37 CFR 1.20(d) when submitting a replacement or supplemental terminal disclaimer.

**Examiner Note:**

This form paragraph can be used to notify a patent owner that another disclaimer fee will not be required when a replacement or supplemental terminal disclaimer is submitted.

¶ *14.36 Suggestion That "Applicant" Request a Refund*

Since the required fee for the terminal disclaimer was previously paid, applicant's payment of an additional terminal disclaimer fee is not required. Applicant may request a refund of this additional terminal disclaimer fee by submitting a written request for a refund and a copy of this Office action to: Commissioner of Patents and Trademarks, Office of Finance, Washington, DC 20231.

**Examiner Note:**

1. This form paragraph should be used to notify applicant that a refund can be obtained if another terminal disclaimer fee was paid when a replacement or supplemental terminal disclaimer was submitted.
2. Note – If applicant has authorized or requested a fee refund to be credited to a specific Deposit Account, then an appropriate credit should be made to that Deposit Account and this paragraph should NOT be used.
3. Use form paragraph 14.36.01 for providing notification to patent owner, rather than an applicant.

¶ *14.36.01 Suggestion That "Patent Owner" Request a Refund*

Since the required fee for the terminal disclaimer was previously paid, patent owner's payment of an additional terminal disclaimer fee is not required. Patent owner may request a refund of this additional terminal disclaimer fee by submitting a written request for a refund and a copy of this Office action to: Commissioner of Patents and Trademarks, Office of Finance, Washington, DC 20231.

**Examiner Note:**

1. This form paragraph should be used to notify patent owner that a refund can be obtained if another terminal disclaimer fee was paid when a replacement or supplemental terminal disclaimer was submitted.
2. Note – If patent owner has authorized or requested a fee refund to be credited to a specific Deposit Account, then an appropriate credit should be made to that Deposit Account and this paragraph should NOT be used.

¶ *14.37 Samples of a Terminal Disclaimer Over a Pending Application and Assignee Certificate Enclosed*

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome a provisional obviousness–type double patenting rejection over a pending application (37 CFR 1.321(b) and (c)).

Also enclosed is a sample Certificate Under 37 CFR 3.73(b) which an assignee may use in order to ensure compliance with the rule. Part A of the Certificate is used when there is a single assignment from the inventor(s). Part B of the Certificate is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B ) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel_____, Frame_____" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:_____ To:_____" blank(s) must be filled in. This certificate should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

**Examiner Note:**

1. This form paragraph can be used to provide applicant samples of a terminal disclaimer which contains the necessary clauses to overcome a provisional obviousness–type double patenting rejection over a pending application and a Certificate to be signed by an assignee to ensure compliance with 37 CFR 3.73(b).
2. Note that the requirements for compliance with 37 CFR 3.73 (b) have been made more liberal, such that certain specifics of the sample certificate are no longer required. At present, in order to comply with 37 CFR 3.73(b), the assignee's ownership interest must be established by (a) filing in the application or patent evidence of a chain of title from the original owner to the assignee, or (b) specifying in the record of the application or patent where such evidence is recorded in the Office (e.g., reel and frame number, etc.). The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee.

(See your Group Paralegal or Special Program Examiner for copies of the sample terminal disclaimer and Certificate to enclose with the Office action. Alternatively, it is permissible to copy the sample terminal disclaimer found in MPEP § 1490 and the Sample Certificate found in MPEP § 324.)

¶ *14.38 Samples of a Terminal Disclaimer Over a Prior Patent and Assignee Certificate Enclosed*

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness–type double patenting rejection over a prior patent (37 CFR 1.321(b) and (c)).

Also enclosed is a sample Certificate Under 37 CFR 3.73(b) which an assignee may use in order to ensure compliance with the rule. Part A of the Certificate is used when there is a single assignment from the inventor(s). Part B of the Certificate is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B ) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel_____, Frame_____" entries should be left blank. If the part B box

is checked, and copies of assignments are not included, the "From:_____ To:_____" blank(s) must be filled in. This certificate should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

**Examiner Note:**

1. This form paragraph can be used to provide applicant samples of a terminal disclaimer which contains the necessary clauses to overcome an obviousness–type double patenting rejection over a prior patent and a Certificate to be signed by an assignee to ensure compliance with 37 CFR 3.73(b).
2. Note that the requirements for compliance with 37 CFR 3.73 (b) have been made more liberal, such that certain specifics of the sample certificate are no longer required. At present, in order to comply with 37 CFR 3.73(b), the assignee's ownership interest must be established by (a) filing in the application or patent evidence of a chain of title from the original owner to the assignee, or (b) specifying in the record of the application or patent where such evidence is recorded in the Office (e.g., reel and frame number, etc.). The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee.

(See your Group Paralegal or Special Program Examiner for copies of the sample terminal disclaimer and Certificate to enclose with the Office action. Alternatively, it is permissible to copy the sample terminal disclaimer found in MPEP § 1490 and the Sample Certificate found in MPEP § 324.)

¶ *14.39 Sample Assignee Certificate Under 37 CFR 3.73(b) Enclosed*

Enclosed with this Office action is a sample Certificate under 37 CFR 3.73(b) which an assignee may use in order to ensure compliance with the Rule. Part A of the Certificate is used when there is a single assignment from the inventor(s). Part B of the Certificate is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B ) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel_____, Frame_____" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:_____ To:_____" blank(s) must be filled in. This certificate should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b).

**Examiner Note:**

1. This form paragraph can be used to provide applicant a sample of a Certificate to be signed by an assignee to ensure compliance with 37 CFR 3.73(b).
2. Note that the requirements for compliance with 37 CFR 3.73 (b) have been made more liberal, such that certain specifics of the sample certificate are no longer required. At present, in order to comply with 37 CFR 3.73(b), the assignee's ownership interest must be established by (a) filing in the application or patent evidence of a chain of title from the original owner to the assignee, or (b) specifying in the record of the application or patent where such evidence is recorded in the Office (e.g., reel and frame number, etc.). The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee.

(See your Group Paralegal or Special Program Examiner for copies of the sample terminal disclaimer and Certificate to enclose with the Office action. Alternatively, it is permissible to copy the sample certificate found in MPEP § 324.)

## WITHDRAWING A RECORDED TERMINAL DISCLAIMER

If timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent, or in a reexamination proceeding before the reexamination certificate issues. After a patent or reexamination certificate issues, it is unlikely that a recorded terminal disclaimer will be nullified.

### *A. Before Issuance Of Patent*

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).

Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer. Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered. The filing of a continuing application other than a CPA, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer.

### *B. After Issuance Of Patent*

The mechanisms to correct a patent — certificate of correction (35 U.S.C. 255), reissue (35 U.S.C. 251), and reexamination (35 U.S.C. 305) — are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent. See, e.g., *Altoona Publix Theatres v. American Tri–Ergon Corp.*, 294 U.S. 477, 24 USPQ 308 (1935).

Certificates of correction (35 U.S.C. 255) are available for the correction of an applicant's mistake. The scope of this remedial provision is limited in two ways — by the nature of the mistake for which correction is sought and the nature of the proposed correction. *In re Arnott*, 19 USPQ2d 1049 (Comm'r Pat. 1991). The nature of the mistake for which correction is sought is limited to those mistakes that are:

(A) of a clerical nature,
(B) of a typographical nature, or
(C) of a minor character.

The nature of the proposed correction is limited to those situations where the correction does not involve changes which would:

(A) constitute new matter, or
(B) require reexamination.

A mistake in filing a terminal disclaimer does not fall within any of the categories of mistake for which a certificate of correction of applicant's mistake is permissible, and any attempt to remove or nullify the effect of the terminal disclaimer would typically require reexamination of the circumstances under which it was filed.

Although the remedial nature of reissue (35 U.S.C. 251) is well recognized, reissue is not available to correct all errors. It has been the Office position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. First, the reissue statute only authorizes the Commissioner to reissue a patent "for the unexpired part of the term of the original patent." Since the granting of a reissue patent without the effect of a recorded terminal disclaimer would result in extending the term of the original patent, reissue under these circumstances would be contrary to the statute. Second, the principle against recapturing something that has been intentionally dedicated to the public dates back to *Leggett v. Avery*, 101 U.S. 256 (1879). The attempt to restore that portion of the patent term that was dedicated to the public to secure the grant of the original patent would be contrary to this recapture principle. Finally, applicants have the opportunity to challenge the need for a terminal disclaimer during the prosecution of the application that issues as a patent. "Reissue is not a substitute for Patent Office appeal procedures." *Ball Corp. v. United States*, 729 F.2d 1429, 1435, 221 USPQ 289, 293 (Fed. Cir. 1984). Where applicants did not challenge the propriety of the examiner's obvious–type double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of 35 U.S.C. 251. *Ex parte Anthony*, 230 USPQ 467 (Bd. App. 1982), *aff'd*, No. 84–1357 (Fed. Cir. June 14, 1985).

Finally, the nullification of a recorded terminal disclaimer would not be appropriate in a reexamination proceeding. There is a prohibition (35 U.S.C. 305) against enlarging the scope of a claim during a reexamination proceeding. As noted by the Board in *Anthony*, *supra*, if a terminal disclaimer was nullified, "claims would be able to be sued upon for a longer period than would the claims of the original patent. Therefore, the vertical scope, as opposed to the horizontal scope (where the subject matter is enlarged), would be enlarged."

PTO/SB/ 43 (10-98)
Approved for use through 10/31/99. OMB 0651-0031
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.

## DISCLAIMER IN PATENT

| Name of patentee | Docket Number (Optional) |
|---|---|
| Patent Number | Date Patent Issued |
| Title of Invention | |

I have reason to believe that without any deceptive intention, claims of the above identified patent are too broad or invalid; therefore:

I hereby disclaim the following complete claims in the above identified patent: _____

_____

The extent of my interest in said patent is [if assignee of record, state liber and page, or reel and frame, where assignment is recorded]: _____

The fee for this disclaimer is set forth in 37 CFR 1.20(d).

☐ Patentee is a small entity under 37 CFR 1.9 and 1.27.
- ☐ A verified statement is attached.
- ☐ A verified statement of status as a small entity under 37 CFR 1.27 has already been filed in this case, and is still correct.

☐ A check in the amount of the fee is enclosed.

☐ The Commissioner is hereby authorized to charge any fees which may be required or credit any overpayment to Deposit Account No. _____. I have enclosed a duplicate copy of this sheet.

Signed at _____, State of _____ this _____ day of _____, 19____ .

_____
Signature

_____
Typed or printed name

_____
Address

_____
City, State, Zip Code or Foreign Country as applicable

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents,Washington, DC 20231.

PTO/SB/25 (10-96)
Approved for use through 10/31/99. OMB 0651-0031
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE


| TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING SECOND APPLICATION | Docket Number (Optional) |
|---|---|

In re Application of:
Application No.
Filed:
For:

The owner*, _____ of ___ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number _____, filed on _____. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney of record.

_____ _____
Signature Date

_____
Typed or printed name

☐ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

*Certification under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

PTO/SB/26 (10-96)
Approved for use through 10/31/99. OMB 0651-0031
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT | Docket Number (Optional) |
|---|---|

In re Application of:
Application No.
Filed:
For:

The owner*, ..... of.....percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. ..... . The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney of record.

_____ _____
Signature Date

_____
Typed or printed name

☐ Terminal disclaimer fee under 37 CFR 1.20(d) included.

*Certification under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.