Chapter 1400 Correction of Patents

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

1401 Reissue [R-31]

35 U.S.C. 251. Reissue of defective patents. Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

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

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

The usual grounds for a reissue are that the claims are too narrow or too broad, or that the disclosure has inaccuracies. A reissue was granted in Brenner v. State of Israel, 862 O.G. 661; 158 USPQ 584, 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. The correction of misjoinder of inventors was held to be a ground for reissue in Ex parte Scudder, 169 USPQ 814.

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

A "claim" for the benefit of an earlier filing date in a foreign country under 35 U.S.C. 119 must be made in a reissue application even though such a claim was 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 § 201.14(b).

The heading on printed copies will not be carried forward to the reissue from the original patent. Therefore, it is important that the file wrapper be endorsed under "Claims Foreign Priority."

1401.01 Requisites

Rule 171. Application for reissue. An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications. The application must be accompanied by a certified copy of an abstract of title or an order for a title report, to be placed in the file, and by an offer to surrender the original patent (rule 178).

1401.02 By Whom Filed and to Whom Granted [R-25]

Rule 172. Applicants, assignees. (a) Reissue applications must be signed and sworn to, or declaration made,

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

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

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

1401.03 Notice in Original File [R–34]

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

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

1401.04 Offer To Surrender Original Patent and When Such Patent Is Returned [R–34]

Rule 178. Original patent. The application for a reissue must be accompanied by an offer to surrender the original patent. The application should also be accompanied by the original patent, or if the original is lost or inaccessible, by an affidavit 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 tent will be returned to applicant upon his request.

The examination of the reissue application on the merits is made even though the offer to surrender the original patent or an affidavit or declaration to the effect that the original is lost or inaccessible has not been received, but in such case the examiner should require one of them in the first action.

If applicant requests the return of his patent, on abandonment of the reissue application, it will be sent to him by the Mail and Correspondence Division and not by the examining group.

1401.05 Use of Original Drawing [R–37]

Rule 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 securely mounted by pasting on sheets of drawing board of the size required for original drawing, or an order for the same.

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

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

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

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

When the reissue case is ready for allowance the examining group makes the formal transfer of the original drawing to the reissue case. See § 608.02(k).

1401.06 Form of Specification and Claims [R–22]

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

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

the claims must be amended as specified in rule 121(a). Note rule 121(e).

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

1401.07 New Matter [R-25]

New matter, that is, matter not present in the patent, is excluded from a reissue application with even greater strictness than in an ordinary case. The claims in the reissue case must also be for matter which the applicant had the right to claim in the original patent. New matter may exist by virtue of the omission of a feature or of a step in a method. See United States Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp. 1942 C.D. 751; 315 U.S. 668; 53 USPQ 6.

1401.08 The Reissue Oath or Declaration of [R-25]

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

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

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

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

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

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

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

The question of the sufficiency of the reissue oath or declaration filed under rule 175 must in each case be reviewed and decided personally by the primary examiner.

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

An allegation that the specification is insufficient merely because the claims are too narrow ordinarily satisfies paragraph (a)(3) of the rule.

A broadened reissue claim is one which brings within its scope any subject matter not embraced by the patent claims. A claim broadened in one limitation is a broadened claim though it may be narrower in other details.

Relative to paragraph (a)(4) of the rule, deliberate cancelation of a claim in the original patent application is ordinarily regarded as evidence that the failure to include claims to the involved subject matter in the patent is not due to error. Claims drawn to substantially the same subject matter are not ordinarily successfully urged in the reissue. An error arising from a lack of understanding or knowledge of applicant's attorney as to the real invention may be an acceptable reason for reissue. However, where an alleged lack of understanding by applicant or his attorney is based on a new factual situation, which did not exist at the time the patent was taken out, reissue is improper.

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

1401.09 Examination of Reissue

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

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

Examination of a reissue application involves two aspects, first, it is examined in the same manner as an original application and second, it must be examined for compliance with the reissue statute and rules. The prosecution of the original patent must be carefully studied for its bearing on the reissue questions.

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

1401.09(a) Adjudication of Original Patent [R-31]

When a reissue application is filed, the Examiner should determine whether the original patent has been adjudicated by a court. The decision of the court and also other papers in the suit may give information essential to the

examination of the reissue. The patented file will contain notices of the filing and termination of infringement suits on the patent, which notices are required by law to be filed by the clerks of the District Courts. These notices do not indicate if there was an opinion by the court, nor whether a decision was published. Shepard's Federal Citations and the cumulative digests of the United States Patents Quarterly, both of which are in the Law Library, contain tables of patent numbers giving the citation of published decisions concerning the patent. Where papers are not otherwise conveniently obtainable, the applicant may be requested to supply or lend copies of papers and records in suits, or the Office of the Solicitor may be requested to obtain them from the court. The information thus obtained should be carefully considered for its bearing on the proposed claims of the reissue, particularly when the reissue application was made in view of the holding of a court.

1401.10 Restriction and Election of Species [R–22]

The examiner may not require restriction in a reissue application (rule 176 in § 1401.09). If the original patent contains claims to different inventions which the examiner may nevertheless consider independent and distinct, and the reissue application also claims the same inventions, the examiner should not require restriction between them or take any other action with respect to the question of plural inventions. Restriction is entirely at the option, in the first instance, of the applicant. If the reissue application contains claims to an independent and distinct invention which was not claimed in the original patent, these claims may be treated by a suitable rejection, such as: lack of inoperativeness of, or defect in, the original patent; lack of error; or not being for matter which might have been claimed in the original patent.

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

1401.10(a) Divisional Reissue Applications [R–25]

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

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

1401.11 Allowance and Issue [R–22]

The specifications of reissue patents will be printed in such a manner as to show the changes over the original patent by printing material omitted by reissue enclosed in heavy brackets [ ] and material added by reissue in italics. Rule 173 (see § 1401.06) requires the specification of a reissue application to be presented in a specified form, specifically designed to facilitate this different manner of printing, as well as for other reasons.

The printed reissue specification will carry the following heading which will be added by the Issue Branch:

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

The examiners should see that the specification is in proper form for the new style of printing. Matter appearing in the original patent which is omitted by reissue should be enclosed in heavy brackets, while matter added by reissue should be underlined. All the claims of the patent should appear in the spec-

ification, with omitted claims enclosed in brackets. New claims should follow the number of the highest numbered patent claims and be underlined to indicate italics. The provisions of rule 173 that claims should not be renumbered applies to the reissue application as filed. When the reissue is allowed, any claims remaining which are additional to the patent claims are renumbered in sequence starting with the number next higher than the number of claims in the original patent. Therefore, the number of claims allowed will not

necessarily correspond to the number of the last claim in the reissue application, as allowed.

In the case of reissue applications which have not been prepared in the indicated manner, the examiner may request from the applicant a clean copy of the reissue specification prepared in the indicated form. However, if the deletions from the original patent are small, the reissue application can be prepared for issue by putting the bracketed inserts at the appropriate places and suitably numbering the claims.

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

The list of references to be printed at the end of the reissue specification should include both the references cited during the original prosecution as well as the references cited during the prosecution of the reissue application.

NOTE.—Transfer of drawing. § 1401.05.

There is no issue fee for reissue applications in which the patent being reissued was granted prior to October 25, 1965. For reissue applications in which the patent being reissued was granted after October 25, 1965, the issue fee is the same as for original applications. (35 U.S.C. 41(a)2). [R-37]

1401.12 Reissue Filed While Patent Is in Interference [R-20]

If an application for reissue of a patent is filed while the patent is involved in interference, that application must be called to the attention of the Commissioner before any action by the examiner is taken thereon.

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

1402 Certificates of Correction—Office Mistake [R-22]

35 U.S.C. 254. Certificate of correction of Patent Office mistake. Whenever a mistake in a patent, incurred through the fault of the Patent 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.

Rule 322. Certificate of correction of Office mistake.

(a) A certificate of correction under 35 U.S.C. 254, may be issued at the request of the patentee or his assignee. Such certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notifying the patentee (including any assignee of record) and affording him an opportunity to be heard.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Commissioner may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

Mistakes incurred through the fault of the Office are the subject of Certificates of Correction under rule 322. If such mistakes are of such a nature that the meaning intended is obvious from the context, the Office may decline to issue a certificate and merely place the correspondence in the patented file, where it serves to call attention to the matter in case any question as to it arises.

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

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

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

1402.01 Applicant's Mistake [R-22]

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 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.

Rule 323. Certificate of correction of applicant's mistake. Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issued a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination.

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

35 U.S.C. 256. Misjoinder of inventor. Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, 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 deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without 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 adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error 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.

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

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

1402.02 Handling of Requests for Certificates of Correction [R–37]

Requests for certificates of correction will be forwarded by the Correspondence and Mail Division, to the Solicitor's Office, where they will be listed in a permanent record book.

Determination as to whether an error has been made, the responsibility for the error, if any, and whether the error is of such a nature as to justify the issuance of a certificate of correction will be made by the Solicitor's office. If a report is necessary in making such determination, the case will be forwarded to the appropriate group with a request that the report be furnished. If no certificate is to issue, the party making the request is so notified by the Solicitor's Office, and the request, report, if any, and copy of the communication to the person making the request are placed in the file and entered thereon under "Contents" by the Solicitor's Office. The case is then returned to the patented files. If a certificate is to issue, it will be prepared and forwarded to the person making the request by the Issue and Gazette Division. 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, PO–1050, which can serve as the final copy for use in direct offset printing of the certificate of correction. The request for issuance of the certificate (together with the fee where the error is due to applicant's mistake) should be in a separate letter accompanied by two copies of Form PO–1050 and a self-addressed envelope.

Where the recommended format is used and approved, one copy of Form, PO–1050, duly certified will be returned to the person making the request for attachment to his copy of the patent. This procedure eliminates the necessity for returning the patent when requesting a certificate of correction. The other copy of the Certificate of Correction Form PO–1050 is used for direct offset printing of copies of the certificate which are attached to every printed copy of the patent subsequently sold or distributed.

To facilitate the use of the Form PO–1050, the public may obtain as many copies as needed from the Correspondence and Mail Division or from the receptionist in the lobby of building 3 at Crystal Plaza.

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.

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 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.

Where the recommended format is not used or where the nature of the subject matter is such that it is more expedient to print by the direct image offset technique, e.g., entire sheets of drawing or pages of corrections, intricate chemical formulas, etc., Issue and Gazette Division will prepare the certificate. Patentee will receive a copy for attachment to his copy of the patent.

UNITED STATES PATENT OFFICE

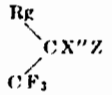
CERTIFICATE OF CORRECTION

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

 should read 

Formula XXXVII, that portion of the formula reading "–CH_2CH–" 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 "five 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.

1403 Statutory Disclaimer [R–37]

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 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.

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

(b) A terminal disclaimer, when filed in an application to obviate a double patenting rejection, must include a provision that any patent granted on that application 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. See rule 21 for fee.

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

Terminal disclaimers may affect the prosecution of other applications. They are brought to the examiner's attention by the Issue and

Gazette Division which attaches a label to the file wrapper and forwards the file containing them to the examining group after having a title search made, endorsing the paper on the "Contents" and otherwise insuring that the patent, if issued, will be properly headed.

Terminal Disclaimer in Pending Application Practice

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 interest in the application and should specify the date when the disclaimer is to become effective. An acceptable form for such a disclaimer is as follows:

To the Commissioner of Patents:

Your petitioner, John Doe, residing at _____ in the county of _____ and State of _____ represents that he is (here state exact interest of disclaimant and, if he is an assignee, set out the liber and page or reel and frame where the assignment is recorded) of Application No. _____, filed on the _____ day of _____ 19__ for _____. Your petitioner hereby disclaims all that portion of the term of any patent to be issued on the said application subsequent to _____ 19____.

The disclaimer must be accompanied by the statutory fee.

Form 53—Terminal Disclaimer To Obviate a Double Patenting Rejection

To the Commissioner of Patents:

Your petitioner, _____, residing at _____ in the county of _____ and State of _____ represents that he is (here state exact interest of the disclaimant and, if he is an assignee, set out the liber and page or reel and frame where the assignment is recorded) of application Serial No. _____, filed on the _____ day of _____, 19__ for _____. Your petitioner, _____, hereby disclaims the terminal part of any patent granted on the above-identified application, which would extend beyond the expiration date of Patent No. _____ and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to United States Patent No. _____, this agreement to run with any patent granted on the above identified application and to be binding upon the grantee, its successors or assigns.