

# Chapter 1400 Correction of Patents

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

## 1401 Reissue

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

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

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

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

*35 U.S.C. 41. Patent Fees.* (a) The Commissioner shall charge the following fees: . . .

4. On filing each application for the reissue of a patent, \$65; in addition, on filing or on presentation at any other time, \$10 for each claim in independent form which is in excess of the number of independent claims of the original patent, and \$2 for each claim (whether independent or dependent) which is in excess of ten and also in excess of the number of claims of the original patent. Errors in payment of the additional fees may be rectified in accordance with regulations of the Commissioner. . . .

The reissue claims must be for the invention 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. There should be something in the original patent evidencing that applicants intended to claim or that applicants considered the material now claimed to be their invention: *In re Rowand et al*, 187 USPQ 487 (CCPA 1975).

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."

The applicant is permitted to present every claim that was issued in the original patent for a fee of 65 dollars. Additional claims must be paid for in the same manner as claims must be paid for in original applications. The filing fee for a design reissue application is 65 dollars.

### 1401.01 Requisites

*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 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 (§ 1.178).

Reissue applicants may utilize new Sections 1.97-1.99 to comply with the duty of disclosure required by Section 1.56. While Section 1.97(a) provides for filing of the prior art statement within three months of the filing of the application, reissue applicants are encouraged to file the prior art statement at the time of filing the application in order that such prior art statements will be available to the public during the two-month period provided by Section 1.176.

### 1401.02 By Whom Filed and to Whom Granted

*37 CFR 1.172. Applicants, assignees.* (a) Reissue applications must be signed and sworn to, or declaration made, by the inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), 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 37 CFR 1.172 has been complied with.

### 1401.03 Notice in Original 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 entered on the file wrapper of the original patent and pertinent data filed in by the Application Division. When divisional or continuation reissue applications are filed, a separate form for each application is placed in the original patent. 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

*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.

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. 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.

If applicant requests the return of the 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.

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 Serial 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.

### 1401.05 Use of Original Drawing

*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 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.

The letter of transmittal in a reissue application should request transfer of the drawings, if such transfer is desired.

Applicant must submit a copy of the original drawing or "an order for same" (37 CFR 1.174) 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). Additional sheets of drawings may be added.

### 1401.06 Form of Specification and Claims

*37 CFR 1.175. 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 Serial Number on the front of the file. "Reissue" also

appears below the Serial Number on the printed label on the file wrapper.

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 37 CFR 1.121(a). Note 37 CFR 1.121(e).

An example of the form for a twice-reissued patent is found in Re. 23,558 and 28,488.

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 chemical formulas should be shown by brackets which are substantially larger and darker than any in the formula.

### CERTIFICATE OF CORRECTION 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 verify that all Certificate of Correction changes have been properly incorporated into the reissue application.

### 1401.07 New Matter

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

### 1401.08 The Reissue Oath or Declaration of

*37 CFR 1.175. Reissue oath or declaration.* (a) Applicants for reissue, in addition to complying with the requirements of the first sentence of § 1.65, must also file with their applications a statement under oath or declaration as follows:

(1) When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief 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) When the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid, particularly specifying such prior art or other information and requesting that if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent.

(5) Particularly specifying the errors or what might be deemed to be errors relied upon, and how they arose or occurred.

(6) Stating that said errors, if any, 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 37 CFR 1.175 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. *Fox Typewriter Co. v. Corona Typewriter Co.*, 282 F. 502; *In re Bostwick*, 26 CCPA 1117, 102 F. 2d 886, 41 USPQ 279; *Schenk v. United Aircraft Corp.*, 43 F. Supp. 679, 51 USPQ 519; and *Mercoid Corp. v. Milwaukee Gas Specialty Co.*, 33 F. Supp. 681, 46 USPQ 23; and *In re Rogoff*, 120 USPQ 185 (CCPA 1958).

Section 1.175(a)(4) of the revised rules recognizes that reissues may be filed to have the patentability of the original patent, without changes therein, considered in view of prior art or other information relevant to patentability which was not previously considered by the Office.

The experience to date reveals the need to clarify what should be filed by the applicant in order to seek the reexamination contemplated by sub-section (a)(4) and also the type and content of the examination which the examiner will give to applications filed under sub-section (a)(4).

First, sub-section (a)(4) does *not* contemplate, or permit, the filing of a reissue application without an oath or declaration. To the contrary, an oath or declaration is required, and such oath or declaration *must* comply with each of sub-sections (a)(4), (a)(5), and (a)(6). Thus, under sub-section (a)(4) the oath or declaration must particularly specify the "prior art or other information relevant to patentability, not previously considered by the Office," which the reissue applicant considers "might cause the examiner to deem the original patent wholly or partly inoperative or invalid." The reissue oath or declaration must also request, under sub-section (a)(4), that "if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent."

Thus, a patentee may file a reissue if he or she believes his or her patent is valid over prior art not previously considered by the Office but would like to have a reexamination. The procedure may be used at any time during the life of a patent. During litigation, a federal court may, if it chooses, stay proceedings to permit new art to be considered by the Office.

If a reissue application is filed as a result of new prior art with no changes in the claims or specification and the examiner finds the claims patentable over the new art, the application will be rejected as lacking statutory basis for a reissue, since 35 U.S.C. 251 does not authorize reissue of a patent unless it is deemed wholly or partly inoperative or invalid. However, the record of prosecution of the reissue will indicate that the prior art has been considered by the examiner. If a rejection is made in an application filed with a section 1.175(a)(4) type oath or declaration, and applicant responds by amending the claims, a new oath or declaration will be required.

Under sub-section (a)(5), the reissue oath or declaration, including those filed under sub-section (a)(4), must particularly specify "the errors or what might be deemed to be errors relied upon, and how they arose or occurred." This sub-section has two specific requirements, *both of which must be complied with* in, or by, the reissue oath or declaration. Thus, insofar as (a)(4) reissue oaths or declarations are concerned, the oath or declaration must particularly specify "what might be deemed to be errors." For example, if the reissue applicant is seeking reexamination in view of particular prior art or other information, the reissue oath or declaration must point out "what might be deemed to be errors" in patentability in view of such prior art or other information. More specifically, the oath or declaration, in appropriate circumstances, might state that some or all claims might be deemed to be too broad and

invalid in view of references X and Y which were not of record in the patented files. Usually, a general statement will suffice. But where appropriate, such as where the pertinence of the new references X and Y are not evident, more specificity about "what might be deemed to be errors" should be provided. Of course, the reissue applicant does *not* have to, and presumably does *not*, agree that "errors" exist. However, the reissue applicant does have to, in the reissue oath or declaration of the sub-section (a) (4) type, particularly specify "what might be deemed to be errors relied upon."

In addition to specifying "what might be deemed to be errors relied upon," sub-section (a) (5) also requires "particularly specifying" "how they arose or occurred." This means, of course, that the reissue oath or declaration must specify the manner in which that which "might be deemed to be errors" "arose or occurred." For example, if the (a) (4) reissue is being filed for reexamination in view of prior art or other information, the reissue oath or declaration must indicate when and the manner in which the reissue applicant became aware of the possible error in the patent, e.g., third party allegation, discovery of prior art or other information subsequent to issuance of patent, knowledge of prior art or other information before issuance of patent with significance being brought out after issuance by third party, through allegations made in litigation involving the patent, etc. It is particularly important that the reissue oath or declaration adequately specify how "what might be deemed to be errors" arose or occurred. If the reissue oath or declaration does not particularly specify "how," i.e., the manner in which any possible errors arose or occurred, the Office will be unable to adequately evaluate reissue applicant's statement in compliance with (a) (6) that the "errors, if any, arose 'without any deceptive intention' on the part of the applicant."

Sub-section (a) (6) specifically requires that the reissue oath or declaration including those filed under sub-section (a) (4), contain the averment that the "errors, if any, arose 'without any deceptive intention' on the part of the applicant." This requirement must not be overlooked in filing since the requirement for an absence of "deceptive intention" is a necessary part of any reissue application, including those of the (a) (4) type.

The significance and importance of sub-sections (a) (5) and (a) (6) must not be overlooked or minimized insofar as reissue oaths or declarations are concerned, including those filed under sub-section (a) (4). These sub-sections, to a large extent, enable the Office to make its determination required by statute that any error is "without any deceptive intention."

In addition to meeting the requirements of Sections 1.175(a) (4)-(a) (6) insofar as the reissue oath or declaration is concerned, the reissue applicant, at the time of filing the reissue application, including the (a) (4) type reissue application, must also be aware of the requirements of 37 CFR 1.56, as revised effective March 1, 1977.

Relative to paragraph (a) (5) of the rule, deliberate cancellation of a claim in the original patent application is ordinarily regarded as evidence that the failure to include claims to the involved subject matter in the patent is not due to error. The patent statutes afford no authority for the reissue of a patent merely to add other claims of the same scope as those already granted, *In re Witty*, 180 USPQ 320 (CCPA 1974). 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.

Where the reissue oath or declaration is found insufficient, all new claims in the reissue application to which the insufficiency applies should be rejected on the basis that the reissue oath or declaration is insufficient, *In re Witty*, 180 USPQ 320 (CCPA 1974).

#### 1401.09 Examination of Reissue

*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.

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, § 1.176 provides that examination of reissue applications will not be started until two months after the publication of the announcement of filing in Official Gazette pursuant to 37 CFR 1.11. The Office will entertain petitions under 37 CFR 1.183 to waive the delay period of 37 CFR 1.176.

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

Since the examining group which issued the original patent is listed in the Official Gazette notice of filing of the reissue application, the indicated examining group should retain the application file for two months after the date of the Official Gazette notice before transferring the reissue application under the procedure set forth in § 903.08(d).

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.

When examining the reissue application the examiner will consider whether or not applicant, in the reissue oath or declaration, has complied with each of the requirements of 37 CFR 1.175. For example, in all reissue applications, the reissue oath or declaration must comply with the requirements of the first sentence of 37 CFR 1.65. When the reissue application is other than the (a) (4) type, the reissue oath or declaration must comply with the appropriate sub-sections (a) (1) to (a) (3) and sub-sections (a) (5) and (a) (6). When the reissue application is filed under sub-section (a) (4), the reissue oath or declaration must also comply with sub-sections (a) (5) and (a) (6). Thus, all reissue applications must comply with sub-sections (a) (5) and (a) (6). If the examination reveals a lack of compliance with any requirement of Section 1.175, e.g., the requirements of sub-sections (a) (5) and/or (a) (6), a rejection will be made on the basis that the reissue oath or declaration is insufficient. See Section 1401.08. Under no circumstances will any reissue application be passed for issue without full compliance with 37 CFR 1.175.

Applications filed under sub-section (a) (4) will not, of course, be passed for issue without amendment, but will be rejected as lacking statutory basis for a reissue if *there are no other grounds for rejection*, since 35 U.S.C. 251 does not authorize reissue of a patent unless the patent unless the patent is deemed wholly or partly inoperative or invalid. If a reissue filed under sub-section (a) (4) is subsequently amended thereby converting it into an application under sub-sections (a) (1) to (a) (3), *a supplemental reissue oath or declaration must be filed containing the appropriate averments*. If such a proper supplemental oath or declaration is not filed, a rejection will be made on the basis that the reissue oath or declaration is insufficient. The supplemental oath or declaration insures compliance with 35 U.S.C. 251 by providing appropriate averments relating to actual errors rather than possible errors.

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

However, any application which indicates the existence of a *question* of "fraud" or "violation of the duty of disclosure" will be forwarded to the Office of the Assistant Commissioner for Patents pursuant to Section 721.01, as soon as the existence of *such question* is appreciated. For example, any reissue application which seeks reexamination in view of material prior art or other information known before issuance of the patent to a person having a duty under 37 CFR 1.56(a) must be forwarded under Section 721.01, to the Assistant Commissioner via the Group Director.

#### 1401.09(a) Adjudication of Original Patent

In situations in which the patent for which reexamination is being sought is, or has been, involved in litigation, which raised a question material to examination of the reissue application, such as the validity of the patent, or any allegation of fraud, the existence of such litigation must be brought to the attention of the Office 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 the examination" of the reissue application as defined in 37 CFR 1.56(a), should accompany the application as filed, or be submitted as promptly thereafter as possible. For example, the defenses raised against validity of the patent, or charging fraud or inequitable conduct in the litigation, would normally be "material to the examination" 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 relating to validity and/or "fraud" relating to the original patent, and the nature of litigation materials relating to these issues. Enough information should be submitted to clearly inform 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 or "fraud" should, at least, be fully described, or submitted. The Office is *not*, of course, 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 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.

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 same. The following paragraph may be used for such an inquiry:

"It has come to the attention of the examiner that the patent sought to be reissued by this application (is) (has been) involved in litigation. Any documents and/or materials, including the defenses raised against validity, or against enforceability because of fraud or inequitable conduct, which would be material to the examination of this reissue application are required to be made of record in response hereto. See 37 CFR 1.175(b)."

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 under 37 CFR 1.175(b).

## 1401.10 Restriction and Election of Species

The examiner may not require restriction in a reissue application (§ 1.176 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: not being "for the invention disclosed in the original patent," as evidenced by the claims in the original patent, *In re Rowand*, 187 USPQ 487 (CCPA 1975), lack of inoperativeness of, or defect in, the original patent; lack of error; or not being for matter which might have been claimed in the original patent.

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

### 1401.10(a) Divisional Reissue Applications

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

*37 CFR 1.177. 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 §§ 1.83 and 1.84. On filing divisional reissued applications, they shall be referred to the Com-

missioner. 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.

Divisional reissue cases which arrive together from the Examining Corps with appropriate identification on their file jackets (in the Continuing Data box) should be kept and processed together by the Patent Issue Division and throughout all stages of preparation for issue. 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.

Some special handling of divisional reissue applications is required in various parts of the Office.

Appropriate amendments to the continuing data entries are to be made to the file jackets and specification paragraphs for all such applications so that all "brother" divisional reissue applications are specifically identified.

#### 1401.11 Allowance and Issue

In all reissue applications prepared for issue, a horizontal line should be drawn through the middle of the "NAME" box on the blue Issue Classification Slip (form PTO-270). The applicant's name should be placed in the upper portion of the box and the number of the original patent being reissued should be placed in the lower portion of the box.

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. Section 1.173 (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 Patent Issue Division:

"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. 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. However, cancellation of material in the original patent should be indicated by brackets.

All the claims of the patent should appear in the specification, with omitted claims enclosed in brackets. No renumbering of the original patent claims is necessary, even if the dependency of a dependent claim is changed by reissue so that it is dependent on a subsequent higher numbered claim. However, when a dependent claim in a reissue application depends upon a claim which has been canceled and no change in dependency to a remaining claim has been made, such a dependent claim must be rewritten in independent form. New claims should follow the number of the highest numbered patent claims and be underlined to indicate italics. The provisions of § 1.173 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.

At least one claim of an allowable reissue application must be designated for printing in the Official Gazette. Whenever possible, that claim should be one which has been changed or added by the reissue. A canceled claim must not be designated as the claim for the Official Gazette.

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. A patent cannot be reissued solely for the purpose of adding citations of additional prior art.

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 set forth in 35 U.S.C. 41(a)2.

### 1401.12 Reissue Filed While Patent Is in Interference

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

When an application for reissue of a patent is filed while the patent is involved in interference, a letter 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

*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 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 Correc-

tion 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. 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 (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)."

### 1402.01 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 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 reexamination.

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. A mistake is not of a minor character if the requested change would materially affect the scope or meaning of the patent.

The Issue Fee Transmittal Form portion (PTOL-85b) of the Notice of Allowance provides a space (item 2) for assignment data

which should be completed in order to comply with 37 CFR 1.334. Unless an assignee's name and address are identified in item 2 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 correction of error arising from incomplete or erroneous information furnished in item 2 of PTOL-85b will not be granted as a matter of course and will be subject to adherence to all the requirements of 37 CFR 1.323.

*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.

*37 CFR 1.324. 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 37 CFR 1.324 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 37 CFR 1.65 corresponding to the newly asserted inventorship must be submitted.

## 1402.02 Handling of Requests for Certificates of Correction

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

Division, to the Decision and Certificate of Correction Branch of the Patent Issue Division, 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 Decision and 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 Decision and 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 Patent Issue 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, PTO-1050, which can serve as the camera copy for use in direct offset printing of the certificate of correction. 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 address, and for ordering any desired additional copies of the printed certificate. The fee for each additional copy ordered is 30 cents per page. The fee should accompany the request.

To facilitate the use of the Form PTO-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.

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 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 repro-

duced 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 revised, 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

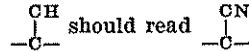
It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

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 "~~CH<sub>2</sub>CH~~" 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 "tixe 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 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 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 § 1.21 for fee.

A disclaimer is a statement filed by an owner (in part or in entirety) of a patent or of a patent to be granted, in which said owner relinquishes certain legal rights to the patent. There are two types of disclaimers; statutory and terminal.

#### 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.

#### 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(b) specifically provides for the filing of a terminal disclaimer in an application for the purpose of overcoming a rejection for double patenting.

#### PROCESSING

The Decision and Certificate of Correction Branch of the Patent Issue Division is responsible for the handling of all disclaimers filed under 35 U.S.C. 253, whether the case is pending or patented. This involves:

1. Determining compliance with 35 U.S.C. 253 and 37 CFR 1.321;
2. Notifying applicant or patentee when the disclaimer is informal and thus not acceptable;
3. Recording the disclaimers; and
4. Providing the disclaimer data for printing.

*Terminal* disclaimers may affect the prosecution of other applications. They are brought to the examiner's attention by the Patent Issue Division which attaches a label to the file wrapper 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 dis-

claimers 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.

#### FORMS

##### STATUTORY DISCLAIMER

###### FORM 3.43—DISCLAIMER IN PATENT

To the Commissioner of Patents and Trademarks:

Your petitioner, \_\_\_\_\_, residing at \_\_\_\_\_, in the county of \_\_\_\_\_ and State of \_\_\_\_\_, represents that he is (here state the exact interest of the disclaimant; if assignee, set out liber and page, or reel and frame, where assignment is recorded) of letters patent of the United States No. \_\_\_\_\_, granted to \_\_\_\_\_ on the \_\_\_\_\_ day of \_\_\_\_\_, 19\_\_\_\_, for \_\_\_\_\_ and that he has reason to believe that without any deceptive intention claims of said letters patent are too broad or invalid. Your petitioner, therefore, hereby disclaims claim \_\_\_\_\_ of said patent.

Signed at \_\_\_\_\_, State of \_\_\_\_\_ this \_\_\_\_\_ day of \_\_\_\_\_, 19\_\_\_\_.

(Signature)

##### TERMINAL DISCLAIMER

To the Commissioner of Patents and Trademarks:

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 3.53—TERMINAL DISCLAIMER To OBLIATE A DOUBLE PATENTING REJECTION

To the Commissioner of Patents and Trademarks:

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.