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## PATENT REISSUE Frequently Asked Questions<sup>1</sup>



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# *Patent Reissue*

## *A. Remedial Statute 35 U.S.C. § 251*

### 1. What is a Reissue Patent Application?

**Answer:** A reissue application is filed to correct an error in an issued patent<sup>2</sup>.

The most common bases for filing a reissue application are *inter alia*:

- (A) the original patent claims are too narrow or too broad;
- (B) the disclosure contains inaccuracies;
- (C) applicant failed to or incorrectly claimed foreign priority; and
- (D) applicant failed to make reference to or incorrectly made reference to prior copending applications.

The error must have been made without any deceptive intention, where, as a result of the error, the patent is deemed wholly or partly inoperative or invalid. An error in the patent arises out of an error in conduct which was made in the preparation and/or prosecution of the application which became the patent. See MPEP § [1401](#).

There must be at least one error in the patent to provide grounds for reissue of the patent. If there is no error in the patent, the patent will not be reissued.

### 2. As a Patent Owner, why use Patent Reissue rather than Patent Reexamination?

**Answer:** The original patent claims may be wholly or partly inoperative for reasons other than lack of novelty and obviousness. Since reexamination can only be based on patents and printed publications, reissue is the only way for applicants to correct their patents for errors of the specification and for claim defects relating to subject matter eligibility, utility, written description, enablement and clarity.

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<sup>2</sup> 35 U.S.C. 254 & 255 provide for the correction of a clerical, typographical or minor character error of a patent via a Certificate of Correction. Corrections impacting claim scope/enforceability are outside of the purview of this statute.

Additionally, reexamination does not allow broadening of claims. If filed within a certain limited time, a broadening reissue may be filed to pursue an enlarged claim scope. Otherwise, a reissue, like a reexamination can only be “narrowing” with respect to claim scope.

3. When is a “Broadening” Reissue available?

**Answer:** Under 35 U.S.C. § [251](#), a broadened reissue must be filed within two years of the original patent grant.

4. Is there a limit on when I can present broadened claims in a Reissue? How do I indicate this intent?

**Answer:** Applicant should manifest his/her intent to file a broadened reissue in the reissue oath or declaration. Once a broadened reissue is timely filed applicant can seek to add new broadened claims outside the two year limit.

Applicant cannot file a narrowing reissue application within two years of the original patent grant, then seek to file broadened claims outside the two year limit. Applicant can file a broadened continuation reissue outside the two year limit when the broadened parent reissue was filed within the two year limit. See MPEP § [1412.03](#).

5. What does “broader” mean?

**Answer:** Within the context of reissue patent law, a claim is considered to be broadened when it has been broadened in any respect even if it may have been narrowed in other respects. See MPEP § [1412.03](#). Generally speaking, the word “broader” means that something will now infringe the claim in its new form which would not have infringed the original patent claim.

6. Is there a limit on when I can file a narrowing reissue?

**Answer:** Once a patent has expired, the Director of the USPTO no longer has the authority to reissue the patent. See MPEP §§ [1415.01](#) and [1443](#). If the patent has not expired applicant may file for a narrowing reissue where the original patent was granted through error and without deceptive intent. In contrast, a request for reexamination can be filed at any time during the period of enforceability of the patent. The period of enforceability is determined by adding 6 years to the date on which the patent expires. See 37 C.F.R. § 1.510(a).

7. For cases in which I have a choice of filing a narrowing reissue or a Patent Owner initiated *ex parte* reexamination what are some of the considerations that impact the selection of one proceeding over the other?

**Answer:** The filing for reissue exposes all issued claims to a second examination. Thus, if only a single, or subset of claims of an issued patent are in question, a reexamination request will generally allow a patent holder to limit the USPTO review to these specific claims only. See MPEP §2243 (“The Office's determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the claim(s) for which reexamination was requested”). On the other hand, a benefit of reissue proceedings is that extensions of time, and requests for continued examination or continuations may be filed; this is not so in reexamination proceedings. Finally, all claims will be examined with respect to compliance with 35 U.S.C. §§ 102, 103, 112, 251 and 101 as well as obviousness-type double patenting in reissue. In reexamination claims are evaluated based on their novelty, nonobviousness and obviousness-type double patenting over prior art patents and printed publications. In reexamination proceedings section 112 is available to the USPTO in the analysis of amended claims and newly added claims. 37 CFR § 1.552(a). 35 U.S.C. § 101 is not applied in reexamination outside of double patenting issues.

8. Are the time periods for reissue responses the same as for normal prosecution?

**Answer:** In most circumstances, yes. See MPEP § 1440 and 37 C.F.R. § 1.176(a) (“A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications.”). However, when the original patent is in a litigation that is stayed, applicants are given a one-month or thirty day shortened statutory period (“SSP”) whichever is longer for reply.

9. Who examines a reissue application?

**Answer:** Reissue applications are normally examined by the same examiner who issued the patent for which reissue is requested. See MPEP § 1440. This is quite different from patent reexamination. In patent reexamination, a special unit of the USPTO, the Central Reexamination Unit performs examination and the examiner of the original patent is precluded from participating in the reexamination proceeding.

10. Is there a special format for making amendments?

**Answer:** Yes, the manner of making amendments to a reissue specification, drawings and claims is set forth in 37 C.F.R. § 1.173. See MPEP § 1453.

## 11. How quickly does an Examiner act on a reissue application?

**Answer:** Officially, Applications for reissue will be acted on by the examiner in advance of other applications. 37 C.F.R. § [1.176\(a\)](#). Reissue applications with related litigation will be acted on by the examiner before any other special applications, and will be acted on immediately by the examiner, subject only to a 2-month delay after notice of the filing of the reissue application has been published in the Official Gazette for examining reissue applications. See MPEP §§ [1440](#), [1441](#) and [1442](#).

In practice, reissue applications tend to be treated by Examiners as any other application, turning the order of examination. Reexamination cases are treated with “special dispatch” as explained in the *ex parte* and *inter partes* Reexamination FAQ.

## 12. Can I file a Reissue Application to pursue restricted claims I forgot to pursue?

**Answer:** A reissue applicant's failure to timely file a divisional application covering the non-elected invention(s) following a restriction requirement is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. See MPEP § [1412.01](#). Thus, such an error is not correctable by reissue of the original patent under 35 U.S.C. § [251](#). Cf., *In re Doyle*, 482 F.2d 1385 (Fed. Cir. 2002) (Reissue was permitted to add linking claims).

## 13. Can a Reissue application be filed that only presents dependent claims?

**Answer:** The USPTO currently advises that an error under 35 U.S.C. § [251](#) *has not been presented* where a reissue application only adds one or more claims that is/are narrower than one or more broader existing patent claims without either narrowing the broader patent claim by amendment or canceling the broader patent claim. See MPEP § [1402](#). A reissue application in which the only error specified to support reissue is the failure to include one or more claims that is/are narrower than at least one of the existing patent claim(s) without an allegation that one or more of the broader patent claim(s) is/are too broad together with an amendment to such claim(s), does not meet the requirements of 35 U.S.C. § [251](#).

Although a reissue applicant may regard the absence of certain narrower claims to be "an error," the original patent is simply not wholly or partly inoperative to protect the invention due to the absence of a narrow claim when the invention to which that narrow claim is directed is covered by one or more broader existing patent claims that the reissue applicant does not propose to either narrow or cancel. The original patent is also not wholly or partly invalid by reason of one or more claims being too broad if the reissue applicant does not propose to either narrow such claims by amendment or cancel them. The allegation that the patent is defective for "claiming less than patentee had a right to claim" does not mean that there are too few claims, but rather that the patent claims are not broad enough to protect the invention (and the patent is thereby inoperative to protect the disclosed invention). Therefore, where no broadening claims are presented, such an allegation does not correctly set forth a 35 U.S.C. § [251](#) error.

#### 14. What is the recapture doctrine?

**Answer:** A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. See MPEP § [1412.02](#). In *In re Clement*, the Court of Appeals for the Federal Circuit set forth a three step test for recapture analysis. *In re Clement*, 131 F.3d 1464, 1468-70, 45 USPQ2d 1167, 1164-65, (Fed. Cir. 1997). In *North American Container, Inc. v. Plastipak Packaging, Inc.*, the court restated this test as follows:

We apply the recapture rule as a three-step process:

- (1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims;
- (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and
- (3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.

Regarding step (2), if the original patent claim limitation being omitted or broadened in the reissue application was originally relied upon by applicant in the original application to make the claims allowable over the applied art, the omitted limitation relates to subject matter previously surrendered by applicant. The recapture doctrine does not apply to non-art related amendments.

#### 15. Do signatures necessary for reissue declarations pose any problems?

**Answer:** In a narrowing reissue, the assignee may sign the reissue declaration. However, in a broadening reissue, the inventors must sign, unless one or more of the inventors cannot be located or refuse to sign the reissue declaration. 37 C.F.R. § [1.172\(a\)](#).; See also MPEP § [1410.01](#). In such case, a petition must be filed under 37 C.F.R. § [1.47](#).

#### 16. When is the consent of the assignee needed?

**Answer:** The reissue oath or declaration must be accompanied by a written consent of all assignees. See MPEP § [1410.01\(I\)](#). The consent of assignee must be signed by a party authorized to act on behalf of the assignee. Where the written consent of all the assignees cannot be obtained, applicant may under appropriate circumstances petition to the Office of Petitions (MPEP § [1002.02\(b\)](#)) for a waiver under 37 C.F.R. § [1.183](#) of the requirement of 37 C.F.R. § [1.172](#), to permit the acceptance of the filing of the reissue application. The petition fee under 37 C.F.R. [1.17\(f\)](#) must be included with the petition. The assignee must establish its ownership in accordance with 37 C.F.R. § [3.73\(b\)](#).

17. What are examples of the statement that the applicant believes the original patent to be wholly or partly inoperative or invalid?

**Answer:** In order to satisfy this requirement, a declaration can state for example:

1. "Applicant believes the original patent to be partly inoperative or invalid by reason of a defective specification or drawing."
2. "Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming *more* than patentee had a right to claim in the patent."
3. "Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming *less* than patentee had a right to claim in the patent."

A statement that "Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming *more or less* than patentee had a right to claim in the patent" will not satisfy 37 C.F.R. § [1.175](#). See MPEP § 1414.

18. What is required to establish the basis for the reissue?

**Answer:** The reissue oath or declaration must include a statement of at least one error made without deceptive intent, which is relied upon to support the reissue application. The reissue focuses on two separate errors: an error in the patent, and an error in conduct that caused the error in the patent.<sup>3</sup> With regard to the error in conduct, see question (21) below. As to the error in the patent, a reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). See MPEP § [1414\(II\)](#).

19. Does the statement of error need to include all of the errors upon which reissue is based?

**Answer:** No. Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. See MPEP § [1414\(II\)](#). Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied. Applicant may specify more than one error. Where more than one error is specified in the oath/declaration and some of the designated "errors" are found not to be "errors" under [35 U.S.C. § 251](#), any remaining error which is an error under [35 U.S.C. § 251](#) will still support the reissue. The "at least one error" which is relied upon to support the reissue application must be set forth in the oath/declaration.

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<sup>3</sup> See *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 882 F.2d 1556 (Fed. Cir. 1989).

## 20. How specific does the statement of error need to be?

**Answer:** It is not sufficient for an oath/declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." Rather, the oath/declaration must specifically identify an error. *See* MPEP § [1414\(II\)](#). In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such identifies the error. *See In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), *cert. denied*, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.

A statement of "failure to include a claim directed to" and then presenting a newly added claim, would not be considered a sufficient "error" statement because applicant has not pointed out what the other claims lacked that the newly added claim has, or vice versa. Such a statement would be no better than saying in the reissue oath or declaration that "this application is being filed to correct errors in the patent which may be noted from the change made by adding new claim 10." In both cases, the error has not been identified.

Likewise, a statement of the error as "the inclusion of claims 3-5 which were unduly broad" and then canceling claims 3-5, would not be considered a sufficient "error" statement because applicant has not pointed out what the canceled claims lacked that the remaining claims contain. The statement of what the remaining claims contain need not identify specific limitations, but rather may provide a general identification, such as "Claims 3-5 did not provide for any of the tracking mechanisms of claims 6-12, nor did they provide an attachment mechanism such as those in claims 1-2 and 9-16."

## 21. What is required in the statement of no deceptive intent?

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

"All errors in the present reissue application up to the time of signing of this oath/declaration, or errors which are being corrected by a paper filed concurrently with this oath/declaration which correction of errors I/we have reviewed, arose without any deceptive intention on the part of the applicant." *See* MPEP § [1414\(III\)](#).

In principle, nothing more is required<sup>4</sup>. The examiner will determine only whether the reissue oath/declaration contains the required averment.

## 22. When is a supplemental declaration required and what needs to be in it?

**Answer:** Whenever amendments are made during the course of prosecution to the reissue application, after the submission of the original reissue declaration, a supplemental reissue declaration must be filed before the reissue application is allowed. 37 C.F.R. § [1.175\(b\)](#); *See*

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<sup>4</sup> Note the requirements of 37 CFR § 11.18(b) must also be satisfied by any person signing a paper submitted to the USPTO.

MPEP § [1414.01](#). Such supplemental reissue declaration may simply recite the standard form paragraph [14.05.02](#) set forth in MPEP § [1444\(II\)](#) where the original reissue declaration has specified an error which is still being corrected in the reissue application. However, where the error specified in the original reissue declaration is no longer applicable, the supplemental reissue declaration must specify at least one error that is applicable to the reissue application in its current form.

### 23. What happens to my original patent if I abandon the reissue application?

**Answer:** Until a reissue application is granted, the original patent shall remain in effect. Consequently, the original patent will remain in effect when a reissue application is abandoned. See 37 CFR § 1.178. The file history of the abandoned reissue application will remain publicly available.

## ***B. MPEP TABLE OF CASES***

<b>Case Name</b>	<b>Citation</b>	<b>Subject Matter</b>	<b>Description of Significance</b>
North American Container, Inc. v. Plastipak Packaging, Inc.	415 F.3d 1335 (Fed. Cir. 2005)	(recapture doctrine)	("A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent.")
Eggert, Ex parte	67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003)	(recapture doctrine)	(Recapture doctrine does not reject a reissue claim that recites a broader form of a key limitation argued during original prosecution to overcome an art rejection.)
Novo Industries L.P. v. Micro Molds Corp.	350 F.3d 1348 (Fed. Cir. 2003)	(correction through district court)	(District Courts have limited authority to correct patents.)
Doyle, In re	293 F.3d 1355 (Fed. Cir. 2002)	(linking claim)	("Linking claims" are allowable in reissue applications.)
Pannu v. Storz Instruments, Inc.	258 F.3d 1366 (Fed. Cir. 2001)	(recapture doctrine)	("A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent.")
Yamaguchi, Ex parte	61 USPQ2d 1043 (Bd. Pat. App. & Inter. 2001)	(broadening - surrendered subject matter)	(Surrender cannot be based solely upon applicant failure to respond to, or challenge, an examiner's statement made during prosecution.)

<b>Case Name</b>	<b>Citation</b>	<b>Subject Matter</b>	<b>Description of Significance</b>
B.E. Meyers & Co. v. United States	56 USPQ2d 1110 (US CtFedCls 2000)	(recapture doctrine)	(Permissible to remove a limitation added to obtain the patent, "where the replacement limitation provided a separate invention.")
Hayes, In re	53 USPQ2d 1222 (Comm'r Pat. 1999)	(broadening - supplemental oath or declaration)	(All inventors must sign a supplemental reissue oath or declaration.)
Hester Industries, Inc. v. Stein, Inc.	142 F.3d 1472 (Fed. Cir. 1998)	(recapture doctrine)	("A reissue will not be granted to 'recapture' claimed subject matter which was surrendered in an application to obtain the original patent.")
Metz, In re	173 F.3d 433 (Fed. Cir. 1998) (table)	(interference through reissue)	(Patentee may file "a reissue application to copy claims from a patent in order to provoke an interference with that patent." )
Slip Track Systems, Inc. v. Metal Lite, Inc.	159 F.3d 1337 (Fed. Cir. 1998)	(interference through reissue)	(Impermissible to file a reissue application solely to provoke an interference without asserting an error in the patent.)
Vectra Fitness, Inc. v. TNWK Corp.	162 F.3d 1379 (Fed. Cir. 1998)	(broadening)	(Reissue claims are considered broadened if they are broader than claims that remain after disclaimer, even though they may be narrower than claims that were disclaimed before reissue.)

<b>Case Name</b>	<b>Citation</b>	<b>Subject Matter</b>	<b>Description of Significance</b>
Clement, In re	131 F.3d 1464 (Fed. Cir. 1997)	(recapture doctrine)	(Court of Appeals for the Federal Circuit sets forth a three step test for recapture analysis.)
Graff, In re	111 F.3d 874 (Fed. Cir. 1997)	(continuing reissue application - broadening)	(Broadened claims in a continuing reissue application will be rejected if the proposal for broadened claims was not made in the parent within the two year limit.)
Graff, In re		(continuing reissue application - broadening)	(Multiple reissue patents are permissible even where the multiple reissue patents are not for "distinct and separate parts of the thing patented.")
Hallmark Cards, Inc. v. Lehman	959 F. Supp. 539 (D.D.C. 1997)	(certificate of correction)	("Third parties do not have standing to demand that the Office issue, or refuse to issue, a Certificate of Correction.")
Molins, In re	368 F.2d 258 (CCPA 1996)	(new subject matter)	(In copying claims to provoke an interference through reissue, subject matter of copied claims must be supported by original disclosure.)
Baker Hughes, Inc. v. Kirk	921 F. Supp. 801 (D.D.C. 1995)	(assignee consent)	(Reissue application can be filed and examined, but will not be allowed or issued without consent of all assignees.)

<b>Case Name</b>	<b>Citation</b>	<b>Subject Matter</b>	<b>Description of Significance</b>
BIC Leisure Prods., Inc. v. Windsurfing Int'l, Inc.	1 F.3d 1214 (Fed. Cir. 1993)	(intervening rights)	(Distinguishes between "absolute" intervening rights, and "equitable" intervening rights.)
Mentor Corp. v. Coloplast, Inc.	998 F.2d 992 (Fed. Cir. 1993)	(claim scope)	(Reissue claims that are broader in a way that does not attempt to reclaim surrendered matter are permissible.)
Morgan, In re	990 F.2d 1230 (Fed. Cir. 1993)	(expiration)	(Reissue applications may not be filed for expired patents.)
Hayes Microcomputer Products, Inc., In re	982 F.2d 1527 (Fed. Cir. 1992)	(broadening - supplemental oath or declaration)	(If a supplemental oath or declaration is needed in a broadening reissue, it must be signed by all of the inventors.)
Amos, In re	953 F.2d 613 (Fed. Cir. 1991)	(same invention requirement)	(The test for same invention is a factual inquiry into the objective intent of the original patent.)
Arnott, In re	19 USPQ2d 1049 (Comm'r Pat. 1991)	(certificate of correction)	(Specifies the nature of mistakes and nature of corrections allowable under 35 U.S.C. 255.)
Watkinson, In re	900 F.2d 230 (Fed. Cir. 1990)	(restriction)	(Failure to file a divisional application prior to issuance of original patent is not correctable by reissue.)
Wikdahl, Ex parte	10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)	(broadening - recapture doctrine)	(Addition of process claims is generally considered to be a broadening of the invention.)

<b>Case Name</b>	<b>Citation</b>	<b>Subject Matter</b>	<b>Description of Significance</b>
Ethicon v. Quigg	849 F.2d 1422 (Fed. Cir. 1988)	(concurrent post-grant proceedings)	(Ex parte reexamination will not be stayed where there is litigation.)
Constant, In re	827 F.2d 728 (Fed. Cir. 1987)	(basis for reissue)	(A reissue oath or declaration must identify specific claim, specific claim language, and specific error.)
Keil, In re	808 F.2d 830 (Fed. Cir. 1987)	(basis for reissue)	(Reissue error must be based on applicant error, and cannot be based solely on the Office failing to either declare an interference, or suggest copying claims to establish an interference.)
Tillotson Ltd. v. Walbro Corp.	831 F.2d 1033 (Fed. Cir. 1987)	(broadening)	(An amended or newly added reissue claim which contains any product or process that would not have infringed the patent is a claim broader than the original patent claims.)
Anthony, Ex parte	770 F.2d 182 (Fed. Cir. 1985)	(terminal disclaimer)	(Filing terminal disclaimer to an avoid obvious-type double patenting rejection is not error under 35 U.S.C. 251.)
Bennett, In re	766 F.2d 524 (Fed. Cir. 1985)	(broadening)	(An improperly executed declaration for a timely filed broadening reissue may be corrected even after the two year limit.)

Case Name	Citation	Subject Matter	Description of Significance
Fotland, In re	779 F.2d 31 (Fed. Cir. 1985)	(broadening)	(Failing to include an oath or declaration indicating a desire to broaden claims will bar future attempts to broaden the claims after the two year limit.)
Ball Corp. v. United States	729 F.2d 1429 (Fed. Cir. 1984)	(recapture doctrine)	("A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent.")
Wilder, In re	736 F.2d 1516 (Fed. Cir. 1984)	(basis for reissue)	(Reissue application must identify an error in the specification, drawings, or claims which causes the original application to be defective.)
Schuurs, In re	218 USPQ 443 (Comm'r Pat. 1983)	(certificate of correction)	(Obtaining a "Certificate of Correction is an appropriate remedy for correcting, in a patent, reference to a prior co pending application.")
Sneed, In re	710 F.2d 1544 (Fed. Cir. 1983)	(presumption of validity)	(No presumption of validity for claims in a reissue application.)
Bauman, In re	683 F.2d 405 (CCPA 1982)	(continuation reissue application)	(A continuation or divisional of a parent reissue application is not a reissue application itself, unless "there is an identification, on filing, that the application is a continuation reissue application.")

<b>Case Name</b>	<b>Citation</b>	<b>Subject Matter</b>	<b>Description of Significance</b>
Dien, In re	680 F.2d 151 (CCPA 1982)	(basis for reissue)	(Reissue error must be based on applicant error, and cannot be based solely on the Office failing to either declare an interference, or suggest copying claims to establish an interference.)
Mead, In re	581 F.2d 251 (CCPA 1978)	(same invention requirement)	(The test for same invention is a factual inquiry into the objective intent of the original patent.)
A.F. Stoddard & Co. v. Dann	564 F.2d 556 (D.C. Cir. 1977)	(basis for reissue)	(Correcting inventorship from sole inventor A to sole inventor B is permitted through reissue.)
Orita, In re	550 F.2d 1277 (CCPA 1977)	(restriction)	(Design reissue is improper for applicant who faced restriction in original design patent application failed to file a timely divisional.)
Lambrech, In re	202 USPQ 620 (Comm'r Pat. 1976)	(certificate of correction)	("Certificate of Correction is an appropriate remedy for correcting, in a patent, reference to a prior co pending application.")
Sampson v. Comm'r Pat.	195 USPQ 136 (D.D.C. 1976)	(basis for reissue)	(Correction of failure to adequately claim 35 U.S.C. 120 in an earlier filed co pending application is permissible through reissue.)

Case Name	Citation	Subject Matter	Description of Significance
Fontijn v. Okamoto	518 F.2d 610 (CCPA 1975)	(basis for reissue)	(Reissue is permissible for "establishing a claim to priority which was not asserted, or which was not perfected during the prosecution of the original application.")
Lafferty, Ex parte	190 USPQ 202 (Bd. App. 1975)	(lack of diligence or delay)	(Reissue application, non-broadening, filed more than 2 years post grant should not be rejected for delay or lack of diligence.)
Rowand, In re	526 F.2d 558 (CCPA 1975)	(same invention requirement)	(The test for same invention is a factual inquiry into the objective intent of the original patent.)
Van Esdonk, In re	187 USPQ 671 (Comm'r Pat. 1975)	(certificate of correction)	(Obtaining a "Certificate of Correction is an appropriate remedy for correcting, in a patent, reference to a prior co pending application.")
Wadlinger, In re	496 F.2d 1200 (CCPA 1974)	(recapture doctrine)	("A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent.")
Doyle, In re	482 F.2d 1385 (CCPA 1973)	(presumption of validity)	(No presumption of validity for claims in a reissue application.)

<b>Case Name</b>	<b>Citation</b>	<b>Subject Matter</b>	<b>Description of Significance</b>
Scudder, Ex parte	169 USPQ 814 (Bd. App. 1971)	(ground for reissue)	(Correcting misjoinder of inventors in divisional reissues is permissible through reissue.)
Doll, In re	419 F.2d 925 (CCPA 1970)	(broadening - diligence in filing)	(Actual broadening of claims may occur outside the two year limit, as long as the reissue application and oath/declaration indicating broadening is filed within the two year limit.)
Richman, In re	409 F.2d 269 (CCPA 1969)	(recapture doctrine)	(Reissue is not available to "recapture" subject matter surrendered in prosecution to obtain the original patent.)
Brenner v. State of Israel	400 F.2d 789 (D.C. Cir. 1968)	(basis for reissue)	(Reissue is available for failure to file a certified copy of original foreign application to obtain foreign priority when claim was made in original patent.)
Jentoft, In re	392 F.2d 633 (CCPA 1968)	(terminal disclaimer)	(No prohibition against cancelling the effect of terminal disclaimer erroneously filed before patent issued.)
Switzer v. Sockman	333 F.2d 935 (CCPA 1964)	(diligence in filing)	(Filing a broadening reissue on the date of the 2-year anniversary of patent grant is within the 2-year limit.)

<b>Case Name</b>	<b>Citation</b>	<b>Subject Matter</b>	<b>Description of Significance</b>
Ruth, In re	278 F.2d 729 (CCPA 1960)	(broadening)	(An amended or newly added reissue claim which contains any product or process that would not have infringed the patent is a claim broader than the original patent claims.)
Willingham, In re	282 F.2d 353 (CCPA 1960)	(recapture doctrine)	(Reissue is not available to "recapture" subject matter surrendered in prosecution to obtain the original patent.)
Spencer, In re	273 F.2d 181 (CCPA 1959)	(new subject matter)	(In copying claims to provoke an interference through reissue, subject matter of the copied claims must be supported by original disclosure.)
Rohm & Haas Co. v. Roberts Chem., Inc.	142 F. Supp. 499 (S.W. Va. 1956)	(diligence in filing)	(Reissue application, non-broadening, filed more than 2 years post grant should not be rejected for delay or lack of diligence.)* Case reversed on other grounds.
Lawrence, Ex parte	70 USPQ 326, 1946 C.D. 1 (Comm'r Pat. 1946)	(term extension)	(Term of a design patent may not be extended by reissue.)
United States Indus. Chem., Inc. v. Carbide and Carbon Chem. Corp.	315 U.S. 668 (1942)	(new subject matter)	(New matter may exist in the form of either an omission of a feature or of a step in method, such are proper grounds for rejection.)

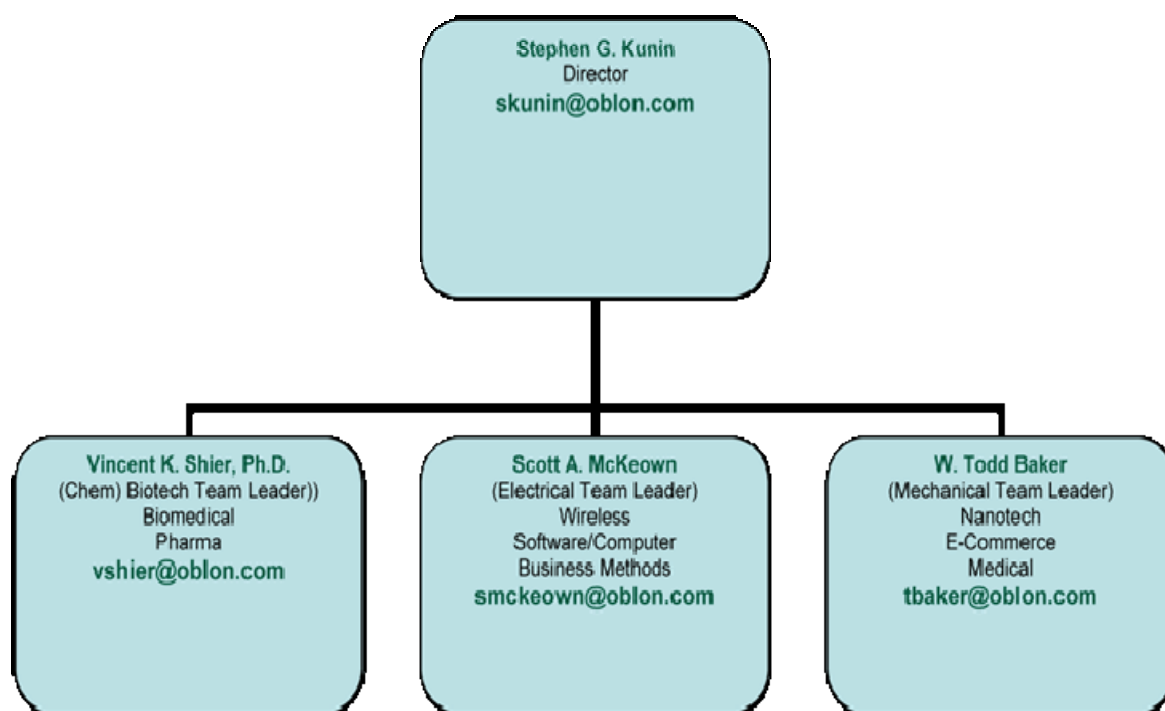
Case Name	Citation	Subject Matter	Description of Significance
Bostwick, In re	102 F.2d 886 (CCPA 1939)	(basis for reissue)	(Reissue error must be based on applicant error, and cannot be based solely on the Office failing to either declare an interference, or suggest copying claims to establish an interference.)
Guastavino, In re	83 F.2d 913 (CCPA 1936)	(basis for reissue)	(Reissue error must be based on applicant error, and cannot be based solely on the Office failing to either declare an interference, or suggest copying claims to establish an interference.)
Altoona Publix Theatres v. American Tri-Ergon Corp.	294 U.S. 477 (1935)	(terminal disclaimer)	(After issuance, public policy is against "...the restoration to the patent owner of something that has been freely dedicated to the public...."
Leggett v. Avery	101 U.S. 256 (1879)	(terminal disclaimer)	(Issuance triggers the "principle against recapturing something that has been intentionally dedicated to the public"
Fassett	1877 C.D. 32, 11 O.G. 420 (Comm'r Pat. 1877)	(assignee consent)	(Reissue application can be filed and examined, but will not be allowed or issued without consent of all assignees.)

Case Name	Citation	Subject Matter	Description of Significance
Wright	1876 C.D. 217, 10 O.G. 587 (Comm'r Pat. 1876)	(assignee consent)	(Reissue application can be filed and examined, but will not be allowed or issued without consent of all assignees.)

## ***C. Oblon Spivak Reexamination/Reissue Practice Group***

Oblon Spivak's Reexamination/Reissue Practice Group is led by partner, Stephen G. Kunin who is the former Deputy Commissioner for Patent Examination Policy at the U.S. Patent and Trademark Office (USPTO). Mr. Kunin served more than 34 years at the USPTO in various patent examination and management capacities. While Deputy Commissioner for Patent Examination Policy, Mr. Kunin had primary responsibility for revising the Rules of Practice found in 37 CFR, Sections 1 and 3, including the rules applicable to both reexamination and reissue. Additionally, Mr. Kunin had oversight responsibility for the Manual of Patent Examining Procedure, including the chapters covering reissue (1400), ex parte reexamination (2200) and optional inter partes reexamination (2600).

Reexamination/Reissue Practice team leaders, Vincent K. Shier, Scott A. McKeown and W. Todd Baker, each are partners who have an extensive amount of experience in prosecuting reissue applications and handling ex parte and inter partes reexamination proceedings for patent owners and third party requesters. Dr. Shier leads the team responsible for reissues and reexaminations in the fields of chemistry, biotechnology, biomedicine, and pharmaceuticals. Mr. McKeown leads the team responsible for electronics, wireless communications, software and computer-related inventions and business methods. Mr. Baker leads the team responsible for mechanical technologies, nanotechnology, e-commerce and medical devices.



Oblon Spivak's Reexamination/Reissue Practice Group handles all aspects of USPTO post issuance proceedings, including appeals to the USPTO Board of Patent Appeals and Interferences. Currently, these proceedings include Patent Reissue and Patent Reexamination.

Patent Reissue provides the patentee with a mechanism for addressing an error made without any deceptive intention that is deemed to render a patent wholly or partly inoperative or invalid by 22 reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had a right to claim. A Patent Reissue is conducted in a similar manner to the original patent prosecution proceedings, although claim amendments must be carefully considered with respect to intervening rights and recapture doctrines. Additionally, claim broadening is only available if initiated within two years of the original patent issuance.

Ex Parte Reexaminations may also be initiated by the patentee to analyze an issued patent in view of published prior art that creates a substantial new question of patentability. However, an Ex Parte Reexamination can also be initiated by third parties to challenge the validity of an issued patent. Once initiated, the third party may not participate further in the reexamination.

Alternatively, Inter Partes Reexaminations are always initiated by a third party. Although Inter Partes reexamination is not available to all issued patents, once initiated, the third party may participate in the reexamination by submitting further comments and argumentation to the USPTO as the proceeding progresses. Increasingly, Ex Parte or Inter Parte Reexamination is used as a strategic litigation tool to couple the USPTO's proceeding on validity with patents asserted in litigation at a US District Court or the International Trade Commission. The Reexamination/Reissue Practice Group is strategically positioned to serve its clients who are either patent owners or third party reexamination requesters.

The emerging popularity of Reexamination stems from two factors, the first is the recent creation of a Central Reexamination Unit (CRU) within the USPTO. CRU Examiners are grouped into 3 person teams to analyze issues presented in Reexamination. Reexaminations are treated with special dispatch within the USPTO. Thus, the quality of review has increased based on the CRU team approach, and the speed of Reexaminations is improved by segregating these issues to the CRU.

The second factor is the increased willingness of some Federal District Courts to stay a patent litigation in the face of an initiated reexamination. As such, the firm's Reexamination/Reissue Practice Group is often called upon to defend validity, or advocate invalidity of patents that are subject to high profile litigation disputes.

Looking forward, recent legislation has been proposed to establish a post-grant opposition proceeding before Administrative Patent Judges of the new USPTO Board of Trials and Appeals. This proceeding is proposed to embrace validity issues not currently subject to reexamination review, and to provide limited discovery opportunities. Due to the wide support for this proceeding, it is anticipated that post-grant opposition will become law to replace and/or augment reexamination options in the future.

The Reexamination/Reissue Practice Group of Oblon Spivak is staffed by teams of seasoned attorneys with technical backgrounds necessary for understanding complex multi-disciplinary technologies and arguing before technical decision makers--senior level Patent Examiners. The Practice Group also leverages an unparalleled expertise in patent prosecution before the USPTO in favorably concluding Reexaminations for our clients' benefit.

## *D. BIOS*



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**STEPHEN G. KUNIN's** practice principally includes serving as the Director of the Reissue/Reexamination Practice Group; testifying expert witness on patent examination policy, practice and procedure and providing consultation services to clients on patent law reform, rulemaking, and strategic approaches to dealing with complex patent prosecution matters. He is the former Deputy Commissioner for Patent Examination Policy with the U.S. Patent and Trademark Office. He has more than 38 years of expertise in intellectual property rights protection and 24 years of organizational management and leadership experience. He was appointed to his former position in March 2000 and has served in a similar capacity since November 1994, under the position's prior title, "Deputy Assistant Commissioner for Patent Policy and Projects." Previously, beginning in July 1989, Mr. Kunin served as Deputy Assistant Commissioner for Patents. He participated in the establishment of patent policy for the various Patent Organizations under the Commissioner for Patents, including changes in patent practice, revision of rules of practice and procedures, establishment of examining priorities and classification of technological arts, and oversaw the operations of the Office of Patent Legal Administration, Patent Cooperation Treaty Legal Administration, and the Office of Petitions. Additionally, in January 1993, Mr. Kunin was designated by the Secretary of Commerce to perform the functions of the Assistant Commissioner for Patents on an acting basis until a new Assistant Commissioner for Patents was appointed in 1994.

Mr. Kunin, as a Partner, serves as a patent consultant who advises clients on patent prosecution and policy matters and prepares infringement and non-infringement opinions. He also serves as an expert witness on patent law, policy, practice and procedure.

Mr. Kunin also now serves as the Intellectual Property Program Director at the George Mason School of Law where he is an adjunct professor who teaches patent law and intellectual property law classes.

Mr. Kunin graduated with honors from Washington University in May of 1970 with a B.S. degree in Electrical Engineering. He attended the National Law Center of the George Washington University, receiving his Juris Doctor degree in law with honors in May of 1975. He is a graduate of the Harvard University Kennedy School of Government SMG Program.



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**SCOTT A. MCKEOWN** is a partner in the firm's Electrical/Mechanical Practice Group focusing on client counseling, litigation and patent prosecution. Mr. Mckeown is also a team leader of the Reissue and Reexamination Practice Group, handling technologies including computer software, wireless telecommunication protocols and network architectures, e-commerce applications, analog and digital signal processing, and consumer electronics.

A significant portion of Mr. Mckeown's work involves post grant proceedings, including patent Reissue practice, Ex Parte, and Inter Partes patent reexamination. Mr. Mckeown has worked extensively in the patent reexamination area as the USPTO's Central Reexamination Unit has become a more common alternative to traditional litigation based validity challenges. In this capacity, he has worked and counseled Patent Holder's on the strategic benefits of patent reexamination, as well as third party requestors.

In the telecommunication arts, Mr. McKeown has worked extensively with IP routing and signaling protocols, ATM and wireless communication protocols. He has a broad breadth of experience with OFDM systems, CDMA, TDMA, FSK, QAM and the 802.11 family of protocols.

In the consumer electronic arts, Mr. McKeown's practice has a strong focus in audio and video processing and display technologies, discs, signal compression and encoding schemes, recording medium formatting and construction, and many other related technologies. In this regard, Mr. McKeown works directly with standard setting organizations and patent pools and has successfully advocated the inclusion of his client's IP into patent pools. Additionally, he has counseled open source communities on third party IPR issues and standard setting.

Mr. McKeown received his Law degree from Temple University School of Law. He received his Bachelor of Science degree in Electrical Engineering from Temple University with honors.

Mr. McKeown is admitted to the Pennsylvania and Virginia State Bars and is registered to practice before the U. S. Patent and Trademark Office. He is a member of the Institute of Electrical and Electronics Engineers (IEEE) and the American Intellectual Property Law Association (AIPLA).



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**W. TODD BAKER** is a patent attorney in the firm's Reissue/Reexamination, Interference, and Electrical/Mechanical Practice Groups.

As a team leader of the Reissue and Reexamination Practice Group, a significant portion of Mr. Baker's practice involves post grant proceedings handled by the USPTO's Central Reexamination Unit including ex parte and inter partes reexaminations.

Mr. Baker is co-chair of the firm's Interference Practice Group. His practice includes advising clients on patent interference prosecution matters before the USPTO's Board of Patent Appeals and Interferences. Interference practice involves issues of priority, patentability, derivation, and inventorship. Mr. Baker's extensive experience with both reexaminations and interferences makes him particularly well suited to advise clients on alternatives to traditional litigation based validity challenges.

In addition to his post grant practice, Mr. Baker prepares and prosecutes patent applications in diversified electrical and mechanical technologies. He is a former patent examiner with the USPTO, where he specialized in multiplex communications.

Mr. Baker is currently the chair of the USPTO Inter Partes Patent Proceedings Committee (formerly known as the Interference Committee) of the American Intellectual Property Law Association. The Interference Committee was renamed and its mission revised to reflect a broadened scope encompassing interferences as well as inter partes reexamination.

Mr. Baker received his Law degree from the University of Maryland School of Law in 1996 and received his Bachelor of Science degree in Electrical Engineering from the University of Virginia in 1993. Mr. Baker is admitted to the Maryland State Bar and is registered to practice before the USPTO.



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**VINCENT K. SHIER** is a partner in the firm's Chemical & Biotechnology Practice Group. Dr. Shier is also a team leader of the Reissue and Reexamination Practice Group. His areas of technical expertise and practice include: biochemistry, genetics, molecular biology, and pharmaceuticals.

A significant portion of Dr. Shier's work involves post grant proceedings, including Reissue practice, and Ex Parte reexamination. Dr. Shier has worked extensively in the reexamination area on behalf of Patent Holders and Third Party Challengers as the USPTO's Central Reexamination Unit has become a viable alternative to traditional litigation based validity challenges. Additionally, he has worked and counseled Patent Holder's on the strategic benefits of self-initiated reexamination and third-party requests.

As a prosecuting attorney, Dr. Shier's work involves preparing and prosecuting patent applications in diversified technologies within the chemical and biotechnology disciplines. He has also worked extensively in the patent prosecution highway and accelerated examination programs before the USPTO. Another aspect of Dr. Shier's practice entails client counseling and the development of patent portfolio management strategies.

Dr. Shier received his J.D. from the George Washington University Law School. He received his Ph.D. in Biological Chemistry from the Pennsylvania State University. His thesis research, under the direction of Professor Stephen J. Benkovic (member of the National Academy of Sciences), focused on the characterization and inhibition of an essential, non-restriction/modification adenine DNA methyltransferase from *Caulobacter crescentus*. He received his Bachelor of Arts degree from the University of Rochester, with a double major in biology and chemistry.

Dr. Shier is actively involved with the American Bar Association's Section of Intellectual Property Law (ABA IPL), where he is currently serving on Patent Inter Partes Proceedings Committee (Committee 104). He is also actively involved with the Intellectual Property Owners Association (IPO), where he is currently serving on the Patent Office Practice (U.S.) Committee. Dr. Shier is also a member of the American Intellectual Property Law Association (AIPLA). Dr. Shier is admitted to the Virginia State Bar and is registered to practice before the U.S. Patent and Trademark Office.