

## Section 16. CORRECTION OF PATENT

- 16-1. Reissue
  - 1-1. Requisites
  - 1-2. By Whom Filed and To Whom Granted
  - 1-3. Notice in Original File
  - 1-4. Offer to Surrender Original Patent and When Such Patent Is Returned
  - 1-5. Court Decision on Original Patent
  - 1-6. Uses of Original Drawing
  - 1-7. Form of Specification and Claims
  - 1-8. New Matter
  - 1-9. The Reissue Oath
  - 1-10. Divisional Reissue Application
  - 1-11. Examination of Reissue
  - 1-12. Election of Species
  - 1-13. Allowance and Issue
  - 1-14. Reissue Filed While Patent is in Interference
  - 1-15. Secrecy Not Preserved
- 2. Certificate of Correction
  - 2-1. Requisites
  - 2-2. Heading
- 3. Statutory Disclaimer

Mistakes in a patent may be corrected in three ways. If the mistake is due to accident or inadvertence and requires re-writing a portion of the specification or claims, the patent may be reissued. If the mistake is of a clerical nature on the part of the Office or printer, a certificate of correction may be issued to form a part of the patent. If the mistake is due to accident or inadvertence and consists merely in the patentee claiming more than he had a right to claim, he may file a statutory disclaimer to go with the patent.

## 16-1.

Reissue

Sec. 4916, R.S. .... "Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he has a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent."

The usual grounds for a reissue are that the claims are too narrow or too broad, or that the disclosure has inaccuracies.

## 16-1-1.

Requisites

Rule 22.1 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.

## 16-1-2.

By Whom Filed and To Whom Granted

Rule 22.2 Applicants, assignees, Reissue

applications must be signed and sworn to by the inventors if they be living, and must be accompanied by the written assent of all assignees, if any, owning an undivided interest in the patent. If the inventor is dead, a reissue application may be made by the assignee of the entire interest.

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

The examiner must inspect the abstract of title to determine whether Rule 22.2 has been complied with.

A reissue cannot be granted to a solo applicant for a patent originally issued to joint applicants.

16-1-3.

Notice In Original File

Rule 22.9 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, giving its serial number and filing date. When the reissue is granted or the reissue application is otherwise terminated, the fact will be added to the notice in the file of the original patent.

The Examiner should see that the clerk of the division enters the paper containing the notice on the file wrapper of the patent and in the Examiner's register and fills in pertinent data.

16-1-4.

Offer To Surrender Original Patent and When Such Patent Is Returned.

Rule 22.8 Original Patent. The application for a reissue must be accompanied by an offer to surrender the original patent. The application should also be accompanied by the original patent, or if the original is lost or inaccessible, by an affidavit to that effect. The application may be accepted for examination in the absence of the original patent or the affidavit, but one or the other must be supplied before the case is allowed. If a reissue be refused, the original patent will be returned to applicant upon his request.

The examination of the reissue application on the merits is made even though the original patent or

an affidavit has not been received, but in such case the Examiner should require them in the first action.

If applicant requests the return of his patent, on abandonment of the reissue application, it will be sent to him by the Executive Officer.

16-1-5. Court Decision on Original Patent

When an application for reissue of a patent is made in view of the holding of the court in a suit on the original patent, a copy of the court's decision should be filed. If it appears either from the reissue oath or from the file of the original patent that there has been such a suit and a copy of the decision is not filed, the Examiner will require it to be filed before final action on the application. The court's opinion should be carefully considered for its bearing on the proposed claims of the reissue.

16-1-6. Use of Original Drawing

The drawing of the original application may be used in lieu of new drawings in the reissue application, provided that no alteration whatsoever be made in the drawings or in any sheet thereof. The complete set of original drawings must be preserved in the condition existing at the time of issue of the original patent.

When a reissue case is filed with a request for transfer of the drawing from the original file, applicant must submit a mounted copy of the original drawing, or an order for same. (Rule 12.9).

The mounted copy of the drawing will be marked "Informal, AFX" (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, and no change has been made in the drawing, the Clerk of the Division forwards the file to the Application Branch for formal transfer of the original drawing to the reissue case.

16-1-7. Form of Specification and Claims

Rule 22.3. 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 or

otherwise indicated as being deleted; 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.

16-1-8.

#### New Matter

##### Rule 22.4 New Matter, Amendment of Drawing.

New matter shall not be introduced into the reissue application, nor shall the drawing be amended, (that is, changed from the drawing of the patent) except to make permissible corrections of errors in the execution of the drawing.

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 be for the same invention intended to be claimed in the original patent. New matter may exist by virtue of the omission of a feature or a step in a method.

16-1-9.

#### The Reissue Oath

Rule 22.5 Reissue Oath. Applicants for reissue, in addition to complying with the requirements of the first sentence of Rule 9.1, must also file with their applications a statement under oath as follows:

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

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

(c) When it is claimed that such patent is inoperative or invalid "by reason of the prior art," distinctly specifying the part or parts so alleged to have been improperly claimed as new.

(d) When any reissue claim is broader

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

16-1-10. Divisional Reissue Applications.

Rule 22.7 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 of such reissued Letters Patent. Each division of a reissue constitutes the subject of a separate specification description of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of Rules 12.3 and 12.4. On filing a reissue in divisions, the applications shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner, all the divisions of a reissue will issue simultaneously; if there be any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner shall otherwise order.

The Examiner may not require division. (Rule 22.6).  
For election of species, see 16-1-12.

16-1-11. Examination of Reissue

Rule 22.6 Examination of Reissue. An original claim, if re-presented in the reissue application, is subject to re-examination, 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 are acted on by the Examiner in advance of other applications.

Thus, reissue cases are "special".

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.

16-1-12. Election of Species

When both the original patent and the reissue

in any respect than the patent claims, applicant shall explain when and under what circumstances he became aware of the lack of breadth in the patent claims, and shall further explain any delay thereafter up to the filing of such reissue application.

(e) Particularly specifying the errors which it is claimed constitute the inadvertence, accident, or mistake relied upon, and how they arose or occurred.

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

Corroborating affidavits of others may be filed and the Examiner may, in any case, require additional information or affidavits concerning the reissue and its object.

The question of the sufficiency of the reissue oath filed under Rule 22.5 must in each case be reviewed and decided personally by the primary examiner, (Order 2712).

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

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

A broadened reissue claim, for the purposes of paragraph (d) of the rule, is one which brings within its scope any subject matter not embraced by the patent claims. Where a broadened claim is asserted more than one year after the issuance of the patent, a clearly conclusive showing must be made in justification of the delay.

Relative to paragraph (e) of the rule, deliberate cancellation of a claim in the original patent application is not ordinarily regarded as an inadvertence, accident or mistake, and claims drawn to substantially the same subject matter are not ordinarily successfully urged in the reissue. An error arising from a lack of understanding or knowledge of applicant's attorney as to the real invention may be an acceptable reason for reissue. But an error based on a change in the factual situation existing at the time the patent was taken out, is an insufficient basis for reissue.

application contain claims to a plurality of species, election of species should not be required even though there is no allowable generic claim. If the original patent contains only generic claims and the reissue in addition to the generic claims asserts claims to more than three species, restriction to three species may be required just as in an original application.

16-1-13.

Allowance and Issue

Before a reissue case is ready to issue, the file is forwarded to the Assignment Branch in order that the abstract of title may be brought down to the latest date. After the case comes back from the Assignment Branch, the Examiner must inspect their report to see that the applicant has complied with Rule 22.2 (Section 16-1-2).

The notice of allowance is not mailed from the examining division. The file with the notice is sent to the Issue and Gazette Branch, where the notice is stamped and mailed.

16-1-14.

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. (Order No. 3193).

When an application for reissue of a patent is filed while the patent is involved in interference, a letter entitled in the interference is placed in the interference file and the reissue application file, and a copy thereof sent to each of the interfering parties, giving notice of the filing of the reissue application. (See 13-6-8).

16-1-15.

Secrecy Not Preserved

Rule 22.2 Notice of Reissue Application.  
A notice of the filing of a reissue application will be published in the Official Gazette. Reissue applications are not preserved in secrecy in the same manner as original applications, and access will ordinarily be granted on request in writing.

Reissue applications are exceptions to the general rule of secrecy. The public should be able to rely on an issued patent to define its scope.



16-2.

## Certificates of Correction

### Rule 35.2 Certificate of Correction.

A certificate of correction under the Act of March 4, 1925 (43 Stat. 1268, 35 U.S.C., sec. 88), may be issued at the request of the patentee or his assignee and endorsed on the patent itself. Such certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notifying the patentee (including any assignee of record) and affording him an opportunity to be heard.

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, with the consent of the patentee (or assignee of record, if any) may issue a reissued patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

16-2-1.

### Requisites

#### Rule 35.3 Other Mistakes Not Corrected.

Mistakes not incurred through the fault of the Office, and not affording legal grounds for reissue, will not be corrected after the date of the patent.

Changes or corrections will not be made in a patent after the date thereof except as above provided.

Mistakes incurred through the fault of the Office and of clerical and typographical nature are the subject of Certificates of Correction.

16-2-2.

### Handling

Requests for Certificates of Correction will be forwarded by the Register, Correspondence and Mail Branch to Issue and Gazette Branch, where they will be listed in a permanent record book.

When the error is a printer's error, or an error originating in Issue and Gazette Branch, the Chief of Issue and Gazette Branch will state the facts and forward the file with the request for a certificate of correction to the Commissioner for action. If there is an office error which did not originate in Issue and Gazette Branch, the Chief of Issue and Gazette Branch will obtain

a report thereof from the Division responsible for the error and forward it with the file to the Commissioner for action. So far as possible, all reports, if more than one is necessary, will be on a single sheet of paper. After action by the Commissioner, the paper and the file will be returned to Issue and Gazette Branch. If the certificate of correction is ordered to issue, it will be prepared and forwarded to the person making the request, by Issue and Gazette Branch.

The request, the report, 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 on the index by Issue and Gazette Branch, after which the file will be returned to the patented files.

If the certificate of correction is refused, the request, the report, and a copy of the communication to the person making the request will be placed in the file and entered on the index by Issue and Gazette Branch, after which the file will be returned to the patented files. (Order No. 2757)

16-3.

### Statutory Disclaimer

#### Rule 35.1 Statutory Disclaimer in Patent.

A disclaimer under R.S. 4717 must comply with the requirements of the statute and must also identify the patent, specify that the claiming of more than the inventor had a right to claim occurred through inadvertence, accident or mistake and without any fraudulent or deceptive intention, identify the claim or claims disclaimed, and be signed by the person making the disclaimer. See form in the Rules of Practice. Such disclaimers are not required except as to formal matters, but a disclaimer observed not to be a disclaimer in fact may be refused, and the omission of a disclaimer does not indicate that it is considered by the Patent Office to be proper or valid or that the patent after disclaimer, or any claim thereof, is considered valid. A notice of the disclaimer is published in the Official Gazette and attached to the printed copy of the specification.

According to the opinion in *Ex parte Inwood* (1884) 14 F. 221, a patent which was invalid ab initio was wholly void. In order to give to the effect of this case on the rule that statutes on disclaimers were inserted. Under the statutes if the inventor disclaims an invalid portion of his patent without any fraud or deception by him or anyone for his profit which is truly and lawfully his own.

The examination as to formal matters of the disclaimer is performed by the Issue and Gazette Branch.

A disclaimer cannot be used to avoid a rejection on double patenting. Moreover, one cannot publish a disclaimer on certain subject matter and thereafter file a reissue including the matter disclaimed.