



Training Academy Session #12

# Addressing Errors in Form and Scope of Patents: Certificates of Correction and Reissue Applications

**Jeffrey W. Gluck, Ph.D.**  
**Sandra M. Katz, Ph.D.**

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## Session Overview

1. Introduction (Slide 3)
2. Certificates of Correction (Slides 4-6)
3. Reissue (Slides 7-24)

# INTRODUCTION

- Correction of Patents
  - MPEP § 1400
  - Two mechanisms
- Certificates of Correction
- Reissue Applications

# CERTIFICATES OF CORRECTION

- USPTO Error
  - 35 U.S.C. § 254 and 37 C.F.R. § 1.322
  - Submit request for certificate of correction, along with evidence of error
  - No fee required
- Applicant Error
  - 35 U.S.C. § 255 and 37 C.F.R. § 1.323
  - Submit request
  - Fee required
  - Scope
    - Clerical error, typographical error, or “mistake of minor character,” not affecting scope or meaning
    - No new matter added/no reexamination required

## CERTIFICATES OF CORRECTION (cont'd)

- Special Examples of Applicant Errors
  - Correction of Inventorship
    - 35 U.S.C. § 256 and 37 C.F.R. § 1.324
    - Submit necessary papers for correction of inventorship
      - Inventor statements of agreement to change
        - › If unable to get all inventor statements, can correct via reissue
      - Assignee statement of agreement to change
      - Fee
    - Typographical errors in inventor names do not require this

## CERTIFICATES OF CORRECTION (cont'd)

- Correction of Priority
  - Petition and fee required
  - Must be “appropriate”
    - May not claim priority to a pre-AIA filing if patent was granted based on examination under first-to-file
  - If not appropriate, may correct via reissue
  
- Correction of Assignee Name
  - Provide evidence that assignment was submitted for recordation prior to patent grant
  - Additional Fee required

## REISSUE – WHEN APPROPRIATE

- Statutory Basis:
  - “In accordance with [35 U.S.C. 251](#), the error upon which a reissue is based must be one which causes the patent to be “deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent.” MPEP § 1402

## REISSUE – WHEN APPROPRIATE (cont'd)

- Most Common Bases for Reissue
  - The claims are too narrow or too broad;
  - The disclosure contains inaccuracies;
  - Applicant failed to or incorrectly claimed foreign priority;
  - Applicant failed to make reference to or incorrectly made reference to prior copending applications.



## REISSUE BASED ON CLAIM SCOPE

- May narrow claims any time during life of patent
- May broaden claims only within two years of patent issuance
  - Considered to be broadening even if a claim is broadened in some aspect and narrowed in another aspect

## REISSUE BASED ON CLAIM SCOPE

- Limited by the “recapture rule”
  - May not recapture subject matter surrendered during initial prosecution
    - Surrender may be via amendments or remarks/arguments
  - Originally limited to amendments and arguments made to overcome prior art
  - However, see *In re McDonald*, No. 2021-1697 (Fed. Cir. Aug. 10, 2022)
    - Amendments made to overcome patent-eligibility rejections under 35 U.S.C. § 101 by adding a limitation (a processor) were considered surrender of subject matter under the recapture rule
  - Will the law change further????

# “NUTS AND BOLTS” OF REISSUE PRACTICE

- Parts of a Reissue Application
  - Copy of patent as issued
  - Clean copy of drawings
  - Statement Under 3.73(c)
  - Assignee’s Consent
  - Power of Attorney
  - Reissue Declaration – see below
  - Amendment – see below
  - ADS (including full priority information)
  - IDS (recommended)
  - No longer need to surrender original letters patent

# INITIAL AMENDMENTS

- Cut up copy of issued patent and add/delete subject matter in original text
  - Messy and cumbersome
  - No one does this any more
- Preliminary Amendment
  - All amendments in reissue applications follow 37 CFR § 1.173, *not* 37 CFR § 1.121
    - Look mostly like old amendments (before the mid- to late-1990s)
  - Will discuss amendment details below

# REISSUE DECLARATION

- Who makes Reissue Declaration?
  - Broadening reissue – inventors
  - Any other reissue – assignee or inventors
  - If inventor signatures needed and cannot be obtained, assignee may sign on behalf of non-signing inventors (substitute statement)
- Contents
  - Usual elements; and
  - Statement of Error(s)
    - Detailed discussion of error and how it is being corrected.
    - In case of broadening reissue, PTO has become strict in insisting that statement of errors include differences between issued claims and broadened versions of those claims (or added broader claims – “best practice”)

## REISSUE DECLARATION (cont'd)

- Examples of statement of errors for declaration in broadening reissue application:
  - Issued claims included method and apparatus claims but no claims directed to a computer-readable medium storing executable instructions.
  - Claims 1, 2, 5, 6, 11, 13, 31 and 32 as issued contain limitations that require that certain actions be carried out, rather than that elements be capable of carrying out the actions, which may limit claim scope to cases in which the elements are actively performing those actions. For example, issued Claim 1 recites, “wherein the station contacts the gateway,” while new Claim 33 recites, “wherein the station is configured to contact the gateway.”

## REISSUE DECLARATION (cont'd)

- The issued claims fail to address a method of reselling credit card validation services, which is supported by the present specification.

## AMENDMENTS

- All amendments are relative to the **original text** of the issued patent
- Amendments follow 37 CFR § 1.173
- Examples:
  - Specification
    - Please replace the paragraph beginning at col. 4, line 23 with the following (i.e., identified by location in issued patent):  
[The wingnut 13 is located perpendicular] Wingnut 13 is disposed parallel to the wingbat 14. Wingbat 14 is secured by one or more screws 15.
    - Note: No strikethrough, no double bracketing



## AMENDMENTS (cont'd)

- Drawings
  - Provide replacement sheet(s) with each amended figure annotated “Amended”
  - May provide annotated sheets (labeled “Annotated Marked-Up Drawings”) or describe amendments in detail in the text of the amendment
- Claims
  - Only amended/added claims need be specifically shown in the “Amendments to the Claims”
  - Examples:
    - New Claims: Please add the following new claims:  
31. (New) A frabulating machine comprising....  
32. (New) The frabulating machine according to Claim 31, further comprising...

## AMENDMENTS (cont'd)

- Amended Issued Claims:
  1. (Amended) A frabulating machine comprising:  
a [wingbat] wingnut coupled to a wingbat...
  
- Multiple-Amended Issued Claims:
  1. (Twice Amended) A frabulating machine comprising:  
a [wingbat] wingnut coupled to a plurality of wingbats...
  
  1. (Thrice Amended) A frabulating machine comprising:  
a [wingbat] plurality of wingnuts coupled to a plurality of wingbats...

## AMENDMENTS (cont'd)

- Amended new claims:
  - As originally presented:  
32. (New) A frabulating machine, comprising:  
a lever;  
a plane; and  
a fulcrum disposed on the plane.
  - As amended:  
32. (New) A frabulating machine, comprising:  
a lever;  
a plane; and  
a fulcrum disposed on the plane, wherein the fulcrum has  
the shape of a substantially triangular prism.

## AMENDMENTS (cont'd)

- All amendments must include, in addition to the amendments themselves and “usual” arguments/remarks, two additional sections (which may be combined, if desired):
  - Status of the Claims
  - Support for Amendments
    - The amendments to the claims may be verbally described or the amended claims may be reproduced with amendments shown and support discussed
- Although not required by 37 CFR § 1.173, many Examiners/Art Units/Tech Centers are “requesting” a complete listing of the claims
- Recommend stating that this listing is not a requirement
- The annotations/format for such a listing of claims are not dictated by the CFR and are up to the practitioner
  - Recommend stating your formatting conventions and call it a “courtesy listing of the claims” (attached as appendix)

## AMENDMENTS (cont'd)

- See M.P.E.P. § 1453 for more further details
- Note on supplemental reissued declarations
  - Formerly required whenever any substantive amendments made
  - **Now:** “For applications filed on or after September 16, 2012, if additional defects or errors are corrected in the reissue after the filing of the reissue oath or declaration, a supplemental reissue oath or declaration is **not** required. However, where all errors previously identified in the reissue oath/declaration are no longer being relied upon as the basis for reissue, the applicant must explicitly identify on the record an error being relied upon as the basis for reissue (e.g., in the remarks accompanying an amendment).” M.P.E.P. § 1414.03

# PROSECUTION OF REISSUE APPLICATION

- Similar to normal utility application, but using amendment details according to 37 CFR § 1.173
- Interviews, extensions of time, etc., available, as are RCEs and appeals
- Restriction/election practice applies
  - Continuation and divisional application practice is available (restriction/election practice also applies to reissue applications) – MPEP § 1451
    - Requires cross-reference paragraph
    - Also requires notice in every reissue application relating to a particular patent of existence of other reissue application(s)

## ALLOWANCE AND ISSUE

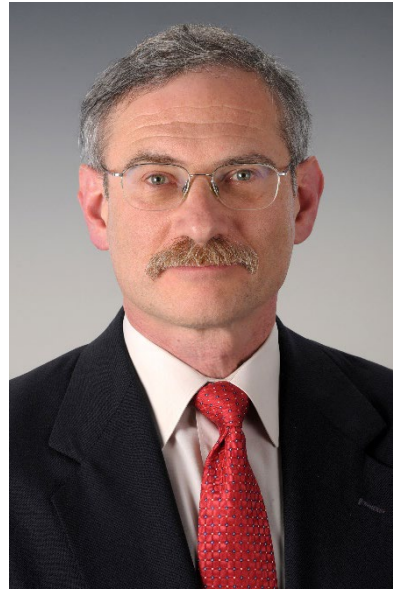
- Payment of issue fee, as usual
- Reissue patent number has format Rxxxxxx
- Shows changes relative to original patent using italics (for additions) and brackets (for deletions)
- Has same expiration date as original patent
  - It is a replacement, corrected patent, not a new patent

## Miscellaneous

- Effect of abandonment – no effect on original patent, except that the record created in the reissue prosecution may bear upon claim interpretation of the original claims
- AFCP 2.0 is *not* available for after-final amendments
- Reissue is also available for design patents – see MPEP § 1457



## Speakers



Jeffrey W. Gluck, Ph.D.  
301.357.8390  
[JGluck@panitchlaw.com](mailto:JGluck@panitchlaw.com)



Sandra M. Katz, Ph.D.  
215.965.1344  
[SKatz@panitchlaw.com](mailto:SKatz@panitchlaw.com)



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