Nanotechnology Law & Business

http://pubs.nanolabweb.com

Reissue Patent Applications

KELLY KORDZIK* and HENRY "BUD" EHRLICH**

ABSTRACT

The field of nanotechnology is in an ever-evolving state, with new discoveries and revelations occurring every day. In some instances, researchers have quickly filed for patent protection on their inventions to stake their claim while their research and development on the invention is still in its nascent stages. The result can be a patent with claims covering inventions not fully understood and appreciated. As a particular nanotechnology invention is further evaluated and advanced, additional properties and applications may be realized that have not been claimed. In this article, patent lawyers Kelly Kordzik and Henry Ehrlich explain how nanotech companies can utilize the reissue procedure to obtain broader patent claims.

You have a cutting edge nanotechnology invention and you have successfully prosecuted a patent application in the United States Patent and Trademark office, issuing as U.S. Patent 1,234,567 (the '567 patent). The invention and the '567 patent are being touted in journals and publications throughout the world and your research and development of the invention are continuing. Then, one of the inventors comes to you and announces, "we have just realized several new properties of our invention and new applications for the invention." The inventor looks at you quizzically because of your immediate lack of excitement. You realize that the '567 patent does not *claim* these newly recognized properties and applications.

You obtain the file for the '567 patent to determine if any other patent applications are pending that claim a priority back to or a relationship to the parent application of the '567 patent. If there is a related application, the "defect" in the '567 patent can be readily corrected. A copending patent application will allow for filing additional claims that cover the scope of the newly recognized properties or applications and allow for the filing of continuation applications. Also, if additional material needs to be provided to fully describe the new aspects of the invention a continuation-in-part (CIP) application can be filed. The

---

* Kelly Kordzik is a shareholder in the Austin office of Winstead Sechrest & Minick P.C. He leads Winstead's Intellectual Property Section, while also the Chair of Winstead's Nanotechnology Practice Group. Mr. Kordzik also serves as the President of the Texas Nanotechnology Initiative (*www.texasnano.org*). He can be reached at *kkordzik@winstead.com* or kkordzik@texasnano.org.

** Henry "Bud" Ehrlich is an IP attorney in the Houston office of Winstead, Sechrest & Minick P.C. He can be reached at *hehrlich@winstead.com*

CIP application permits the addition of "new matter," material which was not included in a prior related application, to be added.

Unfortunately, after review, you discover that there are no patent applications pending that will permit claiming of the newly recognized aspects of the invention. You further realize that the subject matter that is disclosed in the '567 patent is unclaimed, including the unclaimed equivalent subject matter, and is thus dedicated to the public.[1] Fortunately, as the Court specifically noted, the patentee may correct the patent:

> [a] patentee who inadvertently fails to claim disclosed subject matter . . . is not left without a remedy. Within two years from the grant of the original patent, a patentee may file a reissue application and attempt to enlarge the scope of the original claims to include the disclosed but previously unclaimed subject matter.[2]

Reissuance of an issued patent provides the patentee (or the assignee of the patent) with the opportunity to make substantive changes in the issued patent. The federal "Reissue Statute" may provide a solution. In relevant part, the statute provides:

> 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 Director 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 Director 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 on enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent. [3]

Therefore, for the "reissue statute" to provide an avenue for correcting the '567 patent, the '567 patent must be "wholly or partly inoperative or invalid" by reason of an error. Errors that support filing a reissue application may be that the specification or drawings are defective, or that the patentee claimed more or less than he had the right to claim. For the purposes of this paper we are addressing that the patentee "claimed more or less than he had the right to claim."[4]

Due to the quickly evolving state of nanotechnology, the most common reason for filing a reissue application may be to broaden the patent claims. A claim is broadened if it contains within its scope any conceivable process or apparatus that would not have infringed the original patent claims.[5] In other words, the patentee did not claim all he had a right to claim. Broadening reissue applications result

---

1 *Johnson & Johnston Assocs., Inc. v. R.E. Service Co., Inc.*, 285 F.3d 1046, 62 U.S.P.Q.2d 1225 (Fed. Cir. 2002).
2 *Id.* at 1055.
3 35 U.S.C. §251 (2004) (emphasis added).
4 *Id.*
5 *Tillotson Ltd. V. Walbro Corp.*, 831 F.2d 1033 (Fed. Cir. 1987).

because the true scope of the original invention was not recognized during the prosecution of the original patent.

Claims may also be written too broadly and encompass material that renders the claims invalid. Writing the claims too broadly and encompassing or "reading on" material that bars the patentability of the claims often results from not recognizing or discovering prior art during prosecution of the original patent. A reissue application of this nature is referred to as a narrowing reissue, wherein the reissue claims are narrower than the original patent claims. The filing and prosecution of a "narrowing reissue" is substantially the same as "broadening reissue" with the primary exception of an extended period for filing the reissue application. With the issuance of "too broad" nanotechnology patents, there may also be reasons why a company may wish to file a narrowing reissue.

The defect in the original patent must result "through error without any deceptive intention."[6] To broaden the claims, the applicant must provide an oath signed by the inventors containing written consent of any and all assignees.[7] If the reissue application does not seek to broaden the claims, the reissue oath may be signed by the assignee of the entire interest.[8] The oath must provide at least one error being relied on for the reason that the claim or claims are wholly or partially inoperative, declaring that such error did not occur with deceptive intent.[9] Additionally, an error corrected during the prosecution of the application that is not addressed by an original oath must be supported by a supplemental oath as to the error arising without deceptive intent.[10]

The correction to the patent must be supported by the original specification to the patent. Thus, the specification must provide enablement for the corrections and no new matter shall be introduced into the application for reissue.[11]

We have learned that the '567 patent is wholly or partially defective because it *claims less than* we "had a right to claim."[12] We have determined that the error in claiming was not due to deceptive intent. We have also determined that the original patent specification supports the corrections we desire to make to the issued patent. It is now time to file for a reissue patent.

The key to filing a reissue application is timing. A broadening *reissue must be filed within two years of the issue date of the original patent.* A narrowing reissue may be filed during the maintained life of the original patent.

It is vital that this two-year window for filing a broadening reissue patent application be kept in mind and docketed. The original patent and the present state of the understanding of the invention should be reviewed before closing this window for the possibility of filing *any* necessary corrections. The filing of a reissue application before the closing of the two-year window may provide the opportunity to avoid the dedication rule set out in *Johnson and Johnston* above.[13]

On filing of the reissue application, the applicant must surrender the original patent or offer to surrender the original patent.[14] The surrender of the original patent shall take effect upon the issue of the reissued patent.[15]

---

6 35 U.S.C. §251 (2004).
7 37 C.F.R. §1.171.
8 *Id.*
9 37 C.F.R. §1.175.
10 *Id.*
11 *In re* Amos, 953 F.2d 613 (Fed. Cir. 1991).
12 35 U.S.C. §251 (2004).
13 *Johnson & Johnson Assocs.*, 285 F.3d 1046.
14 37 C.F.R. §1.178.

Note that a reissue patent cannot be granted if the original patent has expired.[16] Therefore, the patent holder must continue to pay the maintenance fees on the original patent even though it has been surrendered or offered for surrender.

Once filed, the reissue patent application will be examined at the Patent and Trademark Office "in the same manner" as the original application for patent,[17] with a few exceptions. Unlike originally filed patent applications, reissue patent application files are opened for inspection by the public. Further, the public has the opportunity to protest the granting of the reissue patent. The public is provided a two-month window to protest the filing of the reissue application and to submit information relative to the reissue patent application. Notice of the filing of the reissue application will be published in the *Official Gazette*.[18] Upon the completion of the two-month period and the failure for a protest to be filed, the prosecution of the reissue application continues along the path in the same manner as an original patent application.

During examination, none of the claims in the reissue application are presumed to be valid.[19] The patent examiner can reject the claims on any basis available for rejecting or objecting to claims, or the specification, in the original application. Thus, the patent examiner can reject claims that issued in the original patent that are included in the original patent application.

Further, the patentee may file continuation and divisional applications claiming priority to the original reissue application.[20] Therefore, the patentee may be able to obtain broadened claims if the original reissue patent application is filed on or prior to the *two-year anniversary of the original patent* with an oath or declaration indicating the desire to seek broadened claims.[21] In such a case, broadened claim coverage can be sought after the two-year period by filing broader claims in the original reissue patent application after the two-year window, or by filing broader claims in a divisional or continuation application off of the original reissue patent application.

Again, review the original patent application and the status of the invention before the second anniversary of the original patent. Unlike on originally filed applications for patent, a continuation-in-part application cannot be filed on a reissue patent application.

Realize that filing a reissue patent application is not a cure all. The patentee has to show an error within the meaning of 35 U.S.C. §251. The reissue application cannot be utilized to avoid other patent rules.[22] For example, error may not include a conscious choice to not file a continuation application,[23] or the failure to file a divisional application for nonelected claims.[24] Errors that are correctable are typically those that arise because a patentee failed to appreciate the "scope" of the invention.[25]

The patentee cannot "recapture" claimed subject matter that was surrendered in the original application that resulted in the patent to be reissued.[26] In other words, you cannot recapture material that

---

15 35 U.S.C. §252 (2004).
16 35 U.S.C. §251 (2004); *See In re* Morgan, 990 F.2d 1230 (Fed. Cir. 1993).
17 37 C.F.R. §1.176.
18 U.S. PTO, *Official Gazette*.
19 *In re* Sneed, 710 F.2d 1544 (Fed. Cir. 1983).
20 35 U.S.C. §251 (2004).
21 *See, In re* Fotland, 779 F.2d 31 (Fed. Cir. 1985), *cert. denied*, 476 U.S. 1183 (1986).
22 *In re* Orita, 550 F.2d 1277 (C.C.P.A. 1977).
23 *In re* Mead, 581 F.2d 251 (C.C.P.A. 1978).
24 *In re* Watkinson, 900 F.2d 230 (Fed. Cir. 1990).
25 *C.R. Bard, Inc. v. M3 Sys., Inc.*, 153 F.3d 1340 (Fed. Cir. 1998).
26 *In re* Clement, 131 F.3d 1464 (Fed. Cir. 1997).

was surrendered by argument or by amendment in the prosecution of the original patent.[27] However, keep in mind that the recapture doctrine is applied on an element-by-element basis. Therefore, if the reissue claims are broader in certain respects and narrower in other elements, the recapture doctrine may not apply.[28]

Congratulations! You monitored the status of your inventions and issued patents and recognized a defect in your '567 patent. You filed within two years of the anniversary of the issuance of the '567 patent; you have filed a continuation reissue patent; and your original reissue patent application issued today as U.S. Patent Re 98,567. The claims of your reissued patent are presumed valid as if the new claims had issued in the original patent. The reissued patent will expire on the date of the original '567 patent:

> [E]very reissued patent 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 granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are substantially identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent.[29]

Be aware, however, that the public is protected by intervening rights in claims that have been broadened. Federal statute also provides in part (emphasis added):

> A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, *prior to the grant of a reissue*, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the [use or practice of] the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing *infringes a valid claim of the reissued patent which was in the original patent.* The court before which such matter is in question *may provide for the continued [use or practice] of which substantial preparation was made before the grant of the reissue*, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court *deems equitable* for the protection of investments made or business commenced before the grant of the reissue.[30]

In summary, keep in mind that the easiest and most effective method of ensuring that an invention is fully and accurately claimed is during the prosecution stage, including continuation application practice. However, in the event that post-issuance corrections are necessary, reissuance provides an effective and convenient mechanism. Be diligent in monitoring the scope of inventions and of the scope of issued and pending claims.

---

27 *Hester Indus. v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998).

28 *See, In re* Clement, 131 F.3d 1464 (Fed. Cir. 1997); *see also Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992 (Fed. Cir. 1993).

29 35 U.S.C. §252 (2004).

30 *Id.*