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MEMORANDUM

DATE: November 15, 2007
TO: Technology Center Directors
FROM: *John J. Love*
John J. Love
Deputy Commissioner
for Patent Examination Policy
SUBJECT: Clarification of Treatment of Reissue Applications That Only Add One or More Narrower Claims

Summary: 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 USC § 251. Such reissue application should not be allowed.

Background: It has come to my attention that certain reissue applications are being examined in the Corps in an inconsistent manner. The inconsistent examination occurs in those reissue applications in which the only "error" set forth in the reissue oath/declaration is that one or more additional claims that is/are narrower than at least one of the patent claims is/are being added for some reason other than that one or more patent claims is too broad. Absent a statement that the patent for which reissue is sought is wholly or partly inoperative or invalid in that one or more patent claims is/are too broad, or a statement specifying and correcting some other (proper) error that renders the patent wholly or partly inoperative or invalid, such reissue applications do not recite an error within the meaning of 35 U.S.C. § 251. Retaining the original broader patent claim(s) in the reissue application without amendment or cancellation of such claim(s), is an indication that the broader claim(s) is/are not in any way inoperative to cover the disclosed invention, or invalid as being too broad. In this scenario, some reissue applications are being allowed, while other reissue applications containing similar "error" statements are being rejected as failing to state an error within the meaning of 35 U.S.C. § 251. Accordingly, the purpose of this memo is to clarify how these types of reissue applications should be treated in order to consistently and correctly examine them.

Relevant Statute: The authority for reissue of defective patents is 35 U.S.C. § 251. The statute provides

that: "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 ... reissue the patent for the invention disclosed in the original patent ..."

Office Policy: It is the Office's policy that the reissue statute does not provide a basis for reissuing a patent when the patentee states (in the oath or declaration) only that certain claims could have been claimed, without indicating that in the absence of these claims, (1) the patent *is* wholly or partly inoperative (because the patent claims were too narrow to protect the disclosed invention), or (2) that the patent *is* wholly or partly invalid because one or more patent claims is too broad. Absent a statement by the patentee that the patent claims are too broad or too narrow, or are otherwise defective (*e.g.*, not enabled, indefinite, etc.), the patent claims are not defective such that they render the patent wholly or partly inoperative or invalid under 35 U.S.C. §251. Instead, it is the Office's position that claims added to a reissue application must correct one or more presently existing errors in the scope (breadth) of coverage provided by the patent claims, or must correct another claim defect that would render the claim(s) inoperative or invalid, unless another reissuable error under 35 U.S.C. § 251 is identified and is being corrected in the reissue application. (See MPEP §1402 8th Ed., Rev. 5 for errors correctible by reissue under 35 U.S.C. §251.)

The Office's policy is reflected in 37 CFR 1.175(a), which requires that the reissue oath or declaration include a statement that the applicant for reissue believes the original patent to be wholly or partly inoperative or invalid, and to identify at least one error that is relied upon as the basis for that belief. Thus, the reissue oath or declaration must allege, and the reissue application must provide correction of, an error of the type that will justify reissue in order to invoke 35 U.S.C. § 251, that is, an error that renders the original patent wholly or partly inoperative or invalid.

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 reissuable error under 35 USC § 251:

All claims pending in a reissue application in which (1) the reissue applicant presents one or more claims that are all narrower than the broadest patent claims(s), and (2) the only error that is alleged to support the reissue is that the additional claims "could have been claimed" or that the patentee was claiming "less than" patentee had a right to claim ("less than" being used to mean "too few" claims), are to be rejected as failing to state an error under 35 U.S.C. § 251.

The rejection must be maintained unless (1) the reissue application is thereafter amended to include a reissue oath/declaration that specifies a different "error" that renders the patent wholly or partly inoperative or invalid in accordance with 35 U.S.C. § 251, and (2) includes a corresponding correction of that error.

Where the only error that a reissue applicant desires to correct in a reissue application is to be corrected by the presentation of claims that are all narrower than one or more broader patent claims, examiners must require that (1) the error relied upon by the reissue applicant be described in the reissue oath or declaration as correcting the error of claiming "more than" the patentee had a right to claim, and (2) that the correction of such error include cancellation and/or amendment of one or more patent claims, (as is appropriate to the presentation of the narrow claims), that the patentee regards as being too broad. All claims presented in a reissue application that does not comply with these requirements are to be rejected as failing to state an error under 35 U.S.C. § 251.

Examiners should refer to MPEP § 1402 for guidance on the types of errors that will properly support reissue of a patent in order to determine whether an error specified in the reissue declaration that is relied upon to support the reissue application is an error that will support issuance of a reissue patent under 35 U.S.C. § 251.