

# Training Module for Chapter 14 of the MPEP

## Summary

### Chapter 14: Correction of Patents

#### Section 1401.01 – Introduction

- After the USPTO issues a patent, the patent may be corrected in one of 4 ways:
  - (1) by reissue
  - (2) by issue of a certificate of correction (which becomes part of the patent)
  - (3) by disclaimer
  - (4) be re-examination
- Ex parte reexamination = re-examination initiated by a member of the public who does not actively participate in the proceeding.
- Inter parte re-examination = re-examination initiated by a member of the public who continues to participate in the proceedings.

#### Section 1401 – Reissue

- NOTE: No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within 2 years from the grant of the original patent.
- The USPTO may reissue a patent when there is an error in the patent that causes the patent to be wholly or partially inoperative or invalid, and the error occurred without deceptive intent.

- **THEREFORE:** There must be at least one error in the patent to provide grounds for reissue! (**This is frequently tested.**)
- The process to reissue a patent is almost like starting over with the applicant preparing a **reissue application**!
- **EXAMPLE:** In the case of restriction requirement made on an application and the elected invention becomes an issued patent, it would **not** be possible to revive the non-elected portion of the application by reissue because there is no error in the granted patent.
- Typical errors that can be corrected by reissue:
  - (1) the claims are too narrow or too broad
  - (2) inaccuracies in the disclosure
  - (3) failure or incorrect references to prior art in co-pending applications, etc.
  - (4) substantial errors in drawings
- Errors in spelling grammar etc, do not usually cause the patent to be “wholly or partially invalid or inoperative”, thus they do not serve as a basis for reissue. These errors may be covered by a certificate of correction.

However, if a patent is to be reissued for valid grounds, the trivial errors may also be corrected in the reissue.

- All reissued patents have the same term as the original patent.
- The term of an issued patent (filed after June 1995) is 20 years from the filing date of the earliest U.S. application which priority is claimed. (NOTE: Provisional applications are excluded.)

## Section 1481 – Certificates of Correction – Applicant’s Mistake

- The USPTO may issue a Certificate of Correction for applicant mistakes that were made in good faith and fall into one of the following 3 categories:

- (1) a clerical mistake
  - (2) a typographical mistake (e.g. misspelled inventor's name)
  - (3) a mistake of minor character.
- A mistake that is not of minor character would require re-examination.
  - Under no circumstances can a Certificate of Correction (to an issued patent) be used to correct an applicant's failure to claim priority to a provisional application. That's because such a priority claim must occur during the pendency of the application. (This makes sense, since the provisional application is not examined.)

## Section 1480 – Disclaimers

- A disclaimer is a statement filed by an owner (the original inventor(s) or assignees) of a patent or patent application in which the owner relinquishes legal rights to the patent or portions thereof.
- There are two types of disclaimers:
  - (1) a statutory disclaimer, and
  - (2) a terminal disclaimer.
- A statutory disclaimer is a statement in which the patent owner relinquishes legal rights to one or more claims of a patent. (This may result from a lawsuit or because the owner has reason to believe that the claims are too broad or otherwise invalid.)
- A terminal disclaimer dedicates to the public the entire term of any remaining portion of a patent (e.g. the last 5 years).
- A terminal disclaimer is often used to overcome non-statutory double patenting.
- A disclaimer can be signed by the owner of a patent or patent application or by someone empowered by the owner to sign the disclaimer. **HOWEVER, A REGISTERED PRACTITIONER CAN**

**NOT SIGN A DISCLAIMER UNLESS HE IS OF RECORD!**

- NOTE: A terminal disclaimer in a parent application normally has no effect on a continuing application claiming priority to the parent application. However, if an applicant files a Request for Continued Examination (RCE) of an application, any terminal disclaimer present will remain in effect because a continuing application has not been filed. Rather, prosecution continues with the existing application.
- REMEMBER: A TERMINAL DISCLAIMER ONLY AFFECTS THE APPLICATIONS OR PATENTS **SPECIFICALLY REFERENCED IN THE DISCLAIMER.**

**Selected Questions and Answers for Chapter 14**

**Question 14-1** (Oct03pm-2a)

A U.S. patent was granted on May 8, 2001. The sole independent claim in the patent is directed to a combination of elements ABCD. A registered practitioner filed a reissue application on April 11, 2003 to narrow sole independent claim. In the reissue application, the independent claim is amended to a combination to elements ABCDE. The reissue application is accompanied by a transmittal letter stating that the application was filed to narrow a claim, that all inventors could not be located to sign the reissue oath or declaration at that time, and that a declaration would be submitted in due course. No other amendments to the claims were filed on April 11, 2003. On May 8, 2003, a declaration signed by all inventors is filed declaring that they had claimed less than they had a right to claim, and that the error arose without deceptive intent. The inventors also filed on May 8, 2003 a preliminary amendment deleting element A from the sole independent claim leaving elements BCDE. The amendment and declaration are filed using the provisions of 37 CFR 1.10. The practitioner included an authorization to charge the practitioner's deposit account for any necessary fees. Which of the following actions by the primary the examiner in the first Office action is in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant did not file a broadened reissue claim at the time of filing.
- (B) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant did not file a claim to a broadened reissue claim within the two year period set by 35 USC 251.

- (C) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant's indication in the transmittal letter indicated that the filing of the reissue application was a narrowing reissue and that the broadening amendment was not permissible even if filed within the two-years from the grant of the original patent.
- (D) Determine that the application is a proper broadening reissue and perform an examination and issue an Office action in due course.
- (E) Determine that the application is a proper broadening reissue and reject the claims under the recapture doctrine since the claims are broader than the issued claims.

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ANSWER: (D) is the most correct answer. MPEP §§ 1403 and 1412.03, under the heading "When A Broadened Claim Can Be Presented." A broadening reissue claim must be filed within the two years from the grant of the original patent. (D) is the most correct and the examiner should examine the case as any other application and address appropriate issues concerning reissue examination. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) (a similar rule in interferences). Since applicant filed the amendment by Express Mail, the amendment is treated as being filed with the USPTO on the date of deposit with the US Postal Service. Therefore, (A), (B) and (C) are incorrect answers. A reissue application can be granted a filing date without an oath or declaration, or without the filing fee being present. See 37 CFR § 1.53(f). Applicant will be given a period of time to provide the missing parts and to pay the surcharge under 37 CFR § 1.16(e). See MPEP § 1410.01. Choice (E) is not correct since the mere deletion of an element of a claim does not automatically raise a ground of rejection based on the recapture doctrine. See MPEP § 1412.02.

#### Question 14-2 (Oct03pm-11a)

A U.S. patent was granted on May 8, 2001 to five inventors. The five inventors assigned their entire patent rights to Q Company. Q Company needs to file a reissue application to broaden the claims of the patent. The registered practitioner preparing the application has been unable to locate any of the five inventors to sign the reissue oath or declaration. Today is May 8, 2003. Which of the following should the practitioner do to enable the applicant to broaden the patent claims in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Wait to file the reissue application until the first day the signatures of all five inventors can be obtained. At that time, pay the filing fee and file a petition seeking May 8, 2003 as the filing date. File with the petition a showing of the unavailability of all inventors until the filing of the application.

- (B) Wait to file the reissue application until the signatures of at least three inventors can be obtained. At that time, file a petition seeking May 7, 2003 as the filing date accompanied by a showing of the unavailability of all inventors on May 8<sup>th</sup>. Payment of the filing fees may be postponed until receipt of a decision on the petition.
- (C) File the reissue application on May 8, 2003, presenting only the claims in the patent, and include a listing of inventors, but not pay the filing fee at the time of filing.
- (D) Wait to file the reissue application until the signature of one of the inventors has been obtained since at least one inventor is needed to show a lack of deceptive intent on the part of the applicants.
- (E) File the complete reissue application complying with 37 CFR 1.173(a) and 1.53(b) with an unexecuted reissue declaration listing the names of all the inventors with at least one broadening claim on May 8, 2003.

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ANSWER: (E) is the most correct answer. 35 U.S.C. § 251; 37 CFR § 1.53(f); MPEP § 1403. Filing a broadened reissue application with at least one broadening claim prior to the expiration of the two-year time period set in the statute satisfies the diligence provisions of 35 U.S.C. § 251. The executed reissue oath/declaration and the filing fee may be filed at a later time. According to MPEP § 1403, a reissue application can be granted a filing date without an oath or declaration, or without the filing fee being present. See 37 CFR § 1.53(f). The reissue applicant will be given a period of time to provide the missing parts and to pay the surcharge under 37 CFR § 1.16(e). See MPEP § 1410.01. (A), (B) and (D) are clearly incorrect since the inventors and assignee would be barred from a broadening reissue if filed after the two year period set in the statute. (C) is incorrect since the reissue application was filed without at least one broadening claim prior to the expiration of the two-year time period set in 35 U.S.C. § 251.

### Question 14-3 (Ap03am-11a)

In accordance with the USPTO rules and procedures set forth in the MPEP, a Certificate of Correction effectuates correction of an issued patent where:

- (A) Through error and without deceptive intent, there is a failure to make reference to a prior copending application according to 37 CFR 1.78, and the failure does not otherwise affect what is claimed, but the prior copending application is referenced in the record of the application, and a petition under 37 CFR 1.324 and appropriate fees were filed.
- (B) Through error and without deceptive intent, a preferred embodiment that materially affects the scope of the patent was omitted in the original

disclosure in the filed application, and a petition under 37 CFR 1.324 and appropriate fees were filed.

- (C) Through error and without deceptive intent, a prior copending application is incorrectly referenced in the application, the incorrect reference does not otherwise affect the claimed subject matter, and the prior copending application is correctly identified elsewhere in the application file, and a petition under 37 CFR 1.324 and appropriate fees were filed.
- (D) Through error and without deceptive intent, an inventor's name is omitted from an issued patent, a petition under 37 CFR 1.324 and appropriate fees were filed, and the petition was granted.
- (E) (A), (C) and (D).

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ANSWER: (E) is the most correct answer. (A) and (C) can be corrected by a certificate of Correction. MPEP § 1481. (D) can be corrected by a Certificate of Correction. 37 CFR § 1.324; MPEP § 1481. (B) is incorrect. Such a mistake, which affects the scope and meaning of the claims in a patent, is not considered to be of the "minor" character required for issuance of a Certificate of Correction. MPEP § 1481.

#### Question 14-4 (Oct02am-12a)

Inventor A filed a patent application and assigned the entire interest in the application to his employer, MegaCorp. The application issued as a utility patent on July 9, 2002. In June 2004, MegaCorp's management first learns that a second inventor, Inventor B, should have been named as a co-inventor with respect to at least one claim of the issued patent. There was no deceptive intent in failing to name Inventor B in the original application. Inventor A, who is unfamiliar with patent law and concepts of inventorship, incorrectly believes that he should be the sole named inventor on the patent, and refuses to cooperate with any effort by MegaCorp to change the named inventive entity. The issued patent contains no other error. In accordance with the Manual of Patent Examining Procedure, which of the following procedures is/are available for MegaCorp to seek correction of the named inventive entity without any agreement, cooperation or action from Inventor A?

- (A) File, on or before July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
- (B) File, after July 9, 2004, a reissue application, made by MegaCorp only, that seeks to add Inventor B.
- (C) Request a Certificate of Correction to add Inventor B as a named inventor.
- (D) Submit in the issued patent file: a Request for Correction of Inventorship Under the Provisions of 37 CFR 1.48 that sets forth the desired inventorship change; a statement by Inventor B that the error in inventorship occurred without deceptive intention on her part; an oath or

declaration executed by Inventor B; all required fees; and the written consent of MegaCorp.

- (E) A and B are each available procedures.

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ANSWER: The best choice is (E). *See* MPEP § 1412.04. Reissue is a proper vehicle for correcting inventorship in a patent. Because correction of inventorship does not enlarge the scope of the patent claims, the reissue application may be filed more than two years after the patent issued. Answers (A) and (B) are therefore both correct, and (E) is the best response. Although a certificate of correction may be used to correct inventorship where all parties are in agreement, the facts of the question show that Inventor A is not in agreement. Choice (C) is thus not an available option for MegaCorp. Choice (D) is incorrect because the provisions of 37 C.F.R. § 1.48 are not available to correct inventorship in an issued patent.

#### Question 14-5 (Oct02am-50a)

If a reissue application is filed within two years of the original patent grant, the applicant may subsequently broaden the claims during prosecution of the pending reissue prosecution beyond the two year limit, \_\_\_\_\_.

- (A) if the applicant indicates in the oath accompanying the reissue application that \_\_\_\_\_ the claims will be broadened.
- (B) if an intent to broaden is indicated in the reissue application at any time within three years from the patent grant.
- (C) if the reissue application is filed on the 2-year anniversary date from the patent grant, even though an intent to broaden the claims was not indicated in the application at that time.
- (D) if the reissue application is a continuing reissue application of a parent reissue application, and neither reissue application contained an indication of an intent to broaden the claims until 4 years after the patent grant..
- (E) provided, absent any prior indication of intent to broaden, an attempt is made \_\_\_\_\_ to convert the reissue into a broadening reissue concurrent with the presentation of broadening claims beyond the two year limit.

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ANSWER: (A) is correct. MPEP § 1412.03. *In re Doll*, 164 USPQ 218, 220 (CCPA 1970). (B) is wrong because 35 U.S.C. § 251 prescribes a 2-year limit for filing applications for broadening reissues. (C) is wrong because although *Switzer v. Sockman*, 142 USPQ 226 (CCPA 1964), holds that while a reissue application filed on the 2-year anniversary date from the patent grant is considered to be filed within 2 years of the patent grant, it is necessary that an intent to broaden be indicated in the reissue application within the two years from the patent grant. MPEP § 1412.03. (D) is wrong because a proposal for broadened claims must be made in the parent reissue application within two years from the grant of the original patent MPEP § 1412.03. *In re Graff*, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997). (E) is wrong because there was no intent to broaden indicated within the two years. MPEP § 1412.03. *In re Fotland*, 228 USPQ 193 (Fed. Cir. 1985).

#### Question 14-6 (Ap02am-44a)

An amendment filed in January 8, 2002, in an unassigned nonprovisional application seeks to cancel claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed. The amendment includes a request to delete the names of the persons who are not inventors. In accordance with proper USPTO rules and procedure, the request may be signed by which of the following?

- (A) A registered practitioner not of record who acts in a representative capacity under 37 CFR 1.34(a).
- (B) All of the applicants (37 CFR 1.41(b)) for patent.
- (C) A registered practitioner of record appointed pursuant to 37 CFR 1.34(b).
- (D) (B) and (C).
- (E) (A), (B), and (C).

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ANSWER: (E) is the correct answer. 37 C.F.R. § 1.48(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54619 (September 8, 2000). As stated in 65 FR at 54619, middle column, “Sections 1.48(b) and (d) are revised to indicate that a request to correct the inventorship thereunder must be signed by a party as set forth in § 1.33(b)...” (A), (B), and (C) are provided for in 37 C.F.R. § 1.33(b). Thus (E), the most inclusive answer, is correct.

#### Question 14-7 (Ap02pm-37a)

Applicant Einstein files a patent application on November 26, 1999, that claims a new type of football pads. Prosecution is conducted and the application issues as a patent to Einstein on April 3, 2001. A competitor, Weisman, who has been making and selling football pads since April of 1998, learns of Einstein’s patent when Einstein approaches him on May 3, 2001, with charges of infringement of the Einstein patent.

Weisman makes an appointment to see you to find out what he can do about Einstein's patent, since Weisman believes that he is the first inventor of the claimed subject matter. At your consultation on May 17, 2001, with Weisman, you discover that Weisman widely distributed printed publications containing a fully enabling disclosure of the invention and all claimed elements in the Einstein patent. Weisman used the printed publication for marketing his football pads in April of 1998. Weisman explains that he wishes to avoid litigation. Which of the following is a proper USPTO practice and procedure that is available to Weisman?

- (A) Weisman should file a petition to correct inventorship under 37 CFR 1.324 in the patent, along with a statement by Weisman that such error arose without any deceptive intention on his part, requesting that a certificate of correction be issued for the patent under 35 U.S.C. § 256, naming the correct inventive entity, Weisman.
- (B) Weisman should file a reissue application under 35 U.S.C. § 251, requesting correction of inventorship as an error in the patent that arose or occurred without deceptive intention, wherein such error is corrected by adding the inventor Weisman and deleting the inventor Einstein, as well as citing Joe Weisman's April 1998 printed publication for the football pads as evidence that Weisman is the correct inventor.
- (C) Weisman should file a prior art citation under 35 U.S.C. § 301, citing the sales in April 1998 of football pads, and explain the pertinency and manner of applying such sales to at least one claim of the Einstein patent.
- (D) Weisman should file a request for *ex parte* reexamination of the Einstein patent under 35 U.S.C. § 302, citing the April 1998 printed publication of football pads in, and explain the pertinency and manner of applying such prior art to at least one claim of the Einstein patent.
- (E) Weisman should file a request for *inter partes* reexamination of the Einstein patent under 35 U.S.C. § 311, citing public use of the football pads in April 1998, and explain the pertinency and manner of applying such prior use to at least one claim of the Einstein patent.

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ANSWER: (D) is correct. It is the only answer that proposes to use a practice and procedure that is available to Einstein. 35 U.S.C. § 302. (A) This is incorrect because a statement by the currently named inventor as required by 37 C.F.R. § 1.324(b)(2) and the fee required by 37 C.F.R. § 1.20(b) have not been filed. (B) This is incorrect, as in *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 567 n.16, 195 USPQ 97, 106 n.16 (D.C. Cir. 1977) wherein correction of inventorship from sole inventor A to sole inventor B was permitted in a reissue application, does not apply here, as a reissue application can only be filed by the inventor(s) or assignee(s). See MPEP § 1412.04. (C) This answer is

incorrect because it refers to sales, as opposed to patents or printed publications. (E) The option of requesting *inter partes* reexamination is not available in this scenario, as the patent in question issued from an original application which was filed prior to the critical date of November 29, 1999. Only patents which issued from original applications filed in the United States on or after November 29, 1999, are eligible for *inter partes* reexamination (37 C.F.R. § 1.913).

#### Question 14-8 (Ap00am-23a)

Jo invented a new and unobvious technique for inexpensively manufacturing a chemical that has been used in paper mills for years to bleach paper. Tommie developed a new and unobvious technique to clean-up toxic waste spills. Jo and Tommie collaborated to invent a method to clean-up toxic waste spills using the chemical made according to the unobvious technique invented by Jo. The inventions have been assigned to your client, Dowel Chemical Company. You prepared a single patent application fully disclosing and claiming each invention. Claims 1-9 were directed to the method of manufacturing; claims 10-19 were directed to the method of cleaning up toxic waste spills; and claim 20 was directed to a method of cleaning up toxic waste spills using the chemical manufactured in accordance with claim 1. Both inventors approve the application, but Tommie is unavailable to sign an oath before an upcoming statutory bar date. Accordingly, you are instructed to immediately file the application without an executed oath. On June 1, 1999, you file the application along with an information sheet to identify the application. However, you do not notice that Tommie was inadvertently left off the list of inventors on the information sheet, which listed Jo as a sole inventor. After receiving a Notice to File Missing Parts, you submit an oath executed by both Jo and Tommie. No paper was filed to change the named inventive entity. You later receive an Office action requiring restriction between Jo's invention and Tommie's invention. In reply to the restriction requirement, you elect Jo's invention, cancel claims 10-20, and immediately file a divisional application directed to the invention of claims 10-19. Claim 20 was omitted from the divisional application. The divisional application includes a specific reference to the original application and is filed with an inventor's oath executed by Tommie only. The divisional application incorporated the original application by reference.

Which of the following statements is correct?

- (A) Because the original application as filed named only Jo as an inventor, Tommie's divisional application is not entitled to the filing date of the original application because there is no common inventor between the original application and the divisional application.
- (B) The incorrect inventorship listed on the information sheet of the original application was never properly corrected and, therefore, any patent issuing on that application will be invalid under 35 U.S.C. § 116 unless the inventorship is later corrected.

- (C) After canceling claims 10-20, it is necessary to change the named inventive entity in the original application by filing a petition including a statement identifying Tommie as being deleted and acknowledging that Tommie's invention is no longer being claimed in the application and an appropriate fee.
- (D) Written consent of Dowel Chemical Company is required before Tommie can be deleted as an inventor in the original application.
- (E) It is necessary in the divisional application to file a petition including a statement identifying Jo as being deleted as an inventor and acknowledging that Jo's invention is not being claimed in the divisional application.

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ANSWER: (C). The original mistake in omitting Tommie from the list of inventors was automatically corrected by filing the oath executed by both Jo and Tommie. 37 C.F.R. §1.48(f)(1). Under 37 C.F.R. §1.48(b), a change in inventive entity is thereafter required upon cancellation of the non-elected claims. (B) is wrong because inventorship was automatically corrected with the filing of the correct oath. (A) is wrong because Tommie was properly named as a co-inventor in the parent application, and 35 U.S.C. §120 requires, *inter alia*, only one common inventor. (D) is incorrect because an assignee's written consent is not required if an inventor is being deleted because the prosecution of the application results in the cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the inventions being claimed in the application. 37 C.F.R. §1.48(b). (E) is incorrect because the divisional application never named Jo as an inventor so there is no need to correct the inventorship.

## In-Depth Review of Chapter 14

Please click on the link, below, to bring up a special version of Chapter 14 in the MPEP that has been prepared exclusively by **PassPatentBar** to complete your review of this chapter. It is recommended that you quickly scan through most of this chapter while reading only those sections, about 10% of the total, that are highlighted in yellow. When you are finished with this review, please return here by using the return arrow at the top-left on your screen.

## Chapter 14 MPEP