

Reissue Application Filing Guide for Applications filed on or after September 16, 2012

A reissue application may be filed when a patent, through error, is deemed wholly or partly inoperative or invalid. A detailed discussion of the laws, rules and procedures governing reissue applications may be found in the Manual of Patent Examining Procedure (MPEP) Chapter 1400 (9th Ed., March 2014). The current version of the MPEP can be found on the Office's internet web site, <http://www.uspto.gov>, by typing "MPEP" in the search box at the top right of the home page and clicking the green arrow. All USPTO Forms discussed in this guide may be found on the Office's web site at http://www.uspto.gov/forms/aia_forms.jsp.

The following guide explains the proper way to file an original reissue application, continuation reissue application, or divisional reissue application **on or after September 16, 2012**.

- 1. Application Papers Required**
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1. Application papers required

- For *any* reissue application, the specification including the claims must be a copy of the printed patent in double column format, with text on only one side of each page.
- Any preliminary amendments that are filed with the reissue application must be made in accordance with 37 CFR 1.173 (see MPEP § 1453), and changes are always made relative to the patent (*i.e.*, text being deleted by reissue must be enclosed in brackets, and text be added by reissue must be underlined). Changes to the specification, other than the claims, must be made by

submission of the entire text of an added or amended paragraph with markings as mentioned above, except that an entire paragraph may be deleted by a statement deleting the paragraph. For any claim that is changed by the amendment paper, a parenthetical expression “amended,” “twice amended,” etc. should follow the claim number. If any amendments to the claims are made, a separate page must be filed with the amendment that identifies the status (*i.e.*, pending or canceled) of all patent claims and all added claims, and explains the support in the patent for the changes made to the claims. See 37 CFR 1.173(c).

- A copy of any certificate(s) of correction, or disclaimer (terminal or statutory) must be included in the filing, and the changes made by any certificate of correction or disclaimer must be incorporated cleanly into the specification, claims or drawings *without markings*. The changes must be incorporated without markings because certificates of correction and disclaimers are part of the issued patent. The best practice is to file a preliminary amendment identified as an amendment under 37 CFR 1.173 submitted to incorporate into the patent the changes made in the specifically identified certificate of correction and/or disclaimer. Do not file a substitute specification to incorporate the changes - substitute specifications are not permitted in reissue applications. See 37 CFR 1.125(d).
- Copies of any reexamination certificate must also be filed with the reissue application.

2. Reissue Patent Application Transmittal

Although not required, it is recommended that a completed Reissue Patent Application Transmittal (PTO/AIA/50) accompany the original reissue patent application filing. The form identifies to the applicant which documents should be filed and what other forms or documents could be filed with the reissue application.

3. Consent of Assignee/Statement of Non-Assignment

The reissue application must be accompanied by the written consent of all assignees, if any, currently owning an undivided interest in the patent. If no

assignee exists (*i.e.*, the inventors are the owners), then applicant should affirmatively state that fact which may be accomplished by checking box eight and “No” on the Reissue Patent Application Transmittal (PTO/AIA/50). USPTO Form PTO/AIA/53 or an equivalent may be used to provide the consent of all assignees (100% of the entire right, title and interest) in the patent, or to affirmatively state that there is no assignee and the inventors are the owners of the patent.

The Consent of Assignee must be signed by a party authorized to act on behalf of the assignee or a patent practitioner of record (*i.e.*, a patent agent or patent attorney who is appointed by the reissue applicant in a power of attorney document that is present in the reissue application). See MPEP § 325, V. Party Who Must Sign. If there are multiple assignees who together with other assignees or inventors own 100% of the entire right, title and interest of the patent, then submit one PTO/AIA/53 (or equivalent) for each owner.

Additionally, all assignees consenting to the reissue must establish their ownership in the patent by filing a statement under 37 CFR 3.73(c) (USPTO Form PTO/AIA/96 or equivalent).

If no assignee exists, then the Statement of Non-Assignment may be signed by the inventor(s) or a patent practitioner of record.

If the Consent of Assignee/Statement of Non-Assignment is not filed with the application, the Office will mail a Notice to File Missing Parts requiring the document (and any other missing documents) as well as payment of a surcharge.

4. Inventor’s Oath or Declaration

An inventor’s oath or declaration for a reissue application, in addition to meeting the requirements of 37 CFR 1.63, 1.64 or 1.67, must also comply with 37 CFR 1.175. Depending on the circumstances, the inventor’s oath or declaration for a reissue application can be: (a) a reissue declaration by the inventor, (b) an assignment by the inventor containing the statements required by 37 CFR 1.63 and 1.175 (“assignment-statement”), (c) a reissue declaration by the assignee, or (d) a substitute statement by the patentee, or the current patent owner if there has been an assignment. (See USPTO forms PTO/AIA/05, PTO/AIA/06, PTO/AIA/07, PTO/AIA/10 and PTO/AIA/11, all of which are explained below.) Unlike in non-reissue nonprovisional patent applications, submission of the inventor’s oath or

declaration in a reissue application **cannot** be delayed until payment of the issue fee. The application must contain the inventor's oath or declaration executed by or with respect to each inventor before the case can be released for examination. See 37 CFR 1.175(e).

Error Statement: The inventor's oath or declaration in a reissue application must contain an error statement that is the basis for the reissue application. For a discussion of error statements, see MPEP § 1402. If changing inventorship, then the reissue application should also identify this error as an error, even if other identified errors are being corrected.

Statement of invalidity or inoperability: The inventor's oath or declaration for a reissue application must also state that the applicant believes the original patent to be 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 the patentee had a right to claim in the patent.

PTO/AIA/05, Reissue Declaration by the Inventor: Each inventor being named in the reissue application must execute a reissue declaration unless the declaration can be made by the assignee (PTO/AIA/06) or a substitute statement can be filed (PTO/AIA/07).

PTO/AIA/06, Reissue Declaration by the Assignee: The assignee of 100% of the entire right, title and interest in the patent (who also must be named as the reissue applicant) may sign the declaration if the application does not seek to enlarge the scope of the claims in the original patent, or the application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest. (Note: the latter could only be true where the application that became the patent for which reissue is being sought was filed under on or after September 16, 2012, or if an application that became the patent was filed under 35 U.S.C. 371 and the International Filing Date was on or after September 16, 2012). If the application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest, then the appropriate box on page two of the PTO/AIA/06 should be checked. Note: if contrary to the facts the box indicating that the application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest is checked, a replacement declaration correcting that deficiency will be required.

If the reissue applicant is a juristic entity, then the reissue declaration must be signed by an official of the applicant who has a title that carries apparent authority,

or someone who makes a statement of authorization to act (e.g., an employee of the assignee who by corporate resolution of a Board of Directors has been given authority to act on behalf of the juristic entity). See MPEP § 325. Please note: while a patent practitioner of record can sign a statement under 37 CFR 3.73(c), the same is not true for a substitute statement. A patent practitioner could only sign the document if he or she has been given authority to act as explained above and may not sign the substitute statement merely on the basis of having power of attorney in the application.

PTO/AIA/07, Substitute Statement in Lieu of an Oath or Declaration for Reissue Patent Application (35 U.S.C. 115(d) and 37 CFR 1.64): The patentee, or current patent owner if there has been an assignment, may sign a substitute statement on behalf of an inventor who is deceased, legally incapacitated, cannot be found or reached after diligent effort, or refused to execute the oath or declaration under 37 CFR 1.175.

5. Application Data Sheet (ADS), Domestic Benefit Claims, Foreign Priority Claims

Application Data Sheet

For applications filed on or after September 16, 2012, the best practice is to file an Application Data Sheet (ADS) (USPTO Form AIA/14, EFS-ADS generated at the time of filing the application via EFS-Web, or an equivalent) with the application, and this is also true for reissue applications. An ADS must be filed where the patent has been assigned, or where the underlying patent contained, or the reissue application is making, claims of foreign priority under 37 CFR 1.55 or domestic benefit under 37 CFR 1.78. This guide only contains instructions for and examples of indicating

- a. Secrecy Order 37 CFR 5.2**
- b. Inventor Information**
- c. Application Information**
- d. Publication Information**
- e. Domestic Benefit/National Stage Information**
- f. Foreign Priority Information**
- g. Applicant Information**
- h. Assignee Information including Non-Applicant Assignee Information**

For all other fields the instructions for the AIA/14 need no further elaboration to deal with reissue applications.

Detailed Form Instructions for Fields that have different requirements and/or restrictions for reissue applications:

a. Secrecy Order 37 CFR 5.2

The box in this section should not be checked. Since the application is for a reissue of an already issued patent, secrecy does not apply.

b. Inventor Information

The inventor information should list the proper inventive entity. If, for example, the reissue application is being filed to add an inventor who was not named in the underlying patent for which reissue is being sought, then the inventor should be listed in the Inventor Information section of the ADS. If an inventor who was named in the underlying patent is being deleted in the reissue application, then the inventor should not be listed in the inventor information section of the ADS.

c. Application Information

The information for this reissue application should be listed in this section. The “Filing by Reference” section should not be completed as reference filing cannot be utilized for a reissue application. Since the reissue application is a new application, it will be assigned an application number. Because of this, the application number of the underlying application that became the patent for which reissue is now being sought should not be typed into this section.

d. Publication Information

Neither box in this section should be checked. Reissue applications are not published under 35 U.S.C. 122(b) as patent application publications, so neither early publication nor nonpublication may be requested. **Note:** If you receive a notice of publication in the application that indicates that the application was not processed as a reissue. In such a situation review the application to determine the cause of such processing. After review of the application, you may call the Office of Patent Legal Administration’s

Reexamination/Reissue Helpline (571-272-7703) to determine what action, if any, may be taken to remedy the situation.

e. Domestic Benefit/National Stage Information

For applications filed on or after September 16, 2012, all domestic benefit claims must be made in an ADS. See 37 CFR 1.78. Additionally, the reissue application should be identified as a reissue application in this section. In the first line, the Prior Application Status should be "Patented." "Application Number" should be left blank, the "Continuity type" should be "reissue of" and then the "Prior Application Number," "Filing Date," "Patent Number" and "Issue Date" fields should be completed to identify the patent for which reissue is being sought and its original application number and filing date. Any desired domestic benefit claims that were made in the patent must be repeated. If the claims are not presented in the ADS submitted in the reissue application, then they will not be recognized until properly presented. If any domestic benefit claims are being added, they must be made in this section, and any appropriate petition and fee must be filed. For continuation and divisional reissue applications, see section 6 below. Note: Removing a benefit claim will not result in the term of the patent being extended as 35 U.S.C. 251 limits the term of any reissue to the unexpired term of the issued patent. However, the removal of the benefit claim will affect the effective filing date for purposes of determining what constitutes prior art.

f. Foreign Priority Information

For applications filed on or after September 16, 2012, all foreign priority claims must be made in an ADS. Any desired foreign priority claims that were made in the patent must be repeated. If the claims are not presented in the ADS submitted in the reissue application, then they will not be recognized until properly presented. If any foreign priority claims are being added, they must be made in this section, and any appropriate petition and fee must be filed.

g. Applicant Information:

For reissue applications filed on or after September 16, 2012, the reissue applicant is the original patentee or the current patent owner if there has

been an assignment. See 37 CFR 1.172. The reissue must name the current patent owner (which may be the patentee if ownership has not changed since the underlying patent issued) as the applicant in the Applicant Information section.

If the inventor(s) is not the owner(s) then, in addition to naming the applicant in the ADS, a Statement Under 37 CFR 3.73(c) (USPTO Form AIA/96 or equivalent) and a Consent of Assignee (USPTO Form AIA/53 or equivalent) must be filed for each owner. Note: A juristic entity must be represented by a patent practitioner (See 37 CFR 1.31 and 37 CFR 1.33(b)(3)).

If the inventor(s) are the owners, then the Applicant Information section should be left blank and a Statement of Non-Assignment (USPTO Form AIA/53 or equivalent) must be filed to affirmatively state that the inventors are the owners.

h. Assignee Information including Non-Applicant Assignee Information

This section should not be completed. By rule, if there is an assignee, the assignee must be the Applicant for the reissue of the patent. Thus, a reissue may never have a “Non-Applicant Assignee”.

6. Multiple Reissue Applications Filed for the Same Patent

If more than one reissue application is filed for the same patent, each reissue application must contain or be amended to contain a notice stating that more than one reissue application has been filed. See MPEP 1451, I. for the suggested language to be included.

7. Additional Information for Continuation Reissue and Divisional Reissue Applications

Applicant may file a continuation reissue or divisional reissue application for the same patent, which is a continuation or divisional of a first (or subsequent) reissue application. Any continuation reissue or divisional reissue application must be clearly identified as a reissue application. This is because it is possible under limited circumstances to file a *non-reissue continuing application of a reissue*

application (i.e., a Bauman type continuation application). See MPEP § 1451. The PTO/AIA/50 (Reissue Patent Application Transmittal Form) provides the ability to make this identification by checking the box next to the following text:

This is a continuation reissue or divisional reissue application (*i.e., a second or subsequent reissue application for the same issued patent*).

Identification of the application as a continuation reissue or divisional reissue includes filing the proper specification and claims, and a proper inventor's oath or declaration. In the ADS, the application should both be identified as a continuation (or divisional) of the parent reissue application, and should also be identified as a reissue application of the underlying patent. Here is an example of the proper way to make such identifications:

Facts for this example:

- U. S. Patent Application 32/456789 was filed January 14, 2003 and is a continuation-in-part of 32/012345 was filed June 6, 2002.
- U.S. Patent Application 32/456789 was issued as U.S. Patent No. 9,876,543 on November 20, 2007.
- Reissue Application 33/123456 was filed November 15, 2011, for U.S. Patent No. 9,876,543.
- The application currently being filed is a reissue continuation application, meaning it is a continuation of reissue application 33/123456, **and** is also a reissue of U.S. Patent No. 9,876,543.

(Screen shot of relevant portion of USPTO Form PTO/AIA/14, Application Data Sheet)

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.

When referring to the current application, please leave the application number blank.

Prior Application Status						Remove
Application Number		Continuity Type		Prior Application Number		Filing Date (YYYY-MM-DD)
		Continuation of		33123456		2011-11-15
Prior Application Status		Patented				Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)	Patent Number	Issue Date (YYYY-MM-DD)	
33123456	reissued of	32456789	2003-01-14	9876543	2007-11-20	
Prior Application Status		Abandoned				Remove
Application Number		Continuity Type		Prior Application Number		Filing Date (YYYY-MM-DD)
32456789		Continuation in part of		32012345		2002-06-07
Prior Application Status		Patented				Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)	Patent Number	Issue Date (YYYY-MM-DD)	
	reissued of	32456789	2003-01-14	9876543	2007-11-20	
Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the Add button.						

When the field on the left side beneath “Application Number” is left blank, it signifies “This Application is a” to refer to the application being submitted. Thus, the information above clearly indicates that this application is **both** a continuation of 33/123,456 and a reissue of U.S. Patent No. 9,876,543.

A continuation reissue or divisional application the specification including the claims must be a copy of the printed patent in double column format, with text on only one side of each page.

A copy of the inventor’s oath or declaration from the parent reissue application may be filed if: (a) it identifies an error that is being corrected in the continuation reissue or divisional reissue application and (2) the document is signed by a proper party (*e.g.*, the copy was signed by the current patent owner and ownership has not changed).