

# The Limited Monopoly™

## Broadening Reissue - Changing the Scope of Your Patent Claims

by Robert Gunderman PE and John Hammond PE

### Keeping the patent process in focus with your business

The long pendency of patent applications in the U.S. often creates a problem when a company's technology gets ahead of its patent applications. Product development, competitors, and the market drive change. Unfortunately, keeping patent applications in focus with these changes is oftentimes neglected. Frequently, companies pay no attention to the patenting process once the application has been filed. This creates problems when the market and product evolve away from what was claimed in the original patent application. Keeping your intellectual property adequately protected through new filings, continuations, divisionals, or continuations-in-part is good practice. These continuing applications must all be filed before any patent issues. Filing a continuing application before your patent issues is a technique to keep unclaimed subject matter pending in the U.S. Patent Office so that additional claims can be pursued to better meet future business needs.

### The day of issue may come

Even with the filing of new or continuing applications, eventually a patent application is either abandoned or it issues. Once the patent issues or is abandoned, you are no longer able to file continuing applications. So is this the end of the patenting process? No. The grant of a patent starts the life of the patent, and there are two post issue proceedings available that can alter the scope of the claims: Reexamination<sup>1</sup> and Reissue. A

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broadening reissue is a way to enlarge the scope of the claims in a patent that has issued. It is a powerful tool for broadening patent rights that is generally not well understood or used. A basic knowledge of broadening reissues and how it may fit with your overall patent strategy could prove invaluable.

### Altering the content of a U.S. Patent – "I didn't know you could do that."

A broadening reissue application, if allowed, can broaden the scope of the claims in an issued patent. A broadened claim is basically a claim that covers something that the original claims do not. A claim would be considered a broadening claim if

it would enable the patent owner to sue any party for infringement who previously could not have been sued for infringement<sup>2</sup>. You may wish to file for a broadening reissue if the scope of your claims was not directed at what are now the important parts of your invention, or you discover a potential infringer and also conclude that the scope of your claims are not such as to be able to properly enforce your patent. The discovery that your claims are not written as broadly as you had a right to claim usually occurs upon review of a potentially infringing product. So if business circumstances create a situation where the claims of your patent are not adequate, you may want to evaluate whether a broadening reissue can help.

## The two year requirement of the law

To be eligible for a broadening reissue, you must meet certain criteria that are set forth in 35 U.S.C. 251. You must apply for the broadening reissue within two years from the grant of the original patent. Since a patent can qualify for a broadening reissue at any time within these two years, it makes sense to note this two year deadline on a calendar and keep track of it along with your other important patent dates such as payment of maintenance fees.

A reissue application is for a patent that, without deceptive intent, is deemed wholly or partially 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. No new matter can be introduced into the application for reissue.

In addition to the two year statute, to be eligible for a broadening reissue, the new claims must be fully supported in the original patent, the new claims must not attempt to recapture subject matter surrendered during prosecution of the original patent, and the applicant must be able to make a declaration as to why the original patent was defective (e.g., the patentee claimed less than he had a right to claim in the original patent). Some examples of subject matter surrendered during prosecution of the original patent include claims that were canceled due to an amendment or a restriction requirement, claim amendment language used to overcome a reference, or in certain circumstances, written arguments presented in response to an Office action (similar to prosecution history estoppel). A broadening reissue application is examined similarly to a new patent application, and may receive a rejection from the Examiner that can then be addressed in further prosecution.

## Bending, ever so slightly, the two year rule

If your company has filed a broadening reissue application within the two year interval, and you would now like to pursue other claims that were not submitted in the broadening reissue application, these claims can be added later in the pending reissue application, or a continuing (continuation or divisional) application can be filed based on the pending reissue application. So it is important to make the two year filing cutoff date, and after that you have options to broaden even further, or redirect the scope and content of the claims to meet your business needs.

## Effects of Reissue

The law makes some provisions for those that may be infringing on the broadened claims, but were not infringing on the original patent claims. 35 U.S.C. 252 provides for a court to allow for continued manufacture, use, offer for sale, or sale if substantial preparation was made before the grant of the reissue, and also gives the court the ability to allow for continued practice of the invention. These prior use rights should be understood when determining if a broadening reissue application makes sense.

## Protest

In addition to obtaining prior use rights, a competitor may also file a Protest in a reissue application. A Protest is the filing of papers in the United States Patent and Trademark Office that calls attention to any facts within the protestor's knowledge which, in the protestor's opinion, would make the grant of a patent on the application improper. A Protest may be filed by any member of the public.<sup>3</sup>

## Last Chance...

In summary, a broadening reissue is a last chance to broaden your patent claims. It can be a valuable tool in the right circumstances.

1. *The Limited Monopoly™*, February 2007, "Reexamination of the Peanut Butter and Jelly Sandwich" available at [www.patenteducation.com/patentarticles.html](http://www.patenteducation.com/patentarticles.html)
2. MPEP 1412.03, I.
3. *The Limited Monopoly™*, November 2008, "Protest - A little known, little used process in our U.S. patent system," ibid. 1.

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