

Broadening Your Issued Patent – A Chance to Fix the Past
by Michael Frodsham

Patent owners considering enforcement frequently wonder what they can do to strengthen their patent, more commonly to add claims that better cover known infringers, but also whether to correct errors in spelling and syntax. The USPTO provides several options for correcting patents, including reissue applications discussed below, as well as certificates of correction, ex-parte reexamination/supplemental examination, post-grant review, inter-partes review (IPR), and covered business method review. See *MPEP* § 1400.01

Reissue and reexamination (Supplemental Examination) applications are the more common options for strengthening a patent pre-litigation; however reexamination provides the patent owner with limited response options (patentees cannot broaden the claims, for example), and if the Examiner issues a final rejection, the patent owner's primary responsibility is to appeal. Costs can rise in a hurry. In addition, should the reexamination and appeal route turn out unfavorably, the patent owner obtains a narrower or potentially invalidated patent as the USPTO will simply issue a reexamination certificate that cancels the rejected claims. See 37 CFR 1.570.

Reissue applications, particularly "broadening reissue applications," provide patent owners with the unique advantage of being able to maintain a pending version of their patent for providing corrections and potentially broadening the claims, while at the same time enforcing their patent's present claims against infringers. Notably, the USPTO's final determination against the claims in reissue does not render the patent unenforceable like with reexamination – actually, the original patent remains enforceable until the grant of newly allowed claims, whereas a determination that all claims are invalid would have no effect on the original patent. See 37 CFR 1.178. Of course, a patent owner should expect an infringer to use the USPTO's arguments against patentability as a roadmap during litigation even if the patent owner still maintains opportunities to make its case in court.

Furthermore, unlike reexamination, reissue applications have a similar feel of regular applications, allowing requests for continued examination after a final rejection, and in some cases reissue continuation applications. See *MPEP* §§ 1451-1452. The most powerful of these types of applications is the "broadening reissue application," which provides the added

benefit of allowing a patentee to broaden their claims to cover infringers while at the same time enforcing their patent against the same infringers.

Broadening Reissue

To file a broadening reissue, a patent owner must file their request to correct the patent within two years of the issue date, and identify “at least one error” in the original patent. 35 U.S.C. § 251(d); *MPEP* §1412.03. (Even the two-year rule may appear flexible when considering patent families with multiple child continuation cases and different issue dates). For a broadening reissue application, this can be an error in claiming the invention too narrowly, failing to add a dependent claim that might help the patent withstand a challenge to validity, or even simply to correct inventorship. *See also MPEP* § 1412.05.

As an example, suppose that the patent owner realizes in retrospect that an issued patent could have claimed another embodiment of a product that others are now infringing. As long as the patent owner files within two years of issuance, and the original patent contains support for that embodiment, the patent owner can have the USPTO consider additional claims that now capture the infringers.

Notably, the patent owner can simultaneously assert the original patent against infringers of the current claims even while the patent is in reissue. *See MPEP* § 1416; 37 CFR § 1.178. This remains true even when infringers file a challenge to patent validity via the USPTO’s Inter-Partes Review proceedings (IPR).

In a sense, a reissue application allows a patent owner to get the best of all possible worlds: maintain the ongoing threat of enforcement against infringers, while at the same time working to correct or otherwise improve the patent to avoid other litigation pitfalls. Importantly, in a world where it is increasingly common for infringers to challenge patents via IPR, reissue applications can provide patent owners with important tools to fix any claims that the IPR process deems invalid, and thus allow the patent owner to maintain steady pressure against infringers. This is similar in some respects to the advantages found in ex-parte

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reexamination; however, reissue applications provide more flexibility in claim amendments. Not surprisingly, reissue applications have gained in popularity recently, particularly with the increase in third-party patent challenges.

Some interesting things that patentees can do in a broadening reissue application include but are not limited to: 1) adding new drawings that clarify embodiments discussed in the original specification; 2) amending the specification text to clarify features found in the original figures; 3) adding claims to new embodiments that get restricted into a new, divisional reissue application; and 4) filing co-pending continuation reissue applications that include narrower limitations deemed allowable while continuing prosecution of broader claims in the main reissue application. See *MPEP* §§ 1440, 1445, 1450-1453. Also, just like with regular patent applications, patent owners can interview the case with the assigned Examiner (*i.e.*, a panel of Examiners), and can introduce newly uncovered prior art in line with the ordinary information disclosure statement (IDS) rules.

Regardless, broadening reissue applications are not an opportunity to relitigate the patentee's prior admissions to the USPTO. That is, if the patent owner limited the claims to overcome a particular prior art rejection from the USPTO in the original patent, the patent owner cannot now revise claims to that same invention in the reissue application by removing those limitations, even in a broadening reissue application. This is impermissible "recapture." See *MPEP* § 1412.

Narrowing Reissue

For reissue applications filed outside of two years from the issue date, the patent owner can still take advantage of the flexibility afforded in reissue applications, albeit only by filing a narrowing reissue application. The narrowing reissue application can be filed at any time up until the expiration of the patent. As implied by name, not only must the patentee narrow the original claims in a narrowing reissue application, the patentee is also prohibited from presenting independent claims having the same scope as before, even if providing other types of corrections to the patent claims. See *MPEP* § 1412.01(C)(B)(1)(a). Nevertheless,

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narrowing reissue applications provide important vehicles for pre-litigation and concurrent litigation corrections.

Summary

The USPTO provides a number of options for correcting patents well after the issue date, and patent owners should consider each carefully in connection with enforcement strategies. Reissue applications can be a particularly powerful tool to this end.