

Correcting an Incorrect or Ineffective Patent

AUTHOR: JOSEPH ROLNICKI

The inability of a patent to prevent copying of a patented product could be due to the patent claims being too narrow or the claims being ambiguous. Errors such as these in a patent's claims could be the result of how the patent was written or how the patent was prosecuted at the Patent Office.

A patent having too narrow claims or ambiguous claims could enable a competitor to copy the patented product and avoid infringing the claims of the patent.

As an example, imagine a startup business that was created to manufacture and sell a commercially desirable product. The business owns a patent on the product. The patent describes the product as being operated by a motive source. The patent describes examples of the motive source as a combustion engine, an electric motor, or another equivalent type of motive source. However, when the patent was written an error occurred and the patent claims recite the product being operated by a "combustion source". Not only is a "combustion source" not described in the patent, but a "combustion source" could be interpreted as a combustion engine limitation recited in the patent claims. In such a situation a competitor could copy the patented product and avoid infringing the claims of the patent by replacing the combustion engine of the product with an electric motor. The competitor when accused of infringement could argue the claims of the patent recite a combustion source meaning a combustion engine. A copy of the product that is operated by an electric motor does not infringe the claims that require a combustion engine.

As another example, imagine the startup business owns a patent that describes a product having a first part and a second part. The product operates by the first part being stationary and the second part pivoting relative to the first part. During the Patent Office examination of the patent application that issued as the patent, the patent claims were amended, and the amendments inadvertently switched the first part and the second part. As a result, where the patent describes the first part being stationary and the second part pivoting relative to the first part, the claims recite the second part being stationary and the first part pivoting relative to the second part. If a competitor were to copy the patented product, it would be difficult for the patent owner to prove the competitor copied the patented product and infringed the patent claims where the patent description of the product and the patent claims to the product conflict and are ambiguous.

The United States Patent and Trademark Office provides a patent owner with a way to correct patents that are incorrect or ineffective. A patent reissue application can be filed when a correction is needed by the Patent Office to correct a significant error in an issued patent. The reissue application allows the patentee to re-prosecute the patent and cure any defects found in the issued patent claims or specification. To initiate the reissue application examination and gain a reissued patent, there must be an error in the issued patent that resulted from a mistake made during the preparation or prosecution of the patent application that was issued as the patent.

There are various types of mistakes that can be the basis for a reissue patent application. For example, mistakes such as the examples discussed above make the patent claims too narrow or make the patent claims unclear or ambiguous and therefore difficult to enforce. The error must be significant and cause the patent to be considered wholly or partially inoperative or invalid by reason of a defective patent specification or drawing or by the patentee claiming more or less than the patentee had a right to claim.

In the first example above, a reissue application could be filed to amend the claims of the issued patent to correct the claims by replacing "combustion source" with "motive source". This not only would correct the claim language but would result in the broadening of the claim coverage. The motive source recited in the claims could be interpreted as a combustion engine, an electric motor, or any other equivalent type of motive source.

Where broader claims are desired, it is important to note that the reissue application must be filed within two years of the date the original patent was granted.

Where corrections of mistakes other than broader claims are desired, a reissue application may be filed at any time during the life of the issued patent. In the second example above, a reissue application could be filed to correct the occurrences of where "the first part" and "the second part" were switched at any time during the life of the issued patent.

On the filing of a reissue application with the related filing papers and payment of filing fees, the reissued application will be examined like other regular patent applications. It is a common occurrence for the Patent Office Examiner that examined the patent application that issued as the original patent being assigned to handle the examination of the reissue application.

A reissue application includes an offer to surrender the original patent. On the allowance of the reissue application to issue as a reissue patent, the original patent is surrendered.

During the examination process of a reissue application the original patent remains in effect. The original patent remains in effect until the reissue application is allowed to issue as a reissued patent. If the reissue application is rejected and the examination of the reissue application is abandoned, the original patent remains enforceable.

The statutory basis for filing a reissue application for an issued patent is provided by 35 U.S.C. Sections 251 and 252, 37 CFR Sections 1.171 et seq. and Section 1.291, and by Chapter 1400 of the Manual of Patent Examining Procedure (MPEP).

Additional information on filing patent reissue applications can be found [here](#).