

How Reissue Applications Can Help You Save Your Patent

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Within weeks, the U.S. Supreme Court is expected to issue a landmark patent decision in *Bilski v. Kappos*. This decision is expected to change substantially the rules for patent-eligibility of processes – including, but by no means limited to, business methods and software-implemented processes. Following the decision, many patent claims will be invalid.

Because of the risk of invalidity, savvy patent owners will be scrambling to assure that their patent claims continue to protect their intellectual property rights. Some patent claims considered invalid under the new rules may be salvaged by going back to the Patent Office to “reissue” them in some kind of amended form. Claims that are too broad to be valid can be narrowed, and patent claims that are narrower than necessary under the new ruling—reducing the full range of protection due—may be broadened. However, there is a strict time limit for broadening the claims. In many instances, it will already be too late; in others, acting fast will be of key importance to get in under the wire.

Many patent owners do not understand the obscure procedures for changing the scope of issued patent claims. Some may even erroneously believe it impossible to do so. To respond to the *Bilski* decision, patent owners should educate themselves as to how reissue applications can be used to protect and defend their vested rights.

Reissue, not reexamination

The patent system provides three tools that may be used to change the claims of an issued patent: reissue, reexamination, and certificates of correction, although we will only address the first.

Some may be familiar with reexamination as an alternative or adjunct to litigation. Reexamination allows the Patent Office to reconsider the granted claims in light of prior patents and publications (“prior art”)

that were overlooked during the initial examination. A proper reexamination request must include a prior art reference and an explanation of why the reference raises a substantial question about the validity of the subject patent. Because of this requirement, reexamination is likely not useful for changing claims in response to the *Bilski* decision.

The reissue process provides a more general way to correct defects in issued patents. One such defect may be that the claims of the issued patent are narrower or broader than warranted. When the *Bilski* decision is handed down, of course, many patent owners will be able to assert that their claims are too narrow or too broad in view of the new standard established by the Court. These patent owners should therefore promptly consult their patent counsel about the pros and cons of submitting reissue applications to change—and save—their patent claims.

Reissue requirements

Because the reissue process is designed to correct “defects,” a complete reissue application requires the patent owner to cite at least one error that causes the issued patent to be “wholly or partly inoperative or invalid.” The error must be clearly identified and explained. As a threshold matter, a patent examiner must agree that a defect exists.

While *Bilski* likely will provide a font of citable errors, the errors to list should be selected carefully. First, the errors should have a material impact on the issued patent and not be merely a whim of the patent owner. Further, while the reissue rules allow for many types of changes to be made, only changes that correct the identified error(s) are permitted. Reliance on an error that does not qualify, or a change not linked to an error that justifies a reissue, can cause a court to invalidate individual claims or the entire reissued patent.

Timing requirements may also be a concern for many. If the reissue application will



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broaden any claim in any way, the reissue application must be submitted within two years of the grant of the original patent. Reissue applications that serve only to narrow claims, however, may be submitted at any time.

So, what constitutes broadening a claim? Basically, making any change that removes a restriction from the claim, however small, will be considered a broadening amendment. This is true even if several additional restrictions are imposed on the claim – narrowing amendments – at the same time. So, great care must be taken with every wording change if the two-year broadening reissue deadline has passed.

Reissue process

Examination of reissue applications substantively proceeds according to the familiar rules of utility patent applications. While the patent office rules require reissue applications to be handled urgently, because of the well-known backlog at the Patent Office, reissue applicants should expect to wait a year or more before hearing from an examiner. Months or years may then pass before the process ends. Meanwhile, any infringement litigation is held up and the closing of licensing deals is hampered.

Diligent patent owners should begin reviewing their patent portfolios now so that the reissue process can be started soon after the *Bilski* decision, both to ensure that claims are changed as quickly as possible and to avoid inadvertently missing the two-year broadening deadline.

Cautionary notes

Of course, the benefits of reissue applications are balanced by risks. As mentioned above, improper or insufficient errors may lead a court to invalidate individual claims or even an entire reissue application. Two other risks bear mention and should be carefully addressed.

First, the reissue process may not be used to “recapture” any subject matter surrendered while obtaining the original patent. If claims were amended to distinguish a prior art reference during the original prosecution, for example, reissue claims cannot cover the subject matter that was given up by that amendment. Claims that do “recapture” subject matter will be rejected or invalidated. So it may be necessary to add some additional restriction to avoid running into the recapture doctrine. A careful study of the original patent may be necessary to

ensure a valid reissue patent.

Second, the law provides protection for those who rely on the scope of claims of an originally-granted patent when developing their businesses and making investments. If at the time the reissue process ends, someone is selling a product that does not infringe any remaining claims of the original patent but does infringe a new or changed claim of the reissue patent, that party has an “intervening right” to sell their existing products. The party could even be granted a right to continue making and selling a new, unfinished product if a court determines that fairness requires such a dispensation. Reissue claims should be carefully studied to be sure that competitors are not inadvertently given these rights.

Conclusion

Reissue applications can provide an important tool for patent owners seeking to preserve their IP rights following the *Bilski* decision. The reissue process can be long and sometimes difficult, and includes some risks. However, these risks may be preferable to claims that are simply invalid following the Supreme Court’s decision.