

period of abandonment of a reissue application, should the reissue application become revived and serve to reissue the patent, will result in a loss of patent term for the period that the reissue application was abandoned. Accordingly, there is no need to impose an additional penalty on patentee to terminally disclaim the entire period of abandonment of a reissue application. This rationale accords with the exclusion of the terminal disclaimer requirement when petitioning for revival of nonprovisional applications filed on or after June 8, 1995, pursuant to § 1.137(d)(1).

Current Office practice does not require a terminal disclaimer as a condition precedent for revival of an abandoned reissue application, no matter when the application was filed, where revival is otherwise appropriate.

In order to codify current practice, § 1.137(d)(3) is proposed to be amended by inserting "to reissue applications" to provide a blanket exception for reissue applications. Regardless of when the reissue application was filed, applicant is not required to file an accompanying terminal disclaimer with a petition to revive under § 1.137.

*Section 1.165:* Section 1.165(b) is proposed to be amended to remove the requirement for a black and white copy of a color drawing or photograph. This requirement has already been waived. See *Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs*, 1246 *Off. Gaz. Pat. Office* 106 (May 22, 2001).

*Section 1.173:* Section 1.173(b) is amended to clarify that paragraphs (b)(1), (b)(2) and (b)(3) are directly related to, and should be read with, paragraph (b).

*Section 1.175:* Section 1.175 is proposed to be amended by adding a new paragraph (e) requiring a new oath or declaration for continuing reissue applications, which must identify an error not corrected in an earlier reissue application.

Section 1.175 is currently interpreted to require any continuing reissue application whose parent application has not been abandoned to include an oath or declaration identifying at least one error being corrected, which error is different from the error(s) being corrected in the parent reissue (or an earlier reissue). Ordinarily, a single reissue application is filed to replace a single original patent and corrects all of the errors recognized by the applicant at the time of filing of the (single) reissue. If, during the prosecution of the reissue application, applicant (patentee)

recognizes additional errors needing correcting, such corrections could, and should, be made in the same application. If, however, after the close of prosecution and up until the time that the first reissue issues, applicant recognizes a further error which needs correction and files a continuing reissue application, § 1.175(e) would now explicitly require applicant to include an oath or declaration which identifies an error which was not corrected in the parent reissue application or in an earlier reissue application, e.g., a grandparent reissue application.

*Section 1.178:* Section 1.178 is proposed to be amended to eliminate the requirement for physical surrender of the original letters patent (i.e., the "ribbon copy" of the original patent) in a reissue application, and to make surrender of the original patent automatic upon the grant of the reissue patent. The reissue statute provides in part that:

Whenever any patent is, through error without any deceptive intention, deemed 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 he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

See 35 U.S.C. 251, ¶ 1 (emphasis added).

While the statutory language requires a "surrender" of the original patent, it does not require a physical surrender of the actual letters patent, nor even a statement that the patent owner surrenders the patent. Physical surrender by submission of the letters patent (i.e., the copy of the original patent grant) is currently required by rule via § 1.178; however, such submission is only symbolic, since the patent right exists independently of physical possession of the letters patent.

It is the right to the original patent that must be surrendered upon grant of the reissue patent, rather than any physical document. Thus, where the letters patent is not submitted during the prosecution of the reissue application because it is stated in the reissue that the letters patent copy of the patent is lost or inaccessible, there is no evidence that any stigma is attached to the reissue patent by the public. Further, there is no case law treating such a reissue patent adversely due to the failure to submit the letters patent. In fact, there is no legal reason to retain the requirement for physical surrender

of the letters patent. On the other hand, there is much benefit for eliminating the requirement for physical surrender of the letters patent.

It would be beneficial to both the Office and the public to recognize and provide that the surrender of the original patent is automatic upon the grant of the reissue patent to thereby eliminate the requirement for a physical submission of the letters patent, and to eliminate even the need for filing a paper offering to physically surrender the letters patent (§ 1.178(a)).

The current requirement for submission of the patent document requires the patent owner (seeking reissue) to try to obtain the letters patent copy of the patent. If the document was lost or misplaced, the patent owner must search for it. If it is in the hands of a former employee, the patentee must make an effort to secure it from that employee (who might not be on friendly terms with the patentee). If the letters patent can be obtained, it must then be physically submitted without losing or destroying it. If the letters patent cannot be obtained, the patent owner must make a statement of loss (Form PTO/SB/55) or explain that it cannot be obtained from the party having physical possession of it. The proposed revision of § 1.178 would eliminate these burdens, and the requirement for use of form PTO/SB/55 or its equivalent.

At present, the requirement for submission of the letters patent copy of the patent provides an unnecessary drain on Office processing and storage resources in dealing with the submitted letters patent document. Further, in the event the reissue is not granted, the Office must return the letters patent to the applicant where such is requested. The proposed revision would do away with the burden on the Office of processing, storing, and returning letters patent.

The current requirement for submission of the original patent (the letters patent), or a statement as to its loss, results in a "built in" delay in the prosecution while the Office awaits submission of the letters patent or the statement of loss, which is often submitted only after an indication of allowance of claims. The proposed revision would reduce reissue application pendency, since the Office would no longer need to delay prosecution while waiting for the letters patent or the statement of loss.

As a final point, the complete elimination of the requirement for an affirmative act (of surrender) by the patent owner would put reissue in step with other post patent proceedings for change of patent which have no