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IT IS TIME TO LOOK AT REISSUES AGAIN

CHARLES M. HOGAN*

The Supreme Court of the United States has not since 1942 interpreted the patent reissue statutes.¹

Traditionally a patent has been regarded as a contract between the inventor and the United States Government. In consideration of a full disclosure of the invention, adequate to enable one of ordinary skill in the relevant art to practice it, the United States Government grants to the inventor the exclusive right, for a period of seventeen years, to practice the invention as defined by the claims, which constitute a part of the patent specification. Claims are analogous to a fence around a parcel of real estate in that they define the nature of the inventor's contribution and the respects in which it departs patentably from the prior art. A claim commonly consists of a plurality of related elements constituting a combination. A claim provides a challenge to the ingenuity of rival innovators in that the omission of an element in a combination claim avoids infringement. In some cases the particular element might inadvertently have been included in the original patent claim. If it is superfluous or unnecessary, as in the case where its inclusion was due to inadvertence, accident or mistake, the inventor has an equity to reform the patent contract, so as to obtain a revised or additional claim in which the superfluous element is omitted. Otherwise, the invention is not adequately protected against appropriation by others. Accordingly, the patent statutes authorize the reissue of a

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¹ U.S. Industrial Chem., Inc. v. Carbide & Carbon Chem. Corp., 315 U.S. 668 (1942).

patent in which the inventor's claim represents less than is his just due.

Reissue patent law has classically been treated in a manner closely analogous to the law of reformation of contracts. If the original claim purposely includes the superfluous element, perhaps one omitted by a rival innovator, or if the original patentee did not teach a combination without such element, then the original patentee has no equity for reissue. If the law were otherwise, then a patentee, having obtained his original claim for a plurality of elements, could await the further progress of the art, and then seek to cover by a reissue patent later or independently devised structures comprising a lesser number of elements. It is in this respect that the reissue statute is susceptible to abuse by frauds. The Supreme Court of the United States frequently interpreted the former patent reissue statute and did not hesitate to strike down fraudulent reissues. But in 1952 a new reissue statute was enacted and subsequent decisions have been so liberal as to make reissues favorites of the law. It is time for the Supreme Court of the United States to look at reissues again.

A substantial body of decisional law developed around the former reissue statutes.² Prior to the Patent Act of 1952 the

² Act of May 24, 1928, ch. 730, § 4916, 45 Stat. 732 provided:

Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. . . . The specifications and claims in every such case shall be

general principles applicable to reissue were as stated in *Sontag Chain Stores Co. v. National Nut Co. of California*.³ When the claims of an original patent were inadequate to cover all that was disclosed, the legal operation of the issuance of the patent was that the unclaimed matter was dedicated to the public. This legal effect of the original patent could not be avoided unless the patentee surrendered the patent and met all of the requirements for reissue: i.e., proof that the specification was framed by real inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. Nothing but a clear mistake or inadvertence and a speedy application for its correction would suffice to meet the requirements of the statute when the patentee sought merely to enlarge the claims by reissue.

Deliberate action—i.e., purposeful failure to claim unclaimed subject matter—was of course not a mistake. When it was shown that unclaimed matter was intentionally omitted or abandoned, it could not be recouped by reissue at all—for the simple reason that deliberate action excludes the required inadvertence, accident or mistake.

Some examples of such deliberate abandonment were acquiescence in the rejection of a claim, and acceptance of a patent containing limitations imposed by the Patent Of-

subject to revision and restrictions in the same manner as original applications are. . . . [B]ut no new matter shall be introduced into the specification, or in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

³ 310 U.S. 281, 45 U.S.P.Q. 448 (1940).

face which narrowed the scope of the invention as at first described and claimed.⁴ Other instances were the previous deliberate disclaimer of the subject matter sought to be recovered by reissue or the substance thereof.⁵

The above were not at all the only circumstances which negated the existence of inadvertence, accident or mistake. An even more striking instance of such lack occurred when a patentee obtained the original patent by emphasizing a particular feature. In such cases the courts were quick to hold a reissue patent invalid or not allowable as a matter of law when the very feature emphasized in obtaining allowance of the original was omitted from the reissue claims.⁶

Indeed the old decisions tended to discourage a reissue-abuse practice whereby certain applicants would emphasize a particular element for the purpose of obtaining an original patent and would then assert that the presence of that element in the claims was an unnecessary limitation for the purpose of obtaining a reissue patent without that element. That is, it was classically held that a reissue would not be permitted to enlarge the claims of an original patent by including matter once intentionally omitted.⁷ The substantive law

⁴ See *Dobson v. Lees*, 137 U.S. 258, 265 (1890).

⁵ See *Leggett v. Avery*, 101 U.S. 256, 259 (1880); *Fiberjoint Corp. v. W. R. Meadows, Inc.*, 112 F.2d 322, 326, 45 U.S.P.Q. 632 (7th Cir. 1940); *In re Wadsworth*, 107 F.2d 596, 600, 43 U.S.P.Q. 460 (C.C.P.A. 1939).

⁶ See *Riley v. Broadway-Hale Stores, Inc.*, 217 F.2d 530 (9th Cir. 1940). Some cases continue to apply this principle under the 1952 statute, e.g., *In re French*, 89 F.2d 662, rehearing 90 F.2d 113, 114, 33 U.S.P.Q. 374, 537 (C.C.P.A. 1937).

⁷ Cases cited *supra*, n. 5; *Shepard v. Carrigan*, 116 U.S. 593, 597, 598 (1886); *Dill Mfg. Co. v. J. W. Speaker Corp.*, 179 F.2d 278 (7th Cir. 1950), *cert. denied*, 340 U.S. 818 (); *Mercoid Corp. v. Milwaukee Gas Specialty Co.*, 119 F.2d 370 (7th Cir. 1941), *aff'g* 33 F. Supp. 681, 684 (E.D. Wis. 1940); *Hummel and Downing Co. v. Hinde and Dauch Paper*

so laid down afforded the public a large measure of protection against fraud.

These decisions afforded the public less protection against a situation in which an original applicant would feature two or more elements, in order to obtain an original patent, and then omit only one of those elements for purposes of a reissue. That is, if an original applicant would insert in his original claims a critical element plus some additional verbiage, then he might escape the impact of these decisions and omit the element by contending during the reissue proceedings that it was really the verbiage that motivated the allowance of the original. If in his original argument for allowance of the original the applicant argued not only the merits of the really critical element, but also the merits of another element or two, he had some prospect of escaping the impact of these old decisions.

After the case law on reissues was fairly settled, a new patent statute was substituted for the old in the patent law codification and revision popularly known as the Patent Act of 1952.⁸

The new reissue statute, as judicially interpreted, has fav-

Co., 272 F. 812, 814 (7th Cir. 1921). The traditional doctrine was recently followed in *Haliczer v. United States*, 356 F.2d 541, 148 U.S.P.Q. 565 (Ct. Cl. 1966). In that case the original patentee relied on side edges to obtain the original patent and the accused device lacked such side edges. The court held invalid the additional claims added by reissue because the omitted edges had motivated the examiner to allow the original patent. The claims added by reissue were substantially the same as claims surrendered by applicant during prosecution of the original patent.

⁸ Section 1 of the Act, 66 Stat. 792, enacts Title 35 of the United States Code into positive law.

ored reissues so strongly as inadequately to protect the public.⁹ Let us consider the wording of the new statute and the trend of the decisions since 1952, particularly with reference to the kind of error required as a basis for a reissue of the type in which an element or relation, commonly referred to as a "limitation," is omitted in the broadened reissue claim.

The report of the Committee on the Judiciary, accompanying the House Bill enacted into law as the Patent Act of 1952,¹⁰ insists that the purpose of the new reissue statute was to "replace the present one, making a number of clarifications and a few additions in further development of the subject." While this is an indication that no substantial change was intended, the courts have held otherwise.

⁹ Patent Act of 1952, 35 U.S.C. § 251 provides as follows:

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 commissioner 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. No new matter shall be introduced into the application for reissue.

The provisions of this title relating to applications for patent shall be applicable to application for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

¹⁰ H.R. 1923, 8, 45, 82nd Cong., 2d Sess. (1952). Cf. S. 1979, 7. 82nd Cong., 2d Sess.

Examination of the language of the old and new statutes detects some changes, significant in semantics, and greatly magnified as judicially construed in recent decisions. The more significant of these changes are indicated by this tabulation:

OLD

The error must have arisen by inadvertence, accident or mistake and without any fraudulent or deceptive intention.

The patent must be wholly or partly inoperative or invalid.

The ground for reissue must be a defective or insufficient specification or the difficulty must arise because of the patentee claiming as his own invention or discovery more than he had a right to claim as new.

The reissue patent must be for the same invention, and in accordance with the corrected specification.

No new matter shall be introduced into the specification, nor in the case of a machine patent shall the model or drawing be amended, except each by the other; but when there is neither model nor drawing amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention and was omitted from the specification by inadvertence, accident or mistake.

The specification and claims shall be subject to revision and restriction in the same manner as original applications.

NEW

The defect in the patent must have arisen through error without any deceptive intention.

The patent must be "deemed" so.

A defective or insufficient specification or drawing, the patentee claiming more or less than he had a right to claim in the patent.¹¹

The reissue patent must be for the invention disclosed in the original patent and in accordance with a new and amended application.

No new matter shall be introduced into the application for reissue.

The provisions relating to applications for patent shall be applicable to applications for reissue.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.¹²

¹¹ This was a statutory confirmation of a well established interpretation of the old reissue statute.

¹² Prior to the 1952 statute the decisions, by analogy to the statutory bar applicable to original patent applications, generally applied the same time limitation to broadened claims of a reissue, at least in the absence of excuse.

The changes in the reissue statute have prompted many questions which have not yet been authoritatively decided by the Supreme Court of the United States.¹³ A fundamental question, to which this paper principally attends, is whether the expression "through error, and without deceptive intention" excuses the classic requirement that the reissue defect arise through inadvertence, accident or mistake.

Heretofore the requirement was that inadvertence, accident or mistake be extrinsic. That is, the mere fact that an original patentee claimed less than he might have claimed did not of itself constitute the requisite inadvertence, accident or mistake. The requirement of the classic decisions was that the error arise through inadvertence, accident or mistake. However, decisional law under the new patent statute affords some support to those who contend that the mere failure to claim supplies the requisite inadvertence, accident or mistake.

Of principal concern to the courts and to the patent profession is the broadened type of reissue, that is, a reissue patent in which the claims cover products, for example, that the original patent did not embrace. Suppose that the claims of an original patent are limited to a combination embracing elements designated A, B, C, D and E. Assume further that the patent owner learns that a competitor is making a structure which omits both the element E and its function. It is clear law that if the original patent disclosed the combination A-D together with an intention to claim it, if the failure to obtain a claim on that combination was due to inadvertence, accident or mistake, if the subject matter of that combination was

¹³ For a discussion of intervening rights, i.e., the defensive rights accruing to one who begins the manufacture of an accused device, covered by the broadened reissue claims, prior to the reissue, see generally Silverman, *To Err is Human—Patent Reissues and the Doctrine of Intervening Rights*, 48 JOURNAL OF THE PATENT OFFICE SOCIETY 696 (1966), which also discusses additional reissue cases decided under the 1952 statute.

not deliberately abandoned during the prosecution of the original, and further if the combination A-D patentably distinguishes over the prior art, then the owner may obtain a reissue.

The issue of intrinsic vel extrinsic mistake is of primary importance. Also worthy of consideration are such questions as whether or not an applicant can avoid the effect of a mistake made by his attorney and whether or not a mistake of judgment still precludes reissue.

Occasionally a reissue type defect is discovered before an original patent issues. The question arises as to the impact on the applicant of failure to invoke any alternative remedies that may be available to him at the time of the discovery of the error, such, for example as a continuation patent application, a suspension, or an amendment under Rule 312 of the Rules of Practice of the United States Patent Office.

Defects which motivate applications for reissue arise from a wide variety of circumstances. It is commonly alleged that the attorney who prosecuted the original patent did not understand the invention. Perhaps he credited the prior art with more than it really discloses. He might have inadvertently given undue weight to an unessential element of the embodiment of the disclosed invention. Occasionally there is lack of adequate contact with the inventor. Economic considerations may prompt the applicant to accept a claim or two and cause the patent promptly to be issued. If at the time the applicant did not perceive or appreciate that a broader and patentable claim could properly have been presented, a question arises as to whether the action of cancelling all unallowed claims forecloses any opportunity for a reissue involving such a proper claim.

Indeed there are many sets of circumstances which justify a bona fide reissue and give rise to liberal decisions which furnish appropriate precedents to like cases. However, the new reissue statute has been construed with gross liberality

and the tendency to view decisional law with universality indicates that the gate is being opened wide to the reformation of patents which the reissue statute was not intended to reform. The decisions tend in the direction of a doctrine which would permit the owner of a well-prosecuted patent, who on inspection of an after-devised structure finds that the claims did not cover it but that the state of the prior art permits presentation of a claim generic to both the invention disclosed in the original patent and such structure, to return to the Patent Office, retain the claims that he has, and obtain claims of broader scope for no reason other than mere failure of the original claims to cover a similar structure made by another.

Reissue patent applications should be viewed with strict scrutiny and not with liberality for reasons springing both from the motivations for reissue and from the mechanics of Patent Office practice.

Whenever an original patentee perceives that it is possible to define both the structure he discloses and an accused device, generically, without being impeded by the prior art, the question arises as to whether the patentee is teaching the generic to the art or whether the accused device taught him. Whenever the failure of the claims of an original patent to cover an accused device motivates the reissue, there is a natural query as to whether the teaching sought to be protected by the reissue patent springs from the original patent or from the accused device.

Too often an applicant returns to the Patent Office with his old claims and claims of broader scope, accompanied by an oath signed by the inventor and averring that the error was failure to obtain claims of broader scope. While oaths of this nature are often pro forma and rarely mention the accused device in a candid manner,¹⁴ the additional claims pre-

¹⁴ In *A. O. Smith Corp. v. Affiliated Gas Equip., Inc.*, 107 F.

sented with the reissue application are at least supported by some kind of verification. But since the claims are subjected to revision, amendment, substitution and restriction during the prosecution of the reissue patent, the additional claims finally appearing in a reissue are frequently supported by no oath at all!

It has been cynically asserted that claims, whether in an original or in a reissue patent, are analagous to globules of mercury which slide around on the surface of the issue between the applicant and the examiner and fall into whatever holes the prior art will allow. The actual operation of the reissue statute, therefore, is to permit the patentee to go through the prosecution procedure for the second time, to start out with reissue claims supported by an ex parte self-serving oath, and to end up with claims covering the accused

Supp. 251, 96 U.S.P.Q. 94 (D. Texas 1953), *aff'd on other grounds*, 205 F.2d 654, 98 U.S.P.Q. 169 (5th Cir 1953), the court struck down a reissue patent which incorporated new matter in the form of a drawing. The court held that the incorporation of the new matter, together with an exchange of blueprints with reference to the parties' structures prior to application for reissue, estopped the plaintiff. However, in *Ex parte Allwein*, 99 U.S.P.Q. 177 (Bd. Pat. App. 1953), claims were allowed to an applicant for reissue which dominated the structure of an adversely held patent issuing after the original patent; the claims were of the "intermediate scope" type, i.e., broader than those in the original, narrower than those cancelled during prosecution of the original. The fact that cases turn on issues of this kind indicates that coverage of a device *aliunde* the patent is a factor which ought to be set forth in the reissue oath, but the Board of Patent Appeals has held that this is immaterial.

device and unsupported by any oath.¹⁵ Too often the courts and the United States Patent Office have attempted to re-write the reissue statute as follows:

If an applicant does not obtain claims in the original patent which will adequately cover an accused device that he later sees, which accused device has a community of novelty and unobviousness with the disclosure of the

¹⁵ 35 U.S.C. § 132 is applicable to reissues and recognizes the right of the applicant to respond to an office action and to file new or amended claims. See also Rules 65, 111-123, and 176 of the Rules of Practice of the United States Patent Office (1965 ed.) Particular attention is invited to Rule 175, which reads as follows:

Reissue oath or declaration. (a) Applicants for reissue, in addition to complying with the requirements of the first sentence of Rule 65, must also file with their applications a statement under oath or declaration as follows:

(1) That applicant verily believes the original patent to be wholly or partly inoperative or invalid, and the reasons why.

(2) When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly specifying such defects.

(3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

(4) Particularly specifying the errors relied upon, and how they arose or occurred.

(5) That said errors arose "without any deceptive intention" on the part of the applicant.

(b) Corroborating affidavits of others may be filed and the examiner may, in any case, require additional information or affidavits concerning the application for reissue and its object.

patent, then the patentee can return to the Patent Office and receive an award of additional claims adequate to cover that device even though the claims finally awarded are not directly supported by any oath.

Too often does a reissue applicant bring the original patent to issue with intent to file a reissue. Too often does a patentee, originally well satisfied with his patent, apply for a reissue in order to provoke an interference with a later issued patent.

The reissue statute does not declare that every patentee has the right to return to the Patent Office and obtain by reissue whatever claims the prior art permits. The true intention of the reissue statute was to permit him to obtain the award of only those claims founded on disclosed subject matter, which claims he manifested an intention to obtain and which claims correspond conceptually to his *a priori* teachings. It is not the intention of the reissue statute to permit him to direct claims to the generic that he extracts *ex posteriori* from a later examined accused device.

Review of the decisions since the enactment of the Patent Act of 1952 establishes an urgent need for a current consideration of the reissue statute by the Supreme Court of the United States and an interpretation of the reissue statute that will discourage this sequence of events: Dissatisfaction with a patent, followed by nominal *ex parte* showings of reissue "defects," followed in turn by a second prosecution in the Patent Office terminating with additional claims relating to generic concepts never taught by the patentee, all without any showing as to the absence of such claims from the original patent being due to inadvertence, accident or mistake.

The need for another look at the reissue statute becomes even more impressive when re-reissues are considered.

The minimum thesis of this paper is that claims finally allowed in a reissue should be supported by a supplemental oath and the Patent Office, by rule, should so require. Addi-

tionally, both the inventor and the attorney should be subject to inquiry by deposition and interrogatories propounded by the examiner, so that a full and candid explanation of the true basis for reissue may be spread on the public record.¹⁶

Even under the new reissue statute the cases seem to be in agreement that if, during the prosecution of an original patent, a claim is presented and then cancelled, that precise claim cannot be obtained by reissue. However, the element-

¹⁶ The author submits that Rule 175 (b) should be rigorously enforced and that a supplemental oath should be required with respect to any allowed claim coverage in the reissue departing in any way from the claims filed with the reissue application. Cf. Rule 67, which reads as follows:

Supplemental oath or declaration for matter not originally claimed. (a) When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath or declaration to the effect that the subject matter of the proposed amendment was part of his invention; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, or patented or described in any printed publication in any country before his invention or discovery thereof, or more than one year before his application, or in public use or on sale in the United States for more than one year before the date of his legal representatives or assigns more than twelve months prior to his application in the United States, and has not been abandoned. Such supplemental oath or declaration should accompany and properly identify the proposed amendment, otherwise the proposed amendment may be refused consideration.

(b) In proper cases the oath or declaration here required may be made on information and belief by an applicant other than inventor.

omitting type of reissue claim is frequently granted if it is narrower in scope than a cancelled original claim directed to the same combination. The decisions do not define with precision the acts, intentions, and conduct which constitute final abandonment of subject matter beyond recoupment by reissue.

Many questions remain unresolved under the new patent statute. Does the execution of decision to accept a claim or two, and to bring the original patent to issue without additional investment, constitute a conclusive and final abandonment of all unclaimed subject matter? What about subject matter actually patentably distinct from the prior art on a ground not then within the comprehension of the attorney? Or the inventor? If at an interview following final rejection the attorney agrees with the examiner to accept a limitation in claims as a condition for allowance, does he then irretrievably abandon subject matter not characterized by such limitation? Does it make any difference whether the examiner is in error as to his view of the prior art?

Not only do the decisions under the new patent statute render uncertain the state of the law that was once fairly well established, but so often the records of original patent proceedings are silent with respect to the precise circumstances under which arose the defects that are complained of in reissues, compounding uncertainties for the Patent Office, for attorneys, and for prospective defendants.

Nor is the law so clearly defined as it should be with respect to the steps that an applicant must take during the prosecution of the original patent when he discovers an unnecessary element in a combination claim.

What course must an applicant pursue during the prosecution of the original patent if he discovers a reissue-type defect? If the notice of allowance has been received, must he file a continuation patent application, or apply for additional claim coverage under Rule 312 of the Rules of Practice of the United States Patent Office? Assume that he has ample op-

portunity to pursue either course, but fails to do so. Is this a conclusive abandonment of his reissue equity, on the theory that the defect, if any, then appearing in the original patent, arises deliberately and not through error? The more significant decisions interpreting the new reissue statute are here examined with these inquiries also in mind.

The early impression that the new reissue statute made no substantive change was reinforced by several decisions. The fact pattern of *Moist Cold Refrigerator Co. v. Lou Johnson Co., Inc.*¹⁷ involved a situation in which the original claims were obtained in good faith and were held valid in a jury trial. In the interim between appeal and final decision the Supreme Court struck down claims, cast in terms of ultimate functionality, in *Halliburton Oil Well Cementing Company v. Walker*.¹⁸ On appeal the Halliburton decision was followed and the claims declared functional and invalid. The patentee obtained a reissue on the ground that the functional character of the original claims could not have been foreseen when the original issued. In the principal case the District Court summarily held the reissue to be invalid on the ground that, as a matter of law, failure to anticipate a court decision does not constitute error within the meaning of the reissue statute.

The United States Court of Appeals reversed on the grounds that the patentee acted in good faith, had been vindicated in the jury trial, and that the Halliburton decision was surprising. The failure of appellant to foresee that a claim would be invalid in litigation, for functionality, is a reissue type error when the functional character of the claim is not obvious.

Note that while the reissue of a patent has classically been regarded as analogous to the reformation of contract, the

¹⁷ *Moist Cold Refrigerator Co. v. Lou Johnson Co.*, 217 F.2d 39, 103 U.S.P.Q. 410 (9th Cir. 1954).

¹⁸ *Halliburton Oil Well Cementing Co. v. Walker*, 320 U.S. 1, 71 U.S.P.Q. 175 (1946).

Court of Appeals departed from the analogy by treating a mistake of law as ground for a reissue. However, the most significant pronouncement of the court was that the test as to the type of error required to warrant reissue under the new statute remains the same as under the old. In effect, the court reads the words "inadvertence, accident and mistake" into the new patent statute.

The same court promptly struck down a reissue in *Riley v. Broadway Hale Stores, Inc.*¹⁹ again insisting that the test as to the type of error required to warrant reissue is the same under the new reissue statute as under the old. Here the original patent issued with claims directed to shoulder pads including voids. The reissue added claims to shoulder pads without voids even though claims for shoulder pads without voids had been deliberately abandoned during the original prosecution. The court held that the subject matter of the reissue claims was deliberately abandoned and that no error through inadvertence, accident or mistake could have existed. The court met the argument that the abandoned claims differed materially from the reissue claims by declaring that in effect the chief aspect of the reissue claims was the omission of the voids. The court left open the question as to the extent of the deviation between newly added reissue claims and abandoned claims which might be permitted.

The Court of Customs and Patent Appeals gave support to the doctrine that no substantial change in the nature of a reissue type error was intended in the case of *In re Byers*,²⁰ where it squarely held that the words "through error" mean "through inadvertence, accident or mistake." The same type of error is necessary to justify reissue after enactment of the Patent Act of 1952 as before. In the *Byers* case a claim generally corresponding to a reissue claim was abandoned during the original prosecution. The reissue claim was broader

¹⁹ *Riley v. Broadway-Hale Stores, Inc.*, *supra*, n. 6.

²⁰ 230 F.2d 451, 109 U.S.P.Q. 53 (1956).

in certain respects but not narrower in any respect. The reissue claim was broader in scope than the protection which would have been afforded if that abandoned claim had been allowed as originally presented. While the original claim was not in fact abandoned and was amended in order to obtain its allowance, the decision is on the hypothetical footing that the claim was cancelled and that a new claim including limitations corresponding to the amendment was substituted. This action was held to be a bar to the reissue of the claim as it originally stood or any equivalent claim of broader scope. This case stands for the rule that the deliberate withdrawal or amendment of a claim in order to obtain the original patent does not involve inadvertence, accident or mistake. Additionally, since the deliberate cancellation of the claim constituted a bar to the obtaining of the same claim by reissue, it likewise constitutes a bar to the allowance of any claim which differs from that cancelled only in being broader.

In contrast to these holdings reference is made to observations made by the Honorable Giles S. Rich in a November 6, 1952, address before the New York Patent Law Association. Mr. Rich, a distinguished patent attorney, is quoted as follows:

Section 251 on reissue drops that famous old 'inadvertence, accident, or mistake,' and what it substitutes for it is very broad language. The more one thinks about it, the more it grows. It says that reissue may be had if the patent is inoperative or invalid, 'through error without any deceptive intention'—Query: Is this broad enough to cover the ill-advised, slipshod or stupid cancellation of claims from an application by an attorney? Is his act going to be binding on a subsequent attorney?

I do not see why it should not be broad enough to cover that situation, because what the section says later on is indicative of the purpose of reissue. Let me rephrase it. The purpose of the section appears to be to give the applicant what 'he had a right to claim';

and if he does not have it, by reason of error of some kind, then he should be able to get it by reissue. (New Rule 175 does not seem to include anything contrary to such an interpretation but there is a large body of precedent to be overcome.)

Realistically, unlike the present statute, Sec. 251 says that you can reissue where the defect is due to the fact that the patentee has claimed either more or less than he had a right to claim.

Now, the changes that you can make in a reissue are stated in rather involved language in the present statute, but here it merely refers to filing a 'new and amended application,' and the only restriction on it is that there shall be 'no new matter.'

Another innovation is that an assignee may apply for reissue without the inventor and swear to the application, if it is not a broadening reissue. If it is a broadening reissue, the inventor's signature is required. (New Rule 172.)

The last paragraph codifies two years as the maximum time within which to apply for a broadening reissue, and no excuses will extend that maximum because it is no longer merely a court-made rule, derived by analogy from other statutes. It is written into the law in positive form. In subsequent bills it was extended to two years. It is my recollection that what the Coordinating Committee thought it was doing at the time was to give everybody two years within which to apply for a broadening reissue. The note under Sec. 251 might tend to carry that idea out.

Classically, the acts of the attorney have been deemed to be the acts of the applicant. However, there is noted in *McCullough Tool Company v. Well Surveys, Inc.*²¹ particularly

²¹ 199 F. Supp. 374, 131 U.S.P.Q. 179 (N.D. Okla. 1961), 343 F.2d 381, 145 U.S.P.Q. 6 (10th Cir. 1965).

in the District Court opinion, a tendency to permit reissue unless the inventor has personally authorized cancellation of those claims in the original which are asserted to constitute abandoned subject matter.

The cases in which the reissue-type defects are discovered before issue of the original patent are of particular interest.

In *Ex parte Campbell*²² the reissue claim was first presented under what was then Rule 78,²³ but was neither entered nor considered on the merits. The primary examiner refused to allow it in the reissue proceedings on the ground that there could have been no inadvertence, accident or mistake in failing to obtain such a claim in the original. The Board of Appeals reversed on the ground that the applicant had, by the Rule 78 amendment, exhausted every possible remedy and had not abandoned the subject matter.

In *Ex parte Nehls*²⁴ the final fee for the original patent had been paid and the application had been assigned a patent date and number. Under these circumstances, the mere fact that the inventor discovered the reissue type "errors" before

²² 53 U.S.P.Q. 390 (Bd. Patent App. 1942).

²³ The rules of practice before the Patent Office were substantially revised after the enactment of the Patent Act of 1952. Rule 78, in effect prior to the revision, provided:

Amendments after the notice of allowance of an application will not be permitted as a matter of right, but may be made, if the specification has not been printed, on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the case from issue.

The question arises as to the reason for the failure of the original applicant in *Ex parte Campbell*, supra, n. 22, to file a continuation application. Patent Office practice erroneously did not permit continuations at the time the *Campbell* decision was rendered. See text accompanying n.28, *infra*.

²⁴ 139 U.S.P.Q. 96 (Bd. Patent App. 1963).

the patent issued would not preclude reissue because the original patentee had no opportunity to rectify the insufficiency prior to issuance of the patent.

The above cases should be compared with *Ex parte Zihel*²⁵ in which the defect was discovered before payment of the final fee. The applicant filed a petition under Rule 317²⁶ for delayed payment of the final fee and accompanied it with an amendment. Entry of the amendment was refused but the petition for the delayed payment of the final fee was accepted and the original patent issued. The Board of Appeals refused to grant a reissue on the ground that the patentee should, at the time of the petition, have requested suspension of issue of the patent under Rule 314²⁷ and filed a continuation patent application to include the claims presented thereafter in the

²⁵ 116 U.S.P.Q. 162 (Bd. Patent App. 1957).

²⁶ At that time Rule 317 read as follows:

Delayed payment of final fee. The Commissioner of Patents may, in his discretion, receive the final fee if paid within one year after the six months' period for payment has passed and the patent shall issue as specified in rule 314. Each petition for the delayed payment of the final fee shall be accompanied by the final fee and the petition fee, and a verified statement in support of the petition.

²⁷ At that time Rule 314 read as follows:

Issuance of Patent. Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the date on which the application was allowed and the notice of allowance sent; and if the final fee be not paid within that period, the patent shall be withheld. In the absence of request to suspend issue of the patent up to three months, the patent will issue in regular course in about one month. The issue closes weekly on Thursday, and the patents ordinarily bear date as of the fourth Tuesday thereafter.

reissue application. The patentee accepted the original patent without "erring."

The composite doctrine of this group of cases is that an original patentee who discovers the "error" before the patent issues is bound to exhaust every remedy open to him at the time the "error" is discovered in order to prevent issuance of an original patent containing the error.

The case of *Hazeltine Research, Inc. v. Avco Manufacturing Corporation*²⁸ initiated a strong trend in favor of re-

²⁸ 126 F. Supp. 595, 103 U.S.P.Q. 120 (N.D. Ill. 1954), *aff'd*, 227 F.2d 137, 107 U.S.P.Q. 187 (7th Cir. 1955), *cert. denied*, 350 U.S. 987 (1956).

Finding No. 6 in the opinion of the trial court applies the wording of the 1952 statute to the conduct of the patentee in 1940:

After the issuance of aforesaid original Patent 2,227,815 it was called to Toulon's attention that in several respects the patent was "through error and without any deceptive intention, deemed * * * partly inoperative * * * by reason of a defective specification" and "by reason of the patentee claiming * * * less than he had a right to claim in the patent". Therefore, he authorized the filing of an application under 35 U.S.C. § 251 (35 U.S.C. § 64, 1946 ed.) to reissue his original Patent 2,227,815 to correct such defects, and such application was duly filed under Serial No. 390,212 and duly issued March 24, 1942 as Patent Re. 22,055, in suit.

126 F. Supp. at 598.

Section 1 of the Patent Act of July 19, 1952, 66 Stat. 792, codifies Title 35 of the United States Code into positive law. Section 4(a) of that Act, 66 Stat. 815, provides:

This Act shall take effect on January 1, 1953, and shall apply to all applications for patents filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted

issues and was decided under the new reissue statute, even though the original and reissue patents had issued under the

on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

Section 4(a) of the Act, 66 Stat. 815, provides:

Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction.

Section 5 of the Act, 66 Stat. 815, repeals the sections of prior statutes set out in a schedule of statutes repealed and provides: "Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal."

The Court of Appeals for the Seventh Circuit held that:

The 1952 statute, rather than the prior law, governs this case because we are here considering an unexpired patent which is covered by section 4(a) of the 1952 enactment, which provides:

"This Act shall take effect on January 1, 1953, and * * *. It shall apply to unexpired patents granted prior to such date except as otherwise provided."

See, to the same effect, *Lyon v. Bausch & Lomb Optical Co.*, 2 Cir., 1955, 224 F.2d 530 [106 U.S.P.Q. 1] and *Pacific Contact Laboratories v. Solex Laboratories*, 9 Cir., 1953, 209 F.2d 529 [100 U.S.P.Q. 12].

227 F.2d at 144 (footnotes omitted).

Avco and *Bausch & Lomb* invoked section 5 in their unsuccessful petitions for certiorari, and the question raised in the conflicting decisions was not decided on the merits by the United States Supreme Court.

Retroactive application of the 1952 patent act has been denied under section 5 in the following cases: *Texas-Miller Hat Corp. v. Switzer Bros., Inc.*, 201 F.2d 824, 825 (5th Cir. 1953); *General Motors Corp. v. Estate Stove Co.*, 203 F.2d 912, 917 (6th Cir. 1953); *Hartley Pen Co. v. Lindy Pen Co.*, 16 F.R.D. 141, 145 (S.D. Cal. 1954); *Diebold, Inc. v. Record Files, Inc.*, 114 F. Supp. 375, 376 (N.D. Ohio 1953). See also *United States v. Burr*, 159 U.S. 78 (1895).

old statute and even though the complaint was filed in 1951.

The *Hazeltine* case is of particular interest in that the "errors" were discovered at a time when the original patent application had been forfeited for non-payment of the final fee. It was stipulated that the determination of the advisability of filing a reissue application was made by the inventor's contingent assignee before the original patent issued. Avco urged, unsuccessfully, that *Hazeltine* (which was to take title upon filing of the reissue) abandoned unclaimed subject matter by failing, before the original issued, to invoke a remedy of grace for correction of defects and that the representatives of the inventor-assignor should have accompanied the petition for delayed payment of the final fee with an amendment presenting broadened claims, under Rule 78 of the then existing Rules of Practice, corresponding to Rule 312 of the current Patent Office Rules of Practice.

The contention was made at a time prior to the decision in *Ex parte Zihlerl*. It was clear at the time that had the inventor-assignor in the *Hazeltine* case invoked the Rule 78 proceeding, merely bringing the original patent to issue after discovery of defects would not have constituted an abandonment of unclaimed subject matter, under the doctrine of the *Ex parte Campbell* case.

The timetable of events in the *Hazeltine* case is worthy of attention. On November 21, 1939, the Patent Office mailed a Notice of Allowance. At that time the original patent application stood allowed with four claims, each directed to a combination including the element referred to as "sync transforming means." On May 21, 1940, the patent application became forfeited for nonpayment of the final fee. While the application was in a forfeited condition, on or about September 12, 1940, it was purchased, contingent upon reinstatement of the original patent application and application for reissue. It was stipulated in the case that the "defects" in the original patent, set forth in the application for reissue, were discov-

ered just prior to September 12, 1940. The original patent issued on January 7, 1941. It so happened that one of the Hazeltine engineers independently devised a synchronizing system which Hazeltine considered to be substantially similar to and the equivalent of that described in the original Toulon patent application. However, the allowed claims did not cover that independently devised synchronizing system, and Hazeltine concluded, several months before the original patent issued, that it would be advisable to reissue it. The original claims did not cover the Loughren device because it was a combination without the sync transforming means.

The question immediately arose as to whether the defects arose through inadvertence, accident or mistake or purposely.²⁹

²⁹ The district court made no affirmative finding that the errors arose through inadvertence, accident or mistake; it did find that the record failed to establish misrepresentation or concealment. The court's finding is quoted in note 28 *supra*.

The trial court's finding that Toulon authorized a reissue to be filed and its use of the wording of a statute which did not then exist is understood to imply that the new reissue statute is in substance and meaning the same as the old. This was the position taken by plaintiff in a brief in the trial court against the granting of a summary judgment. On appeal, however, plaintiff argued:

However, the question of "inadvertence, accident, or mistake" is no longer the criterion for testing the legality of a reissue patent. The Reissue Statute in force since 1953 . . . is more liberal in that it requires only that the defect in the original patent occur "through error and without any deceptive intention" (35 U.S.C. § 251).

In short, the court found that the record failed to establish deceptive intention, and it did not rule on whether the error had to arise by inadvertence, accident or mistake. The court of appeals also did not expressly rule on the precise question of extrinsic inadvertence, accident or mistake.

The district court made a specific finding that the "errors arose without deceptive intention."³⁰ However, neither court clearly held that the defects arose through inadvertence, accident or mistake.

³⁰ See note 28 *supra*.

The court of appeals' opinion in *Hazeltine* cites cases which would lead one to conclude not only that the record failed to show any misrepresentation or deceptive intention, but even if it had, that a defense on the ground of deceptive intention which does not appear on the face of the patent will not be heard. See *Walker Process Equip., Inc. v. Food Mach. & Chem. Corp.*, 382 U.S. 172, 147 U.S.P.Q. 404 (1965); *Precision Instrument Mfg. Co. v. Automotive Maintenance Mach. Co.*, 324 U.S. 806, 65 U.S.P.Q. 133 (1945); *Hazel-Atlas Co. v. Hartford Empire Co.*, 322 U.S. 238, 61 U.S.P.Q. 241 (1944); *Keystone Drilling Co. v. General Excavator Co.*, 290 U.S. 240, 19 U.S.P.Q. 228 (1933); *Randolph Labs., Inc. v. Specialties Dev. Corp.*, 199 F.2d 680 (3d Cir. 1952), *cert. denied*, 345 U.S. 910 (1953); *Mas v. Coca Cola Co.*, 198 F.2d 380 (4th Cir. 1952); *Mas v. Coca Cola Co.*, 163 F.2d 505 (4th Cir. 1947); *Monolith Portland Midwest Co. v. Reconstruction Finance Corp.*, 128 F. Supp. 824, 855 (S.D. Cal. 1955); *Wooldridge Mfg. Co. v. R. G. LeTourneau, Inc.*, 79 F. Supp. 908 (N.D. Cal. 1948).

Whenever it appears that the occasion for reissue was to broaden the claims to cover not only the invention of the original patent but also the invention of another, close scrutiny seems required. The finding by both the district court and the court of appeals that the invention of the Toulon reissue patent was the same invention as that of the original patent was based on substantial evidence and was a holding that the occasion for the reissue was to broaden the claims more effectively to claim the Toulon invention. It can be argued, particularly on the basis of the decision of Judge Wyzanski in *United States v Standard Elec. Time Co.*, 155 F. Supp. 949, 116 U.S.P.Q. 14 (D. Mass. 1957), that the reissue applicant has no duty to disclose the fact that an occasion for the reissue is to cover

For reasons explained in *Ex parte Zihel*,⁸¹ the decision, if any, of the purchaser not to file a continuation patent application would not then have constituted a bar to reissue. However, an interesting question, urged in the trial court but not discussed in either opinion, was presented by reason of the failure to accompany the petition for delayed payment of the final fee by an amendment adding additional claims of the type later sought by reissue. On that point it was the contention of Hazeltine that no administrative remedy of grace was available and that the purchaser had only one course of action open to it, to-wit: reissue. On the other hand, the defendant contended that a remedy of grace existed, and that

an invention of another which happens to be similar or is deemed to be the equivalent of that of the reissue applicant. The philosophy of Judge Wyzanski's decision is that an applicant should not be forced to set up what it regards in good faith as a straw man which it reasonably and in good faith believes that it can knock down. Parenthetically, however, there is much to be said for a specific amendment to the Rules of Practice of the Patent Office which would put the burden on the applicant for reissue to reveal circumstances such as this in the reissue oath so that even a question as to deceptive intention may be precluded from arising. When circumstances of this character are stated in a reissue oath, the Patent Office examiner is motivated to look with particular care into the question of whether the original manifests on its face an intention to claim the reissue subject matter, and further, since the negation of deceptive intention is one of the requisites for reissue, it should be competent for a defendant, if he has any evidence bearing on this issue, to present it. Reissue being an *ex parte* proceeding, the Rules of Practice should be amended to require the applicant to establish freedom from deceptive intention in a prophylactic manner. If all of these considerations appear in a reissue oath and are passed on by the Patent Office, then the need for them to be considered by courts would be diminished.

⁸¹ See note 25 *supra*...

by failure to invoke it, the patent owner waived the reissue equity.³²

- ³² Any reader who is interested in looking further into this point is referred to the file wrappers of the following U.S. patents:
- | | |
|---------|-----------|
| Juwylar | 2,247,768 |
| Cairns | 2,251,901 |
| Quimper | 2,247,780 |

See also Commissioner of Patents Order No. 3311.

In each of these file wrappers a petition for acceptance of delayed payment of the final fee was accompanied by an amendment containing claims which thereby became incorporated in an issued original patent.

The following Patent Office Rules of Practice were in effect in 1941:

77. Suspensions will only be granted for good and sufficient cause, and for a reasonable time specified. Only one suspension may be granted by the primary examiner; any further suspension must be approved by the Commissioner

78. Amendments after the notice of allowance of an application will not be permitted as a matter of right, but may be made, if the specification has not been printed, on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the case from issue.

175. The Commissioner of Patents may in his discretion receive the final fee if paid within one year after the six months period for payment has passed and the patent shall issue. Each petition for the delayed payment of the final fee shall be accompanied by the final fee and the petition fee, and a verified statement in support of the petition.

199. All cases not specifically defined and provided for in these rules will be decided in accordance with the merits of each case under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

In the *Hazeltine* case the court of appeals stated that the 1952 statute, "rather than" the prior law, applied to the re-issue patent in suit. While the words "rather than" imply a change, a petition for certiorari, on the ground of earlier cases requiring inadvertence, accident or mistake, was not granted. This expression "rather than" was used by the Court in the context of a holding that the invention of the reissue was the same invention as that disclosed in the original. Some light is cast on this inquiry by dicta of the same court in *Weller Manufacturing Co. v. Wen Products, Inc.*,³³ where, in sustaining a reissue patent, the court referred to the *Hazeltine* case and then said:

Furthermore, we are of the opinion that an applicant for reissue may fully describe his original invention and include in his new description and claims not only what was described before, but also what was suggested or implied in the original drawings, specifications and models. Inasmuch as the justified finding of the court was that the reissue patent included only the inherent function and

In *Hazeltine's* brief in the district court the cases involving the file wrappers mentioned above were referred to as "involving very special circumstances requiring action on petition to the Commissioner." This brings up the question whether, under such circumstances, the original applicant or purchaser was under a duty to petition the commissioner. See note 25 *supra*. It must be conceded that the "administrative remedy" on which *Avco* relied, if it existed, was not notorious and seems to have been used only in special circumstances. However, the suspension of prosecution under unusual circumstances was a well-known remedy. But the *Avco* case was decided before the *Zihert* case, and the point was not presented. These questions, with respect to the existence and non-use of an administrative remedy of grace, were not presented to the court of appeals nor specifically discussed in the district court opinion.

³³ 231 F.2d 795, 109 U.S.P.Q. 73 (7th Cir. 1956). See also *Parker & Whipple Co. v. Yale Clock Co.*, 123 U.S. 87 (1887).

mode of operation of the original patent, it follows that no new matter was introduced. The cases cited by defendants in this connection, we think, are inapposite on their facts.⁸⁴

These dicta would seem to imply a change when the language is compared to that of the Supreme Court in *United States Industrial Chemicals, Inc. v. Carbide and Carbon Chemical Corp.*:⁸⁵

And it is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification. It must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original.

Each of the claims of the original Toulon patent was directed to a combination including the sync transforming means and during the prosecution, the applicant's attorney cancelled a claim which did not include it. None of these claims was of the same scope as those newly added by reissue. The *Hazeltine* case must be viewed on the footing that, as far as the prior art was concerned, the newly added reissue claims defined patentable subject matter. The decision is believed to show a tendency in the direction of holding that, if the claims of the original patent do not adequately cover the original, that alone is a reissue type error, particularly when the surrounding circumstances indicate a probability of error. This view is derived from statements of the Court of Appeals for the Seventh Circuit that:

In accepting the original patent with only the four claims allowed, Toulon's attorney, Albert R. Hodges, erred. There is no evidence indicating that either Toulson or Hodges at any time had any intention to deceive. Decep-

⁸⁴ 231 F.2d at 800.

⁸⁵ 315 U.S. 668, 676 (1942).

tive intention, like fraud, is never presumed. . . . Under these circumstances, a patent was issued with claims whose breadth deviated from those to which Toulon was entitled under the invention which he disclosed. The breadth of the claims therefore, through error, was incorrectly set forth and they, therefore, failed, as stated, to cover the scope of his invention. Within that scope fell Loughren's discovery.³⁶

The decision appears to constitute a departure from decisions under the old statute which held the applicant to be bound by the judgment of his attorneys in accepting claims. Prior to the Patent Act of 1952 errors of judgment by the attorney did not constitute a basis for reissue.³⁷ It is believed that the decision in *Hazeltine* implied that an error of judgment is a reissue type error, and in that respect the decision is a precedent for *In re Wesseler*³⁸, discussed below, and accords with the view quoted above.

As will be pointed out below, the decisions are beginning

³⁶ 227 F.2d at 144-45.

³⁷ In the case of *Dobson v. Lees*, 137 U.S. 258, 265 (1890), the Court said:

Nor, in the light of these protracted proceedings in the Patent Office, *can the applicant be permitted to treat the deliberate acts of his attorney as the result of inadvertence, accident or mistake.*

(Emphasis added.)

In *General Radio Co. v. Allen B. Du Mont Laboratories, Inc.*, 129 F.2d 608, 611 (3d Cir. 1942), the court cited *Dobson* and said:

But an error of judgment, even though made by the solicitor and not by the patentee himself, is binding upon the patentee and may not be rectified by a reissue patent.

(Footnote omitted.)

³⁸ 367 F.2d 838, 151 U.S.P.Q. 339 (C.C.P.A. 1966). See note *infra* and accompanying text.

to stand for a doctrine that the mere fact of inadequate coverage of otherwise patentable subject matter is deemed to justify a reissue. The difficulty of reconciling this doctrine with the principle that unclaimed subject matter disclosed in an original patent is abandoned is obvious. Can it be that patentable but unclaimed subject matter in an original patent is always eligible for recoupment by reissue? But even the most liberal decisions have not yet declared this to be the law. As previously indicated, the precise claim which was cancelled during the original prosecution cannot be recovered by reissue. But in this fact pattern there is an objective standard to which one can adhere. As to unclaimed subject matter beyond this limited ambit, the decisions put the problem in the subjective realm. In one case the original attorney does not understand the invention and misses it in the original claims. In another case the attorney understands the invention and purposely emphasizes a specific element in order to obtain allowance. In still a third case the examiner insists that a particular element, or perhaps several elements, be included in combination claims as a condition for allowance.

The query naturally arises as to the criteria which determine, under the Patent Act of 1952, whether otherwise patentable unclaimed subject matter is ever abandoned and if so, under what circumstances. The casting of these problems into the realm of the subjective is an additional reason why all of the facts and circumstances prompting a reissue should be detailed in the reissue oath and not solely in court opinions illuminated by inter partes testimony which often shines in fullness by comparison with the usual reissue oath. It has been said that some patent proprietors, particularly prone to reissue, employ reissue oaths of striking similitude. If one argues that mere non-coverage of patentable subject matter is sufficient, this argument is consistent with adoption of a standard oath form or no oath at all and is reduced to absurdity. Every inventor intends to obtain full coverage, and instances of failing to obtain full coverage through deception are unheard of.

The decisions have, since the turn of the century, swung from rigorous criticism of many reissues as "patenteering" to present treatment with great liberality.

The trend which began with *Hazeltine* gathered momentum in a number of decisions in the Court of Customs and Patent Appeals, culminating in the *Wesseler* decision which motivated this paper.

In *In re Schmidt*³⁹ the Court of Customs and Patent Appeals interpreted Section 116 of the Patent Act of 1952 which permits misjoinder or non-joinder of an inventor to be corrected if the "error arose without any deceptive intention on his part." The court held that the "error" need not occur through inadvertence or mistake and that the section would be given too restricted a meaning if those words were implied in it.

In the earlier decision in *In re Willingham*⁴⁰ the court said:

The reissue provisions of the Patent Act of 1952, like the reissue provisions of the earlier patent statutes, are remedial in nature. They are based on fundamental principles of equity and fairness and should be applied to the facts in any given case so that justice will be done both to the patentee and to the public.

The reissue claims under consideration were broader in scope than an allowed claim in the original application, but narrower than a cancelled claim therein. This is what is referred to as "an intermediate scope" type of case.

The Court also said:

35 U.S.C. §§ 251, 252 was enacted to provide the present statutory basis for the granting of reissues. These provisions differ in significant respects from the prior reissue statute (R.S.

³⁹ 293 F.2d 274, 130 U.S.P.Q. 404 (C.C.P.A. 1961).

⁴⁰ 282 F.2d 353, 354-55, 127 U.S.P.Q. 211 (C.C.P.A. 1960).

4916, 35 U.S.C. § 64). The differences pertinent to the present issue are found in Section 251 which authorizes a reissue to correct a wholly or partially invalid or inoperative patent when due to "error without deceptive intention," and if as a result of such error the patentee has claimed less than he had a right to claim.⁴¹

*In re Byers*⁴² was distinguished on the ground that in *Byers* the amendments were deliberately and intentionally made in order to secure the reissue, and on the further ground that in *Byers* the reissue claim was broader than the cancelled claim in the original application. Except for dicta in the case, *Willingham* is not significant of a new trend.

*In re Handel*⁴³ is worth mention at this point. For some time there was a widely entertained impression that, both under the new statute and the old statute, a reissue claim would not be for the same invention if it added or subtracted an element from a combination claim in the original. At least there was a tendency to overemphasize this fact in various attacks directed to reissues. Under both statutes it has, in fact, been the law that it is error to look only to the claims of the original and reissue patents in determining whether the reissue claims are for the invention disclosed and intended to be covered by the reissue.

In *Handel* this was clearly spelled out with the admonition that the entire disclosure of the original patent should be considered in determining what the patentee intended to claim and what invention the patent discloses. The court stated that the entire purpose of the new reissue statute is

⁴¹ 282 F.2d at 355.

⁴² 230 F.2d 451, 109 U.S.P.Q. 53 (C.C.P.A. 1956).

⁴³ 312 F.2d 943, 136 U.S.P.Q. 460 (C.C.P.A. 1963).

to permit limitations to be added to claims that are too broad and to be subtracted from claims that are too narrow.

A comparison of *In re Wesseler*⁴⁴ with the *Byers* decision indicates that the Court of Customs and Patent Appeals is now taking a view which is diametrically the opposite to the one taken eleven years ago with reference to the meaning of the word "error" in the new reissue statute. In this case the court squarely held that the reissue "error" need not arise through "inadvertence, accident or mistake."

The *Wesseler* case was decided by a particularly strong bench, composed of two former practicing patent lawyers of renown, an eminent patent trial judge, sitting by assignment, and two other Court of Customs and Patent Appeals judges of mature experience.

The record shows that the original patentee presented claims which were finally rejected as vague and indefinite and on prior art. The examiner was interviewed, and new claims containing certain limitations were presented. The older claims were cancelled with the remark that the amendment after final rejection was submitted in an effort to expedite prosecution of the case and to bring it to a close. Applicant stated that he was attempting to follow completely the procedures and the suggestions presented by the primary examiner in so far as they were understood.

The reissue claims apparently eliminated one limitation—to which the Board of Appeals considered that the invention was confined—and added some new ones. The claims were not coextensive with those cancelled in the original prosecution.

⁴⁴ 367 F.2d 838, 151 U.S.P.Q. 339 (C.C.P.A. 1966). In the view of this writer the *Wesseler* case is in conflict with cases such as *Lockwood v. Langendorf United Bakeries, Inc.*, 324 F.2d 82, 139 U.S.P.Q. 220 (9th Cir. 1963). The confusion could be eliminated by an authoritative Supreme Court pronouncement on the subject.

The state of the prior art at the time was such that the reissue type claims were not rendered unpatentable by the prior art.

At this point it is appropriate to suggest that what the primary examiner should have done was to insist that the original applicant make clear that the amendment, with which he obtained allowance of the original, include a statement that its purpose was to cure the rejection of the claims as vague or indefinite, if that were the fact. If the state of the record at that time was such that the applicant's attorney did not fully understand the examiner's requirements, then any misapprehension should have been clarified on the record. Knowing the well known practice of interviewing cases after final rejection, those familiar with patent prosecution would conclude that, rather than appeal, the patentee decided to "take what the examiner would allow and run."

The action of the attorney in resting on the claims in the amendment was deemed erroneous, but the decision is on the footing that this was a deliberate matter of judgment. The court found that the reissue claims defined patentable subject matter, and were narrower in scope than the claims cancelled during the original prosecution, but were broader than the claims of the original patent. The keystone considerations were that the subject matter of the reissue claims was disclosed in the original patent, that the objects of the invention as there stated manifested an intention to claim it, that the reissue applicant had a right to claim the invention disclosed in the original, that the original claimed less than he had a right to claim, and that the limitations which caused this deficiency in claiming were included "through error."

The court did not agree with the Board that the record established that the examiner would consider allowance of the original claims only with the specific limitations involved. The decision squarely holds that the word "error" as used in

the new reissue statute can be the result of a deliberate action and need not arise from inadvertence, accident or mistake.

The decision of the Court of Customs and Patent Appeals seems to limit the rule which precludes one who deliberately adds a limitation to the claims in order to obtain the original patent from securing a reissue without the limitation to cases in which the omission of the limitation would render a claim unpatentable over the prior art, or to cases in which the record shows indisputably that the applicant expressly distinguishes the prior art on the basis of that limitation. Heretofore it has been generally considered that, when a case is allowed after final rejection as the result of an interview and amendment, subject matter without the limitations agreed upon is abandoned; in other words, that subject matter not claimed or deliberately jettisoned could not be recouped by reissue if the failure to claim or the jettisoning were caused by an error of judgment. However, the *Wessler* case may have the practical impact of permitting any subject matter disclosed in an original patent, if patentable over the prior art and not claimed, to be recouped by reissue, subject to the possible qualification that identical subject matter of an abandoned claim cannot be recouped.

The *Wessler* decision opens the gate wide to reissues and is a radical departure from the *Byers* decision. Coupled with the holding in *Chore-Time Equipment, Inc. v. Big Dutchman, Inc.*,⁴⁵ which permits a reissue patentee to invoke the attorney-client privilege as to communications between the patentee and its attorneys with respect to the basis of the reissue oath, as long as the oath does not refer to such communications, the possibilities of obtaining reissues would seem to be wide open to those who would expand patent coverage in the light of knowledge imparted to them by later art. However, in other recent decisions there are encouraging signs.

Another important case is *LaMaur, Inc. v. DeMert &*

⁴⁵ 258 F. Supp. 233, 151 U.S.P.Q. 170 (W.D. Mich. 1966).

*Dougherty, Inc.*⁴⁶ in which the court scrutinized the reissue patent there involved with the meticulous care with which reissues should be scrutinized by the Patent Office. The court accepted many of defendants' proposed findings and conclusions, deleted fifty of them, altered others and initiated some. The original patent had been involved in an interference proceeding and during the course of the interference and well prior to the termination of prosecution of the original patent, the patentee learned all of the matters which were later asserted in the reissue oath. The reissue patent retained the claims of the original and added two process claims which involved a method of hair spraying which did not require a propellant. In the reissue oath the failure to define the propellant element broadly was the "error". But an additional affidavit was submitted in support of claims, added during the reissue prosecution, which omitted the propellant. These claims were first presented more than two years after the original patent issued and the accompanying affidavit presented a new scientific theory. The Court declared the reissue patent invalid on numerous counts.

First, it was held that since the reissue claims were predicated upon the new scientific discovery they were not supported by the original reissue oath, which did not mention this discovery.

Second, since the patentee knew all of the facts alleged in the reissue oath, well prior to the issuance of the original patent, there was no inadvertence, accident or mistake. Any error involved was an error of judgment.

Third, new matter and absence of disclosure in the original were cited.

Fourth, the reissue claims were broader than the original claims and broader than the reissue claims first presented,

⁴⁶ 265 F. Supp. 961 (N.D. Ill. 1965).

and the doubly broadened subject matter was not claimed until more than two years after the original patent had issued.

In this decision the "ratchet wheel" practice was strongly discouraged. The ratchet wheel practice consists of first obtaining an original patent with knowledge of "defects"; second, presenting broadened claims in a reissue patent application with a reissue oath, and finally, presenting doubly broadened claims not supported by the reissue oath. It was never the intent of the reissue statutes to permit a patentee with foreknowledge of the "errors" to take out the original patent and then to have a second wide open opportunity in the Patent Office to obtain whatever claims he could, without support from a reissue oath. This writer has been unable to find any decision which looks into a reissue background with greater care, perceptiveness and understanding.

A very encouraging indication that the Patent Office is recognizing that the ruling of *In re Wessler* is so liberal as to call for particularly careful evaluation of the reissue patent applications now being examined is the case of *Ex parte Doll*.⁴⁷ In this case the reissue applicant presented, within the two year period of limitation, broadened claims supported by a reissue oath. After the expiration of the two years, the applicant presented certain additional claims which were "doubly broadened" and not supported by a reissue oath. The Board of Appeals affirmed the disallowance of the lastmentioned claims and said that:

It appears that the two year period in which to file for broadened reissue claims is granted for the purpose of enabling the patentee to discover particular deficiencies in the breadth of the claims as originally filed, and not as a period in which to decide whether or not he should spread a net to catch any broad subject matter which he may later decide should have been captured.

⁴⁷ 155 U.S.P.Q. 477 (Bd. Patent App. 1966).

The Patent Office referred the fourth paragraph of section 251 of title 35 to the time of presentation of the claims in controversy and not to the time of the filing of the reissue patent application. However, even in this case the Board allowed reissue claims more limited than those originally presented in the reissue, considering that the original reissue oath was adequate for that purpose.

This writer submits that even allowance such as this should be confined to matters of form and insubstantial changes of wording. The mere fact that such claims are more limited in scope does not per se demonstrate that they are supported by the reissue oath.

This case, like the *LaMaur* case, lays down the doctrine that reissue claims broader than those supported by the reissue oath must be filed within two years after the issue of the original patent.

However, as far as reissue claims supported by the reissue oath are concerned, the one year bar arising out of public sale is referred to the date of filing of the original patent application.

The new reissue statute contains a provision which says that the provisions of this title relating to applications for patent shall be applicable to applications for reissue. This immediately gives rise to the question whether Section 102, specifying the conditions for patentability in chapter 10, applies to a reissue patent or only to the original on which the reissue is based. The Court of Appeals For the Seventh Circuit, in *Crane Packing Co. v. Spitfire Tool & Machine Co.*,⁴⁸ held certain claims invalid because the device against which these claims were asserted was on public sale and in use more than one year prior to the date of application of the reissue patent. The court interpreted the above-mentioned portions of the

⁴⁸ 276 F.2d 271, 125 U.S.P.Q. 289 (7th Cir.), cert. denied, 363 U.S. 820 (1960).

reissue statute to have reference to the conditions for patentability in chapter 10 of title 35.

Shortly thereafter the same court, sitting en banc, decided *Union Asbestos & Rubber Co., v. Paltier Corporation*.⁴⁹ It reversed the previous decision and held that the references in the reissue statute to "provisions of this title relating to applications for patent" had reference to chapter 11 rather than to chapter 10. The apparent error in the earlier decision rested in the fact that to measure the reissue patent by prior art as of the date of its filing would cause the original patent to invalidate any reissue applied for more than one year thereafter. It had long been the law, prior to the new reissue statute, that reissue is measured by the prior art conditions existing at the time that the original patent application was filed. Nothing in any report of Congress suggested any intent to change the law in this respect. In the later decision the court points out that a broadened issue may be applied for within two years of the grant of the original, but the very wording of the new reissue statute would be in conflict with any holding or doctrine to the effect that an application for reissue more than one year after publication of the original patent would be invalid. The later decision points out that the Patent Office Board of Appeals refused to follow the former one. One of the concurring opinions approved the re-

⁴⁹ 298 F.2d 48, 132 U.S.P.Q. 219 (7th Cir.), *cert. denied*, 369 U.S. 865 (1962). See also *Armstrong v. Motorola, Inc.*, 374 F.2d 764, 152 U.S.P.Q. 535 (7th Cir. 1967).

It is worthy of note that the American Patent Law Association considered the *Spitfire* decision (see text accompanying note 48 *supra*) to be without foundation in law and had obtained leave to file an amicus curiae brief in support for the petition for a writ of certiorari.

In *Hartzell Indus., Inc. v. McCauley Indus. Corp.*, 304 F.2d 481, 134 U.S.P.Q. 275 (6th Cir. 1962), the Court of Appeals for the Sixth Circuit adopted the Seventh Circuit Rule.

issue but not the holding on the ground that in the *Union Asbestos* case the claims in controversy were not broadened.

In a brief prepared by the late Floyd H. Crews, a distinguished New York patent attorney, it is related that in 1880 the ratio of reissues to original patents was 3.9 percent. As a result of Supreme Court decisions adverse to reissue, the ratio dropped to 0.33 percent in 1890 and then ascended to 0.9 percent by 1940. The Supreme Court reviewed reissue patent cases in 1940, 1942, and 1945, and by 1950 the ratio had again descended to 0.3 percent. These figures prompt inquiry as to whether the number of reissues is dependent on the judicial climate or on the number of "errors without deceptive intention" bona fide made by applicants. Between 1895 and 1945 the Supreme Court occasionally accepted reissue patent cases for review. If reissues were such a matter of profound public interest from 1880 to 1945 there is reason to urge that they are of even greater public interest in this day of rapid technological development.

In conclusion, speculation is invited as to whether a body of decisional law dealing with the question whether "errors" made in original patents constitute malpractice might have any restraining influence on the filing of reissue applications. It is probable that, almost universally, reissue-type errors occur in spite of the exercise of the very best care usually applied to their cases by patent lawyers in the community. Nonetheless, this so often overlooked possibility is worthy of consideration.

It is indeed time to look at reissues again.