Design Patent ProGuide – Reissue Applications
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Quick Reference Guide

DO:

1. Do identify a specific and correctable error under § 251. The declaration must clearly articulate what rendered the patent wholly or partly inoperative or invalid. General statements are insufficient.

2. Do draft the reissue declaration after finalizing the proposed amendments. The declaration must correspond precisely to the corrections being made.

3. Do ensure the proposed correction is fully supported by the originally filed disclosure. Reissue cannot introduce new matter.

4. Do analyze whether the correction broadens the visual scope of the design. Removing shading, converting solid lines to broken lines, altering boundary relationships, or changing the article designation may constitute broadening.

5. Do file broadening reissues within two years of the original patent's issuance. The two-year period is strict and jurisdictional.

6. Do evaluate whether a supplemental declaration is sufficient or whether a new declaration is required. If the original declaration is defective or the operative error has changed, a new declaration is necessary.

7. Do ensure all amendments are made relative to the patent as originally issued. Each response must stand independently and clearly show changes.

8. Do use proper reissue marking format. Use single brackets for deletions and underline for additions in accordance with reissue practice.

9. Do confirm inventorship ownership if the declaration is signed by an assignee. The assignee must own the entire interest in the patent.

10. Do evaluate prosecution history implications before narrowing. Reissue amendments and arguments may create estoppel or disclaimer effects.

11. Do consider divisional reissue practice when restriction is imposed.
    Filing a divisional reissue may preserve the correction of non-elected embodiments.

12. Do confirm that the declared error remains operative throughout prosecution. If prosecution developments eliminate the originally identified error, update the declaration.

DON'T:

1. Don't use reissue as a vehicle for redesigning the invention. Reissue corrects errors; it does not permit strategic recharacterization beyond the original disclosure.

2. Don't rely on vague or conclusory statements in the declaration. Statements such as "the patent issued with errors" are insufficient without specificity.

3. Don't attempt to introduce new embodiments not shown in the original drawings. New matter cannot be cured by declaration.

4. Don't assume drawing changes are merely formal. Minor visual changes may materially broaden or narrow scope.

5. Don't file a broadening reissue after the two-year window has expired. Late broadening is barred regardless of intent.

6. Don't assume a supplemental declaration cures every defect. If the original declaration was jurisdictionally defective, a new declaration is required.

7. Don't promise to correct the declaration later. The application cannot proceed to allowance without a compliant declaration on file.

8. Don't ignore restriction consequences. An elected group containing only the original claim may eliminate the declared error.

9. Don't assume examiner-identified drawing defects automatically qualify as § 251 errors. Confirm that the defect renders the patent partly inoperative or invalid.

10. Don't make inconsistent amendments to the title, claim, and drawings. All components must remain internally consistent.

11. Don't overlook third-party reliance considerations. Broadening reissue can affect enforcement strategy and potential intervening rights.

12. Don't treat reissue prosecution casually. It creates a new prosecution history that may later define the scope of enforcement.

1. Introduction and Theory

A design patent reissue application is not a continuation of ordinary prosecution. It is a statutory corrective proceeding governed strictly by 35 U.S.C. § 251. The purpose of reissue is to correct an error in an issued patent that renders the patent wholly or partly inoperative or invalid.

It is not a mechanism to refine strategy, improve drafting style, modernize language, or recharacterize the invention after issuance. Reissue is corrective in nature, jurisdictional in structure, and narrow in permissible scope.

In design practice, the "claim" is inseparable from the drawings. The single claim incorporates the visual disclosure. As a result, most design reissue errors arise from the drawings themselves, from the written figure descriptions, from broken-line characterizations, from boundary relationships, or from claiming more or less of the visual design than the patentee had a right to claim. Because scope in design patents is defined visually, even subtle graphical adjustments may constitute a broadening or narrowing change. The reissue statute therefore operates in design practice with particular sensitivity.

The threshold requirement is the existence of at least one specific, correctable error. The error must have existed at the time the patent issued. It must render the patent partly inoperative or invalid. It must be identified with particularity in the declaration. And it must be capable of correction without introducing new matter. Absent a qualifying error, the USPTO lacks authority to process the application.

In practice, the most common design reissue errors fall into several categories. First, drawing errors, including inconsistent solid and broken line usage, inaccurate surface shading, omission of a boundary that was clearly present but unclaimed, or inconsistency between figures. Second, specification errors, including inaccurate broken-line feature statements, misidentified view types, incomplete transitional descriptions in GUI designs, or purely formal inconsistencies in figure descriptions. Third, claiming more or less than the patentee had a right to claim, most commonly by over-claiming features in solid lines that should have been disclaimed, or by failing to claim a patentably distinct segregable embodiment disclosed in the original drawings.

Broadening reissue in design practice requires special attention. Converting solid lines to broken lines, removing shading, deleting boundary-defining lines, or altering article designation can enlarge visual scope. Any such broadening must be pursued within two years of the original patent grant. That two-year limitation is statutory and jurisdictional. After expiration, only non-broadening corrections are permitted.

Equally important is internal consistency. The declaration, specification amendments, drawing replacements, and remarks must all identify and correct the same operative error. If prosecution developments eliminate or alter the originally stated error, for example, through restriction practice or withdrawal of embodiments, the declaration must be updated. A reissue application cannot proceed on an obsolete or inapplicable error statement.

Reissue also creates a new prosecution history. Arguments made to justify narrowing amendments may later operate as disclaimer. Broadening changes may trigger intervening rights. Formal specification corrections may influence claim interpretation. The corrective act of reissue therefore carries substantive downstream consequences.

For these reasons, design reissue practice demands disciplined analysis before filing. The practitioner must first identify the specific statutory error. Then determine whether the correction

broadens or narrows scope. Then confirm support in the original disclosure. Then ensure compliance with marking conventions, drawing replacement rules, declaration requirements, and ownership formalities. Only after that analysis should the reissue filing package be assembled. Reissue is a statutory remedy. The application must reflect that corrective purpose in both substance and form.

Practice Note on Pre-AIA and Post-AIA: Declaration Requirements in Design Reissue Applications.

The America Invents Act (AIA), signed into law on September 16, 2011, made several changes to the reissue declaration requirements under 35 U.S.C. § 251 and the implementing regulations at 37 C.F.R. §§ 1.63 and 1.175. These changes took effect on September 16, 2012. Because the AIA transition rules are keyed to the filing date of the reissue application itself, and because design patents with pre-AIA original filing dates may remain in force for years after the AIA's effective date, practitioners must understand which set of requirements applies and why. For an explanation of these changes, *see* section 5.24.

All references in this ProGuide to statutory requirements are intended to apply under the current version of 35 U.S.C. § 251 unless expressly noted otherwise.

2. Recommended Form

Because reissue is jurisdictional and corrective in nature, the safest practice is to structure the application in a disciplined and complete manner at filing. Design reissue applications frequently generate early objections not because the correction is improper, but because the filing package is incomplete, internally inconsistent, or procedurally disorganized. The recommended form below integrates both substantive correction structure and required filing components.

2.1 Overall Structural Framework

A properly prepared design reissue application should contain the following components, presented in an organized and internally consistent manner:

1. Transmittal – Reissue Application
2. Application Data Sheet (ADS)
3. Power of Attorney (if required)
4. Assignee Showing of Ownership under 37 C.F.R. § 3.73 (if applicable)
5. Reissue Oath or Declaration
6. Preliminary Amendment (including specification amendments, drawing amendments, and remarks)
7. Replacement Drawing Sheets (if applicable)

Each of these components serves a distinct function. Omission or inconsistency in any one can delay examination.

2.2 Reissue Oath or Declaration (Jurisdictional Core)

The reissue declaration is the legal foundation of the application. It must:

1. Identify the patent number and issue date;
2. State that the patent is wholly or partly inoperative or invalid;
3. Specifically identify the correctable error;
4. Confirm that no new matter is introduced.

The declaration must correspond precisely to the correction being made. It should be drafted after finalizing the proposed amendments to ensure alignment. If the declaration is signed by an assignee, a proper § 3.73 showing must accompany it.

2.3 Preliminary Amendment (Corrective Structure)

In most design reissues, the application is filed with a Preliminary Amendment containing all proposed corrections relative to the patent as originally issued. The Preliminary Amendment typically includes three parts:

(a) Amendments to the Specification

These may include:

1. Reissue introductory statement
2. Marked title correction (if required and supported)
3. Marked changes to figure descriptions
4. Conforming amendments throughout the specification
5. Identification of corrected error language

All deletions must appear in brackets. All additions must be underlined. Amendments must be shown relative to the patent as originally issued and not relative to prior amendments.

(b) Amendments to the Drawings

If drawings are corrected:

1. Entire figures must be replaced;
2. Replacement sheets must be properly labeled;
3. Shading, broken lines, and boundary definitions must remain consistent across views;
4. The change must not introduce new matter.

Because design scope is visual, even minor drawing adjustments must be evaluated for broadening implications.

(c) Remarks

Remarks should:

1. Identify the error being corrected;
2. Explain how the amendments cure the defect;
3. Clarify whether the reissue is broadening or narrowing;
4. Confirm compliance with § 251 and § 132.

Remarks should remain corrective and not attempt strategic redesign.

2.4 Drawings (Replacement Sheets)

Corrected drawings must comply fully with design drawing standards. The safest practice is:

1. Replace entire sheets rather than partial figures;
2. Confirm consistent surface shading;
3. Verify broken-line usage is uniform;
4. Ensure figure descriptions correspond exactly to the drawings.

Visual consistency is critical in design reissue practice.

2.5 Assignee Showing of Ownership (37 C.F.R. § 3.73)

If the reissue declaration is executed by an assignee:

1. A § 3.73 statement must be filed;
2. The assignee must own the entire interest in the patent;
3. Objective evidence of assignment must exist.

An incomplete ownership showing renders the declaration defective.

2.6 Transmittal – Reissue Application

The transmittal should:

1. Identify the application as a reissue;
2. Identify the patent being reissued;
3. Indicate whether the application seeks to enlarge scope;
4. Include required fees.

If broadening is sought, filing within two years of issuance must be confirmed.

2.7 Application Data Sheet (ADS)

The ADS should:

1. Identify inventors;
2. Identify assignee (if applicable);
3. Confirm domestic priority information;
4. Provide correspondence address.

Bibliographic data must match the original patent unless correction is part of the reissue.

2.8 Power of Attorney

If representation differs from the original patent, a new Power of Attorney must be filed. If representation is unchanged, confirm that the original power remains effective.

2.9 Internal Consistency Review

Before filing, confirm consistency across:

1. Title
2. Claim
3. Figure descriptions
4. Drawings
5. Declaration
6. ADS
7. Ownership statement

Design reissue applications often encounter early formal objections due to cross-document inconsistencies.

2.10 General Drafting Principles

The safest reissue format adheres to four principles:

1. Minimal correction necessary to cure the identified error.
2. No expansion beyond the original disclosure.
3. Precise marking relative to the patent as issued.
4. Complete internal consistency across all filing components.

Reissue is corrective. The form of the application should reflect that disciplined purpose.

3. Rules and Guidance for Reissue Applications

3.1 A Reissue Application Must Identify At least One Specific Error

35 U.S.C. § 251; 37 C.F.R. § 1.175(a)

A reissue application must specifically identify at least one error in the original patent that renders it wholly or partly inoperative or invalid. The error must be identified with

particularity and a general statement that the patent is partly inoperative without explaining why is insufficient. The declaration must explain what was claimed incorrectly, why that was erroneous, and how the reissue corrects it. Where no correctable error exists, the USPTO lacks authority to process the reissue application.

3.1A The Error Must Have Existed at the Time of Issuance

35 U.S.C. § 251; In re Weiler, 790 F.2d 1576 (Fed. Cir. 1986)

A reissue application may correct only an error that existed in the patent at the time it issued. Events occurring after issuance, including litigation strategy reassessments or changes in commercial embodiment preferences, do not themselves constitute correctable errors. The declaration must therefore identify a defect that was present in the patent as granted, not one that arose through subsequent developments.

3.2 The Error Must Arise from a Defective Specification or Drawing, or From Claiming More or Less Than the Patentee Had the Right to Claim

35 U.S.C. § 251; 37 C.F.R. § 1.175(a)

The statutory basis for reissue is limited to three categories of error: (1) a defective specification, (2) a defective drawing, or (3) the patentee claiming more or less than they had a right to claim. A reissue application that does not identify an error falling within one of these categories will be rejected. For design patents, common errors include defective drawings and failure to claim a patentably distinct segregable embodiment disclosed in the original drawings.

3.3 No New Matter May Be Introduced into a Reissue Application

35 U.S.C. § 251; 37 C.F.R. § 1.173(a)

A reissue application may correct errors in the original patent but may not introduce new matter. For design patents, this means that drawing corrections must be limited to fixing existing errors and may not add new visual features, structural elements, or embodiments not shown in the original patent. Any amendment to the specification, claim, or drawings that introduces subject matter not supported by the original disclosure will be rejected.

3.4 Broadening Reissues Must Be Filed Within Two Years of the Original Patent Grant

35 U.S.C. § 251(d); 37 C.F.R. § 1.173(a)

A reissue patent enlarging the scope of the claims of the original patent may not be granted unless the reissue application is filed within two years from the grant of the original patent. After this two-year period expires, applicants are limited to non-broadening corrections. A reissue application that asserts a broadening error after the two-year window will be rejected on that basis, and the declaration must be restricted to non-broadening corrections.

3.5 A Reissue Application Must Include the Entire Specification and Drawings of the Original Patent

37 C.F.R. § 1.173(a)

An application for reissue must contain the entire specification, including the claims, and all drawing views of the original patent, regardless of whether certain views are being canceled or amended. The USPTO will not transfer drawings from the original patent file to the reissue application. A clean copy of each drawing sheet must be submitted at the time of filing. Failure to submit complete drawing sheets at filing is treated as an incomplete reissue application subject to missing-parts practice rather than a substantive invalidity issue, but correction may delay examination and affect strategic timing in broadening reissues.

3.6 All Changes to the Reissue Specification and Claims Must Be Shown with Prescribed Markings

37 C.F.R. § 1.173(d)

Any changes made to the specification or claims in a reissue application must be shown using specific markings: matter to be omitted must be enclosed in brackets, and matter to be added must be underlined. These markings must appear whether the amendment is incorporated at filing or submitted by a separate amendment paper. Failure to use the required markings is a procedural defect requiring correction.

3.7 All Changes to Drawings Must Be Submitted as Replacement Sheets with Proper Labels

37 C.F.R. § 1.173(b)(3); MPEP § 1509

Amended drawing figures must be labeled "Amended," added figures must be labeled "New," and canceled figures must be surrounded by brackets and labeled "Canceled." A replacement sheet must include all figures that appeared on the original sheet, even if only one figure is changed. Existing figures may not be renumbered; new figures must receive new figure numbers that follow the highest existing figure number. All changes to drawings must be explained in detail on a separate sheet accompanying the amendment.

3.8 Canceled Drawing Views Must Be Reflected in the Specification

37 C.F.R. § 1.173(b)(3); MPEP § 1509

When a drawing view is canceled and not replaced, the corresponding figure description in the reissue specification must also be canceled. Where a drawing view is canceled and replaced by an amended view, the figure description may or may not require amendment depending on whether the description remains accurate. Failure to conform the specification to canceled drawings is a formal defect requiring correction.

3.9 Amended Drawing Views Must Be Accompanied by a Marked-Up Copy When Required by the Examiner

37 C.F.R. § 1.173(b)(3)(ii); MPEP § 1509

A marked-up copy of any amended drawing figure, including annotations indicating the specific changes made, must be provided when required by the examiner. Even when not required, submitting a marked-up copy labeled "Annotated Marked-up Drawings" is good practice and may facilitate examination. The marked-up copy must be presented in the amendment or remarks section that explains the drawing changes.

3.10 If a Drawing Change Converts Solid Lines to Broken Lines, the Specification Must Explain the Purpose of the Broken Lines

37 C.F.R. § 1.173(b)(3); MPEP § 1509

When an amended drawing view converts solid lines to broken lines, typically to indicate that certain features are being disclaimed as part of the claimed design, the reissue specification must include a statement explaining the purpose of the broken lines. This requirement ensures that the visual scope of the amended claim is clearly communicated.

3.11 A Previously Corrected Error May Not Serve as the Basis for a Subsequent Reissue

35 U.S.C. § 251; MPEP § 1457

A reissue application must be grounded in a presently operative and uncorrected error in the original patent. Once a particular error has been corrected in a prior reissue, that same error cannot serve as the statutory basis for a subsequent or divisional reissue. Each reissue application must identify a distinct and currently existing error that renders the patent wholly or partly inoperative or invalid. If errors previously identified are no longer being relied upon, the applicant must clearly identify the error upon which the reissue is presently based.

3.12 The Reissue Declaration, Claim Amendments, and Drawing Revisions Must Be Internally Consistent

35 U.S.C. § 251; 37 C.F.R. § 1.175(a)

The error described in the reissue declaration must align with the changes reflected in the specification, claims, and drawings. If the declared error does not correspond to the amendments actually made, the examiner may object that the reissue is procedurally unsound. Practitioners must ensure that the declaration, claim language, and drawing revisions all work together to describe and correct the same identified error.

3.13 A Divisional Reissue Must Identify a Distinct Error Separate from Any Error Addressed in the Parent Reissue

35 U.S.C. § 251; MPEP § 1457

In a divisional reissue filed following a restriction requirement, the declaration must identify a distinct error not already addressed in the parent reissue application. This error typically consists of the failure to claim a patentably distinct segregable embodiment that was disclosed in the original drawings but was not included in the original patent claim. The declaration should identify the specific figures disclosing the omitted embodiment.

3.14 The Reissue Application Must Disclose the Original Patent to Which It Relates, and the Original Patent Remains in Force Until the Reissue Issues

35 U.S.C. § 251; 37 C.F.R. § 1.178(a)

Filing a reissue application constitutes an offer to surrender the original patent, but the surrender does not take effect until the reissue patent issues. The original patent remains in full force and effect throughout the pendency of the reissue application. Until the reissue is granted, the patentee retains all rights under the original patent.

3.15 The Applicant Must Disclose All Prior or Concurrent Proceedings Involving the Original Patent

37 C.F.R. § 1.178(b)

In any reissue application, the applicant has a continuing duty to call to the attention of the USPTO any prior or concurrent proceedings in which the patent being reissued is or was involved. This includes interferences, trials before the Patent Trial and Appeal Board, other reissue applications, reexaminations, and litigations, along with the results of any such proceedings.

3.16 A Design Patent May Not Be Converted to a Utility Patent Via Reissue, and a Utility Patent May Not Be Converted to a Design Patent Via Reissue

35 U.S.C. § 251; MPEP § 1457

A design patent reissue application may not be used to convert the patent to a utility patent, and a utility patent reissue application may not be used to convert the patent to a design patent. In both directions, the original patent does not contain a correctable error that would justify such a conversion, and the conversion would require the introduction of new matter. Additionally, conversion would improperly affect the patent term.

3.17 The Term of a Design Patent May Not Be Extended by Reissue

35 U.S.C. § 251; MPEP § 1509; *Ex parte Lawrence*, 70 USPQ 326 (Comm'r Pat. 1946)

A reissued design patent must issue for the unexpired portion of the original patent term only. The term of a design patent may not be extended through the reissue process. Any reissue application that would have the effect of extending the original patent term must be rejected.

3.18 In Multiple Reissue Applications, Each Claim of the Original Patent Must Appear in Each Reissue Application

37 C.F.R. § 1.177(b)

If an applicant files more than one reissue application for a single patent, each claim of the patent being reissued must be presented in each reissue application as an amended, unamended, or canceled claim, bearing the same number as in the original patent. The same claim may not be presented in its original unamended form for examination in more than one of the multiple reissue applications. Each reissue application must also include a notice in the first sentence of the specification identifying all related reissue applications by relationship, application number, and filing date.

3.19 In a Reissue Design Application, All Amendments Must Be Made Relative to the Patent as Issued, Not Relative to Prior Amendments in the Reissue

37 C.F.R. § 1.173(g); MPEP § 1457

All amendments in a reissue application must be made relative to the specification and drawings as they appear in the issued patent. Amendments may not be made relative to previous amendments filed during the reissue prosecution. Each response must stand on its own relative to the original issued patent.

3.20 Patent Claims in a Reissue Application May Not Be Renumbered

37 C.F.R. § 1.173(e)

Patent claims may not be renumbered in a reissue application. Any claims added during reissue prosecution must receive numbers that follow the number of the highest numbered claim in the original patent. This rule preserves the numbering integrity of the original patent record.

3.21 When an Assignee Signs the Declaration, the Assignee Must Own the Entire Interest, Including Any Added Inventors' Shares

35 U.S.C. § 251; 37 C.F.R. § 1.172; MPEP § 1412.04

Where a reissue application seeks to add a new inventor, the assignee may only sign the reissue oath or declaration if the assignee owns the entire interest in the patent, including the interest of any newly added inventor. If the added inventor has not assigned their portion of the patent to the assignee, the assignee is only a part-owner and cannot execute the declaration on behalf of all inventors. In that situation, the declaration must be signed by all inventors

individually. A statement under 37 CFR 3.73(b) asserting ownership is insufficient without objective evidence, such as an executed assignment, demonstrating that the added inventor has actually conveyed their rights.

When an assignee executes a reissue declaration, ownership requirements differ depending on whether the reissue is broadening. Under 37 C.F.R. § 1.175(c)(1), for a non-broadening reissue, the assignee of the entire interest may execute the declaration without inventor signatures. However, when the reissue is broadening, additional statutory safeguards apply. Where inventorship is being corrected in a broadening reissue, the assignee must own the entire interest, including the interest of any newly added inventor. If the added inventor has not assigned their rights, the assignee cannot execute the declaration on behalf of all inventors. Practitioners should therefore analyze both the scope of the correction and ownership status before determining signature strategy.

3.22 The Declaration Must Identify the Specific Error with Particularity, Referencing the Specific Drawings and Drawing Features Where the Error Lies - Application of Rule 3.1 in Design Reissue Practice

35 U.S.C. § 251; 37 C.F.R. § 1.175(a); MPEP § 1414

In a design patent reissue application, a general statement that the patentee claimed more or less than they had a right to claim is insufficient. The error must be identified by reference to the specific drawings and the specific drawing features where the error lies. A vague statement, such as that "incorrect drawings were submitted" without identifying which figures were incorrect and in what respect, will be rejected. Similarly, identifying an error as occurring in certain figures "in that there is no line indicating a transition" without explaining what the transition is or what surfaces are involved is not sufficiently specific. The declaration must identify the precise figures and features at issue.

3.23 A Supplemental Declaration Must Be Filed Before Allowance to Cover Any Errors Not Addressed in the Original Declaration, Including Errors Introduced by Subsequent Amendments

37 C.F.R. § 1.175(b)(1); MPEP § 1414.01

Where amendments are made to the drawings or specification after the original declaration was executed, the applicant must file a supplemental reissue oath or declaration before allowance, covering any errors corrected by those subsequent amendments that are not already addressed in the original declaration. This supplemental declaration must be received before the application can be allowed.

3.24 A Declaration That References an Attached Specification, Which Was Never Actually Attached, Is Defective

37 C.F.R. § 1.175; 37 C.F.R. § 1.63

A reissue declaration that purports to identify the application it is executing by reference to an attached specification, but where no specification was attached, is defective because it fails to adequately identify the application being executed. The declaration must sufficiently identify

the reissue application to which it relates, and a reference to a nonexistent attachment does not satisfy this requirement.

3.25 A Declaration Is Defective If It Omits Required Recitations (Pre-AIA)

37 C.F.R. § 1.175; 37 C.F.R. § 1.63; MPEP § 1414

The reissue declaration must comply with all requirements of 37 C.F.R. § 1.63 in addition to the reissue-specific requirements of 37 C.F.R. § 1.175. Defects that have appeared in examined applications include: (1) failure to state that the person making the declaration believes the named inventor to be the original and first inventor of the subject matter claimed (pre-AIA requirement); (2) failure to state that the declarant has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the declaration; and (3) failure to identify the citizenship of each inventor (Pre-AIA). Any of these omissions renders the declaration defective and will support a rejection under 35 U.S.C. § 251.

3.26 When the Declared Error Is No Longer Being Relied Upon, Because of Prosecution Changes Such as a Restriction or Division, the Declaration Must Be Updated to Identify a New Error

35 U.S.C. § 251; 37 C.F.R. § 1.175(d); MPEP § 1414

Where prosecution changes, such as a restriction requirement, a divisional filing, or the withdrawal of a claimed embodiment, render the originally declared error inapplicable to the current application, the declaration becomes defective. The applicant must file a new or supplemental declaration identifying at least one error that is being relied upon in the current application. This arises most commonly in divisional reissues where the original declaration referenced an embodiment that was constructively non-elected and is no longer under examination in the divisional. The supplemental declaration need not affirmatively state that the prior error is no longer being relied upon, but it must identify the error now forming the basis for reissue.

3.27 Where the Elected Group Contains Only the Original Unamended Embodiment, There Is No "Error" in That Claim and a Rejection Under 35 U.S.C. § 251 Will Issue, the Proper Response Is to File a Divisional and Request Suspension

35 U.S.C. § 251; MPEP § 1457, III

Following a restriction requirement in a reissue application, if the constructively elected group contains only the original unamended patent claim, with no correction being made to it, there is no error in that claim upon which a reissue can be based, and a rejection under 35 U.S.C. § 251 will issue. The proper response is not to argue against the rejection on the merits, but rather to: (A) request suspension of action in the original reissue application pending examination of a divisional, (B) file the divisional reissue application or confirm that one has been filed, and (C) argue that a complete response has been made on that basis. The application will then be suspended pending resolution of the divisional.

3.28 A Declaration May Not Be Amended by Supplement When the Original Declaration Is Fatally Defective, a Completely New Declaration Is Required

37 C.F.R. § 1.175; MPEP §§ 602.01, 602.02

The wording of a reissue oath or declaration cannot be corrected through a supplemental filing when the original declaration is fundamentally defective, for example, when it omits required affirmations entirely. In such cases, a completely new declaration is required, not a supplement. The new declaration must properly identify the application of which it forms a part, preferably by application number and filing date in the body of the declaration. A supplement is only appropriate where the original declaration was facially proper but did not cover subsequent amendments or additional errors; it is not a mechanism to supply missing statutory affirmations that were never made.

3.29 The Duty-to-Disclose Language in the Declaration Must Track the Exact Regulatory Formulation, Substituting Non-Standard Phrases Renders the Declaration Defective

37 C.F.R. § 1.63; 37 C.F.R. § 1.175; MPEP §§ 602.01, 602.02

The reissue declaration must use the precise regulatory language when stating the duty to disclose information material to patentability. Substituting non-standard phrases, such as "material to examination" in place of "material to patentability," or citing "37 C.F.R. § 1.56(a)" instead of "37 C.F.R. § 1.56," renders the declaration defective, because the substituted language either has no meaning in the context of the rule or references a provision that does not define the concept invoked. Where such non-conforming language appears, the USPTO will require a new declaration rather than a supplement, since the original affirmation was not properly made.

3.30 When a Declared Error Is Grounded in a Change That Itself Constitutes New Matter, the Error Cannot Support the Reissue

35 U.S.C. § 251; 35 U.S.C. § 112; MPEP § 1414

A reissue declaration that identifies as its basis an error that cannot be corrected without introducing new matter is fatally defective. Where the proposed correction, such as a change to the title or the addition of a term not present in the original specification, fails the written description requirement of 35 U.S.C. § 112, the stated error is invalid as a basis for reissue. The declaration must identify an error that can be corrected within the bounds of the original disclosure. In such cases, a supplemental declaration will not suffice; a new declaration identifying a permissible error is required.

3.31 In a Divisional Reissue, the Declaration May Be Satisfied by the Declaration Accepted in the Parent Reissue, But Only If It Identifies an Error Still Being Relied Upon in the Divisional

37 C.F.R. § 1.175(f); MPEP § 1414

In a divisional reissue application, the applicant may rely on the declaration that was accepted in the parent reissue application to satisfy the declaration requirement, provided that the error identified in that declaration is still being relied upon as the basis for reissue in the divisional. If prosecution changes, such as the divisional being directed to a different embodiment than the one identified in the parent's declaration, mean the previously identified error is no longer

applicable, a supplemental declaration identifying the operative error is required. Where the prior declaration was otherwise proper, the examiner may permit deferral of the supplemental declaration until the application is otherwise in condition for allowance.

3.32 The Declaration Must Identify a Specific Feature or Area of the Claimed Design That Was Wrongly Depicted, A General Statement That "Some Features Are Not Essential" Is Insufficient

35 U.S.C. § 251; 37 C.F.R. § 1.175(a)(1); MPEP § 1414

In a design patent reissue, it is not sufficient for the declaration to state in general terms that "at least some features are not an essential part of the claimed design" or that the applicant "claimed more than they had a right to claim." The declaration must identify at least one specific element, feature, or area of the design that was originally claimed, whether by depiction in solid lines, that the applicant believes should not have been claimed, or conversely, what specific area was under included. The declaration cannot delegate this identification to the drawings; the error must be stated in the declaration itself. An examiner has suggested the following as an example of acceptable language: "The original drawings claimed more of the baskets than the Patentee considers the design. Specifically, the Patent claims two baskets in full lines whereas the applicant believes that he has the right to claim just one basket. The lower basket was claimed in error and is therefore removed from the claim by this reissue."

3.33 When the Examiner Identifies a New Correctable Error During Prosecution, Such as Improper Surface Shading, the Declaration Must Be Updated to Reflect That Error as the Basis for Reissue

35 U.S.C. § 251; 37 C.F.R. § 1.175(a)(1); MPEP § 1414

Where an examiner identifies an error in the original patent drawings during prosecution, such as surface shading that does not accurately represent the contours of the design, and the previously declared error has become moot (for example, due to restriction and withdrawal of an added embodiment), the applicant must file a new or amended declaration identifying the examiner-identified drawing error as the basis for reissue. The examiner may suggest specific language for this purpose. A supplemental declaration will generally not suffice in this situation if the original declared error is entirely inapplicable; a new declaration is required.

3.34 Inaccurate Shading in the Original Patent Drawings Can Constitute a Correctable Error Supporting a Reissue, Even If the Error Does Not Rise to the Level of a Rejection Under 35 U.S.C. § 112

35 U.S.C. § 251; MPEP § 1414

Surface shading that does not correctly represent the contours of a design, for example, curved shade lines used in an elevation or plan view that imply an incorrect direction of surface contour, can constitute a correctable error sufficient to support the filing of a reissue under 35 U.S.C. § 251. The examiner need not find the error sufficiently serious to reject the claim under 35 U.S.C. § 112; it is sufficient that the inaccuracy could result in a misunderstanding of the article's appearance. Where such an error exists, it provides an independent basis for reissue that may be used to replace a previously declared error that has become moot.

3.35 A Promise to File a Proper Declaration Is Not a Substitute for Filing One, the Rejection Cannot Be Withdrawn Until an Acceptable Declaration Is Actually Submitted

35 U.S.C. § 251; 37 C.F.R. § 1.175

Where a reissue declaration is rejected as defective, the rejection cannot be withdrawn based on an applicant's representation that a properly executed declaration will be filed in the future. A proper declaration is an essential element of a reissue application, and failure to provide one is grounds for rejection that must be maintained until an acceptable declaration has been submitted. An applicant who requests that the examiner hold a declaration rejection in abeyance pending notification of allowable subject matter may do so, but the rejection remains live until the declaration is filed.

3.36 Double Brackets Are Improper in a Reissue Specification, Single Brackets Must Be Used for Matter Being Omitted

37 C.F.R. § 1.173(d); MPEP § 1453

In a reissue application, matter to be omitted must be enclosed in single brackets. Double brackets are reserved for identifying changes that were made in a prior reissue and are not appropriate in a new reissue application. A clean copy of the specification without markings must not be included with the response; only the marked-up copy with proper bracket and underline notations should be filed.

3.37 A Broadening Reissue Filed as a Divisional of a Parent Reissue That Was Itself Filed Within Two Years May Contain Broadened Claims Even If the Divisional Is Filed After the Two-Year Period

35 U.S.C. § 251(d); MPEP § 1412.03(IV)

Where a parent reissue application containing a broadened claim was filed within the two-year statutory period from the grant of the original patent, a divisional reissue application directed to a constructively non-elected embodiment may present broadened claims even if the divisional is filed after the two-year period has expired. Where the parent reissue application was timely filed within two years and clearly expressed an intent to broaden, MPEP § 1412.03(IV) provides that a divisional reissue directed to constructively non-elected subject matter may include broadened claims even if filed after the two-year period. Practitioners should treat this as examination practice rather than settled appellate doctrine. Applicants relying on this principle should identify the parent filing date and its relationship to the two-year window in their response to any broadening rejection in the divisional.

This principle is not without limitation. The broadened claim pursued in the divisional reissue must be directed to subject matter disclosed in and supported by the original patent and must correspond to the broadening intent properly established in the timely filed parent reissue application. The divisional may not introduce a new broadening theory unrelated to the error identified in the parent. The "intent to broaden" is essentially a notice requirement. By filing the parent within two years, the applicant puts the public on notice that the scope of the patent is in

flux. A divisional that strays too far from the nature of that original notice may be rejected for failing to meet the statutory deadline.

Practice Note on Rule 3.37

Practitioners relying on the principle that a divisional reissue may present broadened claims after the two-year period, based on a timely filed parent, should be aware that this principle, while supported by MPEP § 1412.03(IV), has not been extensively tested in Federal Circuit litigation in the specific context of design patent reissue. The MPEP guidance is drawn from utility reissue precedent, and its application to design patents has been accepted in USPTO examination practice. However, no published Federal Circuit decision has squarely addressed the limits of this principle as applied to a divisional design reissue where the broadened claim in the divisional differs materially from the broadening pursued in the parent.

This does not mean the principle is unsound. It means that practitioners should exercise caution when extending the principle to factual scenarios not directly addressed in the MPEP. In particular, where the broadened claim in the divisional involves a substantially different broadening theory than the one presented in the parent, or where the broadened scope in the divisional is directed to design features not addressed in the parent's broadening amendments, the practitioner should evaluate whether the divisional's broadening can be fairly traced to the intent to broaden established in the timely parent. If the connection is attenuated, the practitioner should consider whether an independent broadening analysis and alternative filing strategy is warranted.

Where possible, the practitioner should affirmatively establish in the parent reissue application that the intent to broaden encompasses the specific subject matter that will later be pursued in the divisional. This can be accomplished by including the broadened embodiment in the parent filing, even though restriction will require its withdrawal. The record of having presented the broadened embodiment in a timely filed parent strengthens the argument that the divisional's broadened claim falls within the statutory window.

3.38 Correction of Inventorship Is a Permissible Basis for Reissue Under 35 U.S.C. § 251 Where Correction Under 35 U.S.C. § 256 Is Unavailable

35 U.S.C. § 251; 35 U.S.C. § 256; MPEP § 1412.04

Correction of inventorship may serve as a valid basis for filing a reissue application under 35 U.S.C. § 251 where the applicant is unable to satisfy the requirements for correction under 35 U.S.C. § 256. While some examiners have initially rejected such reissues on the grounds that inventorship correction is "not an eligible error," this position is incorrect. Reissue for correction of misjoinder or nonjoinder of inventors is recognized under MPEP § 1412.04 and case law including Ex parte Scudder. Where this basis is raised by an applicant and supported by the record, the examiner should withdraw the § 251 rejection.

3.39 Formal Errors in the Specification, Such as Grammatical Inconsistencies or Inaccurate Descriptions of Broken Line Showings, Can Constitute a Sufficient Basis for Reissue

35 U.S.C. § 251; MPEP § 1414

Formal errors in the specification of a design patent can provide a valid basis for reissue even when no error exists in the drawings themselves. Examples of sufficient formal errors identified in prosecution include inconsistent punctuation in figure descriptions (such as a semicolon used in one description where periods are used in all others) and an inaccurate description of broken lines as showing "environmental features" when the broken line elements are portions of the article itself rather than environmental structure. Where such errors exist, they can support the filing of a reissue and may be used to replace a previously declared error that has become moot following restriction.

3.40 An Inaccurate or Ambiguous Figure Description in the Specification, Such as Mislabeling a View Type, Can Constitute a Correctable Error Supporting Reissue

35 U.S.C. § 251; MPEP § 1414

Where a figure description in the specification inaccurately or ambiguously identifies the type of view depicted, for example, describing a view as a "perspective" view when it is more accurately an "isometric" view, or describing a view as an "upper perspective" view without clearly identifying the point of orientation, this constitutes a correctable error sufficient to support the filing of a reissue. The error need not rise to the level of a § 112 rejection to be a valid basis for reissue; it is sufficient that the inaccuracy could result in a misunderstanding of the claimed appearance. This type of error has been recognized by examiners as a permissible substitute basis for reissue when the originally declared error becomes moot.

3.41 The Declaration Must Identify the Error with Enough Specificity That the Nature of the Defect Is Clear, identifying a General Area Without Describing How It Rendered the Claim Too Narrow or Too Broad Is Insufficient

35 U.S.C. § 251; 37 C.F.R. § 1.175(a)(1); MPEP § 1414

A declaration that identifies a general area or component by name, such as stating that "Figure 3 is inconsistent with Figures 1 and 2," without explaining how that inconsistency renders the original patent inoperative or invalid is not sufficient. The declaration must identify the specific nature of the defect. For example, it should explain that the head in Figure 3 is shown more elongated and out of proportion relative to the head in Figures 1 and 2, such that the issued drawings failed to consistently and accurately depict the same claimed design across views. Similarly, a declaration stating that certain features were "not an essential part of the claimed design" without identifying which specific feature was wrongly claimed, and how that feature made the claim too narrow or too broad, does not satisfy the specificity requirement.

3.42 Where the Declaration Identifies the Basis for Reissue as a Defective Drawing, the Applicant Must Check the Corresponding Box on the Declaration Form and Describe the Drawing Defects

35 U.S.C. § 251; 37 C.F.R. § 1.175(a); MPEP § 1414

When the basis for reissue is a defective drawing rather than the patentee claiming more or less than they had the right to claim, the declaration form must reflect this correctly. The applicant must check the box labeled "by reason of a defective specification or drawing" and then specifically describe the drawing defects in the body of the declaration. Submitting a declaration

that checks the wrong basis, or that identifies a broadening error when the actual correction being made is a drawing correction, creates an internal inconsistency that renders the declaration defective.

3.43 Where Non-Elected Embodiments Remain in the Drawing Disclosure After a Restriction and Election, They Must Be Canceled, Stating That an Election Has Been Made Is Insufficient If the Disclosure Is Not Amended Accordingly

37 C.F.R. § 1.176(b); MPEP § 1450

Following a restriction requirement and an applicant's election of a group or embodiment, all drawings and specification descriptions corresponding to non-elected embodiments must be canceled or otherwise removed from examination before allowance, and the specification must be conformed accordingly. A response that states an election has been made but does not cancel the non-elected figures and their corresponding descriptions is procedurally deficient. The non-elected embodiments must be withdrawn from the disclosure, and the specification must be conformed to reflect only the elected subject matter, before the application can advance.

3.44 A Single Opening Bracket Without a Closing Bracket in the Specification Creates an Improper Indication That an Entire Description Has Been Canceled

37 C.F.R. § 1.173(d); MPEP § 1453

When amending the specification in a reissue application, a single opening bracket that is not paired with a corresponding closing bracket improperly signals that everything following it has been deleted. This is a formal defect that must be corrected. Applicants must take care to ensure that brackets are properly paired and that only the matter intended to be omitted is enclosed within them.

3.45 A Reissue Declaration Cannot Be Amended by Bracketing the Original Error Statement and Submitting a Revised Statement on a Separate Sheet, a Completely New Executed Declaration Is Required

35 U.S.C. § 251; 37 C.F.R. § 1.175; MPEP § 1414

There is no provision in reissue practice for amending the error statement in a declaration by bracketing the original language and underlining revised language on a separate sheet, as one would amend specification text. The USPTO does not know how to treat such a submission and will likely treat the underlined revised language as an addition to the specification rather than as an amendment to the declaration. The original declaration, with its defective error statement, remains in force. To correct a defective error statement, the applicant must file a completely new, properly executed declaration containing the corrected language. The revised language itself may be acceptable, but it must appear in a freshly executed declaration rather than in a marked-up amendment to the original.

3.46 Describing Broken Lines as Showing "Illustrative Purposes Only" or "Environmental Structure" When the Lines Actually Depict Portions of the Article Is an Error in the Specification Sufficient to Support a Reissue

35 U.S.C. § 251; MPEP § 1414; MPEP § 1503.02

In design patent practice, broken lines must be accurately described in the specification. Describing broken lines as being shown for "illustrative purposes only" has no clear meaning in the context of design patents and does not properly describe the purpose of broken lines as required by MPEP § 1503.02. Similarly, describing broken line elements as "environmental structure" when those elements are portions of the article itself, rather than the surrounding environment, is an inaccurate representation in the specification. Either of these errors constitutes a correctable defect in the specification sufficient to support the filing of a reissue, and either can serve as a substitute basis for reissue when the original declared error has become moot following restriction.

3.47 Inconsistencies in the Broken Line Showing Between Figures, Where the Same Feature Is Shown in Solid Lines in Some Views and Broken Lines in Others, constitute a Correctable Drawing Error Supporting Reissue

35 U.S.C. § 251; MPEP § 1414

Where the drawings of an original patent depict the same feature inconsistently across figures, for example, showing a surface bounded by solid lines in some views but broken lines in others, this constitutes a correctable error in the drawings sufficient to support the filing of a reissue. The declaration should identify the specific figures in which the inconsistency appears and explain that the affected figures were corrected to match the consistent depiction shown in the other views. This type of error provides an independent basis for reissue that may be used when a previously declared error has become moot.

3.48 An Inadequate Feature Statement That Fails to Describe a Transitional or Sequential Attribute of the Design Can Constitute a Correctable Specification Error Supporting Reissue

35 U.S.C. § 251; MPEP § 1414

Where a feature statement in the specification fails to adequately describe a material attribute of the claimed design, such as the sequential order of images in a graphical user interface design, this constitutes a correctable error in the specification sufficient to support a reissue. The declaration should explain that the original specification failed to identify the sequential relationship between the depicted images and that the reissue corrects this inadequacy. Like other specification errors, this can serve as a substitute basis for reissue when the original declared error has become moot.

3.49 A Declaration That Identifies an Inapplicable Broadening Error Without Omitting It, Even When a Valid Alternative Error Is Also Stated, Remains Defective

35 U.S.C. § 251; 37 C.F.R. § 1.175(d); MPEP § 1414

Where prosecution has rendered a broadening error inapplicable, for example, because the broadened embodiment has been constructively non-elected and withdrawn from consideration, a declaration that continues to assert that broadening error alongside a valid alternative error remains defective. The inapplicable error must be removed from the declaration, not merely supplemented by the addition of a valid error. A new declaration should identify only the error or errors that are

being relied upon in the current state of the application, without carrying forward error statements that are no longer applicable. *See* Rule 3.26 regarding continuity of operative error.

3.50 When the Original Unamended Embodiment Is Canceled and Only the New Embodiment Remains, the Error Basis Must Be Reframed to Reflect the Design Actually Being Claimed

35 U.S.C. § 251; 37 C.F.R. § 1.175(d); MPEP § 1414

Where the original unamended embodiment is canceled from the reissue application, for example, because the applicant elects to prosecute only the newly added embodiment, the declared error can no longer be framed as a failure to include an additional embodiment alongside the original. Rather, the error must be reframed to accurately describe what is being corrected in the embodiment that remains. In such cases, the declaration should state that the reissue seeks to broaden the claim of the original patent by excluding specific features from the scope of protection, identifying the particular features being moved to broken line form and explaining how the original claim was thereby unduly narrow.

3.51 A Failure to Perfect a Priority Claim, Such as Failing to Make Specific Reference to a Prior Application on the Application Data Sheet, constitutes a Correctable Error Supporting Reissue

35 U.S.C. § 251; 37 C.F.R. § 1.175(a)(1); MPEP § 1414

Where a priority claim was intended but not properly perfected, for example, because the applicant failed to make specific reference to the prior application serial number on the Application Data Sheet at the time of filing, this constitutes a correctable error sufficient to support the filing of a reissue. The declaration must identify the error with specificity, stating not merely that the priority claim was not printed on the face of the patent, but rather identifying the precise procedural failure: that the applicant failed to make specific reference to the prior application on the ADS. A vague statement that priority was "inadvertently omitted" without identifying the specific filing deficiency is insufficient.

3.52 The Declaration Cannot Refer to Adding "Additional Claims," A Design Patent May Have Only One Claim, and the Correct Framing Is the Addition of a New Embodiment

35 U.S.C. § 251; 37 C.F.R. § 1.153; MPEP § 1414

A reissue declaration for a design patent that frames a broadening error as seeking to add "additional claims" is defective because a design patent may only contain a single claim. The correct framing is that the patentee seeks to add a previously disclosed but canceled embodiment, or to broaden the claim to include a variant of the patented design such as a colored or lighting rendition. The declaration must also specifically identify the error in the drawings and explain how the addition of the new embodiment broadens the scope of the existing claim. The declaration must use terminology consistent with the single claim structure of design patents and may not suggest that multiple claims are being pursued.

3.53 The Absence of Any Feature Statement Describing the Purpose of Broken Lines in a Newly Added Figure Constitutes a Correctable Specification Error Supporting Reissue

35 U.S.C. § 251; MPEP § 1414; MPEP § 1503.02

Where a reissue application includes a figure that contains broken lines, but the specification lacks any feature statement explaining the purpose of those broken lines, this omission constitutes a correctable error in the specification sufficient to support the filing of a reissue. The declaration should identify the specific figure in which the broken line showing lacks an accompanying description and state that the reissue is filed to correct this omission by adding the required feature statement.

3.54 Where the Declaration References a General Error Such as Failing to Claim a Distinct Segregable Part Without Identifying the Specific Drawing Feature Involved, the Declaration Is Defective

35 U.S.C. § 251; 37 C.F.R. § 1.175(a)(1); MPEP § 1414(II)(C)

A declaration that states in general terms that the applicant failed to claim a patentably distinct segregable part, without identifying the specific drawing feature or element that was the subject of the error, does not satisfy the specificity requirement. Because in design patents the drawings and the claim are inseparable, identifying a specific error in the claim requires identifying a specific error in the drawings. The declaration must identify the particular element, for example, that the issued patent incorrectly depicted two control knobs and identified them as a set, when the applicant had the right to claim a single control knob, so that the error is described with the particularity required by MPEP § 1414(II)(C).

3.55 When Canceled Original Figures Are Replaced by New Figures, the Canceled Figures Must Each Be Individually Enclosed in Brackets with the Word "Canceled" Adjacent to the Figure Legend, and the New Figures Must Each Bear the Word "New" Adjacent to Their Figure Legends

37 C.F.R. § 1.173(b)(3); MPEP § 1509

Where all original figures are being canceled and replaced by a new set of figures, each canceled figure must be individually enclosed in brackets with the word "Canceled" appearing next to its figure legend, it is not sufficient to cancel figures collectively or by reference. Similarly, each newly added figure must have the word "New" placed adjacent to its figure legend. The label must appear in the vicinity of each individual figure legend, and the font size should be the same as or greater than the size used for the figure legends themselves. Failure to individually label each figure in this manner is a drawing defect requiring correction.

3.56 A Broadening Error Statement Must Clearly Delineate What Specific Feature or Area Was Under Included, A General Statement That the Applicant Seeks to Broaden the Claim Is Insufficient

35 U.S.C. § 251; 37 C.F.R. § 1.175(a)(1); MPEP § 1414

For broadening reissues, it is not sufficient for the declaration to state simply that the applicant seeks to broaden the claim or that features were claimed that are not essential to the design. The declaration must clearly identify the specific feature or area that was originally claimed in solid lines and is now believed to unduly limit the scope of the claim and must explain how removing or converting that feature to broken lines broadens the claim. A statement that merely identifies the general category of the change without identifying the specific element involved does not satisfy the specificity requirement.

3.57 Inconsistencies Between Figures, Where the Same Feature Appears Differently Across Views, constitute a Correctable Drawing Error Supporting Reissue

35 U.S.C. § 251; MPEP § 1414

Where figures in an issued patent are inconsistent with one another in a material respect, for example, where certain views omit a feature that is clearly present in other views of the same design, this inconsistency constitutes a correctable drawing error sufficient to support the filing of a reissue. The declaration should identify the specific figures containing the error, describe what the erroneous figures show versus what they should show, and state that the reissue corrects the inconsistency by replacing the affected figures with corrected versions consistent with the other views. An examiner may suggest specific language for this purpose, and the applicant may adopt that language in a revised declaration.

3.58 An Unclaimed Boundary Line Added in a Reissue Drawing Must Make Explicit a Boundary That Already Existed but Was Unclaimed in the Original Disclosure, It Cannot Define a New Boundary Not Present in the Original

35 U.S.C. § 251; 35 U.S.C. § 112(a); *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013)

Where a reissue application adds a boundary line to divide a previously claimed area into claimed and unclaimed portions, that boundary line must make explicit a boundary that already existed in the original disclosure but was simply not claimed. A boundary line that defines a new demarcation not recognizable from the original drawings introduces new matter and fails the written description requirement. Per In re Owens, unclaimed boundary lines are permissible in reissue only when they reflect a boundary that a designer of ordinary skill in the art would have recognized as present in the original disclosure at the time it was filed.

3.59 A Divisional Reissue Application Requires a New Assignee Consent, A Copy of the Consent Filed in the Parent Reissue Is Generally Not Sufficient

35 U.S.C. § 251; 37 C.F.R. § 1.172; MPEP § 1451

Where a divisional reissue application is filed, a new written consent from all assignees is required. A copy of the assignee consent filed in the parent reissue application is generally not acceptable for the divisional, because the parent consent does not demonstrate that the assignee has consented to the addition of the new error being corrected in the divisional application. Where a continuation reissue is filed and the parent will be abandoned, a copy of the parent's consent may be accepted. But for a divisional, regardless of whether the parent will be abandoned, a new consent is required, and the reissue oath or declaration remains defective until that consent is filed.

3.60 Merely Describing a General Change in Solid and Broken Line Presentation Without Identifying the Specific Feature Involved Does Not Satisfy the Error Specificity Requirement

35 U.S.C. § 251; 37 C.F.R. § 1.175(a)(1); MPEP § 1414(II)(C)

A declaration stating that "the patent identifies some features in solid lines and some features in broken lines whereas the reissue application presents a claim illustrating a different combination of solid and broken lines" satisfies only the basic threshold of MPEP § 1414(II)(A), that a change or departure from the original specification represents an error, but does not satisfy the more specific requirement of MPEP § 1414(II)(C). That provision requires the declaration to specifically identify the error, not merely describe the general nature of the change. The declaration must identify the particular feature or features that were originally claimed in solid lines and are now believed to unduly limit the claim, naming the specific element rather than describing the change in general terms.

3.61 It Is Not Sufficient to Reproduce the Drawings with Brackets and Underlining and State That Such Will Identify the Error, The Error Must Be Stated in the Text of the Declaration

35 U.S.C. § 251; 37 C.F.R. § 1.175(a)(1); MPEP § 1414(II)(C); *In re Constant*, 827 F.2d 728 (Fed. Cir. 1987)

Pursuant to *In re Constant*, it is not sufficient for an applicant to attempt to satisfy the error identification requirement by reproducing the claim or drawings with bracketed and underlined markings and asserting that these markings themselves identify the error. The error must be stated in words in the body of the declaration. In design patent practice this means the declaration must affirmatively describe, in its text, at least one specific aspect of the original design that the applicant no longer wishes to claim, or wishes to add to the claim, with enough specificity that the nature of the error and its relationship to the claimed design is clear.

3.62 A Broadening Reissue May Not Recapture Subject Matter Deliberately Surrendered During Original Prosecution

35 U.S.C. § 251; *In re Mostafazadeh*, 643 F.3d 1353 (Fed. Cir. 2011); *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335 (Fed. Cir. 2005); MPEP § 1412.02

The recapture doctrine prohibits a patentee from using reissue to reclaim subject matter that was deliberately surrendered during the original prosecution to obtain allowance. As the Federal Circuit reaffirmed in *In re Mostafazadeh*, 643 F.3d 1353 (Fed. Cir. 2011), a patentee may not regain through reissue the subject matter surrendered to obtain allowance of the original claims. Although the doctrine developed primarily in utility patent practice, it applies with equal force to design patents. Because design patent scope is defined visually, the recapture analysis operates on the visual content that was given up rather than on claim language in the traditional sense.

The analysis proceeds in three steps. First, determine whether and in what aspect the reissue claims are broader than the patented claims. A reissue claim that deletes a limitation or element from the patented claims is broader with respect to the modified limitation. In design practice, this

broadening typically manifests as converting solid lines back to broken lines, removing previously claimed boundary features, or expanding the visual scope beyond the patented design. Second, determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To identify what was surrendered, the prosecution history must be examined for arguments and amendments made to overcome a prior art rejection. If the broadening is directed to the same subject matter that was narrowed during prosecution, the recapture inquiry proceeds to the third step.

Third, determine whether the reissue claims are materially narrowed relative to the original claims such that the surrendered subject matter is not entirely or substantially recaptured. *Mostafazadeh* clarified two critical principles at this step. First, a limitation added during prosecution to overcome prior art cannot be entirely eliminated on reissue, because doing so constitutes recapture of the surrendered subject matter regardless of whether other narrowing limitations are added to the claim. The limitation may be modified, but only so long as it continues to materially narrow the claim scope relative to the surrendered subject matter. Second, to avoid recapture, any narrowing must relate to the surrendered subject matter itself. Narrowing in unrelated aspects of the claim is insufficient. In *Mostafazadeh*, the applicants had added a "circular attachment pad" limitation during prosecution to overcome prior art and then attempted on reissue to eliminate the circularity requirement while adding narrowing limitations related to bus bar features. The court held that these bus bar limitations, though they genuinely narrowed the reissue claims relative to the original claims, were unrelated to the surrendered subject matter, the shape of the attachment pads, and therefore could not save the reissue from recapture. Similarly, in design patent practice, if the applicant narrowed a visual element such as ornamentation in a particular region of the design to overcome a rejection, a reissue that eliminates that visual narrowing cannot be rescued by adding new visual limitations in an unrelated region of the design.

Mostafazadeh also rejected the argument that partial recapture is sufficient to avoid the rule. The applicants contended that because they retained the attachment pad limitation (only removing the circularity requirement), they had not recaptured everything that was surrendered. The court held that when the reissue claims are broader than the patented claims, the mere assertion of partial recapture is insufficient without a corresponding demonstration that the claims are materially narrowed in a manner related to the surrendered subject matter. Retention of a limitation that was already well known in the prior art does not constitute material narrowing.

The court further clarified the relationship between the recapture rule and MPEP guidance. The Board had relied on MPEP § 1412.02 for the proposition that material narrowing requires that the reissue claims be directed to overlooked inventions, embodiments, or species not originally claimed. The Federal Circuit rejected this framework, explaining that the MPEP provision in question addresses reissue claims directed at wholly unclaimed subject matter, situations where the recapture rule is not even triggered because the new claims are unrelated to anything surrendered during prosecution. The proper inquiry at step three is whether the reissue claims are materially narrowed relative to the surrendered subject matter, not whether they claim distinct inventions.

Recapture is distinct from the two-year broadening limitation. A reissue may be timely filed within the two-year window and still be barred if it attempts to reclaim deliberately surrendered subject matter. Conversely, a non-broadening reissue filed after the two-year window does not

implicate recapture because no expansion of scope is sought. The two doctrines operate independently.

Practitioners must review the original prosecution history before filing any broadening reissue to identify whether any narrowing amendments or arguments were made in response to prior art rejections. If such amendments exist, the broadening reissue must be evaluated under the three-step framework. Under *Mostafazadeh*, the critical question is not merely whether the reissue claims are narrower than the original claims in some respect, but whether the narrowing is directed to the same subject matter that was surrendered. Narrowing that is unrelated to the surrender, no matter how significant, will not avoid recapture.

3.63 Reissue of Design Patents Claiming Graphical User Interface, Transitional, or Animated Designs Requires Particular Attention to the Feature Statement and Sequential Ordering of Figures

35 U.S.C. § 251; MPEP § 1414; MPEP § 1503.02; MPEP § 1504.01(a)

Design patents claiming graphical user interface (GUI) designs, including transitional or animated displays, present distinct reissue challenges because the claimed design includes not only the static visual appearance of each screen state but also the sequential relationship between states. Errors in the specification of these patents frequently involve the failure to adequately describe the transitional or sequential attribute of the design.

Common correctable errors in GUI design patents that may support a reissue filing include the following. First, the absence of any feature statement indicating that the design sequentially transitions between the images shown in the figures. The specification must explain the sequential order; mere presentation of multiple figures without an express statement of transition is an inadequacy that may render the patent partly inoperative. Second, an inaccurate or incomplete description of the transition sequence, such as listing figures in an order that does not correspond to the actual transition sequence of the GUI. Third, failure to identify which figures represent distinct screen states and which represent intermediate transition frames. Fourth, failure to describe the purpose of broken lines in figures depicting a GUI displayed on an electronic device, where the device housing is shown in broken lines.

When filing a reissue to correct a transitional design specification, the declaration should identify the specific figures for which the sequential relationship is inadequately described and should state that the reissue corrects this inadequacy by adding an express statement of the sequential transition order. The amended specification should include a feature statement substantially in the form: “The appearance of the changeable graphical user interface sequentially transitions from the image shown in FIG. [X] to the image shown in FIG. [Y].”

Practitioners should also be aware that GUI design reissues may raise unique broadening questions. Converting a solid-line device housing to broken lines in a GUI patent broadens the claim from a GUI-on-a-specific-device to a GUI on any device, which constitutes broadening that must be filed within two years. Similarly, altering the number of transition states or reordering the sequence of figures may affect the scope of the design claim in ways that require broadening analysis.

3.64 A Reissue Application, Particularly a Divisional Reissue Adding a New Embodiment, May Be Subject to Obviousness-Type Double Patenting Rejections

35 U.S.C. § 251; *In re Lonardo*, 119 F.3d 960 (Fed. Cir. 1997); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999) (abrogated in part on other grounds); MPEP § 1457; MPEP § 804

A reissue application, and particularly a divisional reissue that adds a new embodiment of the design, may be subject to a rejection on the ground of obviousness-type double patenting over the original patent, over another reissue application filed for the same patent, or over a related design patent. This issue arises because the reissued design must be patentably distinct from the designs claimed in related patents. If the reissued design is merely an obvious variation of the original patented design or of a design claimed in a related patent, a double patenting rejection will issue.

Obviousness-type double patenting is a judicially created doctrine that prevents an unjustified timewise extension of patent rights by prohibiting claims in a later patent that are not patentably distinct from claims in an earlier patent. The inquiry is a claim-to-claim comparison asking whether the later-claimed design would have been an obvious variation of the earlier-claimed design. Although design patent analysis necessarily focuses on overall visual impression, the doctrinal test remains one of patentable distinctness grounded in obviousness principles rather than the infringement "ordinary observer" test.

Terminal disclaimers, which are the standard mechanism for overcoming obviousness-type double patenting in utility practice, are available in design patent practice but carry important consequences. A terminal disclaimer filed to overcome a double patenting rejection in a reissue application ties the reissued patent's enforceability to common ownership with the reference patent. Practitioners should carefully evaluate whether the filing of a terminal disclaimer is strategically acceptable before proceeding.

Double patenting rejections are most likely to arise in divisional reissue practice. When a restriction requirement separates the original embodiment from a newly added embodiment, and the divisional is directed to the new embodiment, the examiner may compare the divisional's design to the original patent's design and issue a double patenting rejection if the two designs are not patentably distinct. The practitioner should anticipate this possibility and evaluate the distinctness of the new embodiment before filing the divisional.

3.65 The Duty of Disclosure Is Heightened in Reissue Proceedings and Requires Submission of All Material Prior Art, Including Art Not Before the Examiner During Original Prosecution

35 U.S.C. § 251; 37 C.F.R. § 1.56; MPEP § 1404.01

A reissue application triggers a fresh duty of disclosure under 37 C.F.R. § 1.56. The applicant, the applicant's attorney or agent, and every individual substantively involved in the preparation or prosecution of the reissue application has a duty to disclose to the USPTO all information known to be material to patentability. This duty is not limited to art that was before the examiner during original prosecution. It extends to any prior art, published references, or other material information that has come to the attention of the applicant or practitioner after the original

patent issued, including art identified in litigation, licensing negotiations, or post-issuance searching.

In practice, this means that the reissue filing package should include an Information Disclosure Statement (IDS) citing all known material references, even those previously cited during original prosecution. MPEP § 1404.01 instructs that applicants should bring to the attention of the examiner any information that is material to patentability of the reissue claims. Where a broadening reissue is filed, the expanded scope of the claim may render additional prior art material that was not material to the narrower original claim. Practitioners should re-evaluate the materiality of known references in light of the broadened claim scope.

Failure to comply with the duty of disclosure may render the reissued patent unenforceable. Because reissue prosecution reopens examination, the duty applies with the same force as in an original application, and the consequences of noncompliance are the same: potential unenforceability of the patent for inequitable conduct.

Practitioners should document their prior art review as part of the pre-filing analysis and should file an IDS concurrent with the reissue application. Supplemental IDS filings should be made as additional material references become known during prosecution.

Scope of Individuals Subject to the Duty

The duty of disclosure under 37 C.F.R. § 1.56 is not limited to the named inventor and the attorney or agent of record. The duty extends to every individual who is substantively involved in the preparation or prosecution of the reissue application. In practice, this includes patent agents, technical advisors, in-house counsel who participate in the reissue analysis, paralegals who conduct prior art searches or review prosecution files as part of the reissue preparation, and any other individual who contributes to the substantive content of the application.

The term “substantively involved” has been interpreted broadly. An individual need not draft the declaration or sign the filing papers to be substantively involved. If the individual reviews prior art, evaluates the scope of the reissue correction, participates in discussions about the error to be declared, or advises on whether a particular reference is material to patentability, that individual is substantively involved and subject to the duty.

Practitioners managing the reissue should take affirmative steps to identify all individuals who are substantively involved and remind them of their obligations under § 1.56. This is particularly important in organizational settings where the reissue analysis may involve multiple professionals across different functions, such as a litigation team that identified the error, an in-house IP manager who authorized the filing, and outside counsel who prepared the application. Each of these individuals may independently possess information material to patentability that must be disclosed.

The duty is continuing. It does not expire upon filing and persists throughout prosecution until the reissue patent issues or the application is abandoned. If any substantively involved individual becomes aware of material information at any point during prosecution, that information must be disclosed promptly through a supplemental IDS.

As a best practice, the practitioner should circulate a written reminder of the § 1.56 duty to all substantively involved individuals at the outset of the reissue preparation and should document the circulation in the work file. This documentation may be relevant if the duty of disclosure is later challenged in litigation or enforcement proceedings.

3.66 The Filing of a Reissue Application May Have Prior Art Implications for Related Applications, and Added Subject Matter in a Divisional Reissue May Not Be Entitled to the Original Patent's Filing Date

35 U.S.C. § 251; 35 U.S.C. § 102; 35 U.S.C. § 120; MPEP § 1440

Practitioners should be aware that the filing of a reissue application and, in particular, the addition of new embodiments through divisional reissue practice may raise prior art date questions. The claims of a reissue patent are entitled to the benefit of the filing date of the original patent application to the extent that the reissue claims are supported by the original disclosure. However, where a divisional reissue application adds a new embodiment, the effective filing date of the claim directed to that embodiment depends on whether the embodiment was adequately disclosed in the original application as filed.

If the added embodiment was disclosed in the original patent's drawings and specification, the reissue claim directed to that embodiment is entitled to the original filing date. If the embodiment was not adequately disclosed, the claim may be limited to the filing date of the reissue application itself, which may expose the claim to intervening prior art.

This analysis is particularly important when the original patent issued several years before the reissue is filed. Prior art that postdates the original filing date but predates the reissue filing date could be applied against claims in the reissue that are not entitled to the earlier effective date. Practitioners should confirm that every correction and every added embodiment is fully supported by the original disclosure before filing, not only to satisfy the no-new-matter requirement of § 251 but also to preserve the priority date of the reissue claims.

4. Application of the Rules and Guidance in Cases and Prosecutions

Application numbers cited in this Section refer to publicly accessible USPTO design reissue application files. For clarity and consistency, design reissue applications are referenced using their standard application serial format (e.g., 29/256,632).

4.1 Defective Declaration for Failure to Include Required “Original and First Inventor” and Review Statements (Pre AIA)

In application 29/181,535, the Examiner rejected the reissue oath/declaration because it failed to comply with the requirements of 37 C.F.R. §§ 1.63 and 1.175. Specifically, the declaration omitted required recitations: it did not state that the person making the oath believed the named inventor to be the original and first inventor of the claimed subject matter, did not state that the declarant had reviewed and understood the contents of the specification including any amendments, and did not identify the inventor’s citizenship. The Examiner required submission of a supplemental reissue declaration under 37 C.F.R. § 1.175(b)(1) before

allowance. This example illustrates that omission of required § 1.63 recitations renders the declaration defective and supports rejection of the reissue application under 35 U.S.C. § 251. Rule 3.25.

4.2 Declaration Defective for Referencing an Attached Specification That Was Not Attached

In application 29/210,607, the Examiner rejected the reissue declaration because it referenced an attached specification that was not actually attached. The Office Action explained that the executed declaration failed to adequately identify the reissue application it was executing, as required by 37 C.F.R. §§ 1.63 and 1.175. A declaration may not rely on reference to a nonexistent attachment to identify the application. The Examiner required submission of a supplemental reissue oath or declaration under 37 C.F.R. § 1.175(b)(1) before the application could proceed. This example demonstrates that a reissue declaration must clearly and independently identify the application to which it relates and cannot rely on reference to nonexistent attachments. Rule 3.24.

4.3 Declaration Defective for Failing to Identify a Specific Error with Particularity

In application 29/210,610, the executed reissue declaration stated that "an error took place when formal drawings were filed" and that "incorrect drawings were submitted and printed." The Examiner rejected the declaration under 37 C.F.R. § 1.175(a) because it failed to identify the specific error with sufficient particularity. The record showed that some figures were correct and unchanged, yet the declaration broadly suggested that all formal drawings were in error. The Examiner indicated that the error must be identified with greater specificity and suggested reliance on a prior explanation detailing which figures were incorrect. This example demonstrates that a generalized statement that drawings were incorrect is insufficient; the declaration must identify the specific figures and features constituting the alleged error. Rule 3.22

4.4 Supplemental Declaration Required After Post-Declaration Amendments

In application 29/210,608, the Examiner determined that amendments had been made to the drawings and specification after execution of the original reissue declaration. The Office Action required clarification as to whether the originally asserted error still covered the amended application, or submission of a supplemental reissue oath or declaration under 37 C.F.R. § 1.175(b)(1) prior to allowance. This example demonstrates that when amendments are made after execution of the original declaration, and those amendments affect the scope or nature of the asserted error, a supplemental declaration covering the amended reissue application must be filed before allowance. Rule 3.23

4.5 Assignee May Not Sign Declaration Without Owning Entire Interest Including Added Inventor

In Application 29/256,632, the reissue declaration was signed by the assignee of record. The Examiner first rejected the claim in a non-final Office Action (mailed September 6, 2007)

under 35 U.S.C. § 251 on the ground that the declaration was defective because a newly added inventor, Chadaporn Kusumarn, had not assigned his interest to the assignee. The applicant argued in response that the assignee of the entire interest may sign the reissue declaration to correct inventorship without the added inventor's signature, citing MPEP 1412.04. The Examiner was not persuaded and issued a Final Office Action (December 10, 2007) maintaining the rejection. The Examiner held that because Kusumarn had not assigned his interest, the assignee was only a part owner and could not execute a valid reissue oath or declaration to correct inventorship unless the co-owner joined or had assigned. The Office required submission of either (i) an assignment from the added inventor, or (ii) declarations signed by all inventors. The applicant ultimately resolved the rejection by obtaining an assignment from Kusumarn, which was recorded with the USPTO on March 31, 2008. The application was thereafter allowed. This example illustrates that when correcting inventorship in reissue, the assignee may sign the declaration only if it owns the entire interest, including the share of any added inventor. Rule 3.21.

4.6 Declaration Defective for Failure to Identify at Least One Operative Error

In Application 29/226,248, the Examiner rejected the single claim under 35 U.S.C. § 251 on the ground that the reissue oath/declaration was defective because it failed to identify at least one legally sufficient error supporting reissue. The rejection arose in the first Office Action (April 2006) and was maintained in a second Office Action (February 2007) after applicant's initial attempt to overcome it. The Office Actions cited 37 C.F.R. § 1.175(a)(1) and MPEP § 1414, explaining that a reissue declaration must identify a specific error in the patent forming the statutory basis for reissue. The applicant's generalized statement that the attorney "did not appreciate the full nature and scope of the invention" was held insufficient. The Examiner required identification of the specific claim language wherein the error resided and an explanation of how the claim was broadened by reference to the figures, per MPEP 1414(II)(C). The defect was curable. Applicant ultimately overcame the rejection by submitting a Supplemental Declaration on July 23, 2007 that identified the error with the required specificity, describing how the design claim was broadened by reference to the figures. The application was thereafter allowed. Rule 3.1.

4.7 Defective Reissue Declaration Overcome by Supplemental Oath Identifying Specific Broadening Error

In application 29/226,248, the Examiner rejected the claim under 35 U.S.C. § 251 on the ground that the reissue oath/declaration was defective because it failed to identify at least one error relied upon to support the reissue application with sufficient specificity. The Examiner required the applicant to identify the error by reference to the specific claim language and explain how the claim was broadened by reference to the figures. A general statement that the patent attorney did not appreciate the full scope of the invention was found insufficient.
The applicant overcame this rejection by submitting a supplemental declaration identifying with specificity how the claim was broadened through the inclusion of broken line disclosure in the amended figures, along with corrected replacement drawings that added broken lines to FIG. 1 for consistency with the other views. The Examiner allowed the claim upon receipt of the supplemental oath and proper amended drawings. This example illustrates that a reissue

declaration must identify errors with particularity, specifically describing how the claim scope is affected, rather than relying on generalized statements of attorney error. *See* 37 CFR 1.175; MPEP § 1414.

Note: The application also contained an early broadening-outside-two-years rejection, but applicant successfully traversed it by demonstrating the reissue was filed within the two-year window (original patent issued December 31, 2002; reissue filed December 30, 2004). That rejection was not maintained. Rule 3.1

4.8 Declaration Allegedly Defective for Failing to Identify Citizenship of Inventor

In Application 29/266,846 (Pre-AIA), the Examiner rejected the claim because the reissue oath/declaration allegedly failed to identify the country of citizenship of each inventor. Citing 37 C.F.R. § 1.175 and MPEP § 1414, the Examiner held that the oath was defective and rejected the claim as being based upon a defective reissue oath under 35 U.S.C. § 251. In a Response, the Applicant argued that this rejection was made in error. The Applicant pointed out that the filed "Reissue Application Declaration by the Assignee" (Form PTO/SB/52) explicitly identified the citizenship of the sole inventor, Werner Kienzler, as "Germany" on its first page. Upon further review, the Examiner issued a Final Office Action, stating that the rejection to the oath was indeed made in error and was formally withdrawn. Rule 3.25.

4.9 Declared Error Must “Make Sense” and Correspond to Actual Patent Defect

In application 29/284,092 (Pre-AIA), the Examiner maintained a rejection under 35 U.S.C. § 251 because the error identified in the declaration did not make sense. The declaration referenced Figure 8 as the basis for reissue; however, Figure 8 did not exist in the original patent (D509,028) and had been added during the reissue application before being required to be deleted for introducing new matter. Because the declared error was premised on a figure with no existence in the original patent, it could not identify a genuine defect in the issued patent. The Examiner explained that there must be at least one error in the patent to provide grounds for reissue and maintained the rejection because the stated basis for reissue was not a valid patent defect. This example demonstrates that the declared error must correspond to an actual defect in the issued patent; a nonsensical or unsupported assertion of error cannot support reissue. Rule 3.1 and Rule 3.12.

4.10 Non-Standard Duty-to-Disclose Language in the Declaration Requires a New Declaration

In Application 29/286,205 (Pre-AIA), the Examiner issued a notice of improper declaration because the reissue declaration was defective in two respects. First, it failed to state that the named inventor believed himself to be the "original and first inventor" of the claimed subject matter, as required by 37 CFR 1.63. The words "original and" were omitted. Second, the declaration language did not comply with 37 CFR 1.175(a)(1) because the phrase "partly invalid" was not consistent with the statutory language set forth in the rule and was characterized by the Examiner as "essentially incoherent." The Examiner additionally advised that any supplemental declaration should use the phrase "material to patentability" rather than "material to

examination." The claim was rejected under 35 U.S.C. 251 as being based upon a defective reissue declaration. In response, the applicant filed a newly executed Reissue Application Declaration incorporating the requested changes and corrections. This example demonstrates that a reissue declaration must strictly track the regulatory language of 37 CFR 1.175 and 37 CFR 1.63, and that failure to include required statutory phrases or use of non-standard formulations renders the declaration defective, necessitating a new declaration rather than mere argument. Rule 3.29

4.11 When the Original Declaration Is Fatally Defective, a Supplemental Filing Is Improper and a Completely New Declaration Is Required

In Application 29/365,400 (Pre-AIA), the Examiner rejected the reissue declaration because it failed to state that the person making the oath or declaration believes the named inventor to be the original and first inventor of the subject matter claimed and for which a patent is sought. The Applicant filed a Supplemental Declaration containing only the missing portions of the original declaration. In a Final Office Action, the Examiner stated that a Supplemental Declaration that only contains the missing portions of the original declaration is improper, explaining that one complete and proper declaration is required because the wording of an oath or declaration cannot be amended. The Examiner further stated that if the required affirmations have not been made, a new oath or declaration is required, and that the new declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the declaration. The Applicant ultimately overcame the rejection by filing a second and Supplemental Combined Declaration that was a complete standalone declaration signed by the inventor, which included the required statement that the declarant is the original first and sole inventor of the subject matter disclosed and claimed in the application. The claim was thereafter allowed. This example illustrates that when the original declaration omits required statutory affirmations, the defect cannot be cured by filing only the missing language as a supplement to the original; a fully new and complete declaration containing all required recitations is required. Rule 3.28

4.12 Reissue Specification Markings Must Use the Correct Bracketing Convention and a “Clean Copy” Should Not Be Filed

In application 29/421,264, the Examiner objected to the replacement specification because the applicant used improper markup conventions. The Office Action stated that double bracketing is improper, explaining that double brackets are used to identify changes made in a prior reissue and therefore do not apply in the present reissue. The Examiner required the applicant to use single brackets for deletions and stated that a clean copy of the specification without markings must not be included with the response, and that only the marked-up version should be filed. The Examiner expressly cited MPEP § 1453 for the required reissue specification formatting and treated noncompliant markup (double bracketing and inclusion of an unmarked clean copy) as an objection requiring correction before the case could proceed. Rule 3.36.

4.13 A Reissue Declaration Cannot Merely State the “Correct Design”; It Must Identify What Was Wrongly Claimed and What Feature/Area Is Being Vacated

In application 29/486,266, the Examiner rejected the claim under 35 U.S.C. § 251 because the reissue declaration filed by the applicant identified what the applicant considered to be the correct design but did not identify anything that was originally claimed that should not have been claimed. The Examiner explained that merely stating the issued patent claimed more of the baskets than the patentee considers the design was not an acceptable recitation of a specific error. The declaration was required to identify at least one feature or area of the set of cart baskets that was originally claimed and was now being vacated because it unduly narrowed the scope of the claim, and the Examiner criticized the absence of any specific element or area of the baskets identified as inappropriately claimed. The Examiner provided sample wording illustrating the required structure: identify the over claimed subject matter and then specify the particular portion being removed (e.g., "the Patent claims two baskets in full lines … the lower basket was claimed in error and is therefore removed from the claim by this reissue"). The applicant subsequently filed a new declaration adopting language substantially consistent with the Examiner's suggestion, specifically identifying the lower basket and the bottom surface of the upper basket as having been claimed in error, and the application was thereafter allowed. Rule 3.22, Rule 3.32

4.14 A Substitute (Not Supplemental) Declaration May Be Required When the Proper Reissue “Error” Shifts to Newly Discovered Specification Defects (Even Purely Formal Ones)

In application 29/515,597, the Examiner explained that the reissue declaration was defective because it did not identify an error requiring correction by reissue and because the originally asserted purpose (adding an additional embodiment for broadened coverage) became moot once the added embodiment was withdrawn following a restriction requirement and constructive election. The Examiner then stated that to overcome the rejection the applicant could file a substitute declaration, rather than a supplemental declaration, where the proper grounds for reissue are errors in the specification, including purely formal defects such as a grammatical or punctuation inconsistency in a figure description, or an inaccurate description of a broken line showing describing article portions as environmental features. The Examiner expressly indicated that the purpose of the reissue should not be broadening but correcting formal specification errors. The applicant filed a substitute reissue declaration adopting the grammatical error ground, specifically identifying the inconsistent semicolon punctuation used in the description of Figure 5 compared to the period punctuation used in the other figure descriptions. This illustrates that examiners will accept specification only formalities as a valid § 251 error and may require a substitute declaration to realign the error statement. Rules: 3.26, 3.28, 3.39

4.15 The Error Stated in the Declaration Must Be Specific to the Elected Embodiment; Elections Can Render the Declaration “Obsolete” If It References Inapplicable Figures

In application 29/537,566, the reissue application disclosed two separate embodiments. The Examiner issued a restriction requirement, identifying Figures 1 through 7 as Embodiment 1 (Group 1) and Figures 8 through 14 as Embodiment 2 (Group 2), and constructively elected

Group 1. The applicant traversed the constructive election and elected Group 2. The original declaration identified as its basis for reissue that the parallel crossbeams of the trailer were shown in full solid lines in the issued patent, which narrowed the scope of the claim to more than the applicant had a right to claim. This error pertained to figures associated with Group 1, which was no longer under examination following the election. The Examiner made final the section 251 rejection, finding the declaration defective because the declared error was not based on an error specific to the elected embodiment and identified figures that were no longer applicable to the application. The Examiner stated that the election of the alternate embodiment rendered the declaration "obsolete" because it was directed to figures no longer included in the application. The Examiner suggested specific alternative error statements that would be relevant to the elected embodiment, including a broadening error related to the crossbeams in the elected figures, an inadequacy in the description of Figure 1 as an "upper perspective" view, or a mischaracterization of the broken line showing as "environmental purposes only." A new declaration identifying a specific error relevant to the elected embodiment was required to overcome the rejection. Rule 3.26, Rule 3.49

4.16 The Declaration Can Be Supported by “Micro-Errors” in Figure Descriptions or Broken-Line Explanations (Orientation Clarity, Environmental vs. Article Features)

In Application 29/537,566, the Examiner suggested wording for the reissue declaration demonstrating that the supporting error may consist of correcting ambiguous orientation language such as "upper perspective," which fails to clearly identify the point of orientation from which the article is illustrated, or correcting the mischaracterization of broken lines as being provided for "environmental purposes only" when certain features shown in broken lines are portions of the article rather than environmental structure. These clarity and accuracy defects in figure descriptions or broken line explanations independently qualify as a § 251 error and may serve as a substitute basis when the original error becomes moot. Rule 3.39, Rule 3.40, Rule 3.46

4.17 “Inconsistency Between Figures” Is Too Vague Unless the Declaration States the Concrete Visual Discrepancy

In Application 29/554,344, the Examiner rejected a reissue declaration that stated "Figure 3 is inconsistent with Figures 1 and 2" as defective under 35 U.S.C. § 251 for failing to specifically identify an error in the patent. The Examiner explained that this conclusory statement was not considered equivalent to identifying a specific word, phrase, or expression and how it renders the original patent wholly or partly inoperative or invalid. Because the disclosure in a design patent is essentially confined to the drawings, the declaration must identify something specific in the drawings that causes the original patent to be defective. The Examiner indicated that the declaration should have stated that the head in Figure 3 is shown more elongated and/or out of proportion with the head in Figures 1 and 2. A substitute declaration incorporating this specific language was subsequently filed and accepted. The Office requires articulation of the actual visual discrepancy, not merely a general assertion of inconsistency between figures. Rule 3.41, Rule 3.54

4.18 You Cannot Amend the Declaration by Bracketing the Original Error; You Must File a New Properly Executed Declaration

In Application 29/556,105, the Examiner rejected the claim under 35 U.S.C. § 251 on the ground that the reissue declaration was defective because it failed to identify a specific error upon which the reissue was based. In response, the applicant attempted to correct the error statement by bracketing the original language and submitting a revised underlined error statement on a separate sheet, as though amending the specification under 37 CFR 1.173. The Examiner held that there is no provision for amending a reissue declaration in this manner, that the Office did not know how to treat such a submission, and that the underlined revised language had been treated as an addition to the specification rather than as an amendment to the declaration. The Examiner therefore held that the original defective declaration remained in force. The Examiner noted that the wording of the revised error statement was itself acceptable but that it could only be accepted if submitted in a completely new, properly executed declaration. The same sequence of events and the same holdings occurred in the related Application 29/556,468. In both applications, the applicants ultimately overcame the rejection by filing newly executed declarations containing the corrected error statement language. Rule 3.45

4.19 “Illustrative Purposes Only” Is Not an Acceptable Broken-Line Explanation for Design Patents; the Feature Statement Must Clarify That Broken Lines Form No Part of the Claimed Design

In Application 29/566,813, the Examiner objected to the specification's description of broken lines as being shown for "illustrative purposes only," explaining that this phrase has no clear meaning in design patent practice and does not satisfy the broken line explanation requirement of MPEP § 1503.02. The Examiner further noted that describing broken line elements as "environmental features" was inaccurate where those elements depicted portions of the handrail article itself rather than surrounding environment. The Examiner required the specification to be amended to state that the broken lines in the drawings illustrate portions of the handrail that form no part of the claimed design. Because the original declared error for reissue (adding alternate broadened embodiments) became moot when the added embodiments were withdrawn following restriction, the Examiner identified these specification defects as proper substitute grounds for reissue under 35 U.S.C. § 251, noting that either the discrepancy in the broken line showing between figures or the inadequacy of the broken line description in the specification could support the reissue filing. Rule 3.46

4.20 GUI Transitional or Animated Designs: Failure to Specify Sequential Order Can Constitute a Correctable Error

In application 29/614,296, the Examiner determined that the original basis for filing the reissue application had become moot following a restriction requirement and constructive election of the patented embodiment. Upon examining the original patent specification, the Examiner identified a separate correctable error: the feature statement in the specification failed to adequately describe the transitional attribute of the graphical user interface design, specifically by not indicating that the appearance of the changeable graphical user interface sequentially transitions between the images shown in the figures. The Examiner indicated that this

inadequacy in the specification constituted an appropriate ground upon which to base the reissue application under 35 U.S.C. § 251, and suggested specific language for both a replacement reissue declaration and an amended transitional statement. The applicant filed a replacement reissue declaration identifying the failure to explain the sequential relationship between the depicted images as the error being corrected, amended the specification to expressly state the sequential order of the transition, and amended the drawings to render certain ambiguous line features in broken lines as directed by the Examiner. The claim was subsequently allowed. The declaration should identify the failure to explain the sequential transition between specified figures and indicate that the reissue corrects this inadequacy. Rule 3.48

4.21 Broadening Error Language Must Not Refer to Adding “Claims” in Design Reissue; It Must Describe Adding Embodiments or Variants

In application 29/671,750, the Examiner rejected the reissue declaration under 35 U.S.C. §251 on two grounds. First, the declaration lacked specificity because it failed to explain how the addition of new embodiments broadened the scope of the existing claim. Second, the declaration improperly characterized the broadening error as an effort to pursue "additional claims which were not restricted," when a design patent may contain only a single claim. The Examiner stated that the declaration should instead describe the error as a desire to add previously disclosed but canceled embodiments and should explain how those embodiments broaden the scope of the existing claim. The Examiner provided sample language framing the error as the erroneous omission of an embodiment that resulted in an improperly narrower claim than intended. The Applicant traversed the rejection, arguing that the declaration adequately described the changes to be made to the original claim. The application was subsequently allowed. Rule 3.52

4.22 If Both a Non-Applicable Broadening Error and a Valid Alternate Error Are Stated, the Non-Applicable Error Must Be Removed

In Application 29/628,194, the Examiner rejected the claim under 35 U.S.C. § 251 as being based on a defective reissue declaration because the sole error identified in the original declaration was a broadening error that had been rendered inapplicable by the constructive election of the originally patented embodiment and the withdrawal of the broadening embodiments. In the non-final rejection, the Examiner identified a valid alternate error in the specification of the original patent, specifically an inaccurate description of the broken line showing, and instructed the applicant to file a new declaration identifying only that error. The applicant instead filed a substitute declaration that retained the inapplicable broadening error and added an inventorship error as an additional basis but did not adopt the specification error the Examiner had identified. In the final rejection, the Examiner maintained the defective declaration rejection because the inapplicable broadening error had not been omitted from the substitute declaration. The Examiner explained that the declaration could be corrected by filing a new declaration directed solely to the specification error regarding the broken line description. Rule 3.49

4.23 A Missing Broken-Line Feature Statement Can Itself Be the Reissue “Error” Under § 251

In Application 29/679,629, the reissue application was originally filed to broaden patent coverage by adding an additional embodiment for a segregable lid design. After the Examiner imposed a restriction requirement and constructively elected the original patented embodiment (Group I, Embodiment 1), the original basis for filing the reissue was rendered moot. The Examiner then identified a separate correctable error in the specification of the original patent: the specification did not include a feature statement explaining the purpose of the broken line showing in FIG. 7. The Examiner stated that this omission was an appropriate ground upon which to base the reissue application under 35 U.S.C. § 251. To overcome the rejection for a defective declaration, the Examiner required a new declaration stating that the reissue was filed to include a feature description indicating the purpose of the broken line showing in the drawings in FIG. 7. The applicant filed a corrected declaration with that language and added a statement to the specification that the broken lines illustrate portions of the sport bottle that form no part of the claimed design. The application was subsequently allowed. Rule 3.46

4.24 If the Original or Elected Embodiment Is Unamended, There May Be No Error Being Corrected

In Application 29/703,974, the Examiner rejected the reissue under 35 U.S.C. § 251 because the original claim corresponding to the elected embodiment was unamended and therefore no correctable error was being made in that claim. The Examiner explained that where the elected subject matter is identical to the original patent claim and no amendment is made to that subject matter, there is no error upon which reissue can be based. After the applicant amended the original embodiment, the Examiner determined that a correctable error was present and the application qualified for reissue. The prosecution history further reflects that the application was being examined in parallel with a divisional and was subject to suspension and rejoinder procedures during that process. Rule 3.27.

4.25 Rejoinder or Rejoining Divisional-With-Original Reissue Requires a Specific Procedural Sequence

In Application 29/703,974, the Examiner required suspension of examination pending consideration of amendments and a petition filed in a copending divisional reissue application, and indicated that the applications could be rejoined following resolution of that petition. The record reflects that the applicant filed a petition under 37 C.F.R. § 1.183 in the divisional to waive Rule 1.153, amended the original reissue to incorporate the divisional disclosure, submitted an Information Disclosure Statement listing references from the divisional, and proceeded through suspension and rejoinder before allowance. This sequence reflects an examiner directed procedural framework for rejoining a divisional with an original reissue, distinct from the substantive error analysis under 35 U.S.C. § 251. Rule 3.13, Rule 3.27.

4.26 Declaration Must Identify at least One Specific Originally Claimed Feature That Is Now Unduly Limiting

In Application 29/765,026, the Examiner required identification of at least one specific feature originally claimed that is now believed to be unduly limiting. The applicant complied by naming particular features such as left and right bite wings. The declaration must identify

concrete features rather than generally referring to portions shown in solid lines. Rule 3.32, Rule 3.56

4.27 Inconsistent Drawings Across Figures Can Constitute a Correctable § 251 Error

In Application 29/776,872, the Examiner proposed error language stating that certain figures depicted an inconsistent and incorrect luggage shell by erroneously omitting large outer zipper front pockets that were clearly present in other views, instead showing a contiguous hard surface shell. Reissue was used to replace the inconsistent figures with corrected drawings consistent with the other drawing figures. Inconsistency between figures, where a feature that is clearly present in some views is omitted from other views, may constitute a correctable drawing error sufficient to support reissue. Rule 3.57

4.28 Boundary Lines Added in Reissue Must Satisfy Written Description Under *Owens*

In Application 29/779,083, the Examiner rejected a newly introduced boundary line under § 251 as constituting new matter added to the patent for which reissue was sought, because the original patent did not disclose or support the claimed boundary. Citing *In re Owens*, the Examiner emphasized that an unclaimed boundary line may only make explicit a boundary that already existed but was unclaimed in the original disclosure and may not introduce a new demarcation not recognizable from the original drawings. The Examiner found no indication that the applicant possessed the boundary in the original patent. The applicant ultimately overcame the rejection by converting the structure inside the boundary line to broken lines in the drawings and adding an appropriate boundary line disclaimer statement in the specification, after which the claim was allowed. Rule 3.58

4.29 Assignee Consent in Continuation or Divisional Reissue Requires New Consent Specific to That Application

In Application 29/786,080, the Examiner stated that copying assignee consent from the parent reissue application is generally not acceptable for a divisional reissue application because it does not demonstrate that the assignee has consented to the addition of the new error being corrected in the divisional application. A new written consent from all assignees is required for a divisional reissue application, regardless of whether the parent will be abandoned, and the reissue oath or declaration remains defective until such consent is filed. Rule 3.59

4.30 You Cannot Amend the “Specification” to Fix a Defective Error Statement; Fix the Error Statement by Filing a New Properly Executed Declaration

In Application 29/556,105 (and the parallel language in 29/556,468), the Examiner addressed a tactic some applicants try: bracketing the original error statement in the specification and adding an underlined revised statement of error on a separate sheet, as if amending the specification. The Examiner's position was that there are no provisions for amending a specification to correct a defective error statement in that manner; the Office did not know how to treat the submission and therefore treated the underlined revised error statement as an addition to the specification. The original reissue declaration as filed was therefore still in force and

remained defective. The original error statement had said only that "the portions of the Portable Computer are shown in full lines in the issued patent and thus narrow the scope of the claim to more than the Applicant had the right to claim." The Examiner found this too vague because it failed to identify at least one specific feature or area of the portable computer believed to unduly narrow the claim scope. See 37 CFR 1.175 and MPEP § 1414. The Examiner then said the wording of the revised statement of error was found to be acceptable, and that if a new properly executed declaration were to be submitted using the revised language, it would be accepted. Takeaway: if your error statement is wrong or too vague, you fix it by filing a new or substitute declaration with acceptable wording, not by trying to edit the error into the specification via bracket and underline markup. Rule 3.45

4.31 Recapture Analysis in Design Broadening Reissue (Composite Illustration – Not Based on an Actual Prosecution File)

No publicly available design reissue prosecution file reviewed for this ProGuide presented a fully developed recapture rejection and resolution sequence. However, the following composite illustration, drawn from the recapture principles applied in utility reissue practice and adapted to design patent conventions, demonstrates how the analysis would operate.

Assume a design patent issued for a handbag. During original prosecution, the applicant presented the handbag with decorative stitching on the front panel in solid lines. The examiner rejected the claim over prior art showing a similar handbag with a smooth front panel. To overcome the rejection, the applicant converted the smooth portions of the front panel to broken lines, narrowing the claim to the decorative stitching pattern. The patent issued with the decorative stitching as the primary claimed feature.

Following issuance, the patentee files a broadening reissue within two years, seeking to convert the front panel back to solid lines and reclaim the overall handbag silhouette as part of the design. This broadening directly targets the subject matter that was surrendered to overcome the prior art rejection. Under the three-step recapture framework, the broadening relates to the same area as the surrender, and the reissue would be barred regardless of whether other aspects of the claim were narrowed.

If instead the broadening reissue sought to convert a handle feature from solid to broken lines, which was not part of the original surrender, the recapture doctrine would not bar the reissue because the broadening does not relate to the surrendered subject matter. Rule 3.62

Practice Note on Case 4.31

The composite illustration above is adapted from recapture principles developed in utility reissue practice, principally *In re Mostafazadeh*, 643 F.3d 1353 (Fed. Cir. 2011), *In re Youman*, 679 F.3d 1335 (Fed. Cir. 2012), and *North American Container, Inc. v. Plastipak Packaging, Inc*., 415 F.3d 1335 (Fed. Cir. 2005). No publicly available design reissue prosecution file reviewed for this ProGuide presented a fully developed recapture rejection that proceeded through all three steps of the framework to a final resolution. While the three-step recapture analysis is not

structurally limited to utility patents and has been applied by examiners in design reissue prosecution, practitioners should be aware that the Federal Circuit has not issued a published decision squarely applying the *Mostafazadeh* framework in the specific context of a design patent reissue where the "surrender" consisted of visual changes to drawings rather than textual claim amendments.

In design practice, the concepts of "surrendered subject matter" and "material narrowing" operate on visual impressions rather than claim language. Whether a particular conversion of solid lines to broken lines during original prosecution constitutes a deliberate surrender of the visual area covered by those lines, and whether a subsequent reissue broadening "relates to" that surrendered area, are questions that depend on visual comparison rather than textual claim construction. The three-step framework applies, but its application requires adaptation to the impression-based scope analysis that governs design patents. Practitioners confronting a potential recapture issue in a design broadening reissue should document their analysis of each step with reference to the specific visual features at issue and should not assume that the outcome of the analysis will mirror the result in a textually analogous utility case.

For design patents, the analysis would follow a specific three-step framework adapted for visual disclosures:

Step 1: Identify the Broadening

Determine if and in what specific aspect the reissue claim is broader than the original patented claim. In design practice, this typically manifests as converting broken lines back to solid lines, removing previously claimed boundary features, or removing surface shading. Any deletion of a visual limitation or element from the patented claim constitutes broadening.

Step 2: Determine if Broadening Relates to Surrendered Subject Matter

Review the original prosecution history to identify any "surrender-generating limitations" (SGLs). A surrender occurs when an applicant makes amendments (e.g., adding solid lines or boundaries) or arguments to distinguish the design from prior art. If the reissue seeks to broaden the same visual area that was previously narrowed to overcome a rejection, the recapture inquiry moves to the final step.

Step 3: Evaluate Material Narrowing

Determine if the reissue claim is materially narrowed in other respects such that the surrendered subject matter is not actually recaptured.

The Nexus Requirement: To avoid recapture, any new narrowing must relate directly to the same surrendered subject matter.

Unrelated Narrowing is Insufficient: Adding narrowing limitations to a completely different region of the design (e.g., narrowing the handle of a handbag while trying to broaden the front panel that was previously surrendered) will not save the reissue from the recapture bar.

No Partial Recapture: A limitation added to overcome prior art cannot be entirely eliminated, even if other narrowing features are added.

5. Practice and Enforcement Notes

Reissue prosecution in design patents is structurally rigid but procedurally nuanced. Although 35 U.S.C. § 251 provides the statutory framework, actual examination reveals recurring practice patterns that affect allowance, timing, and strategic posture.

5.1 The Reissue Declaration Controls the Entire Application

In design reissue practice, the declaration is not merely a formality. It is jurisdictional. Examiners consistently treat the declaration as the legal foundation of the application. If the declaration does not identify a correctable error with specificity, the application fails regardless of the technical correctness of the amendments.

Several recurring principles emerge:

1. The error must be stated in the declaration itself.
2. The declaration cannot delegate identification of the error to the drawings.
3. Vague statements such as "claimed more than the patentee had a right to claim" are insufficient without identifying the specific feature or area.
4. If prosecution developments render the originally declared error inapplicable, the declaration must be updated.

Practitioners should consider drafting the declaration last, after all amendments are finalized, to ensure internal consistency.

5.2 When a Supplemental Declaration Is Required and When It Is Not Enough

Reissue prosecution frequently requires updated declarations. However, examiners draw a critical distinction between:

1. Supplemental declarations (permitted in limited situations), and
2. Situations requiring a completely new declaration.

A Supplemental Declaration Is Appropriate When:

1. The original declaration was facially compliant; and
2. Subsequent amendments introduce additional correctable errors not previously covered; and
3. The statutory affirmations were originally present.

In these circumstances, a supplemental declaration covering "every error corrected in the present reissue application not previously covered" is sufficient and may be deferred until allowance.

A New Declaration Is Required When:

1. The original declaration omitted required statutory affirmations;
2. The duty-to-disclose language deviated from the regulatory text;
3. The declaration referenced attachments that were never attached;
4. The originally declared error is no longer operative (e.g., due to restriction or divisional practice);
5. The error relied upon cannot be corrected without new matter.

In these situations, a supplemental declaration will not cure the defect. A completely new declaration is required.

5.3 Restriction Requirements and Divisional Reissues

Restriction in reissue practice creates recurring procedural traps.

5.3.1 When the Elected Group Contains Only the Original Unamended Claim

If the elected group contains only the original patent claim without correction, examiners will reject under § 251 for lack of error.

The correct procedural response is not argument. The correct response is:

1. File a divisional reissue directed to the non-elected embodiment;
2. Request suspension of the parent reissue;
3. Confirm a complete response on that basis.

Attempting to argue that the original claim itself contains an error rarely succeeds.

5.3.2 Divisional Reissues After the Two-Year Broadening Period

Where the parent reissue was filed within the two-year window and contained broadened claims, a divisional reissue may present broadened claims even if filed after the two-year period. The intent to broaden must be traceable to the timely parent filing. Practitioners should affirmatively identify the parent filing date and its timing relative to the two-year window when responding to broadening rejections in the divisional.

5.3.3 Reliance on Parent Declarations in Divisionals

A divisional reissue may rely on a declaration accepted in the parent, but only if the error identified in that declaration is still operative in the divisional. If the

divisional is directed to a different embodiment and the originally declared error does not apply, a new or supplemental declaration is required.

5.4 Examiner-Identified Errors During Prosecution

A recurring scenario occurs when the examiner identifies a correctable error not originally declared, most commonly improper surface shading.

In such cases:

1. If the original declared error remains operative, a supplemental declaration may be sufficient.
2. If the original error has become moot, a new declaration identifying the examiner-identified error is required.

Importantly, inaccurate shading can constitute a correctable § 251 error even if it would not independently support a § 112 rejection. This is a subtle but recurring design-specific basis for reissue.

5.5 New Matter Limitations in Reissue

Reissue cannot introduce new matter. In practice, this most frequently arises in:

1. Attempts to broaden titles beyond the original disclosure;
2. Adding terminology not present in the original specification;
3. Attempting to add embodiments not shown in the original drawings.

Where the declared error depends on a change that itself introduces new matter, the declaration is fatally defective. The solution is not supplementation. The solution is re-framing the error within the bounds of the original disclosure.

5.6 Inventorship Corrections

Correction of inventorship may serve as a valid basis for reissue when § 256 correction is unavailable. However:

1. If an assignee signs the declaration, the assignee must own the entire interest — including any newly added inventor's share.
2. Objective evidence of assignment must exist; a 3.73 statement alone is insufficient.

Failure to satisfy complete ownership requirements renders the declaration defective.

5.7 Marking and Amendment Technicalities

Reissue marking defects are common and easily avoidable. Recurring issues include:

1. Failure to use single brackets for omitted matter;
2. Use of double brackets in new reissue applications;
3. Filing clean copies rather than marked-up copies;
4. Making amendments relative to prior amendments rather than relative to the patent as issued.

Examiners treat these as procedural defects but will require correction before allowance. Practitioners should ensure that every response stands independently relative to the issued patent.

5.8 The Declaration Cannot Be "Promised"

Where a declaration is defective, a promise to file a corrected declaration is insufficient. The rejection remains active until a compliant declaration is actually filed. Examiners may hold the rejection in abeyance pending allowable subject matter, but jurisdictionally, the declaration must be present before allowance.

5.9 Reissue Is Not a Vehicle for Strategic Redrafting

Reissue practice reveals a consistent theme: Examiners will allow correction of errors. They will not permit strategic redesign. If the desired change:

1. Alters the visual appearance beyond correction,
2. Adds new embodiment scope not originally disclosed,
3. Or reframes the invention beyond its issued disclosure,

then Reissue will not cure it.

5.10 Recapture Screening

Recapture analysis is a prerequisite for any broadening reissue. The recapture doctrine is an independent bar that operates separately from the two-year filing deadline. The practitioner should obtain and review the complete prosecution history of the original patent before filing. If any amendment was made to the drawings or specification in response to a substantive rejection, the practitioner must determine whether the amendment narrowed the visual scope of the claimed design. If it did, the practitioner must map the proposed broadening reissue correction against the surrendered subject matter.

Key indicators of potential recapture include the following. First, any conversion of broken lines to solid lines during original prosecution that was responsive to a prior art rejection. Second, the addition of boundary lines or surface features to distinguish over prior art. Third, the restriction of the claim to a subset of the originally presented design in response to an examiner's anticipation or obviousness rejection. Fourth, arguments in the prosecution history that the claimed design is patentable precisely because of features that the broadening reissue now seeks to disclaim.

If the proposed broadening overlaps with surrendered subject matter, the reissue filing should be restructured to avoid the area of surrender, or the practitioner should advise the client that the broadening cannot be obtained through reissue.

Recapture screening should be documented in the practitioner's work file as part of the pre-filing analysis. Although the recapture doctrine is not always raised by examiners at the initial stage, it may be raised at any point during prosecution, including on appeal.

5.11 Intervening Rights and Enforcement Consequences of Design Reissue

Filing a reissue application carries substantive enforcement consequences that practitioners must evaluate before filing. Under 35 U.S.C. § 252, a reissued patent is subject to intervening rights that may limit the patentee's ability to enforce the broadened or amended claims against certain parties.

Section 252 establishes two categories of intervening rights. Absolute intervening rights protect any person who, prior to the grant of the reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of or sale of the specific thing so made, purchased, offered for sale, used, or imported. This right attaches automatically and requires no judicial discretion. Absolute rights apply only to specific things already in existence before the reissue issues; they do not extend to products not yet manufactured at the time of reissuance.

Equitable intervening rights are discretionary. A court may provide for the continued manufacture, use, offer for sale, or sale of a thing made or for which substantial preparation was made before the reissue grant, to the extent the court deems equitable for the protection of investments made or business commenced before the grant. Equitable rights require a showing that the party made substantial preparation or investments in reliance on the scope of the original patent claim.

In design patent reissue practice, intervening rights operate on the visual scope of the design claim. Where the reissue broadens scope by converting solid lines to broken lines, removing surface detail, or otherwise expanding the range of designs covered, the broadened scope is the area most likely to trigger intervening rights. A competitor who manufactured a product that would not have infringed the original patent but would infringe the broadened reissue claim may assert absolute intervening rights for units already made and equitable intervening rights for ongoing production.

Importantly, intervening rights apply only to the extent that the reissue claim differs from the original. Where the original and reissued claims are substantially identical, the surrender of the original patent does not affect pending actions or existing causes of action, and the reissued patent constitutes a continuation of the original. The question of whether claims are substantially identical is a question of law, and "identical" means without substantive change.

The enforcement calculus should be evaluated at the pre-filing stage. If the patentee is aware of specific competitors whose products fall within the broadened scope but outside the

original scope, the patentee should assess whether those competitors could assert intervening rights that would limit the practical value of the broadened claim. In some situations, the enforcement exposure created by the reissue prosecution history, combined with intervening rights, may outweigh the benefit of the broader scope.

Practitioners should also be aware that reissue prosecution creates a new prosecution history that may later be used to interpret the scope of the reissued claim through prosecution history estoppel. Arguments made during reissue to justify broadening or to distinguish prior art become part of the permanent record. Although the Federal Circuit has held that prosecution history estoppel has not been applied to the abandonment of a reissue application, statements made during an active reissue prosecution remain relevant to claim construction.

In summary, the decision to file a broadening design reissue should incorporate an enforcement analysis that accounts for the following. First, whether known competitors have products that fall within the broadened scope. Second, whether those competitors manufactured, sold, or substantially prepared to manufacture those products before the reissue issues. Third, whether the broadened scope is sufficiently valuable to justify the intervening rights exposure. Fourth, whether the reissue prosecution arguments could create estoppel that limits enforcement of the original scope. These considerations should be documented in the pre-filing analysis alongside the recapture screening and broadening assessment.

5.12 The Consent Requirement and the Declaration Requirement Are Separate Obligations

Reissue practice imposes two distinct assignee-related obligations that practitioners must satisfy independently. The first is the consent requirement under 37 C.F.R. § 1.172(a). The second is the question of who may execute the reissue oath or declaration under 35 U.S.C. § 251(c) and 37 C.F.R. § 1.175(c). These requirements serve different purposes and are governed by different rules. Conflating them is a recurring source of procedural defects.

The Consent Requirement (37 C.F.R. § 1.172)

Under 37 C.F.R. § 1.172(a), a reissue application must be accompanied by the written consent of all assignees currently owning an undivided interest in the patent. This consent requirement applies regardless of who executes the declaration. All assignees consenting to the reissue must establish their ownership by filing a submission in accordance with 37 C.F.R. § 3.73(c).

The consent is a threshold filing requirement. It confirms that every party with a proprietary interest in the patent has agreed to subject the patent to reissue proceedings. Without the consent of all assignees, the application is defective. Consent must be specific to each reissue application; as discussed in Rule 3.59, a copy of consent filed in a parent reissue is generally not acceptable for a divisional.

The Declaration Execution Question (35 U.S.C. § 251(c); 37 C.F.R. § 1.175(c))

Separately, the question of who may sign the reissue oath or declaration is governed by 35 U.S.C. § 251(c) and 37 C.F.R. § 1.175(c). The general rule is that the inventor or each joint inventor must execute the declaration. However, the assignee of the entire interest may execute the declaration in lieu of the inventor(s) under two circumstances: (1) the application does not seek to enlarge the scope of the claims, or (2) the original patent application was filed by the assignee under 37 C.F.R. § 1.46.

If the reissue is broadening and the original application was not filed by the assignee, the declaration must be executed by the inventor(s), not the assignee. This is a separate analysis from whether the assignee has consented to the reissue. An assignee may consent to the filing while still being unable to execute the declaration.

Practical Implications

The distinction matters most in two scenarios. First, where the reissue is broadening and the assignee assumes it can both consent and execute the declaration. In that situation, the assignee must consent under § 1.172, but the declaration may need to be executed by the inventors under § 1.175(c) unless the original application was filed by the assignee. Second, where inventorship is being corrected and a new inventor is being added. The assignee may consent to the reissue, but if it does not own the added inventor's interest, it cannot execute the declaration on behalf of all inventors, as discussed in Rule 3.21.

Practitioners should analyze both requirements independently at the pre-filing stage. The consent analysis asks: do all current assignees agree to the reissue? The declaration execution analysis asks: who is legally authorized to sign the oath or declaration given the nature of the correction? Both must be satisfied, and satisfying one does not satisfy the other.

5.12.1 Practical Scope of the Assignee Filing Exception Under 37 C.F.R. § 1.46

Under 37 C.F.R. § 1.175(c)(2), an assignee of the entire interest may execute the reissue declaration for a broadening reissue if the application for the original patent was filed by the assignee under 37 C.F.R. § 1.46. This exception, while correctly stated in the statute and regulation, has a narrower practical reach than many practitioners assume.

The exception applies only where the original patent application was itself filed by the assignee of the entire interest as the applicant. It does not apply where the application was filed by the inventor or inventors and an assignment was subsequently recorded, even if the assignment was recorded before the patent issued. The distinction turns on who was identified as the applicant at the time of filing, not on who owned the patent at the time of issuance.

Note on Post-AIA Scope of 37 C.F.R. § 1.46. For original applications filed on or after September 16, 2012, the AIA broadened 37 C.F.R. § 1.46 to permit any person to whom the inventor has assigned, or is under an obligation to assign, the invention, or who otherwise shows sufficient proprietary interest in the matter, to make the application for patent. This is broader than the pre-AIA version of § 1.46, which was limited to

assignees. As a practical matter, however, the relevant inquiry for purposes of § 1.175(c)(2) remains the same: whether the assignee of the entire interest was identified as the applicant on the Application Data Sheet at the time of filing the original patent application. For original applications filed before September 16, 2012, the pre-AIA version of § 1.46 applies, and the inquiry is whether the assignee filed the application under the more limited pre-AIA provision. In either case, the critical question is what the filing record of the original application reflects, not what ownership arrangements existed at the time of reissue.

In practice, the majority of design patent applications continue to be filed by individual inventors with assignments recorded separately. In those cases, even where the assignee owns the entire interest at the time of reissue, the assignee may consent to the reissue under 37 C.F.R. § 1.172 but may not execute the declaration for a broadening reissue under § 1.175(c). The declaration must instead be executed by the inventor or each joint inventor.

5.13 Post-Issuance Considerations for Design Reissue Patents

The ProGuide addresses reissue practice through allowance. However, the issuance of a reissued design patent triggers several practical obligations and strategic considerations that the practitioner should anticipate during prosecution.

Surrender of the Original Patent

Under 35 U.S.C. § 251, the filing of a reissue application constitutes an offer to surrender the original patent. The surrender takes effect upon issuance of the reissue patent. Until that point, the original patent remains in full force. Once the reissue issues, the original patent ceases to exist as an independent grant. The reissued patent replaces it for all purposes going forward. An exception to this rule is if the reissue claim is recombined with the original claim. For guidance on recombining the original design with a subcombination or segregable part through the reissue process, *see* Section 5.17.

This has practical implications for concurrent enforcement. A patentee may enforce the original patent during the pendency of the reissue application. However, the patentee should be aware that statements made during reissue prosecution may affect the scope of the original patent's claim through prosecution history estoppel, even before the reissue issues.

Marking Obligations

Under 35 U.S.C. § 287(a), a patentee who marks products with a patent number must update the marking to reflect the reissued patent number once the reissue issues. Failure to update marking may limit the patentee's ability to collect damages in an infringement action. Because design patents are frequently enforced through injunctive relief and damages, the marking transition should be planned in advance so that product packaging, molds, labels, and online listings can be updated promptly upon reissuance.

Where virtual marking is used pursuant to § 287(a), the web address listing patent numbers must be updated to include the reissued patent number.

Effect on Pending Litigation

Under 35 U.S.C. § 252, the reissued patent has the same effect and operation in law as if it had been originally granted in its amended form. To the extent the claims of the original and reissued patents are substantially identical, the surrender does not affect any action then pending or abate any cause of action then existing. The reissued patent is treated as a continuation of the original and has effect continuously from the date of the original patent.

Where the reissued claims are not substantially identical to the original, the patentee must assert the reissued claims in place of the original. Pending litigation may require amendment of pleadings to reflect the reissued patent.

Reissue Patent Term

A reissued design patent is granted for the unexpired portion of the original patent term only. The reissue does not extend the term. For design patents issuing from applications filed on or after May 13, 2015, the term is 15 years from the date of grant of the original patent. The reissued patent expires on the same date the original would have expired.

Recording the Reissue

The patentee should ensure that the reissued patent is properly recorded in any assignment databases and internal IP management systems. If the original patent was subject to a license, security interest, or other encumbrance, the patentee should confirm that the reissued patent is covered by the existing agreement or update the agreement as necessary.

5.14 Electronic Filing Notes for Design Reissue Applications

Design reissue applications are filed electronically through the USPTO's Patent Center system. Several filing-specific issues recur in practice and are worth addressing at the pre-filing stage.

Application Type Selection

When initiating a new reissue application in Patent Center, the applicant must select the correct application type. Design reissue applications must be filed under the reissue application type, not as a standard design application. Selecting the wrong application type may result in incorrect fee calculations, improper routing, and delays in examination. The system will prompt for the patent number being reissued; this must be entered accurately.

Document Category Assignment

Each uploaded document must be assigned to the correct document category. Common errors include uploading the reissue declaration as a generic "oath or declaration" rather than specifically as a "reissue oath or declaration," uploading replacement drawing sheets under the wrong drawing category, and failing to upload the assignee consent and § 3.73 statement as separate identified documents. Incorrect categorization can delay processing because documents may not be routed to the examiner or may not appear in the expected section of the file wrapper.

Drawing Upload Requirements

Replacement drawing sheets must be uploaded as individual pages in the correct sequence. Patent Center may reorder or paginate uploads in unexpected ways if multiple drawing sheets are uploaded as a single file. The safest practice is to upload each replacement sheet as an individual PDF page and verify the upload order before submission. Drawing sheets should be uploaded at sufficient resolution to ensure that surface shading, broken lines, and boundary features are clearly legible.

Fee Calculation

Design reissue filing fees are specified in 37 C.F.R. § 1.16(e), with separate search and examination fees under § 1.16(n) and § 1.16(r). The additional claims fees that apply to utility reissue applications do not apply to design reissues because design patents are limited to a single claim. Practitioners should verify that Patent Center calculates the correct fee before submission. If expedited examination under 37 C.F.R. § 1.155 is requested concurrently, the additional petition fee must also be included.

Confirmation and Filing Receipt

After submission, the practitioner should confirm receipt of a filing receipt that correctly identifies the application as a design reissue, lists the correct patent number being reissued, and reflects the correct inventorship and assignee information. Errors in the filing receipt should be corrected promptly, as they may propagate through the examination record.

Note on Expedited Examination

Expedited examination of design applications under former 37 C.F.R. § 1.155 is no longer available. The provision was suspended effective April 17, 2025 and permanently eliminated effective August 14, 2025. For a full discussion of the elimination and remaining options to advance examination, including Petition to Make Special based on age or health and the Accelerated Examination program, *see* Section 5.23.

5.15 GUI and Animated Design Reissue Practice

The growing volume of GUI and animated design patents has increased the frequency with which reissue is sought for these applications. The specification requirements for GUI designs are more demanding than for static product designs because the specification must describe not only what the design looks like but how it transitions between states.

When reviewing a GUI patent for potential reissue, the practitioner should specifically examine whether the specification includes an adequate transitional statement. If the patent shows multiple screen states but the specification does not expressly state the sequential order of transition, this constitutes a correctable error. This type of error has been recognized by examiners as a valid basis for reissue, as demonstrated in the prosecution of application 29/614,296 (Case 4.20).

The practitioner should also confirm that all broken-line elements in the GUI figures are accurately described. GUI designs frequently show the electronic device or display frame in broken lines. If the specification describes these elements inaccurately, for example as "environmental structure" when they are portions of the article itself, this constitutes an independent specification error that may support the reissue or serve as a substitute basis if the original error becomes moot.

For animated or motion-based designs, the practitioner should verify that the specification adequately describes the nature of the animation, including start and end states, and that the figure sequence is internally consistent with the described transition. Inconsistencies between the described transition and the figure order may create ambiguity that renders the patent partly inoperative.

5.16 Double Patenting Screening in Divisional Reissue Practice

The most common scenario for double patenting in design reissue arises when a divisional reissue application is filed to claim a segregable part or subcombination of the originally patented design. Because the divisional's design is derived from the original, the two designs may be closely related and the examiner may find them patentably indistinct.

Practitioners should screen for double patenting exposure before filing a divisional reissue by comparing the new embodiment to the original patented design using the ordinary observer framework. If the new embodiment is essentially the original design with features removed, the risk of a double patenting rejection is significant. If the new embodiment represents a genuinely distinct subcombination, for example a lid design from an original container-and-lid combination, the risk is lower.

The practitioner should also identify any other design patents or pending applications owned by the same assignee that claim related designs. Obviousness-type double patenting can be raised over any commonly owned patent, not just the original patent being reissued. A comprehensive review of the assignee's design portfolio is advisable before filing.

If a double patenting rejection is anticipated, the practitioner should discuss with the client whether a terminal disclaimer is acceptable and, if so, whether the common ownership requirement is likely to remain satisfied throughout the enforcement period. If a terminal disclaimer is not acceptable, the practitioner should consider whether the proposed embodiment can be modified to increase its distinctness from the original design without introducing new matter.

5.17 Recombination of the Original Design with a Subcombination in Design Reissue

A design patent owner who failed to claim a patentably distinct subcombination or segregable part of the original patented design may correct that omission through reissue. Under 35 U.S.C. § 251, the failure to include such a design constitutes a correctable "error." However, because the addition of the subcombination broadens the scope of the patent claim, the reissue application must be filed within two years of the original patent's issuance.

Filing and Restriction

A reissue application that claims both the entire article and the subcombination or segregable part will trigger a restriction requirement under 37 CFR 1.176(b). The added subcombination design will be constructively non-elected and withdrawn from consideration. The examiner will suggest that the applicant file a divisional design reissue application directed to the withdrawn subject matter. *See* MPEP § 1450.

Examination of the Original Claim

The claim to the patented design for the entire article will then be examined. If the original claim is found allowable without amendment, the examiner will reject it under 35 U.S.C. § 251 on the basis that there is no correctable "error" in an unamended original claim. This rejection is procedural rather than substantive. It serves to channel the reissue into the divisional framework necessary for recombination.

Responding to the Section 251 Rejection

A proper response to the rejection must include three elements: (A) a request to suspend action in the original reissue application pending completion of examination of the divisional reissue application; (B) the filing of the divisional reissue application, or a statement that one has already been filed, identified at least by application number; and (C) an argument that a complete response to the rejection has been made based on the filing of the divisional and the request for suspension. The Office will then suspend the original application and proceed with examination of the divisional.

Rejoinder and Recombination

If the divisional design reissue application is found allowable, the applicant must submit a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.153. This waiver permits the rejoining of both designs, the entire article from the original application and the subcombination from the divisional, under a single claim in a single design reissue application. The combined application issues as the original (first-filed) design reissue application.

Limitation: Prior Restriction in the Original Application

This reissue path is not available where the applicant originally included the subcombination in the initial design patent application, a restriction was made during original prosecution, and the applicant failed to file a divisional for the non-elected design before the original patent issued. In that circumstance, the failure to pursue the subcombination is not the type of "error" correctable through reissue. See *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977).

Practitioner Note: The two-year broadening window is critical. Because the addition of a subcombination constitutes a broadening of the original claim scope, practitioners should calendar the two-year deadline from issuance and evaluate early whether subcombination protection is warranted.

5.18 Third-Party Protests Against Pending Reissue Applications

37 C.F.R. § 1.291; MPEP § 1441.01

Third parties may file a protest against a pending reissue application under 37 C.F.R. § 1.291. A protest may include prior art, evidence of public use or sale, or any other information material to patentability of the reissue claims. The protest must be filed before the date the reissue application is published or the date a notice of allowance is mailed, whichever occurs first, unless the protest is accompanied by a service copy to the applicant.

In design reissue practice, protests are most likely to arise where a competitor becomes aware of a broadening reissue that may affect its product line. Because reissue applications are published, competitors monitoring a patent owner's portfolio may identify the reissue and submit prior art directed to the broadened claim scope.

Practitioners filing design reissue applications should be aware of this exposure and should ensure that the reissue claims are supported by a thorough prior art analysis before filing. From the patentee's perspective, the best defense against a protest is a well-prepared application with a complete IDS and a clearly supported correction. From the competitor's perspective, monitoring published reissue applications provides an opportunity to place material prior art before the examiner during prosecution rather than reserving it for litigation.

The existence of protest practice underscores the importance of the pre-filing prior art review recommended in Section 3.65. Art that the patentee identifies and discloses proactively is less likely to be prejudicial than art submitted by a third party in a protest, because the examiner will have had the benefit of the patentee's explanation of relevance.

5.19 Publication of Design Reissue Applications and the Notice Period

35 U.S.C. § 251; 37 C.F.R. § 1.11(b); MPEP § 1441

Reissue applications are published as part of the USPTO's public notice function. Unlike ordinary utility patent applications, which are published 18 months after filing, reissue applications are placed in the public record upon filing and are available for inspection. The

USPTO publishes a notice of the filing of a reissue application in the Official Gazette, identifying the original patent, the patent owner, and the nature of the reissue.

This publication serves a dual purpose. First, it puts the public on notice that the scope of the original patent may change, which is relevant to intervening rights analysis under 35 U.S.C. § 252. Second, it provides third parties with the opportunity to review the pending reissue and, if appropriate, file a protest under 37 C.F.R. § 1.291 or submit prior art for the examiner's consideration.

Practitioners should advise clients that the filing of a reissue application will become public and that competitors will have access to the pending application, including the declaration, proposed amendments, and replacement drawings. This transparency is a feature of the reissue process, not a defect, but it means that the filing package must be prepared with the same rigor and precision as any public filing. Sloppy declarations, internally inconsistent amendments, or overbroad corrections may invite third-party opposition.

From a timing perspective, the publication notice also means that competitors may begin preparing intervening rights defenses as soon as the reissue is published, well before it issues. Patentees pursuing broadening reissue should factor this visibility into their enforcement strategy.

5.20 Continuation Reissue Applications Distinguished from Divisional Reissue Applications

This ProGuide addresses divisional reissue practice in detail because it is the most frequently encountered multi-application reissue scenario in design practice. However, continuation reissue applications also arise and serve a different procedural function. Practitioners should understand the distinction, because the two vehicles carry different consequences for prosecution strategy, declaration requirements, and assignee consent.

Divisional Reissue Applications

A divisional reissue application is filed following a restriction requirement under 37 C.F.R. § 1.176(b). It is directed to subject matter that was constructively non-elected and withdrawn from the parent reissue application. The divisional must identify a distinct error not corrected in the parent. A new assignee consent specific to the divisional is generally required, as discussed in Rule 3.59. The divisional’s declaration must identify an error operative in the divisional application, which may differ from the error identified in the parent.

Continuation Reissue Applications

A continuation reissue application is a reissue application that claims the benefit under 35 U.S.C. § 120 of an earlier-filed reissue application. Unlike a divisional, it is not filed in response to a restriction requirement. A continuation reissue is typically filed when the applicant seeks to pursue a different correction or an alternative claim scope while the parent reissue remains

pending, or when the parent reissue is to be abandoned and the applicant wishes to continue prosecution on a modified basis.

Under 37 C.F.R. § 1.175(f), the declaration requirement for a continuation reissue may be satisfied by a copy of the declaration accepted in the earlier-filed reissue application, provided the error identified in that declaration is still being relied upon. If the error has changed, a new or supplemental declaration is required. Where the parent reissue will be abandoned, a copy of the parent's assignee consent may be accepted for the continuation, unlike the divisional context where a new consent is generally required.

Continuation-in-Part Reissue Applications Are Not Available

A continuation-in-part (CIP) reissue application is not a recognized vehicle in reissue practice. Under 35 U.S.C. § 251, no new matter may be introduced into an application for reissue. A continuation-in-part, by definition, adds new matter not disclosed in the parent application. Because the no-new-matter prohibition is absolute in the reissue context, any application that purports to add subject matter beyond what was disclosed in the original patent would be rejected. Practitioners who identify the need to claim subject matter not supported by the original patent disclosure cannot achieve that result through reissue in any form—whether by direct reissue application, divisional reissue, or continuation reissue. The correction available through reissue is limited to what the original disclosure supports.

Key Practical Differences

The most important practical differences are as follows. First, a divisional reissue arises from restriction practice and is directed to non-elected subject matter. A continuation reissue is a voluntary filing that may pursue the same or overlapping subject matter as the parent. Second, a divisional reissue generally requires a new assignee consent. A continuation reissue where the parent will be abandoned may rely on the parent's consent. Third, both vehicles must comply with 37 C.F.R. § 1.177, which requires that each claim of the original patent appear in each reissue application and that all related reissue applications be identified in the first sentence of the specification. Fourth, a continuation reissue is not itself a mechanism to circumvent the two-year broadening deadline. The continuation must trace its broadening authority to a parent that was timely filed, just as with divisional reissues under Rule 3.37.

Practitioners should evaluate whether a divisional or a continuation is the appropriate vehicle before filing. Where the parent reissue will remain pending and the new application is directed to restricted subject matter, a divisional is appropriate. Where the parent will be abandoned or where prosecution strategy has changed, a continuation may be the better choice. In either case, the declaration, consent, and cross-referencing requirements of 37 C.F.R. § 1.177 must be satisfied.

5.21 Strategic Implications of Abandoning a Reissue Application

Practitioners occasionally file a reissue application and subsequently determine that prosecution should be discontinued, either because the proposed correction is no longer

strategically desirable, because prosecution has generated an unfavorable record, or because intervening developments have made the reissue unnecessary. The question then arises: what are the consequences of abandoning the reissue application?

Effect on the Original Patent

The filing of a reissue application constitutes an offer to surrender the original patent under 35 U.S.C. § 251, but the surrender takes effect only upon issuance of the reissue patent. If the reissue application is abandoned before issuance, the surrender never takes effect. The original patent remains in force as though the reissue had never been filed. The patentee retains all rights under the original patent, and the original patent's term is unaffected.

Prosecution History Estoppel Considerations

The more nuanced question is whether statements made during the abandoned reissue prosecution may later be used against the patentee in litigation to construe the scope of the original patent. The United States District Court for the Eastern District of Pennsylvania addressed this issue in *Junker v. Medical Components, Inc*., No. 16-cv-4112, 2019 U.S. Dist. LEXIS 1530 (E.D. Pa. Jan. 3, 2019), where the court noted that prosecution history estoppel has not been applied to the abandonment of a reissue application. While this decision is instructive, practitioners should note that it is a district court opinion and the Federal Circuit has not squarely addressed this question.

Practitioners should not treat this as an absolute shield. The reissue application file, including the declaration, proposed amendments, and any remarks or arguments, becomes part of the public record upon filing. While the abandonment of the reissue may not formally create estoppel, the contents of the file may be used by litigants or the courts as extrinsic evidence bearing on the patentee's understanding of the patent's scope. A declaration stating that the patent is partly inoperative, for example, could be cited by an accused infringer to argue that the patentee acknowledged a defect in the original patent. Similarly, proposed narrowing amendments that were never adopted could be used to argue that the patentee considered a narrower scope to be the correct one.

For this reason, the decision to file a reissue application should account for the possibility that the application may be abandoned, and the filing package should be prepared with the same care that would apply to a filing the patentee intends to prosecute to issuance. Declarations should be precisely worded. Remarks should be corrective and not argumentative beyond what is necessary. Proposed amendments should not concede more than is required to cure the identified error.

Effect on the Two-Year Broadening Window

If a broadening reissue application is filed within the two-year window and subsequently abandoned, the two-year window is not tolled or extended. Any subsequent reissue application seeking to broaden the patent must independently satisfy the two-year filing requirement. If the window has expired, only non-broadening corrections may be pursued in a new reissue

application. Practitioners contemplating abandonment of a broadening reissue should evaluate whether the two-year window remains open and, if so, whether a continuation reissue should be filed before the parent is abandoned to preserve the broadening option.

Practical Recommendations

Before abandoning a reissue application, the practitioner should consider the following. First, confirm that the original patent will remain in force and that no parallel proceedings depend on the reissue's completion. Second, evaluate whether the reissue prosecution record contains statements that could be used against the patentee in subsequent enforcement actions. Third, assess whether the two-year broadening window is still open and whether a continuation reissue should be filed to preserve future options. Fourth, confirm that no divisional reissue application is pending that depends on the parent reissue's continued prosecution. If a divisional is pending, abandoning the parent may have procedural consequences for the divisional, particularly with respect to the suspension and rejoinder framework described in Section 5.17.

5.22 International Portfolio Considerations

This ProGuide addresses United States design reissue practice exclusively. However, design patents frequently exist as part of international design portfolios that include corresponding Hague registrations, European Community registered designs, individual national registrations, or foreign design patent filings. Practitioners considering a U.S. design reissue should evaluate the potential implications for the broader portfolio.

Reissue Has No Direct Foreign Equivalent

The reissue mechanism under 35 U.S.C. § 251 is a feature of the United States patent system and does not have a direct equivalent in most foreign jurisdictions. Many design registration systems, including the European Union design registration system, the Hague system, and most national design registration regimes, do not provide a post-grant mechanism for correcting the scope of the registered design through a proceeding analogous to reissue. Corrections available in those systems are typically limited to clerical or administrative errors and do not extend to broadening or narrowing the scope of the design as claimed.

As a result, a correction made through U.S. design reissue may create a discrepancy between the scope of the U.S. design patent and the scope of corresponding foreign design registrations. Where the reissue broadens the U.S. patent by converting solid lines to broken lines, for example, the corresponding foreign registrations may remain limited to the original solid-line presentation. Conversely, where the reissue narrows the U.S. patent, the foreign registrations may retain broader scope.

Priority and Filing Date Implications

Where the original U.S. design patent application claimed priority from a foreign application or from a Hague registration designating the United States, the practitioner should confirm that the reissue corrections are supported by the priority document as well as by the U.S.

filing. While the no-new-matter requirement of § 251 is evaluated against the U.S. patent disclosure, discrepancies between the U.S. patent and the priority document may be relevant if the reissue claim's effective filing date is later challenged.

Interaction of Priority Periods with the Two-Year Broadening Window

The two-year broadening window under 35 U.S.C. § 251(d) runs from the grant date of the original U.S. patent. It does not run from the filing date of the original application, the priority date of any foreign application, or the effective registration date of an international design application under the Hague Agreement. The statutory text is explicit: "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."

This means that the six-month priority period under the Paris Convention (Article 4) and the six-month priority period available for Hague designations do not interact with the broadening window in any way that extends or shortens it. A design patent that claims priority from a foreign application filed six months earlier does not receive any additional time for broadening reissue based on that priority relationship. The broadening window is measured exclusively from the U.S. grant date.

Similarly, where the original U.S. design patent issued from a Hague international design application designating the United States, the two-year window runs from the date the USPTO granted the U.S. patent, not from the international registration date or the international filing date. Because there may be a significant gap between the international filing date and the U.S. grant date, practitioners should calendar the broadening deadline from the U.S. grant date specifically and should not rely on calculations based on the international registration.

Practitioners managing international portfolios should confirm the U.S. grant date independently for each patent and calendar the two-year broadening deadline accordingly. Reliance on international filing or registration dates for this purpose will produce an incorrect deadline.

Coordination with Foreign Counsel

Practitioners handling a U.S. design reissue for a client with corresponding foreign design rights should consider notifying foreign counsel of the reissue filing and the nature of the proposed correction. This allows foreign counsel to evaluate whether any analogous correction is available, necessary, or advisable in foreign jurisdictions. In some cases, the identification of an error in the U.S. patent may indicate a parallel error in the foreign registration that could affect enforcement abroad.

Where the reissue broadens the U.S. patent, foreign counsel should assess whether the broader scope can be achieved through other mechanisms in their jurisdiction, such as filing a new design application for the broadened embodiment if the registration period and novelty requirements permit. Where the reissue narrows the U.S. patent, foreign counsel should assess

whether the foreign registrations remain enforceable at their existing scope or whether voluntary limitation is advisable for consistency.

Publication and Competitor Awareness

As discussed in Section 5.19, the filing of a U.S. reissue application is published and becomes part of the public record. Competitors monitoring the patentee's portfolio will have access to the reissue application, including the proposed drawing amendments and the declaration identifying the error. This visibility extends to foreign competitors who may use the information to assess the scope of the patentee's international design portfolio. Practitioners should advise clients that the reissue filing may attract attention to the design portfolio as a whole and should factor this visibility into the overall enforcement and portfolio management strategy.

Reissue of U.S. Design Patents Issued from Hague Designations

Where a U.S. design patent issued from an international design application filed under the Hague Agreement designating the United States (35 U.S.C. §§ 381–390), the patent is subject to reissue under 35 U.S.C. § 251 on the same terms as any other U.S. design patent. Under 35 U.S.C. § 385, an international design application designating the United States has the effect, for all purposes, of an application for patent filed in the USPTO under chapter 16. Accordingly, the reissue filing requirements—including the declaration, specification and drawing requirements, marking conventions, and broadening limitations—apply without modification.

Practitioners should be aware of two additional considerations when filing a reissue for a Hague-originated patent. First, the no-new-matter analysis under § 251 is evaluated against the disclosure contained in the U.S. patent as issued. However, where the correction involves features depicted in the original international registration, the practitioner should confirm that the U.S. patent disclosure and the international registration disclosure are consistent, because discrepancies between the two may be raised if the effective filing date of the reissue claim is later challenged. Second, the filing date for purposes of the two-year broadening window under § 251(d) runs from the grant date of the U.S. patent, not from the effective registration date of the international design application. The practitioner should confirm the applicable grant date and calendar the two-year deadline accordingly.

Additionally, because the international registration may contain multiple designs designated to multiple Contracting Parties, a reissue of the U.S. patent does not affect the status of the international registration or the designations to other Contracting Parties. The correction is limited to the U.S. patent alone.

This ProGuide does not address the procedural requirements of any foreign jurisdiction. Practitioners with international portfolio responsibilities should consult local counsel in each relevant jurisdiction for guidance on available correction mechanisms, enforcement implications, and strategic considerations arising from the U.S. reissue.

5.23 Advancing Examination of Design Reissue Applications

Elimination of Expedited Examination Under Former 37 C.F.R. § 1.155

Prior to 2025, design patent applications, including design reissue applications, could be made special upon petition under 37 C.F.R. § 1.155, commonly referred to as the "Rocket Docket," by filing a request accompanied by the fee under 37 C.F.R. § 1.17(k) and information concerning a pre-examination search of the prior art. This provision had been in effect since September 2000.

Effective April 17, 2025, the USPTO suspended expedited examination of design applications under § 1.155, citing an extraordinary increase in the volume of expedited requests and widespread abuse of micro entity certifications under 37 C.F.R. § 1.29. By fiscal year 2024, nearly 20% of all design applications were filed with requests for expedited examination, representing a 560% increase from the program's early years, when such requests accounted for less than 1% of filings. The surge in volume, combined with a corresponding increase of over 1,400% in expedited applications claiming micro entity status, many of which were found to be erroneous, placed significant strain on examination resources and negatively impacted pendency for all design applicants. *See* Suspension of Expedited Examination of Design Patent Applications, 1533 Off. Gaz. Pat. Office 212 (April 29, 2025).

The USPTO subsequently completed formal rulemaking to permanently eliminate § 1.155 and the associated fee provision at § 1.17(k), effective August 14, 2025. *See* Eliminating Expedited Examination of Design Applications, 90 Fed. Reg. 39124 (Aug. 14, 2025). Both provisions have been removed and reserved. The USPTO has also removed form PTO/SB/27 and decommissioned the corresponding "ROCKET" document code in Patent Center. Requests for expedited examination of design applications filed on or after April 17, 2025 will not be granted, and associated fees will be refunded *sua sponte*.

Practitioners reviewing older MPEP sections, USPTO guidance, or practice materials that reference § 1.155 should be aware that these references are no longer operative. The existing ProGuide reference to the § 1.155 fee at Section 5.14 should be read in light of this elimination.

Remaining Options to Advance Examination

Although expedited examination under § 1.155 is no longer available, design patent applicants, including design reissue applicants, retain limited options to advance examination.

Petition to Make Special Based on Age or Health.

Under 37 C.F.R. § 1.102(c)(1), a petition to make an application special may be filed without a fee where the basis is the applicant's age or health. An applicant who is 65 years of age or older, or whose health is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course, may petition to make special on that basis. *See* MPEP § 708.02, Subsections I and II. This provision applies to design reissue applications because 37 C.F.R. § 1.176(a) subjects reissue applications to the same rules as non-reissue, non-provisional applications except as otherwise provided.

Accelerated Examination Program.

The Accelerated Examination program under 37 C.F.R. § 1.102(a) and MPEP § 708.02(a) remains in effect for design applications. Under this program, an applicant may file a petition to make special with the appropriate showing, including a pre-examination search, an examination support document, and the applicable fee. The requirements are more demanding than the former § 1.155 procedure, which required only a fee and search information. Practitioners considering the Accelerated Examination program for a design reissue should evaluate whether the additional showing requirements can be met and whether the time and cost of preparing the petition are justified by the urgency of the correction. Note that the Accelerated Examination program was discontinued for utility applications effective July 10, 2025, but it remains available for design applications as of the date of this ProGuide.

Prioritized Examination (Track One)

Prioritized examination under 37 C.F.R. § 1.102(e), commonly known as Track One, is available for utility and plant applications but is not currently available for design applications. Because Track One is limited to applications filed under 35 U.S.C. § 111(a) that contain or are amended to contain a method, product, or composition of matter claim, design patent applications do not qualify. This exclusion applies equally to design reissue applications. Practitioners seeking to advance examination of a design reissue should rely on the age or health petition or the Accelerated Examination program rather than the Track One program.

Default Priority for Reissue Applications

Even without a petition to make special, reissue applications are examined in advance of other applications under 37 C.F.R. § 1.176(a). In practice, however, the time from filing to first Office Action in design reissue applications varies depending on art unit workload and the complexity of the filing. The elimination of § 1.155 may increase average pendency for design reissue applications, because the reallocation of examiner resources previously devoted to expedited applications will take time to normalize.

Timing Implications for Practice

The elimination of expedited examination reinforces the importance of filing a complete and compliant reissue application at the outset. Under the former § 1.155 regime, practitioners could obtain rapid first actions, which allowed defects to be identified and corrected relatively quickly. Without expedited examination, defective filings will remain unexamined for longer periods, potentially consuming valuable months of the original patent term. Where the two-year broadening window is approaching, where concurrent litigation makes prompt resolution desirable, or where the original patent term is limited, the inability to accelerate examination makes it even more critical that the filing package is complete, internally consistent, and procedurally compliant when submitted.

Practitioners should also be aware that the elimination of § 1.155 does not affect the filing deadline for broadening reissues. The two-year statutory window under 35 U.S.C. § 251(d) runs from the date of the original patent grant regardless of the availability or unavailability of expedited examination. The filing of the reissue application within the two-year period is what satisfies the statute; the timing of examination thereafter is a separate matter.

5.24 Practice Note on Pre-AIA and Post-AIA: Declaration Requirements in Design Reissue Applications.

The America Invents Act (AIA), signed into law on September 16, 2011, made several changes to the reissue declaration requirements under 35 U.S.C. § 251 and the implementing regulations at 37 C.F.R. §§ 1.63 and 1.175. These changes took effect on September 16, 2012. Because the AIA transition rules are keyed to the filing date of the reissue application itself, and because design patents with pre-AIA original filing dates may remain in force for years after the AIA's effective date, practitioners must understand which set of requirements applies and why.

The Controlling Date: Filing Date of the Reissue Application

The version of 37 C.F.R. § 1.175 (and the corresponding version of 37 C.F.R. § 1.63) that governs the reissue declaration is determined by the filing date of the reissue application itself, not by the filing date or issue date of the original patent being reissued.

Reissue applications filed on or after September 16, 2012 are governed by the AIA versions of 37 C.F.R. §§ 1.63 and 1.175, and by the AIA version of 35 U.S.C. § 251. The appropriate declaration forms are PTO/AIA/05 (declaration by inventor) and PTO/AIA/06 (declaration by assignee).

Reissue applications filed before September 16, 2012 are governed by the pre-AIA versions of those provisions. The appropriate declaration forms for those applications were PTO/SB/51 (declaration by inventor) and PTO/SB/52 (declaration by assignee).

This means that even when the original patent was filed and issued entirely under the pre-AIA regime, the declaration requirements for a reissue application filed today are governed by the AIA rules. Conversely, a reissue application that was filed before September 16, 2012—even if it remains pending—continues to be governed by the pre-AIA rules. See MPEP § 1401 ("In this chapter, for reissue applications filed before September 16, 2012, all references to pre-AIA 35 U.S.C. 251 and 253 and pre-AIA 37 CFR 1.172, 1.175, 1.321, and 3.73 are to the law and rules in effect on September 15, 2012.").

Key Differences Between Pre-AIA and Post-AIA Declaration Requirements

The following summarizes the principal differences between the pre-AIA and post-AIA declaration requirements for design reissue applications.

1. "Without Deceptive Intention" Requirement (Removed)

Pre-AIA: Under pre-AIA 35 U.S.C. § 251, the error in the patent must have arisen "without any deceptive intention." Pre-AIA 37 C.F.R. § 1.175(a)(2) required the declaration to affirmatively state that all errors being corrected "arose without any deceptive intention on the part of the applicant." This statement was required in both the original declaration and in any supplemental declaration filed under pre-AIA 37 C.F.R. § 1.175(b)(1).

Post-AIA: The AIA eliminated the "without deceptive intention" requirement from 35 U.S.C. § 251 entirely. The post-AIA version of 37 C.F.R. § 1.175 does not require any statement regarding deceptive intention. This change applies to all reissue applications filed on or after September 16, 2012, regardless of when the original patent was filed or issued.

2. "Original and First Inventor" Statement (Removed)

Pre-AIA: Under pre-AIA 37 C.F.R. § 1.63(a)(4), the declaration was required to state that "the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought." Omission of this recitation rendered the declaration defective.

Post-AIA: The AIA revised 35 U.S.C. § 115 to eliminate this requirement. Under post-AIA 37 C.F.R. § 1.63, the declaration requires only that the person executing it has reviewed and understands the contents of the application and is aware of the duty to disclose information material to patentability under 37 C.F.R. § 1.56. No statement regarding "original and first inventor" is required.

3. Citizenship Identification (Removed)

Pre-AIA: Under pre-AIA 37 C.F.R. § 1.63(a)(3), the declaration was required to "identify the country of citizenship of each inventor." Failure to include this information was a defect in the declaration.

Post-AIA: The AIA removed the citizenship requirement from 35 U.S.C. § 115. Post-AIA 37 C.F.R. § 1.63 does not require identification of inventor citizenship in the declaration. Citizenship information may still appear on the Application Data Sheet, but its omission from the declaration is not a defect.

4. Willful False Statements Acknowledgment (Removed from Declaration)

Pre-AIA: Pre-AIA 37 C.F.R. § 1.63 required the declarant to acknowledge that willful false statements may jeopardize the validity of the application or any patent issuing thereon, and to state that all statements made of the declarant's own knowledge are true and all statements made on information and belief are believed to be true.

Post-AIA: These acknowledgment requirements were eliminated from the declaration itself. The penalty provisions under 18 U.S.C. § 1001 remain operative by operation of law, but the declaration is no longer required to contain these specific recitations.

5. Supplemental Declaration Requirements

Pre-AIA: Under pre-AIA 37 C.F.R. § 1.175(b)(1), a supplemental declaration was required before allowance for any error corrected that was not covered by a previously submitted compliant declaration. Critically, this supplemental declaration was also required to include the "without deceptive intention" statement. In broadening reissue applications, both the original and any supplemental declarations had to be signed by all inventors. See In re Hayes, 53 USPQ2d 1222 (Comm'r Pat. 1999).

Post-AIA: Under post-AIA 37 C.F.R. § 1.175(d), when errors previously identified in the declaration are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon. However, the identification of a new error may be made conspicuously and clearly in the remarks section of a reply, and submission of a supplemental declaration may be deferred until allowance. See MPEP § 1444. The "without deceptive intention" statement is not required in any supplemental declaration filed in a post-AIA reissue.

6. Who May Sign the Declaration in a Broadening Reissue

Pre-AIA: Under pre-AIA 35 U.S.C. § 251 (third paragraph) and pre-AIA 37 C.F.R. § 1.172, the assignee of the entire interest could sign the declaration only if the reissue did not seek to enlarge the scope of the claims. In broadening reissues, all inventors were required to sign the declaration, with limited exceptions under pre-AIA 37 C.F.R. § 1.47.

Post-AIA: Under post-AIA 37 C.F.R. § 1.175(c), the assignee of the entire interest may sign the declaration for a broadening reissue if the application for the original patent was filed by the assignee under 37 C.F.R. § 1.46. If the original application was filed by the inventors (as is the case for the majority of design patent applications), the inventors must still sign the broadening reissue declaration. Additionally, the post-AIA rules provide for the use of a substitute statement under 37 C.F.R. § 1.64 where an inventor is deceased, legally incapacitated, cannot be found after diligent effort, or refuses to sign.

7. Substitute Statements

Pre-AIA: Pre-AIA practice did not provide for substitute statements in reissue applications. Where an inventor refused to sign or could not be located, the applicant was required to proceed under pre-AIA 37 C.F.R. § 1.47.

Post-AIA: Post-AIA 37 C.F.R. § 1.64 permits a substitute statement in lieu of the inventor's oath or declaration in reissue applications where the inventor is deceased, legally incapacitated, cannot be found or reached after diligent effort, or refuses to execute the declaration. The patentee or current patent owner may file the substitute statement. See MPEP § 604.

Why Pre-AIA Declaration Requirements May Still Be Encountered

Because the controlling date is the filing date of the reissue application, and because no reissue application can be newly filed before September 16, 2012, the pre-AIA declaration requirements will never apply to any newly filed reissue application. Every reissue application filed today is governed by the post-AIA rules, even if the underlying patent was filed and issued entirely under the pre-AIA regime.

However, practitioners may still encounter the pre-AIA requirements in the following contexts:

1. Pending pre-AIA reissue applications. Although increasingly rare, a reissue application filed before September 16, 2012 that remains pending—for example, due to suspension, appeal, or extended prosecution—is still governed by the pre-AIA rules. Any supplemental or new declaration filed in such an application must comply with the pre-AIA requirements, including the "without deceptive intention" statement.

2. Prosecution history review. When reviewing the prosecution history of a reissued patent for claim construction, enforcement, or validity analysis, practitioners will frequently encounter pre-AIA declarations in patents that were reissued before or shortly after the AIA transition. Understanding the pre-AIA requirements is necessary to evaluate whether the declaration was compliant at the time it was filed.

3. Case law and prosecution examples. Many of the published prosecution examples cited in this ProGuide, as well as a substantial body of case law addressing reissue declaration defects, arise from pre-AIA filings. Several of the declaration defects discussed in Section 4—including failure to state that the inventor is the "original and first inventor" (Case 4.1), failure to identify citizenship (Case 4.8), and the "without deceptive intention" requirement (Cases 4.10, 4.11)—are specific to pre-AIA practice and would not arise under the current rules. These examples remain instructive for understanding the principles of declaration specificity and compliance, but practitioners should not apply the pre-AIA-specific requirements to reissue applications filed under the current rules.

4. Older design patents still in force. Design patents issued from applications filed before September 16, 2012 carry a 14-year term from the date of grant. A design patent that issued on, for example, September 15, 2014 (from a pre-AIA application) would not expire until September 15, 2028. Such a patent may still be the subject of a non-broadening reissue (the two-year broadening window having long since closed). Any reissue application filed for such a patent today would be governed by the post-AIA declaration rules, because the filing date of the reissue application controls. The pre-AIA origin of the underlying patent does not change the applicable declaration requirements.

Practical Guidance

1. Always use the current (post-AIA) declaration forms for any reissue application filed today. Use Form PTO/AIA/05 (declaration by inventor) or Form PTO/AIA/06 (declaration by assignee). Do not use the retired Forms PTO/SB/51 or PTO/SB/52.

2. Do not include pre-AIA-specific recitations in a post-AIA declaration. A post-AIA reissue declaration does not need to state that the error arose "without deceptive intention," does not need to identify inventor citizenship, and does not need to include the "original and first inventor" statement. Including these recitations is not harmful, but their omission is not a defect.

3. If reviewing or taking over prosecution of a pre-AIA reissue, apply the pre-AIA requirements. In the rare event that a practitioner inherits a still-pending reissue application filed before September 16, 2012, all declaration requirements must comply with the pre-AIA versions of 37 C.F.R. §§ 1.63 and 1.175, including the "without deceptive intention" statement in any supplemental declaration.

4. When reading prosecution history examples in this ProGuide, note whether the application was pre-AIA. Applications identified as "(Pre-AIA)" in Section 4 were filed before September 16, 2012 and reflect pre-AIA declaration requirements. The declaration defects identified in those cases may not be applicable under current rules. The underlying principles of specificity, internal consistency, and jurisdictional compliance remain fully applicable regardless of the AIA transition.

5. The remaining substantive requirements of 37 C.F.R. § 1.175 are unchanged. Both the pre-AIA and post-AIA versions of § 1.175 require that the declaration specifically identify at least one error in the patent being relied upon as the basis for reissue and state that the applicant believes the original patent to be wholly or partly inoperative or invalid. The specificity requirements discussed throughout this ProGuide—including the rules addressing particularity of error identification, internal consistency, and correspondence between the declaration and the proposed amendments—apply with equal force under both regimes.

Summary of AIA Declaration Changes

The following summarizes the key differences. The controlling date for determining which requirements apply is the filing date of the reissue application.

Requirement	Pre-AIA	Post-AIA
"Without deceptive intention"	Required	Not required
"Original and first inventor"	Required	Not required
Inventor citizenship	Required	Not required
Willful false statements acknowledgement	Required	Not required
Substitute statement (§ 1.64)	Not available	Available
Assignee may sign broadening decl.	Not permitted	If original filed under § 1.46
Error specificity requirement	Required	Required (unchanged)
Applicable declaration forms	PTO/SB/51, 52	PTO/AIA/05, 06

Cross-References Within This ProGuide

The following Sections and Cases in this ProGuide address declaration requirements that are affected by the AIA transition. Where a case or rule is identified as reflecting pre-AIA

practice, practitioners should apply the corresponding post-AIA requirement when filing under the current rules:

Rule 3.25 (Declaration defective for omitting required recitations): Lists citizenship and "original and first inventor" as defects. These are pre-AIA requirements only. Post-AIA declarations are not required to include either recitation.

Case 4.1 (Application 29/181,535): Declaration defective for omitting "original and first inventor" and citizenship. Pre-AIA application. These defects would not arise under current rules.

Case 4.8 (Application 29/266,846): Declaration allegedly defective for failure to identify citizenship. Pre-AIA application. This requirement no longer applies.

Case 4.10 (Application 29/286,205): Declaration defective for omitting "original and" from "original and first inventor" and for using "material to examination" rather than "material to patentability." Pre-AIA application. The "original and first inventor" requirement is no longer applicable. The duty-to-disclose language requirement remains applicable under 37 C.F.R. § 1.63(c).

Case 4.11 (Application 29/365,400): Declaration defective for failure to state that the inventor is the "original and first inventor." Pre-AIA application. This specific defect would not arise under current rules.

Section 5.12.1 (Assignee filing exception under § 1.46): The post-AIA version of § 1.46 is broader than the pre-AIA version in terms of who may file as applicant, but the practical analysis for design reissue purposes remains the same—the inquiry is whether the assignee was identified as the applicant at the time of filing the original application.

Section 5.12 (Consent and declaration requirements): The consent requirement under 37 C.F.R. § 1.172 was also revised by the AIA, but the core principle—that all assignees owning an undivided interest must consent—remains substantively the same under both regimes.

Note: This Practice Note is current as of the date of last update of this ProGuide. The AIA transition rules for reissue declarations have remained stable since September 16, 2012. Unless Congress or the USPTO further amends 35 U.S.C. § 251 or 37 C.F.R. §§ 1.63 and 1.175, the framework described in this Practice Note will continue to govern.

5.25 Interaction Between Design Reissue and PTAB Proceedings

The filing of a design reissue application may intersect with inter partes review (IPR), post-grant review (PGR), or other proceedings before the Patent Trial and Appeal Board (PTAB). Although these proceedings are governed by separate statutory frameworks, they may affect the same patent simultaneously, and practitioners must account for their interaction when planning reissue strategy.

Duty to Disclose Concurrent PTAB Proceedings

Under 37 C.F.R. § 1.178(b), the applicant has a continuing duty to call to the attention of the USPTO any prior or concurrent proceedings in which the patent being reissued is or was involved, including trials before the Patent Trial and Appeal Board. This duty extends to IPR and PGR proceedings, whether instituted or pending at the petition stage. The results of any such proceedings must also be disclosed. *See* Rule 3.15. Where an IPR or PGR is filed after the reissue application is pending, the applicant must promptly notify the examiner.

Timing Considerations

The timing windows for IPR and PGR operate differently and must be distinguished. For patents subject to the first-inventor-to-file provisions of the AIA, a petition for post-grant review under 35 U.S.C. § 321 must be filed no later than nine months after the date of the grant of the patent or the issuance of a reissue patent. After that nine-month window closes, PGR is no longer available. A petition for inter partes review under 35 U.S.C. § 311 may not be filed until the later of: (1) nine months after the grant of the patent or issuance of a reissue patent, or (2) if a PGR proceeding has been instituted, the date of termination of that proceeding. In effect, IPR becomes available after the PGR window expires.

The issuance of a reissue patent is significant for both windows. A reissue patent opens a new nine-month PGR window measured from the date of the reissue grant, during which PGR petitions may challenge the reissue claims. Once that new PGR window closes, IPR petitions directed to the reissue claims become available. This means that a broadening reissue may expose the patent to PGR challenges that would not have been available against the original patent if its own PGR window had already expired.

Practitioners filing broadening reissue applications should be aware that the broadened claims may attract both PGR and IPR petitions that the original narrower claims would not have invited. The prior art landscape relevant to the broadened scope should be evaluated during the pre-filing analysis described in Section 3.65, and the IDS should reflect this expanded analysis. The practitioner should also advise the client that the issuance of the reissue patent will open new PTAB challenge windows and should factor this exposure into the enforcement strategy.

Concurrent Reexamination and Reissue

Where an ex parte reexamination under 35 U.S.C. §§ 301–307 is pending concurrently with a reissue application for the same patent, the two proceedings may be subject to merger under MPEP § 1451. The USPTO's established practice is to merge the reexamination and reissue proceedings into a single proceeding to avoid inconsistent determinations on the same patent claim.

Merger practice operates as follows. When the USPTO becomes aware that both a reexamination and a reissue application are pending for the same patent, the examiner assigned to one proceeding will typically initiate coordination with the examiner assigned to the other. Under MPEP § 1451, the reexamination and the reissue are merged, with the merged proceeding

conducted under the reissue application number. The reexamination proceeding is effectively absorbed into the reissue, and examination continues under the reissue framework. The merged proceeding must address all issues raised in both the reexamination and the reissue, including any prior art cited in the reexamination request and any errors identified in the reissue declaration.

Practitioners should be aware of several practical implications. First, the duty to disclose concurrent proceedings under 37 C.F.R. § 1.178(b) requires that the applicant notify the examiner of the existence of the reexamination in the reissue application, and vice versa. This disclosure obligation is continuing and extends to the results of each proceeding. Second, if the reexamination results in a cancellation of the patent claim before the reissue is resolved, the reissue application may become moot with respect to that claim, although a divisional reissue directed to a different embodiment may survive. Third, prior art cited in the reexamination request becomes part of the record in the merged proceeding and must be considered by the examiner during reissue examination.

The timing of merger may affect prosecution strategy. If the practitioner anticipates that a reexamination may be requested—for example, because the patent is the subject of pending litigation and the opposing party has identified potentially invalidating prior art—the practitioner should consider whether filing the reissue before or after the reexamination request affects the procedural posture of the merged proceeding. In general, filing the reissue first establishes the corrective framework within which the reexamination issues will be addressed, whereas filing the reissue after a reexamination has been initiated may result in the reissue being absorbed into an already-structured reexamination proceeding.

Because ex parte reexamination is the only reexamination vehicle currently available for design patents (inter partes reexamination having been replaced by inter partes review for patents issuing from applications filed on or after November 29, 1999, per 35 U.S.C. § 311), the concurrent proceeding scenario most likely to arise in design practice is an ex parte reexamination filed by a third party during the pendency of a reissue application. Practitioners should plan for this possibility when filing broadening reissue applications, particularly where the broadened scope may attract prior art challenges.

Practitioners should note that inter partes review under 35 U.S.C. § 311 is not statutorily limited to utility patents. The IPR statute applies to any patent, including design patents, and the PTAB has accepted and instituted IPR petitions challenging design patent claims. *See, e.g., Campbell Soup Co. v. Gamon Plus, Inc.,* IPR2017-00091 (PTAB 2017). However, IPR petitions directed to design patents remain relatively uncommon compared to utility patent IPRs. This is due in part to the visual, impression-based nature of design patent invalidity analysis, which can be more difficult to present effectively within the structured briefing and evidentiary framework of an IPR proceeding. Additionally, the prior art basis for IPR is limited to patents and printed publications under §§ 102 and 103, which may not capture the full range of prior art relevant to a design patent claim.

The reference to ex parte reexamination as the reexamination vehicle most likely to arise in concurrent proceedings with a design reissue reflects practical frequency rather than statutory

exclusivity. Where a design reissue broadens claim scope, the practitioner should consider the possibility that a competitor may file either an ex parte reexamination request or an IPR petition directed to the broadened claims, and should evaluate the prior art landscape accordingly. The strategic implications of each proceeding differ: an ex parte reexamination may be merged with the pending reissue under MPEP § 1451, whereas an IPR is conducted before the PTAB under a separate procedural framework and may result in a stay of the reissue proceedings.

Potential Suspension or Stay of Reissue Prosecution

Where a reissue application and a PTAB trial involve the same patent, the PTAB has authority under 37 C.F.R. § 42.3 to take exclusive jurisdiction over the patent during the proceeding. In practice, the Board has stayed concurrent reexamination proceedings and may similarly stay or suspend a pending reissue application to avoid duplicative or inconsistent determinations. Practitioners should anticipate that a concurrent IPR may delay the resolution of a pending reissue. Conversely, if a reissue is well advanced when an IPR petition is filed, the PTAB may consider the advanced state of the reissue in its institution decision under the discretionary factors of 35 U.S.C. § 325(d).

Strategic Considerations

The interaction between reissue and PTAB proceedings raises several strategic questions that should be addressed at the pre-filing stage. First, if the patentee is aware of a potential or pending IPR challenge, filing a broadening reissue may expand the attack surface by creating broader claims that are more vulnerable to prior art. Second, if the PTAB cancels the original patent claim in an IPR, the reissue application directed to that claim may become moot, although a divisional reissue directed to a different embodiment may survive. Third, arguments and amendments made during reissue prosecution become part of the prosecution history and may be cited by a PTAB petitioner in a subsequent IPR to support claim construction or invalidity arguments. Fourth, a patent owner's ability to amend claims in an IPR under 37 C.F.R. § 42.121 is distinct from and more limited than the correction available through reissue, but the two mechanisms may affect the same patent and should be evaluated together when both options are available.

Practitioners should coordinate reissue prosecution and PTAB defense as part of a unified patent strategy, particularly where enforcement litigation is pending or anticipated.

5.26 Certificate of Correction Distinguished from Reissue

Before filing a reissue application, the practitioner should evaluate whether the error in the patent can be corrected through a simpler mechanism: a certificate of correction under 35 U.S.C. § 254 (for USPTO mistakes) or 35 U.S.C. § 255 (for applicant's mistakes). A certificate of correction is faster, less expensive, and does not create a new prosecution history. However, its scope is limited, and many errors that arise in design patent practice exceed what a certificate can correct.

Scope of Certificate of Correction Under 35 U.S.C. § 255

A certificate of correction for an applicant's mistake may issue only where the mistake is (1) of a clerical or typographical nature, or of minor character, (2) occurred in good faith, and (3) the correction does not involve changes that would constitute new matter or require re-examination. See MPEP § 1481; In re Arnott, 19 USPQ2d 1049 (Comm'r Pat. 1991). The critical limitation is that the correction may not affect claim scope. In design patent practice, because the drawings define the claim, any drawing change that alters the visual scope of the design—including converting solid lines to broken lines, modifying surface shading, adding or removing boundary lines, or altering the proportions of a depicted feature—goes beyond what a certificate of correction can accomplish.

When Certificate of Correction Is Appropriate

A certificate of correction is generally appropriate for errors in the specification that do not affect the scope of the claimed design. Examples include correcting a typographical error in the patent number of a related application cited in the specification, fixing an incorrect inventor address or assignee name, correcting a misspelled word in a figure description that does not change the meaning of the description, and correcting a clerical error in a priority claim reference. These are errors that are manifest from the patent record and do not require substantive re-examination of the design.

When Reissue Is Required

Reissue under 35 U.S.C. § 251 is required when the error renders the patent wholly or partly inoperative or invalid and the correction would affect the substance of the patent. In design patent practice, this includes any correction that changes the visual appearance or scope of the claimed design, adds or removes claimed features, corrects inconsistencies between drawing figures that affect how the design is understood, corrects inaccurate broken-line characterizations that bear on what is claimed, or adds a previously unclaimed embodiment. As discussed throughout this ProGuide, even seemingly minor drawing adjustments may materially broaden or narrow the scope of a design patent claim.

The Boundary in Practice

The boundary between certificate-correctable errors and reissue-required errors in design patents is often narrower than in utility patents. Because the design patent's single claim is defined entirely by its drawings, almost any change to the drawings implicates claim scope and thus falls outside the reach of a certificate of correction. The MPEP confirms that "usually, any mistake affecting claim scope must be corrected by reissue." MPEP § 1481. Practitioners who are uncertain whether an error can be corrected by certificate should default to reissue, because a certificate of correction that improperly alters claim scope may be challenged as exceeding the authority of 35 U.S.C. § 255.

Where a patent contains both a certificate-correctable error and a reissue-required error, both corrections may be included in the reissue application. A certificate of correction cannot, however, substitute for reissue when a § 251 error exists. See MPEP § 1402.

5.27 Ex Parte Appeals in Reissue Prosecution

Under 37 C.F.R. § 1.179, an applicant in a reissue proceeding has the same right of appeal to the Patent Trial and Appeal Board as an applicant in a non-reissue application. Because 37 C.F.R. § 1.176(a) subjects reissue applications to the same rules as non-reissue, non-provisional applications except as otherwise provided, the procedures for ex parte appeal under 37 C.F.R. §§ 41.31–41.54 apply to reissue prosecution.

In practice, however, the decision to appeal a rejection in a reissue application requires a different strategic calculus than in ordinary prosecution. The most frequently maintained rejection in design reissue practice is the rejection under 35 U.S.C. § 251 for a defective declaration. As the prosecution examples in Section 4 demonstrate, declaration defects are typically curable by filing a new or corrected declaration rather than by arguing that the examiner's rejection is legally incorrect. Where the rejection is based on insufficient specificity, missing statutory affirmations, or internal inconsistency between the declaration and the amendments, the most efficient path is almost always correction rather than appeal.

Appeal may be appropriate in narrower circumstances. First, where the examiner has rejected the reissue on the ground that no correctable error exists under § 251, and the applicant believes a legitimate statutory error has been identified and properly declared. This situation most commonly arises when the examiner takes the position that a particular drawing or specification defect does not rise to the level of rendering the patent partly inoperative or invalid. Second, where the examiner has maintained a new matter rejection under § 251 and § 112(a), and the applicant contends that the proposed correction is fully supported by the original disclosure. Third, where the examiner has rejected the reissue on recapture grounds and the applicant disputes the examiner's characterization of the original prosecution history or the scope of the alleged surrender.

Before filing an appeal brief, the practitioner should consider whether the time and cost of the appeal are justified in light of the remaining patent term. Because design patent terms are finite and reissue applications already receive priority in examination under 37 C.F.R. § 1.176(a), an appeal that consumes a year or more of Board pendency may significantly diminish the practical value of the correction being sought. The practitioner should also consider whether continued prosecution through a request for continued examination (RCE) or a new declaration filing would resolve the rejection more efficiently.

Additionally, the practitioner should be aware that the appeal brief and the Board's decision become part of the permanent prosecution history of the reissued patent. Arguments made on appeal may be cited in subsequent litigation for claim construction or enforcement purposes. This is consistent with the general principle, discussed in Sections 1 and 5.11, that reissue creates a new prosecution history with substantive downstream consequences.

Where an appeal is taken, the brief should focus on the legal standard for the rejection at issue. For § 251 error rejections, the brief should address the threshold question of whether the identified defect renders the patent partly inoperative or invalid, citing the specific drawings and

features at issue. For new matter rejections, the brief should identify the specific support in the original disclosure for each element of the proposed correction, applying the written description standard of In re Owens where boundary lines are involved. For recapture rejections, the brief should apply the three-step framework of *In re Mostafazadeh* and demonstrate that the broadening does not target surrendered subject matter.

5.28 Reissue as a Tool to Address Prosecution History Disclaimer in Design Patents

Reissue practice may be used to correct errors in the specification or drawings that give rise to unintended prosecution history disclaimer. In design patents, disclaimer most commonly arises from amendments to broken-line statements, feature descriptions, article identifications, or arguments distinguishing prior art based on specific visual features.

Where the originally issued patent contains language that narrows the apparent scope of the claimed design beyond what was intended, reissue may be appropriate if the narrowing resulted from error and the statutory requirements of 35 U.S.C. § 251 are satisfied. However, practitioners must carefully analyze whether the proposed correction would constitute impermissible recapture of subject matter deliberately surrendered to secure allowance.

Reissue cannot erase deliberate narrowing arguments made to overcome prior art. It may, however, correct objectively erroneous descriptive language or clarify ambiguities that create unintended narrowing effects. Because prosecution history is routinely used in claim construction and infringement analysis, practitioners should evaluate potential disclaimer consequences when auditing issued design patents for reissue suitability.

Appendix 1
Design Reissue Filing Checklist

This checklist is intended for disciplined pre-filing review. Each item should be affirmatively confirmed before submission of a design reissue application.

I. Statutory Basis

☐ At least one specific error under 35 U.S.C. § 251 has been identified.
☐ The error falls within one of the statutory categories:
- Defective specification
- Defective drawing
- Claiming more than entitled
- Claiming less than entitled

☐ The error renders the patent wholly or partly inoperative or invalid.
☐ The declaration explains why the error existed at the time of issuance.

II. Broadening Analysis

☐ The application has been analyzed to determine whether it enlarges scope.
☐ If broadening, the application is filed within two years of original grant.
☐ Conversion of solid lines to broken lines has been evaluated for recapture.
☐ Shading removal or modification has been evaluated for scope impact.
☐ Boundary changes have been visually compared against the issued patent.
☐ Title amendments have been screened for enlargement of the article class.
☐ The original prosecution history has been reviewed in full for surrender-generating limitations (SGLs), including amendments made or arguments presented to overcome prior art rejections.
☐ Each proposed broadening change has been compared against any identified SGLs to confirm that the broadening does not target the same subject matter that was surrendered.
☐ If the broadening relates to or overlaps with surrendered subject matter, the three-step recapture analysis under In re Mostafazadeh has been documented, including an assessment of whether the reissue claims are materially narrowed relative to the surrendered subject matter.

III. Recapture Screening

☐ The prosecution history review and recapture analysis required by Section II items above have been completed and documented.
☐ No deliberate surrender during original prosecution is being reversed by the proposed broadening.
☐ If the broadening implicates surrendered subject matter, the reissue claims have been materially narrowed relative to the surrendered subject matter, and the narrowing has been documented with reference to specific visual features.

☐ The recapture analysis has been preserved in the work file for future reference in the event of a recapture rejection or litigation challenge.

IV. New Matter Review

☐ No new structural features are introduced.
☐ No new contours or surfaces appear that were absent in the original patent.
☐ Added views do not disclose previously undisclosed three-dimensional form.
☐ Specification amendments do not introduce new descriptive content.

V. Declaration Compliance

☐ The declaration identifies the patent number and issue date.
☐ The declaration identifies the specific error with particularity.
☐ The declaration aligns precisely with the amendments being made.
☐ The declaration is self-contained and does not rely on remarks.
☐ If signed by an assignee, full ownership of the entire interest has been confirmed.
☐ A 37 C.F.R. § 3.73 statement is included where required.

VI. Drawing Compliance

☐ The entire set of original drawings is included.
☐ Replacement sheets are properly labeled.
☐ Canceled figures are bracketed and labeled.
☐ Added figures are sequentially numbered.
☐ Figure descriptions correspond exactly to the amended drawings.
☐ Broken-line explanations are included where required.

VII. Specification Marking

☐ All deletions are shown in brackets.
☐ All additions are underlined.
☐ Amendments are made relative to the patent as issued.
☐ Canceled drawing views are reflected in the specification.

VIII. Divisional Reissue (If Applicable)

☐ The divisional identifies a distinct error not corrected in the parent.
☐ The omitted embodiment is identified by specific figure number.
☐ The declaration corresponds to the correction pursued in this application.

IX. Internal Consistency

☐ Title, claim, drawings, and figure descriptions are fully consistent.
☐ The ADS matches inventorship and ownership.
☐ The transmittal correctly identifies whether the reissue enlarges scope.

X. Duty of Disclosure

☐ A prior art search has been conducted or updated in light of the reissue claim scope.
☐ An IDS has been prepared citing all known material references, including art from litigation, licensing, or post-issuance searching.
☐ References previously cited during original prosecution have been re-evaluated for materiality to the reissue claims.
☐ If the reissue is broadening, additional prior art that may be material to the expanded scope has been identified and disclosed.
☐ All individuals substantively involved in the reissue preparation have been reminded of their duty under 37 C.F.R. § 1.56.
☐ Written reminders of the 37 C.F.R. § 1.56 duty have been circulated to all substantively involved individuals, and the circulation has been documented in the work file.

XI. Post-Issuance

☐ Product marking has been updated to reflect the reissued patent number.
☐ Virtual marking web pages have been updated (if applicable).
☐ Pending litigation pleadings have been reviewed for amendment.
☐ IP management systems and assignment records have been updated.
☐ License and encumbrance agreements have been reviewed for coverage of the reissued patent.
☐ Intervening rights exposure has been assessed for the broadened scope (if applicable).

Appendix 2
Questions and Answers

This Appendix addresses recurring practitioner questions in design reissue prosecution.

Q1: Is a drawing change automatically a proper basis for reissue?

A: No. A drawing change is proper only if it corrects a statutory error under § 251. The declaration must explain why the original drawing rendered the patent wholly or partly inoperative or invalid. A preference for a different presentation, improved aesthetics, or modernized drafting style is not sufficient. Even an examiner-identified drawing defect does not automatically qualify as a § 251 error; the defect must actually render the patent partly inoperative or invalid. See Rules 3.1, 3.9, and 3.34; Section 5.4 (Examiner-Identified Errors During Prosecution).

Q2: If an examiner required a narrowing amendment during original prosecution, can that amendment be reversed in reissue?

A: Not automatically. If the original amendment was made to overcome a rejection or secure allowance, reversal may implicate the recapture doctrine under In re Mostafazadeh and North American Container. The three-step recapture analysis requires determining (1) whether subject matter was deliberately surrendered, (2) whether the broadened reissue claim is materially narrower in other respects, and (3) whether the broadening relates to the same area as the surrender. If broadening targets the surrendered subject matter, the reissue is barred regardless of other narrowing. Recapture is independent of the two-year broadening deadline. See Rule 3.62 and Section 5.10.

Q3: Does removing surface shading always broaden a design?

A: Not always, but often. Shading defines contour and form. Removing shading may enlarge scope if the amended design would cover embodiments that would not have infringed the original patent. The analysis is visual and impression-based. Conversely, inaccurate shading that does not correctly represent the contours of the design can itself constitute a correctable error supporting reissue, even if it would not independently support a § 112 rejection. See Rules 3.4 and 3.34.

Q4: Must the entire original specification and drawings be included in a reissue filing?

A: Yes. Under 37 C.F.R. § 1.173(a), a reissue application must contain the complete specification and all drawing views of the original patent, even if some are being canceled or amended. The USPTO will not transfer drawings from the original patent file to the reissue application. A clean copy of each drawing sheet must be submitted at the time of filing. See Rule 3.5.

Q5: Can a reissue be filed to improve visual claim presentation strategy?

A: No. Reissue is corrective, not strategic. It is not a mechanism to redesign the invention, reposition the visual scope of the claim, modernize the drawing presentation, or recharacterize the claimed design beyond what the original disclosure supports. Because the single claim in a design patent is defined entirely by the drawings, any change to the visual presentation must correct an identified error—not implement a preferred drafting approach that the applicant wishes it had adopted originally. Examiners consistently allow correction of errors but will not permit strategic redesign of the claimed appearance. See Section 1 (Introduction) and Section 5.9.

Q6: What happens if a new error is discovered during reissue prosecution?

A: A supplemental declaration must be filed before allowance covering any additional errors not identified in the original declaration. Under 37 C.F.R. § 1.175(b)(1), where amendments are made after the original declaration was executed, the supplemental declaration must cover any errors corrected by those amendments that are not already addressed. However, if the original declaration was fatally defective (e.g., missing required statutory affirmations), a completely new declaration is required rather than a supplement. See Rules 3.23 and 3.28; Section 5.2 (When a Supplemental Declaration Is Required and When It Is Not Enough).

Q7: Does filing a reissue immediately surrender the original patent?

A: No. Under 35 U.S.C. § 251, filing the reissue application constitutes an offer to surrender, but the surrender takes effect only upon issuance of the reissue patent. Until then, the original patent remains in full force and effect. The patentee retains all enforcement rights under the original patent during pendency of the reissue. See Rule 3.14 and Section 5.13.

Q8: Can a broadening reissue be filed after two years if the error was discovered later?

A: No. The two-year limit for broadening reissues under 35 U.S.C. § 251(d) is strict and jurisdictional. Discovery timing does not extend the statutory window. After expiration, only non-broadening corrections are permitted. However, a divisional reissue filed after the two-year period may contain broadened claims if the parent reissue was filed within the two-year window and contained the intent to broaden. See Rules 3.4 and 3.37.

Q9: If the declaration is defective, can it be corrected later?

A: It depends on the nature of the defect. If the original declaration was facially proper but did not cover subsequent amendments, a supplemental declaration may suffice. However, if the original declaration omitted required statutory affirmations, used non-standard duty-to-disclose language, or referenced nonexistent attachments, a completely new declaration is required. A supplement cannot supply missing statutory affirmations that were never made. A promise to file a proper declaration later is also not sufficient—the rejection remains active until a compliant declaration is actually filed. See Rules 3.28, 3.35, and Section 5.2.

Q10: Does a reissue create a new prosecution history?

A: Yes. Statements and amendments made during reissue become part of the prosecution history and may later affect enforcement through estoppel or disclaimer principles. Arguments made to justify broadening or narrowing may be used in claim construction. This new prosecution history carries substantive downstream consequences for enforcement strategy. See Sections 1 and 5.11.

Q11: Can a reissue declaration be amended by bracketing the original error statement and submitting revised language on a separate sheet?

A: No. There is no provision in reissue practice for amending the error statement in a declaration by bracketing original language and underlining revised language as one would amend specification text. The USPTO will treat such a submission as an addition to the specification rather than as an amendment to the declaration, leaving the original defective declaration in force. To correct a defective error statement, the applicant must file a completely new, properly executed declaration containing the corrected language. See Rule 3.45 and Cases 4.18 and 4.30.

Q12: What level of specificity is required in the reissue declaration for a design patent?

A: The declaration must identify the error by reference to the specific drawings and the specific drawing features where the error lies. A vague statement such as “incorrect drawings were submitted” or “the patentee claimed more than they had a right to claim” without identifying the specific feature or area is insufficient. The declaration must name the particular element being added or removed from the claim and explain how the error renders the patent partly inoperative or invalid. The error must be stated in words in the body of the declaration—reproducing drawings with bracket and underline markings is not sufficient per In re Constant. See Rules 3.22, 3.32, 3.41, 3.54, 3.56, 3.60, and 3.61.

Q13: When an assignee signs the reissue declaration, what ownership requirements apply?

A: The assignee must own the entire interest in the patent, including the interest of any newly added inventor. If an inventor is being added and has not assigned their portion to the assignee, the assignee is only a part-owner and cannot execute the declaration. In that situation, either an assignment from the added inventor must be obtained, or all inventors must sign individually. Additionally, the consent requirement under 37 C.F.R. § 1.172 and the declaration execution authority under 37 C.F.R. § 1.175(c) are separate obligations—satisfying one does not satisfy the other. See Rules 3.21, 3.59, and Section 5.12.

Q14: Can an assignee sign a broadening reissue declaration?

A: Only under limited circumstances. Under 37 C.F.R. § 1.175(c)(2), the assignee of the entire interest may execute the declaration for a broadening reissue only if the application for the original patent was itself filed by the assignee under 37 C.F.R. § 1.46. This exception does not apply where the application was filed by the inventors and an assignment was subsequently recorded. In practice, the majority of design patent applications are filed by individual inventors,

so this exception has a narrower practical reach than many practitioners assume. If the original application was filed by the inventors and the reissue is broadening, the inventors must sign the declaration. See Section 5.12.1.

Q15: What happens when a restriction requirement in a reissue leaves the elected group containing only the original unamended claim?

A: If the elected group contains only the original patent claim with no correction being made, there is no error upon which reissue can be based, and a rejection under 35 U.S.C. § 251 will issue. The proper response is not to argue on the merits but to (A) request suspension of the original reissue application, (B) file a divisional reissue application directed to the non-elected embodiment, and (C) confirm a complete response on that basis. The application will then be suspended pending resolution of the divisional. See Rule 3.27 and Section 5.3.1.

Q16: Can a divisional reissue present broadened claims if it is filed after the two-year broadening period?

A: Yes, under certain conditions. Where the parent reissue application was filed within the two-year statutory period and contained broadened claims, the divisional may present broadened claims even if filed after the two-year period. The intent to broaden, having been established in the timely parent, carries forward. However, the broadened claim in the divisional must correspond to the broadening intent established in the parent—the divisional may not introduce a new broadening theory unrelated to the parent's error. Practitioners should affirmatively establish in the parent that the intent to broaden encompasses the subject matter later pursued in the divisional. Note that this principle, while accepted in USPTO practice, has not been extensively tested in Federal Circuit litigation specific to design patent reissue. See Rule 3.37 and Section 5.3.2.

Q17: Does a divisional reissue require a new assignee consent, or can a copy from the parent be used?

A: A new written consent from all assignees is generally required for a divisional reissue. A copy of the consent filed in the parent is generally not acceptable because the parent consent does not demonstrate that the assignee has consented to the addition of the new error being corrected in the divisional. However, for a continuation reissue where the parent will be abandoned, a copy of the parent's consent may be accepted. See Rule 3.59 and Case 4.29.

Q18: Can the declaration from a parent reissue satisfy the declaration requirement in a divisional reissue?

A: Yes, but only if the error identified in the parent's declaration is still being relied upon in the divisional. Under 37 C.F.R. § 1.175(f), if prosecution changes mean the previously identified error is no longer applicable to the divisional (e.g., the divisional is directed to a different embodiment), a new or supplemental declaration identifying the operative error is required. See Rule 3.31 and Section 5.3.3.

Q19: What constitutes “new matter” in a design reissue context?

A: New matter includes any visual features, structural elements, contours, surfaces, or embodiments not shown in the original patent drawings. It also includes boundary lines that define a new demarcation not recognizable from the original disclosure (per In re Owens), specification terminology not present in the original, and title expansions beyond the original disclosure. Drawing corrections must be limited to fixing existing errors and may not add new visual features. Where the declared error depends on a change that itself introduces new matter, the declaration is fatally defective. See Rules 3.3, 3.30, 3.58, and Section 5.5.

Q20: Can a boundary line be added in a reissue drawing?

A: Yes, but only if the boundary line makes explicit a boundary that already existed in the original disclosure but was unclaimed. Under In re Owens, 710 F.3d 1362 (Fed. Cir. 2013), a boundary line that defines a new demarcation not recognizable from the original drawings introduces new matter and fails the written description requirement. The test is whether a designer of ordinary skill would have recognized the boundary as present in the original disclosure at the time it was filed. See Rule 3.58 and Case 4.28.

Q21: Can formal specification errors alone support a reissue filing?

A: Yes. Formal errors in the specification can provide a valid basis for reissue even when no error exists in the drawings themselves. Examples recognized by examiners include inconsistent punctuation in figure descriptions (such as a semicolon where periods are used elsewhere), inaccurate description of broken lines as “environmental features” when the elements are portions of the article, describing broken lines as shown for “illustrative purposes only” (which has no clear meaning in design patent practice), mislabeling a view type (e.g., “perspective” vs. “isometric”), and failure to include a transitional statement for GUI designs. See Rules 3.39, 3.40, 3.46, 3.48, and 3.53; Section 5.15 (GUI and Animated Design Reissue Practice); Cases 4.14, 4.16, 4.19, and 4.20.

Q22: What broken-line description errors can support a reissue?

A: Several types. Describing broken lines as shown for “illustrative purposes only” has no clear meaning in design patent practice and does not satisfy MPEP § 1503.02. Describing broken line elements as “environmental structure” when they are portions of the article itself is inaccurate. Inconsistencies between figures where the same feature is shown in solid lines in some views and broken lines in others is a correctable drawing error. The absence of any feature statement describing the purpose of broken lines in a newly added figure is also a correctable specification error. Any of these can serve as a primary or substitute basis for reissue. See Rules 3.46, 3.47, and 3.53, and Cases 4.19 and 4.23.

Q23: How does the recapture doctrine apply specifically to design patents?

A: The recapture doctrine prohibits using reissue to reclaim subject matter deliberately surrendered during original prosecution. In design patents, because scope is defined

visually, the analysis operates on visual content rather than claim language. Surrender typically occurs when the applicant converts broken lines to solid lines, adds boundary features, restricts to a single embodiment, or otherwise narrows the design in response to a prior art rejection. The three-step framework requires identifying the surrender, comparing the reissue claim for material narrowing in other respects, and determining whether the broadening relates to the surrendered subject matter. Recapture screening should be documented in the pre-filing analysis. See Rule 3.62 and Section 5.10.

Q24: What are intervening rights, and how do they affect design reissue?

A: Under 35 U.S.C. § 252, intervening rights protect parties who acted in reliance on the scope of the original patent. Absolute intervening rights automatically protect anyone who made, purchased, or used a specific thing patented by the reissued patent before the reissue grant. Equitable intervening rights are discretionary and may protect ongoing manufacture where substantial preparation was made before reissuance. In design reissue, these rights operate on the visual scope of the claim. Where reissue broadens scope (e.g., by converting solid to broken lines), competitors whose products fall within the broadened scope but outside the original may assert intervening rights. This analysis should be part of the pre-filing evaluation. See Section 5.11.

Q25: Can a design patent be converted to a utility patent through reissue, or vice versa?

A: No, in either direction. A design patent reissue may not convert the patent to a utility patent, and a utility patent reissue may not convert to a design patent. The original patent does not contain a correctable error justifying conversion, the conversion would require new matter, and it would improperly affect the patent term. See Rule 3.16.

Q26: Can a reissue extend the term of a design patent?

A: No. Under 35 U.S.C. § 251, a reissued design patent must issue for the unexpired portion of the original patent term only. For design patents issuing from applications filed on or after May 13, 2015, the term is 15 years from the date of grant of the original patent. The reissued patent expires on the same date the original would have expired. See Rule 3.17 and Section 5.13.

Q27: What marking requirements apply after a design reissue issues?

A: Under 35 U.S.C. § 287(a), a patentee who marks products with a patent number must update the marking to reflect the reissued patent number once the reissue issues. Failure to update may limit the ability to collect damages. Product packaging, molds, labels, and online listings should be updated promptly. If virtual marking is used, the web address listing patent numbers must also be updated. See Section 5.13.

Q28: What special reissue considerations apply to GUI, transitional, or animated design patents?

A: GUI and animated design patents require specification descriptions of not only what the design looks like but how it transitions between states. Common correctable errors include failure to include a sequential transition statement, inaccurate or incomplete description of the transition sequence, failure to identify which figures represent distinct screen states versus intermediate frames, and failure to describe the purpose of broken lines for device housing. GUI reissues may also raise unique broadening questions—for example, converting a solid-line device housing to broken lines broadens the claim from a GUI on a specific device to a GUI on any device. See Rule 3.63, Section 5.15, and Case 4.20.

Q29: What is the proper marking format for reissue specification amendments?

A: Matter to be omitted must be enclosed in single brackets. Matter to be added must be underlined. Double brackets are reserved for identifying changes made in a prior reissue and are improper in a new reissue application. A clean copy of the specification without markings must not be included—only the marked-up copy should be filed. All amendments must be made relative to the patent as originally issued, not relative to prior amendments in the reissue. Each response must stand independently. See Rules 3.6, 3.19, 3.36, and 3.44; Section 5.7 (Marking and Amendment Technicalities).

Q30: How should canceled and amended drawing views be handled in reissue?

A: Canceled figures must be individually enclosed in brackets with “Canceled” adjacent to the figure legend—collective cancellation by reference is insufficient. Amended figures must be labeled “Amended.” New figures must be labeled “New” with figure numbers following the highest existing number. Existing figures may not be renumbered. A replacement sheet must include all figures from the original sheet, even if only one is changed. The corresponding specification must be conformed to reflect canceled or amended views. See Rules 3.7, 3.8, 3.10, and 3.55.

Q31: Is correction of inventorship a valid basis for design reissue?

A: Yes. Correction of inventorship may serve as a valid basis for filing a reissue under 35 U.S.C. § 251 where correction under 35 U.S.C. § 256 is unavailable. While some examiners have initially rejected such reissues, this position is incorrect. Reissue for correction of misjoinder or nonjoinder of inventors is recognized under MPEP § 1412.04 and case law including Ex parte Scudder. See Rule 3.38 and Section 5.6.

Q32: What is the difference between a divisional reissue and a continuation reissue?

A: A divisional reissue is filed following a restriction requirement and is directed to constructively non-elected subject matter. It must identify a distinct error not corrected in the parent and generally requires a new assignee consent. A continuation reissue claims the benefit of an earlier-filed reissue under 35 U.S.C. § 120 and is not filed in response to restriction. It is typically filed to pursue a different correction or alternative claim scope. A continuation where the parent will be abandoned may rely on the parent’s assignee consent. Both must comply with

37 C.F.R. § 1.177 cross-referencing requirements. Neither can independently circumvent the two-year broadening deadline. See Section 5.20.

Q33: What double patenting risks arise in divisional reissue practice?

A: A divisional reissue adding a new embodiment may be subject to obviousness-type double patenting over the original patent, over another reissue application, or over a related design patent. The analysis applies the ordinary observer test: whether a designer of ordinary skill would consider the divisional's design to be an obvious variation of the original. Where the reissue differs from the original only by converting solid to broken lines, examiners may evaluate whether the broader design is patentably distinct. Terminal disclaimers are available but carry enforceability consequences. Practitioners should screen for double patenting before filing by comparing the new embodiment to the original using the ordinary observer framework. See Rule 3.64 and Section 5.16.

Q34: What is the heightened duty of disclosure in reissue proceedings?

A: A reissue application triggers a fresh duty of disclosure under 37 C.F.R. § 1.56 that extends to all information known to be material to patentability, not limited to art before the examiner during original prosecution. It includes art identified in litigation, licensing negotiations, or post-issuance searching. The duty applies to every individual substantively involved in preparation or prosecution, including patent agents, technical advisors, in-house counsel, and paralegals conducting searches. The duty is continuing through prosecution. Where a broadening reissue is filed, previously immaterial art may become material to the expanded scope. An IDS should be filed concurrent with the reissue application. See Rule 3.65.

Q35: Can third parties oppose a pending design reissue application?

A: Yes. Under 37 C.F.R. § 1.291, third parties may file a protest including prior art, evidence of public use or sale, or any other material information before the reissue is published or a notice of allowance is mailed (whichever occurs first), unless a service copy is provided to the applicant. Because reissue applications are published upon filing, competitors monitoring a patent owner's portfolio can identify the reissue and submit prior art directed to the broadened claim scope. This underscores the importance of thorough pre-filing prior art review. See Sections 5.18 and 5.19.

Q36: What are the consequences of abandoning a reissue application?

A: If the reissue application is abandoned before issuance, the surrender never takes effect and the original patent remains in force. The Federal Circuit has indicated that prosecution history estoppel has not been applied to the abandonment of a reissue application. However, the reissue file (declaration, proposed amendments, remarks) becomes part of the public record and may be used as extrinsic evidence in litigation. Additionally, the two-year broadening window is not tolled or extended by an abandoned filing. Practitioners should evaluate whether the prosecution record contains damaging statements and whether a continuation reissue should preserve future options before abandoning. See Section 5.21.

Q37: Is expedited examination still available for design reissue applications?

A: No. Effective April 17, 2025, the USPTO suspended expedited examination under former 37 C.F.R. § 1.155, and the provision was permanently eliminated effective August 14, 2025. Remaining options to advance examination include a Petition to Make Special based on age or health under 37 C.F.R. § 1.102(c)(1) (available without fee for applicants age 65 or older or with health concerns), and the Accelerated Examination program under 37 C.F.R. § 1.102(a) and MPEP § 708.02(a). Track One prioritized examination is not available for design applications. Reissue applications do receive default priority over other applications under 37 C.F.R. § 1.176(a). See Section 5.23 (Advancing Examination of Design Reissue Applications).

Q38: When should the reissue declaration be drafted relative to the proposed amendments?

A: The declaration should be drafted after finalizing the proposed amendments to ensure precise alignment. The declaration must correspond exactly to the corrections being made. If the declaration is drafted first and the amendments later change, the declaration may no longer match the actual correction, creating an internal inconsistency that renders it defective. Practitioners should consider drafting the declaration last in the filing preparation process. See Sections 2.2 and 5.1.

Q39: What happens to a declared error that becomes moot during prosecution (e.g., after restriction)?

A: The declaration becomes defective and must be updated. If prosecution changes—such as a restriction requirement, divisional filing, or withdrawal of a claimed embodiment—render the originally declared error inapplicable, the applicant must file a new or supplemental declaration identifying at least one error that is being relied upon in the current application. A declaration that continues to assert an inapplicable error alongside a valid alternative error also remains defective—the inapplicable error must be removed, not merely supplemented. See Rules 3.26 and 3.49, and Cases 4.15 and 4.22.

Q40: Does a U.S. design reissue have implications for an international design portfolio?

A: Yes, potentially. The reissue mechanism has no direct equivalent in most foreign jurisdictions. A correction made through U.S. reissue may create scope discrepancies between the U.S. patent and corresponding foreign registrations (e.g., Hague, EU Community designs). Practitioners should notify foreign counsel of the reissue filing, confirm corrections are supported by the priority document, and evaluate whether analogous corrections are available or necessary abroad. The publication of the U.S. reissue also gives foreign competitors visibility into the portfolio. See Section 5.22.

Q41: Can a previously corrected error serve as the basis for a subsequent reissue?

A: No. Once a particular error has been corrected in a prior reissue, that same error cannot serve as the statutory basis for a subsequent or divisional reissue. Each reissue application must identify a distinct and currently existing error that renders the patent wholly or partly inoperative or invalid. See Rule 3.11.

Q42: What is the proper way to handle non-elected embodiments after restriction in a reissue?

A: All drawings and specification descriptions corresponding to non-elected embodiments must actually be removed from the application. A response that merely states an election has been made, without canceling the non-elected figures and their corresponding descriptions, is procedurally deficient. The specification must be conformed to reflect only the elected subject matter before the application can advance. See Rule 3.43.

Q43: Can a failure to perfect a priority claim support a reissue filing?

A: Yes. Where a priority claim was intended but not properly perfected—for example, because the applicant failed to make specific reference to the prior application serial number on the Application Data Sheet—this constitutes a correctable error. However, the declaration must identify the precise procedural failure, not merely state that priority was "inadvertently omitted." See Rule 3.51.

Q44: What is the recombination procedure for adding a subcombination design through reissue?

A: A patentee who failed to claim a patentably distinct subcombination may correct this through reissue (filed within two years as it constitutes broadening). The application claiming both the entire article and the subcombination will trigger restriction. The subcombination will be constructively non-elected. When the original unamended claim is rejected under § 251, the applicant requests suspension, files a divisional, and confirms a complete response. If the divisional is found allowable, the applicant petitions under 37 C.F.R. § 1.183 to waive § 1.153, permitting rejoinder of both designs under a single claim in a single application. This path is not available where the subcombination was originally included, restriction was imposed during original prosecution, and the applicant failed to file a divisional before original issuance. See Section 5.17.

Q45: What electronic filing pitfalls should practitioners watch for in design reissue applications?

A: Common issues include selecting the wrong application type (must be "reissue" not standard design), uploading the declaration under a generic category rather than specifically as a "reissue oath or declaration," uploading multiple drawing sheets as a single file (which may reorder), and incorrect fee calculations. Replacement drawing sheets should be uploaded as individual PDF pages at sufficient resolution. The filing receipt should be verified to confirm it correctly identifies the application as a design reissue with the correct patent number, inventorship, and assignee information. See Section 5.14.

Appendix 3
Limitations

This ProGuide reflects analysis of statutory text, USPTO regulations, publicly available prosecution histories, and observed examination practice as of the date of last update.

It does not:

1. Provide legal advice for any specific patent or factual situation.
2. Replace statutory text, regulations, or binding judicial precedent.
3. Guarantee that any examiner will adopt a particular interpretation.
4. Eliminate the need for independent recapture doctrine analysis.
5. Address every procedural variation in complex multi-application reissue scenarios.

Design reissue practice is jurisdictional and fact-dependent. Broadening analysis is impression-based and may vary depending on the specific visual features at issue. Examiner practice may vary by art unit and individual examiner.

Practitioners remain responsible for:

1. Independent statutory interpretation.
2. Screening for recapture and intervening rights implications.
3. Confirming ownership and inventorship status.
4. Ensuring compliance with current USPTO forms and regulations.
5. Evaluating strategic enforcement consequences of narrowing amendments.

This ProGuide is intended as a structured drafting and review framework to reduce avoidable defects and promote disciplined reissue practice. It is not a substitute for professional judgment. Although efforts have been made to reduce errors made in the ProGuide, some errors may remain. If you believe you have found an error, please report it to Robert Oake at rgo@oake.com.

Appendix 4
Selected MPEP, CFR, Statutory, and Case Law References

1. Statutes

35 U.S.C. § 251 — Reissue of Defective Patents

(a) In General

Whenever any patent is, through error, 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. No new matter shall be introduced into the application for reissue.

(b) Multiple Reissued Patents

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

(c) Applicability of This Title

The provisions of this title relating to applications for patent shall be applicable to applications 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 or the application for the original patent was filed by the assignee of the entire interest.

(d) Reissue Patent Enlarging Scope of Claims

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.

35 U.S.C. § 252 — Effect of Reissue

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, used, or imported as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or for the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

Additional Design Patent Statutes

Statute	Coverage
35 U.S.C. § 171	Specific to design patents. Defines what a design patent can cover. No new matter may be added via reissue that falls outside this definition.
35 U.S.C. § 173	Governs the term of a design patent (15 years from grant). Reissues must not extend the original term.
35 U.S.C. § 251(d)	Clarifies that broadening reissue applications must be filed within two years of the original grant. Applies to design patents.

2. Regulations (37 C.F.R.)

Practice Note on Currency of Regulatory

The regulatory text reproduced in this Appendix reflects the Code of Federal Regulations as in effect at the time of last review. Certain provisions of 37 C.F.R. § 1.173 and related sections have been amended periodically, including subsections addressing Sequence Listings, Sequence Listing XML, Large Tables, and Computer Program Listing Appendices. These subsections reflect regulatory updates implementing the WIPO Standard ST.26 XML-based sequence listing requirement, which replaced the prior ST.25 text-based format, and related procedural changes.

Practitioners should verify the current text of all regulations cited in this ProGuide against the Electronic Code of Federal Regulations (eCFR) at ecfr.gov before relying on the reproduced text for filing or prosecution purposes. While the provisions most directly relevant to design reissue practice, including the amendment marking requirements of § 1.173(d), the drawing replacement procedures of § 1.173(b)(3), and the relative-to-patent amendment requirement of § 1.173(g), have remained substantively stable, practitioners working with design patents that include sequence data or large tables in their specifications should confirm the current procedural requirements for those elements.

This Appendix is intended as a reference aid and does not substitute for the regulations themselves. Where any discrepancy exists between the text reproduced here and the current eCFR, the eCFR controls.

37 C.F.R. § 1.171 — Application for Reissue

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications.

37 C.F.R. § 1.172 — Reissue Applicant

(a) The reissue applicant is the original patentee, or the current patent owner if there has been an assignment. A reissue application must be accompanied by the written consent of all assignees, if any, currently owning an undivided interest in the patent. All assignees consenting to the reissue must establish their ownership in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(c) of this chapter.

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

37 C.F.R. § 1.173 Reissue specification, drawings, and amendments.

(a) Contents of a reissue application.

An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. No reissue 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, pursuant to 35 U.S.C. 251.

(1) Specification, including claims. The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) Drawings. Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the

changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

(b) Making amendments in a reissue application.

An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made, as follows:

(1) Specification other than the claims, "Large Tables" (§ 1.58(c)), a "Computer Program Listing Appendix" (§ 1.96(c)), a "Sequence Listing" (§ 1.821(c)), or a "Sequence Listing XML" (§ 1.831(a)).

(i) Changes to the specification, other than to the claims, "Large Tables" (§ 1.58(c)), a "Computer Program Listing Appendix" (§ 1.96(c)), a "Sequence Listing" (§ 1.821(c)), or a "Sequence Listing XML" (§ 1.831(a)), must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph, without presentation of the text of the paragraph. The precise point in the specification where any added or rewritten paragraph is located must be identified.

(ii) Changes to "Large Tables," a "Computer Program Listing Appendix," a "Sequence Listing," or a "Sequence Listing XML" must be made in accordance with § 1.58(g) for "Large Tables," § 1.96(c)(5) for a "Computer Program Listing Appendix," § 1.825 for a "Sequence Listing," and § 1.835 for a "Sequence Listing XML."

(2) Claims. An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," etc., should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) Drawings. One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which shall be an attachment to the amendment document. Any replacement sheet of drawings must be in compliance with § 1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded

by brackets and identified as "Canceled." All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings.

(i) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings.

(ii) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(c) Status of claims and support for claim changes.

Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) Changes shown by markings.

Any changes relative to the patent being reissued that are made to the specification, including the claims but excluding "Large Tables" (§ 1.58(c)), a "Computer Program Listing Appendix" (§ 1.96(c)), a "Sequence Listing" (§ 1.821(c)), and a "Sequence Listing XML" (§ 1.831(a)) upon filing or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and
(2) The matter to be added by reissue must be underlined.

(e) Numbering of patent claims preserved.

Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

(f) Amendment of disclosure may be required.

The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) Amendments made relative to the patent.

All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

37 C.F.R. § 1.174 — [Reserved]

Previously addressed reissue of design patents separately; now reserved. Design patent reissues are governed by §§ 1.171 and 1.173.

37 C.F.R. § 1.175 Inventor's oath or declaration for a reissue application.

(a) The inventor's oath or declaration for a reissue application, in addition to complying with the requirements of § 1.63, § 1.64, or § 1.67, must also specifically identify at least one error pursuant to 35 U.S.C. 251 being relied upon as the basis for reissue and state that the applicant believes the original patent to be 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 the patentee had the right to claim in the patent.

(b) If the reissue application seeks to enlarge the scope of the claims of the patent (a basis for the reissue is the patentee claiming less than the patentee had the right to claim in the patent), the inventor's oath or declaration for a reissue application must identify a claim that the application seeks to broaden. A claim is a broadened claim if the claim is broadened in any respect.

(c) The inventor, or each individual who is a joint inventor of a claimed invention, in a reissue application must execute an oath or declaration for the reissue application, except as provided for in § 1.64, and except that the inventor's oath or declaration for a reissue application may be signed by the assignee of the entire interest if:

(1) The application does not seek to enlarge the scope of the claims of the original patent; or
(2) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

(d) If errors previously identified in the inventor's oath or declaration for a reissue application pursuant to paragraph (a) of this section are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(e) The inventor's oath or declaration for a reissue application required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f), except that the provisions of § 1.53(f)(3) do not apply to a reissue application.

(f)

(1) The requirement for the inventor's oath or declaration for a continuing reissue application that claims the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) in compliance with § 1.78 of an earlier-filed reissue application may be satisfied by

a copy of the inventor's oath or declaration from the earlier-filed reissue application, provided that:

(i) The inventor, or each individual who is a joint inventor of a claimed invention, in the reissue application executed an inventor's oath or declaration for the earlier-filed reissue application, except as provided for in § 1.64;

(ii) The continuing reissue application does not seek to enlarge the scope of the claims of the original patent; or

(iii) The application for the original patent was filed under § 1.46 by the assignee of the entire interest.

(2) If all errors identified in the inventor's oath or declaration from the earlier-filed reissue application are no longer being relied upon as the basis for reissue, the applicant must identify an error being relied upon as the basis for reissue.

(g) An oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1), will be placed in the file record of the reissue application, but may not necessarily be reviewed by the Office.

37 C.F.R. § 1.176 — Examination of Reissue

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

37 C.F.R. § 1.177 — Issuance of Multiple Reissue Patents

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under § 1.322 any reissue patent resulting from an application to which this paragraph applies that does not contain the required notice.

(b) If applicant files more than one application for the reissue of a single patent, each claim of the patent being reissued must be presented in each of the reissue applications as an amended, unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by 35 U.S.C. 251 but is otherwise in condition for allowance, the Office may suspend action in the allowable application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself.

37 C.F.R. § 1.178 — Original Patent; Continuing Duty of Applicant

(a) The application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent. Until a reissue application is granted, the original patent shall remain in effect.

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences or trials before the Patent Trial and Appeal Board, reissues, reexaminations, or litigations and the results of such proceedings (see also § 1.173(a)(1)).

Additional Regulations Quick Reference

Rule	Coverage
37 C.F.R. § 1.84	Standards for drawings. Applies to reissue applications; reissue drawings must meet the same standard as original applications.
37 C.F.R. § 1.121	Amendment practice — explains how to amend the specification and drawings in any patent application, including reissues.
37 C.F.R. § 1.152	Specific requirements for design patent drawings. Reissue drawings must comply.
37 C.F.R. § 1.179	If a reissue is refused, applicant has the right to appeal.
37 C.F.R. § 1.183	Petition to waive a rule. Sometimes used in reissue practice to obtain an exception to a procedural requirement (e.g., to permit rejoining of designs).

37 C.F.R. § 3.73(c)	Requirements for establishing assignee ownership in a reissue application.

3. MPEP Sections

MPEP Section	Coverage
§ 1401	Introduction to reissue applications.
§ 1402	Reissue oath or declaration — general details.
§ 1411	Examination of reissue applications.
§ 1412.03	Broadening reissue applications: strict rules about filing within two years. Applies to design patents. A divisional reissue may present broadened claims if the parent was filed within the two-year window, even if the divisional is filed afterward.
§ 1412.04	Correction of inventorship as a basis for reissue. Also governs when the assignee may sign the declaration (only if assignee owns the entire interest, including any added inventors' shares).
§ 1414	Reissue declaration requirements. Requires specific identification of errors, including by reference to specific drawings and drawing features. Sets out required recitations and specificity standards. Also addresses supplemental declarations and when a new declaration (rather than a supplement) is required.
§ 1414.01	Supplemental reissue oath or declaration requirements.
§ 1450	Restriction in reissue applications. Non-elected embodiments are constructively withdrawn.
§ 1453	Marking requirements in reissue specifications. Single brackets for matter being omitted; double brackets reserved for matter bracketed in a prior patent or prior reissue.
§ 1457	Design reissue applications and patents. Covers: expedited examination; design reissue fees; multiple design reissue applications; restriction and divisional procedure; prohibition on conversion to/from utility patents.
§ 1503.02	Broken line requirements for design patent drawings. Broken lines must be accurately described in the specification.
§ 1509	Reissue of a design patent. Covers drawing requirements, labeling of canceled/amended/new figures, and broken line statement requirements.
§§ 1500 (generally)	Design patents — covers special rules affecting design patent prosecution, including reissue.

1509 Reissue of a Design Patent [R-11.2013]

See MPEP Chapter 1400 for practice and procedure in reissue applications. See also MPEP § 1457 regarding design reissue applications.

For design reissue application filing, search and examination fees, see 37 CFR 1.16(e). For the fee for issuing a reissue design patent, see 37 CFR 1.18(a).

The term of a design patent may not be extended by reissue. See *Ex parte Lawrence,* 70 USPQ 326 (Comm'r Pat. 1946). If a reissue application is filed for the purpose of correcting the drawing of a design patent, either by canceling views, amending views or adding new views, the provisions of 37 CFR 1.173(b)(3) must be followed. All changes to the patent drawing shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawing. A marked-up copy of any amended drawing figure, including annotations indicating the changes made, should be submitted. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and it must be presented in the amendment or remarks section that explains the change to the drawing.

A reissue application must be filed with a copy of all drawing views of the design patent regardless of whether certain views are being cancelled or amended in the reissue application. Inasmuch as the drawing is the primary means for showing the design being claimed, it is important for purposes of comparison that the reissue of the design patent shows a changed drawing view in both its canceled and amended versions and/or show a previously printed drawing view that has been canceled but not replaced. In addition to drawing views that are unchanged from the original design patent, the drawing in the reissue application may include the following views, all of which will be printed as part of the design reissue patent:

(1) CANCELED drawing view. Such a drawing view must be surrounded by brackets and must be labeled as "Canceled." For example, FIG. 3 (Canceled). If a drawing view is canceled but not replaced the corresponding figure description in the reissue specification must also be cancelled. However, if a drawing view is cancelled and replaced by an amended drawing view the corresponding figure description in the reissue specification may or may not need to be amended.

(2) AMENDED drawing view. Such a drawing view must be labeled as "Amended." For example, FIG. 3 (Amended). When an amended drawing view is present, there may or may not be a corresponding canceled drawing view. If there is such a corresponding canceled drawing view, the amended and canceled drawing views should have the same figure number. The specification of the reissue application need not indicate that there is both a canceled version and an amended version of the drawing view.

(3) NEW drawing view. Such a drawing view must be labeled as "New" For example, FIG. 5 (New). The new drawing view should have a new figure number, that is, a figure number that did not appear in the original design patent. The specification of the reissue application must include a figure description of the new drawing view.

If a drawing view includes both a cancelled and amended version, and the change in the amended version is for the purpose of converting certain solid lines to broken lines, the reissue specification must include a statement indicating the purpose of the broken lines.

1457 Design Reissue Applications and Patents [R-07.2022]

A reissue application can be filed for a design patent in the same manner that a reissue application is filed for a utility patent. There are, however, a few procedures specific to design reissue applications as explained below.

II. DESIGN REISSUE FEE

The design reissue application fee is set forth for in 37 CFR 1.16(e). A search fee (37 CFR 1.16(n)) and an examination fee (37 CFR 1.16(r)) are also required. The additional fees in 37 CFR 1.16(h) and 37 CFR 1.16(i) do not apply for a design reissue application because more than one claim in not permitted in a design application pursuant to the last sentence of 37 CFR 1.153(a).

The fee for issuing a design reissue patent is set forth in 37 CFR 1.18(b).

III. MULTIPLE DESIGN REISSUE APPLICATIONS

The design reissue application can be filed based on the "error" of failing to include a design for a patentably distinct segregable part of the design claimed in the original patent or a patentably distinct subcombination of the claimed design. A reissue design application claiming both the entire article and the patentably distinct subcombination or segregable part would be proper under 35 U.S.C. 251, if such a reissue application is filed within two years of the issuance of the design patent, because it is considered a broadening of the scope of the patent claim. Restriction will be required under 37 CFR 1.176(b) in such a reissue design application, and the added design to the segregable part or subcombination will be held to be constructively non-elected and withdrawn from consideration. See MPEP § 1450. In the Office action containing the restriction requirement, the examiner should suggest to the applicant that a divisional design reissue application directed to the constructively non-elected segregable part or subcombination subject matter may be filed. The claim to the patented design for the entire article will then be examined and, if found allowable without change from the patent, a rejection will be made under 35 U.S.C. 251 based on the fact that there is no "error" in the non-amended original patent claim. In the Office action making this rejection, applicant should be advised that a proper response to the rejection must include (A) a request to suspend action in this original reissue application pending completion of examination of a divisional reissue application directed to the constructively non-elected segregable part or subcombination subject matter, (B) the filing of the divisional reissue application, or a statement that one has already been filed (identifying it at least by application number), and (C) an argument that a complete response to the rejection has been made based upon the filing of the divisional reissue application and the request for suspension. Action in the original design reissue application will then be suspended, and the divisional will be examined.

If, after examination, the divisional design reissue application is also determined to be allowable, a requirement must be made in the divisional design reissue application to submit a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.153 in order to permit the rejoining of the designs to the entire article (of the original application) and the segregable part or subcombination (of the divisional) under a single claim into a single design reissue application for issuance, the single application being the first design reissue application.

It should be noted that the filing of a design reissue application would not be proper if applicant did in fact include the design for a segregable part or subcombination thereof in the original design patent application, a restriction was thus made, and then applicant failed to file a divisional reissue application for a non-elected invention that was canceled in view of a restriction requirement (before issue of the original application). See *In re Watkinson,* 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita,* 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977).

IV. CONVERSION TO UTILITY PATENT

A design patent cannot be converted to a utility patent via reissue.

35 U.S.C. 251 requires that the "patent is, through error, 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"; however, the design patent (for which the reissue application would be filed) is not wholly or partly inoperative or invalid. There is no error in the design patent. Also, converting a design patent to a utility patent will, in most instances, involve the introduction of new matter into the patent. The disclosure of a design patent is not directed to how the invention is made and used, and the introduction of new matter is required to bridge this gap and provide support for the utility patent. Accordingly, the examiner should consider rejections based on the introduction of new matter under 35 U.S.C. 251 and lack of enablement and/or description under 35 U.S.C. 112, when a reissue application is filed to convert a design patent to a utility patent.

Further, the term of a design patent may not be extended by reissue. *Ex parte Lawrence,* 70 USPQ 326, 1946 C.D. 1 (Comm'r Pat. 1946). Thus, any reissue application filed to convert a design patent to a utility patent, which conversion would thereby extend the term of the patent, should be rejected as failing to comply with 35 U.S.C. 251, which permits reissue only "for the unexpired part of the term of the original patent." The statute requires that the reissued patent shall not extend the term of the original patent.

V. CONVERSION TO A DESIGN PATENT

A utility patent cannot be converted to a design patent via reissue.

35 U.S.C. 251 requires that the "patent is, through error, 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"; however, the utility patent is not wholly or partly inoperative or invalid. There is no error in the utility patent. It is also noted that conversion to a design patent would exempt the existing utility patent from

maintenance fees, and there is no statutory basis for exempting an existing patent from maintenance fees. See also subsection IV above regarding patent term.

4. Case Law

Reissue Scope and Validity

Citation	Key Holding
In re Wilder, 736 F.2d 1516 (Fed. Cir. 1984)	A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims which causes the original patent to be defective. A change or departure from the original specification or claims represents an "error" under 35 U.S.C. § 251.
In re Constant, 827 F.2d 728 (Fed. Cir. 1987)	It is not sufficient to satisfy the error identification requirement by reproducing the claim or drawings with bracketed and underlined markings. The error must be stated in words in the body of the declaration.
In re Owens, 710 F.3d 1362 (Fed. Cir. 2013)	Unclaimed boundary lines are permissible in reissue only when they reflect a boundary that a designer of ordinary skill in the art would have recognized as present in the original disclosure at the time it was filed.
Ex parte Lawrence, 70 USPQ 326 (Comm'r Pat. 1946)	The term of a design patent may not be extended by reissue.
Ex parte Scudder (cited in MPEP § 1412.04)	Reissue for correction of misjoinder or nonjoinder of inventors is recognized under 35 U.S.C. § 251.
In re Watkinson, 900 F.2d 230 (Fed. Cir. 1990)	A design reissue application is not proper if applicant included the design for a segregable part in the original application, a restriction was made, and applicant then failed to file a divisional for the non-elected invention before original patent issuance.
In re Orita, 550 F.2d 1277 (CCPA 1977)	Same principle as Watkinson: reissue is not available to correct the failure to pursue a non-elected design that was available through a timely divisional in the original prosecution.

Intervening Rights (35 U.S.C. § 252)

Citation	Key Holding
Shockley v. Arcan, Inc., 248 F.3d 1349 (Fed. Cir. 2001)	Absolute intervening rights apply only to existing (already-manufactured) products. An offer to sell products not yet manufactured at the time of reissuance cannot create absolute intervening rights.

BIC Leisure Prods., Inc. v. Windsurfing Int'l, Inc., 1 F.3d 1214 (Fed. Cir. 1993)	The absolute right extends to anything made, purchased, or used before the grant of the reissue patent. A binding purchase order for products was sufficient to create absolute intervening rights under § 252.
Marine Polymer Techs., Inc. v. HemCon, Inc., 672 F.3d 1350 (Fed. Cir. 2012)	Section 252 provides for two types of intervening rights: (1) absolute intervening rights abrogating liability for products made or used before reissue; and (2) equitable intervening rights applied by judicial discretion to mitigate liability for infringing activities that began before reissue.
Junker v. Medical Components, Inc., No. 16-cv-4112, 2019 U.S. Dist. LEXIS 1530 (E.D. Pa. Jan. 3, 2019)	Prosecution history estoppel has not been applied to the abandonment of a reissue application. Note: This is a district court decision, not Federal Circuit precedent. While its reasoning is instructive, it does not carry the same precedential weight as the Federal Circuit decisions cited elsewhere in this table. Practitioners should be aware that the Federal Circuit has not squarely addressed the application of prosecution history estoppel to the abandonment of a reissue application.
Underwater Devices, Inc. v. Morrison-Knudsen Co., 717 F.2d 1380 (Fed. Cir. 1983)	Intervening rights is an affirmative defense that must be raised at trial; failure to plead is a waiver.
Laitram Corp. v. NEC Corp., 163 F.3d 1342 (Fed. Cir. 1998)	Whether reexamined or reissued claims are "identical" to original claims (for § 252 purposes) is a question of law. "Identical" means without substantive change.