Design Patent ProGuide – Reissue Declarations
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Quick Reference Guide

DO:

✓ Identify the specific error with particularity

✓ Explain how the error renders the patent wholly or partly inoperative or invalid

✓ State the error existed at the time of issuance (even if discovered later)

✓ Make the declaration self-contained and complete (do not rely on remarks)

✓ If requesting expedited examination, draft a "clean" declaration to avoid avoidable defects that can stall prosecution

✓ Identify where the error appears (e.g., figure numbers, claim language, specific wording)

✓ For multiple errors, identify each error separately or clearly explain their relationship

✓ Address procedural context for examiner-mandated steps (e.g., divisional/suspension/abandonment)

✓ Keep the declaration factual and evidentiary; reserve persuasion for remarks

DON'T:

✗ Use conclusory statements without explanation (e.g., "defective," "needs correction," "incorrect drawings")

✗ Assume the examiner will infer the error from amendments to drawings or claims

✗ Treat the declaration as a formality or boilerplate attachment

✗ Describe the "error" as post-issuance preference, redesign, or change of mind

✗ Copy a parent reissue declaration into a divisional unless it identifies the error being corrected in the divisional

✗ Use advocacy tone in the declaration (save arguments for remarks)

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1. Introduction and Theory

1.1 Purpose and Function of the Reissue Declaration

A reissue application is not a vehicle to improve a patent. It is a statutory correction mechanism. The reissue declaration (or reissue oath) is the mechanism that establishes the threshold requirement for reissue: that the patent, through error, is deemed wholly or partly inoperative or invalid within the meaning of 35 U.S.C. § 251. The declaration is therefore not merely procedural. It is the evidentiary foundation for reissue eligibility.

In design patent practice, "wholly or partly inoperative or invalid" is most commonly implicated where the issued disclosure does not clearly and consistently convey the claimed design. In practice, "inoperative" often means the issued drawings and related description create an incomplete or internally inconsistent depiction of the design such that the intended scope cannot be reliably determined (for example, where views are inconsistent, necessary views are missing to understand the three-dimensional form, or line conventions materially miscommunicate what is claimed versus disclaimed).

Terminology Note: In post-AIA practice, "declaration" is the standard terminology (see 37 C.F.R. § 1.63). In pre-AIA practice, "oath" and "declaration" are both commonly used. This ProGuide uses "declaration" as the default term, but references to "declaration" are intended to be interchangeable unless a pre-AIA distinction is specifically discussed.

1.2 How Broadening Reissue by Line Conversion Fits the "Claimed Less Than Entitled" Framework

In design patent practice, a reissue that broadens claim scope often arises from drawings that over-specify structure through the use of solid lines. Although the corrective act (e.g., converting solid lines to broken lines) broadens the scope of the design claim, the statutory error under 35 U.S.C. § 251 is properly characterized as the patentee having *claimed less than he had a right to claim* at the time of issuance.

This is because over-specification of structure in solid lines can improperly exclude embodiments that were part of the inventor's design but were not intended to be claimed as required features. In such cases, the issued patent under-claimed the design by unnecessarily restricting its scope. Reissue corrects that issuance-time error by removing unintended structural limitations, even though the resulting claim scope is broader.

1.3 Practice Alert: Intervening Rights in Broadening Reissue

Practitioners should advise clients that any broadening reissue under 35 U.S.C. § 251 may give rise to intervening rights under 35 U.S.C. § 252. Intervening rights can limit or bar enforcement of the reissued patent against activities that occurred before issuance of the reissue patent.

Absolute intervening rights may protect products made, used, or sold before reissue issuance, and equitable intervening rights may limit remedies for continued activity begun before reissue. These considerations are particularly important in design reissue practice where broadening corrections, such as conversion of solid lines to broken lines, are undertaken to capture commercial embodiments already in the marketplace.

1.4 Common Failure Points in Design Patent Practice

In design patent practice, reissue declaration defects arise most often when applicants attempt to correct drawing-related problems (e.g., adding or canceling views, revising line conventions, or addressing inconsistencies between views) but describe the reason for the reissue in conclusory terms. Examiners generally do not object to the corrective act itself merely because it is drawing-related, provided the underlying error is properly articulated and the amendments do not introduce new matter. The common failure point is the declaration's articulation of the error: what the error was at issuance, where it appears in the issued patent, and why it renders the patent wholly or partly inoperative or invalid.

1.5 The Misconception About "Showing Error Through Correction"

A recurring misconception is that the "error" can be shown by the correction. That approach often produces declarations that read as if reissue is being filed because the patentee now prefers a different presentation of the design. Examiner practice reflected in the prosecution histories reviewed for this ProGuide is consistent: the declaration must articulate the error independently, and it must do so with enough specificity that the examiner can evaluate reissue eligibility from the declaration itself.

1.6 Scope and Objective of This ProGuide

This ProGuide focuses on the most common examiner objections and rejections directed to reissue declarations in design patent practice. It does not address substantive patentability issues, new matter analysis, or recapture doctrine, except to the extent those issues intersect with reissue declaration requirements. The objective is to provide rules and model form guidance that reduce avoidable declaration defects, limit delay, and preserve flexibility in how the reissue is prosecuted, without overloading the declaration with unnecessary detail or attorney argument.

1.7 AIA vs. Pre-AIA Reissue Applications

For reissue applications filed on or after September 16, 2012, the America Invents Act (AIA) version of 35 U.S.C. § 251 applies. The AIA removed the requirement that a reissue error be made "without any deceptive intention."

For reissue applications filed before September 16, 2012, the pre-AIA version of 35 U.S.C. § 251 applies, which includes the requirement that the error have occurred "without any deceptive intention."

Unless otherwise stated, this ProGuide addresses reissue declaration practice under the current (post-AIA) version of § 251, while noting pre-AIA differences where relevant.

Note: This ProGuide is subject to certain limitations, which are set forth in Appendix 3 to this document.

2. Recommended Form

2.1 Express Identification of the Error

The declaration should include an explicit statement identifying:

- The nature of the error
- Where the error appears in the issued patent
- Why the error renders the patent partially inoperative or invalid

Recommended phrasing should go beyond "error occurred" and include design-specific consequences (e.g., incomplete disclosure of the design, unintended claim breadth, inconsistency between views, or unintended exclusion of subject matter from the claimed design).

2.2 Temporal Framing at Time of Issuance

The declaration should expressly state that the error existed at the time the patent issued, not that it was discovered later. Examiners scrutinize language suggesting post-issuance dissatisfaction rather than issuance-time error.

2.3 Declarant's Knowledge and Role

While inventors typically sign reissue declarations, the declaration should clarify the declarant's role in the original prosecution or design development where relevant. This is particularly important where the asserted error relates to what the inventor intended the design to cover.

2.4 Avoidance of Attorney Argument Tone

Declarations written in argumentative or advocacy tone are more likely to be objected to. The declaration should be factual, explanatory, and evidentiary, reserving persuasion for attorney remarks.

2.5 Procedural-Context Clause for Examiner-Directed Reissue Errors

Where applicable, the declaration should include a short procedural-context clause explaining that the asserted error arose during compliance with examiner-directed reissue procedure, rather than from a substantive change in design intent.

This clause should:

- Identify the procedural requirement imposed by the examiner
- Explain how compliance with that requirement produced or revealed the error
- Confirm that the error nonetheless existed at issuance

2.6 "Single Word/Phrase" Error Identification Clause (Optional Structure That Examiners Treat as Sufficient)

Where appropriate, draft the error statement to:

- identify a single word/phrase/expression in the issued patent (spec/claim/drawing-description context), and
- explain how that language/feature renders the patent wholly or partly inoperative or invalid.

The declaration need not recite the corrective action taken in the reissue, but it may do so without automatically becoming defective.

2.7 Divisional-Reissue Alignment Clause (When Using a Parent Reissue as Procedural Background)

If a divisional reissue is filed and any parent reissue declaration exists, ensure the divisional declaration expressly ties the asserted § 251 error to the specific correction pursued in the divisional (and not merely to the parent's rationale). Otherwise, the Office may treat the declaration as identifying an error that is not actually being corrected in the divisional and require a replacement declaration.

2.8 Before Filing: Seven-Question Gatekeeper

Before submitting the reissue declaration, perform this final audit. If any answer is "No" (or "Yes" for Questions 2 and 6), the declaration should be revised to avoid immediate examiner objection. If the answer to Question 7 is yes, be prepared to file a terminal disclaimer.

1. The "No-Remarks" Test: If the examiner read only the declaration (with no attorney remarks and no amended drawings visible), could they clearly identify what the error was, where it appears in the issued patent, and why it makes the patent wholly or partly inoperative or invalid?

2. The Temporal and Recapture Test: Does the declaration sound like it is describing a "post-issuance preference" or a "redesign" rather than an error that existed at the time of issuance? Crucially: Does the correction attempt to "recapture" subject matter that was intentionally surrendered during the original prosecution to overcome a rejection?

3. The Divisional Alignment Test: If this is a divisional reissue, does the declaration identify an error being corrected in this specific application, rather than simply repeating the rationale for the parent reissue?

4. The Internal Completeness Test: Is the declaration entirely self-contained, or does it rely on external remarks or labels like "incorrect drawings" to provide the necessary factual explanation?

5. The "New Matter" and Supplemental Test: If a new or different error has been identified or introduced via amendment during the prosecution of the reissue, has a supplemental declaration been prepared to cover that specific change?

6. The Recapture Check: If the reissue broadens the claim (e.g., converting solid lines to broken lines), was the original narrowing made to overcome any rejection or objection, or through a deliberate amendment that narrowed scope for any reason during original prosecution (including, but not limited to, prior art rejections, § 112 issues, or examiner-required amendments)? If yes, the correction is likely barred by the Recapture Doctrine, regardless of the declaration's quality.

7. The Double Patenting Check: Does this broader claim now create a "patentably indistinct" design compared to another patent in the same portfolio? If so, be prepared to file a Terminal Disclaimer to overcome a Non-Statutory Double Patenting rejection.

2.9 Model Supplemental Declaration Clause

When an amendment is filed during prosecution to correct a drawing inconsistency or error discovered *after* the initial reissue filing, a supplemental declaration should be submitted. Use the following model language to ensure the new correction is properly grounded in a statutory error:

> [Note: This model addresses the common scenario where a supplemental declaration identifies an additional error. If the supplemental declaration is clarifying, refining, or replacing the originally identified error, adjust the opening sentence accordingly (e.g., "The error identified in the original Reissue Declaration filed on [Date] is hereby clarified as follows …" or "As prosecution has developed, it has become apparent that the error being corrected is different from that originally identified …").]
>
> Model Clause: "In addition to the errors identified in the original Reissue Declaration filed on [Date], the applicant has identified a further error in the original patent that

renders it [wholly/partly] inoperative or invalid. Specifically, Figure [X] of the issued patent contains [describe specific visual defect, e.g., an inconsistent line weight or missing contour], which was present at the time of issuance. This supplemental declaration is filed to identify this additional error as a basis for the amendments currently being pursued in this application."

3. Rules and Guidance for Reissue Declarations

3.1 Reissue Declarations Must Identify a Statutorily Cognizable "Error"

A reissue declaration must affirmatively identify an error recognized under 35 U.S.C. § 251. General statements that the patent is "defective," "in need of correction," or "requires clarification" are insufficient. The declaration must tie the asserted error to a legally cognizable category, such as claiming less than the inventor had a right to claim, inclusion of unintended subject matter, or omission of subject matter that was disclosed but not claimed. Examiners do not infer statutory error from context or from attorney remarks. The declaration itself must supply the legal basis for reissue eligibility. In design reissue practice, this includes situations where the issued drawings over-specified structure (e.g., through solid lines), thereby causing the patentee to claim *less* than the full design to which the inventor was entitled.

3.2 The Error Must Be Identified With Particularity, Not Merely Outcome

Declarations stating only that the reissue is being filed "to correct errors in the drawings" or "to correct errors in claim scope" are routinely treated as conclusory. The declaration must explain what the error was at the time of issuance, even if the error was discovered only after issuance, and how it manifested in the issued patent. In design cases, this commonly arises where applicants seek to cancel views, add views, or alter line conventions. The declaration must explain why the issued configuration was erroneous, not merely that a different configuration is now preferred.

3.3 Intentional Decisions at Issuance Are Not Automatically Disqualifying but Must Be Addressed

Examiners do not categorically bar reissue where the original drawings or claim scope were intentionally chosen. However, where the record indicates a deliberate prosecution choice, the declaration must explain why that choice nonetheless resulted in an error under § 251 (e.g., misunderstanding of legal effect, unintended claim scope, or incomplete disclosure of the design). Silence on intent, where intent is apparent from the file history, invites rejection or objection. Practitioners should also consider whether the asserted "error" is actually an attempt to recapture subject matter intentionally surrendered during original prosecution. Reissue is not a proper mechanism to recapture surrendered subject matter. Practitioners should take particular care when the original use of solid lines was a deliberate prosecution choice. In such cases, the declaration should explain why that choice nonetheless resulted in an unintended restriction of claim scope, rather than an attempt to recapture surrendered subject matter.

3.4 Recapture Doctrine Must Be Screened Before Asserting Broadening "Claimed Less Than Entitled" Error

Even where the asserted § 251 error is properly characterized as "claimed less than entitled," reissue is not a proper mechanism to recapture subject matter deliberately surrendered during original prosecution. If the broadening correction would reverse a deliberate narrowing made to overcome any rejection or objection (including prior art, § 112 issues, or examiner-required amendments), the reissue may be barred by recapture regardless of how well the declaration is drafted. Where broadening is pursued through conversion of solid lines to broken lines, practitioners should specifically evaluate whether the original solid-line scope reflects a deliberate prosecution narrowing.

3.5 The Declaration Must Be Internally Complete and Stand on Its Own

As with 37 C.F.R. § 1.130(a) practice, examiners treat reissue declarations as evidentiary submissions, not supplements to attorney remarks. If the nature of the error, its origin, or its legal significance is described only in remarks, examiners routinely object that the declaration is defective. Supporting explanation must appear in the declaration itself, even if duplicated in remarks.

3.6 Each Distinct Error Must Be Addressed

Where a reissue application seeks to correct multiple issues (e.g., drawing errors plus claim scope issues), the declaration must either:

- Identify each error separately, or
- Clearly state that the errors are related and explain their relationship.

Declarations that generically reference "errors" without differentiation are vulnerable to objection.

3.7 Reissue Declarations Must Affirmatively Address Examiner-Required Procedural Errors Unique to Design Reissue

Where the reissue prosecution history reflects examiner-mandated procedural steps unique to design reissue practice (e.g., required divisional filing followed by mandatory abandonment of a related application), the reissue declaration must affirmatively frame any corrective filing error within that procedural context. A declaration that omits this context risks being treated as internally inconsistent or incomplete.

3.8 Single Word/Phrase Identification May Be Sufficient If Paired With Legal Consequence

It is sufficient to identify (i) a single word, phrase, or expression that is erroneous, and (ii) how that error renders the patent wholly or partly inoperative or invalid. The corrective action need not be stated in the declaration, though including it does not make the declaration

defective. *See* MPEP § 1414 (content of reissue declaration) and MPEP § 1444 (examination of the reissue declaration).

3.9 "Wrong Drawings / Incorrect Figures" Assertions Must Identify the Error by Reference to Specific Figures and the Specific Visual Defect

A declaration is defective if it merely states that certain drawings were "inadvertently replaced with incorrect drawings" or otherwise gestures to drawings being "wrong," without identifying the error by reference to the specific figures and the specific inconsistency/defect that makes the issued patent partially inoperative or invalid.

3.10 Divisional Reissue Declaration Must Identify Error Being Corrected in That Application

Where a divisional reissue is filed with a copy of the reissue declaration from the parent reissue, the copied declaration may be initially accepted as a procedurally sufficient filing. However, during examination, if the copied declaration does not substantively identify an error actually being corrected by the divisional reissue, the examiner should reject the divisional claims under 35 U.S.C. § 251 and require a new declaration identifying an error being corrected in the divisional.

3.11 Design Reissue Remains Limited to a Single Claimed Design; Patentably Distinct Designs Trigger Restriction/Divisional Practice

A design patent is limited to a single claim directed to a single design. A reissue may correct multiple drawing-related errors, but the corrections must remain directed to the same claimed design. If amendments effectively present patentably distinct designs (for example, an entire article and a patentably distinct segregable part or subcombination), restriction practice may be required under 37 C.F.R. § 1.176(b), and divisional reissue procedure may be implicated. In that circumstance, the reissue declaration must remain aligned to the particular § 251 error actually being corrected in the application at issue.

3.12 Correcting Errors Must Not Introduce "New Matter" (35 U.S.C. § 251)

While a declaration identifies the *legal basis* for correction, it cannot provide *evidentiary support* for subject matter that was never disclosed. Even if a legitimate "error" is identified (e.g., a missing view), the correction must find clear support in the original patent disclosure. In design practice, adding new lines or views that were not explicitly or inherently present in the original drawings will trigger a new matter rejection because 35 U.S.C. § 251 limits reissue to the invention disclosed in the original patent, and written description support under 35 U.S.C. § 112(a) must be present for any added or modified subject matter. *See also* 35 U.S.C. § 132(a).

3.13 Requirement for Supplemental Declarations (37 CFR 1.175(d))

Reissue declarations are dynamic. If the prosecution results in the correction of a *new* or *different* error not explicitly covered by the initial declaration, or if the original error is no longer being corrected, a supplemental declaration is required.

Practice Point: Professionals often wait until the application is in condition for allowance to file one "cumulative" supplemental declaration that covers all final corrections made during prosecution.

3.14 Two-Year Limitation for Broadening Reissue

Any reissue application that seeks to enlarge the scope of the claims of the original patent must be filed within two years from the grant of the original patent (35 U.S.C. § 251(d)). In design patent practice, conversions from solid lines to broken lines that broaden claim scope are subject to this limitation. Non-broadening reissue applications may be filed at any time during the term of the patent.

3.15 Unavailable or Deceased Inventor: Substitute Statement Practice

A reissue declaration must be made by the proper party. For post-AIA reissue applications, the declaration is made by the applicant (37 C.F.R. § 1.63). Where the applicant is the inventor, or where the inventor is required to be the declarant, practitioners must address situations where the inventor is deceased, legally incapacitated, or cannot be located after a diligent effort, or refuses to execute the declaration.

In these circumstances, a substitute statement under 37 C.F.R. § 1.64 may be filed in lieu of the inventor's declaration. The substitute statement must:

Identify the inventor for whom the substitute statement is being filed

Identify the basis for filing the substitute statement (e.g., death, incapacity, unavailability after diligent effort, or refusal)

Include a statement that the identified inventor is the inventor of the claimed invention

Practice Points:

Where the inventor cannot be located, the practitioner should document the diligent effort to contact them before relying on § 1.64. What constitutes "diligent effort" is fact-specific, but contemporaneous records of attempted contact are advisable.

Where the inventor refuses to execute, the substitute statement procedure is available, but practitioners should evaluate whether the refusal implicates any dispute about inventorship or ownership that may affect reissue eligibility independently of the declaration requirement.

For pre-AIA reissue applications, the oath requirements differ. Practitioners should consult MPEP § 1414 and 37 C.F.R. § 1.175 for applicable pre-AIA oath requirements, and MPEP § 409 for practice regarding unavailable inventors generally.

Note that the substitute statement addresses the *execution* of the declaration and does not relax the substantive requirements for identifying the § 251 error with particularity. All content requirements discussed in this ProGuide apply equally where a substitute statement is filed.

4. Application of Rules and Guidance to Objections and Rejections

4.1 Drawings must be Erroneous

In Application No. 29/932,940, the examiner questioned whether the declaration adequately explained why the issued drawings were erroneous, rather than merely incomplete. The record reflects scrutiny of whether the correction reflected issuance-time error versus later preference.

4.2 Broad Reference to Errors Insufficient

In Application No. 29/901,769, the declaration broadly referenced errors in the issued patent without isolating the specific design defect. Examiner correspondence reflects insistence on clearer articulation of the nature of the error under § 251.

4.3 Conclusory Phrasing Insufficient

In Application No. 29/884,990, the declaration was scrutinized for conclusory phrasing and lack of factual explanation tying the asserted error to the issued design.

4.4 Error Must Render Patent Partially Inoperative or Invalid

In Application No. 29/855,713, the Examiner statements reflect concern that the declaration did not sufficiently explain how the asserted error rendered the original patent partially inoperative or invalid, rather than merely suboptimal.

4.5 Confirm that the Error existed at Issuance

Application No. 29/855,327: Procedural Context: This reissue involved an examiner-mandated sequence where:

1. The original reissue application claimed both the entire article and a patentably distinct segregable part
2. Examiner required restriction under 37 CFR 1.176(b)
3. Examiner directed filing of a divisional reissue for the non-elected subject matter
4. Examiner required suspension of the original reissue pending divisional examination
5. After allowance of both applications, examiner required petition under 37 CFR 1.183 to rejoin the designs

Declaration Issue: The examiner scrutinized whether the reissue declaration adequately identified the "error" in light of this examiner-directed procedural sequence. The examiner's concern was that the declaration characterized as "error" what appeared to be examiner-mandated compliance steps rather than an issuance-time defect in the original patent.

Applicant's Response Strategy: The applicant's declaration included procedural-context language explaining:

- The error (failing to claim the segregable part) existed at the time the original patent issued
- The examiner-mandated divisional/suspension/rejoinder sequence was the *mechanism* for correcting that issuance-time error, not the error itself
- The error was properly characterized as "claiming less than entitled" under § 251 because the original patent failed to include a design for a patentably distinct segregable part

Outcome: Although the applicant ultimately prevailed via petition practice, the record reflects that a declaration failing to situate the asserted error within the examiner-mandated procedural framework was vulnerable to objection.

Practice Point: When reissue prosecution involves examiner-directed sequencing (restriction → divisional → suspension → rejoinder), the declaration must explicitly:

1. Acknowledge the procedural context
2. Distinguish between the issuance-time error and the procedural mechanism for correcting it
3. Confirm that the error existed at issuance, even though correction requires examiner-directed steps

Model Language for Similar Situations: "The original patent failed to claim the ornamental design for [segregable part], which constituted a patentably distinct design. This omission rendered the original patent partly inoperative under 35 U.S.C. § 251 by failing to claim subject matter to which the inventor was entitled. Although correction of this error requires compliance with examiner-directed restriction and divisional reissue procedure, the error itself existed at the time the original patent issued."

4.6 Corrective Action need not be Stated

In Application No. 29/776,872, the Examiner applied the principle that it is sufficient to identify a single word/phrase/expression and explain how it renders the patent wholly/partly inoperative or invalid, and that corrective action need not be stated.

4.7 Insufficient to State figures were “inadvertently replaced with incorrect drawings”

In Application No. 29/776,872, the “Incorrect Drawings” had to be tied to figures and specific visual error. It was improper to merely state figures were “inadvertently replaced with

incorrect drawings," because that failed to specifically identify the error. The Examiner suggested that the Applicant identify the specific figure numbers/pages and explain the inconsistency or omission that made the issued figures incorrect; then state the reissue is filed to correct that inconsistency.

4.8 Oath in Divisional Reissue must Identify Error Being Corrected in Divisional

Application No. 29/704,971 involved a divisional reissue where the Parent Declaration did not identify an error being corrected in the divisional and a new oath was required. The Examiner stated that if the copied declaration did not cover an error being corrected by the divisional, then it should be rejected under § 251 and a new oath or declaration was required. The Examiner stated that the parent's broadening rationale was not an actual error being corrected in the divisional. The Examiner suggested that the error was an inaccurate broken-line description in the patent (mischaracterizing broken lines as environmental structure), and the Examiner-provided wording for a compliant declaration.

4.9 Failure to Identify a Proper Reissue Error

Examiners frequently object where the declaration does not clearly articulate a statutory error under § 251, even where the reissue amendments themselves appear facially permissible.

4.10 Conclusory Statements Without Explanation

Statements such as "the patent issued with errors" or "correction is required" are treated as insufficient. Examiners require explanation, not labels.

4.11 Reliance on Remarks to Supply Missing Declaration Content

Where the declaration is sparse and the explanation appears only in remarks, examiners routinely object that the declaration itself is defective.

4.12 Ambiguity as to Whether the Error Was Intentional

Where the prosecution history suggests intentional choices, silence in the declaration as to intent may triggers examiner concern and objection.

4.13 Declaration Silent as to Examiner-Mandated Reissue Procedure

Examiners may object where the declaration fails to acknowledge examiner-mandated reissue sequencing (e.g., divisional/abandonment structure), particularly when the asserted error appears inconsistent with actions the examiner previously required.

4.14 Divisional Reissue Uses Parent Declaration That Does Not Match the Divisional Correction

Examiners reject divisional reissue claims under § 251 where the divisional was filed with a parent reissue declaration, but the declaration does not identify an error that is actually being corrected in the divisional (requiring a new declaration).

4.15 Mismatch Between Declared Error and Amendments

Examiners object where the declaration identifies one type of error (e.g., omission of views) but the amendments suggest a different correction (e.g., alteration of line scope or contour).

4.16 Boilerplate Reissue Language

Avoid using generic, utility-style reissue templates that do not account for the unique constraints of design practice. In particular, generic forms often lack the specificity required to describe drawing inconsistencies and may fail to respect the single-claim restriction inherent to design patents. Practitioners must ensure the declaration is made by the proper party (the inventors for pre-AIA or the applicant for AIA) and that it explicitly identifies the issuance-time error relative to specific figure numbers and visual defects. Treating the declaration as a boilerplate formality is a recurring and costly mistake that frequently invites examiner objections.

4.17 "Incorrect Drawings" Error Stated as a Conclusion, Not an Identified Error

A declaration is treated as defective when it asserts that figures were replaced with incorrect drawings (or similar) but does not identify the actual drawing error by reference to the specific figure(s) and what is inconsistent/incorrect about them (i.e., why the issued patent is partially inoperative/invalid).

5. Practice and Enforcement Notes

5.1 Examiners appear to apply a higher explanatory standard to reissue declarations than to original filing declarations.

5.2 Design reissue declarations are frequently evaluated independently of whether the amendments themselves appear allowable.

5.3 Treating the declaration as a procedural formality is a recurring and costly mistake.

5.4 Drafting the declaration first, and aligning amendments to it, reduces objection risk.

5.5 Practice Point for Divisional Reissue Declarations. The Office may accept a copy of a parent reissue declaration when filing a divisional reissue, but the examiner can still require a new declaration (and reject under § 251) if the copied declaration does not identify an error being corrected in the divisional.

Appendix 1
Checklist

A. Before Drafting the Declaration (Triage)

□ Confirm whether the reissue is post-AIA or pre-AIA (file date relative to 9/16/2012) and draft accordingly.
□ Identify the exact correction target(s) (drawings / figure descriptions / broken-line statements / claim scope effects).
□ Identify the issuance-time error (what was wrong at issuance, not what is preferred now).
□ If the file history shows deliberate choices at issuance, identify the intent issue to address (misunderstanding, unintended scope, incomplete disclosure, etc.).
□ If the reissue involves design-specific procedural steps (restriction/divisional/suspension/abandonment), identify the procedural context that must be acknowledged.
□ Confirm that all required inventors are available to execute the declaration; if any inventor is deceased, incapacitated, unavailable, or refusing, identify the basis for a substitute statement under 37 C.F.R. § 1.64 before drafting.

B. Core § 251 Error Statement (Must-Have Elements)

□ Does the declaration identify a statutorily cognizable "error" under § 251 (not merely "defective" or "needs correction")?
□ Does it state where the error appears (figure numbers / specific wording / claim language / description language)?
□ Does it explain why the error renders the patent wholly or partly inoperative or invalid (not merely incomplete or suboptimal)?
□ Does it state the error existed at the time of issuance, even if discovered later?
□ If multiple errors are being corrected, does it separately identify each error or clearly explain their relationship?

C. Drafting Quality Controls (Avoidable Objection Triggers)

□ Is the declaration self-contained (i.e., an examiner could evaluate reissue eligibility from the declaration alone)?
□ Does the declaration avoid conclusory language (e.g., "incorrect drawings," "needs correction," "clarification required") without explanation?
□ Does it avoid advocacy tone (legal argument reserved for remarks)?
□ Does it avoid describing the "error" as a post-issuance preference, redesign, or refinement?
□ If the declaration states "incorrect drawings," does it identify the specific figures and the specific visual defect/inconsistency?

D. Checklist for 37 CFR 1.173(b)(3) Compliance (Accompanying Papers)

 Detailed Explanation: You must provide a separate sheet (not just remarks) explaining every change to the drawing in detail.
 Annotated Marked-up Drawings: A copy showing changes (brackets for canceled lines, underlining for new/amended lines) must be submitted for comparison.
 Clean Replacement Sheets: Standard replacement sheets labeled as "Amended," "Canceled" (within brackets), or "New" are required for the final record.

E. Special Situations

Divisional reissue

□ If a parent reissue declaration is being reused, does the declaration identify an error actually being corrected in the divisional (not just the parent)?
□ Does it avoid a mismatch where the “error” described is moot in the divisional?

Examiner-mandated procedural context

□ If the prosecution posture required examiner-directed sequencing (e.g., restriction → divisional → suspension/abandonment), does the declaration briefly acknowledge that context and explain how the asserted error fits within it?

Supplemental declaration (alignment during prosecution)

□ If prosecution changes introduce a correction that is not fairly encompassed by the original error statement, consider filing a supplemental reissue declaration/oath so the declaration continues to identify an error actually being corrected in the application as prosecuted (and is not dependent on attorney remarks to supply the missing linkage).

F. Final “No-Remarks” Test (Fast Gatekeeper)

□ If the examiner reads only the declaration (no remarks, no amended drawings visible), can the examiner identify:

(1) What the error was?
(2) Where it appears in the issued patent?
(3) Why it makes the patent wholly or partly inoperative or invalid?

Appendix 2
Questions and Answers

Q1. What is the single most common reason examiners object to reissue declarations in design cases?

A. The declaration identifies a correction (e.g., "fix drawings" or "add/cancel views") but fails to identify the issuance-time error with particularity and fails to explain why the patent was wholly or partly inoperative or invalid under § 251.

Q2. Is "we are correcting errors in the drawings" sufficient?

A. No. That is typically treated as conclusory. The declaration must identify what was wrong (by reference to specific figures/wording) and explain why the defect made the patent wholly or partly inoperative or invalid.

Q3. Do I have to describe the corrective action being taken in the reissue?

A. Not necessarily. It is often sufficient to identify the error (including a single word/phrase/expression where appropriate) and explain how it renders the patent wholly or partly inoperative or invalid. Stating the corrective action may be included, but it does not substitute for a proper error explanation.

Q4. The "error" was discovered after issuance. Is that a problem?

A. Not if the declaration clearly states the error existed at issuance and explains how it manifested in the issued patent. The key is issuance-time error, not discovery date.

Q5. If the original drawings were intentionally chosen, is reissue barred?

A. Not automatically. But if the file history reflects a deliberate choice, the declaration should address why that choice nevertheless produced a § 251 "error" (e.g., misunderstanding of legal effect, unintended scope, incomplete disclosure).

Q6. Can I rely on attorney remarks to supply the missing "error" explanation?

A. No. Examiner practice commonly treats reissue declarations as evidentiary submissions that must be internally complete. Missing content in the declaration is not cured merely because the remarks explain it.

Q7. What's wrong with stating "incorrect drawings were inadvertently substituted"?

A. Standing alone, it is usually too conclusory. The declaration should identify the specific figure numbers and the specific visual defect/inconsistency that makes the issued patent partly inoperative or invalid.

Q8. How specific does the declaration need to be for drawing-related errors?

A. It must be specific enough that the examiner can understand the defect without guessing: identify the figure(s), describe the defect, and explain the legal consequence (inoperative/invalid in whole or in part).

Q9. How should I handle multiple errors in one reissue?

A. Identify each error separately, or clearly explain how they relate. Generic references to "errors" without differentiation commonly invite objection.

Q10. Are drawing corrections always acceptable in design reissue?

A. No. Examiners generally do not object merely because a correction is drawing-related, but the declaration must articulate the underlying error, and the prosecution must still comply with other requirements (including avoiding new matter).

Q11. I'm filing a divisional reissue. Can I reuse the parent declaration?

A. Sometimes a copied declaration will be accepted as a declaration, but it can still be defective if it does not identify an error being corrected in the divisional. If the error described is not the one addressed in the divisional, the Office may require a new declaration and may reject under § 251.

Q12. What is the best practice workflow to avoid declaration objections?

A. Draft the declaration first (error → location → consequence), then align the reissue amendments to the declared error. This reduces mismatch problems and avoids having the declaration look like a post-issuance preference statement.

Q13. Do I ever need a supplemental reissue declaration during prosecution?

A. Potentially. If the reissue amendments ultimately pursued are not fairly encompassed by the error described in the original declaration, the Office may view the declaration as misaligned with what is actually being corrected and may require a corrected or supplemental declaration. As a best practice, if the prosecution trajectory materially changes the correction being pursued, consider updating the declaration so it clearly identifies an error that matches the reissue as prosecuted.

Q14. If converting solid lines to broken lines broadens the claim, shouldn't the error be that the patentee "claimed more than he had a right to claim"?

A. No. In design patent practice, over-specifying structure in solid lines can improperly restrict claim scope by excluding embodiments that were part of the inventor's design. Although the reissue correction broadens the claim, the issuance-time error is that the patentee claimed *less* than he had a right to claim because the original drawings imposed

unintended structural limitations. This is why broadening reissues based on line-conversion are properly grounded in the "claimed less than entitled" category under § 251.

Q15. Can I file a broadening reissue if my design patent has been on the market for more than two years and I discover that solid lines are excluding commercial embodiments?

A. No. Under 35 U.S.C. § 251(d), any reissue application that enlarges the scope of the original patent claim must be filed within two years from the grant of the original patent. In design patent practice, converting solid lines to broken lines to remove unintended structural limitations constitutes a broadening of claim scope and is therefore time-barred if filed more than two years after grant. After the two-year window closes, only non-broadening reissue corrections are permitted.

Appendix 3
Limitations

1. Scope Limited to Reissue Declarations.

This ProGuide is limited to drafting and responding to examiner objections and rejections directed to reissue declarations/oaths in design patent reissue practice.

2. Not a General Reissue Manual.

This ProGuide does not comprehensively address reissue practice topics such as petition practice, publication/Official Gazette procedures, expedited examination mechanics, prosecution sequencing, or post-allowance amendment practice, except where those topics intersect with declaration requirements.

3. Not a New Matter or Substantive Allowability Guide.

This ProGuide does not provide a full new matter analysis framework for design reissue drawing changes, nor does it address substantive patentability issues. Any references to new matter are included only to prevent misunderstandings about what a declaration can accomplish.

4. Not a Recapture Doctrine Guide.

Recapture doctrine is not treated comprehensively. The ProGuide references recapture only to the extent an examiner's declaration objection or reissue eligibility analysis overlaps with how the error is characterized.

5. Examples Are Illustrative, Not Exhaustive.

Example applications are cited for practitioner reference and illustrate recurring declaration issues. They do not represent an exhaustive catalog of all examiner approaches across design Technology Centers or art units.

6. Practice May Vary by Examiner and Procedural Posture.

Examiner sensitivity to declaration phrasing can vary based on prosecution posture (e.g., divisional reissue context, prior examiner-mandated sequencing, or perceived intent issues). This ProGuide provides rules and forms intended to reduce objection risk across typical scenarios, but it cannot eliminate examiner discretion.

7. Authority and Fees Should Be Verified in Current Sources.

Statutory, regulatory, MPEP, and fee references should be confirmed in current USPTO sources. Fee amounts and certain procedural guidance can change over time.

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

Note: MPEP section numbers are cited by section only. Practitioners should consult the current edition of the MPEP for the most recent revisions.

1509 Reissue of a Design Patent

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 canceled 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 shows 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 canceled. However, if a drawing view is canceled 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 canceled 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

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.

I. EXPEDITED EXAMINATION PROCEDURE

Design reissue applications requesting expedited examination and complying with the requirements of 37 CFR 1.155 are examined with priority and undergo expedited processing throughout the entire course of prosecution in the Office, including appeal, if any, to the Patent Trial and Appeal Board. All processing is expedited from the date the request is granted.

Design reissue applicants seeking expedited examination may file a design reissue application in the Office together with a corresponding request under 37 CFR 1.155 pursuant to the guidelines set forth in MPEP § 1504.30.

The design reissue application and the request are processed by the Office of Patent Application Processing (OPAP). OPAP enters the appropriate information into Patent Data Center specifying when notice of the design reissue application will be published in the Official Gazette (see MPEP § 1441). After processing in OPAP, the design reissue application and the request are forwarded to the Design TC Director's Office. Upon a decision by the Design TC Director to grant the request for expedited examination, the design reissue application file is referred to the Office of Patent Legal Administration (OPLA) for consideration under 37 CFR 1.182 to sua sponte waive the requirement for delaying action in the application until 2 months after announcement of the design reissue application filing is published in the Official Gazette (see MPEP § 1441). Once the decision under 37 CFR 1.182 is mailed, the design reissue application file will be returned to the Design TC Director's Office. In accordance with the waiver, the Design Group will begin expedited examination of the application under 37 CFR 1.155 promptly after the return of the design reissue application file from OPLA, rather than delay examination until after 2 months from the date the announcement is published in the Official Gazette and the applicant will be notified that examination is being expedited. The decision under 37 CFR 1.182 will require that no Notice of Allowance be mailed in the design reissue application until after 2 months from the

date the announcement is published in the Official Gazette. For example, if the design reissue application is allowed on the first Office action, then jurisdiction over the reissue application will be retained in the TC, and the Notice of Allowance will not be mailed until the expiration of 2 months after publication of the filing of the design reissue application in the Official Gazette (plus time for matching any protest filed with the application). The examiner will check the Patent Data Center contents to ascertain when publication actually occurred. The delay in the mailing of the Notice of Allowance is to ensure that any potential protests complying with 37 CFR 1.291 submitted within the 2-month delay period will be considered by the Office. (see MPEP § 1441.01).

The expedited examination procedure under 37 CFR 1.155 occurs through initial examination processing and throughout the entire prosecution in the Office. Once a request for expedited examination is granted, prosecution of the design reissue application will proceed according to the procedure under 37 CFR 1.155, and there is no provision for "withdrawal" from expedited examination procedure.

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 is not permitted in a design application pursuant to the last sentence of 37 CFR 1.153(a).

Fee Disclaimer: Reissue filing, examination, and issuance fees are subject to periodic adjustment. Practitioners should verify current fee amounts at the USPTO’s official fee schedule (www.uspto.gov/fees).

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 [without any deceptive intention - pre-AIA only], 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.