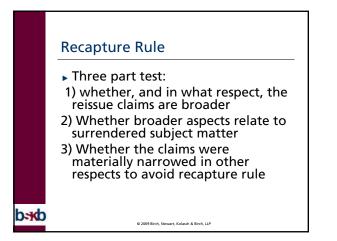


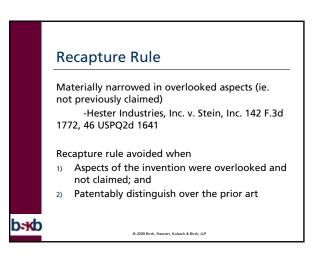
Compared to Continuation and Divisional Applications

- Court states that claims can be pursued in a continuation and divisional application restricted by only the requirement of the written description requirement
- Seeking to add claims in a reissue application requires that the claims not violate the recapture rule and the statutory original patent requirement

b:xb

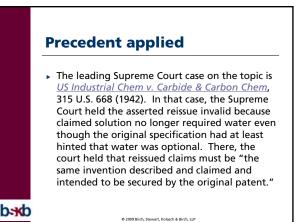
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Original Patent Requirement • This "original patent" requirement is roughly equivalent to both the written description requirement and the prohibition on new matter — all three basically require that the original patent specification disclose the particular invention now being claimed.

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Precedent applied It is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification but must be explicitly disclosed and taught in the specification- McCullough Tool Co. v. Well Surveys, Inc. 343 F.2d 381 (10th Cir 1965) Court has rejected an "intent to claim" test

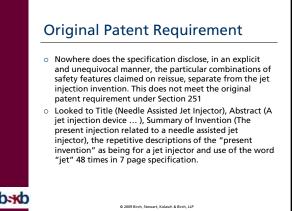
In re Mead, 581.5.2d 251 (C.C.P.A. 1978)

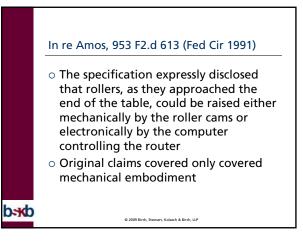
Original Patent Requirement

• The specification discussed only one invention: a particular class of jet injectors. . . . Although safety features were mentioned in the specification, they were never described separately from the jet injector, nor were the particular combinations of safety features claimed on reissue ever disclosed in the specification. Rather, the safety features were serially mentioned as part of the broader conversation: how to build the patented jet injection device

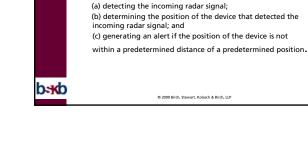
b:xb

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Reissue Application

- o Amends independent claim 11, rewrites claim 18 into independent form, add many dependent claims
- Claims error is not having claimed certain features, now recited in new claims
- o Escort states that there is no error being corrected

b:xb

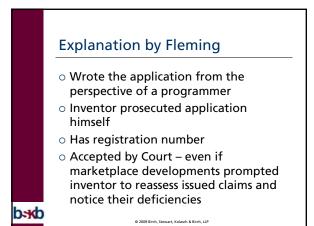
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Recapture not an error

 Deliberate withdrawal or amendment cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the withdrawn subject matter

b-xb

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 Conclusion

 • Any questions