

Broadening Your (Patent) Protection

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In the fast-paced world of innovation, inventors sometimes realize that their patents do not fully protect their inventions until after the patent issues. If the patent family has an application still pending at the patent office, the solution is to claim the invention more broadly in the continuation application. If there is no pending continuation, it still may be possible to file for a reissue patent to broaden the scope of the patent's claims. But do not delay filing this; claims may only be broadened in a reissue patent application when filed within two years of the date that the original patent was issued (Figure 1).

What is a broadening reissue patent application? A broadening reissue patent application is a request by a patent owner to modify an already-granted patent to enlarge the scope of its claims. For example, suppose you invented a new catalyst for the catalytic cracking of hydrocarbons to make ethylene. You filed a patent application, the original patent application was allowed, and the patent was issued. But the original patent claims only covered the novel catalyst in a narrow range of concentrations, even though the patent disclosed that the catalyst worked more broadly. Once the patent was issued, competitors quickly adopted the catalyst. However, the competition was savvy and employed the catalyst in a concentration outside that of the one claimed to avoid infringing the patent.

If you had failed to claim the concentration more broadly due to an error and without deceptive intent, then you can file a broadening reissue patent application to broaden the scope of your patent.

Reasons for seeking a broadening reissue. Patent owners pursue broadening reissues for several reasons. The case above is an example of unnecessarily narrow claims. In that example, the granted patent had overly narrow claims, leaving room for competitors to design around the patent. This is a surprisingly common reason to file a broadening reissue patent application.

There are other reasons, too. For example, the patent may have been filed prior to the business commercializing a

product and, therefore, the claims do not cover the commercialized product. In this case, the original claims might not be overly broad but might claim something slightly different than what the business needs to protect. Sometimes, a clerical error was made that had a substantive effect during the original prosecution that needs to be corrected.

Lastly, the law could change. Most people think of the law as being written in stone, but it is ever-evolving with each court decision. A patent owner may wish to file a broadening reissue patent application to account for a new court decision that would have otherwise adversely affected the scope of the original patent's claims.

Legal requirements. There are several requirements for filing a broadening reissue patent application. First and foremost, there is a two-year deadline. The broadening claims must be filed within two years of the original patent issue date. This is for public policy reasons. On one hand, the patent owner wishes to profit from the full scope of the invention. On the other hand, the public needs to know when it can begin using technology legitimately in the public domain. Congress decided that two years struck the right balance between patent owners' interests and the public interest.

Beyond the two-year deadline, the patent owner must establish that an error occurred in the original patent, leading to claims that are too narrow. Often, this is as simple as not realizing that broader claims could have been pursued. But not realizing that broader claims could have been pursued is different than making a conscious decision not to pursue broader claims in the first place, whether to avoid a piece of prior art or for other considerations. Similarly, any mistake justifying the reissue must not have been made with deceptive intent. Purposely pursuing narrow claims to get your competition to invest heavily in technology that you know could be covered by a patent claim would be ineligible.

Finally, the reissue cannot introduce new subject matter beyond the original disclosure. Claiming matter that was originally disclosed but not claimed is allowed, but one cannot claim a new invention that was never previously disclosed in the original patent and call it a broadening reissue.

Closing thoughts. Broadening reissue patent applications provide a valuable mechanism for patent owners to correct overly narrow claims and strengthen their intellectual property portfolio. If you, too, are considering filing for one, just remember to act quickly before the two-year deadline passes.

CEP



▲ **Figure 1.** A reissue patent application must be filed within two years of the original patent issue date in order to broaden the patent's claims.

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