

Using Reissue Applications To Strategically Improve Patents

By **Curtis Powell** (September 11, 2025)

Reissue applications represent a very small fraction of the total number of applications filed at the U.S. Patent and Trademark Office each year.

Indeed, at the midpoint of 2025, over 1.2 million utility applications have been filed, with less than 300 of them being reissue applications. As such, it is not uncommon to speak to a U.S. patent practitioner or patent owner that has never filed a reissue application.



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Yet, despite their rarity, reissue applications can offer powerful tools for correcting errors, strengthening patent protection, or adapting to evolving business and legal landscapes — making them an often-overlooked but critical strategic consideration in today's competitive environment.

This article provides an overview of strategic uses and considerations for reissue applications to help you identify instances when pursuing a reissue application would be advantageous.

Establishing an Adequate Ground for a Reissue Application

As is evident, to pursue a reissue application successfully, you must first get a reissue application on file. However, the requirements for filing a reissue application differ from the more familiar requirements for filing a continuation application.

A reissue application is a statutorily provided mechanism to correct an error in an unexpired patent. As such, to successfully get a reissue application on file, you must expressly identify an error in an unexpired patent.

However, not all errors provide sufficient ground for a reissue application. The identified error must render the patent "wholly or partly inoperative or invalid," according to Title 35 of the U.S. Code, Section 251(a). "Claiming more or less than [one] had a right to claim in the patent" is an error that provides adequate ground for a reissue application, and it is the most common error expressly identified by successful filers of reissue applications.

Some may feel dissuaded from filing a reissue application because of concerns in stating on the record that an issued patent has an error that renders it wholly or partly inoperative or invalid.

The U.S. Court of Appeals for the Federal Circuit clarified, however, in *In re: Tanaka* in 2011, that "the omission of a narrower claim from a patent can render a patent partly inoperative by failing to protect the disclosed invention to the full extent allowed by law."

In other words, the error that renders a patent wholly or partly inoperative or invalid — and that provides grounds for a reissue application — may simply be the error of not previously including a narrower dependent claim that provides more robust coverage of a species already encompassed by issued claims of the patent. As such, a statement on the record identifying an error that renders a patent wholly or partly inoperative or invalid can be quite

innocuous.

Many of the strategic uses of reissue applications discussed below relate to adjustments to issued claim scope, which may also provide adequate ground for filing a reissue application.

Others, however, relate to adjustments that do not alone provide adequate grounds for reissue. To pursue these strategic uses of reissue applications, one can first provide sufficient ground for the reissue application, *a la In re: Tanaka*, by introducing a narrower dependent claim that provides more robust coverage of a species already encompassed by issued claims of the patent, or by identifying another error that renders the patent wholly or partly inoperative or invalid.

Strategic Uses of Reissue Applications — Adjusting Claim Scope

As mentioned above, many uses of reissue applications relate to adjustments to issued claim scope, which can also provide adequate ground for filing a reissue application.

Reissue applications are commonly filed to make these types of adjustments in anticipation for an enforcement proceeding, e.g., to strengthen the validity of issued claims or to strengthen an infringement position.

However, reissue applications can also be filed to adjust claim scope even after claims have been found invalid, e.g., before a court or before the USPTO, although there are time constraints to do so.

For example, the Patent Trial and Appeal Board has expressly stated that a reissue application may be filed at any time before issuance of a USPTO certificate canceling all patent claims or a Federal Circuit mandate finding all claims invalid.

There are other instances — beyond the common uses described above — when the filing of a reissue application to adjust claim scope can be beneficial. For example, a reissue application could be used to do the following.

Update an Orange Book-listed patent to include a claim that recites the presence of an active drug.

The Federal Circuit has held, in *Teva Branded Pharmaceutical Products Research & Development Inc. v. Amneal Pharmaceuticals of New York LLC* last year, that, in order for a patent to be properly listed in the Orange Book, it must claim the active ingredient of an approved drug. The Federal Circuit has made clear that patents that only claim the device components of a product approved in a drug application do not meet this requirement.

Maintain the patent term adjustment of an issued patent.

Typically, continuation applications are filed to pursue new subject matter. However, reissue patents carry the unexpired term of their corresponding original patents.[1] As such, if an issued patent received a substantial amount of patent term adjustment, you may consider pursuing the new subject matter in a reissue application as opposed to pursuing the subject matter in a continuation application.

Selecting a first filed, first issued patent would have the additional benefit of avoiding nonstatutory double patenting issues over later filed, later issued patents in the same family.[2]

Reduce a nonstatutory double patenting footprint.

The common practice of filing serial continuation applications for the full 20-year statutory term can result in a large nonstatutory double patenting footprint. Filing a reissue application instead of a continuation application can help reduce the size of this footprint.

One could also consider filing a reissue application to remove potential reference claims, e.g., dependent claims reciting narrow species, in an attempt to avoid a potential double patenting rejection in an application that you anticipate filing, e.g., to pursue claims that encompass species recited in the issued dependent claims.

Additional Strategic Uses of Reissue Applications

As mentioned above, some strategic uses of reissue applications relate to adjustments that do not alone provide adequate grounds for reissue. For example, a reissue application could be used for the following.

Revive prosecution of a patent family without a pending application.

There may be times when you are interested in pursuing unclaimed subject matter disclosed in an issued patent, but no related application is pending. In such an instance, you may be able to pursue the subject matter in a broadening reissue application.

Moreover, once a broadening reissue application has been filed, serial broadening continuation reissue applications can be filed, claiming priority to the initial reissue application, to pursue additional subject matter.

Prosecute claims before a new examiner.

Reissue applications can present an opportunity to prosecute claims before a new examiner. If you are facing challenges with an examiner during prosecution of an application, and there is a related issued patent in the family, you could consider filing a reissue application to pursue the claims. Reissue applications are examined by senior patent examiners and supervisory patent examiners in the Central Reexamination Unit of the USPTO.

Correct an improper examination of a patent application.

Some patents have issued from transition applications that were mistakenly examined under pre-America Invents Act law. A reissue application can be filed to address this defect by requesting examination of the reissue application under the AIA, as opposed to the pre-AIA.

Limitations of Reissue Applications

There are various limitations on how reissue applications can be used.

First, reissue applications cannot be used to cure all defects in a patent, even when an error providing ground for a reissue application is present. Courts have reasoned that reissue applications should be used to correct "inadvertence, accident, or mistake," according to the Federal Circuit in *In re: Weiler* in 1986.

In the absence of evidence of inadvertence, accident or mistake, an error may be

designated a deliberate choice that is later regretted. Examples of errors that cannot be corrected via a reissue application include:

- A failure to timely file a divisional application to pursue nonelected subject matter is not correctable by reissue.[3]
- A failure to designate an application as a divisional application prior to issuance is not correctable by reissue.[4]
- The filing of an erroneous terminal disclaimer, e.g., over a reference patent that is not commonly owned by the owners of the patent at issue, is not correctable by reissue.[5]

In addition, reissue applications are limited by the following:

- Two-year timing limitation: A first broadening reissue application must be filed within two years of a patent's issuance.[6] A reissue application is broadening if it includes a claim that encompasses any subject matter not encompassed by the original patent. As noted above, broadening reissue applications can be filed after the two-year period, if a patent reissue application was a broadening reissue application that was filed within two years from issuance.
- Recapture: The rule against recapture provides that a reissue application cannot be used to recapture subject matter that was surrendered during prosecution of the original claims.[7]
- Orita doctrine: The Orita doctrine precludes the use of a reissue application to pursue subject matter that was not elected — a nonelected invention or a nonelected species — during prosecution of the application giving rise to the original patent.[8]
- The original-patent requirement: The original-patent requirement finds its roots in Section 251 and has been likened to a heightened written description requirement.[9]

Additional Strategic Considerations

In addition to the limitations highlighted above, the following are additional items to consider before pursuing a reissue application:

- Third-party protests: Third-party protests are similar to third-party preissuance submissions; however, unlike third-party preissuance submissions, which have a very limited time window for submission, third-party protest can be filed at any time prior to allowance of a reissue application.[10]
- Intervening rights: Intervening rights protect the interests of those who begin infringing activity that is newly covered by a reissue patent, before the reissue patent is granted.[11]

Conclusion

Although utilized infrequently, reissue applications are sometimes the best tool available to achieve your goals. Before pursuing a reissue application, however, it is important to consider the limitations of reissue applications, as well as potential third-party protests and intervening rights, to help steer your strategy for and assess the value of the reissue application.

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[1] See Title 35 of the U.S. Code, Section 251.

[2] See Allergan USA, Inc. v. MSN Lab'ys Priv. Ltd., 111 F.4th 1358 (Fed. Cir. 2024).

[3] See In re Watkinson, 900 F.2d 230 (Fed. Cir. 1990).

[4] See G.D. Searle LLC v. Lupin Pharm., Inc., 790 F.3d 1349, 1355 (Fed. Cir. 2015).

[5] See In re Dinsmore, 757 F.3d 1343, (Fed. Cir. 2014); see also SIPCO, LLC v. Jasco Prods. Co., LLC, 736 F. Supp. 3d 1109, 1115 (W.D. Okla. 2024).

[6] See 35 U.S.C. § 251.

[7] See In re McDonald, 43 F.4th 1340, 1345 (Fed. Cir. 2022); see also Ball Corp. v. United States, 729 F.2d 1429, 143).

[8] See In re Orita, 550 F.2d 1277, 1280 (CCPA 1977).

[9] See Antares Pharma, Inc. v. Medac Pharma Inc., 771 F.3d 1354 (Fed. Cir. 2014).

[10] See M.P.E.P. § 1901.02.

[11] See 35 U.S. Code § 252.