

September 21, 2016

---

## Post-Grant Patent Amendment – Canadian and US Options



By [Shohini Bagchee](#)

On the long and sometimes bumpy road of patent prosecution, a Notice of Allowance can be a welcome sign that you are nearly at your destination: a granted patent. But the journey is not over yet. At the time of grant, what if you realize that you need to amend the claims to better protect your invention, or correct mistakes in the patent?

The good news is that both the Canadian and US patent systems offer mechanisms for patentees to amend, to a limited degree, claims and other parts of their patents and to correct mistakes. The bad news? In some cases, some of these same mechanisms may also be used by your competitors to challenge your granted patent. We discuss these mechanisms below.

### At the USPTO:

1. Ex Parte Re-examination - Either the patent holder or another party can request an ex parte re-examination. In an ex parte re-examination the review of a patent is based solely on prior art patents and printed publications. The standard for instituting ex parte re-examination is a substantial new question of patentability, which is whether there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. The ex parte re-examination procedure is available at any time as long as the patent is enforceable.

An amendment may be submitted in an ex parte reexamination proceeding. Patent owners cannot file any amendment prior to an initial Office Action on the merits in any ex parte re-examination proceeding.

2. Inter-Partes Review – is a procedure by which third parties can challenge the validity of patent claims based on patents and printed publications. Inter partes review can be initiated immediately following issuance for patents filed prior to March 16, 2013. For patents filed on or after March 16, 2013, inter partes review is the

mechanism for challenging the validity after nine-months have passed since issuance.

An inter partes review can be filed within one year of a third party being served with an infringement complaint by the patentee. For an inter partes review to be commenced, a third party must establish a reasonable likelihood that they will prevail on at least one claim. The prior art available for inter partes review is limited to prior art grounds based on patents and printed publications.

3. Post-Grant Review – can be commenced by a third party within the first nine months of issuance of a patent and typically concludes within one year of commencement. Post-grant review proceedings are initially handled by the Patent Trial and Appeal Board (PTAB), and a final decision of the PTAB is appealable to the U.S. Court of Appeals for the Federal Circuit either by the patent owner or the third party.

To invoke post-grant review, a challenge must be filed within nine months of a patent's issuance, based on any grounds that can be used to challenge the validity of a patent claim. In addition to patents and printed publications, post-grant review can be sought by alleging unpatentability based on evidence of public use, on-sale activity, or other public disclosures, or based on an alleged lack of compliance with written description, enablement, or patent eligibility requirements.

4. Patent Reissue – is an avenue for correcting errors in an issued patent. By eliminating a previous requirement that the error occur without "deceptive intent," the USPTO has made it easier to request a reissue. The reissue proceeding is handled by a patent examiner and is similar to a standard patent prosecution. It may be particularly helpful to clients who are preparing to enforce their patent through a patent infringement lawsuit. Patent claims can be amended in a Reissue.

#### **At the Canadian Patent Office:**

1. Re-Issue - Re-issue is the only method to obtain broadening amendments for an issued patent. A patent may be reissued if a patentee claimed more or less than s/he had a right to claim as new, and (i) the error arose from inadvertence or accident; (ii) the error was without deceptive intention, and (iii) the application for re-issue is filed within four years of the date of patent issuance. For a broadening amendment to be valid, the claims must be directed to what the patentee was attempting to protect in the original application. Further, the broadening amendments must be reasonably inferable from the original specification.
2. Disclaimer - Disclaimer is a procedure allowing a patentee to narrow the claims of the patent by disclaiming particular subject matter. A patentee may disclaim any subject matter that was included by mistake, accident or inadvertence without any willful intent to mislead or defraud the public. There is no time limit on disclaimer. A patentee can disclaim a whole claim or only a portion of a claim. Generally, a disclaimer will not affect court proceedings initiated before the filing of the disclaimer.
3. Clerical Errors – To correct a clerical error, the patentee simply writes a letter to the Patent

Office requesting the correction and explaining the origin of the mistake. The correction of clerical errors may be less likely to be permitted if it would negatively affect the rights of others by, for example, broadening the claim scope.

Re-Examination - Either a third party or the patentee may request re-examination to narrow the patent scope. The requesting party must provide prior art, explain its pertinency and how it raises a substantial new question of patentability of a claim. The possible consequences of re-examination include (i) upholding of the claim in question as patentable; (ii) cancellation of the claim as invalid; or (iii) amendment of the claim by the patentee to be patentable over the prior art.

For questions regarding patents, contact [Shohini](#) in our [Intellectual Property and Technology Group](#).

**SHARE THIS ARTICLE**



---

**CALGARY**

400 - 604 1 ST SW  
Calgary AB T2P 1M7  
403-260-8500

**EDMONTON**

2000 - 10235 101 ST  
NW  
Edmonton AB T5J 3G1  
780-423-3003

**YELLOWKNIFE**

601 - 4920 52 ST  
Yellowknife NT X1A 3T1  
867-920-4542

---

© 2016 Field Law. All rights reserved.

Articles contain general legal information only - always contact your lawyer for advice specific to your situation.

"Field Law" and the Field Law logo are registered trademarks of Field LLP.

"Field Law" is a registered trade name of Field LLP.