



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Dethmers Mfg.
Co.
v.
Automatic
Equip. Mfg. Co.***

Nos. 00-1114,
-1130
Federal Circuit
Dec. 5, 2001

***“Rule 175 . . .
requires a
reissue
declaration to
‘specify every
difference
between the
original and
reissue
claims.’”***

On December 5, 2001, the Federal Circuit affirmed-in-part and reversed-in-part the district court’s summary judgment that U.S. Reissue Patent No. 35,482 (reissued from U.S. Patent No. 5,232,240) is invalid because a substitute reissue declaration supported only some of the patent claims as required by 37 C.F.R. § 1.175 (Rule 175). The reissue application was filed to correct two asserted errors in the original patent: (1) the inclusion of the subject matter of application claims 2 and 3 in application claim 7 (and thus in original patent claim 1) and (2) the use of the term “pivot block” in application claim 4 (and thus in original patent claim 1). The patented technology related to collapsible and removable hitches for towing vehicles, such as a hitch for towing a car behind a motor home. The Federal Circuit reviewed the Rule 175 compliance issue *de novo*, on which basis Judge Dyk dissented. In any event, the Federal Circuit noted:

Rule 175 . . . requires a reissue declaration to “specify every difference between the original and reissue claims.” [W]ord-for-word correspondence is [not] required between a reissue declaration and the changes made in a reissue application. . . . Rule 175 does require a reissue declaration to “particularly specify[] each error relied upon, and how they arose or occurred” and to state that the “errors arose ‘without any deceptive intention.’” . . . Rule 175 requires a reissue declaration “explaining the source of [every] error, that it was non-deceptive and otherwise excusable, and how the amendment corrects the [error.]” . . .

“There are two substantive errors that arose in the claims of the patent which are at issue. . . . The errors arose because Johnson failed to appreciate the limiting effects of [certain] language. Such errors arose without any deceptive intent on the part of Johnson or his attorneys.” As discussed above, the district court determined that all of the reissue claims are invalid because they all “contain undisclosed alterations, either in their text or in the supporting drawings and specifications.” Because the court did not discuss each claim individually, it is difficult for us to review this determination. Automatic has not pointed to any changes to the specification that were not explained in the reissue declaration. The changes to the drawings that were made in the reissue application consist of the addition of reference numerals to two of the figures. [A] reissue declaration might not need to explain an amendment that was required by the examiner because the examiner “arguably . . . would already know what the declaration might tell him.” We also left open the question whether “small language changes that do not affect the scope of the claims” need to be explained in a reissue declaration. We hold that because the changes to the drawings made in the reissue application appear to have been required by the Patent Office and do not affect the scope of the claims, they did not have to be explained in the reissue declaration. Because the only other differences in the reissue patent appear in the claims, the validity of each claim turns on whether the substitute reissue declaration explains every difference in that claim. . . .