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OFFICE OF PETITIONS

MATTINGLY, STANGER & MALUR, P.C.
Suite 370
1800 Diagonal Road
Alexandria VA 22314

In re Patent No. 7,475,261 :
Issue Date: January 6, 2009 :
Application No. 10/768,136 : DECISION ON PETITION
Filed: February 2, 2004 :
Patentee: Y. TOTSUKA et al. :
Attorney Docket No. ASA-788-02 :

This is a decision on the renewed petitions filed September 30, 2010, requesting under the provisions of 37 CFR 1.182 or in the alternative under 37 CFR 1.183, a review of the Decision mailed July 30, 2010, that dismissed the petitioner's request for a review of the Office's decision of August 4, 2009 denying patentee's request for Certificate of Correction filed July 6, 2009.

The petitions are **DENIED**.

BACKGROUND

1. On February 2, 2004, the instant application was filed as a continuation of Application having the serial number 09/308,488.
2. The non-final Office action dated March 25, 2008 included a rejection under the grounds of non-statutory obviousness-type double patenting noting that the claims were unpatentable "over claims 1-9 of U.S. Patent No. 6,715,090 in view of Smith et al., and in view of Martin, U.S. Patent No. 5,111,058."
3. The applicants filed a response on June 25, 2008 that included a Terminal Disclaimer signed by the petitioner herein, disclaiming the terminal part of the statutory term of the instant patent "which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of U.S. Patent No. 6,715,090 and U.S. Patent No. 5,111,058."
4. The Terminal Disclaimer was accepted and a Notice of Allowance was mailed on September 2, 2008.

5. The instant patent issued on January 6, 2009.
6. On July 6, 2009 petitioner filed a request for a certificate of correction to have the Terminal Disclaimer filed August 25, 2008, corrected by directing the Certificate of Corrections Branch to issue the Certificate of Correction by deleting "and U.S. Patent No. 5,111,058", in said Terminal Disclaimer "in order to clarify the record so that the patent is only disclaimed with respect to co-owned U.S. Patent No. 6,715,090."
7. In a decision filed August 4, 2009, the request was not approved.
8. A petition was filed on October 7, 2009 seeking a review of this earlier decision by the Office that disapproved the request for a certificate of correction.
9. In a decision mailed July 30, 2010 the petition was dismissed.
10. The instant petition was filed September 30, 2010 requesting a review of the earlier decisions refusing to grant the requested certificate of correction.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. § (2)(B)(2) provides, in part, that:

The Office-- may, establish regulations, not inconsistent with law, which

(A) shall govern for the conduct of proceedings in Office.

35 U.S.C. 253 Disclaimer

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. 255 Certificate of correction of applicant's mistake

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR § 1.182 Questions not specifically provided for

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR § 1.183 Suspension of rules

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.321. Statutory disclaimers, including terminal disclaimers - states in the pertinent part:

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) be signed:*
 - (i) by the applicant, or*
 - (ii) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or*
 - (iii) if there is an assignee of record of the entire interest, by such assignee, or*
 - (iv) by an attorney or agent of record;*
- (2) specify the portion of the term of the patent being disclaimed;*
- (3) state the present extent of applicant's or assignee's ownership interest in the patent to be granted; and*

- (4) *be accompanied by the fee set forth in § 1.20(d).*
- (c) *A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:*
- (1) *Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;*
- (2) *Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and*
- (3) *Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.*

37 CFR § 1.325 Other mistakes not corrected

Mistakes other than those provided for in §§ 1.322, 1.323, 1.324, and not affording legal grounds for reissue or for reexamination, will not be corrected after the date of the patent.

MPEP §1490(VII) - Withdrawing A Recorded Terminal Disclaimer

B. After Issuance Of Patent

The mechanisms to correct a patent — Certificate of Correction (35 U.S.C. 255), reissue (35 U.S.C. 251), and reexamination (35 U.S.C. 305) — are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent. See, e.g., Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935).

Certificates of Correction (35 U.S.C. 255) are available for the correction of an applicant's mistake. The scope of this remedial provision is limited in two ways — by the nature of the mistake for which correction is sought and the nature of the proposed correction. In re Arnott, 19 USPQ2d 1049 (Comm'r Pat. 1991). The nature of the mistake for which correction is sought is limited to those mistakes that are:

- (A) *of a clerical nature;*
- (B) *of a typographical nature; or*
- (C) *of a minor character.*

The nature of the proposed correction is limited to those situations where the correction does not involve changes which would:

- (A) *constitute new matter, or*

(B) require reexamination.

A mistake in filing a terminal disclaimer does not fall within any of the categories of mistake for which a certificate of correction of applicant's mistake is permissible, and any attempt to remove or nullify the effect of the terminal disclaimer would typically require reexamination of the circumstances under which it was filed.

Although the remedial nature of reissue (35 U.S.C. 251) is well recognized, reissue is not available to correct all errors. It has been the Office position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent.

OPINION

Petitioner seeks by way of the instant petition to amend the previously recorded terminal disclaimer in the instant patent over U.S. Patents 6,715,090 and 5,111,058. The specific relief requested by the petitioner is that "that the Certificate of Corrections Branch be directed to issue the Certificate of Correction filed July 6, 2009 which deletes "and U.S. Patent No. 5,111,058" in the Terminal Disclaimer in order to clarify the record so that the record is clear that the only patent which is the target of the Terminal Disclaimer is co-owned U.S. Patent No. 6,715,090."

Petitioner's arguments and the declaration of Lynn Maxwell concerning the instant request for a certificate of correction have been considered. However, as noted in MPEP §1490, a mistake in filing a terminal disclaimer does not fall within any of the categories of mistake for which a certificate of correction of applicant's mistake is permissible. Applicants should have filed a corrected terminal disclaimer during the prosecution of the application, i.e., prior to its issuance as a patent. The USPTO will not grant a request to withdraw or amend a recorded terminal disclaimer in an issued patent as the rules of practice and 35 USC 253 do not include a mechanism for withdrawal or amendment of such a terminal disclaimer. Unfortunately, once a patent issues, the USPTO cannot remove the effect of a recorded terminal disclaimer in an issued patent. See MPEP §1490; Bayer AG v. Carlsbad Technology Inc., 298 F.3d 1377, 64 USPQ2d 1045, 1048-49 (CAFC 2002) (hereafter "Bayer AG"). While petitioner may now consider the previously filed disclaimer to be unnecessary, or unnecessarily limiting, petitioner is, nevertheless, confronted with what has been characterized as "an unhappy circumstance," rather than a circumstance necessitating relief. See In re Jentoft, 392 F.2d 633, 639 n. 6, 157 USPQ 363, 368 n. 6 (CCPA 1968); MPEP 1490(A).

In arguing that the petition meets the requirements for a certificate of correction, petitioner states that: (a) "the mistake is of a clerical nature as the wrong patent number was added to the Terminal Disclaimer in addition to the correct patent number at the time of preparation and filing of the Terminal Disclaimer"; (b) "the U.S. Patent No. 5,111,058 is not related (by 35 U.S.C. § 120) to the '261 patent and not commonly owned by the assignee"; (c) "the correction of the mistake requested by the Certificate of Correction will not require examination as a result, for the same reasons"; and (d) "further, entry of the proposed correction will not introduce new matter."

Petitioner's request for issuance of a Certificate of Correction under 35 U.S.C. § 254 to correct the alleged error in the expiration date of the above-identified patent is refused. By statute (§ 254) and regulation (37 CFR 1.322), for a Certificate of Correction to be issued, there must be (1) a mistake in the patent that is (2) clearly disclosed by the records of the Office. However, the records of the Office do not clearly disclose a mistake in the patent within the meaning of the statute and regulation. Petitioner is reminded that this or any patent is printed in accordance with the record in the USPTO of the application as passed to issue by the examiner. Here, the original application for patent was passed to issue by the examiner on September 2, 2008, upon receipt of the terminal disclaimer filed June 25, 2008, which set forth that it "disclaims...the terminal part of the statutory term of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,715,090 and U.S. Patent No. 5,111,058." While petitioner also proposed amending the terminal disclaimer by way of a Certificate of Correction, the alleged error is not an error within the meaning of 35 U.S.C. § 254 and 37 CFR 1.322, and even assuming it were such an error it is not subject matter for and amenable to the proposed correction by the proffered Certificate of Correction under 35 U.S.C. § 254 and its promulgating regulation 37 CFR 1.322. What is here controlling is that petitioner seeks to correct an issued patent. The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of the named inventor which is provided for by 35 U.S.C. § 256 and 37 CFR 1.324, which is, by statute, a part of the patent (i.e., "shall contain"). See 35 U.S.C. § 154(a)(1). In addition, 35 U.S.C. § 254 merely authorizes the correction of the patent; it does not authorize correction of a terminal disclaimer.

Petitioner argues that "[s]till further, the public would have no expectation that the Terminal Disclaimer that was filed actually dedicated any term to the public. Terminal Disclaimers typically do not disclaim any term, as a result of the changes made by the URAA. The public sees only the indication on the front page of the '261 patent "Notice: This patent is subject to a terminal disclaimer." This Notice does not provide expiration date information as in many factually similar cases decided by the Patent Office. Further, the Notice would remain unchanged after the issuance of the Certificate of Correction, thereby providing no change in Notice to the public." Petitioner's argument is not well formed. The public is on notice that the patent is subject to a Terminal Disclaimer and that reference must be made to the file wrapper to determine the period disclaimed. Thus, it is not seen how one can argue that the public has no expectation of terminal disclaimer to USP 5,11,058 since by the very nature of the patent, reference must be made to the file wrapper. The public is entitled to rely on the public record, including the prosecution history of the a patent in determining the scope of the patent's claims. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996); Vectra Fitness v. TNWK Corp., 162 F3d 1379, 1384, 49 USPQ2d 1144, 1148 (Fed Cir. 1998). This reliance enables businesses, as well as others, to plan their future conduct in as certain an environment as possible. Vitronics, Id.

Petitioner's arguments concerning the ambiguity in the expiration date of the instant patent have been noted. Petitioner is asserting that "the Terminal Disclaimer in the '261 [patent] must be corrected to clarify the ambiguity so that the record is clear with respect to the intention on the part of the patentee to disclaim the '261 patent only with respect to U.S. Patent No. 6,715,090,

which is the parent, commonly owned patent.” In comparing the instant situation to that in Bayer AG, where an ambiguity in the expiration of the patent was resolved by the Office, petitioner notes that, “the difference in the expiration dates [here] arises as a result of a clerical mistake made by petitioner, not as a result of operation of law as in Bayer AG.” However, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314,317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

Petitioner’s argument regarding the Office policy on permitting a replacement of a Terminal Disclaimer in an issued patent, as stated in MPEP § 1490, has been noted. As also noted by the petitioner, the procedure of allowing a replacement of Terminal disclaimer is limited to a situation where there is an inadvertent transposition of numbers in the terminal disclaimer filed and the inadvertency is clear from the record. Furthermore, as noted in MPEP § 1490, “If the transposing error resulted in an earlier patent term expiration date than provided by the corrected terminal disclaimer, a statement must be included in the corrected terminal disclaimer to retain that earlier expiration date. The absence of such a statement will result in the Office declining to exercise its discretion to grant relief.” Assuming *arguendo* that the Office would regard the listing of the ‘058 patent in the Terminal disclaimer of record to be inadvertent, the relief sought by the petitioner herein cannot be granted as there is nothing the instant petition that clearly shows a retention of the earlier expiration date indicated by the Terminal Disclaimer of record in the instant patent. As Congress has already enacted legislation for patent term adjusting, extending, or restoring provisions in four sections (154, 155, 155(a), and 156) of the patent statute, and has not seen fit to create any additional statutory term modifying remedies, it is inappropriate for the Office to now create an additional, extra-legislative means of adjusting, extending, or restoring, the term of the original patent by now removing or amending the terminal disclaimer filed June 25, 2008 by way of a petition under 37 CFR 1.182, or by way of a certificate of correction as requested here.

What is controlling here is that the petitioner seeks to correct an issued patent. The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of a mistake by the USPTO (35 USC § 254) or correction of the named inventor (35 USC § 256). In addition, while the instant petition involves a disclaimer, 35 USC § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the amendment of a terminal disclaimer. Bayer AG, supra.

Unless a “mistake” is provided for in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination, such “mistake” will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325; MPEP 1490. As further noted in MPEP 1490, the mechanisms to correct a patent (i.e., certificate of correction (35 USC § 255), reissue (35 USC § 251), and reexamination (35 USC § 305)) are not available to withdraw or other nullify the effect of a recorded terminal disclaimer.

In this regard, an applicant's use, and Office's acceptance, of a terminal disclaimer is in the public interest because such encourages the disclosure of additional developments, the earlier filing of patent applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. See In re Jentoft, *supra*. It is brought to petitioners' attention that the principle against recapturing something that has been intentionally dedicated to the public dates back at least to Leggett v. Avery, 101 U.S. 246 (1879).

The USPTO will not grant a request to withdraw or amend a recorded disclaimer in an issued patent on the grounds that the rules of practice and 35 U.S.C. § 253 do not include a mechanism for withdrawal or amendment of such a disclaimer. *Id.*; see also MPEP 1490. Petitioner's contention that the USPTO has misinterpreted Bayer AG with the unfortunate result herein of not permitting removal or correction of the terminal disclaimer filed September 6, 1996, is not persuasive. The USPTO neither withdrew nor failed to give effect to the terminal disclaimer recorded against the Bayer patent. *Id.* The USPTO noted that the two dates recited in the recorded terminal disclaimer created an ambiguity as to the date of expiration, and resolved the ambiguity in favor of the patent holder. *Id.* The USPTO did not vacate or amend the recorded terminal disclaimer, or accept a substitute disclaimer in lieu of the recorded disclaimer, notwithstanding the ambiguity in the recorded terminal disclaimer. *Id.* The Federal Circuit noted with the approval the USPTO's underlying reasoning and its conclusion. *Id.* The court itself noted the date of expiration of the Bayer patent was automatically extended by operation of the URAA amendments to the patent statute on the term of the patent referenced in the recorded terminal disclaimer. What is especially significant is that the USPTO and the Federal Circuit both considered the recorded but flawed terminal disclaimer to remain in force on the Bayer patent. *Id.* Applying the facts of that case to the present situation, the terminal disclaimer of June 25, 2008, properly remains recorded against the issued patent and that disclaimer will not be withdrawn or amended on petition. See Bayer AG, *supra*; MPEP 1490(B).

Furthermore, equitable powers should not be invoked to excuse the performance of a condition by, as here, a party that has not acted with reasonable, due care and diligence. U.S.v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983). Petitioner had more than six months in which to correct, under the provisions of MPEP 1490(A), the filing of the disclaimer of June 25, 2008, before the patent issued. It is well settled that the public has a right to rely on the public record of a patent. See Vitronics Id.; Vectra Fitness, Id. Petitioner does not offer any reason that would excuse the inordinate delay in this case. Any contention that petitioner was diligent in seeking correction of this matter is simply not supported by the record. The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence(s) of his delay. See Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378,379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975).

PETITION under 37 CFR 1.183

As an initial matter, the petition fee of \$400 under 37 CFR 1.17(f), required for consideration of a petition under 37 CFR 1.183, has been charged to Deposit Account 50-1417, as authorized.

In regard to the request under 37 CFR 1.183, it is noted that 37 CFR 1.183 states that only in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Petitioner, has not, however, shown an extraordinary circumstance where justice requires suspension of the rules. Applicants should have filed a corrected terminal disclaimer during the prosecution of the application, i.e., prior to its issuance as a patent. Applicants had more than six months to correct the Terminal disclaimer prior to the issuance of the instant application.

The term of this patent was set by way of 35 USC § 154(b), and, by way of the disclaimer filed June 25, 2008, under § 253. Since the patent statute at sections §§ 154, 155, 155(a), and 156 limits the adjustment, extension, or restoration, of the term of a given patent to the causes and conditions specified therein; it would be inappropriate, by way of a petition under 37 CFR 1.183 to fashion yet another manner of adjusting, extending, or restoring, the term of the above-identified patent beyond the statutory scheme already provided by Congress. Further in this regard, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). That is, the patent statute at sections §§ 154, 155, 155(a), and 156 (and their promulgating regulations at 37 CFR 1.701 et seq.) provides a specific mechanism grounded on specific delays (arising from judicial, regulatory agency, or internal USPTO delay) whereby a party may petition the Office to adjust, extend, or restore the term of a given patent. As Congress has already enacted legislation for patent term adjusting, extending, or restoring provisions in four sections (154, 155, 155(a), and 156) of the patent statute, and has not seen fit to create any additional statutory term modifying remedies, it is inappropriate for the Office to now create an additional, extra-legislative means of adjusting, extending, or restoring, the term of the original patent by now removing or amending the terminal disclaimer filed June 25, 2008 by way of petition under 37 CFR 1.183 (or 1.182).

The contested terminal disclaimer clearly complies with 37 CFR 1.321(b). While petitioner argues that the common ownership requirements of 37 CFR 1.321 (c)(3) were not met by the recorded disclaimer, common ownership is not a condition required for a viable terminal disclaimer under 37 CFR 1.321(b). Indeed, even where 37 CFR 1.321(c)(4) requires common ownership, such is mentioned in conjunction with enforcement *vel non* of the disclaiming patent and is not mentioned in conjunction with, or as a condition of, the forfeiture of a given period of time.

37 CFR 1.183 should not be considered a panacea for applicant's tactical errors in prosecution in the original patent, as the failure to file a disclaimer over the patent actually relied upon in the obviousness-type double patenting rejection was a circumstance that was not beyond the control of petitioner, or petitioner's counsel. Rather, as any disclaimer of additional term over the '058 patent could have been avoided the by exercise of reasonable care and diligence, petitioner has failed to show that waiver of the rules is appropriate. See Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when counsel makes an avoidable mistake in filing papers); Vincent v. Mossinghoff, 230 USPQ 621,625 (D.D.C. 1985) (petitioner's failure to take adequate notice of USPTO procedures will not be permitted to shift, in equity, his lack of diligence onto the USPTO). The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, *supra*; Huston v. Ladner, *supra*; see also Haines v. Quigg, *supra*.

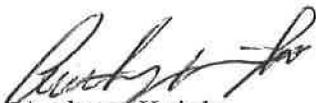
The instant petition requesting a waiver under 37 CFR 1.183, of applicable regulation, is therefore **DENIED**.

DECISION

For the above-stated reasons, the petition to withdraw the terminal disclaimer and issue a certificate of correction is **denied**.

This is a **final agency action** within the meaning of 5 U.S.C. § 704. The Director will undertake no further reconsideration or review of this matter.

Telephone inquiries concerning this decision should be directed to Ramesh Krishnamurthy at (571) 272-4914.



Anthony Knight
Director,
Office of Petitions