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OFFICE OF PETITIONS

In re Patent No. 6,505,391 :
Patentee: Philippe Berna :
Issue Date: January 14, 2003 : FINAL AGENCY DECISION
Application No. 08/580,493 :
Filed: December 29, 1995 :
Title: PROCESS FOR MAKING A :
VERSATILE CLAMPING DEVICE :
DESIGNED TO HOLD OBJECTS :
WITHOUT DAMAGING THEM, SUCH A :
DEVICE AND ITS USE

This is in response to the REQUEST FOR RECONSIDERATION TO THE DECISION OF OCTOBER 1ST, 2010 ON THE RESPONSE TO THE DECISION ON THE PETITION FILED ON JULY 11, 2003 filed November 23, 2010. Receipt of the status request filed November 30, 2010.

This request is **DENIED** with respect to making any change in the decision affirming the conclusion that the patent is subject to the "twenty year patent term provisions" of 35 U.S.C. 154(a)(2) and that subject to any disclaimer, the "twenty year term" of this patent is extended or adjusted under 35 U.S.C. 154(b) by 19 days for examination delay. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review.

BACKGROUND

On December 29, 1995, this application was filed.

On August 23, 2001, a continued prosecution application was filed.

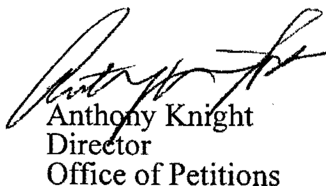
On January 14, 2003, the application issued as U.S. Patent No. 6,505,391, with a patent term adjustment of 19 days.

OPINION

This decision affirms the conclusion that this application is not subject to the patent term provisions for applications filed on or before June 8, 1995 pursuant to the URAA because it claims priority to applications filed on or before June 8, 1995. Rather, because this application was filed on December 29, 1995, which is after the implementation date of URAA, the application is subject to the "twenty year patent term provisions" of 35 U.S.C. 154(a)(2). Moreover, pursuant to the filing of the CPA on August 23, 2001, this application was accorded patent term adjustment for examination delay. Pursuant to 35 U.S.C. 154(b) and Sections 1.702 through 1.705, the patent issued with the "twenty-year term" and a revised patent term adjustment of 19 days for examination delay.

Patentee's arguments with respect to there being an implied contract are noted; however, the burden of presenting facts to establish that a contract exists, explicitly or otherwise, is petitioner's. Petitioner's citation to the statute in force, prior to June 8, 1995, and the citation of cases not germane to the patent statutes do not establish that any contract exists. Prior to June 8, 1995, Congress set the term for a patent to be 17 years from the date of issuance. The pamphlet produced by patentee merely repeats what the law required; the term of the patent was 17 years from date of issuance. Congress having the power to change the patent laws, amended the law, and the term for a patent was changed to 20 years from the earliest effective filing date. The Constitution provides that Congress shall have power to promote the progress of science and useful arts by securing for limited times to inventors the exclusive right to their discoveries. U.S. Const. art I, §8, cl. 8. The constitutional provision is not self-executing. *Cali v. Japan Airlines, Inc.,* 380 F.Supp. 1120, 1124, 184 USPQ 293, 295 (E.D.N.Y. 1974), aff'd, 535 F.2d 1240 (2d Cir. 1975). It empowers, but does not command, Congress to grant patent rights. *Id.* The power of Congress to legislate on the subject of patents is plenary by the terms of the Constitution. *McClurg v. Kingsland,* 42 U.S. (1 How.) 202, 206 (1843). Thus, within the limits of the constitutional grant, Congress may select the policy "which in its judgment best effectuates the constitutional aim." *Graham v. John Deere Co.,* 383 U.S. 1, 6 [148 USPQ 459] (1966). The right to a patent is purely statutory. *DeFerranti v. Lyndmark,* 30 App.D.C. 417, 424 (1908); *Giuliani v. United States,* 8 USPQ2d 1095 (D.Hawaii 1988), *aff'd mem.,* 878 F.2d 1444 [11 USPQ2d 1656] (Fed.Cir. 1989). Inasmuch as Congress creates the right, it may put such limitations upon the right as it pleases. *Mast, Foos & Co. v. Stover Mfg. Co.,* 177 U.S. 485, 494 (1900). Thus, "Congress has full power to prescribe to whom and upon what terms and conditions a patent shall issue." *Owen v. Heimann,* 12 F.2d 173, 174 (D.C. Cir.), *cert. denied,* 271 U.S. 685 (1926); *Kling v. Haring,* 11 F.2d 202, 204-5 (D.C. Cir), *cert. denied,* 271 U.S. 671 (1926). Notwithstanding petitioner's arguments, nothing within the materials supplied by petitioner show that a contract, implied or otherwise, exists.

Telephone inquiries with regard to this communication should be directed to Nancy Johnson, Senior Petitions Attorney at (571) 272-3219.



Anthony Knight
Director
Office of Petitions