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**OFFICE OF PETITIONS**

In re Patent No. :  
7,168,818 :  
Issue Date: January 30, 2007 : DECISION ON PETITION  
Application No. 10/905,330 :  
Filed: December 28, 2004 :  
Attorney Docket No. 71486-0088 :

This is a decision on the petition under 37 C.F.R. 1.182 filed May 24, 2007, which is properly treated as a petition under 37 C.F.R. 1.181(a)(3) asking the Director to exercise his supervisory authority and review the refusal of Certificate of Correction branch mailed April 30, 2007 to issue the requested certificate of correction.

The petition is **DENIED**.

#### BACKGROUND

The above identified patent, as filed December 28, 2004, contained 19 claims. Originally filed claim 1 provided:

A vehicular rearview mirror system for a motor vehicle having a driver's side and a passenger's side, a first rearview mirror assembly attached to the driver's side, and a second rearview mirror assembly attached to the passenger's side, comprising: a first reflective element assembly for providing a rearward view along the driver's side to the operator of the vehicle, the first reflective element having a first base assembly for attaching the first reflective element assembly to the exterior of the vehicle; a second reflective element assembly for providing a rearward view along the passenger's side to the operator of the vehicle, the second reflective element assembly having a second base assembly for attaching the second reflective element assembly to the exterior of the vehicle; and wherein the natural frequency of the second vehicular rearview mirror assembly is less than the natural frequency of the first vehicular rearview mirror assembly.

Originally filed claims 5, 9, 14, and 18 additionally provided:

The vehicular rearview mirror system of claim 4 wherein the natural frequency of the first reflective element assembly is at least 60 Hz and the natural frequency of the second reflective element assembly is less than 60 Hz.

Thus, independent claim 1 and dependent claims 5, 9, 14, and 18 each required the natural frequency associated with the passenger's side rearview mirror assembly and reflective element to be less than the natural frequency associated with the driver's side rearview mirror assembly and reflective element.

On May 23, 2006 the examiner's first office action was mailed in which originally filed claims 1-19 were rejected under 35 USC 103 as obvious over the admitted prior art in view of Nielson US 2003/0086191. In particular, the examiner noted that from the teachings of Nielson

“it would have been obvious to the ordinarily skilled artisan at the time of invention to replace one of the vehicular mirrors, e.g. the passenger's side mirror, with Nielsen's mirror as per Nielsen's suggestion in order to enable remote adjustment of this mirror. In such a combination, since the passenger's side mirror assembly, including the base, is made of plastic, it has a lesser natural frequency and is more resilient than the driver's side mirror assembly (which is made of metal).” (emphasis added)

To overcome this rejection, claims 1 and 11-19 were canceled and claim 20 was added in the amendment filed August 23, 2006. New claim 20 was the sole independent claim and provided:

A vehicular rearview mirror system for a motor vehicle having a driver's side and a passenger's side, comprising:

a first rearview mirror assembly attached to the driver's side for providing a rearward view along the driver's side to the operator of the vehicle, a first planar reflective element assembly comprising a first planar reflective element, a first base assembly fabricated of a first material having a first modulus of elasticity for attaching the first planar reflective element assembly to the exterior of the vehicle, and a first cantilever arm coupling the first planar reflective element assembly to the first base assembly;

a second rearview mirror assembly attached to the passenger's side for providing a rearward view along the passenger's side to the operator of the vehicle, a second non-planar reflective element assembly comprising a second non-planar reflective element, a second base assembly fabricated of a second material having a second modulus of elasticity for attaching the second non-planar reflective element assembly to the exterior of the vehicle, and a second cantilever arm coupling the second non-planar reflective element assembly to the second base assembly;

wherein said second modulus of elasticity is substantially less than said first modulus of elasticity; and

whereby the natural frequency of said first planar reflective element assembly supported by said first cantilever arm on said first base assembly is substantially less than the natural frequency of said second non-planar reflective element assembly supported by said second cantilever arm on said second base assembly.

Thus, sole independent claim 20 required the natural frequency associated with the driver's side rearview mirror (first planar reflective element assembly) to be less than the natural frequency associated with the passenger's side rearview mirror (second non-planar reflective element assembly). That is, the order of the driver's side (first) and passenger's side (second) were reversed in claim 20 from the order presented in the rejected claims.

In the "Remarks/Arguments" section of the amendment filed August 23, 2006, Applicant asserted that

"Nielsen '191 lacks the claimed subject matter of claim 20. The Examiner's asserted modification of the prior art exclusive of Nielsen '191 also lacks the claimed subject matter of claim 20. Thus, claim 20 is patentable over the prior art, alone and in combination with Nielsen '191. Applicant requests the allowance of claim 20."

The amended claims were allowed on September 22, 2006. In the Statement of Reasons for Allowance, the examiner explained that independent claim 20 was allowed, in part, because it requires:

"the natural frequency of the first planar reflective element assembly supported by the first arm on the first base to be substantially less than the natural frequency of the second non-planar reflective element assembly supported by the second arm on the second base assembly as claimed. Although Nielsen of record discloses a replacement mirror to comprise a plastic base component, which could result in a lower modulus of elasticity for the second base, the claimed combination noted above cannot be said to be taught or suggested by this reference (or by the disclosed admission of prior art)."

As evident by the reasons for allowance, the order of the "first" and "second" elements was important to the allowance of the claims since "the claimed combination" cited by the examiner included a first element with a natural frequency that is less than the natural frequency of the second element.

Moreover, the Statement of Reasons for Allowance was concluded by noting that:

"[A]ny comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

No such comment was filed prior to the payment of the issue fee.

The patent issued on January 30, 2007, with claims 2-10 and 20 printed with limitations exactly as allowed by the examiner, *i.e.*, exactly as they had been drafted by applicant and presented on amendment. In the printed patent, claim 20 was renumbered as claim 1 with claims 2-10 being dependent claims.

A request under 37 CFR 1.322 for a Certificate of Correction was filed February 1, 2007. This request asserted that the office erred during examination by applying an incorrect reference number to a component discussed in the specification. This error was corrected through the Certificate of Correction issued May 22, 2007. This request is not the subject of the present petition.

The present petition relates to a request under 37 CFR 1.323, also filed February 1, 2007, for another Certificate of Correction. This request indicates that amended claim 20 (patented claim 1) was incorrectly drafted to call for the first assembly to have a natural frequency less than the natural frequency of the second assembly. According to the request, this mistake was due to an "oversight" by Applicant.

In a decision dated April 30, 2007, Certificate of Corrections Branch refused the requested correction to patented claim 1 as the requested changes would result in a change in scope, based upon the examiner's determination.

The instant petition was filed May 24, 2007.

#### OPINION

37 CFR 1.182, by its terms applies when no other regulation speaks to the issue. Since 37 CFR 1.181(a)(3) provides for the requested supervisory review, 37 CFR 1.182 is inapposite. In any event, petitioner requests reconsideration of the refusal of Certificate of Correction Branch to issue the requested correction that seeks to reverse the order of "first" and "second" in the last clause of claim 1 from the order allowed by the examiner.

Since petitioner has failed to show that the issues herein raised are proper subject matter for a Certificate of Correction under either 35 U.S.C. § 254 or § 255, the refusal of Certificate of Correction Branch to process the requested correction will not be disturbed.

As to § 255 and its promulgating regulation 37 CFR 1.323:

This or any patent is printed in accordance with the record in the Patent and Trademark Office of the application as passed to issue by the examiner. A Certificate of Correction under 35 U.S.C. § 255 and 37 CFR 1.323 is available only for the correction of errors of a minor or clerical character, and does not extend to the correction of errors that would constitute new matter or would require reexamination. See Superior Fireplace Co. v. Majestic Products Co., 270 F.3d 1358, 60 USPQ2d 1668 (Fed. Cir. 2001); In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pat. 1991); In re Hyman, 185 USPQ 441, 442 (Sol. Pat. 1975). Specifically, 35 U.S.C. § 255

requires, *inter alia*, that two specific and separate requirements be met prior to the issuance of a Certificate of Correction. The first requirement is that the mistake is: (1) of a clerical nature, (2) of a typographical nature, or (3) of minor character. The second requirement is that the correction must not involve changes that would: (1) constitute new matter or (2) require reexamination. See In re Arnott 19 USPQ2d at 1052; see also MPEP 1490. Petitioner's request fails on both counts to show that his failure to present an allowable claim with a passenger's side mirror system element with a natural frequency that is less than the natural frequency of a driver's side mirror system element may now be remedied by a Certificate of Correction under § 255.

In particular, it is not seen, and petitioner has not shown, that there is an error of a clerical nature, or of a typographical nature, or of minor character, present. What petitioner now proposes, in the guise of a Certificate of Correction is to present a claim to subject matter that was never examined by the examiner, was never passed to issue by the examiner, and was never given patent protection by the USPTO. As observed in Superior 60 USPQ2d 1668 at 1676: "clerical or typographical mistakes are generally understood to include simple mistakes such as obvious misspellings that are immediately apparent. Upon viewing such a misspelling, there is no doubt that a mistake, indeed a clerical or typographical mistake, has occurred." Also, "[a]bsent very unique and unusual circumstances, a clerical or typographical mistake should be manifest from the contents of the file of the patent sought to be corrected." See In re Arnott at 1053. Here, however, the contents of the file do not manifestly show that the mistake was merely clerical or typographical. Rather, the record suggests that the mistake was introduced by amendment in an intentional attempt to overcome the prior art.

The examiner rejected an arrangement in which the natural frequency associated with a "second" mirror assembly and "second" reflective element is less than the natural frequency associated with a "first" mirror assembly and "first" reflective element. In overcoming this rejection, the claim was amended to recite, in part, that the natural frequency associated with "first" reflective element is less than the natural frequency associated with the "second" reflective element. Although an arrangement in which the "first" natural frequency is less than the "second" natural frequency was not supported by the original disclosure and was arguably impossible, as petitioner notes, the record suggests that this order was necessary to overcome the examiner's finding that an arrangement with the "second" natural frequency being less than the "first" natural frequency would have been obvious. This reordering of "first" and "second" was recognized in both the arguments to the amendment and the examiner's Statement of Reasons for Allowance as not being taught or suggested by the prior art. Indeed, an arrangement with a "first" natural frequency less than a "second" natural frequency was not found in the prior art and the claims were allowed. The examiner's Statement of Reasons for Allowance specifically cite the limitation reciting that the "first" natural frequency is less than the "second" natural frequency as a basis for allowance. Thus, reordering of "first" and "second" was necessary to overcome the prior art. The record never suggests that the arrangement of the proposed correction was allowable. A mere clerical or typographical error did not result when the claims were amended to satisfy 35 USC §§ 102 and 103 with respect to the prior art cited by the examiner. The "oversight" in drafting the amended claim involved neglecting sections of the statute other than §§ 102 and 103 to which the claim must also conform, which is not a clerical or typographical error of the type described in Superior.

Moreover, the arguments to the amendment and the examiner's Statement of Reasons for Allowance indicate that the reordering of "first" and "second" was a significant change, which, in combination with the further limitations of the claims, was not found in the prior art. However, the petition suggests that now reversing the order of "first" and "second" in the patented claim would be a minor correction that would not broaden the scope of the claim. This is not true.

MPEP § 1412.03 discusses changes that would broaden the scope of a claim in regard to reissue applications, which similarly applies to changes to a claim through a Certificate of Correction.

"A claim in the [correction] which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the [correction] contains within its scope any conceivable product or process which would not have infringed the patent, then that [corrected] claim would be broader than the patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603, 120 USPQ 185, 186 (CCPA 1958). A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement."

Since the apparatus that would be defined by claim 1, as corrected by the proposed Certificate of Correction, would contain within its scope a product that would not have infringed patented claim 1, corrected claim 1 would be broader than patented claim 1. A mistake the correction of which broadens a claim is not a "mistake of ... minor character" subject to correction under 35 U.S.C. § 255. *Superior Fireplace Co. v. Majestic Products Co.*, 270 F.3d 1358, 60 USPQ2d 1668 (Fed. Cir. 2001). Also, where, as here, the proposed correction broadens the scope of coverage of claim 1, and the alleged mistake in the claim is not clearly evident from the specification, drawings, and prosecution history, that is not a "mistake of a clerical or typographical nature" subject to correction under 35 U.S.C. §255. *Id.*

Furthermore, reexamination clearly would be required for the requested correction. The examiner determined that it would have been obvious to provide an arrangement having the natural frequency associated with a "second" mirror assembly and "second" reflective element that is less than the natural frequency associated with a "first" mirror assembly and "first" reflective element. The claims were allowed only after "first" and "second" were reversed in this arrangement, and the examiner specifically cited this new recitation in his reasons for allowance. The proposed correction presents a claim with a scope that was not previously examined or issued by the USPTO. Also, the proposed correction presents an arrangement with a second natural frequency less than a first natural frequency, which was previously considered obvious by the examiner.

In section 1 of the remarks of the present petition, Petitioner states:

“The Examiner's argument against patentability was not grounded upon which reflective element assembly had the greater or lesser natural frequency. It was grounded only upon one of the reflective element assemblies having a lower modulus of elasticity than the other.”

This is not true. The argument against patentability was grounded upon the obvious nature of the passenger's side (second) mirror assembly having a “lesser” natural frequency than the driver's side (first) mirror assembly. This was specifically indicated in the rejection of the original claims. The “modulus of elasticity” was not recited in the original claims or addressed in the argument against the patentability of those claims. Thus, contrary to Petitioner's assertion, the proposed correction would derogate from the argument against patentability. Moreover, since the claims proposed by the correction were never examined, their patentability is not clear.

Since the mistake in the patented claims is not of a clerical nature, or of a typographical nature, or of minor character, and the correction of which would require reexamination, the petition under § 255 cannot be granted.

As to § 254 and its promulgating regulation 37 CFR 1.322:

Petitioner indicated that there is uncertainty as to which of Rules 1.322 and 1.323 provided the basis for evaluation of the request for correction. The decision of Certificate of Correction Branch dated April 30, 2007 specifically referenced Rule 1.322, but the content of the decision addressed the substance of the request pursuant to Rule 1.323. Furthermore, Petitioner suggests that patented claim 1 introduces new matter, which may present a mistake by the USPTO in allowing such a claim.

Nonetheless, the decision of Certificate of Correction Branch was appropriate under both rules. The decision is consistent with the standards of Rule 1.323, as discussed above. The decision is also consistent with the standards of Rule 1.322.

In order for a proposed correction to lie under § 254 and its promulgating regulation (1.322), the requestor must show that (1) there is a mistake in the patent, that was (2) incurred through the fault of the Patent and Trademark Office, which mistake is (3) clearly disclosed by the records of the Office. See 35 U.S.C. § 254. “The Office, however, has discretion under 35 U.S.C. 254 to decline to issue a Certificate of Correction even though an Office mistake exists.” See MPEP § 1480. Moreover, Superior at 1680 notes for applicants “the critical importance of reviewing claims” before the allowed claims issue. See Chef America Inc. v. Lamb-Weston Inc., 358 F.3d 1371, 1373 (Fed Cir. 2004) (quoting underlying district court decision, “[i]t is the job of the patentee, and not the court, to write patents carefully and consistently.”). See also In re Lambrech, 202 USPQ 620, 621 (Comm'r Pat. 1976)(noting the duties of an Applicant in correctly prosecuting an application, “He cannot neglect this duty and then, if the Office fails to notice and correct his oversight, be relieved of the consequences by claiming Office mistake...the primary responsibility to make the insertion rests with the applicant. His failure to make it is not correctable by way of 37 CFR 1.322.”

Certificate of Correction Branch, based upon the examiner's determination, noted that the requested changes would result in a change in claim scope. Such claims were not previously examined or issued by the USPTO, and involve questions of obviousness that were identified in relation to the original claims. Appropriately, Certificate of Correction Branch denied the request.

DECISION

For the reasons given above, the decision of Certificate of Correction Branch was proper in refusing the requested correction. The petition is granted to the extent that the decision of Certificate of Correction Branch has been reviewed, but is **denied** as to any modification thereof or issuance of a Certificate of Correction. While the requested correction will not be forthcoming under 35 U.S.C. §§ 254 or 255, petitioner may yet obtain relief under 35 U.S.C. § 251.

This decision may be considered a final agency action within the meaning of 5 U.S.C. § 704 for purposes of obtaining judicial review. See MPEP 1002.02. The USPTO will not further consider or reconsider this matter.

Any inquiries concerning this communication may be directed to Christopher Bottorff at (571) 272-5092.

A handwritten signature in black ink, appearing to read "Charles Pearson", with a long horizontal flourish extending to the right.

Charles Pearson  
Director, Office of Petitions

db/bh