



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
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**MEMORANDUM**

DATE: August 15, 2017

TO: Office of Petitions Staff

FROM: *Robert A. Clarke*  
Robert A. Clarke  
Editor, Manual of Patent Examining Procedure

SUBJECT: **Advance Notice of Change to MPEP 1490**

This memorandum is to provide advance notice of a change that will be made to MPEP 1490 in the next revision of the MPEP.

The current published text of the last paragraph in MPEP 1490, subsection VIII.B.:

Where a terminal disclaimer was submitted to overcome a nonstatutory double patenting rejection (made during prosecution of an application which has now issued as a patent), and the numbers for the patent being disclaimed in the terminal disclaimer were inadvertently transposed (e.g., 6,444,316 written as 6,444,136), a petition under 37 CFR 1.182 may be filed to withdraw the terminal disclaimer with the incorrect (transposed) patent number (recorded in the issued patent), and replace it with a corrected terminal disclaimer having the correct patent number. In this instance, the inadvertency is clear from the record. 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 that the term is limited to the shorter expiration date of the original [sic] terminal disclaimer or the corrected terminal disclaimer. The absence of such a statement will result in the Office entering the second disclaimer and not withdrawing the original disclaimer.

Will be revised to read:

Accordingly, after issuance of a patent, a request to replace or remove a previously recorded terminal disclaimer will not be addressed on the merits. Where a terminal disclaimer was submitted to overcome a nonstatutory double patenting rejection (made during prosecution of an application which has now issued as a patent), and one or more patent or application numbers for the patent(s) or application(s) being disclaimed in the terminal disclaimer were in error, the patent owner may file a paper explaining the

error(s) and requesting that the explanation be included in the file history and its request acknowledged. A patent owner may file additional terminal disclaimer(s) disclaiming the correct patent(s) or application(s) accompanied by the fee for such disclaimer(s) for processing by the Office. See subsection IV above.

This change is effective August 15, 2017.

**BACKGROUND:** After a revision to MPEP 1490 in 2008, the USPTO (Office) permitted a patentee to file a petition under 37 CFR 1.182 to withdraw a terminal disclaimer in issued patents where the numbers of the patent being disclaimed were inadvertently transposed if the error was clear from the record. Since 2008, the Court of Appeals for the Federal Circuit (Federal Circuit) has issued a number of decisions that have caused the Office to reconsider that practice.

Apart from the aforementioned limited provision of MPEP 1490 as published in the Ninth Edition, Revision 07.2015 (currently published MPEP), the Office's established policy is to deny any request to withdraw or amend a recorded terminal disclaimer in an issued patent on the grounds that 35 U.S.C. § 253 and the rules of practice do not include a mechanism for withdrawal or amendment of such a terminal disclaimer. From the 2008 revision to present day, the Office has received, after patent grant, petitions under 37 CFR 1.182 to withdraw incorrect terminal disclaimers in favor of correct terminal disclaimers due to: i) transposition errors, ii) errors in identifying the correct target application/patent numbers due to more than transposition errors, iii) errors in filing terminal disclaimers directed to an application or patent that is not commonly-owned, and iv) errors in filing terminal disclaimers due to miscommunication between practitioner of record and client. As to circumstances ii) – iv), the Office has routinely declined to withdraw or nullify the incorrect terminal disclaimers, following the established policy of denying such requests.

**INTERVENING DECISIONS:** In *In re Dinsmore* 757 F.3d 1343, 1346 (Fed. Cir 2014), the Federal Circuit affirmed the Office's position, as stated in a Patent Trial and Appeal Board decision, that the "voluntary and intentional filing of a terminal disclaimer to overcome a non-statutory obviousness-type double patenting rejection during prosecution of the original patent is not an 'error' correctible by reissue under 35 U.S.C. § 251." (quoting *Ex parte Dinsmore*, No. 13-6879, 2013 WL 5274029, at \*9 (Patent Tr. & App. Bd. June 3, 2013))<sup>1</sup>. In *Dinsmore*, the applicant during prosecution of the original application had filed a terminal disclaimer directed to a patent that was not commonly owned. The reissue applicant was not allowed to replace the terminal disclaimer of record with a corrected terminal disclaimer even though the corrected terminal disclaimer included a statement that the term is limited by the expiration date of the original terminal disclaimer. Thus, the Court did not allow patent owner to withdraw a terminal disclaimer by way of reissue, even in an instance where the patent as issued is unenforceable due to the filing of the terminal disclaimer.

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<sup>1</sup> The deliberate filing of a terminal disclaimer to overcome a double patenting rejection could not be considered an error as contemplated by the reissue statute. *Ex parte Anthony*, 230 U.S.P.Q. 467.

In *Japanese Foundation for Cancer Research v. Lee*, 773 F.3d 1300 (Fed. Cir. 2014), the Federal Circuit reversed a district court's order directing the USPTO to withdraw a properly filed terminal disclaimer, and held that a paralegal's mistaken belief that the patentee sought to disclaim the patent was not a "clerical error" that the USPTO was statutorily empowered to correct. The court found that there was no basis for withdrawing the terminal disclaimer by means of a certificate of correction under 35 U.S.C. § 255.

DISCUSSION: The reissue statute is remedial in nature and its provisions should be liberally construed. *Medrad, Inc. v. Tyco Healthcare Group LP*, 466 F.3d 1047, 1051 (Fed. Cir. 2006). Additionally, during examination of a reissue application the Office must reconsider the entire application. 35 U.S.C. § 251(c). Moreover, the public interest that disfavors restoration to the patent owner of something that has been freely dedicated to the public is protected at least partially in reissue by intervening rights. *Seattle Box Co., v. Industrial Crating and Packing Inc.* 756 F.2d 1574, 78-79 (Fed. Cir. 1985). Thus, the Office's authority to allow a patent owner to correct errors in an issued patent is typically higher during a reissue proceeding compared with other mechanisms, such as filing a certificate of correction or a petition under 37 CFR 1.182 to withdraw and replace a paper. Petitions under 37 CFR 1.182 provide for relief for matters that are not otherwise provided for, but not for matters that are not permitted by existing statutes or regulations. See *Hicks v. Costello*, 1903 Dec. Comm'r Pat. 123, 125 (1903). In *Dinsmore*, the Federal Circuit did not allow patent owner, even during reissue proceedings, to withdraw the effect of a recorded terminal disclaimer. Since the Office's authority to correct errors in issued patents is generally higher during examination of a reissue application, *Dinsmore* raises concerns about the Office's practice on petition of replacing disclaimers in issued patents having transposition errors in the patent number.

Accordingly, the Office is reinstating its pre-2008 policy of not withdrawing terminal disclaimers in issued patents due to transposition errors (i.e., inadvertently transposed patent numbers). At the same time the Office will permit a patentee to file an explanation of an error that resulted in an erroneous number being referred to in a terminal disclaimer accompanied by additional terminal disclaimer(s) disclaiming the correct patent(s) or application(s) accompanied by the fee for such disclaimer(s) for processing by the Office. This explanation will be accepted as part of the patent record.