



Paper No. 50

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In re Application of: :
David L. Marshall :
Application No. 07/096,207 : DECISION DENYING PETITION
Filed: December 18, 1990 :
Attorney Docket No. 85-US-0050M :

This is a decision on the renewed petition filed February 2, 1998, which requests under 37 CFR 1.182 that the terminal disclaimer filed on July 20, 1993 as part of a petition under 37 CFR 1.183 and 1.137(b), which Terminal Disclaimer was accepted for the term of forty three (43) months, be withdrawn in favor of the terminal disclaimer proffered with the initial petition, which latter term is of two (2) days.

The petition is DENIED.

BACKGROUND

Application No. 07/096,207 ('207) filed September 8, 1987 was a properly filed continuing application of application No. 06/807,157 filed December 10, 1985. In due course, the '207 application received a non-final Office action mailed December 18, 1987 which set a shortened statutory period of three (3) months within which to respond. A three month extension of time under 37 CFR 1.136(a), to extend the period for response to June 18, 1987 having been obtained by the communication filed June 22, 1988 (timely by way of the certificate of mailing bearing the date of June 18, 1988), the '207 application became abandoned at midnight, June 18, 1988 by operation of 35 USC 133.

On June 18, 1988, applicant deposited papers with the U.S. Postal Service via first class mail which requested a continuation under 37 CFR 1.62 of the '207 application. As the papers were received at the PTO on June 22, 1988, that date became the filing date for application No. 07/220,882 ('882), notwithstanding the lack of copendency with the '207 case. Petitioner was informed of the

filing dates and application numbers for all the aforementioned applications by way of the filing receipt received by counsel for petitioner on or about September 22, 1988 (Exhibit A).

In due course, the '882 application gave way to application No. 07/630,365 ('365) filed under 37 CFR 1.62 on December 18, 1990, which ultimately issued as U.S. Patent No. 5,236,826 ('826) patent issued on August 17, 1993.¹ Petitioner was likewise informed of the filing dates and application numbers for all the aforementioned applications by way of a filing receipt for the '365 application. During the pendency of the '365 application, applicant noted the lack of copendency between the parent '207 and '883 applications, and filed the petition under 37 CFR 1.183 and 1.137(b) to revive the '207 application to obtain copendency with the '883 application on July 20, 1992. The accompanying terminal disclaimer disclaimed four years and one month i.e., forty nine (49) months. The petition was granted in the decision of February 17, 1993, which accepted a disclaimer of forty three (43) months of the terminal part of any patent to be granted on the application which was being revived. Moreover, the decision also required that any application claiming benefit under 35 USC 120 of the revived application had to also request that the disclaimer be recorded against the latter application. Consequently, the '826 patent, as issued, facially disclaimed its term subsequent to January 17, 2007.

A first petition under 37 CFR 1.183 was filed June 14, 1996, and was treated as petition under 37 CFR 1.182, which petition was dismissed in the decision of October 30, 1997.

The instant petition was filed February 2, 1998.

STATUTE AND REGULATION

35 USC § 253 states that:

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.

¹Under the practice of 37 CFR 1.62, all of the above-noted files have been "bundled" into one wrapper.

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 USC § 254 provides:

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such 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. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

35 USC § 255 states that:

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 Commissioner 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 re-examination. 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 provides that:

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

Commissioner, 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(h).

37 CFR 1.322 provides that:

(a) A certificate of correction under 35 U.S.C. 254 may be issued at the request of the patentee or the patentee's assignee. Such certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notifying the patentee (including any assignee of record) and affording the patentee an opportunity to be heard. When the request relates to a patent involved in an interference, the request shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Commissioner may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

37 CFR 1.321 states:

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed by the patentee, or an attorney or agent of record;

(2) identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term, will be refused recordation;

(3) state the present extent of patentee's ownership interest in the patent; and

(4) be accompanied by the fee set forth in § 1.20(d).

(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 a judicially created double patenting rejection in a patent application or in a reexamination proceeding, 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 rejection.

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, 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 rejection.

37 CFR 1.323 states that:

Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in § 1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. A for a certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

OPINION

Petitioner reasserts that the forty three month period currently disclaimed in the above-identified application constitutes an unjust penalty herein in light of the two days of actual hiatus in pendency in the '207 and '882 parent applications. As such, petitioner asserts, the facts of this case constitute an extraordinary situation, such that the terminal disclaimer proffered with the petition, which is limited to the two day

period of hiatus in copendency, should be accepted by the PTO in lieu of the terminal disclaimer currently of record, and a certificate of correction issued to that effect.

In actuality, since the '207 application is abandoned and, as such, has no enforceable rights, petitioner belatedly seeks to extend the term of enforcement of the '826 patent by forty three (43) months, less two days.

The showing of record fails to adequately demonstrate that the facts of this case warrant the relief(s) requested.

Petitioner appears to confuse the forty three (43) month time period application No. 07/096,207 remained abandoned before it was revived, with the two day period of time in which there was a hiatus in copendency between the '207 application, and its continuing application No. 07/220,882 filed June 22, 1998. Petitioner's two day hiatus in copendency, nevertheless, was not remedied until the filing of a grantable petition in excess of some forty three months after that hiatus occurred.² That is, petitioner required in excess of forty three months to discover, and remedy, an error of petitioner's own making. As a prerequisite to a grantable petition, petitioner submitted a disclaimer of the time equivalent to the period of abandonment in that abandoned application, as well as in any future continuing application (which includes the instant application) which claims benefit under § 120 of the aforementioned application. Petitioner is reminded that the statutes and regulations did not compel petitioner to rely upon those early application(s) for benefit under 35 USC 120, in the instant application. However, since petitioner desires to be entitled to the potential benefits of those earlier application(s) via § 120 and specifically, the above-identified application, then petitioner must also accept the consequences attendant to that action. See Abbott Laboratories v. Novopharm Ltd., 38 USPQ2d 1309, 1312 (D.C. N. Il. 1996), *aff'd* 104 F.3d. 1305, 41 USPQ2d 1535 (Fed. Cir. 1997). That is, petitioner is not in a good position to urge that the forty three month loss

² It is worth noting that petitioner voluntarily initially tendered a disclaimer of four years and one month, i.e., forty nine (49) months, while the decision on petition accepted a disclaimer of but forty three (43) months. That is, while petitioner was initially willing to forego even more time (over four years) than was actually assessed, petitioner now feels that two days is reasonable under the circumstances.

of term caused by petitioner's improper filing of the successor to this application be forgiven, at the same time that petitioner simultaneously claims the benefit of the filing date of both applications under 35 USC 120. See Id.

There is no dispute that application No. 07/096,207 was abandoned for in excess of forty three months prior to its revival and the resultant establishment of copendency with application No. 07/220,882 on petition, and, as such, there is no error with respect to the period disclaimed in the recorded terminal disclaimer. Even assuming, *arguendo*, the relief(s) requested should be considered on petition, petitioner is reminded that, as a general rule, public policy does not favor the restoration to the patentee [applicant] of something that has been freely dedicated [here, forty three months of the patent term] 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 Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). Petitioner has failed to provide a reasonable, much less any, assurance that the public interest will, or can be, protected if the relief(s) requested in this petition is given favorable consideration. In this regard, an applicant's use, and Office 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, 392 F.2d 633, 157 USPQ 363 (CCPA 1968).

It is brought to petitioner's 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). In this regard, the public had almost three years since the grant of the above-identified patent to act on its facial representation that the term of the above-captioned patent will expire January 17, 2007, before the first petition was filed herein. Similarly, petitioner has had, since the submission of the aforementioned terminal disclaimer, which was proffered to secure revival for the sole purpose of obtaining copendency, no reasonable basis to expect a patent term that would extend beyond January 17, 2007. 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.

Petitioner had the opportunity, when the petition of July 20, 1992 was under consideration by the PTO, to request relief from the requirement for a terminal disclaimer, and/or the extent of the term disclaimed, but did not do so. Moreover, petitioner has provided no adequate explanation as to why the circumstances surrounding this patent warrant a belated consideration of this issue, some three years after the petition was granted, and the terminal disclaimer was accepted, on February 17, 1993. Equitable powers should not be invoked to excuse the performance of a condition by 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).

The Patent and Trademark Office did not cause or contribute to petitioner's failure to properly obtain copendency, in that petitioner relied upon the certificate of mailing procedure. It is well established, and well publicized, that the certificate of mailing practice under 37 CFR 1.8 is ineffective to obtain a filing date earlier than the date of receipt of the application papers at the PTO. See Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C. 1985). While the PTO did contribute to petitioner's delay in realizing the true abandoned status of application No. 07/096,207 such that the aforementioned petition to revive was untimely within the meaning of (then) 37 CFR 1.137(b), such PTO contribution nevertheless, was duly considered, and resulted in the favorable decision on petition, which decision revived the '207 application such that copendency was obtained, and also required the terminal disclaimer at issue.

Petitioner's reliance on In re Wilson, 8 USPQ2d 1375 (Comm'r Pat. 1988) (requirement for a terminal disclaimer under 37 CFR 1.137(c) that would have required a loss of eleven (11) years of patent term waived due to extraordinary circumstances) in support of petitioner's request for an abbreviated terminal disclaimer is noted. However, Wilson gives no guidance as to what extraordinary circumstances therein led to waiver of the terminal disclaimer, nor does either petitioner proffer, or inspection of the instant record reveal, that any extraordinary circumstances, much less the same circumstances as in Wilson, are present and operative herein. Rather, Wilson's counsel's reasonable misinterpretation of 37 CFR 1.8 (in 1977) led to revival (not waiver) under the unavoidable standard, in Wilson. However, as noted in Vincent, supra, by 1979 the inapplicability of 37 CFR 1.8 to obtaining copendency when relying upon the date of deposit was well publicized. Still further, contrary to petitioner's assertions, the PTO was under no obligation to notify petitioner of his mistake in relying upon the

certified mailing procedure, much less research whether copendency had been obtained. Vincent, Id. While the PTO does attempt to notify parties of defective papers, it is applicant who is ultimately responsible for filing proper documents. See Id.; In re Colombo Inc., 33 USPQ2d 1530, 1531 (Comm'r Pat. 1994). Rather, as in Vincent, petitioner was provided with a filing receipt (see petition of July 20, 1992, exhibit A) that *inter alia*, correctly listed the actual filing dates for all involved applications, and furthermore, that filing receipt admonished applicant to verify the accuracy of the data thereon.

Furthermore, petitioner concededly received the filing receipt, and, as such, petitioner was put on reasonable notice of the lack of copendency well before the one year time limit of former 37 CFR 1.137 had expired. Note in this regard, that petitioner had specifically requested to extend the response period in the '207 application to June 18, 1987, and was shortly thereafter informed that the filing date of the continuing application was June 22, 1988, not June 18, 1988. Nevertheless, petitioner failed to provide the necessary (and timely) reply to the filing receipt: a petition under 37 CFR 1.137(b) to revive this application to obtain copendency. The failure to supply the proper reply was the fault of petitioner, not the PTO. As noted in Brenner v. Ebbert, 398 F.2d. 762, 765, 157 USPQ 609, 611 (D.C. Cir. 1968), *cert. den.* 159 USPQ 799:

The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received.

It follows that petitioner had received the reasonable notice required so as ensure a timely and full response to the filing receipt. That petitioner failed to timely and adequately respond was unfortunate, but such failure was avoidable by the exercise of ordinary care and diligence. See Brenner, supra. As such, had petitioner diligently filed a petition seeking to revive this application for copendency purposes under 37 CFR 1.137(b), the very terminal disclaimer that petitioner now seeks to vitiate would have been unnecessary. That is, under the terms of former 37 CFR 1.137(b), a terminal disclaimer was not required if a grantable petition to revive was filed within one year of the date of abandonment. Rather, a terminal disclaimer was only required pursuant to 37 CFR 1.183, when the one year filing period of 37 CFR 1.137(b)(4) was waived. As in Vincent, applicant's, and applicant's counsel's failure to exercise reasonable, due care and

diligence does not constitute grounds for requesting an extraordinary remedy. Lockheed, supra.

That is, that counsel (1) erroneously applied 37 CFR 1.8 in lieu of 1.10, to file an application where copendency was sought, and (2) failed to duly observe the lack of copendency expressly noted upon the subsequently issued filing receipt, does not represent circumstances that were beyond the control of petitioner, or counsel for petitioner. Rather, such circumstances could have been avoided merely by the exercise of reasonable, due care and diligence. Circumstances resulting from petitioner's, or petitioner's counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977). Moreover, even assuming that clerical inadvertence or mistake in former counsel's office caused or contributed to the asserted filing error, such is not adequate grounds for requesting extraordinary relief. See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994) (clerical error causing delay resulting in a statutory bar does not warrant suspension of the rules).

Further in this regard, in light of the filing receipt which clearly pointed out the lack of copendency, that petitioner required some forty three months to realize that copendency had not been obtained, does not warrant PTO acceptance of a terminal disclaimer of two days. That is, as counsel for petitioner had received the filing receipt, petitioner had constructive notice of the lack of copendency. That is, notice given to applicant's representative of record constitutes notice to applicant. Rosenberg v. Carr Fastener Co., 10 USPQ 106, 51 F.2d 1014 (2nd. Cir. 1931), cert. denied, 284 U.S. 652. While counsel may have failed to properly obtain pendency, and then may have failed to note the lack of pendency, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner 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. Ouigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Moreover, petitioner did not discover the lack of copendency in two days; petitioner required a time period in excess of forty three months. Thus, there is no

adequate showing of an extraordinary situation warranting the requested relief. See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require exceptional remedies, when a party makes an avoidable mistake in filing papers). Had petitioner duly observed the lack of copendency within two days of the actual fact, and immediately presented a petition to remedy the situation, petitioner would be in a better position to request PTO acceptance of a terminal disclaimer limited to but two days.

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 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). In this regard, the established PTO practice was (1) to require, for a grantable petition under 37 CFR 1.183 and 1.137(b), a terminal disclaimer equivalent to the time period in months that the application remained abandoned, and (2) to require that the terminal disclaimer be recorded against any application claiming § 120 benefits of the application being revived.

Moreover, the PTO did not cause or contribute to petitioner's three year delay in presenting the initial petition, during which time the public has been continuously apprised that the term of the patent expires on January 17, 2007, by operation of the recorded Terminal disclaimer. Petitioner is reminded that the terminal disclaimer was then required as a condition for waiver of the one year time period of 37 CFR 1.137(b), under the authority of 37 CFR 1.183 (i.e., "subject to such other requirements as may be imposed.")³ Such does not afford proper legal or public policy grounds for requesting nullification of the terms of free

³ It is noted that, effective December 1, 1997, 37 CFR 1.137(b) was amended to delete the one year time period for filing a petition to revive thereunder, while 37 CFR 1.137(c) was also amended to require, for applications filed before June 8, 1995, the filing of a terminal disclaimer as part of a petition submitted under 37 CFR 1.137(b). The time period required to be disclaimed is equivalent to the interval starting from when the application became abandoned, and ending when a grantable petition was filed. See the final notice entitled "Changes to Patent Practice and Procedure", 62 Fed. Reg. 53132, 53160 (October 10, 1997).

dedication to the public contained in the previously filed terminal disclaimer by way of appeal, much less on petition. Cf. Ex Parte Anthony, 230 USPQ 467 (PBAI 1982) aff'd. No. 84-1357 (Fed. Cir. June 14, 1985).

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 Patent and Trademark Office (Office) (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 withdrawal of a terminal disclaimer. Finally, petitioner has not sought amendment or correction by reissue (35 USC §§ 251 and 252).

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. As stated in section 1490 of the Manual of Patent Examining Procedure (MPEP) (6th Ed., Rev. 3 1997), 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 otherwise nullify the effect of a recorded terminal disclaimer.

In any event, to withdraw the terminal disclaimer filed January 28, 1993 and properly recorded in the above-identified patent, such action must be authorized pursuant to 35 USC § 255.

A Certificate of Correction under 35 USC § 255 and 37 CFR 1.323 is available 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 In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pat. 1991); In re Hyman, 185 USPQ 441, 442 (Sol. Pat. 1975). Specifically, 35 USC § 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) would require reexamination. See Arnott 19 USPQ2d at 1052; see also MPEP 1490.

Apparently, the "mistake" at issue here involves petitioner's lack of inclusion in the terminal disclaimer filed January 28,

1993, of a term of two days. However, this "mistake" is not one of a clerical or typographical nature; rather correcting this "mistake" would involve a substantive change to the recorded terminal disclaimer of record. Secondly, the "broadening" of the claims of a patent, via the attempted removal of a recorded terminal disclaimer, requires reexamination (pursuant to 35 USC § 251) of the issues raised thereby. See Anthony, supra.

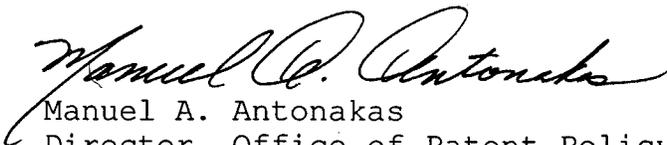
Rather, the "broadening" of the claims of a patent, via the attempted removal of a recorded terminal disclaimer, requires reexamination (pursuant to 35 USC § 251) of the issues raised thereby. See Anthony, supra. Further, in this regard, even while 35 USC § 251 is a remedial statute, and, as such, is often liberally construed, nevertheless, there is a two year bar on applying for any remedy that would effectuate broadening of an issued patent. See 35 § USC 251, ¶ 4. As held in Anthony, however, removal of a recorded terminal disclaimer, and the resultant "broadening" of the vertical scope (term) of the original patent, is prohibited, *inter alia*, if the attempt via reissue is not sought within two years of the patent grant. See Id. at 470. That is, the requested nullification here, as in Anthony, of the recorded terminal disclaimer would increase the period of enforceability of the originally granted patent. It would be an improper exercise of 37 CFR 1.182 to permit petitioner to regain, on petition, what petitioner could not regain under the remedial patent statute, which, as such, is "liberally construed."

DECISION

For the reasons given above, it would be an inappropriate exercise of 37 CFR 1.182 to rescind the terminal disclaimer of record. Accordingly, the petition is granted to the extent that the previous decision has been reconsidered, but is **denied** as to rescinding the terminal disclaimer of record.

This patent file is being returned to the Files Repository.

Telephone inquiries relative to this decision should be directed to Special Projects Examiner Brian Hearn at (703) 305-1820.



Manuel A. Antonakas
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Office of the Deputy Assistant Commissioner
for Patent Policy and Projects