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OFFICE OF PETITIONS
AND PATENTS

In re Application of
Robert Lonardo

Application No: 08/020,222
Filed: February 16, 1993
Issued: December 14, 1993
Patent No.5,269,748

Application No: 08/052,517
Filed: April 29, 1993
Issued: March 29, 1994
Patent No.5,298,013

Application No: 08/218,756
Filed: March 28, 1994

DECISION ON

PETITION

This is a decision on a petition, filed October 16, 1995, to waive or suspend under 37 CFR 1.183 the requirement in 37 CFR 1.137(c) for a terminal disclaimer in each of the above identified patents and the above identified pending application. In a supplement to the above petition, filed on February 26, 1996, petitioner requests that, if the requirement for a terminal disclaimer is not waived, that the term disclaimed should be calculated from the date of abandonment to the date of filing the first petition to revive (176 months) rather than the date of filing the second petition to revive (182 months).

The petitions are denied.

BACKGROUND

Each of the above patents and application claim benefit under 35 U.S.C. 120 to the filing date of application No. 05/399,365 of Robert Lonardo (Lonardo), which became abandoned on March 8, 1974, for failure to file formal drawings within a two-month

period specified in an office communication dated January 7, 1974. Lonardo's attorney filed a substitute application No. 05/584,371 on June 6, 1975, which matured into U.S. Patent No. 3,976,059 on August 24, 1976. Because of the above abandonment, however, there was no copendency with the '365 application and no claim under 35 U.S.C. 120 for the benefit of its filing date. During an infringement action on his '059 patent, Lonardo became aware of the above abandonment and lack of continuity and realized that his patent was open to attacks in view of prior art which occurred prior to filing the '371 application. In order to remedy this situation, on November 21, 1988, Lonardo filed a petition to revive the '365 application under 37 CFR 1.137(a) in order to claim benefits under 35 U.S.C. 120 in his '059 patent. This petition was denied on April 18, 1989. Along with the petition of November 21, 1988, Lonardo filed a terminal disclaimer as required by 37 CFR 1.137(c) "disclaiming ...terminal part..equivalent to the period of abandonment" but did not specify the period of time disclaimed. On May 4, 1989, Lonardo filed a renewed petition to revive under 37 CFR 1.137(a). That petition was denied on August 4, 1989. As part of the petition of May 4, 1989, Lonardo filed a terminal disclaimer specifying the period disclaimed as being 182 months, following a suggestion made in the decision of April 18, 1989.

Lonardo filed suit against the Commissioner in the United States District Court, Middle District of Florida, seeking a court order directing the Commissioner to revive the '365 application. On May 4, 1990, the District Court granted a stay and remanded the case to the Patent and Trademark Office (PTO) to consider additional evidence. On June 1, 1990 Lonardo filed a renewed petition and on August 6, 1990, the petition to revive the '365 application was granted, In re Lonardo 17 USPQ2d 1455 (Comm'r Pat. & Trademarks 1990). The terminal disclaimer of May 4, 1989, disclaiming 182 months of the terminal part of any patent granted on the revived application was therefore accepted. That disclaimer applies to any patent granted on the application, including any later issuing patent on any application claiming benefit under 35 U.S.C. 120 of the filing date of the revived application. As part of the order dismissing the above civil case without prejudice, Lonardo filed a 15-month terminal disclaimer in his '059 patent.[1]

Following the revival, Lonardo filed for reissue of the '059 patent in order to obtain the benefit of 35 U.S.C. 120 to the revived '365 application resulting in U.S. Patent No. Re. 33,762 on December 10, 1991. Because of the 15-month terminal

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[1]In view of the fact that U.S. Patent No. 3,976,059 was in existence at the time of the revival of the '365 application, the 182-month terminal disclaimer in the latter application did not apply to the '059 patent. The separate 15-month terminal disclaimer was therefore required.

disclaimer, this patent expired on May 24, 1992. Also following the revival, the '365 application was further prosecuted and on February 16, 1993, was abandoned in favor of an FWC continuation application No. 08/020,222 which issued as U.S. Patent No. 5,269,748 on December 14, 1993. In the preliminary amendment accompanying the '222 application, Lonardo affirmed that his terminal disclaimer in the '365 application applied to the '222 application. U.S. Patent No. 5,269,748 expired on October 14, 1995, due to the terminal disclaimer of May 4, 1989.

On April 29, 1993, applicant filed divisional application No. 08/052,517 from the above application No. 08/020,222. The divisional application issued as U.S. Patent No. 5,298,013 on March 29, 1994. U.S. Patent No. 5,298,013 also expired on October 14, 1995, due to the 182-month terminal disclaimer, as well as the filing of an additional terminal disclaimer on November 19, 1993, over the '222 application.

On March 28, 1994, applicant filed Rule 60 continuation application No. 08/218,756 of application No. 08/052,517. In view of the 182-month terminal disclaimer, as well as the filing of another terminal disclaimer on October 11, 1994, over the '013 patent, any patent granted on this application would also have expired on October 14, 1995.

On March 23, 1994, applicant filed a petition under 37 CFR 1.183 in the '517 application to waive or suspend 37 CFR 1.137(c) and to withdraw or limit the terminal disclaimer of 182 months filed in the '365 parent application. This petition was denied on March 28, 1994, since the facts did not establish an extraordinary situation that required the suspension of the rule in the interests of justice. The decision pointed out that if applicant believed the period disclaimed was inappropriate, a petition under 37 CFR 1.183 should have been filed prior to the revival of the '365 application.

Finally on November 14, 1994, following notification by the Office that it intended to issue a Certificate of Correction to U.S. Patent No. 5,269,748 and U.S. Patent No. 5,298,013 to read "the portion of the terms of this patent subsequent to October 14, 1995 has been disclaimed", petitioner indicated he did not intend to oppose issuance of the Certificate of Correction and requested that issuance be expedited.

PETITIONER'S ARGUMENTS

Petitioner argues (1) that an extraordinary situation exists and quotes portions of the Lonardo decision which indicated the unusual set of facts that justified the revival of the '365 application; (2) that justice requires the terminal disclaimer be set aside or modified in view of the facts set forth in the Lonardo decision that the abandonment was the fault of applicant's attorney and applicant should not be charged with his

attorney's conduct; (3) that the terminal disclaimer is a deprivation of property without due process under the Fifth Amendment of the Constitution in that the PTO has taken 15+ years of applicant's patents without due process or compensation; and (4) since 37 CFR 1.183 has no limitation regarding timeliness, this petition is timely. Petitioner, alluding to the above decision of March 28, 1994, which indicated that applicant should have invoked 37 CFR 1.183 prior to revival of the '365 application, argues that there is no authority for requiring such a petition to be filed prior to the revival of the application and that further delay in the revival was not warranted.

STATUTES, REGULATIONS and POLICY GUIDELINES

The Constitution of the United States provides:

"Art. 1, Sec. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

35 U.S.C. 6(a) provides:

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; shall have the authority to carry on studies, programs, or exchanges of items or services regarding domestic and international patent and trademark law or the administration of the Patent and Trademark Office; and shall have charge of property belonging to the Patent and Trademark Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

35 U.S.C. 112, first paragraph provides:

The specification shall contain a written description of the invention, and the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

35 U.S.C. 154 provides:

(a) IN GENERAL.

(1) CONTENTS. Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.

(2) TERM. Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed....

(c) CONTINUATION.

(1) DETERMINATION. The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act (December 8, 1994) shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

35 U.S.C. § 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. 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.
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> 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 provides 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 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.

35 U.S.C. 261 provides:

Subject to the provisions of this title, patents shall have the attributes of personal property.

37 CFR 1.11 provides:

(a) After a patent has been issued or a statutory invention registration has been published, the specification, drawings and all papers relating to the case in the file of the patent or statutory invention registration are open to inspection by the public, and copies may be obtained upon paying the fee therefor. See § 2.27 for trademark files.

37 CFR 1.137 provides:

(a) An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A petition to revive an abandoned application must be promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment, and must be accompanied by:

(1) A proposed response to continue prosecution of that application, or the filing of a continuing application, unless either has been previously filed;

(2) The petition fee as set forth in § 1.17(l); and

(3) A showing that the delay was unavoidable. The showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(b) An application unintentionally abandoned for failure to prosecute may be revived as a pending application if the delay was unintentional. A petition to revive an unintentionally abandoned application must be:

(1) Accompanied by a proposed response to continue prosecution of that application, or the filing of a continuing application, unless either has been previously filed;

(2) Accompanied by the petition fee as set forth in § 1.17(m);

(3) Accompanied by a statement that the delay was unintentional. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Filed either:

(i) Within one year of the date on which the application became abandoned; or

(ii Within three months of the date of the first decision on a petition to revive under paragraph (a) of this section which was filed within one year of the date on which the

application became abandoned.

(c) ...any petition pursuant to paragraph (a) of this section not filed within six months of the date of abandonment of the application, must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. The terminal disclaimer must also apply to any patent granted on any continuing application entitled under 35 U.S.C. 120 to the benefit of the filing date of the application for which revival is sought.

(d) Any request for reconsideration or review of a decision refusing to revive an application upon petition filed pursuant to paragraphs (a) or (b) of this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision.

(e) The time periods set forth in this section cannot be extended, except that the three-month period set forth in paragraph (b)(4)(ii) and the time period set forth in paragraph (d) of this section may be extended under the provisions of § 1.136.

37 CFR 1.181 provides:

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Commissioner.

(f) Except as otherwise provided in these rules, any such

petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings.

(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR 1.183 provides:

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 Commissioner or the Commissioner'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(h).

37 CFR 1.321 provides:

(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 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 provides 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 request 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.

37 CFR 1.325 provides that:

> 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.

PRELIMINARY TO DECISION

As background to this decision, a review of the law providing for the grant of patents and its effect on the patentee as well as the public appears in order.

The Constitution empowers Congress "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."(U.S. Const. art.1, § 8). Congress, in exercising this authority, has enacted Title 35 of the United States Code establishing the Patent and Trademark Office and the laws governing its operation. Pursuant to these laws, a patent grants to the patentee, his heirs or assigns, "the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States" (35 U.S.C. 154 (a)(1)). The term of the patent (as it applies in this instance)

is "17 years from grant subject to any terminal disclaimers" (35 U.S.C. 154 (c)(1)). In return for this grant, in order to promote the progress of science and the useful arts, the patentee is required to provide "a written description of the invention, and the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same" (35 U.S.C. 112). This latter provision has often been referred to as the quid pro quo from patentee to the public for the grant of the patent, since, once the patent term expires, the rights therein become public property and are freely available to all. Once granted, the patent has all the aspects of personal property rights granted for a limited time (35 U.S.C. 261).

In establishing the duties of the Commissioner, Congress empowered him to "establish regulations, not inconsistent with law, for conduct of proceedings in the Patent and Trademark Office" (35 U.S.C. 6). During the prosecution of the '365 application, petitioner failed to respond to an action within the set statutory period and the application was held abandoned pursuant to 35 U.S.C. 133, which indicates that in such a situation the "application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable". Since the latter statute defers this determination to the Commissioner, the Commissioner through his rule making authority established 37 CFR 1.137, which provides for petitions to revive an application abandoned for failure to prosecute if it can be shown that the delay was unavoidable. The rule also sets forth specific requirements that must accompany the petition. The requirement particularly relevant to this decision is 37 CFR 1.137(c) which states that "any petition pursuant to paragraph (a) of this section not filed within six months of the date of abandonment of the application, must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application". The terminal disclaimer must also apply to any patent granted on any continuing application entitled under 35 U.S.C. 120 to the benefit of the filing date of the application for which revival is sought in order to prevent the refiling of an application from negating the effect of the terminal disclaimer. This section was provided in the rule in order to prevent abuse and injury to the public.(See In re Application of S, 8 USPQ2d 1630 (Comm'r Pat. & Trademarks 1988).

DECISION

This petition requests relief impacting on two patents and one patent application. Petitioner requests that the terminal disclaimers recorded on the patents and application be waived or suspended or, in the alternative, that the period disclaimed be

reduced.

In view of the fact that the terminal disclaimers are recorded on the patents, petitioner's request raises a separate issue with respect to "correction of patents" which will be initially treated prior to the issue of waiver of the requirements of 37 CFR 1.137(c) that impact on both the patents and the application.

Correction of the Patents

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 U.S.C. § 254) or correction of the named inventor (35 U.S.C. § 256). In addition, while the instant petition involves a disclaimer, 35 U.S.C. § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the withdrawal or modification of a terminal disclaimer. Finally, petitioner has not sought amendment or correction by reissue (35 U.S.C. §§ 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. 1 1995), the mechanisms to correct a patent (*i.e.*, 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. The Supreme Court has stated that, as a general principle, public policy does not favor the restoration to a patent of that which has been dedicated to the public by disclaimer. See Altoona Publix Theatres, 294 U.S. 477, 492, 24 USPQ 308, 315 (1935); see also Leggett v. Avery, 101 U.S. (11 Otto) 256, 259-60 (1879).

In any event, to withdraw the terminal disclaimer filed on May 4, 1989 and properly recorded in the above-identified patents, such action must be authorized pursuant to 35 U.S.C. § 255.

A Certificate of Correction under 35 U.S.C. § 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 Pats. 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) would require reexamination. See Arnott 19 USPQ2d at 1052; see also MPEP 1490.

The "mistake" at issue involves petitioner's filing of the terminal disclaimer on May 4, 1989 that disclaims 182 months of any patent granted on the revived application or on any patent granted on any continuing application entitled under 35 U.S.C 120 to the benefit of the filing date of the revived application, or alternatively the failure to file a terminal disclaimer disclaiming only 176 months. This "mistake," however, is not one of a clerical or typographical nature; rather, it involves either the elimination of the recorded terminal disclaimer or altering the language concerning the expiration date of the above-identified patents. This "mistake" cannot reasonably be characterized as one of minor character. See MPEP 1490.

Since the first requirement under 35 U.S.C. § 255 is not met (*i.e.*, the "mistake" sought to be corrected is not of the type proper for correction under 35 U.S.C. § 255), whether the withdrawal of the terminal disclaimer filed on May 4, 1989 or the substitution in favor of one disclaiming only 176 months would constitute new matter or require reexamination is moot. Id.

Accordingly, a Certificate of Correction is not available for the requested correction.

Assuming, *arguendo*, that the patent statutes authorized the withdrawal of the terminal disclaimer filed on May 4, 1989, or the substitution of a newly submitted terminal disclaimer disclaiming 176 months, such action would not constitute an appropriate exercise of the Commissioner's discretion under 37 CFR 1.182 or 1.183 or 35 U.S.C. § 255 and 37 CFR 1.323. Granting the requested relief would operate to evade the requirements of the reissue statutes (*i.e.*, 35 U.S.C. §§ 251 and 252). The remedial nature of reissue notwithstanding, reissue is not available to correct all errors. Specifically, it is the Office's position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. See Ex parte Anthony, 230 USPQ 467 (Bd. App. 1982), affd, Appeal No. 84-1357 (Fed. Cir. 1985); see also MPEP 1490.

Thus, the "mistake" at issue is not provided for in 37 CFR 1.322, 1.323, or 1.324, and does not afford legal grounds for reissue or for reexamination. Therefore, the PTO will not, pursuant to 37 CFR 1.182 or 1.183, withdraw or otherwise nullify the effect of a disclaimer properly recorded in an issued patent. See 37 CFR 1.325; MPEP 1490.

Waiver of 37 CFR 1.137(c) Under 37 CFR 1.183

With respect to the due process and timeliness issues, petitioner was given ample opportunity, when he petitioned to revive

abandoned application '365, to address the terminal disclaimer issue of 37 CFR 1.137(c). Petitioner voluntarily filed terminal disclaimers in the petitions of November 21, 1988 and May 4, 1989. The 182-month terminal disclaimer filed on May 4, 1989 was accepted by the revival of the '365 application on August 6, 1990. By doing so, petitioner gave up a portion of the patent term of any patent granted on that application, including any later issuing patent on any application claiming benefit under 35 U.S.C. 120 of the filing date of the revived application. The PTO did not take any patent term from petitioner. In fact, petitioner's only stated purpose for the original petition to revive the '365 application was to enable that application to have continuity with his '059 patent.[2] In this respect petitioner gained not only the right to perfect his '059 patent by claiming priority under 35 U.S.C. 120 through reissue of the '059 patent, but also the right to continue to prosecute the '365 application[3] in return for the terminal disclaimer.

If petitioner believed that the regulatory requirement for a terminal disclaimer was not justified, that issue could have and should have been raised in any one of the petitions of November 21, 1988, May 4, 1989 and June 1, 1990. Although petitioner argues that there is "no authority for requiring such a petition to be filed prior to revival of the application", 37 CFR 1.181(f) clearly states that, "except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely". In view of this rule, if petitioner felt that the terminal disclaimer requirement of 37 CFR 1.137(c) was unjustified, his petition, to be timely, should have been filed at the time the terminal disclaimer was being required. This was clearly the appropriate time to raise such a petition since the presence of a terminal disclaimer and its acceptance by the PTO was a factor in the decision of the PTO granting the petition to revive and there had yet to be any public reliance on the language of the terminal disclaimer. Instead, petitioner waited until the petition of March 23, 1994, to raise for the first time his request to retroactively waive the terminal disclaimer accepted three and a half years earlier and following the denial on March 28, 1994, waited another year and a half to raise it again in this petition.

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[2]A reissue application of the '059 patent was filed on September 4, 1990 to claim priority to the '365 application, and issued as Re 33,762 on December 10, 1991.

[3]Petitioner continued prosecution of the '365 application, which was subsequently abandoned in favor continuing applications that resulted in U.S. Patent No. 5,269,748 and U.S. Patent No. 5,298,013. This continued prosecution permitted petitioner to enlarge the scope of his claims over that of the '059 patent.

The provisions of 37 CFR 1.183 permit suspension or waiver of a rule in an extraordinary situation when justice requires. This is a two-part test and, to warrant the waiver, the petition must show (1) that this is an extraordinary situation and (2) that justice requires waiver of the rule.

Petitioner, in support of his position that an extraordinary situation exists relies upon the facts that led to the revival of the '365 application. In order to revive an abandoned application under the unavoidable delay standard, as was the case with the '365 application, a petitioner must set forth sufficient facts to satisfy the Commissioner that the delay was unavoidable. This petitioner did. The word "unavoidable" is applicable to ordinary human affairs and requires no more or greater care than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31,32-33 (Comm'r Pat. 1887); In re Matullath, 38 App. D.C. 497, 514-15 (1912); Winkler v. Ladd, 221 F.Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172,172 (D.D.C. 1964; In re Katrapat, AG, 6 USPQ2d 1863,1866 (Comm'r Pat. & Trademarks 1988). However, many applications that are revived under the unavoidable standard of 37 CFR 1.137(a) quite often have facts analogous to those set forth by petitioner. By its very definition, "extraordinary" means something that is beyond what is common or usual. It is something that is "very exceptional".[4] In many, if not most, situations unusual circumstances will be present when the Commissioner finds that a delay was unavoidable. 37 CFR 1.137(c) recognizes that in these situations, a terminal disclaimer would be required to protect the public interest. To obtain the requested relief under 37 CFR 1.183, petitioner must show that in its situation the unusual circumstances were so extraordinary that justice requires that the Commissioner waive the requirement for a terminal disclaimer. Taken in the context of similar fact situations that arise commonly in 37 CFR 1.137(a) petitions, petitioner has failed to demonstrate why his situation rises to the level of extraordinary. In fact, if petitioner's argument were accepted, 37 CFR 1.137(c) would serve no useful purpose, since a terminal disclaimer is only accepted when unavoidable delay has been established.

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[4]Webster's II New Riverside University Dictionary,The Riverside Publishing Company,1988.

Furthermore, in addition to the fact that petitioner has failed to demonstrate why his 37 CFR 1.137(a) fact situation rises to the level of extraordinary, when examining the facts to determine whether an "extraordinary situation" exists that warrants a waiver of the rules in the interest of justice, weight must be given, not only to the situation that led to the original revival, but also to what has transpired subsequent to the revival. The "extraordinary situation" to be evaluated is the situation that exists at the time of the requested waiver. A showing of unavoidable delay under 37 CFR 1.137(a) may rise to the level of "extraordinary and a waiver of the terminal disclaimer would be warranted. However, the most unusual aspect of this case is that petitioner acquiesced to the terminal disclaimer and then waited years before raising the issue of the appropriateness of the disclaimer. As explained below, while this situation may be unusual, it is not an "extraordinary situation" that, in the interest of justice, supports waiving a rule.

With respect to the second part of the test, justice in this instance requires that not only petitioner's interests be protected but also that the public's interest be considered. The record indicates that throughout the prosecution of petitioner's chain of applications, petitioner has continually affirmed his terminal disclaimer. The terminal disclaimer of May 4, 1989, originally disclaimed the 182 months in the '365 application. When the '222 application was filed in February 16, 1993, as a continuation of the '365 application, petitioner in his preliminary amendment stated "the terminal disclaimer in the parent case ('365) automatically applies to the present case". In the '517 application, which was a divisional application of the '222 application, petitioner filed a terminal disclaimer on November 19, 1993, such that a patent issuing on that application would expire with any patent issuing on the '222 application. In the '756 application, which was a continuation of the '517 application, petitioner filed a terminal disclaimer on October 11, 1994, such that any patent issuing on that application would expire with U.S. Patent No. 5,298,013 (the '517 application). Finally on November 14, 1994, after being notified that a Certificate of Correction was being issued in U.S. Patent No. 5,269,748 (the '222 application) and U.S. Patent No. 5,298,013(the '517 application) to indicate that "the term subsequent to October 14, 1995 has been disclaimed", petitioner not only acquiesced but requested that it be expedited. Once a patent has issued, all papers relating to the case in the file of the patent are open to inspection by the public (37 CFR 1.11). The public has therefore been placed on notice that the above noted patents expired on October 14, 1995, as a result of the above terminal disclaimers. Any patent granted on the still pending '756 application would also have the October 14, 1995 expiration because of the disclaimers.

As a general rule, 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. (See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477(1935). Petitioner's voluntarily filed 182-month terminal disclaimer filed on May 4, 1989 was accepted on August 6, 1990, and has continuously been reaffirmed by petitioner as noted above. The public has a right to rely on voluntarily filed terminal disclaimers of which they have been notified.

Petitioner has brought a number of infringement actions against members of the public and clearly they are aware not only that there has been a terminal disclaimer, but that petitioner's patents have expired as of October 14, 1995. They, and the rest of the public, should now be free to practice the invention which has now become public property. As recently noted in Herbert Markman and Positek, Inc. v Westview Instruments, Inc.,1996 U.S. Lexis 2804, 64 U.S.L.W. 4263 (1996), "the limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public." Although that case involved claim interpretation, the limits of a patent that must be known involve not only what the patentee can exclude others from but also the term of this exclusion. When balancing the equities between the petitioner who did not timely raise this waiver issue, either the full waiver or the partial waiver, and the public who had the right to rely on petitioner's continued affirmation of the disclaimer and who now are free to use the invention of the expired patents, the scale of justice clearly falls on the side of protecting the public interest.

SUMMARY

The petition fails to establish that the requested relief for the two patents is proper under the patent statutes and regulations. Furthermore, the petition does not establish an extraordinary situation that requires suspension of the rules in the interest of justice. On the contrary, justice in this instance mitigates against allowing petitioner to recapture something that he has intentionally dedicated to the public.

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