



Paper No. 44

MCANDREWS HELD & MALLOY LTD  
500 WEST MADISON STREET  
CHICAGO ILLINOIS 60661

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**OFFICE OF PETITIONS**

In re Patent No. 6,165,500  
Issue Date: December 26, 2000  
Application No. 07/844,664  
Filed: April 8, 1992 (CPA filed 2/26/99)  
Patentee: Cevc

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:  
: DECISION DENYING  
: PETITION

This is a decision on the paper filed December 12, 2002, which is being treated as a request under 35 U.S.C. § 254 and 37 CFR 1.322 and petition under 37 CFR 1.182 to issue a Certificate of Correction for the above-identified patent to remove the indication that "[t]his patent is subject to a terminal disclaimer."

The petition to issue a Certificate of Correction for the above-identified patent to remove the indication statement that "[t]his patent is subject to a terminal disclaimer" is **DENIED**.

BACKGROUND

International application PCT/EP/91/01956 was filed August 22, 1991, which claimed priority based on an earlier Federal Republic of Germany application filed August 24, 1990. As such, the twenty two (22) month period for meeting the requirements of 35 USC 371(c) and entering the national stage in the United States as a designated country pursuant to 37 CFR 1.494 expired at midnight on June 24, 1991. As the required 35 USC 371(c)(2) translation of the application into English was not filed prior to midnight on June 24, 1992, the application became abandoned with respect to the United States on June 25, 1992. 35 USC 371(d); 37 CFR 1.494(h). A Notification of Abandonment was mailed August 29, 1992.

A petition to revive the application under the provisions of 37 CFR 1.137(a), or alternatively under 37 CFR 1.183 and 1.137(b) to waive the (then) one year filing requirement in 37 CFR 1.137(b) was filed on February 15, 1995 and was dismissed in the decision of June 22, 1995. The decision noted (at 4), *inter alia*, that any petition filed under 37 CFR 1.137(a) had to be accompanied by a terminal disclaimer if, as here, a grantable petition to revive was not filed within 6 months from the date of abandonment. The decision further noted that the terminal disclaimer proffered with the petition was not acceptable *per se* in that it lacked, pursuant to 37 CFR 1.137(c)(1995)

the statement "this terminal disclaimer applies to any patent granted on the above-identified application or on any application which is entitled to the benefit of the filing date of this application under 35 USC 120."

A renewed petition under the same grounds was filed October 26, 1995, and was dismissed in the decision of January 23, 1996. The petition was accompanied by a terminal disclaimer containing the previously omitted language noted above.

A further renewed petition under 37 CFR 1.137(a) was filed April 26, 1996, and was granted in the decision of June 26, 1996. The above-noted terminal disclaimer filed October 26, 1995, was accepted, and the period disclaimed was forty six (46) months which was equivalent to the period of abandonment. Applicant was also notified that any continuing application would have to contain a copy of the above-noted terminal disclaimer, along with a cover letter requesting the terminal disclaimer be recorded against the continuing application.

In due course, on February 26, 1999, applicant filed a request for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d). The CPA request specifically identified the above-noted parent application (application No. 07/844,064), and the CPA request form filed by applicant noted (at 3) "A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request. 37 CFR 1.178(a)."

A Notice of Allowance was mailed in the CPA on March 30, 2000. In reply, applicant timely paid the issue fee and patent No. 6,156,500 issued to the CPA application on December 26, 2000. The as-issued patent included a notice to the fact that a terminal disclaimer had been recorded against the patent.

The instant petition was filed December 12, 2002.

#### STATUTE AND REGULATION

35 U.S.C. § (2)(b)(2) provides, in pertinent part, that:

The Office...may establish regulations, not inconsistent with law,  
which...

(A) shall govern the conduct of proceedings in the Office.

35 USC § 253 states in pertinent part:

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.

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. § 254 provides that:

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.

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 1.321 states in pertinent part:

(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).

37 CFR 1.322 states:

(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 1.325 states:

Mistakes other than those provided for in §§ 1.322, 1.323, 1.324, and not affording legal grounds for reissue or reexamination, will not be corrected after the date of the patent.

MPEP 1490 states in pertinent part:

WITHDRAWING A RECORDED TERMINAL DISCLAIMER If timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent, or in a reexamination

proceeding before the reexamination certificate issues. After a patent or reexamination certificate issues, it is unlikely that a recorded terminal disclaimer will be nullified.

A. Before Issuance Of Patent While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA). Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer. Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered. The filing of a continuing application other than a CPA, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer.

B. After Issuance Of Patent The mechanisms to correct a patent - 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. As a general principle, 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 - e.g., intervening rights in the case of a reissue patent. See, e.g., *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477, 24 USPQ 308 (1935). Certificates of correction (35 U.S.C. 255) are available for the correction of an applicant's mistake. The scope of this remedial provision is limited in two ways - by the nature of the mistake for which correction is sought and the nature of the proposed correction. *In re Arnott*, 19 USPQ2d 1049 (Comm'r Pat. 1991). The nature of the mistake for which correction is sought is limited to those mistakes that are: (A) of a clerical nature, (B) of a typographical nature, or (C) of a minor character. The nature of the proposed correction is limited to those situations where the correction

does not involve changes which would: (A) constitute new matter, or (B) require reexamination. A mistake in filing a terminal disclaimer does not fall within any of the categories of mistake for which a certificate of correction of applicant's mistake is permissible, and any attempt to remove or nullify the effect of the terminal disclaimer would typically require reexamination of the circumstances under which it was filed. Although the remedial nature of reissue (35 U.S.C. 251) is well recognized, reissue is not available to correct all errors. It has been the Office position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. First, the reissue statute only authorizes the Commissioner to reissue a patent "for the unexpired part of the term of the original patent." Since the granting of a reissue patent without the effect of a recorded terminal disclaimer would result in extending the term of the original patent, reissue under these circumstances would be contrary to the statute. Second, the principle against recapturing something that has been intentionally dedicated to the public dates back to *Leggett v. Avery*, 101 U.S. 256 (1879). The attempt to restore that portion of the patent term that was dedicated to the public to secure the grant of the original patent would be contrary to this recapture principle. Finally, applicants have the opportunity to challenge the need for a terminal disclaimer during the prosecution of the application that issues as a patent. "Reissue is not a substitute for Patent Office appeal procedures." *Ball Corp. v. United States*, 729 F.2d 1429, 1435, 221 USPQ 289, 293 (Fed. Cir. 1984). Where applicants did not challenge the propriety of the examiner's obvious-type double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of 35 U.S.C. 251. *Ex parte Anthony*, 230 USPQ 467 (Bd. App. 1982), *aff'd*, No. 84-1357 (Fed. Cir. June 14, 1985). Finally, the nullification of a recorded terminal disclaimer would not be appropriate in a reexamination proceeding. There is a prohibition (35 U.S.C. 305) against enlarging the scope of a claim during a reexamination proceeding. As noted by the Board in *Anthony*, *supra*, if a terminal disclaimer was nullified, "claims would be able to be sued upon for a longer period than would the claims of the original patent. Therefore, the vertical scope, as opposed to the horizontal scope (where the subject matter is enlarged), would be enlarged."

#### OPINION

Petitioner requests under 37 CFR 1.182 expedited correction under 35 USC 254 and 37 CFR 1.322 by removing the reference to a terminal disclaimer on the cover page of

the above-identified patent. Specifically, petitioner asserts, the patent should be entitled to its full statutory 20 year term, and that its term should not be additionally shortened by the terminal disclaimer, since as petitioner asserts, "by its terms the terminal disclaimer in question is inapplicable to the patent." While petitioner concedes the terminal disclaimer (of 46 months) was properly required in the parent application with its 17 year term, due to the filing of the continuation (CPA) after June 8, 1995, such is subject to a 20- years- from- filing term that is automatically shortened by the 46 month period of abandonment, the resultant effect is that with the terminal disclaimer in force applicant is now subject to a term that is shortened by an additional 46 months.

Unfortunately petitioner has not demonstrated any error in the patent as-issued, or even an error that may now be corrected with respect to the terminal disclaimer by way of a Certificate of Correction. Rather, the alleged error is not an error within the meaning of 35 USC 254 and 37 CFR 1.322, and even assuming there is an error in the patent, it is not subject matter for and amenable to the proposed correction by the proffered Certificate of Correction under 35 USC § 254 and its promulgating regulation 37 CFR 1.322.<sup>1</sup>

Initially, petitioner's references to the amendment of 37 CFR 1.137(d), which eliminated the requirement for a terminal disclaimer as a condition of revival of applications filed on or after June 8, 1995, and 60 *Fed. Reg.* 20195 at 20203 (April 25, 1995) are simply not relevant to the issue as why the above-identified patent issued with the recorded terminal disclaimer in question. That is, it was in the prior application, filed April 8, 1992, where the terminal disclaimer was properly required by the USPTO and filed by applicant, and it was not in the CPA application whose filing date is March 29, 1999, where the previous filed terminal disclaimer was compelled by the USPTO or filed by applicant. Nevertheless, since applicant filed a CPA with an outstanding terminal disclaimer recorded in the prior application, the terminal disclaimer carried over into the CPA and applicant did nothing to ameliorate the effect of the recorded terminal disclaimer on the CPA.

Any patent is printed in accordance with the record in the USPTO of the application as passed to issue by the examiner. The terminal disclaimer filed October 26, 1995, was captioned for application No. 07/844,644 and was to apply to any patent issued thereto.

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<sup>1</sup> While petitioner does not invoke 35 USC § 255 or its promulgating regulation 37 CFR 1.323, such are immaterial to the relief requested for an issued patent. See MPEP 1490 subsection (B).

That is, when a CPA request is filed in this or any other application such, by operation of 37 CFR 1.53(d)(iv):

**will utilize the file jacket and contents of the prior application**, including the specification, drawings, and oath or declaration from the prior application, **to constitute the new application, and will be assigned the application number of the prior application for identification purposes** (emphasis added).

Indeed, MPEP 201.06(d), which pertains to CPA practice has noted since July 1998<sup>2</sup>:

A terminal disclaimer filed in the parent application carries over to a CPA. The terminal disclaimer filed in the parent application carries over because the CPA retains the same application number as the parent application, i.e., the application number to which the previously filed terminal disclaimer is directed. **If applicant does not want the terminal disclaimer to carry over to the CPA applicant must file a petition under 37 CFR 1.182 along with the required petition fee, requesting the terminal disclaimer filed in the parent application not be carried over into the CPA.** See MPEP 1490, "Withdrawing a Terminal Disclaimer," subheading entitled "A. Before Issuance of a Patent." (emphasis added)

Thus, the terminal disclaimer captioned for and accepted in prior application 07/844,644 automatically remained recorded against the CPA having the same application number. See 37 CFR 1.53(d)(iv). That CPA application was passed to issue by the examiner with a terminal disclaimer recorded against its application No. 07/844,664 in full force and effect. The notice on the resultant patent that such is subject to a terminal disclaimer in fact correctly reflects the instant record as passed to issue by the examiner. Thus, contrary to petitioner's urging, the records of the USPTO fail to disclose "a mistake in [this] patent" much less one "incurred through the fault of the Patent and Trademark Office." It follows that the remedial provisions of 35 USC 254 and 37 CFR 1.322 simply do not apply to the circumstances of this case, and as such, the USPTO is without authority to issue the requested Certificate of Correction.

The record fails to show that applicant ever filed during the pendency of the CPA, and therefore did not receive a favorable decision on, a petition under 37 CFR 1.182 (or 1.183) seeking mitigation of all or part of the effect of the recorded terminal disclaimer

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<sup>2</sup> MPEP 7th Ed. (July 1998).

on the CPA. Thus, applicant acquiesced to the recorded terminal disclaimer during the pendency of the CPA, and the consequent issuance of the patent to the CPA with the terminal disclaimer in question in full force and effect.

Furthermore, once a patent issues, the USPTO will not remove the effect of a recorded terminal disclaimer. See MPEP 1490 subsection; Bayer AG v. Carlsbad Technology Inc., 64 USPQ2d 1045, 1048-49 (Fed. Cir. 2002). While petitioner may now consider the previously filed disclaimer to be unnecessary in the CPA, or unnecessarily limiting in the CPA, 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(A).

Since petitioner's voluntary submission of the aforementioned terminal disclaimer on October 26, 1995, petitioner had no reasonable basis to expect a term for any patent that would include the disclaimed 46 months. Furthermore, since petitioner did not timely seek relief in the manner noted above from the recorded terminal disclaimer that carried over to the CPA filed after June 8, 1995, petitioner had no reasonable basis to expect relief from the additional 46 month loss of term of which petitioner here complains.

It follows that it was incumbent upon applicant to take every reasonable precaution to avert issuance with his voluntarily filed terminal disclaimer still in force and effect in the CPA. Petitioner knew, or should have known, of the stringent statutory and regulatory provisions which severely limit the scope of USPTO treatment of an alleged mistake(s) in an issued patent, as well as the long-established USPTO policy on the treatment of recorded terminal disclaimers after issuance as set forth in MPEP 1490.<sup>3</sup> It is incumbent upon any applicant to prosecute his invention with continuing diligence and an acute awareness of the statute. BEC Pressure Controls Corporation v. Dwyer Instruments, Inc., 380 F.Supp. 1397, 1399, 182 USPQ 190, 192 (D.C. N.Ind. 1974).

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<sup>3</sup> The MPEP has no binding force on the courts, but it commands notice as an official interpretation of statutes and regulations with which it does not conflict. Patent attorneys, examiners, and the public commonly rely on the MPEP as a guide in procedural matters. In re Kaghan, 387 F.2d 398, 401, 156 USPQ 130, 132 (CCPA 1967); Syntex v. U.S. Patent and Trademark Office, 882 F.2d 1570, 1571 n.3, 11 USPQ2d 1866, 1867 n.3 (Fed. Cir. 1989); Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1439, 221 USPQ 97, 107 (Fed. Cir. 1984).

Petitioner relies upon Bayer, supra in support of his contention that the USPTO has previously granted relief from a terminal disclaimer recorded against an issued patent, and this relief has purportedly been approved by the Court of Appeals for the Federal Circuit. Contrary to petitioner's assertion, however, the USPTO neither withdrew nor failed to give effect to the terminal disclaimer recorded against Bayer's patent. The USPTO noted that the two dates recited in the recorded terminal disclaimer created an ambiguity as to the date of expiration, and resolved the ambiguity in favor of the patent holder. The Federal Circuit noted with the approval the USPTO's underlying reasoning and its conclusion. The court itself noted the date of expiration of the Bayer patent was automatically extended by operation of the URAA amendments to the patent statute on the term of the patent referenced in the recorded terminal disclaimer. That is, the USPTO, and the Federal Circuit, both considered the recorded terminal disclaimer to remain in force on the Bayer patent.

Petitioner further contends that the terminal disclaimer can reasonably be interpreted not to apply to the present patent; i.e., petitioner interprets the language appearing in the disclaimer as applying only to a patent application entitled as of October 3, 1995, to the benefit of the national phase application, which predates the existence of the CPA (filed in 1999) by some three years. Since, petitioner contends, the CPA application did not exist On October 3, 1995, it could not then met the requirements of 35 U.S.C 120, which can only apply after all requirements are met. Nevertheless, as the CPA did in fact meet all the requirements of 35 USC 120 when it was filed in 1999, it follows that the terminal disclaimer properly applies to the instant patent. Necessarily any continuing application, whether filed under the provisions of 37 CFR 1.53(b), or, as here a CPA filed under the provisions of 37 CFR 1.53(d) is necessarily filed subsequent to the filing date of the parent application(s). Indeed, 37 CFR 1.137(c), even prior to December 1, 1997, required, as a condition of revival, the statement in a terminal disclaimer that such disclaimer would apply to any patent granted on a continuing application that made a claim for benefit under 35 USC 120 to the application for which revival was sought. See 62 *F. R.* 53132 at 53160 (Oct. 10, 1997). It is the claim for, and not the entitlement to, the benefit of the filing date of the application for which revival is sought that triggers the need for a terminal disclaimer in the continuing application. Id. It is noted that the instant patent application was not revived until petitioner supplied a terminal disclaimer with the requisite statement. Thus whether applicant filed a CPA request (which by identifying the patent application constitutes the specific reference to the patent application required by 35 USC 120, and uses all the papers and application number of the parent case), or a regular continuing application with a different application number and file wrapper, petitioner had no reasonable basis to expect that a terminal disclaimer of 46 months would not be required and recorded against any forthcoming continuing application. Having freely chosen to herein claim the benefit

under 35 USC 120 of the parent application, petitioner cannot now be heard to complain herein. See Abbott Laboratories v. Novopharm Ltd., 38 USPQ2d 1309, 1312 (D.C. N. II. 1996), *affm'd.* 104 F.3d. 1305, 41 USPQ2d 1535 (Fed. Cir. 1997). This is particularly so in this case, since, as noted above, petitioner did not seek to mitigate the effect of the recorded terminal disclaimer during the pendency of the CPA, but nevertheless claimed the benefit of the patent application under 35 USC 120.

Lastly, petitioner contends that the USPTO should exercise its discretion in this matter, as it required the wording of the terminal disclaimer. However, the abandonment and delay in seeking revival in the first instance were due to applicant and triggered the need for a terminal disclaimer. Petitioner concedes the terminal disclaimer was properly assessed in the prior application. 37 CFR 1.182 applies only where other rules are inapplicable. 37 CFR 1.182 is not a mechanism for avoiding the requirements of the established rules and procedures. See Hicks v. Costello, 1903 Dec. Comm'r Pat. 123, 125 (1903). Since applicant voluntarily filed the CPA long after the petition seeking revival was granted and the disclaimer had been accepted, the USPTO in no way caused or contributed to applicant's current predicament. Applicant was advised by the decision of June 26, 1996, that 46 months of term had been forfeited as a condition of revival of the prior application, and further, the CPA was pending from February 26, 1999, until December 26, 2000, a period of some 22 months in which petitioner had ample time during pendency to seek relief from the effects of the carried-over terminal disclaimer in the CPA. As noted in MPEP 1490, once, as here, a patent issues with a terminal disclaimer recorded against the patent, the USPTO will not remove, on petition, the effects of that terminal disclaimer.

#### DECISION

For the reasons noted above, the terminal disclaimer of record which has been properly recorded against the above-identified patent will not be withdrawn. The requested Certificate of Correction will not be issued. The petition is **denied**.

This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02. The USPTO will not give further consideration or reconsideration to this matter.

The instant patent file is being returned to the Files Repository.

Telephone inquiries relative to this decision should be directed to Senior Petitions Examiner Brian Hearn at (703) 305-1820.<sup>4</sup>

Charles Pearson  
Director, Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>4</sup> During review of this patented file on May 19, 2005, it was noted that this original page was missing from the file record. Accordingly, this substitute page has been prepared and inserted to make the record complete. *Brian Hearn 5/19/05*