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THOMAS SARRO
LARSON AND TAYLOR
SUITE 900
1199 NORTH FAIRFAX STREET
ALEXANDRIA, VIRGINIA 22314

In re Patent No: 4,346,116 :
Application No. 06/151,816 :
Filed: October 31, 1984 : DECISION DENYING PETITION
Issue date: August 24, 1982 :
Inventor: Francoise Verwaerde et al:

This is a decision on the renewed petition under 37 CFR 1.182, which now requests that the PTO "give notice to the public of the true expiration date of the patent, i.e., May 14, 1999."

The petition is DENIED.

BACKGROUND

In response to the final Office action of August 19, 1991, wherein the examiner rejected inter alia, various claims over claims 6 and 7 of copending application No. 038,711, applicants filed an amendment and a terminal disclaimer on December 21, 1981. The accompanying remarks noted:

"[t]he amendment (sic, rejection) of claims 27-34 and 37-40 as obvious variants of claims in Serial No. 038,711 is being obviated by the Terminal Disclaimer submitted herewith."

The application was allowed by the examiner in the Office communication mailed March 15, 1992, and issued August 24, 1982.

A petition filed September 11, 1997, requested under 37 CFR 1.182 that the recorded terminal disclaimer filed on December 21, 1981, be withdrawn in favor of a revised, apparently forthcoming, terminal disclaimer, and further, that a Certificate of Correction (PTO mistake) be issued to that effect. Petitioners specifically requested that the aforementioned original terminal disclaimer be replaced, in that the instant patent term, via the original terminal disclaimer, is limited to the pre "GATT-NAFTA" (Uruguay

Round Agreements Act (URAA) (1994)) expiration date for U.S. Patent No. 4,279,931 (July 21, 1998), while the latter patent now expires May 14, 1999, as was apparently to be reflected in any forthcoming terminal disclaimer. As such, petitioner asserted, the instant patent contains an erroneous date of expiration, and further, as the error in the patent is not the fault of petitioner, no fees for either the petition, or the requested Certificate of Correction, should be assessed.

The petition was dismissed in the decision of February 11, 1998.

The instant renewed petition was filed April 13, 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. 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

Petitioners request reconsideration in that the decision of February 11, 1998 is asserted to have failed to address the basis of the prior request filed September 11, 1997. Specifically petitioners assert, the Commissioner has authority under 37 CFR 1.182 to give notice to the public of the true expiration date of the above-captioned patent, which petitioner contends, is May 14, 1999.

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

The terminal disclaimer under 35 USC § 253 and 37 CFR 1.321, filed December 21, 1981, was relied upon by petitioners to overcome a rejection on the grounds of obviousness type double patenting involving the claims of commonly owned U. S. Patent No. 4,279,931 issued July 21, 1981. The terminal disclaimer was executed by Germain Roquette, on behalf of the assignee, Roquette Freres, and specified in pertinent part that:

"The said assignee does hereby disclaim and dedicate to the public the terminal portion of any United States Patent to be issued on this application beyond July 21, 1998."

While petitioners now predicate their request for withdrawal of the recorded terminal disclaimer upon a subsequent change in the term of the '931 patent, inspection of the above-quoted language in that disclaimer reveals that petitioners originally made such disclaimer contingent upon an actual date of expiration of the term of the '931 patent. That is, petitioners made the original terminal disclaimer absolute, that is, date-specific to July 21, 1998. It follows that regardless of what effect the URAA may have

subsequently had on the expiration date of the '931 patent, there is no nexus between that date and the specific expiration date as set forth in the original terminal disclaimer of record. As such, no error is apparent in the term of the original instant letters patent, as indicated by the recorded terminal disclaimer, which warrants correction. As such, it is not apparent from the record, and petitioner has not shown, on the record, how the express date certain patent expiration of July 21, 1998 given by the assignee of the entire interest, becomes May 14, 1999. Rather, as the patent was freely stated to expire on July 21, 1998 whatever effects the URAA might have had on the term of other patent, is simply immaterial to the date specific expiration of the above-captioned patent. Contrary to petitioners' contention, whatever authority may be vested under and by the patent statutes and rules of practice, such authority does not controvert the assignee's express statement of a date certain expiration of the instant patent. In other words, it is manifestly inconsistent with the express language supplied by petitioners in the above-noted terminal disclaimer to now aver that the "true expiration date" is any other than that specifically recited in the terminal disclaimer, and proclaimed to the public as part of the instant patent since its date of issuance.

It is also brought to petitioners' attention that:

"The purpose of the URAA [codified in part in 35 U.S.C. § 154] **was not to extend patent terms**, although it has that effect in some cases, but to harmonize the term provision of United States patent law with that of our leading trading partners which grant a patent term of 20 years from the date of filing of the patent application. Prior to June 8, 1995, U.S. patents had an expiration date under 35 U.S.C. Section 154 **measured as 17 years from the date the patent issued, except where terminal disclaimers were filed.** Amended section 154(a) now reads:

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.

35 U.S.C. § 154(a)(2) (1994).

For certain patents which were issued and for pending applications which were filed prior to June 8, 1995, a transitional provision preserves a guaranteed 17-year term, if it is longer than 20 years from filing, by the following provision:

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 **shall be the greater of the 20-year term as provided in subsection (1), or 17 years from grant, subject to any terminal disclaimers.**

Id. at Section 154(c)(1). Patents in the section 154(c)(1) category thus are entitled to keep or to enjoy the 17-year term from issuance of the patent or a 20-year from filing term, whichever is longer."¹ (emphasis added)

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, petitioners have 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.

¹ Merck & Co. v. Kessler, 80 F.3d 1543, 1547-1548, 38 USPQ2d 1347, 1349-1350 (Fed. Cir. 1996).

Further in this regard, the public has had fifteen (fifteen) years since the grant of the above-identified patent, to act on its facial representation that the term of this patent will expire, at the latest, on July 21, 1998. Similarly, petitioners have had, since the submission of the aforementioned terminal disclaimer on December 21, 1981, no reasonable basis to expect a term for this patent that would extend beyond July 21, 1998.

While petitioners may now consider the originally filed disclaimer to be unnecessary, or unnecessarily limiting, petitioners are, 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. When the question of whether or not a given set of claims in one application or patent is distinct from another set of claims in another application or patent with respect to obviousness double patenting arises, that question relates to the merits of an invention, and the appropriate remedy for resolution of that issue ultimately lies by appeal as provided by statute. See e.g. In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Petitioners had the opportunity to challenge the need for a terminal disclaimer, on appeal, but instead, freely chose to file a terminal disclaimer to avoid the rejection, during the prosecution of the application that led to the above-identified patent. Such does not afford proper legal or public policy grounds for requesting nullification of the terms of free 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).

Even assuming, *arguendo*, the relief(s) requested should be considered on petition, petitioners are reminded that, as a general rule, public policy does not favor the restoration to the patentee [applicant] 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 Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). Petitioners have 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 are 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. Jentoft, supra. It is brought to petitioners' 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). As noted above, while petitioners may now consider the previously filed disclaimer to be unnecessary, or unnecessarily limiting, petitioners are, nevertheless, confronted with what has been characterized as "an unhappy circumstance", rather than a circumstance(s) necessitating relief. Jentoft at 639 n. 6, 157 USPQ at 368 n. 6.

Moreover, petitioners have made no attempt to explain their delay in presenting this petition, over two years after the implementation of the URAA. The public has thus had some two years within which to rely on the fact that, notwithstanding the URAA of 1994, and its effective date of June 8, 1995, petitioners permitted the original terminal disclaimer in this patent to continue in unabated force and effect. While petitioners should not infer that, had the instant petition been more seasonably presented, a different result might have been obtained; nevertheless, the record shows that petitioners did not diligently address the issues pertaining to the instant terminal disclaimer presented by the aforementioned URAA. Assuming, *arguendo*, that petitioners may, seasonably or otherwise, request rescission of the terminal disclaimer of record, 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).

In any event, to withdraw the recorded terminal disclaimer filed on December 21, 1981 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 petitioners' inclusion in the terminal disclaimer filed December 21, 1981, of a specific expiration date: July 21, 1998. 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. 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 any remedy that would effectuate broadening of an issued patent. See 35 USC 251. 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. It would appear to be an improper exercise of 37 CFR 1.182 to permit petitioner to regain, on petition, what petitioner could not herein regain under the remedial patent statute, which, as such, is "liberally construed." Under the facts of this case, it would be an inappropriate exercise of 37 CFR 1.182 to rescind the terminal disclaimer.

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
Director, Office of Patent Policy Dissemination
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects