

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

MYLAN PHARMACEUTICALS INC., TEVA PHARMACEUTICALS USA,  
INC., WATSON LABORATORIES, INC., DR. REDDY'S LABORATORIES,  
INC., DR. REDDY'S LABORATORIES, LTD., and SUN  
PHARMACEUTICALS INDUSTRIES LTD.<sup>1</sup>

Petitioner,

v.

MERCK SHARP & DOHME CORP.  
Patent Owner.

---

Case IPR2020-00040

U.S. Patent 7,326,708 B2

---

**PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO  
FILE REQUEST FOR CERTIFICATE OF CORRECTION OF CLAIMS 5-7**

---

<sup>1</sup> Teva Pharmaceuticals USA, Inc. and Watson Laboratories, Inc. were joined as a party to this proceeding via Motion for Joinder in IPR2020-01045; Dr. Reddy's Laboratories, Inc. and Dr. Reddy's Laboratories, Ltd. were joined as a party to this proceeding via a Motion for Joinder in IPR2020-01060; and Sun Pharmaceuticals Industries Ltd. was joined as a party to this proceeding via Motion for Joinder in IPR2020-01072.

**TABLE OF CONTENTS**

	<b>Page</b>
ARGUMENT .....	1
1.    No Mistake of a Clerical or Typographical Nature.....	2
2.    Merck Cites No Authority where the PTO has Before Allowed What Merck Seeks.....	3
3.    No Mistake “of Minor Character” .....	4
4.    The Proposed Corrections Constitute New Matter or Would Require Reexamination .....	5
5.    Evidence of Inattention and Lack of Diligence Does Not Show “Good Faith” .....	7
6.    Patent Owner Should Be Ordered to Provide This Opposition to the Director When Filing any Correction Request.....	10
CONCLUSION .....	10

## TABLE OF AUTHORITIES

	<b>Page(s)</b>
<b>Cases</b>	
<i>Arthrocare Corp. v. Smith &amp; Nephew, Inc.</i> , 406 F.3d 1365 (Fed. Cir. 2005) .....	7
<i>ASM IP Holding BV v. Kokusai Electric Corp.</i> , IPR2019-00378, Paper 17 (PTAB July 5, 2019) .....	1, 10
<i>Central Admixture Pharmacy v. Advanced Cardiac</i> , 482 F.3d 1347 (Fed. Cir. 2007) .....	2
<i>Fina Technology, Inc. v. Ewen</i> ,  265 F. 3d 1325 (Fed. Cir. 2001) .....	6, 7
<i>Honeywell Int’l, Inc. v. Arkema Inc.</i> , 939 F.3d 1345 (Fed. Cir. 2019) .....	1, 4
<i>In re Arnott</i> , 19 U.S.P.Q.2d 1049, 1991 WL 326548 .....	3, 4, 5
<i>In re U.S. Patent No. 7,168,818</i> .....	5, 7
<i>In re U.S. Patent No. 7,475,261</i> .....	4
<i>In re U.S. Patent 6,660,701</i> .....	7, 9
<i>Intuitive Surgical, Inc. v. Ethicon LLC</i> , IPR2020-00050, Paper 13 (PTAB Feb. 26, 2020) .....	1, 10
<i>Nautilus Inc. v. Biosig Instruments, Inc.</i> , 134 S. Ct. 2120 (2014) .....	5
<i>Southwest Software, Inc. v. Harlequin Inc.</i> , 226 F.3d 1280 (Fed. Cir. 2000) .....	8
<i>Superior Fireplace Co. v. Majestic Products Co.</i> , 270 F. 3d 1358 (Fed. Cir. 2001) .....	2, 3, 7, 8

**Statutes**

35 U.S.C. § 251 .....6  
35 U.S.C. § 255 .....2, 6

**Regulations**

37 C.F.R. § 42.6(e).....12  
37 C.F.R. § 42.24(d) .....12

**Other Authorities**

MPEP §1481 .....5  
MPEP §1490 .....4

The District Court found Claims 5–7 indefinite. EX2282, 7. Rather than seek Reissue, Merck attempts to evade substantive review of its so-called ‘corrections’ to Claims 5-7 of the ’708 patent by using the Certificate of Correction procedure. While Claims 5-7 are not at issue in this IPR, the Panel must decide whether Patent Owner “has demonstrated a sufficient basis that the mistake may be correctable.” *Honeywell Int’l, Inc. v. Arkema Inc.*, 939 F.3d 1345, 1349 (Fed. Cir. 2019). A “sufficient basis” exists if there is at least a “legitimate question as to whether the issuance of a Certificate of Correction is an appropriate course of action.” *Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2020-00050, Paper 13, at 4–5 (PTAB Feb. 26, 2020). There is none here.

That said, should the Board cede its exclusive jurisdiction over the ’708 patent as it relates to this single issue—which it should not—Petitioner requests that the Board instruct Merck to include this Opposition with any request for correction to the Director. *Intuitive Surgical*, IPR2020-00050 at 5; *ASM IP Holding BV v. Kokusai Electric Corp.*, IPR2019-00378, Paper 17 at 5–6 (PTAB July 5, 2019).

### **ARGUMENT**

Claims 5–7 of the ’708 patent currently recite “absorption bands obtained from the X-ray powder diffraction pattern at spectral” d-spacings of particular angstroms. EX1001 (“the ’708 Patent”). The District Court found “absorption bands” to be indefinite. EX2282, 7. The District Court was correct. Attempting to

rescue its claims, Merck now contends Claims 5-7 should have always referred to “diffraction peaks” rather than “absorption bands.” Request, 1. But this is not a “mistake of a clerical or typographical nature, or of minor character” that can be remedied via a Certificate of Correction. 35 U.S.C. § 255. Diffraction peaks are different from absorption bands. Merck knows this. EX2281, ¶6. And, the law is clear: a Certificate of Correction may not “involve[] changes in the patent as would constitute new matter **or** would require reexamination.” *Id.* Merck’s request should be denied.

### **1. No Mistake of a Clerical or Typographical Nature**

Merck must establish that the alleged mistake is correctable through the Certificate of Correction procedure. It has not done so. As noted, changing “diffraction peaks” to “absorption bands” is not a “mistake of a clerical or typographical nature.” “[C]lerical or typographical mistakes are generally understood to include simple mistakes such as obvious misspellings that are immediately apparent. Upon viewing such a misspelling, there is no doubt that a mistake, indeed a clerical or typographical mistake, has occurred.” *Superior Fireplace Co. v. Majestic Products Co.*, 270 F. 3d 1358, 1370 (Fed. Cir. 2001); *Central Admixture Pharmacy v. Advanced Cardiac*, 482 F.3d 1347, 1350 (Fed. Cir. 2007) (noting the change from “osmolarity” with “osmolality”); *In re Arnott*, 19 U.S.P.Q.2d 1049; 1991 WL 326548, \*6 (Com’r Pat. & Trademarks 1991).

Merck’s proposed corrections are a wholesale rewrite of the claim; the current language of Claims 5-7 “is itself syntactically correct and on its face raises no question of a mistake.” *Superior Fireplace*, 270 F. 3d at 1375. Merck’s own evidence indicates that its proposed corrections are not a clerical or typographical mistake. With its Request, Merck submitted the Third Declaration of Inventor (Dr.) Wenslow, in addition to other parol evidence. EX2281; *see also* EX2278-2280. But “[r]eference to ‘parol’ evidence beyond the patent file should not be necessary to establish the existence of a clerical or typographical mistake.” *In re Arnott*, 1991 WL 326548, \*6. The inquiry ends there.

## **2. Merck Cites No Authority where the PTO has Before Allowed What Merck Seeks**

Merck fails to cite a single instance where the PTO has allowed a patentee to correct a claim that a District Court had found indefinite through the Certificate of Correction procedure. While Merck refers to dicta in *Novo Indus., LP v. Micro Molds Corp.*—which makes a passing reference to indefiniteness—*Novo Indus.* never held that Certificate of Correction is the proper mechanism to correct a claim rendered indefinite. 350 F.3d 1348, 1356 (Fed. Cir. 2003).<sup>2</sup>

---

<sup>2</sup> Although the Federal Circuit in *Honeywell* noted the PTO’s longstanding practice of using Certificates of Corrections to correct priority issues, *Honeywell*, 939 F.3d

The propriety of using the Certificate of Correction procedure to correct indefiniteness is part of the showing Merck must make for its request. *Honeywell*, 939 F.3d at 1350. As the Office of Petitions has noted, the MPEP will guide it in determining the propriety of using the Certificate of Correction procedure. *In re U.S. Patent No. 7,475,261* (“However, as noted in MPEP §1490, 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.”).<sup>3</sup> Merck has not pointed to any provision in the MPEP (or other authority) permitting a Certificate of Correction to rewrite claim recitations a District Court had previously found to be indefinite.

### **3. No Mistake “of Minor Character”**

As explained above, the MPEP will guide the PTO. As the MPEP clearly states: “[a] mistake is not considered to be of the ‘minor’ character required for the issuance of a certificate of correction if the requested change would materially affect the scope or meaning of the patent.” MPEP §1481; *In re U.S. Patent 6,660,701* at

---

at 1350, it has never authorized the use of a certificate of correction to resurrect a claim found indefinite.

<sup>3</sup> Mylan attaches *In re U.S. Patent No. 7,475,261*, *In re U.S. Patent 6,660,701*, and *In re U.S. Patent No. 7,168,818* as Exhibits A, B and C respectively to this Paper.



p. 7; *Arnott*, 1991 WL 326548, \*7 (“[t]he difference between having and not having a claim of particular scope is significant.”). Indefiniteness means the claim fails to “inform those skilled in the art about the **scope** of the invention with reasonable certainty.” *Nautilus Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129 (2014). To undo the District Court’s indefiniteness determination, Merck is attempting to change the scope of the claims. That is improper. “Usually, any mistake affecting claim scope must be corrected by reissue.” MPEP §1481; *In re U.S. Patent 6,660,701* at p. 7.

Another test used by the PTO to consider if a claim’s scope is changed by the proposed correction is “if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement.” *In re U.S. Patent No. 7,168,818* at p. 6. Once again, this clearly undermines Merck’s position. Given the indefiniteness of these claims as written, Merck could not sue any party for infringement of Claims 5-7. The requested corrections change the scope of those claims and for that reason are not of “minor character.” *Id.* Again, “[e]xamples of mistakes that fall under § 255 typically include correcting a misspelled word or adding a prior art reference that was submitted to and discussed by the examiner but inadvertently omitted by the applicant on PTO Form 1449 for listing references.” *Fina Technology, Inc. v. Ewen*, 265 F. 3d 1325, 1328 (Fed. Cir. 2001).

#### **4. The Proposed Corrections Constitute New Matter or Would Require Reexamination**

Merck has failed to show any basis that its proposed corrections “would [not] constitute new matter **or** would [not] require reexamination.” 35 U.S.C § 255. By using the Certificate of Correction, Merck appears to be attempting to evade examination. 35 U.S.C. § 251. “What [Merck] now proposes to do, in the guise of a Certificate of Correction is to present a claim to subject matter that has never been examined by the examiner, was never passed to issue by the examiner, and never given any patent protection by the USPTO.” *In re U.S. Patent 6,660,701* at p. 6. For this added reason, Merck’s request should be denied.

Even assuming *arguendo* that Merck has shown written support for its proposed corrections in the specification of the ’708 patent (Request, 5-6), patentability is not determined simply on whether or not written support exists. Rather, other conditions such as, *inter alia*, subject matter eligibility, utility, novelty and enablement must be met. “[It] clearly would require reexamination for the requested correction as the [requested] embodiment was never claimed or examined during the pendency of the original application for patent, and was never issued by the USPTO.” *In re U.S. Patent 6,660,701* at p. 6.

The Federal Circuit has **repeatedly** emphasized a Certificate of Correction is proper when it is “**clearly evident** from the specifications, drawings, **and prosecution history** how the error should appropriately be corrected to one of skill in the art.” *Arthrocare Corp. v. Smith & Nephew, Inc.*, 406 F.3d 1365, 1374–75

(Fed. Cir. 2005); *Superior Fireplace Co.*, 270 F.3d at 1372, 1374 (discussing events that occurred during examination); *Fina Technology*, 265 F. 3d at 1328 (discussing a “prior art reference that was submitted to and discussed by the examiner”); *In re U.S. Patent No. 7,168,818* at p. 6.

Merck concedes that there is nothing from the prosecution history of the ’708 patent showing “how the error should appropriately be corrected.” In fact, Merck recognizes that “if there had been, the mistake presumably would have been addressed during the original prosecution.” Request, 6-7. This, however, places the proverbial cart before the horse. The Examiner is not charged with understanding the subjective mindset of the inventors as to what they intended to present for examination, or determining any mistakes based on a claim that was never presented. *In re U.S. Patent No. 6,550,701* at p. 5 (“Claim 4 was passed to issue by the examiner exactly as it was drafted by the applicant and presented on filing.”). Merck’s effort to place any responsibility on the examination process for its mistake is simply improper. *In Re U.S. Patent 6,550,701* at p.5 (“The primary responsibility for presenting claims that provide adequate coverage for disclosed inventions rests with applicant.”).

##### **5. Evidence of Inattention and Lack of Diligence Does Not Show “Good Faith”**

Merck claims the error occurred in alleged “good faith.” Request, 7. The only so-called evidence Merck presents is that of an inattentive review of the ’708

patent's claims by Merck's attorneys and inventors. Dr. Wenslow alleges the alleged mistake was obvious. EX2281, ¶4 (“As scientists who perform X-ray powder diffraction would know, and I knew at the time the application was filed, X-ray powder diffraction does not involve absorption or absorption bands, nor are d-spacings “spectral”). Despite the very apparent nature of the alleged mistake, Dr. Wenslow's admits he did not catch this error during his inattentive review of the patent. *Id.* ¶6 (“When I reviewed the draft patent application, I did not catch the error in these claims. . . . and if I had noticed the mistake during the prosecution of the patent, I would have taken steps to correct this error then.”).

The Office of Petitions has taken a dim view of a patentee's failure to properly review its claims with evaluating alleged mistakes. *In re U.S. Patent 6,660,701* at p. 4 (citing *Superior Fireplace Co.*, 270 F.3d at 1376 (noting “the critical importance of reviewing claims” before the allowed claims issue)); *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1296 (Fed. Cir. 2000) (“it does not seem to us to be asking too much to expect a patentee to check a patent when it is issued in order to determine whether it contains any errors.”). Even if, as Merck contends, “[t]he correction fixes the claims to recite what they plainly were intended to cover all along” (Request, 7), “suggestions that we compare claim scope by considering what was ‘intended’ by the parties, rather than by construing the claims for what they actually recite, is **completely without merit.**” *Superior Fireplace Co.*, 270 F.3d at

1375.

Further, the '708 patent issued 12 years ago. In those twelve (12) years, Merck never once sought a Certificate of Correction. Merck presumably also did an initial pre-filing investigation before asserting Claims 5-7 against multiple defendants in the underlying litigations (again, according to Dr. Wenslow, the mistake would have been clear during that initial investigation). EX2281, ¶4, ¶6. Yet, it took a Court's indefiniteness finding *more than a year* into the underlying litigations for Merck to seek a Certificate of Correction. That does not show good faith:

[The] equitable powers [of the PTO] should not be invoked to excuse the performance of a condition by, as here, a party that has not acted with reasonable, due care and diligence....Petitioner does not offer any reason that would excuse the inordinate delay in this case. Any contention that petitioner was diligent in seeking correction of this matter is simply not supported by the record. The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence(s) of his delay.

*In Re U.S. Patent No. 7,475,261* at p.8.

Put simply, what Merck intended to get is exactly what it got from the USPTO and the Certificate of Correction procedure should be unavailable to Merck. *In re U.S. Patent No. 6,550,701* at p. 5 ("Claim 4 was passed to issue by the examiner

exactly as it was drafted by the applicant and presented on filing.”). Merck’s own admitted failure to participate properly in the examination process, inattention, lack of diligence, and delay is not evidence of good faith.

**6. Patent Owner Should Be Ordered to Provide This Opposition to the Director When Filing any Correction Request**

Alternatively, should the Board cede its exclusive jurisdiction and refer the matter to the Director, which Petitioner respectfully submits there is no basis for, Petitioner requests the Board to instruct Merck to include this Opposition with any request to the Director. *Intuitive Surgical*, IPR2020-00050 at 5; *ASM IP Holding*, IPR2019-00378 at 5–6. “Petitioner’s Opposition may be useful to the Director in determining whether the issuance of a Certificate of Correction is appropriate.” *Intuitive Surgical*, IPR2020-00050 at 5; *ASM IP Holding*, IPR2019-00378 at 5–6 (“in the interests of transparency, and in order for those Branches of the Office to be aware of the events leading up to Patent Owner’s request(s)”).

**CONCLUSION**

The Board should DENY Merck’s Request to file for a Certificate of Correction, or in the alternative, ORDER Merck to provide this Opposition with any request to the Director.

Date: December 4, 2020

Respectfully submitted,

/s Jitendra Malik/

Jitendra Malik, Ph.D.

# Exhibit A



**MAILED**

**JUL 29 2011**

**OFFICE OF PETITIONS**

MATTINGLY, STANGER & MALUR, P.C.  
Suite 370  
1800 Diagonal Road  
Alexandria VA 22314

In re Patent No. 7,475,261 :  
Issue Date: January 6, 2009 :  
Application No. 10/768,136 : **DECISION ON PETITION**  
Filed: February 2, 2004 :  
Patentee: Y. TOTSUKA et al. :  
Attorney Docket No. ASA-788-02 :

This is a decision on the renewed petitions filed September 30, 2010, requesting under the provisions of 37 CFR 1.182 or in the alternative under 37 CFR 1.183, a review of the Decision mailed July 30, 2010, that dismissed the petitioner's request for a review of the Office's decision of August 4, 2009 denying patentee's request for Certificate of Correction filed July 6, 2009.

The petitions are **DENIED**.

### **BACKGROUND**

1. On February 2, 2004, the instant application was filed as a continuation of Application having the serial number 09/308,488.
2. The non-final Office action dated March 25, 2008 included a rejection under the grounds of non-statutory obviousness-type double patenting noting that the claims were unpatentable "over claims 1-9 of U.S. Patent No. 6,715,090 in view of Smith et al., and in view of Martin, U.S. Patent No. 5,111,058."
3. The applicants filed a response on June 25, 2008 that included a Terminal Disclaimer signed by the petitioner herein, disclaiming the terminal part of the statutory term of the instant patent "which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of U.S. Patent No. 6,715,090 and U.S. Patent No. 5,111,058."
4. The Terminal Disclaimer was accepted and a Notice of Allowance was mailed on September 2, 2008.



5. The instant patent issued on January 6, 2009.
6. On July 6, 2009 petitioner filed a request for a certificate of correction to have the Terminal Disclaimer filed August 25, 2008, corrected by directing the Certificate of Corrections Branch to issue the Certificate of Correction by deleting "and U.S. Patent No. 5,111,058", in said Terminal Disclaimer "in order to clarify the record so that the patent is only disclaimed with respect to co-owned U.S. Patent No. 6,715,090."
7. In a decision filed August 4, 2009, the request was not approved.
8. A petition was filed on October 7, 2009 seeking a review of this earlier decision by the Office that disapproved the request for a certificate of correction.
9. In a decision mailed July 30, 2010 the petition was dismissed.
10. The instant petition was filed September 30, 2010 requesting a review of the earlier decisions refusing to grant the requested certificate of correction.

**STATUTE, REGULATION, AND EXAMINING PROCEDURE**

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

*The Office-- may, establish regulations, not inconsistent with law, which*

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

35 U.S.C. 253 Disclaimer

*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.*

*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 Certificate of correction of applicant's mistake

*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 Director 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.*

37 CFR § 1.182 Questions not specifically provided for

*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 Director, 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(f).*

37 CFR § 1.183 Suspension of rules

*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 Director or the Director'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(f).*

37 CFR 1.321. Statutory disclaimers, including terminal disclaimers - states in the 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).*
- (c) *A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, 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 judicially created double patenting.*

### 37 CFR § 1.325 Other mistakes not corrected

*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.*

### MPEP §1490(VII) - Withdrawing A Recorded 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.*

### OPINION

Petitioner seeks by way of the instant petition to amend the previously recorded terminal disclaimer in the instant patent over U.S. Patents 6,715,090 and 5,111,058. The specific relief requested by the petitioner is that “that the Certificate of Corrections Branch be directed to issue the Certificate of Correction filed July 6, 2009 which deletes "and U.S. Patent No. 5,111,058" in the Terminal Disclaimer in order to clarify the record so that the record is clear that the only patent which is the target of the Terminal Disclaimer is co-owned U.S. Patent No. 6,715,090.”

Petitioner's arguments and the declaration of Lynn Maxwell concerning the instant request for a certificate of correction have been considered. However, as noted in MPEP §1490, 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. Applicants should have filed a corrected terminal disclaimer during the prosecution of the application, i.e., prior to its issuance as a patent. The USPTO will not grant a request to withdraw or amend a recorded terminal disclaimer in an issued patent as the rules of practice and 35 USC 253 do not include a mechanism for withdrawal or amendment of such a terminal disclaimer. Unfortunately, once a patent issues, the USPTO cannot remove the effect of a recorded terminal disclaimer in an issued patent. See MPEP §1490; Bayer AG v. Carlsbad Technology Inc., 298 F.3d 1377, 64 USPQ2d 1045, 1048-49 (CAFC 2002) (hereafter “Bayer AG”). While petitioner may now consider the previously filed disclaimer to be unnecessary, or unnecessarily limiting, petitioner is, nevertheless, confronted with what has been characterized as “an unhappy circumstance,” rather than a circumstance necessitating relief. See In re Jentoft, 392 F.2d 633, 639 n. 6, 157 USPQ 363, 368 n. 6 (CCPA 1968); MPEP 1490(A).

In arguing that the petition meets the requirements for a certificate of correction, petitioner states that: (a) “the mistake is of a clerical nature as the wrong patent number was added to the Terminal Disclaimer in addition to the correct patent number at the time of preparation and filing of the Terminal Disclaimer”; (b) “the U.S. Patent No. 5,111,058 is not related (by 35 U.S.C. § 120) to the '261 patent and not commonly owned by the assignee”; (c) “the correction of the mistake requested by the Certificate of Correction will not require examination as a result, for the same reasons”; and (d) “further, entry of the proposed correction will not introduce new matter.”

Petitioner's request for issuance of a Certificate of Correction under 35 U.S.C. § 254 to correct the alleged error in the expiration date of the above-identified patent is refused. By statute (§ 254) and regulation (37 CFR 1.322), for a Certificate of Correction to be issued, there must be (1) a mistake in the patent that is (2) clearly disclosed by the records of the Office. However, the records of the Office do not clearly disclose a mistake in the patent within the meaning of the statute and regulation. Petitioner is reminded that this or any patent is printed in accordance with the record in the USPTO of the application as passed to issue by the examiner. Here, the original application for patent was passed to issue by the examiner on September 2, 2008, upon receipt of the terminal disclaimer filed June 25, 2008, which set forth that it "disclaims...the terminal part of the statutory term of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,715,090 and U.S. Patent No. 5,111,058." While petitioner also proposed amending the terminal disclaimer by way of a Certificate of Correction, the alleged error is not an error within the meaning of 35 U.S.C. § 254 and 37 CFR 1.322, and even assuming it were such an error it is not subject matter for and amenable to the proposed correction by the proffered Certificate of Correction under 35 U.S.C. § 254 and its promulgating regulation 37 CFR 1.322. What is here controlling is that petitioner seeks to correct an issued patent. 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 the named inventor which is provided for by 35 U.S.C. § 256 and 37 CFR 1.324, which is, by statute, a part of the patent (i.e., "shall contain"). See 35 U.S.C. § 154(a)(1). In addition, 35 U.S.C. § 254 merely authorizes the correction of the patent; it does not authorize correction of a terminal disclaimer.

Petitioner argues that "[s]till further, the public would have no expectation that the Terminal Disclaimer that was filed actually dedicated any term to the public. Terminal Disclaimers typically do not disclaim any term, as a result of the changes made by the URAA. The public sees only the indication on the front page of the '261 patent "Notice: This patent is subject to a terminal disclaimer." This Notice does not provide expiration date information as in many factually similar cases decided by the Patent Office. Further, the Notice would remain unchanged after the issuance of the Certificate of Correction, thereby providing no change in Notice to the public." Petitioner's argument is not well formed. The public is on notice that the patent is subject to a Terminal Disclaimer and that reference must be made to the file wrapper to determine the period disclaimed. Thus, it is not seen how one can argue that the public has no expectation of terminal disclaimer to USP 5,11,058 since by the very nature of the patent, reference must be made to the file wrapper. The public is entitled to rely on the public record, including the prosecution history of the a patent in determining the scope of the patent's claims. See Vitronics Corp. v. Conceptoronic, Inc., 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996); Vectra Fitness v. TNWK Corp., 162 F3d 1379, 1384, 49 USPQ2d 1144, 1148 (Fed Cir. 1998). This reliance enables businesses, as well as others, to plan their future conduct in as certain an environment as possible. Vitronics, Id.

Petitioner's arguments concerning the ambiguity in the expiration date of the instant patent have been noted. Petitioner is asserting that "the Terminal Disclaimer in the '261 [patent] must be corrected to clarify the ambiguity so that the record is clear with respect to the intention on the part of the patentee to disclaim the '261 patent only with respect to U.S. Patent No. 6,715,090,

which is the parent, commonly owned patent.” In comparing the instant situation to that in Bayer AG, where an ambiguity in the expiration of the patent was resolved by the Office, petitioner notes that, “the difference in the expiration dates [here] arises as a result of a clerical mistake made by petitioner, not as a result of operation of law as in Bayer AG.” However, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314,317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

Petitioner’s argument regarding the Office policy on permitting a replacement of a Terminal Disclaimer in an issued patent, as stated in MPEP § 1490, has been noted. As also noted by the petitioner, the procedure of allowing a replacement of Terminal disclaimer is limited to a situation where there is an inadvertent transposition of numbers in the terminal disclaimer filed and the inadvertency is clear from the record. Furthermore, as noted in MPEP § 1490, “If the transposing error resulted in an earlier patent term expiration date than provided by the corrected terminal disclaimer, a statement must be included in the corrected terminal disclaimer to retain that earlier expiration date. The absence of such a statement will result in the Office declining to exercise its discretion to grant relief.” Assuming *arguendo* that the Office would regard the listing of the ‘058 patent in the Terminal disclaimer of record to be inadvertent, the relief sought by the petitioner herein cannot be granted as there is nothing the instant petition that clearly shows a retention of the earlier expiration date indicated by the Terminal Disclaimer of record in the instant patent. As Congress has already enacted legislation for patent term adjusting, extending, or restoring provisions in four sections (154, 155, 155(a), and 156) of the patent statute, and has not seen fit to create any additional statutory term modifying remedies, it is inappropriate for the Office to now create an additional, extra-legislative means of adjusting, extending, or restoring, the term of the original patent by now removing or amending the terminal disclaimer filed June 25, 2008 by way of a petition under 37 CFR 1.182, or by way of a certificate of correction as requested here.

What is controlling here is that the petitioner seeks to correct an issued patent. 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 USPTO (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 amendment of a terminal disclaimer. Bayer AG, supra.

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; MPEP 1490. As further noted in MPEP 1490, 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 other nullify the effect of a recorded terminal disclaimer.

In this regard, an applicant's use, and Office's acceptance, of a terminal disclaimer is in the public interest because such encourages the disclosure of additional developments, the earlier filing of patent applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. See In re Jentoft, *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).

The USPTO will not grant a request to withdraw or amend a recorded disclaimer in an issued patent on the grounds that the rules of practice and 35 U.S.C. § 253 do not include a mechanism for withdrawal or amendment of such a disclaimer. *Id.*; see also MPEP 1490. Petitioner's contention that the USPTO has misinterpreted Bayer AG with the unfortunate result herein of not permitting removal or correction of the terminal disclaimer filed September 6, 1996, is not persuasive. The USPTO neither withdrew nor failed to give effect to the terminal disclaimer recorded against the Bayer patent. *Id.* 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. *Id.* The USPTO did not vacate or amend the recorded terminal disclaimer, or accept a substitute disclaimer in lieu of the recorded disclaimer, notwithstanding the ambiguity in the recorded terminal disclaimer. *Id.* The Federal Circuit noted with the approval the USPTO's underlying reasoning and its conclusion. *Id.* 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. What is especially significant is that the USPTO and the Federal Circuit both considered the recorded but flawed terminal disclaimer to remain in force on the Bayer patent. *Id.* Applying the facts of that case to the present situation, the terminal disclaimer of June 25, 2008, properly remains recorded against the issued patent and that disclaimer will not be withdrawn or amended on petition. See Bayer AG, *supra*; MPEP 1490(B).

Furthermore, equitable powers should not be invoked to excuse the performance of a condition by, as here, 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). Petitioner had more than six months in which to correct, under the provisions of MPEP 1490(A), the filing of the disclaimer of June 25, 2008, before the patent issued. It is well settled that the public has a right to rely on the public record of a patent. See Vitronics Id.; Vectra Fitness, Id. Petitioner does not offer any reason that would excuse the inordinate delay in this case. Any contention that petitioner was diligent in seeking correction of this matter is simply not supported by the record. The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence(s) of his delay. See Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378,379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975).

**PETITION under 37 CFR 1.183**

As an initial matter, the petition fee of \$400 under 37 CFR 1.17(f), required for consideration of a petition under 37 CFR 1.183, has been charged to Deposit Account 50-1417, as authorized.

In regard to the request under 37 CFR 1.183, it is noted that 37 CFR 1.183 states that only 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 Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Petitioner, has not, however, shown an extraordinary circumstance where justice requires suspension of the rules. Applicants should have filed a corrected terminal disclaimer during the prosecution of the application, i.e., prior to its issuance as a patent. Applicants had more than six months to correct the Terminal disclaimer prior to the issuance of the instant application.

The term of this patent was set by way of 35 USC § 154(b), and, by way of the disclaimer filed June 25, 2008, under § 253. Since the patent statute at sections §§ 154, 155, 155(a), and 156 limits the adjustment, extension, or restoration, of the term of a given patent to the causes and conditions specified therein; it would be inappropriate, by way of a petition under 37 CFR 1.183 to fashion yet another manner of adjusting, extending, or restoring, the term of the above-identified patent beyond the statutory scheme already provided by Congress. Further in this regard, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). That is, the patent statute at sections §§ 154, 155, 155(a), and 156 (and their promulgating regulations at 37 CFR 1.701 et seq.) provides a specific mechanism grounded on specific delays (arising from judicial, regulatory agency, or internal USPTO delay) whereby a party may petition the Office to adjust, extend, or restore the term of a given patent. As Congress has already enacted legislation for patent term adjusting, extending, or restoring provisions in four sections (154, 155, 155(a), and 156) of the patent statute, and has not seen fit to create any additional statutory term modifying remedies, it is inappropriate for the Office to now create an additional, extra-legislative means of adjusting, extending, or restoring, the term of the original patent by now removing or amending the terminal disclaimer filed June 25, 2008 by way of petition under 37 CFR 1.183 (or 1.182).

The contested terminal disclaimer clearly complies with 37 CFR 1.321(b). While petitioner argues that the common ownership requirements of 37 CFR 1.321 (c)(3) were not met by the recorded disclaimer, common ownership is not a condition required for a viable terminal disclaimer under 37 CFR 1.321(b). Indeed, even where 37 CFR 1.321(c)(4) requires common ownership, such is mentioned in conjunction with enforcement *vel non* of the disclaiming patent and is not mentioned in conjunction with, or as a condition of, the forfeiture of a given period of time.



37 CFR 1.183 should not be considered a panacea for applicant's tactical errors in prosecution in the original patent, as the failure to file a disclaimer over the patent actually relied upon in the obviousness-type double patenting rejection was a circumstance that was not beyond the control of petitioner, or petitioner's counsel. Rather, as any disclaimer of additional term over the '058 patent could have been avoided the by exercise of reasonable care and diligence, petitioner has failed to show that waiver of the rules is appropriate. See Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when counsel makes an avoidable mistake in filing papers); Vincent v. Mossinghoff, 230 USPQ 621,625 (D.D.C. 1985) (petitioner's failure to take adequate notice of USPTO procedures will not be permitted to shift, in equity, his lack of diligence onto the USPTO). The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, *supra*; Huston v. Ladner, *supra*; see also Haines v. Quigg, *supra*.

The instant petition requesting a waiver under 37 CFR 1.183, of applicable regulation, is therefore **DENIED**.

#### **DECISION**

For the above-stated reasons, the petition to withdraw the terminal disclaimer and issue a certificate of correction is **denied**.

This is a **final agency action** within the meaning of 5 U.S.C. § 704. The Director will undertake no further reconsideration or review of this matter.

Telephone inquiries concerning this decision should be directed to Ramesh Krishnamurthy at (571) 272-4914.



Anthony Knight  
Director,  
Office of Petitions

# Exhibit B



BACON & THOMAS, PLLC  
625 SLATERS LANE  
FOURTH FLOOR  
ALEXANDRIA VA 22314

**COPY MAILED**

JUN 07 2006

**OFFICE OF PETITIONS**

In re Patent No.:6,550,701 :  
Issue Date: April 22, 2003 :DECISION ON PETITION  
Application No. 09/684,777 :  
Filed: October 10, 2000 :  
Inventor: Chang :

This is a decision on the petition under 37 CFR 1.182 filed April 19, 2005, which is properly treated as a petition under 37 CFR 1.181(a)(3) asking the Director to exercise his supervisory authority and review the refusal of Certificate of Correction Branch mailed March 2005 to issue the requested Certificate of Correction.

The petition is **DENIED**.

BACKGROUND

The above-identified patent, as filed October 10, 2000, contained 4 claims, with claim 1 being the sole independent claim. Claim 1 provided:

A dual-functional medium shredding machine structure, that allows shredding of paper, optical discs, and credit cards, characterized in comprising: a machine body being provided with a power switch on a surface thereof and roller blades therein, the roller blades being driven by a gearbox; two inports on an upper lid thereof, the inports including a paper inport with an opening of a larger dimension and inclined, curved channel walls, and a disc inport with an opening of a smaller dimension and vertical channel walls, the inports being each led to the shredding roller blades such that, regardless of the type of substance being fed by a user, the paper or the disc can all be shredded by the shredding roller blades through the intermeshing of roller blades; a paper touch switch being provided at an appropriate location between the paper inport and the roller blades; and a disc touch switch being provided at an appropriate location between the paper inport and the roller blades; whereby the roller blades are activated by the touch switches when paper, discs, or credit cards are fed and touch the touch switches so as to activate the roller blades to perform intermeshing and shredding task.

Claim 4 depends from independent claim 1, and provided:

The dual-functional medium shredding machine structure of claim 1, wherein the paper inport and the disc or card inport are both led to the roller blades, a single touch switch is provided between the roller blades such that regardless of the type of substance being fed by a user, the paper, disc, or credit cards can all touch the touch switch so as to activate the roller blades to perform shredding task while the scraps are all dispensed to an identical bin.

Thus, independent claim 1 called for a paper touch switch located "between the paper inport and the roller blades" and a disc touch switch also located "between the paper inport and the roller blades." Dependent claim 4 references independent claim 1 and further recites a single touch switch which is "provided between the roller blades."

On November 14, 2002, the examiner allowed claims 1-4 exactly as they had been drafted by applicant and presented on filing.

The patent issued on April 22, 2003, with claims 1-4 printed exactly as allowed by the examiner, *i.e.*, exactly as they had been drafted by applicant and presented on filing.

A request under 37 CFR 1.322 for a Certificate of Correction was filed October 20, 2004. The request asserted that the Office had erred during examination by failing to require that applicant rewrite claim 4 as an independent claim. That is, the requested correction contended that as claim 1 recited two touch switches, and claim 4 specified but one touch switch, claim 4 is broader in scope than claim 1, and therefore could not be considered a claim properly dependent on claim 1.

On or about March 5, 2005, Certificates of Correction Branch refused the requested correction as not falling under 35 U.S.C. § 254 and 37 CFR 1.322, based upon the examiner's determination. Rather, reissue was suggested as the avenue for obtaining the requested relief.

The instant petition was filed April 19, 2005.

On April 20, 2005, petitioner filed a request for reissue of the above-captioned patent, which was assigned application no. 11/109,843. The filing was announced in the Official Gazette of November 8, 2005.

On March 7, 2006, the court in *Michilin Prosperity Co. v. Fellowes Mfg. Co.*, 422 F.Supp.2d 86 (D.D.C. Mar. 7, 2006) rendered a decision in litigation involving the above-captioned patent. The court, *inter alia*, declined to correct the patent by rewriting claim 4 in independent form as beyond its corrective power, and in so doing opined that the underlying error was caused by applicant and was not caused by the USPTO. *Id.* at 91 ("Michilin requests that this court correct a drafting error by the patent applicant.").

#### OPINION

37 CFR 1.182, by its terms applies when no other regulation speaks to the issue. Since 37 CFR 1.181(a)(3) provides for the requested supervisory review, 37 CFR 1.182 is inapposite. In any event, petitioner requests reconsideration of the refusal of Certificates of Correction Branch to issue the requested correction that seeks to rewrite claim 4 in independent form. Petitioner again asserts that claim 4, which Petitioner drafted and presented to the Office, was an improper dependent claim and as such, the Office should have required claim 4 to be rewritten in independent form.

Since petitioner has failed to show that the issues herein raised are proper subject matter for a Certificate of Correction under either 35 U.S.C. § 254 (or § 255), the refusal of Certificate of Correction Branch to process the requested correction will not be disturbed.

As to § 254 and its promulgating regulation, 37 CFR 1.322:

This or any patent is printed in accordance with the record in the Patent and Trademark Office of the application as passed to issue by the examiner. In order for a proposed correction to lie under § 254 and its promulgating regulation, the requestor must show that (1) there is a mistake in the patent, that was (2) incurred through the fault of the Patent and Trademark Office, which mistake is (3) clearly disclosed by the records of the Office.<sup>1</sup> See 35 U.S.C. §

---

<sup>1</sup>It is noted that a Certificate of Correction is only applicable to causes of action initiated after the USPTO grants the correction. *Southwest Software v. Harlequin*, 226 F.3d 1280, 56 USPQ2d 1161 (Fed. Cir. 2000). Otherwise, the patent is read in its as-issued, uncorrected form. *Id.*

254.<sup>2</sup> If any one of the three prongs is not satisfied, then, as here, the Office must deny the request for correction under § 254.

Petitioner contends that a mistake incurred through the fault of the USPTO in that the examiner failed to require that original claim 4 be rewritten in independent claim format. In essence, Petitioner believes that the examiner made a mistake by not catching applicant's claim drafting error and identifying the error in the record. Petitioner asserts that there are two alternate embodiments of the shredder disclosed in the specification: a two switch two bin arrangement, and a one switch one bin. While claim 1 is asserted to refer to the former embodiment, claim 4 is asserted to be drawn to the latter. Petitioner further contends that claim 4 does not present a further limitation to claim 1; rather, claim 4 is contended to remove a limitation, and, as such, is alleged to be an improper dependent claim. Specifically, Petitioner wishes to have the Office rewrite claim 4 to include the limitations of claim 1, except for (i) the "paper touch switch" limitation, (ii) the "disc touch switch" limitation, and (iii) the "whereby the rollerblades are activated by the touch switches" limitation. Petitioner further asserts that the statute, 35 U.S.C. § 112, paragraph 4 defines what is the proper scope of a dependent claim, and MPEP 608.01(n) which addresses the instant circumstance, indicates that the examiner should have required claim 4 to be written in independent form.

Taking the last issue first, inspection of the record of this file fails to "clearly disclose" that the examiner made an error by not requiring claim 4 to be rewritten in independent form. The introductory phrase of the part of section 608.01(n) quoted in the petition sets forth that "[w]here a claim in dependent form is not considered to be a proper dependent claim under 37 CFR 1.75(c), the examiner should object to such claim under 37 CFR 1.75(c) and require cancellation of such improper dependent claim and or rewriting of such improper dependent claim in independent form."

MPEP 608.01(n) subsection III sets forth the test:

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim. A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

Inspection of claim 4 fails to reveal that it is an improper dependent claim. A fair reading of claim 4 as drafted by petitioner and as it appears in the issued patent fails to evidence that claim 4 expressly omits or precludes either or both of the paper touch switch and the disc touch switch, or expressly states that either or both of paper touch switch and the disc touch switch are replaced by the single touch switch. Accordingly, claim 4 meets the test for a proper dependent claim.<sup>3</sup> This is particularly so in that in claim 1, the paper touch switch is provided at an appropriate location between the paper inport and the roller blades, and the disc touch

---

<sup>2</sup>The USPTO has a long history of issuing certificates of correction to correct errors in patents arising from its processing and patent printing operations that actually predates the statutory authorization provided by § 254 and its 1925 predecessor statute. See McCrady, *Patent Office Practice*, 4th Ed. (1959) at 439. The USPTO originated mistakes in printed patents corrected by Certificates of Correction have run the gamut from the trivial, such as punctuation errors, to omitted drawings, and even to missing claims. *Id.* Here, however, every claim presented on filing by applicant was printed *verbatim* in the as-issued patent.

<sup>3</sup> As the court observed in Chef America Inc. v. Lamb-Weston Inc., 358 F.3d 1371, 1374 (Fed. Cir. 2004) "[t]hus, in accord with our settled practice we construe the claim as written, not as the patentees wish they had written it."

switch is likewise provided at an appropriate location between the paper inport and the roller blades; the disc touch switch is not, as claimed, placed between the disc inport and the roller blades. The "single touch switch" of claim 4 is provided at a different location, i.e., "between the roller blades" such that regardless of the respective substance input port used, all substances input can touch the touch switch of claim 4.

Petitioner's further reliance on § 608.01(n) to urge that given a claimed combination of ABCD, a dependent claim omitting D or replacing D with E to show that claim 4 is not a proper dependent claim, is not convincing. A fair reading of claim 4 as drafted by petitioner and as it appears in the issued patent fails to evidence that claim 4 expressly omits or precludes either or both of the paper touch switch and the disc touch switch, or expressly states that either or both of paper touch switch and the disc touch switch are replaced by the single touch switch. While petitioner contends that the specification only describes either a one or two switch embodiment, he has failed to consider the import of the description of claim 4 *vis-a-vis* its being an originally presented claim. An originally filed claim constitutes its own description for purposes of 35 U.S.C. § 112 first paragraph. See In re Benno, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985). Thus, it is permissible for original claims to disclose an embodiment not disclosed in the descriptive part of the patent application, since the original claims are part of the patent specification. See Hyatt v. Boone, 146 F.3d 1348, 1352 (Fed. Cir. 1998); In re Gardner, 475 F.2d 1389, 1391 (CCPA 1973).

Since original dependent claim 4, by law, necessarily contains both the switches recited in independent claim 1, and recited yet another, "single touch switch", originally filed claim 4 thus describes a three switch shredder. See Benno, Id.; Hyatt, Id.; Gardner, Id. Furthermore, and contrary to petitioner's contention, as claim 4 is part of the specification, see 35 U.S.C. § 112, second paragraph ("[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention,"), the specification can be fairly said to describe a 3 switch embodiment given that claim 4 does not expressly omit or preclude either or both of the paper touch switch and the disc touch switch, or expressly state that either or both of paper touch switch and the disc touch switch are replaced by the single touch switch, yet itself presents an additional, single touch switch whereby all input materials can all touch that touch switch. Thus, as drafted by applicant claim 4 recites a third switch that, while different in placement and operation from the other two touch switches, is capable of coexistence with the other 2 recited switches. Accordingly, the records of the USPTO do not clearly show the existence of a mistake in claim 4, much less a mistake incurred through the fault of the USPTO.

What the records of the USPTO do show is that, contrary to petitioner's urging, applicant never presented a claim limited to the one switch embodiment of the disclosure. However, that is not a USPTO caused error; that is applicant's error in claim drafting, which is not properly remedied under 35 U.S.C. § 254 and 37 CFR 1.322. See In re Lambrech, 202 USPQ 620 (Comm'r Pats. 1976); see also Superior Fireplace Co. v. Majestic Products Co., 270 F.3d 1358, \_\_\_\_\_ (Fed. Cir. 2001) (noting for applicants "the critical importance of reviewing claims" before the allowed claims issue) (quoting Southwest Software, Inc. v. Harlequin, Inc., 226 F.3d 1280, 1296 (Fed. Cir. 2000) ("it does not seem to us to be asking too much to expect a patentee to check a patent when it is issued in order to determine whether it contains any errors...") see also Chef America Inc. v. Lamb-Weston Inc., 358 F.3d 1371, 1373 (Fed. Cir. 2004) (quoting underlying district court decision, "[i]t is the job of the patentee, and not the court, to write patents carefully and consistently."). An example of the type of mistake typically covered by section 254 would be the circumstance that Petitioner had in fact presented a claim actually limited to the one switch embodiment, and that claim was allowed by the examiner, but it did not appear in the as-issued patent.

Moreover, as pointed out below, Petitioner essentially seeks to obtain through a certificate of correction a claim of a particular scope (a shredder with only one switch) which simply has never been evaluated on its merits by the Office. As made clear by the examiner's Reasons for Allowance, the examiner considered claims 1-4 patentable because the claims all required a paper touch switch and a disc touch switch (an interpretation that Petitioner did not dispute before the claims issued). If the Petitioner's request was granted, the Office would be issuing a broadened claim that it never considered, much less determined to be patentable, which is simply an illogical result. That type of error is not amenable to correction through section 254;

rather, reissue is the appropriate path to resolve Petitioner's claim drafting error, as was pointed out in the decision by the Certificates of Correction Branch. It is noted that Petitioner has in fact filed a reissue application which is currently pending.

Furthermore, petitioner appears to overlook section MPEP 608.01(I):

In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it. Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. **The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.** It is, of course, to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and description (emphasis added).

Since claim 1 and 4 are both originally presented claims, the above-quoted section of the MPEP undercuts petitioner's contention that the examiner erred in not making some sort of objection to claim 4 and requiring it to be rewritten in independent form. This section of the MPEP further indicates that originally filed and patented claim 4 is not defective per se, and as noted above claim 4 is a proper dependent claim. That is, in view of the practice set forth in MPEP 608.01(I), the record does not "clearly disclose" any error that makes claim 4 eligible for correction under section 254.

Here, the patent was printed in accordance with the record in the Patent and Trademark Office of the application as passed to issue by the examiner. Claim 4 was passed to issue by the examiner exactly as it was drafted by applicant and presented on filing, and claim 4 was printed in the patent exactly as it was allowed by the examiner. Accordingly, assuming *arguendo*, there is a mistake in the patent, such was not "incurred through the fault of the Patent and Trademark Office" within the meaning of 35 U.S.C. § 254 and 37 CFR 1.322. Indeed, the applicant is bound by § 112, paragraph 4 to the same extent as the examiner. That is, any applicant has a clear duty to present claims that comply with § 112, paragraph 4 and provide adequate protection for his invention(s); he cannot neglect this duty and then be relieved of the consequences by claiming that the mistake is that of the USPTO in failing to notice and correct his error. *Lambrech*, at 621. The primary responsibility for presenting claims that provide adequate coverage for disclosed inventions rests with applicant. Applicant's failure to present a claim to the one switch embodiment is not correctable by way of 35 U.S.C. § 254 and 37 CFR 1.322. *Id.* Indeed, the *Michilin* court characterized this matter as a "drafting error by the patent applicant" as opposed to "an obvious administrative error" on the part of the USPTO, which is consistent with and reinforces the conclusion that petitioner is not entitled to a Certificate of Correction under § 254 and 37 CFR 1.322.

Ultimately, Petitioner's contentions boil down to the position that it should have been manifestly clear to the Office that claim 4 was intended to be an independent claim, and not a dependent claim, as was mistakenly drafted by the Petitioner. It is too much, however, to expect an examiner to be clairvoyant and read the mind of an applicant to understand that the applicant really wanted a claim that included the limitation recited in claim 4, and further included some, but not all, of the limitations recited in claim 1. Moreover, for the reasons stated above, it was entirely permissible for the examiner to understand original claim 4 as reciting an invention having an additional third switch. In fact, it is very clear from the format of claim 4 chosen by the applicant that the applicant sought claim 4 to be dependent on claim 1, rather than an independent claim. See, e.g., *Jeneric/Pentron, Inc. v. Dillon Co., Inc.*, 1999 WL 66537, \*9 (D. Conn. 1999), *aff'd*, 205 F.3d 1377 (Fed. Cir. 2000) ("Claims can either be independent or dependent. An independent claim does not refer to any other claim of the patent and is read separately to determine its scope. . . . A dependent claim refers to at least one other claim of the patent, includes all of the limitations of the claim to which it refers, and specifies a further limitation on that claim."); see also 35 U.S.C. § 112, ¶¶ 3 and 4. Thus, since applicant drafted the claim and then did not respond to the examiner's Reasons for Allowance, Petitioner cannot reasonably expect that the claim can now be revised through a certificate of correction.

As to § 255 and its promulgating regulation, 37 CFR 1.323:

While petitioner has not specifically requested relief under 35 U.S.C. § 255 and 37 CFR 1.323, and Certificate of Correction Branch has not ruled on the matter, in the interests of economy for both petitioner and the USPTO, the USPTO will consider, *sua sponte*, the possibility of relief under this statute and its promulgating regulation. Cf. Lambrech, supra.

A Certificate of Correction under 35 U.S.C. § 255 and 37 CFR 1.323 is available only 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 Superior Fireplace, supra; In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pat. 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) require reexamination. See Arnott 19 USPQ2d at 1052; see also MPEP 1490. Petitioner's request fails on both counts to show that his failure to present a claim limited to the single switch embodiment during prosecution may now be remedied by a Certificate of Correction under § 255.

Specifically, it is not seen, and petitioner has not shown, that there is an error of a clerical nature, or of a typographical nature, or of minor character, present. What petitioner now proposes, in the guise of a Certificate of Correction is to present a claim to subject matter that was never examined by the examiner, was never passed to issue by the examiner, and was never given patent protection by the USPTO. Claim 1 presented a two switch embodiment and claim 4, by law, includes all the features—including both touch switches—of claim 1 and additionally recites an additional "single touch switch". The Examiner's Statement of Reasons for Allowance shows that the examiner considered all 4 claims as allowed to be inclusive of two touch switches. As the Federal Circuit observed in Superior at 1375: "[t]hus, Superior's suggestion that we compare claim scope by considering what was "intended" by the parties, rather than by construing the claims for what they actually recite, is completely without merit." Thus, the single touch switch *only* embodiment was clearly not before the examiner, or passed to issue by the examiner. It follows that the proposed Certificate of Correction does not, contrary to petitioner's assertions, merely rewrite claim 4 in independent form. Rather, the proposed correction now specifically excludes the two touch switches of claim 1 that by operation of 35 U.S.C. § 112, paragraph 4, were specifically included in claim 4 as patented. The mistake in applicant's claim drafting is therefore, not of a clerical nature; not of a typographical nature; and not of minor character. Superior at 1376. Where, as here, the proposed correction broadens the scope of coverage of claim 4, and the alleged mistake in the claim is not clearly evident from the specification, drawings, and prosecution history, that is not a "mistake of a clerical or typographical nature" subject to correction under 35 U.S.C. § 255. Superior, Id. Moreover, a mistake the correction of which broadens a claim is not a "mistake of ... minor character" subject to correction under 35 U.S.C. § 255. Id. Furthermore, it clearly would require reexamination for the requested correction, as the "one touch switch" only embodiment was never claimed or examined during the pendency of the original application for patent, and was never issued by the USPTO. Petitioner's complaint that the decision of Certificate of Correction Branch failed to cite any authority for its refusal of a correction certificate, or its constructive suggestion to seek reissue, is answered by MPEP 1481<sup>4</sup> which states in pertinent part:

37 CFR 1.323 relates to the issuance of Certificates of Correction for the correction of errors which were not the fault of the Office. Mistakes in a patent which are not correctable by Certificate of Correction may be correctable via filing a reissue application (see MPEP § 1401 - § 1460). See Novo Industries, L.P. v. Micro Molds

---

<sup>4</sup>See also case law and MPEP provisions discussed infra.



Corporation, 350 F.3d 1348, 69 USPQ2d 1128 (Fed. Cir. 2003) (The Federal Circuit stated that when Congress in 1952 defined USPTO authority to make corrections with prospective effect, it did not deny correction authority to the district courts. A court, however, can correct only if "(1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation...").

In re Arnott, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991) specifies the criteria of 35 U.S.C. 255 (for a Certificate of Correction) as follows:

Two separate statutory requirements must be met before a Certificate of Correction for an applicant's mistake may issue. The first statutory requirement concerns the nature, i.e., type, of the mistake for which a correction is sought. The mistake must be:

- (1) of a clerical nature,
- (2) of a typographical nature, or
- (3) a mistake of minor character.

The second statutory requirement concerns the nature of the proposed correction. The correction must not involve changes which would:

- (1) constitute new matter or
- (2) require reexamination.

If the above criteria are not satisfied, then a Certificate of Correction for an applicant's mistake will not issue, and reissue must be employed as the vehicle to "correct" the patent. Usually, any mistake affecting claim scope must be corrected by reissue.

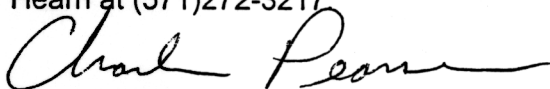
A mistake is not considered to be of the "minor" character required for the issuance of a Certificate of Correction if the requested change would materially affect the scope or meaning of the patent. See also MPEP § 1412.04 as to correction of inventorship via certificate of correction or reissue.

#### DECISION

For the reasons given above, the decision of Certificate of Correction Branch was proper in refusing the requested correction. The petition is granted to the extent that the decision of Certificate of Correction Branch has been reviewed, but is **denied** as to any modification thereof or issuance of a Certificate of Correction. While the requested correction will not be forthcoming under 35 U.S.C. § 254 or 255, petitioner may yet obtain relief under 35 U.S.C. § 251.

This decision may be considered a final agency action within the meaning of 5 U.S.C. § 704 for purposes of obtaining judicial review. See MPEP 1002.02. The USPTO will not further consider or reconsider this matter.

Any inquiries concerning this communication may be directed to the Petitions Examiner Brian Hearn at (571)272-3217.



Charles Pearson  
Director, Office of Petitions

# Exhibit C



MCGARRY BAIR PC  
32 MARKET AVE. SW  
SUITE 500  
GRAND RAPIDS, MI 49503

**COPY MAILED**

**AUG 15 2007**

**OFFICE OF PETITIONS**

In re Patent No. :  
7,168,818 :  
Issue Date: January 30, 2007 : DECISION ON PETITION  
Application No. 10/905,330 :  
Filed: December 28, 2004 :  
Attorney Docket No. 71486-0088 :

This is a decision on the petition under 37 C.F.R. 1.182 filed May 24, 2007, which is properly treated as a petition under 37 C.F.R. 1.181(a)(3) asking the Director to exercise his supervisory authority and review the refusal of Certificate of Correction branch mailed April 30, 2007 to issue the requested certificate of correction.

The petition is **DENIED**.

#### BACKGROUND

The above identified patent, as filed December 28, 2004, contained 19 claims. Originally filed claim 1 provided:

A vehicular rearview mirror system for a motor vehicle having a driver's side and a passenger's side, a first rearview mirror assembly attached to the driver's side, and a second rearview mirror assembly attached to the passenger's side, comprising: a first reflective element assembly for providing a rearward view along the driver's side to the operator of the vehicle, the first reflective element having a first base assembly for attaching the first reflective element assembly to the exterior of the vehicle; a second reflective element assembly for providing a rearward view along the passenger's side to the operator of the vehicle, the second reflective element assembly having a second base assembly for attaching the second reflective element assembly to the exterior of the vehicle; and wherein the natural frequency of the second vehicular rearview mirror assembly is less than the natural frequency of the first vehicular rearview mirror assembly.

Originally filed claims 5, 9, 14, and 18 additionally provided:

The vehicular rearview mirror system of claim 4 wherein the natural frequency of the first reflective element assembly is at least 60 Hz and the natural frequency of the second reflective element assembly is less than 60 Hz.

Thus, independent claim 1 and dependent claims 5, 9, 14, and 18 each required the natural frequency associated with the passenger's side rearview mirror assembly and reflective element to be less than the natural frequency associated with the driver's side rearview mirror assembly and reflective element.

On May 23, 2006 the examiner's first office action was mailed in which originally filed claims 1-19 were rejected under 35 USC 103 as obvious over the admitted prior art in view of Nielson US 2003/0086191. In particular, the examiner noted that from the teachings of Nielson

“it would have been obvious to the ordinarily skilled artisan at the time of invention to replace one of the vehicular mirrors, e.g. the passenger's side mirror, with Nielsen's mirror as per Nielsen's suggestion in order to enable remote adjustment of this mirror. In such a combination, since the passenger's side mirror assembly, including the base, is made of plastic, it has a lesser natural frequency and is more resilient than the driver's side mirror assembly (which is made of metal).” (emphasis added)

To overcome this rejection, claims 1 and 11-19 were canceled and claim 20 was added in the amendment filed August 23, 2006. New claim 20 was the sole independent claim and provided:

A vehicular rearview mirror system for a motor vehicle having a driver's side and a passenger's side, comprising:

a first rearview mirror assembly attached to the driver's side for providing a rearward view along the driver's side to the operator of the vehicle, a first planar reflective element assembly comprising a first planar reflective element, a first base assembly fabricated of a first material having a first modulus of elasticity for attaching the first planar reflective element assembly to the exterior of the vehicle, and a first cantilever arm coupling the first planar reflective element assembly to the first base assembly;

a second rearview mirror assembly attached to the passenger's side for providing a rearward view along the passenger's side to the operator of the vehicle, a second non-planar reflective element assembly comprising a second non-planar reflective element, a second base assembly fabricated of a second material having a second modulus of elasticity for attaching the second non-planar reflective element assembly to the exterior of the vehicle, and a second cantilever arm coupling the second non-planar reflective element assembly to the second base assembly;

wherein said second modulus of elasticity is substantially less than said first modulus of elasticity; and

whereby the natural frequency of said first planar reflective element assembly supported by said first cantilever arm on said first base assembly is substantially less than the natural frequency of said second non-planar reflective element assembly supported by said second cantilever arm on said second base assembly.

Thus, sole independent claim 20 required the natural frequency associated with the driver's side rearview mirror (first planar reflective element assembly) to be less than the natural frequency associated with the passenger's side rearview mirror (second non-planar reflective element assembly). That is, the order of the driver's side (first) and passenger's side (second) were reversed in claim 20 from the order presented in the rejected claims.

In the "Remarks/Arguments" section of the amendment filed August 23, 2006, Applicant asserted that

"Nielsen '191 lacks the claimed subject matter of claim 20. The Examiner's asserted modification of the prior art exclusive of Nielsen '191 also lacks the claimed subject matter of claim 20. Thus, claim 20 is patentable over the prior art, alone and in combination with Nielsen '191. Applicant requests the allowance of claim 20."

The amended claims were allowed on September 22, 2006. In the Statement of Reasons for Allowance, the examiner explained that independent claim 20 was allowed, in part, because it requires:

"the natural frequency of the first planar reflective element assembly supported by the first arm on the first base to be substantially less than the natural frequency of the second non-planar reflective element assembly supported by the second arm on the second base assembly as claimed. Although Nielsen of record discloses a replacement mirror to comprise a plastic base component, which could result in a lower modulus of elasticity for the second base, the claimed combination noted above cannot be said to be taught or suggested by this reference (or by the disclosed admission of prior art)."

As evident by the reasons for allowance, the order of the "first" and "second" elements was important to the allowance of the claims since "the claimed combination" cited by the examiner included a first element with a natural frequency that is less than the natural frequency of the second element.

Moreover, the Statement of Reasons for Allowance was concluded by noting that:

"[A]ny comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

No such comment was filed prior to the payment of the issue fee.

The patent issued on January 30, 2007, with claims 2-10 and 20 printed with limitations exactly as allowed by the examiner, *i.e.*, exactly as they had been drafted by applicant and presented on amendment. In the printed patent, claim 20 was renumbered as claim 1 with claims 2-10 being dependent claims.

A request under 37 CFR 1.322 for a Certificate of Correction was filed February 1, 2007. This request asserted that the office erred during examination by applying an incorrect reference number to a component discussed in the specification. This error was corrected through the Certificate of Correction issued May 22, 2007. This request is not the subject of the present petition.

The present petition relates to a request under 37 CFR 1.323, also filed February 1, 2007, for another Certificate of Correction. This request indicates that amended claim 20 (patented claim 1) was incorrectly drafted to call for the first assembly to have a natural frequency less than the natural frequency of the second assembly. According to the request, this mistake was due to an "oversight" by Applicant.

In a decision dated April 30, 2007, Certificate of Corrections Branch refused the requested correction to patented claim 1 as the requested changes would result in a change in scope, based upon the examiner's determination.

The instant petition was filed May 24, 2007.

#### OPINION

37 CFR 1.182, by its terms applies when no other regulation speaks to the issue. Since 37 CFR 1.181(a)(3) provides for the requested supervisory review, 37 CFR 1.182 is inapposite. In any event, petitioner requests reconsideration of the refusal of Certificate of Correction Branch to issue the requested correction that seeks to reverse the order of "first" and "second" in the last clause of claim 1 from the order allowed by the examiner.

Since petitioner has failed to show that the issues herein raised are proper subject matter for a Certificate of Correction under either 35 U.S.C. § 254 or § 255, the refusal of Certificate of Correction Branch to process the requested correction will not be disturbed.

As to § 255 and its promulgating regulation 37 CFR 1.323:

This or any patent is printed in accordance with the record in the Patent and Trademark Office of the application as passed to issue by the examiner. A Certificate of Correction under 35 U.S.C. § 255 and 37 CFR 1.323 is available only 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 Superior Fireplace Co. v. Majestic Products Co., 270 F.3d 1358, 60 USPQ2d 1668 (Fed. Cir. 2001); In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pat. 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) require reexamination. See In re Arnott 19 USPQ2d at 1052; see also MPEP 1490. Petitioner's request fails on both counts to show that his failure to present an allowable claim with a passenger's side mirror system element with a natural frequency that is less than the natural frequency of a driver's side mirror system element may now be remedied by a Certificate of Correction under § 255.

In particular, it is not seen, and petitioner has not shown, that there is an error of a clerical nature, or of a typographical nature, or of minor character, present. What petitioner now proposes, in the guise of a Certificate of Correction is to present a claim to subject matter that was never examined by the examiner, was never passed to issue by the examiner, and was never given patent protection by the USPTO. As observed in Superior 60 USPQ2d 1668 at 1676: "clerical or typographical mistakes are generally understood to include simple mistakes such as obvious misspellings that are immediately apparent. Upon viewing such a misspelling, there is no doubt that a mistake, indeed a clerical or typographical mistake, has occurred." Also, "[a]bsent very unique and unusual circumstances, a clerical or typographical mistake should be manifest from the contents of the file of the patent sought to be corrected." See In re Arnott at 1053. Here, however, the contents of the file do not manifestly show that the mistake was merely clerical or typographical. Rather, the record suggests that the mistake was introduced by amendment in an intentional attempt to overcome the prior art.

The examiner rejected an arrangement in which the natural frequency associated with a "second" mirror assembly and "second" reflective element is less than the natural frequency associated with a "first" mirror assembly and "first" reflective element. In overcoming this rejection, the claim was amended to recite, in part, that the natural frequency associated with "first" reflective element is less than the natural frequency associated with the "second" reflective element. Although an arrangement in which the "first" natural frequency is less than the "second" natural frequency was not supported by the original disclosure and was arguably impossible, as petitioner notes, the record suggests that this order was necessary to overcome the examiner's finding that an arrangement with the "second" natural frequency being less than the "first" natural frequency would have been obvious. This reordering of "first" and "second" was recognized in both the arguments to the amendment and the examiner's Statement of Reasons for Allowance as not being taught or suggested by the prior art. Indeed, an arrangement with a "first" natural frequency less than a "second" natural frequency was not found in the prior art and the claims were allowed. The examiner's Statement of Reasons for Allowance specifically cite the limitation reciting that the "first" natural frequency is less than the "second" natural frequency as a basis for allowance. Thus, reordering of "first" and "second" was necessary to overcome the prior art. The record never suggests that the arrangement of the proposed correction was allowable. A mere clerical or typographical error did not result when the claims were amended to satisfy 35 USC §§ 102 and 103 with respect to the prior art cited by the examiner. The "oversight" in drafting the amended claim involved neglecting sections of the statute other than §§ 102 and 103 to which the claim must also conform, which is not a clerical or typographical error of the type described in Superior.

Moreover, the arguments to the amendment and the examiner's Statement of Reasons for Allowance indicate that the reordering of "first" and "second" was a significant change, which, in combination with the further limitations of the claims, was not found in the prior art. However, the petition suggests that now reversing the order of "first" and "second" in the patented claim would be a minor correction that would not broaden the scope of the claim. This is not true.

MPEP § 1412.03 discusses changes that would broaden the scope of a claim in regard to reissue applications, which similarly applies to changes to a claim through a Certificate of Correction.

"A claim in the [correction] which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the [correction] contains within its scope any conceivable product or process which would not have infringed the patent, then that [corrected] claim would be broader than the patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603, 120 USPQ 185, 186 (CCPA 1958). A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement."

Since the apparatus that would be defined by claim 1, as corrected by the proposed Certificate of Correction, would contain within its scope a product that would not have infringed patented claim 1, corrected claim 1 would be broader than patented claim 1. A mistake the correction of which broadens a claim is not a "mistake of ... minor character" subject to correction under 35 U.S.C. § 255. *Superior Fireplace Co. v. Majestic Products Co.*, 270 F.3d 1358, 60 USPQ2d 1668 (Fed. Cir. 2001). Also, where, as here, the proposed correction broadens the scope of coverage of claim 1, and the alleged mistake in the claim is not clearly evident from the specification, drawings, and prosecution history, that is not a "mistake of a clerical or typographical nature" subject to correction under 35 U.S.C. §255. *Id.*

Furthermore, reexamination clearly would be required for the requested correction. The examiner determined that it would have been obvious to provide an arrangement having the natural frequency associated with a "second" mirror assembly and "second" reflective element that is less than the natural frequency associated with a "first" mirror assembly and "first" reflective element. The claims were allowed only after "first" and "second" were reversed in this arrangement, and the examiner specifically cited this new recitation in his reasons for allowance. The proposed correction presents a claim with a scope that was not previously examined or issued by the USPTO. Also, the proposed correction presents an arrangement with a second natural frequency less than a first natural frequency, which was previously considered obvious by the examiner.

In section 1 of the remarks of the present petition, Petitioner states:



“The Examiner's argument against patentability was not grounded upon which reflective element assembly had the greater or lesser natural frequency. It was grounded only upon one of the reflective element assemblies having a lower modulus of elasticity than the other.”

This is not true. The argument against patentability was grounded upon the obvious nature of the passenger's side (second) mirror assembly having a “lesser” natural frequency than the driver's side (first) mirror assembly. This was specifically indicated in the rejection of the original claims. The “modulus of elasticity” was not recited in the original claims or addressed in the argument against the patentability of those claims. Thus, contrary to Petitioner's assertion, the proposed correction would derogate from the argument against patentability. Moreover, since the claims proposed by the correction were never examined, their patentability is not clear.

Since the mistake in the patented claims is not of a clerical nature, or of a typographical nature, or of minor character, and the correction of which would require reexamination, the petition under § 255 cannot be granted.

As to § 254 and its promulgating regulation 37 CFR 1.322:

Petitioner indicated that there is uncertainty as to which of Rules 1.322 and 1.323 provided the basis for evaluation of the request for correction. The decision of Certificate of Correction Branch dated April 30, 2007 specifically referenced Rule 1.322, but the content of the decision addressed the substance of the request pursuant to Rule 1.323. Furthermore, Petitioner suggests that patented claim 1 introduces new matter, which may present a mistake by the USPTO in allowing such a claim.

Nonetheless, the decision of Certificate of Correction Branch was appropriate under both rules. The decision is consistent with the standards of Rule 1.323, as discussed above. The decision is also consistent with the standards of Rule 1.322.

In order for a proposed correction to lie under § 254 and its promulgating regulation (1.322), the requestor must show that (1) there is a mistake in the patent, that was (2) incurred through the fault of the Patent and Trademark Office, which mistake is (3) clearly disclosed by the records of the Office. See 35 U.S.C. § 254. “The Office, however, has discretion under 35 U.S.C. 254 to decline to issue a Certificate of Correction even though an Office mistake exists.” See MPEP § 1480. Moreover, Superior at 1680 notes for applicants “the critical importance of reviewing claims” before the allowed claims issue. See Chef America Inc. v. Lamb-Weston Inc., 358 F.3d 1371, 1373 (Fed Cir. 2004) (quoting underlying district court decision, “[i]t is the job of the patentee, and not the court, to write patents carefully and consistently.”). See also In re Lambrech, 202 USPQ 620, 621 (Comm'r Pat. 1976)(noting the duties of an Applicant in correctly prosecuting an application, “He cannot neglect this duty and then, if the Office fails to notice and correct his oversight, be relieved of the consequences by claiming Office mistake...the primary responsibility to make the insertion rests with the applicant. His failure to make it is not correctable by way of 37 CFR 1.322.”

Certificate of Correction Branch, based upon the examiner's determination, noted that the requested changes would result in a change in claim scope. Such claims were not previously examined or issued by the USPTO, and involve questions of obviousness that were identified in relation to the original claims. Appropriately, Certificate of Correction Branch denied the request.

#### DECISION

For the reasons given above, the decision of Certificate of Correction Branch was proper in refusing the requested correction. The petition is granted to the extent that the decision of Certificate of Correction Branch has been reviewed, but is **denied** as to any modification thereof or issuance of a Certificate of Correction. While the requested correction will not be forthcoming under 35 U.S.C. §§ 254 or 255, petitioner may yet obtain relief under 35 U.S.C. § 251.

This decision may be considered a final agency action within the meaning of 5 U.S.C. § 704 for purposes of obtaining judicial review. See MPEP 1002.02. The USPTO will not further consider or reconsider this matter.

Any inquiries concerning this communication may be directed to Christopher Bottorff at (571) 272-5092.

A handwritten signature in black ink, appearing to read "Charles Pearson", with a long horizontal flourish extending to the right.

Charles Pearson  
Director, Office of Petitions

db/bh

**CERTIFICATION UNDER 37 C.F.R. § 42.24(d)**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a true and correct copy of the foregoing paper was served by December 4, 2020, by delivering a copy via electronic mail on the following attorneys of record.

[sfisher@wc.com](mailto:sfisher@wc.com)

[jberniker@wc.com](mailto:jberniker@wc.com)

[smahaffy@wc.com](mailto:smahaffy@wc.com)

[asheh@wc.com](mailto:asheh@wc.com)

[bgenderson@wc.com](mailto:bgenderson@wc.com)

[ebaumgarten@wc.com](mailto:ebaumgarten@wc.com)

[azolan@wc.com](mailto:azolan@wc.com)

[kzullo@goodwinprocter.com](mailto:kzullo@goodwinprocter.com)

[sfischer@goodwinprocter.com](mailto:sfischer@goodwinprocter.com)

[jwong@winston.com](mailto:jwong@winston.com)

[ZCohen@winston.com](mailto:ZCohen@winston.com)

[CKlein@winston.com](mailto:CKlein@winston.com)

[Cfundakowski@winston.com](mailto:Cfundakowski@winston.com)

[rfaegenburg@lerner david.com](mailto:rfaegenburg@lerner david.com)

[tvanbuskirk@lerner david.com](mailto:tvanbuskirk@lerner david.com)

[mteschner@lerner david.com](mailto:mteschner@lerner david.com)

[ERapalino@goodwinlaw.com](mailto:ERapalino@goodwinlaw.com)

*/s Jitendra Malik/*

Jitendra Malik, Ph.D. (Reg. No. 55,823)