

Correction of Patents

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Overview: Three Options

- Certificate of Correction
- Reissue
- Reexamination in view of the America Invents Act (AIA)

Certificate of Correction

Certificate of Correction

- To correct errors of minor character in an issued patent
- Results in a separate document including the correction
- Certificate is issued under seal by the United States Patent and Trademark Office (USPTO)
- May request certificate at anytime during life of the patent

Examples

- Typographical errors in the claims
 - No new matter
 - Must not require reexamination
- Inventorship / Assignee information
- Priority information

Superior Fireplace Co. v. Majestic Prods. Co. et al.

- Patentee is the owner of U.S. Patent No. 5,678,534, which relates to gas fireplace technology.
- Claim 1: “. . . a firebox within the housing comprising a top wall, **rear walls** and side walls, said firebox forming a primary combustion chamber”

Superior Fireplace Co. v. Majestic Prods. Co. et al.

- Shortly after Patentee sued Competitor for patent infringement, Competitor pointed out that claim 1 requires “rear walls” (plural) and not “rear wall” (singular).
- Patentee attempted to file a request for a certificate of correction to change “rear walls” to “rear wall.”

Superior Fireplace Co. v. Majestic Prods. Co. et al.

- First, Patentee filed a request for a certificate of correction under 35 U.S.C. § 245 (PTO mistake), which was denied by the USPTO.

Certificate of Correction

- 35 U.S.C. § 245: Certificate of correction of Patent and Trademark Office mistake
 - Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent.
 - Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.
 - The Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

Superior Fireplace Co. v. Majestic Prods. Co. et al.

- Next, Patentee filed a request for a certificate of correction under 35 U.S.C. § 255 (Applicant mistake), which was granted by the USPTO.
- The certificate of correction amended claim 1 to change “rear walls” to “rear wall.”

Certificate of Correction

- 35 U.S.C. § 255: Certificate of correction by 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 re-examination.
 - Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

Superior Fireplace Co. v. Majestic Prods. Co. et al.

- Issue: is the certificate of correction changing “rear walls” to “rear wall” valid under 35 U.S.C. § 255?

Superior Fireplace Co. v. Majestic Prods. Co. et al.

- “[A] mistake in a claim the correction of which broadens the scope of coverage of that claim and is not clearly evident from the specification, drawings, and prosecution history is not a **‘mistake of a clerical or typographical nature’** subject to correction under 35 U.S.C. § 255.”

270 F.3d 1358, 1376 (Fed. Cir. 2001).

Superior Fireplace Co. v. Majestic Prods. Co. et al.

- A change from “rear walls” to “rear wall” broadens the scope of the claim.
- Support for “rear wall” is not clearly evident from the specification, drawings or prosecution history.

Superior Fireplace Co. v. Majestic Prods. Co. et al.

- “[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.”

270 F.3d 1358, 1376 (Fed. Cir. 2001).

Superior Fireplace Co. v. Majestic Prods. Co. et al.

- Because changing the phrase from plural to singular broadens the scope of the claim, it is not a “mistake of . . . minor character.”

Superior Fireplace Co. v. Majestic Prods. Co. et al.

- Holding: The certificate of correction changing “rear walls” to “rear wall” is invalid under 35 U.S.C. § 255.

Certificate of Correction

- A certificate of correction is a viable means to correct an error in a patent that incidentally broadens the scope of a claim.
- However, such broadening is allowed only if there is support in the specification, drawings, or prosecution history.
- If a mistake affects claim scope, it usually must be corrected by reissue.

Reissue

Two Types

- Broadening reissue
 - Two years from date of issuance
- Narrowing reissue
 - Anytime during life of the patent

Reissue: Current Law

- 35 U.S.C. § 251: Reissue of defective patents
 - Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent **for the invention disclosed in the original patent**, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.
 - The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.
 - The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.
 - No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within **two years** from the grant of the original patent.

Reissue: Amendment Effective September 16, 2012

- 35 U.S.C. § 251: Reissue of defective patents
 - Substantially the same as the current law
 - “without any deceptive intention” language has been removed
 - Minor formatting changes to add subheadings

Requirements

- Surrender of the original patent
 - To be replaced by the reissued patent if one is granted
- Error made must be explicitly stated, and evidence provided
 - Reissue declaration by inventors
- Special formatting rules during reissue prosecution

Effect of Reissue

- Surrender of the original patent takes effect upon the issuance of the reissue patent.
- Parties with intervening rights are not liable for the infringement of claims that were broadened during reissue.

Examples

- Failed to claim a categorical set
 - e.g., patentee claimed an apparatus and a compound, but failed to claim a method of making the compound
 - The specific error would be that the patentee failed to obtain protection for the method category.
- Any errors the correction of which would affect claim scope.

Reexamination

Types of Reexamination

- There are two types of reexamination of issued U.S. patents before the U.S. Patent and Trademark Office (USPTO):
(1) *ex parte* reexamination, and
(2) *inter partes* reexamination.

Ex parte Reexams

- Requested by the patentee, a third party or the USPTO
- Third party requestor does not participate in the *ex parte* reexamination proceedings.
- Can be anonymously filed
- Typically used by patent owner to strengthen patent

Ex parte Reexams

- Remain unchanged with the AIA
- The USPTO will grant an *ex parte* reexamination request only if “a substantial new question of patentability affecting any claim of the patent concerned is raised by the request.”
 - 35 U.S.C. §303(a)(2002).

SNQ Standard

- Ultimately, the Federal Circuit interpreted SNQ as “a question which has never been considered by the PTO.”
- (1) Can a prior art reference raise a SNQ of patentability despite having been considered in previous infringement litigation? **YES**
- (2) Can a prior art reference raise a SNQ of patentability despite having been considered in previous USPTO proceedings? **YES**

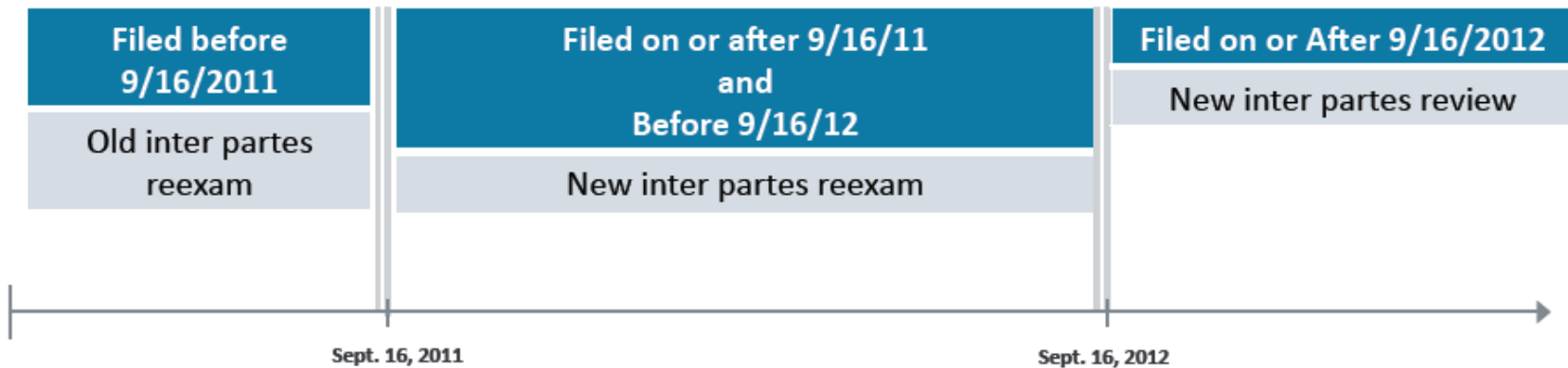
Inter partes Reexams

- *Inter partes* reexams can be requested by third parties for a patent issued from an original application filed on or after November 29, 1999.
- Third party requestors do participate in the *inter partes* reexam process by filing a reply to each response filed by the Patentee.
 - Third Party remains involved for length of reexamination.

Inter partes Reexams

- Significantly changed by the AIA
- New higher standard of proof
- Valid from September 16, 2011 to September 16, 2012, to be replaced by *inter partes* review (part of the post-grant review group) after 9/16/12.

Inter Partes Reexamination (Transition)



Inter partes Reexams

- A request for *inter partes* reexamination will not be granted unless the information presented in the request shows that there is a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request.
 - Old standard was SNQ

Inter partes review

- Post September 16, 2012
- Requires a “petition” for *inter partes* review to be filed
 - *inter partes* review proceedings are to be held before the Patent Trial and Appeal Board
- Standard is believed to remain reasonable likelihood of success on the merits.
- Petitions for *inter partes* review are permitted at the later of 9 months from the grant date of a patent or reissued patent, or the date of termination of post-grant review (§ 311(c)(1) or (2)).
- Director's decision whether to grant *inter partes* review cannot be appealed (§ 314(d)).

Inter partes review

- *Inter partes* review petitions cannot be filed anonymously, requiring identification of all real parties in interest and must identify "in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence supporting the challenge to each claim" (§ 312(a)(3)).
- The petition must be accompanied by copies of all patents or printed publications and any affidavits containing supporting evidence or opinion (§§ 312(a)(3)(A) and (3)(B)), as well as "any other information that the Director may require by regulation" (§312(a)(4)).

Inter partes review

- Prohibits grant of *inter partes* review to a petitioner who has filed a "civil action challenging the validity of a claim of the patent" (§ 315(a)(1)) (which includes declaratory judgment actions but expressly excludes counterclaims in patent infringement litigation; § 315(a)(3)).
- An *inter partes* review can be terminated by settlement (§ 317) or decision of the Board (§ 318).

Case Study: An Example

CBT Flint Partners, LLC v. Return Path, Inc.

- Patentee is the owner of U.S. Patent No. 6,587,550, which relates to systems and methods for charging a fee for sending “spam” to e-mail recipients.
- Claim 13: “. . . a computer in communication with a network, the computer being programmed to **detect** **analyze** the electronic mail communication sent by the sending party to determine whether or not the sending party is an authorized sending party or an unauthorized sending party”

CBT Flint Partners, LLC v. Return Path, Inc.

- Different interpretations
 - “detect”
 - “analyze”
 - “detect and analyze”

CBT Flint Partners, LLC v. Return Path, Inc.

- “Because each of the three proposed reasonable interpretations would result in the same claim scope, requiring that the computer be programmed to ‘detect and analyze’ the e-mail, a person of skill in the art would readily know that the meaning of the claim requires insertion of the word ‘and’ between the words ‘detect’ and ‘analyze.’”

654 F.3d 1353 (Fed. Cir. 2011).

CBT Flint Partners, LLC v. Return Path, Inc.

- Claim 13: “. . . a computer in communication with a network, the computer being programmed to **detect** the electronic mail communication sent by the sending party to determine whether or not the sending party is an authorized sending party or an unauthorized sending party. . . .”

CBT Flint Partners, LLC v. Return Path, Inc.

- Claim 13: “. . . a computer in communication with a network, the computer being programmed to ***analyze*** the electronic mail communication sent by the sending party to determine whether or not the sending party is an authorized sending party or an unauthorized sending party. . . .”

CBT Flint Partners, LLC v. Return Path, Inc.

- Claim 13: “. . . a computer in communication with a network, the computer being programmed to ***detect and analyze*** the electronic mail communication sent by the sending party to determine whether or not the sending party is an authorized sending party or an unauthorized sending party. . . .”

CBT Flint Partners, LLC v. Return Path, Inc.

- Holding: Claim 13 is not indefinite because there is an obvious and correctable error in the claim, the construction of which is not subject to reasonable debate.

CBT Flint Partners, LLC v. Return Path, Inc.

- Filing a request for a certificate of correction to correct obvious errors may avoid unnecessary litigation.
- If a claim error leads to multiple reasonable interpretations having different claim scope, then the claim may be rendered indefinite under 35 U.S.C. § 112, ¶ 2.

Practice Tips for Avoiding Correction of Patents

- Provide adequate written description.
 - to ensure support for prospective claim amendments
- Proofread allowed claims at the time of Notice of Allowance.
 - Proofread Letters Patent
- Check for desire to file continuing applications during the pendency of the parent to avoid reissue.

THE END