

ALERT

Federal Circuit Patent Bulletin: *In re Dinsmore*

June 17, 2014

"[35 U.S.C. § 251 does not authorize reissue where the asserted error is] no more than an effort to reverse a later-regretted choice made in obtaining the original patent."

On June 10, 2014, in *In re Dinsmore*, the U.S. Court of Appeals for the Federal Circuit (Taranto,* Bryson, Hughes) affirmed the USPTO Patent Trial and Appeal Board's decision upholding the patent examiner's rejection of Dinsmore's application seeking reissue under 35 U.S.C. § 251 of U.S. Patent No. 7,236,568, which related to a miniature x-ray source with improved output stability and voltage standoff, to modify the recorded terminal disclaimer to U.S. Patent No. 6,658,086. The Federal Circuit stated:

The applicants argue that, because the '568 and '086 patents are not and never have been commonly owned, the recorded terminal disclaimer was "an ineffective, invalid terminal disclaimer" and its filing therefore was an "error" within the meaning of the reissue statute, 35 U.S.C. § 251. . . . The terminal disclaimer promises that the '568 patent "shall be enforceable only for and during such period that it and the prior patent [i.e., the '086 patent] are commonly owned." That promise, which is clear on its face, can readily be given effect: the patent will not be enforced except when owned by the owner of the '086 patent. And the applicants, by filing the disclaimer, achieved the immediate effect of overcoming the obviousness-type double-patenting rejection.

At the same time, the terminal disclaimer was valid. The applicants identify nothing missing that was required or anything included that was forbidden. Under the relevant PTO regulation, "to obviate judicially created double patenting in a patent application" a terminal disclaimer must "[i]nclude a provision that any patent granted on that application . . . shall be enforceable only for and during such period that said patent is commonly owned with the . . . patent which formed the basis" for the rejection. The terminal disclaimer at issue here did just that: it made the required promise about what would happen if the two patents at issue were ever separately owned. It thereby fulfilled a purpose of the bar on obviousness-type double patenting—"to prevent multiple infringement suits by different assignees.

At bottom, therefore, the applicants can only be arguing, more broadly, that the disclaimer was “ineffective” in the sense that it did not produce a patent they could actually enforce by themselves (without common ownership) and that they erred in producing that result (which they deem to be inoperativeness) by choosing to file the terminal disclaimer in order to include in the ‘568 patent, in their final form, the four claims that led to the obviousness-type double-patenting rejection. This argument, however, is an insufficient basis for reissue, even if the condition of present inability to enforce constitutes inoperativeness within the meaning of section 251. It is ultimately no more than a statement of a now-regretted choice, because the applicants identify no cognizable false or deficient understanding of fact or law that underlay the choice. This is not “error” as required by section 251.

Section 251 requires not only that the original patent be “wholly or partly inoperative or invalid,” and that the inoperativeness or invalidity be by reason of a defective specification or drawing or unduly broad or narrow claiming, but that “error” be the cause of the infirmity. Section 251 often applies to applicants’ choices, i.e., their deliberate decisions about what to say in their patents, not just slips of the pen. But not every choice that produces inoperativeness or invalidity by reason of a specification, drawing, or claiming problem (within the meaning of section 251) can qualify. Only choices based on “error” count. . . .

A focus on the understandings behind a patentee’s choices during the patenting process may not resolve all “error” issues. But that focus suits this case. Here, the applicants have not identified any deficient understanding as leading to the issuance of original claims 1, 16-17, and 21 with the terminal disclaimer.

Thus, the applicants simply have not alleged or shown that they had a mistaken belief as to the invalidity of those claims on the cited ground of obviousness-type double patenting in the absence of the disclaimer or, therefore, the choice they faced: cancel or sufficiently modify those claims to avoid the rejection; or file the disclaimer. They have not alleged or shown that they did, let alone reasonably could, misunderstand the plain meaning of the disclaimer. They also have not alleged or shown that their choice in favor of filing the disclaimer resulted from any mistaken belief that the ‘568 and ‘086 patents were in fact commonly owned. The applicants never declared, and do not show here, that they believed that such common ownership existed when they filed the terminal disclaimer to obtain the ‘568 patent.

From all that appears, the applicants—knowing that the patents were not commonly owned—intentionally surrendered a possible right (the ability to obtain all or some of the ‘568 patent claims in a form enforceable independently of the ‘086 patent) in exchange for a benefit (overcoming an obviousness-type double-patenting rejection of several of the proposed claims). On the record of this case, applicants are ultimately seeking

simply to revise a choice they made, not to remedy the result of a mistaken belief. Theirs is not an error remediable under the reissue statute. . . .The Board's decision rejecting the application for reissue is affirmed.