

Reissue “Error” and “Analogous Art” for Obviousness Rejection

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Precedential Federal Circuit Opinions

- In Re Dinsmore, decided June 10, 2014
 - Addresses what constitutes an “error” within the meaning of 35 U.S.C. § 251
- Scientific Plastic Products, Inc., v. Biotage AB, decided September 10, 2014.
 - Addresses what constitutes analogous art for purposes of an obviousness rejection

In Re Dinsmore -Background

Mark Dinsmore and David Caruso are the named inventors of U.S. Patent No. 7,236,568 ('568 Patent)

- The '568 Patent issued from application serial no. 11/087,271 filed on March 3, 2005.
- Assignment from inventors to TWX, LLC was executed on May 9, 2007 and recorded with the PTO on May 18, 2007.
- An Office action issued September 13, 2006 rejected claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over USPN. 6,658,086 to Mark Dinsmore ("Dinsmore") and claims 18-20 as being unpatentable over the '086 patent in view of USPN 5,153,900 to Nomikos et al.
- The Office action also rejected claims 1, 2, 7, 8, and 10-17 under 35 USC § 102(e) anticipated by Dinsmore and claims 18-20 under 35 USC § 103(a) as being unpatentable over the combination of Dinsmore and Nomikos.

In Re Dinsmore – Background Con't

Claims 3-6 were indicated as containing allowable subject matter.

In response

- a terminal disclaimer from the inventor's Mark Dinsmore and David Caruso was was filed; and
- Claims 1 and 20 were amended to include allowable subject matter of canceled claim 3;
- Claims 11 and 17 were re-written independent form; and
- Applicants argued that the terminal disclaimer overcome the double-patenting rejection; that claim 1 included allowable subject matter and Dinsmore failed to teach the additional limitations of claims 11 and 17.

The Application was allowed and issued on June 26, 2007.

Problem with issued patent

The terminal disclaimer filed in response to the Office action states

“The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent [i.e., the ‘086 Patent] are commonly owned”; and

the two patents are not nor ever have been commonly owned.

The ‘568 patent is owned by TWX, LLC whereas, the ‘086 Patent is owned by Carl Zeiss AG

Solution – File Reissue Application

On June 12, 2008, a reissue application was filed stating at least one error as being:

“Applicants inadvertently and without deceptive intent filed a Terminal Disclaimer over Patent No. 6,658,086, which patent was not commonly owned by the owners of Patent No. 7,236,568 currently at issue.”

No amendments to the claims or Specification were submitted only a letter requesting “the terminal disclaimer be stricken from the instant patent.”

PTO – Rejected Applicants' Solution

An Office action was issued rejecting claims 1-21 as being based upon a defective reissue declaration under 35 USC 251 because the stated error is not an error upon which a reissue can be based. Claims 1-21 were also rejected under 35 USC 251 as being an improper recapture of broadened claimed subject matter surrendered in the application based on attempt to remove the terminal disclaimer.

Applicants Revised Their Strategy

- Applicants filed a supplemental declaration checking “by reasons of the patentee claiming more or less than he had the right to claim in the patent” and stating at least one error as:
“Original claims 1 and 18-20 were rejected on the ground of non-statutory obviousness-type double patenting and allowed based on an ineffective, invalid terminal disclaimer. The allowance of issued claims 1 and 18-20 based on the original claims was in error.”
- Claims 1 and 18-20 were also canceled; and
- A petition to accept a revised terminal disclaimer excluding the common ownership statement was filed.

PTO – Rejected Revised Strategy

The PTO denied the Petition to replace the terminal disclaimer stating:

- “The mechanism to correct a patent ...reissue (35 U.S.C. 251)...are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer”
- “[T]he terminal disclaimer filed with the present petition is not acceptable because it is not signed by anyone.” and
- “[T]he public may rely upon the existence of the requirement for the common ownership of the '568 patent and U.S. Patent No. 6,658,086 (the '086 patent)...No authority exists for withdrawal of this provision [i.e., common ownership] which the public is justified in relying upon.”

PTO – Rejected Revised Strategy

Patent Office rejects claims 2-15 , 18-20 and 22-25 as being based upon a defective reissue declaration stating that

- “[t]he mechanism to correct a patent – ...reissue (35 U.S.C. 251)...- are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer.”
- “Where applicants did not challenge the propriety of the examiner’s nonstatutory double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of 35 U.S.C. 251.

Applicants Appealed to the PTAB

Appellant's statement of the issue on appeal:

- whether patentee can remedy the filing of an incorrect Terminal Disclaimer by canceling the claims rejected under obviousness double patenting and filing a terminal disclaimer disclaiming the term that differs from the term of the not commonly owned patent appearing in the first Terminal Disclaimer

Appellant's Arguments

- The invalid terminal disclaimer renders the patent unenforceable.
- Patentee failed to present narrower claims as a hedge against unenforceability.
- Patentee is not requesting a complete withdrawal of the TD, but rather replacement of the incorrect TD with a corrected TD disclaiming the same term.
- Patentee is not trying to recapture claims that originated from original claims 1 and 18-20.
- The reissue statute is remedial in nature and should be construed liberally.

PTAB Affirmed Examiner

PTAB's statement of the issue:

- Whether Appellants' voluntary and intentional filing of a terminal disclaimer to overcome a non-statutory obviousness-types double patenting rejection during prosecution of the original patent is an "error" correctable by reissue under 35 U.S.C. § 251.

PTAB's rationale

- Case law holds that the deliberate action of an inventor or attorney during prosecution generally fails to qualify as a correctable error under § 251.

PTAB's Rationale Con't

- The terminal disclaimer is akin to a contract in which Appellants agreed that the '568 patent is unenforceable unless commonly owned with Dinsmore and the fact that they are not commonly owned does not render the promise ineffective or invalid.
- The present case differs from *In Re Tanaka* because
 1. Appellants have replaced the original broader claims with narrowing claims, not added a narrow claim to the original claims as in *Tanaka*
 2. In *Tanaka* the added narrower claim was a hedge against *invalidity* of the broader claims, not enforceability of the patent as a whole.

Applicants Appealed to Fed. Cir.

The Court affirmed the Board's ruling "because the applicants have not identified an 'error' underlying the choices made in the original patent that they now seek to revise."

Federal Circuit Analysis

The error asserted in the reissue declaration was “that the recorded terminal disclaimer was ineffective or invalid”

- Not ineffective because (1) the promise, i.e., enforceable only for and during common ownership, which is clear on its face, can readily be given effect and (2) Applicants, by filing the disclaimer, achieved the immediate effect of overcoming the obviousness-type double-patenting rejection.
- Not invalid because Applicants identify nothing missing that was required or anything included that was forbidden in the TD (i.e., it met the requirements of 37 CFR 1.321(c))

Applicants’ ineffective argument is predicated on the assertion that the disclaimer was “ ineffective” because it did not produce a patent they could actually enforce without common ownership. However, even if the inability to enforce constituted inoperativeness within the meaning of § 251 there is no “error” as required by § 251

Federal Circuit Analysis Con't

- “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.”
- “[I]t is important whether deficient understandings, by the applicants or their agents, gave rise to the patenting choice that reissue is being involved to correct.”
- Typical situations of acceptable error are (for broadening reissue) the “post-issuance discovery of attorney error in understanding the scope of the invention” and (for a narrowing reissue) the “belated discovery of partially invalidating prior art”
- However, in “cases where the applicants identified no deficient understanding behind a choice” the Court has held the reissue application “inadequate as being no more than an effort to reverse a later-regretted choice made in obtaining the original patent.”
- A focus on the understanding behind a patentee’s choices during the patenting process may not resolve all “error” issues, but suits this case.

Possible Errors the Court Noted Were Not Alleged or Shown

- Mistaken belief as to the invalidity of those claims on the cited ground of obviousness-type double patenting in the absence of the disclaimer;
- Misunderstood the plain meaning of the disclaimer;
- That the decision to file the TD resulted from any mistaken belief that the '568 and '086 patents were in fact commonly owned.

Lessons to be Learned

Think twice before filing a terminal disclaimer.

Establish error/deficiency in “understanding” to support error to be corrected in reissue applications.

Don't file a terminal disclaimer to overcome an obviousness-type double patenting rejection that you have already overcome by amendment.

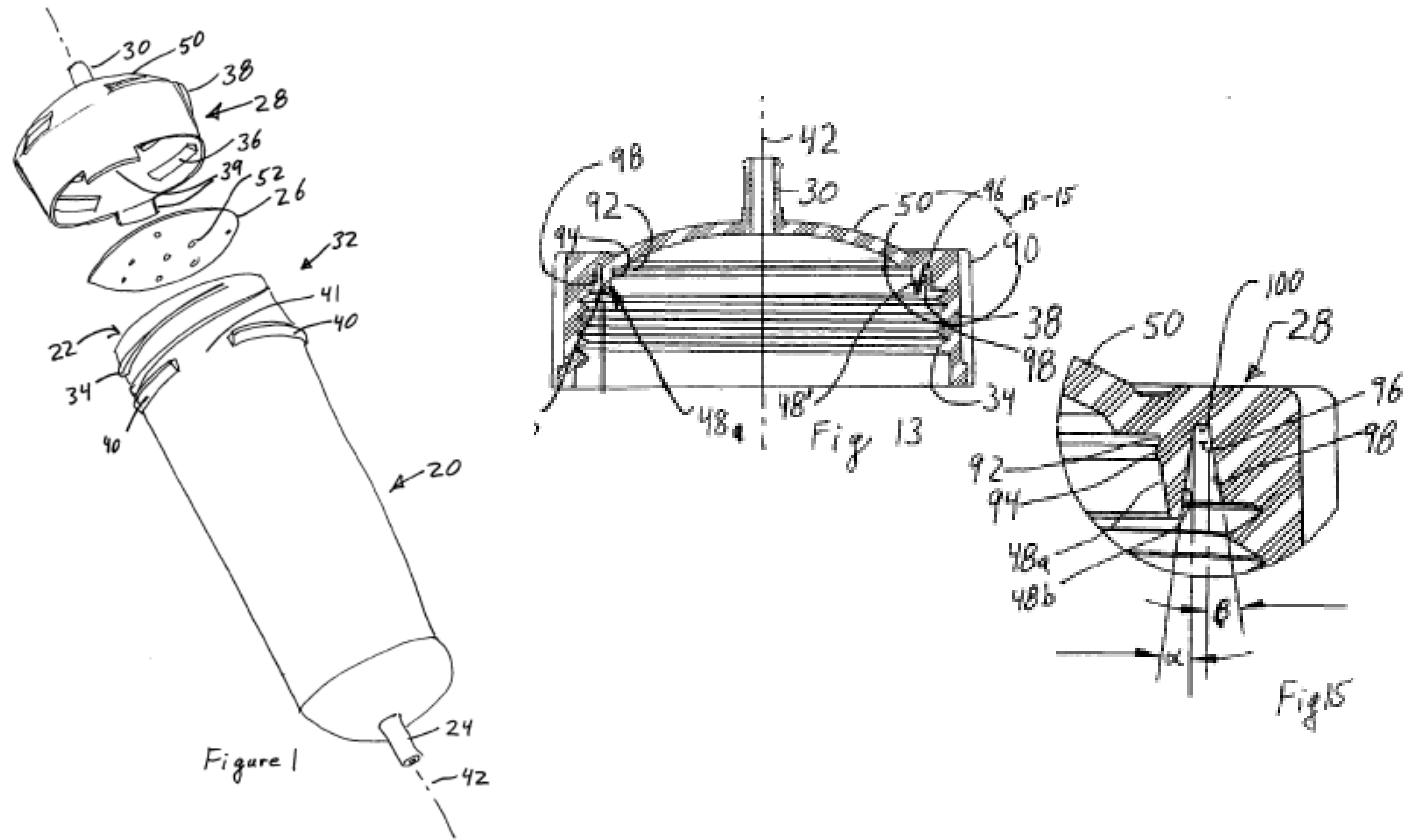
Scientific Plastics Products v. Biotage AB

Scientific Plastics Products, Inc. (“Plastics”) is the owner of three US patents relating to a resealable cartridge for low pressure liquid chromatography (LPLC). One patent is directed to a method of performing LPLC using the cartridge, one is directed to the cartridge, and the third is directed to a modified cartridge.

After Plastics filed suit against Biotage for infringement, Biotage requested an *inter partes* reexamination.

The Examiner rejected all the claims on the ground of obviousness, the PTAB affirmed the Examiner and cancelled all the claims, and the Fed. Cir. affirmed the PTAB’s decisions.

Representative Cartridge from '327 Patent



Prior Art Caps

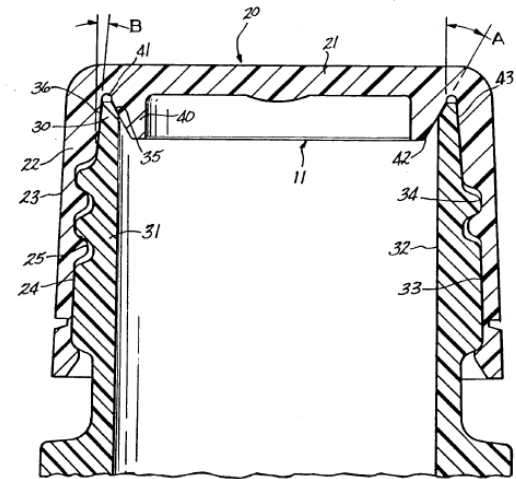
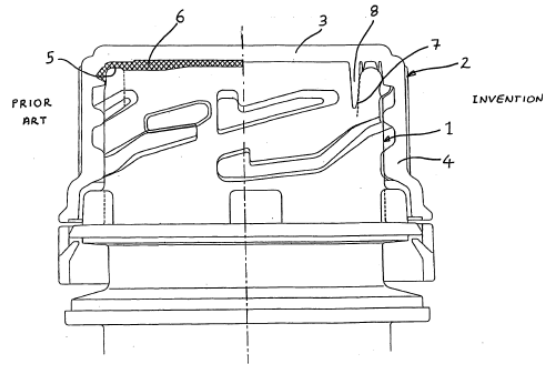
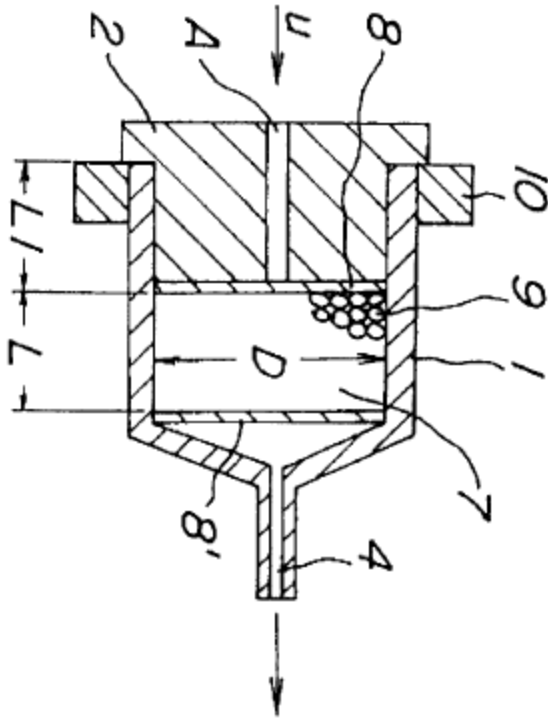


FIG-2

Obviousness Issue

The primary issue on reexamination was the obviousness of combining the LPLC cartridge disclosed in Yamada with the pressure-resistant cap of King or Strassheimer.

Primary Reference - Yamada

U.S. Patent No. 5,693,223 discloses:

- an LPLC cartridge having a tubular polymer container with an open upstream end and an outflow at the downstream end;
- a threaded polymer cap for the cartridge that is “detachably” fitted to the corresponding threaded upstream end of the cartridge body; and
- an O-ring in the cap to ensure liquid tightness.

U.S. Patent No. 5,693,223 fails to disclose:

- The complementary inclined sealing surfaces of the cap and the lip of the container

1st Secondary Ref. - King

WO 2002/42171 A1

- Relates to “improved seals for container closure assemblies” and is “especially applicable to the sealing of containers in substantially gas-tight and liquid-tight fashion, such as the sealing of...beverage containers.”
- Discloses a “container closure assembly” with a threaded polymer cap that ensures a fluid tight seal. The Examiner found that the sealing surfaces have oppositely inclined surfaces with respect to the cap and lip of the container.

2nd Secondary Ref. - Strassheimer

U.S. Patent No. 5,100,013

- Relates to plastic bottles and closures therefore that are “especially useful for carbonated beverages.”
- Discloses a plastic threaded cap that ensures a fluid tight seal “even after repeated use.” The Examiner found that a taper on the lip of the plastic container that corresponds to a taper on the cap.

Plastics challenge on Appeal

Plastics challenged

1. The examiner's determination that King and Strassheimer were "analogous art"; and
2. That it would have been obvious to combine the LPLC cartridge of Yamada with the pressure-resistant resealable cap of either King or Strassheimer

Fed. Cir. Analysis

Criteria for determining whether prior art is analogous may be summarized as

1. whether the art is from the same field of endeavor, regardless of the problem addressed, and
2. if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

“Reasonably Pertinent” the Issue

“A reference is reasonably pertinent if...it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection”

The Board's Support

The Board concluded that a person of ordinary skill seeking a cartridge that would allow a user to easily vary and access the cartridge's contents without destroying its ability to be sealed and function under LPLC pressures would reasonably look to sealing arrangements for other pressurized systems.

The Board's Support Con't

- When the problem an invention is designed to solve is not unique to the specific field of the invention, it is not improper for the trier of fact to consider whether a person of ordinary skill would consult a different art in order to solve the problem.
- The known problem of leakage in threaded connections of plastic LPLC cartridges under pressure identified in the patents provides a reason for one of ordinary skill in the art to have turned to King or Strassheimer to improve the sealing arrangement set forth in Yamada

Majority Opinion

The issue here is not whether the Yamada cartridge leaked, but whether there is a concern with leakage in LPLC cartridges such that a person of ordinary skill would have provided a known pressure-resistant cap, as in King and Strasseheimer, to the cartridge of Yamada.

There was substantial evidence to support the Board's finding that there was such a concern.

Dissenting Opinion

- These were contested *inter partes* reexaminations with experts on both sides, yet there is no testimony or other evidence of a known leakage problem in prior art cartridges that would have motivated one of skill in the art to modify Yamada.
- Even Biotage's expert admitted that Yamada's configuration did not have leakage problems at the pressures identified by the patents-at-issue.

Dissenting Opinion Con't

- There is no evidence even suggesting that one skilled in the art was aware of a leakage problem in Yamada's design during the ten years between Yamada's earliest priority date and the earliest priority date of the patents-at-issue.
- The Board's conclusion that Yamada's O-ring "implicitly" acknowledges a "potential" leakage problem is pure conjecture.

Dissenting Opinion Con't

- It is troubling that the majority and the Board rely on the inventors' disclosure of the problem *their inventions solve* as the primary basis for modifying the prior art.
- The Board found the claims obvious without resolving the level of skill in the art despite the fact that the parties contested this factual issue throughout the proceedings.

Questions?