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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHUNPEI YAMAZAKI

Appeal 2010-002033
Application 10/045,902
Patent 6,180,991 B1
Technology Center 2800

Before: JAMES T. MOORE, *Acting Chief Administrative Patent Judge*,
RICHARD E. SCHAFER, ADRIENE LEPIANE HANLON,
JENNIFER D. BAHR, ALLEN R. MACDONALD, LINDA E. HORNER,
and MARC S. HOFF, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

Concurring opinion filed by HANLON, *Administrative Patent Judge*, with
whom BAHR, *Administrative Patent Judge*, joins.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

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STATEMENT OF THE CASE

Shunpei Yamazaki (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision in reissue application 10/045,902 ("the '902 application"). This reissue application seeks to reissue U.S. Patent 6,180,991 B1 ("the '991 patent"), issued January 30, 2001, based on Application 08/426,235 ("the '235 application"), filed April 21, 1995.

The '991 patent issued with claims 1-35, which correspond to claims 1-35 currently pending in this reissue application on appeal. The '991 patent, col. 9, l. 44 - col. 14, l. 3; App. Br. Evidence App'x A. By this reissue, Appellant attempts to withdraw a terminal disclaimer that was filed during prosecution of the '991 patent. The Examiner rejected reissue claims 1-35 as based on a defective reissue oath or declaration for lack of error correctable under 35 U.S.C. § 251. We have jurisdiction under 35 U.S.C. § 6(b).

Though we are mindful of the prosecution delays suffered by Appellant, we are constrained by the plain meaning of the reissue statute to deny the redress Appellant seeks. We AFFIRM.

ISSUE

The Examiner concluded that Appellant failed to state an "error" correctable by reissue under 35 U.S.C. § 251 because reissue may not be used to nullify the effect of a terminal disclaimer recorded in an issued patent. Ans. 5.

Appellant argues that reissue under 35 U.S.C. § 251 is permissible because the terminal disclaimer became unnecessary by virtue of amendments made to the claims during the original prosecution of the patent

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and because Appellant petitioned to withdraw the terminal disclaimer prior to issuance of the patent. App. Br. 10-21; Reply Br. 1-6.

The issues before us are:

Does 35 U.S.C. § 251 authorize the Office to reissue a patent that has expired based on an expiration date set at the time of issuance of the original patent?

Does 35 U.S.C. § 251 authorize the Office to expand in reissue the term of a patent beyond the term of the original patent set at the time of issuance?

BACKGROUND

The '235 application was filed on April 21, 1995. The '991 patent. During the prosecution of the '235 application, Appellant filed a terminal disclaimer (“the Terminal Disclaimer”) to overcome an obviousness-type double patenting rejection. *See* App. Br. Evidence App’x E.4 Terminal Disclaimer (filed November 27, 1996).

Subsequent to filing the Terminal Disclaimer, Appellant amended the claims.² While the '235 application was still pending, Appellant filed a *Petition Under 37 C.F.R. § 1.182 to Withdraw a Terminal Disclaimer*³ (“the Petition”), contending that the amendment altered the claims so that the obviousness-type double patenting rejection was no longer applicable.

While the Petition was pending, a Notice of Allowance of the '235 application was mailed, and in reply, Appellant elected to pay the issue fee.

² Appellant added the phrase “not lower than 4×10^{15} atoms/cm³” to the claims. App. Br. 10.

³ The Petition was filed on April 9, 1999. App. Br. Evidence App’x E.1.

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The '235 application issued as the '991 patent on January 30, 2001. The '991 patent.

After the '991 patent issued, and 21 months after the Petition had been filed, the United States Patent and Trademark Office (USPTO) dismissed the Petition.⁴ The decision dismissing the petition states that, unfortunately, the requested relief could not be considered because the USPTO will not remove a recorded terminal disclaimer once a patent issues.⁵

Appellant filed a *Request for Reconsideration of Petition under 37 C.F.R. § 1.182 to Withdraw a Terminal Disclaimer*, which was denied.⁶ This decision repeated that the USPTO will not remove a recorded terminal disclaimer once a patent issues.⁷

Following the decision on reconsideration, Appellant filed an application for reissue of the '991 patent on January 16, 2002. The '902 application. The errors upon which the reissue application were based are: (1) Appellant's error in failing to ensure proper disposition of the Petition to Withdraw during the prosecution of the '235 application, (2) Appellant's error in not withdrawing the '235 application from issuance before payment of the issue fee, (3) Appellant's error in not withdrawing the '235 application from issuance after the payment of the issue fee, (4) Appellant's error in not deferring issuance of the patent until the outstanding Petition to

⁴ *Decision on Petition* dated May 10, 2001.

⁵ *Id.* (citing to Manual of Patent Examining Procedure (MPEP) § 1490(B), which would have been the 7th ed., Rev. 1 (Feb. 2000)).

⁶ *Decision Denying Petition* dated November 8, 2001.

⁷ *Id.* at 5. The decision also noted that reissue under 35 U.S.C. § 251 is not available to withdraw or otherwise nullify a recorded Terminal Disclaimer. *Id.*

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Withdraw was considered, and (5) USPTO's error in failing to consider and act upon the Petition to Withdraw prior to issuance of the '991 patent. App. Br. Evidence App'x E.7 Reissue Declaration. Appellant has not filed a petition to withdraw the terminal disclaimer in this reissue application. The '902 application. Unfortunately, the processing of the reissue application, like that of the Petition in the '235 application, was marred by lengthy delay. See Reply Br. 5. The rejection of this reissue application is before us now.

PRINCIPLES OF LAW

35 U.S.C. § 251

Section 251 of title 35, United States Code, first paragraph, provides that:

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 language of the statute is clear and unequivocal that the Office's authority to reissue a patent under 35 U.S.C. § 251 is limited to "the unexpired part of the term of the original patent."

The Federal Circuit has held that § 251 does not permit reissue of a patent that has expired. *In re Morgan*, 990 F.2d 1230 (Fed. Cir. 1993). Morgan filed a reissue application that was rejected, *inter alia*, for containing new matter in contradiction of § 251. After affirmance of the rejection by the Board, and while Morgan's case was pending before the

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Federal Circuit, Morgan's patent expired. The Commissioner moved to dismiss the case as moot because reissue was not permitted for an expired patent. The court agreed, stating:

The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only "for the unexpired part of the term of the original patent." Thus, when Morgan's original patent expired on August 19, 1992, the Commissioner was divested of his reissue authority because there was no longer an unexpired term of the patent for which Morgan's patent could be reissued.

Id. at 1231.

35 U.S.C. § 253

Section 253 of title 35, United States Code, second paragraph, pertains to disclaimer and provides that:

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.

The Federal Circuit has recognized that under § 253 a terminal disclaimer links the expiration date of the patent subject to the terminal disclaimer to that of the patent referenced in the terminal disclaimer, so that the expiration date of the patent subject to the terminal disclaimer is "reset" to the expiration date of the patent referenced in the terminal disclaimer. *See Merck & Co. v. Hi-Tech Pharmacal Co.*, 482 F.3d 1317, 1319, 1322-23 (Fed. Cir. 2007) (holding that "computation of a Hatch-Waxman patent term extension [under 35 U.S.C. § 156] is from the expiration date resulting from the terminal disclaimer and not from the date the patent would have expired in the absence of the terminal disclaimer"); *see also Bayer AG v. Carlsbad Tech., Inc.*, 298 F.3d 1377, 1381, 1382-83 (Fed. Cir. 2002) (holding that

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“[b]ecause the URAA [Uruguay Round Agreements Act] amendments automatically changed the expiration date of the [parent patent] from October 1, 2002 to December 9, 2003, the expiration date of the [terminally disclaimed patent], which is contingent upon the expiration date of the [parent patent], also changed simultaneously to December 9, 2003”) (rehearing and rehearing en banc denied).

Notably in *Bayer*, the patentee attempted to file, post issuance, an amended terminal disclaimer to reflect the change in expiration date made by the URAA. *Id.* at 1379. The Office refused to accept the amended terminal disclaimer, taking the position that under 35 U.S.C. § 253, the terminal disclaimer is part of the original patent and the rules of practice do not provide for withdrawal of a terminal disclaimer after issuance. *Id.* at 1379-1381. Rather, the Office in *Bayer* reset the expiration date of the terminally disclaimed patent because the URAA automatically extended the term of the parent patent “by operation of law.” *Id.*

ANALYSIS

While 35 U.S.C. § 251 is a remedial statute and should be liberally construed, such interpretation must remain within the statute’s scope.⁸ Section 251 does not permit the reissue of a patent that has expired. Hence, one question before us is whether the ‘991 patent has expired.

⁸ See *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986) (citations omitted) (Section 251 “is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally”). See also *In re Morgan*, 990 F.2d 1230, 1232 (Fed. Cir. 1992) (Interpreting the phrase “unexpired part of the term of the original patent” of § 251 and observing that “[t]he fact that the intent of the reissue provision is remedial does not permit avoidance of plain statutory language.”).

Here, the Terminal Disclaimer reset the expiration date of the original '991 patent to that of the '476 patent. App. Br. Evidence App'x E.4 Terminal Disclaimer. Thus, the '991 patent expired with the '476 patent on December 22, 2003. App. Br. 10. Because there is no remaining unexpired term of the original '991 patent, the Office is not permitted by § 251 to reissue the '991 patent, and thus Appellant has failed to state an error correctable under 35 U.S.C. § 251.

Appellant contends that the facts of this case are analogous to, and perhaps present an even stronger case for correction through reissue than, the facts in *Ex Parte Durckheimer*, Appeal No. 94-2004, Application No. 07/551,615 (BPAI 1996). App. Br. 15-18; Reply Br. 3.⁹

In *Durckheimer*, a terminal disclaimer was filed to overcome an obviousness-type double patenting rejection in view of another patent. *Durckheimer* at 3, 6.¹⁰ Prior to issue, the claims that were the basis of the obviousness-type double patenting rejection were cancelled due to a restriction requirement. *Id.* at 9. After issue, *Durckheimer* filed a reissue application seeking to withdraw the terminal disclaimer. *Id.* at 11. The Examiner rejected all of the reissue claims, stating that reissue is not

⁹ Contrary to the facts in the present appeal, the Board decided *Durckheimer*'s appeal *prior to* the expiration date set by terminal disclaimer of the patent sought to be reissued. For that reason, the term of the original patent in *Durckheimer* had unexpired term remaining at the time of the Board's decision.

¹⁰ The application sought to be reissued was filed on March 30, 1978, and issued as a patent (US 4,758,556) on July 19, 1988. The terminal disclaimer reset the expiration date of US 4,758,556 (the patent sought to be reissued) to that of US 4,278,793 (the patent referenced in the terminal disclaimer), namely July 14, 1998.

available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. *Id.* at 11-12 (citing MPEP § 1490).

Durckheimer appealed this rejection to the Board. *Id.* at 2.

The Board disagreed with the Office policy set forth in section 1490 of the MPEP, on which the Examiner had relied, and found:

To the extent that this section of the MPEP is interpreted to mean that reissue is *never* available for whatever reason to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent, we find this interpretation to be inconsistent with the provisions of 35 U.S.C. § 251.

Id. at 17-18. In particular, the Board agreed with appellant's statement that:

A terminal disclaimer does not alter “the term of the original patent.” Rather, a terminal disclaimer is only a “disclaim[er] [of a] terminal part of the term, of the patent granted or to be granted.”

Id. at 19. The Board in *Durckheimer* interpreted “the term of the original patent”¹¹ of 35 U.S.C. § 251 to mean the full term of the patent granted by 35 U.S.C. § 154 without taking into account the terminal disclaimer because § 154 did not make an exception for shortening the term of a patent with regard to terminal disclaimers. *Id.* at 19. Thus, the Board determined that the reissue statute allows the Commissioner to reissue an original patent under certain circumstances. *Id.* at 18.¹²

¹¹ *Durckheimer* consistently quotes § 251 as including the phrase “unexpired term of the original patent”; however, this portion actually states “unexpired part of the term of the original patent.” See e.g., *Durckheimer* at 20; see also 35 U.S.C. § 251 (emphasis to words left out in *Durckheimer* added).

¹² The Office did not subsequently revise MPEP § 1490 in accordance with the Board's decision in *Durckheimer*.

The Board elaborated that Durckheimer's failure to petition to have the terminal disclaimer cancelled, withdrawn, or nullified during the prosecution of the patent is potentially an error correctable under 35 U.S.C. § 251 if such error occurred without deceptive intention. *Id.* Because this potential error was mentioned in Durckheimer's appeal brief and supplemental brief, and not in the reissue declaration, Durckheimer's reissue declaration was defective under 35 U.S.C. § 251 in that it failed to set forth an error. *Id.* at 14-15, 27. The Board issued a new ground of rejection, rejecting all of the claims under 35 U.S.C. § 251 for failing to state an error without deceptive intention that would warrant reissue of the patent. *Id.* at 25.

We have since held, under different circumstances, that § 251 does not permit reissue of a patent to extend the term of the original patent, as set upon issuance of the patent. *Ex Parte Wellerdieck*, Appeal No. 2007-1119, 2007 WL 5211676 (BPAI 2007) (informative). In *Wellerdieck*, the applicant filed a continued prosecution application under 37 C.F.R. § 1.53(d), which provided for a term of 20 years from the date of the earliest application referenced in the application. Wellerdieck later filed a reissue application, alleging the error of failing to file the application instead under 37 C.F.R. 1.53(d) which appellant argued would have provided the patent with the longer term of 17 years from date of issue. The Board held that Wellerdieck had not alleged an error correctable by reissue under § 251, because the term of the original patent is set upon issuance, and thus by the terms of the statute, which permits reissue only "for the unexpired part of the term of the original patent," reissue cannot operate to extend that term. *Id.* at *5.

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We take this opportunity to resolve a conflict within the Office as to the meaning of “the term of the original patent” in 35 U.S.C. § 251 and whether the Office is authorized by this statute to remove a terminal disclaimer during reissue resulting in an expansion of the term of the original patent set at issuance.

We interpret “the term of the original patent” in § 251 to refer to the “term” of the patent as the term set upon issuance of the original patent. As we noted *supra*, the Federal Circuit has recognized that under § 253 the expiration date of the patent subject to the terminal disclaimer is “reset” to the expiration date of the patent referenced in the terminal disclaimer. *See Merck & Co.*, 482 F.3d at 1319; *see also Bayer AG*, 298 F.3d at 1381. Thus, we disagree with the Board’s earlier holding in *Durckheimer* that a terminal disclaimer does not alter “the term of the original patent.”

As to the Board’s reliance in *Durckheimer* on an omission in 35 U.S.C. § 154 of any mention of the patent term being shortened by a terminal disclaimer, we note that § 154 was subsequently amended to specifically recognize that patent term can expire based upon a terminal disclaimer. *Durckheimer* was decided on August 6, 1996. 35 U.S.C. § 154(b)(2)(B) was amended by PL 106-113 § 4402(a) in 1999. 35 U.S.C. § 154(b)(2)(B) recites that patent term adjustments for patents having a disclaimed portion are prohibited from adjustment “beyond the expiration date specified in the disclaimer.”

As such, we feel that the prior panel's interpretation of § 251 in *Durckheimer* was in error, and the present decision overrules *Durckheimer*.¹³ We adopt the position of the Office as stated in MPEP § 1490 that “[s]ince the granting of a reissue patent without the effect of a recorded terminal disclaimer would result in extending the term of the original patent, reissue under these circumstances would be contrary to the statute.”

Consequently, at the time of issuance of Appellant's patent on January 30, 2001, the statute recognized that the term of the '991 patent would expire on December 22, 2003, the expiration date specified in the Terminal Disclaimer.¹⁴ Section 251 does not permit the Office to now reissue the '991 patent beyond that term as set upon issuance.

¹³ The decision in *Durckheimer* was an unpublished, non-precedential opinion by an eleven member panel of the Board. The present expanded panel has the authority to overrule the prior panel's non-precedential, unpublished decision. *Compare Ex parte Holt*, 19 USPQ2d 1211, 1214 (BPAI 1991) (“A published Board opinion may be *overruled* only by the Board sitting en banc, or by an expanded panel of the Board (i.e., one with more than three members.)” (Citations omitted.)) “Unpublished Board opinions, except as they may be the ‘law of the case’, may not be binding precedent, since the opinions are often fact driven by the specific facts present in the appeal before the Board.” *Id.*

¹⁴ The Terminal Disclaimer disclaimed “the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 17, as presently shortened by any terminal disclaimer, of prior Patent No. 4,581,476.” App. Br. Evidence App'x E.4 Terminal Disclaimer.

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CONCLUSIONS

35 U.S.C. § 251 does not authorize the Office to reissue a patent that has expired based on an expiration date set at the time of issuance of the original patent.

35 U.S.C. § 251 does not authorize the Office in reissue to expand the term of a patent beyond the term of the original patent set at the time of issuance.

DECISION

We AFFIRM the Examiner's decision to reject claims 1-35.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

HANLON, *Administrative Patent Judge*, with whom BAHN, *Administrative Patent Judge*, joins, concurring.

For the reasons set forth below, I respectfully concur. In my opinion, there are two issues on appeal:

1. Is a reissue under 35 U.S.C. § 251 available to withdraw a terminal disclaimer that has been recorded in an issued patent?
2. If so, does the Office have authority under 35 U.S.C. § 251 to reissue the Appellant's patent?

The majority recognizes that the reissue statute is remedial. *See, e.g., In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986) (citations omitted) (Section 251 “is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally.”). Nonetheless, the majority answers the first question in the negative.

The majority points to the language in § 251 which states that a patent may be reissued “for the unexpired part of the *term* of the original patent” (emphasis added). According to the majority, the term of a patent is set at the time of issuance and withdrawing a recorded terminal disclaimer in an issued patent would extend the term of that patent contrary to § 251.

The “term” of a patent is set by statute at the time of issuance. 35 U.S.C. § 154(a)(2) (2010). However, as explained in *Ex parte Durckheimer*, No. 94-2004, slip op. at 19 (BPAI 1996), a terminal disclaimer does not alter the “term” of the original patent. Rather, a terminal disclaimer disclaims a “terminal part of the term . . . of the patent granted or to be granted” thereby resetting the expiration date of that patent. 35 U.S.C. § 253 (2010).

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The majority appears to equate “term” with “expiration date.” However, I respectfully disagree that these terms are synonymous in this case where a terminal disclaimer has been recorded in an issued patent. *See, e.g., Merck & Co., Inc. v. Hi-Tech Pharmacal Co., Inc.*, 482 F.3d 1317, 1322-23 (Fed. Cir. 2007) (discussing the *expiration date* resulting from the terminal disclaimer and the *expiration date* of the patent in the absence of the terminal disclaimer).

In my opinion, there have been no statutory changes since *Durckheimer* that require interpreting the word “term” in § 251 differently than the Board interpreted that word in *Durckheimer*. Therefore, for the reasons set forth in *Durckheimer*, I would answer the first question in the affirmative.

As for the second question, I would answer that question in the negative. The Appellant’s patent expired on December 22, 2003, by virtue of the terminal disclaimer that remains in effect.¹⁵ Therefore, the Office does not have the authority to reissue the Appellant’s patent for “the unexpired part of the term of the original patent.”

nlk

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¹⁵ As the majority points out, the Appellant has not filed a petition in this reissue application to withdraw the terminal disclaimer at issue.