Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

IN RE ERIC J. ARNOTT
Reissue Patent No. 33,039
May 22, 1991
***1** Granted: August 29, 1989

For: Lens Implant for Insertion in the Human Eye

Harry F. Manbeck, Jr.

Commissioner of Patents and Trademarks

DECISION ON PETITION

MEMORANDUM OPINION AND ORDER

Eric J. Arnott (petitioner) seeks review by petition (Paper No. 32) of several decisions denying requests for certificates of correction. More specifically, the petition concerns denial of two requests for Certificates of Correction, filed pursuant to 35 U.S.C. § 255, seeking to correct Reissue Patent No. 33,039 (reissue patent), a reissue of United States Patent No. 4,476,591 (original patent). Petitioner is the sole inventor named in both the original patent and the reissue patent.

Background

The original patent included only claims 1-6. Original claim 1 is an independent claim. Original claims 2-6 all depend either directly or indirectly from original claim 1. The reissue application proposed to modify original claim 1, and to add new claims 7 and 8, each depending from claim 1. The reissue patent issued on August 29, 1989, with reissue claims 1-8. Reissue claim 1 is different from, and broader than, original claim 1; reissue claims 2-6 read the same as original claims 2-6; new reissue claims 7 and 8 depend from reissue claim 1 and do not correspond to any original claim.

In his reissue declaration, petitioner stated:

> 5. That he verily believes Letters Patent No. 4,476,591 to be wholly or partially inoperative by reason of claiming less than he had a right to claim in said Letters Patent.
>
> 6. That furthermore, he verily believes that claim 1 of said Letters Patent and the claims dependent thereon respectively are of insufficient breadth for the reason that each is limited by the recitation of a specific lens and loop material, i.e., polymethyl methacrylate; by the recitation of the loop structure, i.e., that the fourth portion of each loop lies radially outwards of the said second portion of the other loop; likewise by the recitation that the fourth portion of each loop can be pressed inwards into contact with the second portion of the other loop; and by the recitation that, after insertion in the posterior chamber of the human eye the loops spring open, again. As such, each of said claims is unduly limited and hence,

inoperative to afford patent coverage commensurate with the true scope of his improvement as disclosed in the specification, to wit a lens implant having a pair of integrally formed diametrically opposed loops, the configuration of which loops is designed to completely surround the circular lens element. As originally claimed, the invention of claim 1 fails to precisely cover what is critical to the invention, namely the completely encircling nature of the lens loops as opposed to the extent of the lens loop overlap. [Emphasis in original.]

During examination of the reissue application, an examiner objected to the reissue declaration on the basis that it did not specify when and how the alleged error occurred. Petitioner, through a first supplemental reissue declaration, overcame the examiner's objection. The examiner then further objected to the reissue declaration on the basis that it was not clear whether petitioner had reviewed and understood the contents of the reissue application. Petitioner, through a second supplemental reissue declaration, overcame the examiner's further objection. The first and second supplemental reissue declarations did not allege an error different from that alleged in the original reissue declaration, i.e., that petitioner claimed less than he had a right to claim, and that claim 1 and claims dependent thereon were of insufficient breadth.

***2** The reissue patent contains reissue claims 1-8. Figure 1 of the reissue patent (which is the same as Fig. 1 of the original patent) is reproduced below.

TABULAR OR GRAPHIC MATERIAL SET AT THIS POINT IS NOT DISPLAYABLE

Reissue claim 1 reads as follows (numerals from Figure 1 added; language deleted from original claim 1 in brackets and crossed out; and language added to original claim 1 underlined):

1. A lens implant for insertion in the posterior chamber of a human eye after an extra-capsular extraction, said implant comprising a lens 1 and first and second similar holding loops 2 formed integrally with and projecting from the periphery of said lens 1, each of said loops 2 lying substantially in the plane of said lens 1 and being open-ended with one end of said loop integral with said lens 1 and the other end of said loop free, said ends of said loops which are integral with said lens 1 being substantially diametrically opposite each other around the periphery of said lens 1, and each of said loops 2, starting from said end which is integral with said lens 1, including a first portion 3 extending substantially radially outwards from said lens 1, a sharp bend 4 extending from said first portion 3, a second portion 5 extending from said bend 4, said second portion 5 being of a curvature such that it follows, but is spaced radially outwards from, said periphery of said lens 1, a third portion 6 which extends from, and is of less curvature than, said second portion 5, and a fourth portion 7 which extends from said third portion 6 and is of a curvature substantially similar to that of said second portion 5, the end of said fourth portion remote from said third portion 6 being free and lying radially outwards of the other of said loops 2, whereby said two loops 2 together surround said lens 1, and said first portion 3 of each said loops 2 being relatively stiff and the other portions 5, 6, 7 of said loops 2 being more flexible and resilient so that, in use, when said implant is to be inserted through an incision into a human eye, said

fourth portion 7 of each of said loops 2 can be pressed inwards into contact with the other of said loops 2, and both said loops 2 bend in such a way that together they form a substantially circular ring surrounding said lens 1, and, after insertion, said loops 2 spring open and the configuration of an encircling ring is maintained and said ring tends to adhere to the underlying posterior lens capsule of said eye eye.

Reissue claims 7 and 8 did not appear in the original patent. They read as follows, with reference numerals from Figure 1 added:

7. A lens implant as claimed in claim 1, wherein the implant is made of polymethyl methacrylate.

8. A lens implant as claimed in claim 1, wherein the fourth portion 7 of each loop 2 lies radially outward from the second portion 5 of the other loop 2 such that, in use, when the implant is to be inserted through an incision into a human eye, said fourth portion 7 of each loop 2 can be pressed inward into contact with the second portion 5 of the other loop 2.

***3** As shown above, reissue claim 1 deletes from original claim 1 limitations concerning (1) the material from which the lens implant is made, and (2) the second portion of the other loop. Reissue claim 7 adds back the limitation that the lens implant is made of polymethyl methacrylate, but does not contain any limitation concerning the second portion of the other loop. Reissue claim 8 adds back certain limitations about the second portion of the other loop, but does not contain any limitation concerning the material with which the implant is made. Consequently, reissue claims 1, 7, and 8 are each broader in scope than original claim 1, the only independent claim in the original patent. Reissue claims 2-6 are also each broader than respectively corresponding dependent claims 2-6 of the original patent, because reissue claims 2-6 depend from broadened reissue claim 1. The broader scope of reissue claims 1-8 is fully consistent with the statements made in petitioner's reissue declaration.

On May 18, 1990, petitioner filed a first request for Certificate of Correction (Paper No. 24). The mistake alleged was that reissue claim 8 erroneously had been made to depend from reissue claim 1 when it should have been made to depend from reissue claim 7 (id. at page 2). Petitioner further stated that if made to depend from reissue claim 7, reissue claim 8 would have (1) a form corresponding exactly to the limitations of original claim 1, and (2) a scope that is coextensive with original claim 1 (id. at page 3).

The first request for Certificate of Correction was denied on May 24, 1990 (Paper No. 27); reconsideration was denied on July 11, 1990 (Paper No. 28).

On August 14, 1990, petitioner filed a second request for Certificate of Correction (Paper No. 30). Rather than seeking to change the dependency of reissue claim 8 from reissue claim 1 to reissue claim 7, petitioner sought to add a proposed reissue claim 9. Proposed claim 9 is said to be of the same scope as original claim 1, except for one apparently mis-typed word. Petitioner stated that the error which he now seeks to correct is the same as that sought to be corrected by the first request for Certificate of Correction. The second request describes the mistake as: "[T]he potential absence of a claim in the

reissue that is identical to a claim in the original patent" (Paper No. 30, page 1).

The second request for Certificate of Correction was denied on November 8, 1990.

Petitioner now requests (1) further reconsiderationof the denial of the first request for Certificate of Correction, and (2) reconsideration of the denial of the second request for Certificate of Correction.

Opinion

1. The petition is not timely insofar as it seeks further reconsideration of the denial of the first request

The current petition (filed on January, 7, 1991) was not filed within two months of the action complained of, viz., the decision of May 24, 1990 (Paper No. 27), adhered to on reconsideration on July 11, 1990 (Paper No. 28), denying the first request for Certificate of Correction. No excuse has been presented as to why the current petition was not filed within the two-month period specified in 37 CFR § 1.181(g). Hence, insofar as the current petition seeks further reconsideration of the denial of July 11, 1990, the petition is denied as being untimely. Another independent ground for denying the first request, as well as the second request, follows.

2. Petitioner is not entitled to relief on the merits of either request

***4** Independent from being untimely, the petition fails to state a claim for relief on the merits with respect to the first request for Certificate of Correction. It also fails to state a claim with respect to the second request for Certificate of Correction on the merits.

A. The choice of who decides and the expertise of the deciding official

As a preliminary matter, petitioner charges that there was an inconsistency between the handling of the first and second requests (Paper No. 32, pages 2- 3). Evidently, the petitioner is of the view that it is the examining art unit which should decide whether a proposed correction requires reexamination. On that basis, petitioner requests that the denials of May 24 and July 11, 1990, be vacated. Petitioner demands that the first request be forwarded to the Group Director of Group 330 for consideration.

Petitioner's argument lacks merit. The Commissioner has discretion to delegate authority to decide requests under 35 U.S.C. § 255 to appropriate employees of the Patent and Trademark Office (PTO). Petitioner is not entitled to a decision by any particular PTO employee, or unit, or to have any particular PTO employee, or unit,

participate in the decision on any request for Certificate of Correction.

Moreover, petitioner is not necessarily entitled to know whether the examining art unit participated in the denial of the first request for Certificate of Correction. To permit petitioner to inquire into who a deciding official consults, and the extent of any consultation, would constitute an unwarranted invasion into the deciding official's mental process or manner of deliberation in arriving at the ultimate decision; as such, it is privileged information protected from discovery. See United States v. Morgan, 313 U.S. 409, 422 (1941); Western Electric Co., Inc., v. Piezo Technology, Inc. v. Quigg, 860 F.2d 428, 432, 8 U.S.P.Q.2d 1853, 1856 (Fed. Cir. 1988). In addition, within the executive branch, confidential exchanges of opinions and rendering of advice are protected as privileged information. Kaiser Aluminum and Chemical Corp. v. United States, 157 F. Supp. 939, 944-47 (Ct. Cl. 1958). See also Zenith Radio Corp. v. United States, 764 F.2d 1577 (Fed. Cir. 1985).

Petitioner asserts that "it is the art unit which possesses the ready expertise to assess whether or not reexamination would really be required" (Paper No. 32, page 3). Insofar as the petitioner is challenging the expertise of any individual who rendered any decision on either request for Certificate of Correction, it suffices to simply note that the expertise of a deciding official is not legally relevant to the merits of any decision and is not subject to challenge. See In re Nilssen, 851 F.2d 1401, 1402-03, 7 U.S.P.Q.2d 1500, 1501 (Fed. Cir. 1988).

***5** In any event, inasmuch as the merits of both requests for Certificates of Correction are being reviewed by the Commissioner in person, petitioner's expertise and/or authority challenge is moot. There can be no challenge to the authority of the Commissioner to decide the petition in person. Kingsland v. Carter Carburetor Corp., 168 F.2d 565, 77 USPQ 499 (D.C. Cir.), cert. denied, 335 U.S. 819 (1948), reh'g denied, 335 U.S. 864 (1948).

B. Two separate requirements of 35 U.S.C. § 255

Section 255 of Title 35, United States Code reads:

§ 255 Certificate of correction on 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 Commissioner 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. [Emphasis added.]

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 mistake sought to be corrected is not of the type proper for correction by a Certificate of Correction, PTO need not consider whether an applicant's proposed correction would involve new matter or require reexamination. Even if the mistake is of the proper type, a certificate of correction cannot issue if the proposed correction involves changes which would constitute new matter or require reexamination.

1. The first request for Certificate of Correction

Petitioner's mistake is not of a clerical nature, typographical nature, or one of minor character. Hence, the mistake is not one which can be corrected under 35 U.S.C. § 255.

The first request states that it is the "current understanding and opinion" of petitioner's attorneys that (Paper No. 24, page 2):

> a clerical or typographical error occurred in connection with the preparation of the reissue application, so that claim 8 which they intended to be dependent on claim 7 was submitted as being dependent on claim 1.

***6** The first request was accompanied by declarations of petitioner's attorneys, Bradley B. Geist, Esq., and Marina Larson, Esq.

Mr. Geist stated that prior to the drafting of reissue claims 7 and 8, he and Ms. Larson agreed that:

> a claim must be presented in the reissue which had a scope identical to the scope of the independent claim [claim 1] in the [original patent].

Mr. Geist also stated that claims 7 and 8 were thereafter drafted to achieve the agreement. Mr. Geist further stated that the error arose:

> probably during the original typing of claim 8 from a handwritten draft (since it was my practice to prepare handwritten drafts), and that claim 8 should have been dependent from claim 7.

Ms. Larson stated that she and Mr. Geist agreed that a claim must be presented in the reissue which had a scope identical to the scope of the independent claim 1 in the original patent, and that claims 7 and 8 were drafted to achieve that agreement. Ms. Larson further stated that the error arose:

> perhaps during the original typing of claim 8 from a handwritten draft, and that claim 8 should have been dependent from claim 7.

She still further stated that her efforts to locate handwritten drafts

of the reissue application have not been successful.

The statements by Mr. Geist and Ms. Larson are inadequate to show that a clerical or a typographical mistake occurred. At most, the statements demonstrate only that Mr. Geist and/or Ms. Larson did not implement their stated intent. In their statements, Mr. Geist and Ms. Larson use speculative words, i.e., "probably" and "perhaps," in associating the alleged mistake to the process of typing from a handwritten draft.

Moreover, there is no evidence of the existence of any handwritten draft. Mr. Geist declared that "it was [his] general practice to prepare handwritten drafts," but that does not mean that on this occasion there actually was a handwritten draft. Even if there had been a handwritten draft, it is uncertain on this record that draft claim 8 was to depend from draft claim 7.

Absent 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, i.e., the file of the reissue patent in this particular case. For example, if the specification refers to degrees in Celsius and the claims recite merely degrees, it might be said that a clerical error occurred in not reciting degrees Celsius in the claims. Another example would be where (1) numerous references are submitted with a disclosure statement (37 CFR § § 1.97-1.98); (2) the references are discussed by the examiner in an Office action; (3) but one reference inadvertently is not listed by the applicant in a form for listing references, i.e., Form 1449 (see MPEP, § 609); and (4) thus, the one reference is not printed on the resulting patent. One might reasonably say that a clerical error occurred in not listing the reference in Form 1449; the error would be apparent from the file because the reference was discussed in the disclosure statement. Likewise, a typographical error is shown when one looking at a mis-typed word immediately knows the correct spelling. Reference to "parol" evidence beyond the patent file should not be necessary to establish the existence of a clerical or typographical mistake.

***7** The PTO file of the reissue application itself does not reflect that a clerical or typographical mistake was made when claim 8 was made to depend from claim 1. On its face, claim 8, as originally presented, reads fine and is consistent with petitioner's reissue declaration which indicates that the petitioner sought to broaden the claims of the original patent. The file of the reissue patent does not otherwise indicate the existence of a clerical error in connection with the dependency of claim 8; the petitioner has not pointed to anything in the file which refers to claim 8 as being dependent from claim 7 rather than claim 1.

Likewise, petitioner's alleged mistake is not a mistake of "minor character." The difference between having and not having a claim of particular scope is significant, and especially significant in the context of a reissue patent.

Claim 8 in its present form is without the limitation that the lens implant is made of polymethyl methacrylate. If made to depend from claim 7, rather than claim 1, claim 8 will have a limitation to

polymethyl methacrylate. The mistake, whether it be viewed as failing to have claim 8 depend from claim 7, or as failing to have a reissue claim that is of the same scope as original claim 1, is not minor because it results in the absence in the reissue patent of a claim of certain particular scope.

Adding to an existing patent a claim having a scope different from that of any claim already included in the patent undoubtedly strengthens the patent. If the new claim is broader in scope than any claim in the existing patent, the scope of coverage under the patent is expanded; and if the new claim is narrower in scope than some or all of the claims in the existing patent, the hierarchical claim-scope structure of the patent is expanded. A more expansive hierarchical structure strengthens a patent because each level in the claim- scope hierarchy represents a line of defense for the patentee against charges of invalidity.

Moreover, this case involves a reissue patent, which makes very important whether there is a reissue claim having the same scope as an original patent claim. If there is, an accused infringer cannot assert intervening rights under 35 U.S.C. § 252 as an affirmative defense; if there is not, then the accused infringer can. See Kaufman Company Inc. v. Lantech Inc., 807 F.2d 970, 977-78, 1 U.S.P.Q.2d 1202, 1207-08 (Fed. Cir. 1986); Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 829-30, 221 USPQ 568, 576-77 (Fed. Cir. 1984). In their statements, both Mr. Geist and Ms. Larson indicate that it was their consideration of intervening rights which resulted in their agreement that the reissue patent must include a claim which has identical scope with original claim 1.

Since the alleged mistake has not been shown to be a clerical mistake or a typographical mistake, and is not a mistake of minor character, the first requirement under 35 U.S.C. § 255 concerning the nature of the mistake sought to be corrected has not been met. A Certificate of Correction cannot issue even if the second requirement concerning the nature of the proposed correction is met.

***8** Where a proposed correction involves a change in claim scope, the reissue statute is controlling, not the provisions of law governing Certificates of Correction. Eagle Iron Works v. McLanahan Corporation, 429 F.2d 1375, 1383, 166 USPQ 225, 231 (3d Cir. 1970).

It is not necessary to consider whether petitioner's proposed correction involves changes which would require reexamination. Nevertheless, the following discussion is believed to be appropriate.

Evidently, petitioner believes that claim 8, if modified to depend from claim 7 rather than claim 1, would have the same scope as original claim 1. Petitioner further believes that because original claim 1 was previously examined, reexamination of corrected claim 8 would not be required. However, it is not entirely clear that reissue claim 8, after the proposed correction, would have a scope identical to original claim 1.

In original claim 1, it is only the free end of the fourth portion of each loop which must lie radially outwards of the second portion of the other loop; in pertinent part, original claim 1 reads:

[T]he end of said fourth portion remote from said third portion being free and lying radially outwards of said second portion of the other of said loops[.]

Reissue claim 8 would require the entire fourth portion of each loop to lie radially outwards of the second portion of the other loop. In pertinent part, reissue claim 8 reads:

[T]he fourth portion of each loop lies radially outward from the second portion of the other loop[.]

Accordingly, reissue claim 8, even if made to depend from claim 7 to thereby add a limitation concerning the material with which the lens implant is made, would not have identical scope with original claim 1.

Even if modified claim 8 were identical in scope with original claim 1, reexamination would nevertheless be required. In a reissue patent application, even if some claims are identical to certain original patent claims, PTO is nevertheless required to reexamine all reissue application claims; that is because 35 U.S.C. § 131 requires examination of patent applications, and 35 U.S.C. § 251 makes applicable to reissue proceedings all statutory provisions governing original applications subject to one exception not applicable here. Section 251 of Title 35 states:

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent . . . .

As stated in 37 CFR § 1.176:

§ 1.176 Examination of reissue

An original claim, if re-presented in the reissue application, is subject to reexamination, and the entire application will be examined in the same manner as original applications, subject to the rules relating thereto, except that division will not be required . . . . Furthermore, § 1440 of the Manual of Patent Examining Procedure states, in pertinent part:

***9** Section 1.176 [37 CFR § 1.176] provides that an original claim, if re-presented in a reissue application, will be subject to reexamination and along with the entire application, will be fully examined in the same manner subject to the same rules relating thereto, as if being presented for the first time in an original application . . . [Emphasis added.]

Had petitioner not made the mistake now alleged when he filed the reissue application, claim 8 as dependent on claim 7 would have been reexamined during the reissue proceeding, even if it had the same scope as original claim 1. For that reason, it would be improper to now permit a correction of the alleged mistake without subjecting modified claim 8 to reexamination. Accordingly, petitioner's proposed correction of claim 8 involves changes which would require reexamination.

2. The second request for Certificate of Correction

Petitioner, via the correction proposed in the second request for Certificate of Correction, seeks to add new claim 9, which is in all respects the same as original claim 1 except for one apparently mis-

typed word appearing in original claim 1. Petitioner asserts that the mistake is the same as that alleged in the first request for Certificate of Correction, and characterizes the mistake as "the potential absence of a claim in the reissue that is identical to a claim in the original patent" (Paper No. 30, page 1). As further stated in petitioner's reconsideration request of January 7, 1991:

> By the two requested Certificates of Correction, patentee seeks to correct an error which arose during the prosecution of the reissue application whereby no claim is present in the reissue of absolutely identical scope to a claim in the original patent.

As already discussed above in connection with the first request for Certificate of Correction, the failure to include in the reissue application a claim of the same scope as original claim 1 is not a mistake of minor character. Additionally, the specific failure to include a claim written out as now proposed independent claim 9 is not a clerical or a typographical mistake.

Petitioner and his attorneys do not allege, and there is no evidence demonstrating, that there was at any time a handwritten draft of the reissue application which included an independent claim 9 as now proposed. Neither petitioner nor his attorneys have alleged that when filing and prosecuting the reissue application they intended to include a claim written out in the same form as now proposed independent claim 9. Rather, the second request for Certificate of Correction reveals that the thought of adding independent claim 9 is for avoiding the opinion expressed in the decision of July 11, 1990, that causing claim 8 to depend from claim 7 does not necessarily result in a claim having the same scope as original claim 1.

For the foregoing reasons, not including a claim in the reissue application exactly like proposed independent claim 9 was not a clerical or typographical mistake or a mistake of minor character. Rather, it was a mistake in judgment. Accordingly, the first requirement under 35 U.S.C. § 255 concerning the nature of the mistakes correctable by a Certificate of Correction is not met. For that reason alone, the second request for Certificate of Correction should be denied.

***10** Even assuming that the first requirement of 35 U.S.C. § 255 is met, the second requirement that the proposed correction would not require reexamination is not satisfied. As discussed above, 35 U.S.C. § 131 requires examination of patent applications, and 35 U.S.C. § 251 makes applicable to reissue proceedings all statutory provisions governing original applications for patent subject to one exception not applicable here.

Had the petitioner included in the reissue application a claim written out exactly like now-proposed independent claim 9, it would have been reexamined during the reissue proceeding notwithstanding the fact that it has the same scope as that of original claim 1. 37 CFR § 1.176; § 1440, Manual of Patent Examining Procedure. Thus, it would be improper now to permit the addition of independent claim 9. For that additional reason, petitioner's proposed correction to add independent claim 9 to the reissue patent involves changes which would require reexamination.

ORDER

Upon consideration of petitioner's request dated January 7, 1991, for reconsideration of the denial of petitioner's first request for Certificate of Correction, it is

ORDERED that the first request is DENIED.

Upon consideration of petitioner's request dated January 7, 1991, for reconsideration of the decision which denied petitioner's second request for Certificate of Correction, it is

FURTHER ORDERED that the second request is also DENIED.

19 U.S.P.Q.2d 1049

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