

Keywords: correctable error; 35 U.S.C. § 251; mistake;

General: The Federal Circuit held that it is not correctable error when an attorney makes a conscious decision regarding prosecution strategy. The attorney had failed to submit drawings with an application, and then had to choose between adding the drawings (and thus taking a later filing date) or keeping the earlier date (without the benefit of the omitted drawings). The attorney chose the former. Later, the inventor's new attorney claimed that the predecessor's decision was an error and wanted to use a reissue proceeding under 35 U.S.C. § 251 to claim the original filing date. The court held that a conscious decision by an attorney is not correctable error under Section 251.

In Re Arnold B Serenkin
No. 06-1242 (Fed. Cir. 2007)
Decided March 6, 2007

I. Facts

Applicant filed a provisional application 60/036,649 ("the '649 application") in the PTO on January 29, 1997. The Applicant filed a PCT application with the USRO on January 28, 1998, but failed to include eight pages of drawings with the application. Applicant submitted the missing drawings on February 17, 1998. The USRO did not accept the late drawings and informed the Applicant that the file is not complete until the drawings are submitted. Thus, the Applicant has the choice of either not including the drawings or "completing" the file on February 17, 1998, and using that date as the filing date. If the Applicant chooses the latter, the initial filing date of January 29, 1997 would be lost.

On March 31, 1998, Applicant's attorney filed a petition with the USRO to accept the February 17, 1998 date and include the drawings with the application. Applicant's attorney reiterated this request on August 19, 1998, and requested that the World Intellectual Property Organization republish the application to show the February 17, 1998 filing date and to include the eight pages of drawings. USRO confirmed the drawings and date on September 10, 1998.

Applicant filed a request to commence the United States national phase of the PCT application on August 21, 1998 (Application No. 09/125,736 – "the '736 application"). The application included a preliminary amendment that deleted the '649 filing date of January 29, 1997, and instead used the PCT filing date of February 17, 1998. The '736 application issued as U.S. Patent 6,109,425 ("the '425 patent") on August 29, 2000.

On April 30, 2002, the Applicant's new counsel sought a reissue of the '425 patent, seeking the benefit of the '649 provisional application's filing date of January 29, 1997. The Examiner rejected this request, stating that this was not the type of error that supports a reissue. An appeal board sustained the Examiner's rejection after concluding that the Applicant failed to obtain the earlier filing date because of a deliberate choice, and not because of inadvertence, accident, or mistake, which are correctable by reissue under Section 251.

Applicant now argues that the attorney should have accepted the January 28, 1998 filing date without the drawings, and added the drawings at a later date.

II. Issues

- A. Whether an attorney's incorrect procedural choice during prosecution constitutes an "error" for Section 251 reissue purposes.

III. Discussion

- A. No. The attorney made a procedural choice to use a later filing date in exchange for inclusion of missing drawings. Section 251, which governs the reissue of defective patents, is not construed to authorize a reissue when an attorney makes an informed, albeit poor, decision. Section 251 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 ... reissue the patent for the invention disclosed in the original patent ... for the unexpired part of the term of the original patent.

35 U.S.C. § 251 (emphasis added). The court noted that while Section 251 is based on principles of equity and fairness, its remedial function is limited. Section 251 "is not a panacea for all patent prosecution problems." A deliberate action of an inventor or attorney is not a correctable error under Section 251.

The court cited several examples of deliberate actions by attorneys that did not qualify as correctable error under Section 251. In the first, the attorney made a "conscious choice" of not filing a continuing application during the pendency of the parent application.¹ During the subsequent year, the attorney discovered prior art references that would defeat patentability of the subject matter unless the attorney could claim priority from the parent application. The court held that the delay was a conscious choice and thus not an error under Section 251.

In the second case cited by the court, the inventor cancelled one of two sets of claims when the Examiner required restriction between the claims.² When the attorney failed to file the second set of claims in a new application, the court held that the delay did not make the original patent partially inoperative. The inventor acquiesced to the Examiner's request to cancel claims, and therefore did not establish a correctable error.

Serenkin's attorney knowingly chose the date over the drawings, and knew the consequences at the time of the decision, and thus Serenkin cannot now claim that the decision is a correctable error. The court drew a distinction between a conscious choice, which is not a correctable error, and an error caused by accident, inadvertence, or mistake, which are correctable errors. Examples of the latter include clerical error by failing to file a certified copy of the foreign application and failure to notify PTO of earlier-filed copending applications during prosecution of original application.

IV. Conclusion

An attorney's conscious decision to surrender a right to a claim of priority is not a correctable error under Section 251.

¹ In re Mead, 581 F.2d 251 (CCPA 1978).

² In re Orita, 550 F.2d 1277 (CCPA 1977).

IN RE SERENKIN TIMELINE

