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CLIENT ALERT

PTAB Has No Authority to Decide the Merits of a Petition for a Certificate of Correction

OCTOBER 1, 2019

Honeywell International Inc. v. Arkema Inc., Arkema France, Nos. 2018-1151, 2018-1153 (Fed. Cir. Oct. 1, 2019)
The patent owner appealed the combined Final Written Decision of the Patent Trial and Appeal Board (PTAB) on two post-grant review proceedings concerning the same patent. The appeal challenged the PTAB's decision to deny the patent owner's request to file a motion for leave to petition the Patent and Trademark Office Director (Director) for a Certificate of Correction. The patent owner sought to correct the priority chain in the challenged patent pursuant to 35 U.S.C. § 255, which allows patentees to petition the Director to correct "a mistake of a clerical or typographical nature, or of minor character" upon a showing that the mistake "occurred in good faith." Without even allowing the patent owner to file its motion, the PTAB found there was "a failure to show that the requirements of 255 have been met." The Federal Circuit held that the PTAB abused its discretion when it evaluated whether the petitioner met the requirements of § 255. By doing so, the PTAB assumed authority expressly delegated to the Director.

The Federal Circuit clarified the three steps a patent owner subject to post-grant review must take to petition for a Certificate of Correction: "(1) seek authorization from the Board to file a motion, 37 C.F.R. § 42.20(b); (2) if authorization is granted, file a motion with the Board asking the Board to cede its exclusive jurisdiction so that the patentee can [petition] the Director, 37 C.F.R. § 1.323; MPEP § 1485; and (3) if the motion is granted, petition the Director for a Certificate of Correction." In particular, at the second step, the PTAB is to "determine whether there is sufficient basis supporting the patent owner's position that the mistake may be correctable." It held that this standard of review was more consistent with the statute and regulations. Finally, the court recognized that the Director has a longstanding practice of allowing priority claims to be corrected through certificates of correction.
A copy of the opinion can be found here.

1 Min Read

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